THE LAW AND PRACTICE

RELATING TO

LETTERS PATENT FOR INVENTIONS.

THE

LAW AND PRACTICE

RELATING TO

LETTERS PATENT FOR INVENTIONS.

WITH FULL

APPENDICES

OF

STATUTES, RULES, AND FORMS.

BY

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DURING THE

INTRODUCTION AND ENACTMENT

OF THE

PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.

PREFACE.

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Bearings with which Letters Patent for Inventions are now sealed.

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R. W. W.
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THE LAW AND PRACTICE

OF

LETTERS PATENT FOR INVENTIONS.

CHAPTER I.

Historical and Introductory.

THE PREROGATIVE OF THE CROWN TO GRANT MONOPOLIES BY LETTERS PATENT AND THE LIMITATIONS IMPOSED THEREON BY THE STATUTE OF MONOPOLIES.

No Property in an Invention.—Neither at common law nor by statute is there any property in an invention. Hence no inventor, as such, is in law entitled to the sole use of his invention. He may exclude others from participation in its benefits, by keeping the product of his ingenuity secret; but if he adopts this course it will generally be at the price of himself abstaining from all profitable use of the invention. For if he once publishes his invention either by use in public or by description, so that others become cognizant of the manner of performing it, the public are free to use it as they please, and he cannot by virtue of any property in it peculiar to himself restrain them from so doing.

Hence an inventor who desires to secure to himself the full benefit of his ingenuity must not only invent but also acquire by a further step that right to the exclusive use of his invention which is not a legal incident of the successful exercise of the inventive faculty. In other words, he must obtain by grant, for such period as the law permits, the sole use of his invention. This is a monopoly and by English law can be granted only by the Sovereign, in whom

from time immemorial has been vested the right of thus bestowing upon an inventor the sole benefit of his invention.

The Granting of Monopolies a Prerogative of the Crown.—The right of the Crown to make such grants does not spring from, though it has been from time to time controlled by, parliamentary enactment. It is an inherent part of the royal prerogative; (*a*) one of those powers which the law recognizes as vested in the Sovereign for use for the public good; a power in its origin outside of and apart from the common law, and yet admeasured thereby, so that it shall not tend to the prejudice or hurt of any subject. (*b*) "The king's prerogative," says Sir Henry Finch, "stretcheth not to the doing of any wrong." (*c*) Thus the prerogative rights of the Crown enjoy legal sanction, not for the private advantage of the Sovereign, but for the general good of the community. (*d*)

The powers of the prerogative are of great antiquity; in fact, as ancient as the law itself. (*e*) Thus, from time immemorial the Crown has claimed and exercised the right of granting by charters and letters patent franchises and privileges to individuals and corporations. The subject-matters of such grants have been numerous and diverse; here, however, it is only material to consider the use of this power in respect of trade and the industrial development of the country.

Origin of the Royal Prerogative in relation to Trade.—At a very early period the king assumed in English history the position of arbiter and protector of commerce. (*f*) As the force in the Constitution responsible for the peace of the land and the orderly government of the community, he was the natural guardian and

(*a*) "By the word prerogative we usually understand that special pre-eminence which the king hath over and above all other persons, and out of the ordinary course of the common law, in right of his regal dignity" (Blackstone's *Com.*, vol. i. bk. 1, c. 7); "The king's prerogative is part of the law of England and comprehended within the same" (Coke, 2 *Inst.* 496).

(*b*) See *Willion* v. *Berkeley* (temp. 3 Eliz.), Plowden's Reps., edit. 1779, p. 236. Bracton says, "Ipse autem rex, non debet esse sub homine, sed sub deo et sub lege, quia lex facit regem" (*De Legibus Angliae*, lib. i. c. 8). "All prerogatives must be for the advantage and good of the people, otherwise they ought not to be allowed by law" (Bacon's *Abridgt.*, 7th edit. vol. vi. 385).

(*c*) *Description del Common Leys d' Angleterre* (pub. 1613), edit. 1759, p. 85.

(*d*) Per Lord Kenyon, C.J., in *Yorke* v. *Dayrell*, 4 T. R., p. 410.

(*e*) "The rights and prerogatives of the Crown are in most things as ancient as the law itself; for though the Statute 17 Ed. II. st. 1, commonly called *De prerogativa Regis*, seems to be introductive of something new, yet for the most part it is but a sum or collection of certain prerogatives that were known law long before" (Bacon's *Abridgt.*, 7th edit. vol. vi. p. 387).

(*f*) See Blackstone, *Com.*, bk. 1, c. 7, v.

fosterer of trade. When life and property were insecure, population sparse, and communication between the different parts of the realm difficult and hazardous, combination under the protection of the central executive authority was essential to the maintenance and development of trade. Hence merchants and craftsmen, for their mutual safety, formed themselves into guilds and societies under royal charters of privilege. The king's peace made trade possible; the king's charter regulated its exercise. Each craft or trade became a separate mystery, the practice of which was rigidly limited to members of the guild or society and those who obtained entrance thereto by serving a period of apprenticeship.

In addition to this regulation of internal trade, the Crown likewise played a leading part in promoting the introduction of new trades and manufactures from abroad, by issuing licenses or letters of protection to traders and craftsmen who were subjects of foreign states. (*g*)

From letters of protection the step was inevitable to letters of privilege, and thus the law early recognized that the Crown might, as an encouragement to introducers of new trades, grant to such persons advantages not enjoyed by subjects of the Crown at large. Hence, under the 40th year of Edward III. it is laid down in the Year-book that arts and sciences are greatly favoured in law, and the king, as chief guardian of the common weal, has power and authority by his prerogative to grant many privileges for the sake of the public good, although *primâ facie* they appear to be clearly against common right. (*h*) Such privileges were granted by letters patent, *i.e.* open letters addressed in the name of the sovereign to all to whom they may come, and attested by an impression of the great seal appended at the foot. (*i*)

Limitations Imposed on the Prerogative by Law.—Although the law thus recognized the royal right of intervention in matters of

(*g*) In 1331 Edward III. granted letters of protection to John Kempe, a native of Flanders, to enable him to set up the industry of cloth-making in England. Similar grants were made in 1336 to two weavers of Brabant, and in 1368 to three clockmakers of Delft. In 1440 Henry VI. made a similar grant to John Shiedame, the introducer of a new method of manufacturing salt; while again, in 1452, a grant was made to three Bohemian miners who possessed *meliorem scientiam in mineris*. See an article by Mr. E. W. Hulme in the *Law Quarterly Review* (1896), vol. xii. p. 141.

(*h*) 40 Ed. III., pt. iv. fol. 17, 18.

(*i*) Now, in the case of patents for inventions, the seal of the Patent Office. "The king's grants," says Blackstone, "are also of public record. These grants, whether of lands, honours, liberties, franchises, or ought besides, are contained in charters, or letters patent, that is, open letters, *literæ patentes:* so called because they are not sealed up, but exposed to open view, with the great seal pendant at the bottom; and are usually directed or addressed by the king to all his subjects at large" (*Com.*, vol. ii. bk. ii. c. 21, edit. 1809, p. 316).

trade, it vigilantly watched its exercise and protested against its abuse. For the freedom of trade was a principle dear to the common law; and just as private contracts in restraint of that freedom were repugnant to the law, so royal grants having the like effect could only be justified on exceptional grounds. Hence the law early denied the validity of grants which purported to place in a few hands a trade already known and used by others; for this was to abridge the vested rights of the subject. (*j*)

"The king's grant of a monopoly," says Bacon, "as of the sole buying, selling, working, making, or using of any commodity, is not only void by the common law, but the persons procuring such grants are said to be punishable by fine and imprisonment. And indeed the freedom of trade and labour is of such consequence that, as no man can by his own act totally debar himself of this privilege, much less can he be restrained by the king's letters patent." (*k*)

Monopolies of existing trades were objectionable on the double ground that they took away from a limited number of persons a lawful livelihood, and increased for all the price of the commodity covered by the grant. (*l*) Nevertheless, with the increase of the royal authority in the Tudor period, such grants became frequent. They afforded an easy means at once of rewarding favourites and increasing the royal revenues; and hence, though ever without law, were never without friends. (*m*)

The granting of these monopolies was carried by Elizabeth to an enormous height. (*n*) By the close of her reign, however, notwithstanding the high pretensions of the Crown, the principles of law applicable to such grants were clearly settled; and monopolies, though not invalid *per se*, were admitted to be unlawful, if so granted as to be injurious to the public interest. Thus a monopoly of a known trade found no favour with the law, but a monopoly of a trade new in the realm, granted for a limited time by way of encouragement to the first inventor or introducer thereof, was

(*j*) Parliament frequently interfered to vindicate freedom of trade against encroachment. See 9 Ed. III. st. 1, c. 1; 25 Ed. III. st. 4, c. 2; 31 Ed. III. c. 10; 2 R. II. st 1, c. 1; 12 H. VII. c. 6.

(*k*) *Abridgement*, 7th edit. vol. vi. p. 499.

(*l*) See Hawkins, *Pleas of the Crown*, bk. i. c. 79, s. 2; edit. 1716, p. 231.

(*m*) Coke, 3 *Inst.* c. 85, 182.

(*n*) Blackstone, *Comm.*, bk. iv. c. 12. Much interesting light is thrown upon Elizabeth's abuse of the prerogative in this respect by a debate in the parliament of 1601. Monopoly patents had been granted for all sorts of commodities, Secretary Cecil enumerates upwards of a score. See *Parl. Hist.*, vol. i. pp. 926, 927, 929; D'Ewe's *Journals of Parl.*, edit., 1682, pp. 645, 646, 652. The duration of these grants seems to have ranged from seven to twenty years. See Mr. E. W. Hulme's Article, *Law Quarterly Review*, vol. xii. p. 141.

regarded as a legitimate stimulus to trade enterprise and therefore beneficial to the whole community. A glance at the early authorities will illustrate this.

In the time of Edward III. one *John Pechey* obtained a license under the great seal that he only might sell sweet wines in London. For this monopoly he was arraigned at the bar in parliament, where the patent, after great advice and dispute, was adjudged void, and before his face, in open parliament, cancelled because he had exacted 3*s.* and 4*d.* for every tun of wine, he himself being adjudged to prison until he had made restitution of all he had ever received, and paid a fine of £500 to the king. (*o*)

A patent for the sole making and selling of frisadoes in England during a stated period was granted by Elizabeth, to one *Hastings*, in consideration of his having brought into the realm the skill of making frisadoes as they were made in Haarlem and Amsterdam beyond the seas. The patentee took proceedings upon this patent against certain clothiers of Coxall, for making frisadoes in breach of his monopoly; but failed upon the defendants shewing that they had done what he complained of before the making of his grant. (*p*)

In *Matthey's* case, a patent had been granted for the making of knives with bone hafts, a device which the patent alleged that *Matthey* had first introduced from abroad. But the Wardens of the Company of Cutlers proved that, except for a trifling difference, they had made similar knives before, and, therefore, the patentee "could never have the benefit of this patent, although he laboured very greatly therein." (*q*)

Again, in *Humphrey's* case, a patent had been granted for an instrument for melting lead, upon the supposition that the instrument was the patentee's own invention. But, doubt being cast upon this in a proceeding before the Exchequer Chamber, the Court held that if, as alleged, the invention had been used before within the realm, the patentee could not have that exclusive use thereof which his patent purported to give him. (*q*)

The Case of Monopolies.—Next in the well-known case of *Darcy* v. *Allin* (*r*) at the close of Elizabeth's reign, the validity of letters

(*o*) D'Ewe's *Journals*, edit. 1682, p. 645; *Parl. Hist.*, vol. i. p. 926; Coke 3, *Inst.* 181; Rot. Par., 50 Ed. III., nu. 33.

(*p*) Noy's Reps. 183.

(*q*) Ibid.; also a grant of Elizabeth.

(*r*) This case was argued between Trin. Term, 1602, and Easter Term, 1603, when judgment was given. It is reported in Moore's Rs., pp. 671 to 675; Noy's Rs., pp. 173 to 185; Coke's Rs., pt. xi. 84 b. The various reports are carefully collated and edited by Mr. J. W. Gordon in his recent book on *Monopolies by Patents*, pp. 193 to 234.

patent for trade monopolies was exhaustively debated before the Court of King's Bench. In this case the plaintiff, Edward Darcy, alleged that Queen Elizabeth had by letters patent granted to one Ralph Bowes for a period of twelve years and thereafter to the plaintiff for a further period of twenty-one years, the sole right of importing playing cards and of making, buying and selling them in England; that the defendant, a haberdasher of London, in breach of the plaintiff's monopoly, had made eighty gross of playing cards and imported one hundred gross more, and sold half a gross without the license of the Queen or consent of the plaintiff, and so defrauded the plaintiff of the benefit of his charter. The defendant contended that the patent was bad, on the ground that it created a monopoly of a known industry. After hearing repeated arguments, the Court of King's Bench held that the plaintiff's grant, being a monopoly, was utterly void, as contrary to the common law and against divers Acts of Parliament. (*s*).

This case is important, not only on account of the view it affords of the earlier authorities, but also as shewing through the arguments adduced on both sides the extent to which the common law by 1603 had established its right to limit the indiscriminate exercise of the royal prerogative in the granting of monopoly patents. Thus it is nowhere suggested by the counsel who argued for the patent that a Crown grant is above the law and *ipso facto* sufficient authority to support any monopoly. On the contrary, it is admitted that there is an onus upon the patentee to shew that his grant is for the public good. Sir E. Coke (Att.-Gen.) and Flemming (Sol.-Gen.), counsel for the plaintiff, both defended the grant in this case upon the ground that card playing was the cause of idleness and want, and a misemployment of time. From this they argued that the free and uncontrolled making or importing of cards was a national evil which the king's patent might in the public interest prohibit altogether and therefore certainly restrain. Further, they admitted by implication that the grant of a monopoly of an existing trade was void in law, by the attempt they made to save the patent in this case from the application of that principle by arguing that cards were not any merchandize or thing concerning trade of any necessary use, but things of vanity. Indeed, the whole course of the argument shews that it was common ground between the parties that royal letters patent are subject to review by the judges, who must determine whether they are good or bad according to the ancient allowance. Again, no

(*s*) See ante, p. 4, n. (*j*).

suggestion is found in the argument that trade monopolies are bad *per se* (*t*). It is assumed throughout that in a proper case the Court will enforce the grant.

What at common law were at this time considered to be the incidents of a valid monopoly patent was succinctly stated by Fuller, one of the counsel for the defendant, in a passage which has since been so frequently quoted as a correct exposition of the law, that it may be regarded as invested now almost with the authority of a judicial deliverance. That passage is as follows :—

"Now, therefore, I will shew you how the judges have heretofore allowed of monopoly patents, which is that where any man of 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 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."

Policy of the Crown under James I.—One of the results of this celebrated case was the publication, in 1610, of a book or declaration in the name of King James I., in which the royal pleasure in matters of bounty was set forth (*u*). In this book monopolies were expressed to be "things contrary to our laws," and suitors were commanded not to move the king in respect of them. From this command, however, were excepted "projects of new invention, so they be not contrary to the law, nor mischievous to the State, by raising prices of commodities at home, or hurt of trade, or otherwise inconvenient."

Some five years later, in 1615, trade monopolies again came under the notice of the Courts in the case of the *Clothworkers of Ipswich* (*v*). In that case the action was brought by the

(*t*) Sir E. Coke in his Commentary on the Statute of Monopolies seems, by limiting his definition of a monopoly to the objectionable type which the common law condemned, to suggest that all monopolies are bad in law. But this obviously is incorrect. For the sole right of using a new invention is clearly a monopoly, and this the common law never condemned. Sir E. Coke's definition is as follows:—"A monopoly is an institution or allowance by the king by his grant, commission or otherwise to any person or persons, bodies politic or corporate, of or for the sole buying, selling, making, working, or using of anything, whereby any person or persons, bodies politic or corporate, are sought to be restrained of any freedom or liberty that they had before, or hindered in their lawful trade" (3 Inst. c. 85).

(*u*) Coke says that this case was "the principal motive of the publishing of the King's Book" (3 Inst., 181). A copy of this curious book is reprinted by Mr. J. W. Gordon, in his *Monopolies by Patents*, pp. 160–193.

(*v*) Godbolt's Reps., p. 252; Coke's Reps. pt. xi. 53 a. This case was heard in the Court of King's Bench, Easter Term, 1615, Sir E. Coke then being Chief Justice.

Corporation of Ipswich Clothworkers against a defendant who had used the trade of a tailor in their town. The plaintiffs alleged that the king, by his charter, had incorporated them, and granted them the sole trade of clothworker or tailor in Ipswich. The Court of King's Bench, as appears by the following extract from Godbolt's Reports, held that this constitution, or ordinance, was unlawful.

"And it was agreed by the Court that the king might make corporations, and grant to them that they may make ordinances for the ordering and government of any trade; but thereby they cannot make a monopoly, for that is to take away free trade, which is the birthright of every subject."

But the judges also agreed that—

"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, or if a man hath made a new discovery of anything, in such cases the king, of his grace and favour, in recompense of his costs and travail, may grant by charter unto him that he only shall use such a trade or traffic for a certain time, because at first the people of the kingdom are ignorant, and have not the knowledge or skill to use it. But when that patent is expired, the king cannot make a new grant thereof. For when the trade has become common, and others have been bound apprentices in the same trade, there is no reason that such should be forbidden to use it."

Thus, at the commencement of the seventeenth century, two kinds of monopoly by patent were well known in England; both creatures of the royal prerogative; the one justified and supported by the law, the other regarded as a usurpation and an abuse; the first, a monopoly of a new trade or contrivance tending to the public advantage, granted for a reasonable time only, by way of reward and encouragement to the first inventor or introducer thereof; the second, a monopoly of a trade or contrivance already known and used by others, granted in deprivation of their rights to some suitor of the Crown who had conferred no benefit upon the public, and was therefore undeserving of such reward.

Examples of Illegal Patents.—Although the incidents of a good patent were thus clearly settled at common law, and the king in his book had announced his royal intention to grant no further monopolies except for projects of new inventions, the abuse of the prerogative in the issuing of illegal patents rapidly became under James I. an even greater source of oppression and discontent than it had been under Elizabeth.

Grants conferring monopolies of excessive duration, and interfering with existing trades, were obtained by many persons, and oppressively enforced before the Privy Council, under commissions and proclamations. A few of these grants may be briefly noticed.

In February, 1619, a patent was granted to Abraham Baker for the making of smalt, which gave the patentee a monopoly for the term of thirty-one years, although two previous patents (one declared prejudicial and void by the king, the other surrendered by the grantee) had been granted in respect of the same monopoly to the same patentee. (*w*) By the terms of this grant Baker undertook to make in the kingdom *smalt* as good and cheap as the like brought from beyond the seas within the seven years preceding the date of the first patent. The grant was expressed to be made by way of reward for Baker's great labours and expenses in attaining this mystery, and for his encouragement and that of others in the like endeavours. It prohibited the importation of smalt made abroad, and thus struck at a trade already existing when this monopoly was first granted.

With Baker's patent may be compared the patents granted by James I. for the making of *glass* with coal, on the pretext that it was necessary for the public good to stop the use of wood for this purpose; the making of glass with timber being alleged in the letters patent to be "the greatest and thiefest means to consume and destroy timber and wood." The glass patents created wide discontent, because, by prohibiting the importation of foreign-made glass, they at once raised the price and depreciated the quality of the glass formerly sold. (*x*)

Three other monopolies of an even more objectionable character, and most oppressively enforced, led to the intervention of the House of Commons. The first concerned inns, and in effect compelled every person who kept an inn to take out a license from certain private persons. (*y*) The second was of the same

(*w*) The first was granted to Baker jointly with two other persons. See these patents, 1 W. P. C. pp. 9 to 13.

(*x*) Three patents were granted for making glass; the first two being for the term of twenty-one years each. The third (to Sir Robert Mansel) was limited to a period of fifteen years. It was granted in 1624, and removed the restraint upon the importation of foreign glass. Further no rent or royalty was made payable under it to the Crown. In this way the enhancing of the price of glass was intended to be avoided. See 1 W. P. C. pp. 17 to 27.

(*y*) This grant was made (3rd March, 1617) apparently in the form of a Commission, Sir Giles Mompesson, Sir Giles Bridges, and James Thurburne being the grantees (Pat. Roll 14, Jac. I. c. 22). It authorized Sir Giles Mompesson, and at least one other Commissioner, to grant licenses for inns and charge fees for so doing, on the pretext that there were many unauthorized inns in the country. A second grant was made with reference

nature with respect to ale-houses. The third granted a monopoly of the making and selling of gold and silver thread. (*z*) Under this patent great quantities of counterfeit gold and silver thread were made from copper and other sophisticated materials, while persons who did an honest trade in the genuine articles were thrown into gaol, and fined severely as infringers of the patent. (*a*)

These monopolies led to a conference of the two Houses. Sir Giles Mompesson and Sir Francis Michell, who had been mainly instrumental in enforcing them, were, in the Session of 1601, impeached by the Commons, degraded from their knighthood, and otherwise severely punished by the Lords. (*b*) The king, finding how high the feeling ran, himself came down to the House and announced his intention to revoke the grants.

The Statute of Monopolies.—The continued misuse of the royal prerogative in the granting of these illegal patents resulted in 1624 in the passing of the Statute of Monopolies (21 Jac. I. c. 3) (*c*). This Act, "forcibly and vehemently penned for the suppression of all monopolies," did not introduce any new principle of law. Reciting in its preamble the King's Book of Bounty, the royal command therein contained that suitors should not presume to move the king for grants of monopolies, and the fact that, nevertheless, upon misinformations and untrue pretences of public good, many such grants had been unduly obtained and unlawfully put in execution, it enacted that all monopolies and all commissions, grants, licenses, charters, and letters patent

to the same matter sixteen days later, to Sir Giles Mompesson and his brother (19th March, 1617). See *Archæologia of Soc. of Antiquaries of London*, vol. xli. p. 235. The Commons reported to the Lords that proceedings had been taken against 4000 persons under this monopoly (see *Parl. Hist.*, vol. i. 1219).

(*z*) Sir Giles Mompesson was also charged as the principal offender under this patent. He was not, however, the patentee, but a Commissioner under a royal Commission issued to enforce the patent. The original patent was granted in 1611 to four patentees for a term of twenty years, on the assumption that they were introducing a new trade into England. It was surrendered, and a new patent granted in 1616 for twenty-one years. This patent granted to three patentees the sole making, working, beating, cutting, milning, and flatting of gold and silver thread. It also was surrendered, and a third patent granted to one Fowle, in 1618. Sir Giles Mompesson's name first appears in a Commission to enforce this last patent, dated 20th October, 1618. Two royal proclamations and two royal Commissions were issued in aid of these patents. See *Archæologia of Society of Antiquaries of London*, vol. xli. Paper by S. R. Gardiner on *Four Letters of Lord Bacon*, p. 217.

(*a*) See *Parl. Hist.*, vol. i. 122; also *Rapin*, vol. ii. bk. 18, pp. 203, 204.

(*b*) The estate of Mompesson (who had escaped abroad) was confiscated and the king added banishment to his punishment. Michell was fined £1000, ordered to be imprisoned for life, and carried on horseback with his face to the tail, through the public streets of London. Ibid.

(*c*) "This Act moved from the House of Commons." Coke, 3 *Inst.* 181.

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, are altogether contrary to the laws of this realm, and so are and shall be utterly void and of none effect, and in no wise to be put in use or execution. (*d*)

To this sweeping condemnation of all monopolies, the Statute, however, like the King's book, allowed of one exception.

"Provided also, and be it declared and enacted, that any declaration before mentioned shall not extend to any letters patent and grants of privilege for the term of fourteen years or under, 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 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: the said fourteen years to be accomplished from the date of the first letters patent 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." (*e*)

Thus, the limit of a reasonable time for which a patent monopoly might be granted was fixed so that it should not exceed fourteen years. Doubts, however, were entertained by some as to whether this period was not hurtful to the public on account of its excessive length, having regard to the circumstance that seven years was the legal term of apprenticeship. Hence the addition to the above section of its concluding words. Sir Ed. Coke, who took a principal part in pressing on the Bill, says with reference to this point—

"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 passed and for the time to come, they were left of such force as they were before the making of this Act." (*f*)

(*d*) 21 Jac. I. c. 3, s. 1.
(*e*) Ibid. s. 6.
(*f*) 3 *Inst.* 184. For an unsuccessful opposition by apprentices to the extension of a patent term, see *Baxter's Patent*, 13 Jur. 593.

Certain existing patents, including the glass and smalt patents above-noticed, were excepted from the operation of the Act, and left of such force as they would have been if the Act had not been made. (*g*) This appears to have been done upon the intervention of the Lords, the Commons consenting "not in love of these patents, but to the passage of the Bill." (*h*)

The Statute of Monopolies Affirmative of the Common Law.—Thus the Statute of Monopolies created no new patent right. It merely forbade the granting of those monopolies which the law had already declared to be *ultra vires* of the royal prerogative. All legal patent grants were left precisely where they stood before, except that in no future case could the term of a patent grant exceed fourteen years. "This Act," says Sir Ed. Coke, "maketh patents no better than they should have been if the Act had not been passed." (*i*)

The making of the grant still remained, as it does to-day, a matter of royal grace and favour. Neither this nor any subsequent Act requires the grant to be made in any given state of circumstances. It is still made *ex speciali gratia*, and remains what it has always been, an exercise of the prerogative. (*j*)

At one time it was supposed that a patent grant was in the nature of a bargain or contract between the inventor and the Crown, and many judicial dicta may be found supporting this view. In *Feather* v. *The Queen* (*k*), however, the Court of Queen's Bench, after full and elaborate argument at the bar, decisively rejected this contention. "It was contended," said Cockburn, C.J., "on the part of the patentee that the patent was based on a species of contract between the patentee and the Crown, in which the patentee, by communicating the secret of his invention to the public, gave a valuable consideration for the grant which he obtained; so that the grant being based on such a consideration, should receive the more liberal construction which it has been held that royal grants, when proceeding on a valuable consideration from the grantee, ought to receive. It appears to us that the assumption on which this presumption rests is altogether fallacious. The grant of the patent is, as has been explained, simply an exercise of the prerogative."

(*g*) 21 Jac. I. c. 3. See ss. 10, 11, 13, 14.

(*h*) *Journals of the House of Commons.* May 1, 1624. See note 1 W.P.C. 27.

(*i*) 3 *Inst.* 184.

(*j*) The prerogative right of the Crown to grant or withhold letters patent was expressly saved, so that it should not be in any way abridged, by the Patent Law Amendment Act, 1852; and a like provision has been inserted in the Patents Act, 1883. (See 15 & 16 Vict. c. 83, s. 16, and 46 & 47 Vict. c. 57, s. 113.)

(*k*) 35 L. J. Q. B., 205; 6 B. & S. 257.

No definition other than that in section 6 of the Statute of Monopolies has been attempted by the legislature of the subject-matter in respect of which that prerogative may lawfully be exercised; subsequent Acts merely referring to and incorporating this section. (*l*)

To sum up, then, the contents of this chapter; it may be said that the stream of English patent law still flows direct from the fountain of the royal prerogative; but along the defined course, and within the narrow channel which the ancient allowance of the common law determined centuries ago, and parliament subsequently ratified and affirmed by express enactment.

(*l*) 15 & 16 Vict. c. 83, s. 55; 46 & 47 Vict. c. 57, s. 46.

CHAPTER II.

THE GRANT: ITS TERMS AND EFFECT.

Form of the Grant.—As the grant to an inventor of the sole use of his invention is a mere exercise of the prerogative, the Crown is not restricted, in conferring the monopoly, to any special form of grant. By ancient custom, however, such grants are invariably made by open letters and not by charter. (*a*) A form of letters patent for an invention is provided by the Patents Act, 1883, but the use of that form is optional as the Statute only enacts, "Every patent may be in the form in the first schedule to this Act." (*b*) In practice, however, all patents for inventions now granted substantially follow the scheduled form; such variations as are used being introduced merely for the purpose of adapting that form to the differing circumstances of particular applicants. (*c*) It will be sufficient, therefore, in discussing the terms of the grant to examine the statutory form.

Address and Recitals.—Shorter and more concise than the ancient grants, the form now in use is nevertheless in all its essential features of great antiquity. It begins in the name of the Sovereign and is addressed at large.

"*Victoria by the grace of God, of the United Kingdom of Great Britain and Ireland Queen, Defender of the Faith: to all to whom these presents shall come greeting.*"

Being an open grant, the contents of the patent are presumed in law to have come to the notice of, and be binding upon, all subjects of the Crown. (*d*)

(*a*) See ante, p. 3.

(*b*) Patents Act, 1883, s. 33, first sched. form D.

(*c*) The Board of Trade may vary the scheduled form (Patents Act, 1883, s. 101). Special forms are now in use intended to meet applications by the following: a single inventor; a joint inventor; an importer; joint applicants; legal representatives of a deceased applicant; legal representatives of a deceased inventor; a female inventor; and joint applicants where one of the original applicants is dead.

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

Next follow the recitals, the first setting forth the name of the grantee, the nature of his invention, and his representation to the Crown that the invention is lawful subject-matter for a patent grant—

Whereas, John Smith, of 29, *Perry Street, Birmingham, in the County of Warwick, Engineer, hath* (*e*) *represented unto us that he is in possession of an invention for "Improvements in Sewing Machines," and that he is the true and first inventor thereof and that the same is not in use by any other person to the best of his knowledge and belief.*

This recital alleges the applicant to have made certain representations to the Crown to induce the grant. These representations rebut the common law objections to the grant of a monopoly, for they allege the invention to be new and not already in use; thus suggesting to the Crown that the grant will not deprive any other subject of any right he already possesses. This recital also suggests that the grant is justified in the public interest as an encouragement to a deserving person, viz. a true and first inventor. By thus rebutting the common law objections to a monopoly (*f*) the applicant brings himself within the saving powers of Section 6 of the Statute of Monopolies. (*g*) This recital further states that the patentee is in possession of "an invention." Formerly there was nothing to prevent the Crown including more than one invention in the same grant. Now, however, it is enacted that "Every patent shall be granted for one invention only." (*h*)

And whereas the said inventor hath humbly prayed that we would be graciously pleased to grant unto him (*hereinafter, together with his executors, administrators, and assigns, or any of them, referred to as the said patentee*) *our Royal Letters Patent for the sole use and advantage of his said invention.*

Here, again, the grant is represented to have been made at the solicitation of the patentee. It includes not only the grantee himself, but also his executors, administrators, and assigns; so that the legal rights which the patent confers are not merely personal to the inventor, but may be transferred to others by assignment, (*i*) and pass, on his decease, to his legal representatives.

(*e*) The words "by his solemn declaration" are omitted here, as the declaration is not now made under the Statutory Declarations Act, 1835. See *post*, Patents Act, 1885, s. 2; also Patent Rules, 1890, rule 6.

(*f*) See ante, pp. 4, 8.

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

(*h*) Patents Act, 1883, s. 33. It is not, however, competent for any person in an action or other proceeding to take any objection to a patent on the ground that it comprises more than one invention. Ibid.

(*i*) Unless the terms of the grant included assigns, the patent would not be assignable (*Duvergier* v. *Fellows*, 10 B. & C. p. 829). Now by s. 46 of the Patents Act, 1883, the word patentee in that Act

What the patentee solicits from the Crown is a monopoly: the sole use and advantage of his invention. Apart from the grant he could not have this privilege, for the law does not recognize any property in an invention such as the copyright in a book or a work of art.

And whereas the said inventor hath by, and in his complete specification, particularly described the nature of his invention.

The subject of the specifications will be dealt with hereafter; meanwhile it may be pointed out that, by an ancient rule of law, no royal grant can be supported which is not certain. The subjects of the king must know what the king grants, otherwise the letters patent are void. (*j*) This recital, by alleging that the subject-matter of the grant has been defined, suggests that this rule of law has been satisfied.

The filing of a complete specification is now a statutory requirement, and no patent is sealed until this has been done (*k*). Besides ascertaining and defining the subject-matter of the monopoly, this specification likewise gives to the public the knowledge of how the invention may be put in practice by them at the conclusion of the patent term. If the patentee were not compelled to give this information, the object of all patent law—the advancement of trade—would clearly be frustrated.

No mention of specifications is to be found in the Statute of Monopolies. At the passing of that Act, it was assumed that a new invention would, in effect, be a new trade, and put in use with the aid of apprentices who, as instructed persons, would be able to work the invention at the termination of the monopoly, and thus create a new industry. (*l*)

In the form of letters patent, authorized by the Patent Law Amendment Act, 1852, the recital as to the specification alleged that the patentee had therein also described the manner of performing the invention. (*m*) It is not apparent why this should have been omitted from the present form, seeing that the complete specification is still required to fulfil this function. (*n*)

And whereas we, being willing to encourage all inventions which

"means the person for the time being entitled to the benefit of a patent."

(*j*) *Lightfoot* v. *Lenet*, 3 Croke, 421; Comyn's *Digest*, Title Grant G. 6; Viner, Title, Prerogative F. C.; *Boulton* v. *Bull*, 2 H. Bl. 484; *Eastern Archipelago* v. *The Queen*, 2 E. & B. 892; 23 L. J. Q. B. 82.

(*k*) Patents Act, 1883, s. 5 (4).

(*l*) A condition that the patentee should employ apprentices was sometimes inserted in the grant.

(*m*) 15 & 16 Vict. c. 83, schd.

(*n*) Patents Act, 1883 (46 & 47 Vict. c. 57), s. 5 (4).

may be for the public good, are graciously pleased to condescend to his request.

This is a recital that in granting the monopoly the Crown is using its prerogative for the public benefit, and thus conforming to an established rule of law: For "the prerogative, as a general principle, affords the Sovereign the liberty of restraint only when the public good is the object in view." (*o*)

It is also a declaration of the intention of the Crown in making the grant. This is important, as the grant is void if it contradicts the intention. (*p*) Therefore if the invention be not new, or the patentee not the first or true inventor of it, the monopoly is not for the public good, and the letters patent cannot be supported.

The foregoing observations apply to the respective recitals. In addition, it may be noticed generally, that recitals in grants by the Crown are no estoppel upon the grantor. For, contrary to the rule applicable to private grants, such recitals are construed as mere suggestions emanating from the grantee, and binding only upon him. Hence, if any one of the recitals is false the grant is void, on the assumption that the Crown has been deceived by the false suggestion. (*q*) Moreover if the recited consideration is bad in part, (*e.g.* if any part of the invention claimed is not new), the grant is void, for the consideration is one and entire, and if it fails in part it fails in all. (*r*)

This rule has a far-reaching effect, for a royal grant possesses the distinguishing characteristic that it can be declared void, not merely in proceedings for its revocation between the Crown and the grantee, but also in any suit brought upon it by the grantee against a third party. (*s*) Letters patent can thus, notwithstanding the above recitals, be found invalid in an action of infringement, where the recited invention is proved not to be lawful subject-matter.

The Operative Part of the Grant.—*Know ye, therefore, that we, of our especial grace, certain knowledge, and mere motion, do by these presents for us, our heirs and successors*

These words, which are common form of ancient standing in grants by letters patent, are manifestly inconsistent with the

(*o*) Chitty, *Prerogative of the Crown*. Preface.

(*p*) Coke, 1 Rep. 46 a.

(*q*) *Alton Wood's Case*, Coke, 1 Rep. 40 b; Comyn's *Digest*, Title Grant G. 8, 9. See, also, *Lord Chancellor's Case*, Hob. 214.

(*r*) *Morgan* v. *Seaward*, 2 M. & W. 544; 1 W. P. C. 187; 6 L. J. Ex. 153; *Brunton* v. *Hawkes*, 4 B. & Ald. pp. 552, 558. As to curing an invalid patent by disclaimer, see post, p. 257, chap. xiii.

(*s*) *Travell* v. *Carteret*, 3 Lev. 134; *Alcock* v. *Cooke*, 5 Bing. 340.

recitals already considered, and, it would seem, have now little meaning. Strictly construed, they import that the grant is a voluntary exercise of the prerogative made on the certain knowledge of the Crown, and without the solicitation of the grantee. The words "especial grace" shew that the grant is not a matter of right, but an act of bounty on the part of the Crown. (*t*) They negative the suggestion which has sometimes been made, that the patent is in the nature of a contract between the patentee and the public, (*u*) and indicate that the grant is in law a mere exercise of the prerogative. The words "certain knowledge" imply that the Sovereign has knowledge of the invention granted, and relies, in making the grant, upon that knowledge and not upon the suggestions of the patentee. (*v*) If these words, therefore, were strictly construed they would effectually cure any falsity in the recitals and prevent a patent being upset on that ground. They do not, however, have this effect, for the common law early placed the curious construction upon them that the king's knowledge is to be intended only of verity, which is the proper object of science, and not of falsity, which is a *non-ens* whereof the king cannot have knowledge. (*w*) Hence, notwithstanding these words, where the king was deceived in his grant it was held that the patentee could get no advantage by them.

The words "mere motion" are likewise now of little more than antiquarian interest. Strictly construed, they imply that the letters patent are granted at the instance of the Crown without any suit or request of the grantee. (*x*) They therefore directly contradict the recitals already discussed and are utterly at variance with the actual practice now in force: the grant always being made in pursuance of an application left at the Patent Office by the patentee. They are words of ancient use, however, in letters patent, and are said by Sir Edward Coke to have been introduced into royal grants to prevent such grants being avoided by the operation of the statute 4 Henry IV. c. 4, in which the king declared that he would abstain from granting any part of his revenues, lands, or wardships, unless to those who had deserved,

(*t*) See Viner, *Abridgement*, Title Prerogative, E. C. 3 (*c*), Coke, 10 Rep. 113 a.

(*u*) See *Brunton* v. *Hawkes*, 4 B. & Ald. 551; *Walton* v. *Potter*, 1 W. P. C. 595; *Gibson* v. *Brand*, 1 W. P. C. 629; *Feather* v. *The Queen*, 6 B. & S. 285.

(*v*) See Coke, 10 Rep. 112 b; Viner, *Abridgement*, Title Prerogative; Bacon, *Abridgement*, 7th edit. vol. vi. p. 515. The introduction of these words in royal grants was due to the statute, 1 H. IV. c. 6.

(*w*) Coke, 10 Rep. 112 b.

(*x*) Viner's *Abridgement*, Title Prerogative, E. C. 3 (1); Coke, 10 Rep. 113 a.

and that those who sued for any such thing should be punished, and not have the thing for which the suit was made. (*y*) It has also been said that the words "certain knowledge and mere motion" entitle the patentee, contrary to the rule in royal grants, to have the grant construed beneficially to himself; it seems doubtful, however, whether any actual benefit really accrues to the patentee from them. The words "our heirs and successors" are obviously intended to save the patent privilege being avoided by a demise of the Crown. But as such demise does not in law determine the grant, they are mere surplusage. (*z*)

Give and grant unto the said patentee our especial license, full power, sole privilege, and authority, that the said patentee by himself, his agents or licensees and no others, may at all times hereafter during the term of years herein mentioned, make, use, exercise, and vend the said invention within our United Kingdom of Great Britain and Ireland and Isle of Man, in such manner as to him or them may seem meet, and that the said patentee shall have and enjoy the whole profit and advantage from time to time accruing by reason of the said invention during the term of fourteen years from the date hereunder written of these presents.

It is difficult to say what is the precise effect of the above words in letters patent; they have on first consideration the appearance of a granting clause, but they are not now followed by any habendum clause, as in the case of some of the older grants and the form used under the Patent Law Amendment Act, 1852. They would seem rather to be in the nature of a statement of that intention of the Crown in making the grant to which effect is given by the prohibitory clause which follows. The words "especial license, full power, sole privilege, and authority" are words of ancient use, and, like others already considered, have now an antiquarian rather than a practical interest. (*a*) They were introduced into letters patent at a time when trade was closely regulated and controlled by privileged companies and guilds, and were perhaps intended to prevent the patentee's use of his invention being held to be an interference with the privileges of some existing trade society or company. (*b*).

(*y*) Coke, 10 Rep. 113 a.

(*z*) Comyn's *Digest*. See Title Grant G. 3.

(*a*) In *Gilbert's Patent* (1618), Rymer. vol. xvii. p. 102, the corresponding words are "full and sole license, power, privilege, and authority;" while in some of the old grants this clause is rendered "full and free liberty, license, power, and authority:" see *Dudley's Patent*, 1 W. P. C. 14; *Mansell's Patent*, 1 W. P. C. 21.

(*b*) See Gordon's *Monopolies by Patents*, pp. 121, 122.

The words "make, use, exercise, and vend the said invention" differ somewhat from the corresponding words in the ensuing prohibitory clause. It may also be noticed that the word "vend" does not occur at all in the Statute of Monopolies, where the monopoly saved by Section 6 is the "sole working or making of any manner of new manufactures." (*c*)

It does not appear, however, that any real importance attaches to these variations; the intention of the grant, as subsequently expressed, being to give the patentee the whole profit and advantage of the invention, which he manifestly would not have unless the exclusive right of original sale were included. At the same time, once the patentee or his agent has sold the patented article the law implies a license to the purchaser, or any other person in whom the ownership of the article may subsequently become vested, to re-sell without interference by the patentee. (*d*)

The words "make, use, exercise and vend," are another instance of archaic language in the grant, and would seem to have reference to ancient trade distinctions, now of no practical importance.

The construction which the Courts have put upon the word "making" in the Statute, in fact renders the word "vend" in the letters patent redundant and unnecessary. "If a man buys and sells," said Jervis, C.J., in *Holmes* v. *London and North Western Railway Company*, (*e*) "he may be said to be making by the hands of another." And, notwithstanding the circumstance that the Statute only saves from illegality monopolies of "working" and "making," it has long been established that an unlicensed sale of a patented article is an infringement of the patent right. (*f*)

The area of the patent's operation is the United Kingdom and the Isle of Man. In the form of grant scheduled to the Patent Act, 1852, the Channel Islands were also included; (*g*) but they are now excluded by Section 16 of the Patents Act, 1883, which limits the effect of the letters patent to the above area. The position of the Channel Islands is peculiar, for the Act of 1852, which

(*c*) The words "sole buying and selling" are found in s. 1 of 21 Jac. I. c. 3, where any patent for sole buying and selling is declared to be void.

(*d*) *Thomas* v. *Hunt*, 17 C. B. (N. S.), 183; *Smith* v. *Buchanan*, 26 Sol. J. 347; *Heap* v. *Hartley*, 5 R. P. C. 503; 6 R. P. C. 496; but see post, p. 342.

(*e*) Macr. P. C. p. 23.

(*f*) *Minter* v. *Wells*, 4 A. & E. 251; *Gibson* v. *Brand*, 1 W. P. C. 630; *Walton* v. *Lavator*, 29 L. J. C. P. 279; *Oxley* v. *Holden*, 8 C. B. (N. S.), 666; 30 L. J. C. P. 68; *Elmslie* v. *Boursier*, 9 L. R. Eq. 217; 39 L. J. Ch. 328; *Von Heyden* v. *Neustadt*, 14 C. D. 230; *United Tel.* v. *Sharples*, 29 C. D. 164; *United Tel.* v. *Henry*, 2 R. P. C. 12.

(*g*) 15 & 16 Vict. c. 83, s. 18.

included them, is repealed, and the later Patent Acts do not apply to those islands. (*h*)

The term of the grant is fourteen years. This is in accordance with the Statute of Monopolies, by which royal grants of this description were limited to that number of years. (*i*) The theory of the common law, as already indicated, (*j*) was that the monopoly was only lawful when granted for a reasonable time; by the Statute, parliament fixed a reasonable time at fourteen years. A patentee may, however, in certain cases, obtain a prolongation of his monopoly, in the form of a further grant, if the Judicial Committee of the Privy Council so advise. The circumstances under which such a prolongation may be obtained will be considered hereafter; it is sufficient here to state that such a prolongation of the patent privilege is never granted unless it can be shewn that the object of all patent law, viz.—the encouragement of the inventor by the provision of a suitable reward for his ingenuity—has been defeated by circumstances beyond the patentee's control.

The term of the patent includes the day of its date. (*k*) The grant is dated as of the day of the application; (*l*) unless the grant is made under the international and colonial arrangements authorized by Section 103 of the Patents Act, 1883, when the patent is dated as of the day of application for the foreign patent. (*m*)

The Prohibitory Clause.—*And to the end that the said patentee may have and enjoy the sole use and exercise and the full benefit of the said invention, we do, by these presents, for us, our heirs, and successors, strictly command all our subjects whatsoever, within our United Kingdom of Great Britain and Ireland and the Isle of Man, that they do not at any time during the continuance of the said term of fourteen years, either directly or indirectly, make use of, or put in practice the said invention, or any part of the same, nor make, nor cause to be made, any addition thereto, or subtraction therefrom, whereby to pretend themselves the inventors thereof, without the consent, license, or agreement of the said patentee in writing, under his hand and seal, on pain of incurring such penalties as may be justly inflicted on such offenders for their contempt of this our royal command, and of being answerable to the patentee, according to law, for his damages thereby occasioned.*

The above prohibitory clause is addressed to all subjects of the

(*h*) See Patents Act, 1883, ss. 112 and 117.

(*i*) 21 Jac. I. c. 3, s. 6. See, also, s. 17 (1) of the Patents Act, 1883.

(*j*) See ante, pp. 7, 8.

(*k*) *Russell* v. *Ledsam*, 14 L. J. Ex. 353; 14 M. & W. 574, 583.

(*l*) Patents Act, 1883, s. 13.

(*m*) See post, Patents Act, 1883, s. 103 as amended by Patents Act, 1885, s. 6.

Crown within the United Kingdom and the Isle of Man. This does not, however, mean that an infringement committed by an alien within the territorial limits of the letters patent is not a violation of the patent right. (*n*) The words of prohibition are very wide and cover all colourable imitations of the patented article or process. They cover also not only the whole invention, but any part thereof. That is, any part claimed by the patentee in his complete specification, for only what the patentee claims is protected. The terms of the prohibition do not apply, however, to persons acting under the license of the patentee. It would at first sight seem that such license is only effectual if given under seal. It has, however, been decided that a parol license is sufficient, and in certain cases the law will imply a license from the conduct of the parties. Where, however, it is intended to register the license, a license under seal is required.

The reference to the penalties, inflicted on offenders for contempt of the royal command, has now only an antiquarian interest. At one time, however, these penalties, stringently enforced by the Court of Star Chamber, were the most formidable weapon of the monopolist. The patentee's present remedy against an infringer of the patent right is an action of infringement, in which he can claim damages or an account of profits and an injunction. (*o*)

The Provisoes.—*Provided that these our letters patent are on this condition that, if at any time during the said term it be made to appear to us, our heirs, or successors, or any six or more of our Privy Council, that this our grant is contrary to law, or prejudicial or inconvenient to our subjects in general, or that the said invention is not a new invention as to the public use and exercise thereof within our United Kingdom of Great Britain and Ireland, and Isle of Man, or that the said patentee is not the first and true inventor thereof within this realm as aforesaid, these our letters patent shall forthwith determine, and be void to all intents and purposes, notwithstanding anything hereinbefore contained.*

These words appear to provide a simple mode of revoking letters patent which are found not to fulfil the necessary

(*n*) *Caldwell* v. *Vanvlissengen*, 9 Hare, 426; 21 L. J. Ch. 97.

(*o*) The Statute of Monopolies, with the object of defeating the jurisdiction of the Star Chamber (which, as a committee of the King's Privy Council, was disposed to uphold all royal grants irrespective of their legality), enacted that all monopolies, and all such commissions, grants, licenses, charters, letters patent, proclamations, inhibitions, etc., should be examined, heard, tried, and determined by and according to the common laws of this realm and not otherwise. See 21 Jac. I. c. 3, s. 2.

conditions of a valid grant. The proviso is of great antiquity: a substantially identical clause being found in patent grants prior to the Statute of Monopolies. (*p*) In modern times, however, no recourse has been had to this mode of getting rid of an invalid patent. Nor is it likely that this remedy will again be resorted to, revocation by petition providing a sufficient means of avoiding a bad patent. Moreover, it is doubtful whether the proviso is now good in law, having regard to the terms of Section 2 of the Statute of Monopolies, which enacts that the validity of such grants shall be left to be determined according to the common law; for this would seem to exclude the interference of the Privy Council. These considerations suggest that the continued inclusion of this proviso in letters patent arises merely from a slavish following of the ancient forms, and that these words, like others in the grant, have now merely an historical interest.

Provided also, that if the said patentee shall not pay all fees by law required to be paid in respect of the grant of these letters patent, or in respect of any matter relating thereto at the time or times, and in the manner for the time being by law provided; and also if the said patentee shall not supply or cause to be supplied, for our service all such articles of the said invention as may be required by the officers or commissioners administering any department of our service in such manner, at such times, and at and upon such reasonable prices and terms as shall be settled in manner for the time being by law provided, then, and in any of the said cases, these our letters patent, and all privileges and advantages whatever hereby granted shall determine and become void, notwithstanding anything hereinbefore contained.

Ancient grants by letters patent usually reserved a rent to the Crown. In the form of letters patent scheduled to the Patent Law Amendment Act, 1852, this rent took the form of stamp duty. Under the Patents Act, 1883, the payments of the patentee to the Crown are by way of fees, payable at stated intervals during the term of the patent. (*q*) The proviso for avoiding the patent privilege if the grantee makes default in these payments is now unnecessary, as Section 17 of the Patents Act, 1883, expressly enacts that "every patent shall, notwithstanding anything therein or in this Act, cease, if the patentee fails to make the prescribed payments within the prescribed times." Provision, however,

(*p*) See the Smalt Patent of July 17, 1606, 1 W. P. C. 10; also the patent to Lord Dudley of February 24, 1622, 1 W. P. C. 16.

(*q*) As to these payments, see post, Patent Rules, 1892 (second set).

exists for enlarging the time in cases of "accident, mistake, or inadvertence." (*r*)

The condition that the patentee shall provide the patented article for the public service if required has long been inserted in letters patent. The grant being a matter of grace and bounty, and not of right, the Crown has full power to impose such a condition; (*s*) but the provision that the price of such articles shall be settled "in manner for the time being by law provided" is new. The present provision as to this is contained in Section 27 of the Patents Act, 1883, which enacts as follows:—

(1) "A patent shall have to all intents the like effect as against her Majesty the Queen, her heirs and successors, as it has against a subject. (*t*) (2) But the officers or authorities administering any department of the Crown may, by themselves, their agents, contractors, or others, at any time after the application, use the invention for the services of the Crown on terms to be before or after the use thereof agreed on with the approval of the Treasury, between those officers or authorities and the patentee, or in default of such agreement, on such terms as may be settled by the Treasury after hearing all parties interested."

In view of this express enactment it would seem that the proviso that the patentee shall, if required, supply the patented article for the public service is now of little importance; for as the public authorities may, by virtue of the Statute, themselves use the invention even before the patent is sealed, the occasion contemplated by the condition is hardly likely to arise. It may be noted, however, that if it does, and the patentee fails to observe the obligation created by this condition, the patent is void by the terms of the grant, although such a penalty does not attach by Statute.

Provided also that nothing herein contained shall prevent the granting of licenses in such manner and for such considerations as they may by law be granted: and lastly, we do by these presents for us, our heirs and successors, grant unto the said patentee that these our letters patent shall be construed in the most beneficial sense for the advantage of the said patentee. In witness thereof we have caused these our letters to be made patent this one thousand eight hundred and and to be sealed as of the one thousand eight hundred and .

The granting of licenses by patentees will be considered

(*r*) Patents Act, 1883, s. 17 (3) (4).

(*s*) See Hindmarch, *Patent Law*, p. 431.

(*t*) Formerly the rule was otherwise; the Crown not being bound unless expressly named in the terms of the grant. As to this, see *Feather* v. *The Queen*, 35 L. J. Q. B. 200; 6 B. & S. 257.

hereafter. The above proviso saves the right of the patentee to grant licenses from being affected in any way by the special terms of the letters patent. (*u*)

The proviso that the grant shall be construed most beneficially to the patentee is inserted to except the letters patent from the ancient general rule of law that grants by the Crown shall be construed most strongly against the grantee.

The clause has now little importance. Questions of construction in regard to letters patent arise generally upon the terms of the specification, and notwithstanding dicta in many cases that that document ought to be construed benevolently, it is now settled law that specifications, like other written instruments, are to be construed according to the fair meaning of their terms without intending anything for or against the patent. (*v*)

The Authentication of the Grant.—The grant is made "patent," *i.e.* open, in order that all may be cognizant of its contents. It must be under seal. At common law all grants of privileges or franchises by the Crown require authentication by the great seal. (*w*) In the case of letters patent for inventions, however, the grant is now sealed with the seal of the Patent Office; all business arising from the exercise of the prerogative in the granting of letters patent for inventions being now transacted in that office. By statutory provision a patent so sealed has the same effect as if sealed with the great seal of the United Kingdom. (*x*)

If a patent is lost or destroyed or its non-production is accounted for to the satisfaction of the Comptroller-General of Patents, the Comptroller may at any time cause a duplicate thereof to be sealed. (*y*)

(*u*) See ante, pp. 20, 22.
(*v*) See post, p. 242, chap. xii.
(*w*) Comyn's *Digest*, Title Patent; A. & C. 2.
(*x*) Patents Act, 1883, s. 12.
(*y*) Ibid. s. 37.

CHAPTER III.

THE GRANTEE: TO WHAT PERSONS LETTERS PATENT FOR INVENTIONS MAY BE GRANTED.

The True and First Inventor.—The prerogative of the Crown to grant monopolies by letters patent and the form of such grants have already been considered. The limitations imposed by the law on that prerogative as to the persons in whose favour it may be exercised will form the subject of the present chapter.

By the operation of the Statute of Monopolies (*a*) this prerogative is now preserved only in the case of such persons as fall within Section 6 of that Act. That section, so far as at present material, is as follows:—

"Provided also, and be it declared and enacted, that any declaration before mentioned shall not extend to any letters patent and grants of privilege for the term of fourteen years or under, hereafter to be made of the sole working or making of any manner of new manufactures within this realm, to the true and first inventor or inventors of such manufactures which others at the time of making such letters patent and grants shall not use."

Every patent must therefore be granted to the true and first inventor of a manufacture not already in use. Where, however, several applicants apply jointly for a grant of letters patent, it is now sufficient if one of such applicants is the true and first inventor. (*b*) So that an inventor who lacks the capital required to push his invention may now associate with himself as co-patentees persons in a more fortunate financial position.

The words true and first inventor have not been the subject of further statutory definition, but a long series of judicial decisions has placed upon them an interpretation now as binding upon the Courts as the Statute of James I. The general effect of these decisions was thus summarised by Sir George Jessel, M.R., in *Plimpton*

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

(*b*) Patents Act, 1885, s. 5.

v. *Malcolmson* (*c*): "As I understand, shortly after the passing of the Statute the question arose whether a man could be called a first and true inventor who, in the popular sense, had never invented anything, but who, having learned abroad that somebody else had invented something, quietly copied the invention and brought it to this country and then took out a patent. As I said before, in the popular sense he had invented nothing. But it was decided, and now, therefore, is the legal sense and meaning of the Statute, that he was a first and true inventor within the Statute, if the invention being in other respects novel and useful, was not previously known in this country—'known' being used in that particular sense as being part of what had been called the common or public knowledge of the country. That was the first thing. Then there was a second thing. Suppose there were two people, actual inventors, in this country, who invented the same thing simultaneously, could either be said to be the first and true inventor? It was decided that the man who first took out the patent was the first and true inventor. Then there was another point. If the man who took out the patent was not, in popular language, the first and true inventor, because somebody had invented it before, but had not taken out a patent for it, would he still, in law, be the first and true inventor? It was decided he would, provided the invention of the first inventor had been kept secret, had not been made known in such a way as to become a part of the common knowledge, or the public stock of information. Therefore in that case also there was a person who was legally the first and true inventor, although, in common language, he was not, because one or more people had invented it before him, but had not sufficiently disclosed it."

A true inventor (except in the case of an importer, to be considered hereafter) means a person who has in fact created a new invention by the exercise of inventive ingenuity: one who has himself found out by his own skill and application the discovery of which he seeks a monopoly. If, therefore, the person alleging himself to be an inventor has not found out the invention himself; if he has taken it from a book or from a prior patent, or borrowed it from another person, or learned it in a fiduciary capacity, he cannot in law be the recipient of a valid grant. (*d*)

(*c*) L. R. 3 C. D. 555; 45 L. J. Ch. 507.

(*d*) *R.* v. *Wheeler*, 2 B. & Ald. 349; *Minter* v. *Wells*, 1 W. P. C. 129; *Patterson* v. *Gas Light & Coke Co.* L. R. 2 C. D. 893; 3 App. Ca. 239; 45 L. J. Ch. 843; 47 L. J. Ch. 402.

Commenting on this in *Gibson* v. *Brand*, Tindal, C.J., said, "Now a man may publish to the world that which is perfectly new in all its use, and has not been enjoyed, and yet he may not be the first and true inventor; he may have borrowed it from some other person, he may have taken it from a book, he may have learnt it from a specification, and then the legislature never intended that a person who had taken all his knowledge from the act of another, from the labours and assiduity or ingenuity of another, should be the man who was to receive the benefit of another's skill." (*e*) In *Tennant's* case a patent for a bleaching preparation was held invalid when it appeared that a principal portion of the invention was due, not to the ingenuity of the patentee, but to the suggestion of a chemist who had assisted him. (*f*) So likewise where a workman in the employment of a master has made the discovery of an invention, the workman is the inventor, and not the master; (*g*) even though it be made in the employer's time, and with the use of his materials. (*h*)

How far an Inventor may be assisted by others.—This does not, however, preclude an inventor from obtaining help from others in perfecting and working out the details of his invention, and if a servant or professional assistant, working in such employment, makes a discovery subsidiary to the main invention, but of value in giving it practical shape and perfecting its use, such subsidiary discovery belongs to the master, and is considered in law to be his invention.

It may often be a question of some nicety, whether in such case the invention of the servant is, or is not, really subsidiary to, and therefore absorbed by, that of the master. As to this, Erle, J., directing the jury in *Allen* v. *Rawson*, said, "I take the law to be, that if a person has discovered an improved principle, and employs engineers or agents or other persons, to assist him in carrying out the principle, and they, in the course of the 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

(*e*) 1 W. P. C. 627; 11 L. J. C. P. 177. See, also, *Walton* v. *Potter*, 1 W. P. C. 592; *Cornish* v. *Keene*, 1 W. P. C. 507–509; *Muntz* v. *Foster*, 2 W. P. C. 102; *Household* v. *Neilson*, 9 Cl. & F. 788.

(*f*) D. P. C. 429; 1 W. P. C. 125 n.

(*g*) *Barker* v. *Shaw*, Holroyd 60; *Bloxam* v. *Elsee*, 1 C. & P. 558; 1 W. P. C. 132 n.; *Barber* v. *Walduck* cited, 1 C. & P. 567.

(*h*) *Heald's Patent*, 8 R. P. C. 430; *Saxby* v. *Gloucester Waggon Co.*, Griff. A. P. C. 56.

embodied in his patent; and, if so embodied, the patent is not avoided by evidence that the agent or servant made the suggestions of that subordinate improvement of the primary and improved principle." (*j*)

In this case the patent was for improvements in the manufacture of felted fabrics. The invention related to the formation of the layer, or bat of wool, a preparatory step to the operation of felting. The patentee's method consisted of the employment of a roller mechanism, and in connection therewith he claimed, *i.a.* the use of a compound apron and longitudinal guides; both of these improvements had been suggested by workmen. On behalf of the defendant it was objected that the patent was bad because it included these claims.

The jury having found a verdict for the plaintiff, the Court of Common Pleas refused a new trial. Tindal, C.J., said, "The real question is, whether or not the improvements suggested by *Shaw* and *Milner* were of such a serious and important character as to preclude their adoption by *Williams* as part of his invention. It would be difficult to define how far the suggestions of a workman employed in the construction of a machine, are to be considered as distinct inventions by him, so as to avoid a patent incorporating them, taken out by his employer. Each case must depend upon its own merits But when we see that the principle and object of the invention are complete without it, I think it is too much that a suggestion of a workman employed in the course of the experiments, of something calculated more easily to carry into effect the conceptions of the inventor, should render the whole patent void." (*k*)

To put the test in another form, where the leading idea of the invention is the master's, and the workman's variations or additions are steps subsidiary and ancillary to that idea, there the master is in law permitted to include in his monopoly all such variations and additions as if he were in fact the true and first inventor of them.

In *Minter* v. *Wells*, where a similar question arose, Alderson, B., said, "If *Sutton* (the workman) 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

(*j*) 1 C. B. 551, at p. 567. See, also, Byles, J., in *Hatton* v. *Keane*, 7 C. B. (N. S.), 275.

(*k*) 1 C. B. p. 574.

Mr. Minter uses for the purpose of enabling him to carry his original conception into effect." (*l*)

"If a workman is employed by an inventor," said Davey, S.G., in *David* and *Woodley's* application "to make a model for the purpose of carrying out his invention, and the workman suggests improvements in detail of the machine which are adopted in the machine or model as completed, those suggestions are the property of his employer, and the workman cannot afterwards take out a patent for them." (*m*)

It may sometimes happen that the assistance which an employer receives from his servant assumes such importance that it is difficult to say, as between them, who in fact is the true inventor of the perfected invention. In such case the Patent Office authorities would now, if either opposed a grant to the other, refuse the letters patent, except in the form of a joint grant to them both. (*n*)

Inventor means, Inventor of all that is claimed.—The distinction between a subsidiary and an independent invention is of vital importance, because not only must the grantee be a true inventor, he must, further, be the inventor of everything which in his application to the Crown he represents himself to have discovered, (*o*) otherwise the grant will be void for false suggestion. (*p*)

This was clearly laid down in *Brunton* v. *Hawkes*. There Abbot, C.J., said: "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 patent is granted upon the recital that he has made improvements in all three, and that they are all 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 the other part of his invention." (*q*) In the same case, Best, J.,

(*l*) 1 Cr. M. & R. 505; 1 W. P. C. 133; 4 A. & E. 251.

(*m*) Griff. A. P. C. 26; *Homan's Patent*, 6 R. P. C. 104; *Kurtz* v. *Spence*, 5 R. P. C. 181.

(*n*) *Russell's Patents*, 2 De G. & J. 130; *Healey's Application*, Johnson, 165.

(*o*) See *Tennant's Case*, 1 W. P. C. 125 note; *Hill* v. *Thompson*, 1 W. P. C. 239.

(*p*) See ante, p. 17.

(*q*) 4 B. & Ald. 551.

said, "A patent taken out too large is not only void for the excess, but void altogether."

So also in *Losh* v. *Hague*: "If a man," said Lord Abinger, C.B., "claims by his patent a number of things, as being the inventor of them whether they consist of improvements or original inventions, and it turns out that some of them are not original and not improvements, his patent is void" (*r*).

"Upon the authorities," said Parke, B., in *Morgan* v. *Seaward* (*s*), "we feel bound to hold that the patent is void upon the ground of fraud on the Crown, without entering into the question whether the utility of each and every part of the invention is essential to a patent where such utility is not suggested in the patent itself as the ground of the grant. That a false suggestion of the grantee avoids an ordinary grant of lands or tenements from the Crown is a maxim of the common law, and such a grant is void, not against the Crown merely, but in suit against a third party. It is on the same principle that a patent for two or more inventions where one is not new is void altogether, as was held in *Hill* v. *Thompson* (*t*) and *Brunton* v. *Hawkes* (*u*), 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 of 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 is maintainable upon it." (*v*)

A First Importer is an Inventor.—The first importer of a new manufacture from abroad is a true and first inventor within the meaning of the Statute.

This construction, which was first placed upon the Statute in the case of *Edgebury* v. *Stephens*, (*w*) was a mere reading into the words of the Act of the early practice at common law, (*x*) under which it had been held that any man who, by his own charge and industry, for the good of the realm, brought any new trade into the realm, or any engine tending to the furtherance of a trade that never was used before, might properly receive from the

(*r*) 1 W. P. C. 203, 204.

(*s*) 2 M. & W. 561; 1 W. P. C. 196.

(*t*) 2 B. Moo. 424; 8 Taunt. 375; 1 W. P. C. 237.

(*u*) 4 B. & Ald. 542. See, also, *Templeton* v. *Macfarlane*, 10 Court of Session Ca. 796; 1 H. of L. 595.

(*v*) Cf. *Roberts* v. *Heywood*, 27 W. R. 454; *Britain* v. *Hirsch*, 5 R. P. C. 74.

(*w*) 2 Salk. 447; 1 W. P. C. 35.

(*x*) See Tindal, C. J., in *Beard* v. *Egerton*, 3 C. B. 128.

king by patent the grant of a monopoly thereof, for some reasonable time, until the subjects might learn the same. (*y*)

"A grant to an importer is good," says Sir Edward Coke, "because such a person 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." (*z*)

In the report of *Edgebury* v. *Stephens* it is stated to have been agreed by *Holt* and *Pollexfen* 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 they 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." (*a*)

In *Carpenter* v. *Smith*, (*b*) Lord Abinger, C.B., told the jury that a man has a right to a patent if he is the first person who brings into England an invention which is used abroad and not known in England, and that it was sufficient if the patentee was an "original importer."

In *Walton* v. *Bateman*, (*c*) Cresswell, J., stated the law thus: "The party obtaining the patent must be the true and first inventor in this country. If he imports from a foreign country that which others at the time of the making of such letters patent and grants did not use, it will suffice."

In *Beard* v. *Egerton*, (*d*) Tindal, C.J., said: "A person who has learned an invention abroad, and imported it into this country, where it was not used or known before, is the first and true inventor within the Statute."

In *Berry's Patent*, Lord Brougham, dealing with an application made to the Privy Council for the extension of a patent term, said: "The patent law is framed in a way to include two species of public benefactors; they are those who benefit the public by their ingenuity, industry, and science and invention and personal capability; the other, those who benefit the public without any ingenuity or invention of their own, by the importation of the

(*y*) *Darcy* v. *Allin*, Noy's Rs. 178; 1, W. P. C. 6; *Clothworkers of Ipswich Case*, Godbolt, 252.

(*z*) 3 Inst. 184. See, also, Sheppard's *Abridgement*, Part III., Title Prerogative, p. 61.

(*a*) 2 Salk. 447, 1 W. P. C. 35. See, also, Eyre, C. J., in *Boulton* v. *Bull*.

(*b*) 1 W. P. C., pp. 535, 536.

(*c*) 1 W. P. C., p. 615.

(*d*) 15 L. J. C. P. 270; 3 C. B. 128, 129. See, also, *Stead* v. *Anderson*, 2 W. P. C. 149; *Stead* v. *Williams*, 2 W. P. C. 130; *Nickels* v. *Ross*, 8 C. B. 679.

results of foreign inventions. Now, the latter is a benefit to the public incontestably, and therefore they render themselves entitled to be put upon somewhat, if not entirely, the same footing as inventors." (*e*)

In *Marsden* v. *The Saville Foundry Company*, (*f*) Jessel, M.R., while recognizing the existence of the foregoing rule, strongly expressed the opinion that it was not possible to find any principle upon which to justify the putting of an inventor and an importer on the same footing. It is submitted, however, that the principle which has guided the Courts in this interpretation of the Statute is manifestly that suggested by Lord Brougham in *Berry's Patent*, as quoted above. For the merit in respect of which the law recognizes that an inventor deserves to be placed in the exceptional position of a monopolist is not the exercise by him of an unusual ingenuity *per se*, but the fact that he has made a contribution of value to the stock of industrial knowledge; and so far as the public are concerned, the value to them of that contribution is precisely the same whether the patentee has invented it by his personal ingenuity or imported it through his enterprise. In either case an addition is made to the stock of industrial knowledge, and hence in the eyes of the Crown, so far at least as the original grant is concerned, an inventor and an importer are properly held to be equally deserving of encouragement.

In *Beard* v. *Egerton*, (*g*) it was argued that the person who took out the patent as an importer must be a meritorious importer and not a mere clerk or servant; nor even an agent, acting for the purposes of the application only, upon a communication made by a foreign inventor. In rejecting this contention, Tindal, C.J., said: "No authority is cited for such distinction. So far as the public are concerned in interest, no such distinction is necessary. *Berry* (the patentee) is an Englishman, to whom the invention is communicated by a foreigner residing abroad; and *Berry* first brings the invention into England and makes it public there. So far, therefore, as relates to the interests of the public, *Berry* has all the merit of the first inventor." (*h*)

A foreign inventor may thus obtain a grant of an English patent, in the name of a person resident in England, who acts as a mere trustee for such foreigner. Formerly one foreigner could obtain a grant of letters patent as an importer upon a communication

(*e*) 7 Moo. p. 189. See, also, *Claridge's Patent*, 7 Moo. p. 396; *Soame's Patent*, 1 W. P. C. 733.

(*f*) L. R. 3 Ex. D. 203.

(*g*) 3 C. B. 128, 129.

(*h*) See, also, *Nickels* v. *Ross*, 8 C. B. 679; *Stead* v. *Williams*, 2 W. P. C. 130.

made abroad to him by another foreigner. (*i*) Now, however, the application, if made by an importer, must be made by an applicant resident in England. (*j*)

The Importer must be an Importer from Abroad.—The importer must, however, be a genuine importer. His invention, whether he learns it abroad or has it communicated to him from abroad, must come from beyond the limits of the Kingdom. At one time it was doubted whether or not Scotland was within the Kingdom for this purpose, but that question has long been answered in the affirmative. (*k*)

"It would be a monstrous thing," said Lord Lyndhurst, C., in *Brown* v. *Annandale*, "if an invention having full publicity in one part of the Kingdom could be made the subject of a patent in another part of it." Lord Campbell, in the same case, said, "If the Crown were made aware of that fact the grant would be refused." (*l*)

Colonies of the Empire which have statutory powers to grant letters patent in their own dominions are, for the purposes of the inventor, foreign countries, and persons first importing inventions from them are qualified to be grantees of letters patent. (*m*)

In *Marsden* v. *The Saville Foundry Company*, (*n*) the plaintiff in an action of infringement alleged in her statement of claim that letters patent had been granted to her for an invention communicated to her by her late husband which was not in use by any other person or persons in the United Kingdom, and of which, therefore, she was the first introducer. The defendant demurred to the statement of claim as bad in law, because on the facts stated, the plaintiff could not be the true and first inventor within the Statute, the communication not having been made from abroad. Pollock, B., upheld the demurrer. His decision was affirmed on appeal.

"This is a mere experiment," said Jessel, M.R. "From the time of the passing of the Statute (21 Jac. 1, c. 3) down to the present time, no one, as far as I know, has contended in a court of law, much less has any court of law allowed, the validity of such a contention as that a communication made in England by

(*i*) *Re Wirth's Patent*, L. R. 12 C. D. 303.

(*j*) See *Patent Office Journal*, May 9, 1884; and Form A 1, Appendix II., post. The applicant may be a corporation; *Société Anonyme, &c., du Temple*, 13 R. P. C. 54.

(*k*) *Roebuck* v. *Stirling*, 1 W. P. C. 45.

(*l*) *Brown* v. *Annandale*, 8 Cl. & F. 437. Now, by the Patents Act, 1883, s. 16, every patent takes effect throughout the United Kingdom and the Isle of Man.

(*m*) *Rolls* v. *Isaacs*, 19 C. D. 268; 45 L. T. (N. S.), 704.

(*n*) L. R. 3 Ex. D. 203; 39 L. T. 92.

one British subject to another British subject can be patented by the receiver of the communication, so as to make the receiver the true and first inventor within the meaning of the patent laws. It has been argued that before the Statute of James such patents were valid, and were allowed by the judges, and that the Statute merely restricts the duration of the patent, and does not destroy the right as it previously existed. Even supposing that were so, the Statute defines who are considered to be worthy recipients of the grant of such a monopoly, as it was then called, and the definition so given has been followed ever since. What possible right have we to say that we can now extend that privilege beyond the importation of the invention from beyond the seas to the case of a man who dies before taking out a patent, and whose legal personal representative, finding the invention sufficiently described amongst his papers, thereupon obtains a patent as upon a communication from him. Whether or not there should be legislative provision for such a case it is not for me to say. But there is none. He is neither the first nor the true inventor within the ordinary or existing legal meaning of the term." This legislative provision to meet the case of a deceased inventor has, however, now been made, as will be shortly indicated. (*o*)

It was at one time doubtful whether the Patents Act, 1883, had not introduced a modification of the law by excluding the rights of importers to rank as inventors, and in *Edmund's* case this view of the Act was pressed upon the Law Officer. Sir R. Webster, A.G., in refusing to accede to it said: "Prior to the passing of the Act of 1883 the law was well settled that a person importing into the realm an invention was the true and first inventor within the meaning of the Statute of James, and it mattered not under what circumstances he had obtained the invention from abroad. In my judgment, the Act of 1883 has made no alteration of the law in this respect. In the case of an imported invention the merit of the invention is the importation—the communication to the public in the United Kingdom and the Isle of Man; and I think, therefore, the Comptroller has no jurisdiction to enquire as to the circumstances under which the invention was obtained by the importer. Of course there may be cases in which the relations between the parties are such that the person who has first imported the invention may be guilty of some breach of contract or breach of duty towards the person from whom he has obtained the invention abroad, and the importer may be liable

(*o*) See post, p. 38; also Patents Act, 1883, s. 34.

to proceedings in respect of the breach of such contract or duty; but in my opinion these are matters which the Comptroller General and Law Officer cannot enquire into, but must form the subject of independent proceedings between the parties either in this country or abroad as the case may be." (*p*)

An importer who applies for a patent for an invention communicated from abroad may supplement that invention by original improvements of his own, and does not thereby invalidate any patent granted upon the application. "It was suggested," said Lindley, L.J., in *Moser* v. *Marsden*, "that as the English patentee had himself improved *Grosselin's* invention, the specification ought to have shewn this on the face of it; and that as the whole invention was not communicated to the plaintiff by *Grosselin*, as stated by the plaintiff, his patent is bad. This point has been raised before, but as yet it has not found favour with any Court. Nor ought it. There is no substance in it. The patentee is the true and first inventor, within the meaning of the patent law, whether he invents himself, or whether he simply imports a foreign invention. I cannot see how he is anything but a true and first inventor if he does both; that is, if he both imports a foreign invention and improves it himself." (*q*)

Where two Persons simultaneously make the same Invention.—When two or more independent inventors simultaneously make the same invention the inventor who first discloses his invention to the public under the protection of letters patent is the true and first inventor. (*r*)

In *Cornish* v. *Keene*, (*s*) Tindal, C.J., said: "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 enjoy its benefits."

In *Henry's* Application (*t*) for letters patent, Lord Selborne, C., said: "I apprehend that it would be no answer to a *bonâ fide* applicant for a patent, assuming the absence of fraud or communication, to allege that experiments had been going on, or even

(*p*) Griffin, p. 283. See, also, *Higgin's Patent*, 9 R. P. C. 74, in which Sir R. Webster, A.G., said it mattered not even if the importer had stolen the invention abroad.

(*q*) 10 R. P. C. 359.

(*r*) *Forsyth* v. *Riviere*, 1 Carp. 401; 1 W. P. C. 97 *n.*

(*s*) 1 W. P. C. 508.

(*t*) L. R. 8 Ch. 237; 42 L. J. Ch. 356.

drawings made by another inventor. One person, being a *bonâ fide* inventor, comes first to ask for a patent for his invention, and such allegations are no answer to him. If a patent be granted to him, it would date from the date of his application. If he were the true inventor, the circumstance of something having taken place somewhere else, which was not disclosed to the world, and as to which no prior application was made, would be no answer to him, even if it were shewn that the two inventors were travelling very much upon the same lines, and that their minds were going very much to the same point at the same time."

An Inventor means the First Discloser of an Invention.—The inventor who invents and first discloses his invention is the true and first inventor. Therefore an inventor who is not in strict language the first discoverer of an invention may still be a lawful recipient of a patent grant, if the earlier inventor who has anticipated him, has kept the invention secret.

Thus, in *Dollond's Patent* it was held that a patent for a new method of making object glasses was good, although the same discovery had been previously made by another, who had confined the invention to his closet and never disclosed it to the public. (*u*)

In *Hill* v. *Thompson*, Dallas, J., said that it was not enough to defeat the rights of a grantee to shew that there had been a prior discoverer of the invention, unless it was also shewn that that prior inventor had disclosed his discovery; (*v*) while in *Lewis* v. *Marling*, Bayley, J., said: "If I discover a thing for myself, it is no objection to my having a patent for it that another has also made the discovery, provided I first introduce it into public use." (*w*)

In *Carpenter* v. *Smith*, (*x*) Abinger, C.B., said: "That if an invention is new and useful, the inventor shall not be prejudiced by any other man having invented that before, and not made 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." Hence "a man shall not, by his own private invention which

(*u*) 1 W. P. C. 43; Parl. R. 182; cited in 2 H. Bl. 470, 487. See, also, *Bramah* v. *Hardcastle*, 1 W. P. C. 44; Holroyd, 81.

(*v*) 8 Taunt. 395.

(*w*) 1 W. P. C. 126; 10 B. & C. 27.

(*x*) 1 W. P. C. p. 534.

he keeps locked up in his own breast or in his desk and never communicates it, take away the right that another man has to a patent for the same invention."

So likewise in *The Househill Iron Company* v. *Neilson*, Lord Lyndhurst said: "He is not called the inventor who has in his closet invented it, but who does not communicate it. The first person who discloses that invention to the public is considered as the true inventor."

Aliens, Infants, Married Women, Lunatics, and Executors.—Provided the applicant for letters patent (or in the case of joint applicants, any one of them) satisfies the condition of being a true and first inventor, as above interpreted, it is not necessary that he should be a British subject. This had been decided prior to the Patents Act, 1883, (*y*) and is now expressly enacted by Section 4 of that Statute. (*z*)

So, too, letters patent may be granted to two or more inventors jointly, (*a*) and even to one inventor jointly with other applicants, who have not themselves that qualification. (*b*) In this way a corporation may join in an application for, and become a grantee of, letters patent. (*c*)

Infants, (*d*) married women, and lunatics may be grantees of letters patent. Section 99 of the Patents Act, 1883, provides the manner in which any declaration or act required by the Statute may be made or done on behalf of persons so incapacitated.

An important modification of the law was introduced by Section 34 of the same Act to meet the case of an inventor who died before he had obtained letters patent for his invention. (*e*)

That section provides, "If a person possessed of an invention dies without making application for a patent for the invention, application may be made by, and a patent for the invention granted to, his legal representative."

"Every such application must be made within six months of

(*y*) See Tindal, C.J., in *Beard* v. *Egerton*, 3 C. B. 128; *Chappel* v. *Purday*, 14 M. & W. 318. This is consistent with the early policy of the Crown in encouraging foreign subjects to bring new trades into England. See ante, p. 3.

(*z*) Whether the Crown would exercise its prerogative by granting a patent to an alien enemy is at least doubtful. See *Bloxam* v. *Elsee*, 6 B. & C. 169; 1 C. & P. 558; 1 W. P. C. 418 *n*.

(*a*) Patents Act, 1883, s. 4.

(*b*) Patents Act, 1885, s. 5.

(*c*) Patents Act, 1883, s. 117.

(*d*) See *Cheavin* v. *Walker*, L. R. 5 C. D. p. 858; 46 L. J. Ch. 265; 35 L. T. 757.

(*e*) See the case of *Marsden* v. *Saville Foundry*, L. R. 3 Ex. D. 203. See aute, p. 34.

the decease of such person, and must contain a declaration by the legal representative that he believes such person to be the true and first inventor of the invention."

If an inventor dies after making application for a patent, but before it is sealed, the patent may be granted to his legal representative, and sealed at any time within twelve months after the death of the applicant. (*f*)

(*f*) Patents Act, 1883, s. 12 (3).

CHAPTER IV.

THE SUBJECT-MATTER OF THE GRANT.

Letters Patent Granted for Manufactures only.—The prerogative of the Crown to grant monopolies of inventions, and the limitations which the law imposes on that prerogative as to the persons in whose favour it may be exercised, have already been under review; the subject-matter of such grants must now be considered.

At the outset it is necessary to turn again to the Statute of Monopolies. By Section 6 of that Act the privilege of granting monopolies is preserved to the Crown only in respect of matters which can be brought under the following description. "*Any manner of new manufactures within this realm . . . which others at the time of the making of such letters patent and grants shall not use.*" Moreover, the Act further provides that such manufactures shall only be made the subject of grants by letters patent when "*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 inventor, therefore, who seeks a grant of letters patent must bring to the Crown a "manufacture." Further, such manufacture must be *new*. It must also be *useful*. The quality of utility is not specifically named in the Statute, but the words of the Act imply it. Prior to the passing of the Act the grant of a monopoly in a manufacture possessed of no utility was contrary to the common law, and at all times such a grant must necessarily be hurtful to the interests of the public, as calculated to obstruct and impede the discovery of really useful inventions. Lastly, a manufacture to be patentable, must be the fruit of ingenuity on the part of the inventor. In a word, it must imply *invention*. These qualities, which the law requires to be present in the subject-matter of all valid letters patent, will be considered in this and the five succeeding chapters.

Meaning of the Term Manufacture.—Recognizing that the primary object of all patent privileges is the advancement of trade and industry, the Courts have placed a very wide interpretation upon the term "manufactures." Alluding to this in *Boulton* v. *Bull*, Eyre, C.J., said: "I observe also that according to the letter of the Statute the words any manner of new manufacture in the saving fall very far short of the words 'anything' in the first section. But most certainly the exposition of the Statute, as far as reason will expound it, has gone very much beyond the letter. In the case in *Salkeld* (*a*) the words 'new devices' are substituted and used as synonymous with the words 'new manufacture.' It was admitted in the argument at the bar, that the word 'manufacture' in the Statute 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." (*b*)

In *Ralston* v. *Smith*, Lord Westbury, C., said: "Your lordships are well aware that 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." (*c*)

No comprehensive definition of all that the term "manufactures" may import has been attempted by the Courts. Nor, indeed, is such definition possible. (*d*) Judges have been content to define the term by stating illustratively what may be embraced under it.

A Thing Made.—It undoubtedly includes a thing made or produced.

In *R.* v. *Wheeler*, Abbott, C.J., said: "The word 'manufactures' has generally been understood to denote either a thing made, which is useful for its own sake, and vendible as such, as a medicine, a stove, a telescope, and many others, or to mean an engine or instrument, or some part of an engine or instrument, to be employed either in the making of some previously known article, or in some other useful purpose, as a stocking-frame, or a steam-engine for raising water from mines." (*e*)

'A thing made' does not, however, mean anything made; it

(*a*) *Edgeberry* v. *Stephens*, 2 Salk. 447.
(*b*) 2 H. Bl. 492, 493; Dav. P. C. 207.
(*c*) 11 H. of L. Ca. 246.
(*d*) *Per* Lopes, L.J., in *Blakey* v. *Latham*, 6 R. P. C. 189.
(*e*) 2 B. & Ald. 349.

must be a something industrial and vendible, for the Statute refers only to manufactures which are the subject of trade. (*f*)

"I approve of the term 'manufacture' in the Statute," said Heath, J., in *Boulton* v. *Bull*, "because it precludes all nice refinements: it gives us to understand the reason of the proviso, that it was introduced for the benefit of trade." (*g*)

An Addition may be a Manufacture.—Owing to the immense progress of invention, it can hardly ever happen now (except in the case of chemical products) that the thing produced can be *in toto* a new manufacture. Yet it was at one time doubted whether an invention which merely added something to a known thing could be the subject of a patent. Thus in *Bircot's* case it was held by the Court of Exchequer Chamber that the addition to a manufacture cannot be the subject of a patent. For there it was said that that was to put a new button to an old coat, and it is much easier to add than to invent. (*h*) Lord Mansfield, however, refused to follow this case, and held in *Morris* v. *Bransom* (*i*) that an addition to an old stocking-frame was good subject-matter for a patent, saying, that if there could be no patent for an addition, that proposition of law would go far to repeal almost every patent that ever was granted. So, too, Eyre, C.J., in *Boulton* v. *Bull* (*j*) refused to follow *Bircot's* case; while in *Hornblower* v. *Boulton*, Grose, J., said that if *Bircot's* case were to be considered as law it would set aside many patents for many ingenious inventions, in cases where the additions to manufactures before existing were much more valuable than the original manufactures themselves. (*k*)

Nor is it any objection in law to the granting of a patent for an addition to shew that the manufacture to which the addition is made is the subject of a prior grant, provided the second patentee claims the addition only; for the second patent, after the expiration of the first, will be free from any objection, and even whilst the earlier grant subsists the second invention can lawfully be used by procuring a license, or purchasing the necessary apparatus, from the first patentee; and the probability of the refusal of a license to any one applying for it is so extremely remote that it cannot enter into consideration as a ground of legal objection. (*l*)

(*f*) See *Boulton* v. *Bull*, 2 H. Bl. 482; *Cornish* v. *Keene*, 1 W. P. C. p. 517.

(*g*) 2 H. Bl. 482.

(*h*) Coke, 3 *Inst.* 183; 1 W. P. C. 31 *n.*; temp. 15 Eliz.

(*i*) 1 W. P. C. 51; Bull N. P. 76 *a*.

(*j*) 2 H. Bl. 492; Dav. P. C. 205.

(*k*) 8 T. R. p. 104.

(*l*) *Per* Tindal, C.J., in *Crane* v. *Price*, 1 W. P. C. 413. As to the compulsory licenses

A New Process or Method of making an Old Article is a Manufacture.—In like manner it was at one time doubted whether the word "manufacture" could extend to the process or method of making as well as to the thing made. But in *Boulton* v. *Bull* (*m*) this meaning of the word was very clearly laid down by the Court of Common Pleas. In that case the patent was for a new method of using an old machine in a more beneficial manner than was before known. Eyre, C.J., said: "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, in one of the common acceptations of the word, as we speak of the manufacture of glass, or any other thing of that kind. The advantages to the public from improvements of this kind are beyond all calculation important to a commercial country, and the ingenuity of artists who turn their thoughts towards such improvements is in itself deserving of encouragement; and in my apprehension it is strictly agreeable to the spirit and meaning of the Statute Jac. 1 that it should be encouraged. . . . 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, (*n*) it must be for the method, detached from all physical existence whatever. . . . Probably I do not over-rate it when I state that two-thirds, I believe I might say three-fourths, of all patents granted since the Statute passed, are for methods of operating and of manufacturing, producing no new substances and employing no new machinery. . . . And shall it now be said, after we have been in the habit of seeing patents granted, in the immense number in which they have been granted, for methods of using old machinery to produce substances that were old, but in a more beneficial manner, and also for producing negative qualities by which benefits result to the public, by a narrow construction of the word 'manufacture' in this Statute, that there can be no

which may now be obtained under the Patents Act, 1883, s. 22, see post, p. 349.

(*m*) 2 H. Bl. 463 (1795).

(*n*) *Millar* v. *Taylor*, 4 Burr. 2397.

patent for methods producing this new and salutary effect, connected, and intimately connected as it is, with the trade and manufactures of the country? . . . It is not that the patentee has conceived an abstract notion that the consumption of steam in fire-engines may be lessened, but he has discovered a practical manner of doing it; and for that practical manner of doing it he has taken this patent. Surely this is a very different thing from taking a patent for a principle. It is not for a *principle*, but for a process." (*o*)

So, too, in *R.* v. *Wheeler*, Abbot, C.J., said: "The word 'manufacture' may perhaps also extend to a new process to be carried on by known implements or elements acting upon known substances, and ultimately producing some other known substance, but producing it in a cheaper or more expeditious manner, or of a better or more useful kind." (*p*) Again, in *Morgan* v. *Seaward*, (*q*) Parke, B., said: "The word 'manufacture' in the Statute must be construed in one of two ways; it may mean the machine when completed, or the mode of constructing the machine."

In *Stevens* v. *Keating*, (*r*) where the patent was for improved processes of manufacturing stuccoes, plasters, and cements, a similar view was taken by the Court. Pollock, C.B., said: "The word 'manufacture' is introduced, and all patents must be for a manufacture. The real invention may not be so much for the thing when produced as for 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." In *Bush* v. *Fox*, (*s*) Coleridge, J., said: "In most of the cases cited the new method constitutes the manufacture. Manufacture includes both process and result." "One of the most useful of inventions," said James,

(*o*) 2 H. Bl. 494, 495, 496; Dav. P. C. 210-213.

(*p*) 2 B. & Ald. 350; followed by Tindal, C.J., in *Crane* v. *Price*, 1 W. P. C. 409; and *Gibson* v. *Brand*, 1 W. P. C. 633.

(*q*) 2 M. & W. 558; M. & H. 58; 1 W. P. C. 193.

(*r*) 2 W. P. C. 182.

(*s*) Macr. 176.

V.C., in *Elmslie* v. *Boursier*, (*t*) "is that of a process by which a common article may be made more economically than it was before."

It is no objection to a patent for a process to shew that a prior patent has been granted for another process aimed at the same end, provided the second process be new in itself, and distinct from the first.

In *Hullet* v. *Hague*, (*u*) the plaintiff claimed a specified method of hastening the evaporation of sugar. The plaintiff carried out his method by means of a large horizontal tube placed over the surface of the liquid. Into this tube were introduced a number of small perpendicular tubes, descending through the fluid to the bottom of the boiler, and having their lower ends exactly on a level, and parallel to the surface of the fluid. The air was forced by a blowing apparatus in at the open end of the large tube, and as the other end of that tube was closed, it descended through the smaller tubes to the bottom of the boiler, and thence bubbling up, facilitated evaporation. It was objected by the defendant that the plaintiff's patent had been anticipated by an earlier patent aimed at the same result. But the apparatus described in the earlier patent was a perforated coil of piping placed at the bottom of the vessel or boiler, and emitting the air through the perforations. The Court of King's Bench held that the plaintiff's patent was good as being for a different method and an apparatus perfectly distinct from that of the earlier invention.

A New Process means a Process distinct from any already known.—When the patent is for a new process it must, as above stated, be a process distinct from any other process already known. (*v*)

In *Curtis* v. *Platt*, (*w*) Lord Westbury, C., said: "If the idea started by one man 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 road to go to Brighton by Croydon, another man shall not have a road to go to Brighton by Dorking. They are roads, and means of attaining the end, and unless you can prove that one is a colourable imitation of the other, or unless you can prove that one bodily incorporates the other with merely an addition, it is impossible to say that they shall not be co-existent subjects of contemporaneous patents."

(*t*) L. R. 9 Eq. 222.
(*u*) 2 B. & Ad. 370, p. 379.
(*v*) *Walton* v. *Potter*, 1 W. P. C. 590, 591.
(*w*) 11 L. T. (N. S.), 249.

In *Moore* v. *Thomson*, (*x*) Lord Halsbury, C., dealing with the rule that a new mode of attaining an old result is good subject-matter for a patent, said: "I will take the illustration which I think is that of Lord Westbury, in one of the cases relied on, 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 a patent is granted for a new method or process of attaining a known result, the protection it affords extends only to that particular method or process.

In *Bovill* v. *Pimm*, (*y*) Pollock, C.B., said: "It appears to us that where a subject is not new, as this certainly was not, viz. 'the cooling of substances undergoing the process of grinding' (which had been long known to be a desideratum in grinding, and to effect which various contrivances had been adopted, and several, if not many, patents taken out), any patent taken out for a method of performing the operation is substantially confined to that method, and cannot be extended to other methods obviously different, because they involve some common principle applied to the common object, and may apparently be described by the same general phrase. In this case the common object was known, viz. cooling the grinding surfaces or the substances exposed to their action. The principle of obtaining a current of air by a rotating vane (if that can be called a principle) was already made known to the world by *Gordon's* patent. *Bovill's* method was an improvement on *Gordon's*. . . . *Rands'* is also probably a better method than *Gordon's*. . . . We think the patents as they appear before us are respectively independent original improvements; and that each is entitled to protection in respect of the method disclosed in it, but cannot claim beyond what is substantially the method actually described and given to the public."

A New Process may consist in the Omission of a Step in a Process already known.—A new process may consist in the omission of a step from some process previously pursued to the same end. If such an omission results in producing the same article in a cheaper

(*x*) 7 R. P. C. 333. (*y*) 11 Ex. 739.

or better form it is an improvement and may be made the subject of a patent. (*z*)

In *Wallington* v. *Dale*, (*a*) the patent was for improvements in the manufacture of gelatinous substances. Previous to the patent gelatine had been obtained by submitting large pieces of hide to the action of caustic alkali; or by reducing them to pulp in a paper machine and employing blood to purify the product. The patentee discovered that by cutting the hides into shavings, thin slices, or films, the use of blood for subsequent purification could be dispensed with, and this discovery was held to be good subject-matter for a patent. Again, in *Booth* v. *Kennard*, (*b*) the patentee claimed as his invention, making gas direct from seed, instead of making it from oil previously extracted. By this means the patentee got rid of one out of two processes. "Previous to this invention," said Cockburn, C.J., "the gas was obtained from oil previously expressed. The patentee says that instead of going through that first process of abstracting the oil, he makes it all at one process. I think that there can be no doubt it is a useful invention, and one for which a patent can be obtained, supposing it to be new."

A New Combination of Old Materials is a New Manufacture.—A new combination of old materials previously in use, if that new combination produces either a new result or an old result in a more useful and beneficial manner, is subject-matter for a patent.

In *Hill* v. *Thompson*, Lord Eldon, C., said, "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. But, in order to its being effectual, the specification must clearly express that it is in respect of such new combination or application, and of that only, and not lay claim to the merit of original invention in the use of the materials." (*c*)

In *Cornish* v. *Keen*, (*d*) the patent was for improvements in the making of elastic goods or fabrics. In carrying out the invention strands of indiarubber were first covered by winding filaments tightly round them by an ordinary covering machine. They were then arranged as warp threads, and stretched to their utmost tension. Additional warp threads of cotton, flax, etc., were combined with the indiarubber strands. The cloth was then woven in the ordinary manner. Thereafter it was submitted to the action of

(*z*) *Russell* v. *Cowley*, 1 W. P. C. 467; 1 C. M. & R. 875.

(*a*) 7 Ex. 888; 23 L. J. Ex. 49.

(*b*) 26 L. J. Ex. 23 and 305.

(*c*) 1 W. P. C. 237; followed in *Crane* v. *Price*, 1 W. P. C. 409; *Murray* v. *Clayton*, L. R. 7 Ch. 584.

(*d*) 1 W. P. C. 508; 3 Bing. (N. C.) 570; 6 L. J. C. P. 225.

heat, which caused the indiarubber to contract and become elastic; the non-elastic threads, however, prevented the extension of the fabric exceeding a certain limit. In this way a new fabric of limited elasticity was produced. This new combination was held to be entitled to the protection of a patent, although the materials thus combined were before known and used. In delivering the judgment of the Court of Common Pleas, Tindal, C.J., said: "Does this invention come under the description 'any manner of new manufacture,' which are the terms employed in the Statute of James? That it is a manufacture can admit of no doubt; it is a vendible article produced by the art and hand of man; and of all the instances that would occur to the mind, when inquiring into the meaning of the terms employed in the Statute, perhaps the very readiest would be that of some fabric or texture of cloth. . . . That it comes within the description of a manufacture, and so far is an invention which may be protected by a patent, we feel no doubt whatever. The materials indeed are old, and have been used before; but the combination is alleged to be, and if the jury are right in their finding is, new, and the result or production is equally so. The use of elastic threads or strands of indiarubber, previously covered by filaments wound round them, was known before; but the placing them alternately side by side together as a warp, and combining them by means of a weft when in extreme tension and deprived of their elasticity, appears to be new; and the result, namely, a cloth in which the non-elastic threads form a limit up to which the threads may be stretched, but beyond which they cannot, and therefore cannot easily be broken, appears a production altogether new. It is a manufacture at once ingenious and simple. It is a web combining the two qualities of great elasticity and of a limit thereto."

In *Crane* v. *Price*, (*e*) the question whether or not a combination could be good subject-matter for a patent was again considered by the same Court. In this case, Tindal, C.J., in the course of a "considered judgment," often since approved, said: "The question therefore becomes this, whether, admitting the use 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 cold blast, but that the two together were not known to be combined before in the manufacture of iron, whether such combination can be the

(*e*) 1 W. P. C. 377; 4 M. & G. 580; 12 L. J. C. P. 81.

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, that such combination is an invention or manufacture intended by this Statute and may well become the subject of a patent. . . . 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." (*f*)

In *Spencer* v. *Jack*, (*g*) Lord Westbury, C., said: "It is impossible to deny that, if there be a combination of several things previously well known, which combination is attended with results of such utility and advantage to the public that the combination itself is rightfully denominated a substantial improvement, it is, I say, impossible to deny that that is the subject of a patent."

In *Cannington* v. *Nuttall*, (*h*) the invention related to certain improvements in the manufacture of glass. The improvements consisted in a new combination of the materials previously used, by which the patentee obviated certain difficulties in the manufacture, and attained a result long desired by glass-makers. Under the former method of manufacturing glass it had been customary to put the raw materials into pots made of fireproof clay, which were stationed on "sieges" or benches, so that heat might be applied to them from below. A very high degree of heat was required, with the result that the pots often cracked, and the molten glass escaped through the fissures. To save the glass in such cases it was found necessary to remove the pots, so as to allow contact with the open air, when the glass congealed and stopped the fissures. As the pots were of very great weight, and could only be moved by means of a huge instrument acting like a pair of pincers, this was a troublesome thing to do. The patentee's combination was directed both to the prevention of cracking and to the healing of cracks when they occurred without the necessity of removing the vessels in use. To achieve this the inventor substituted a tank for the pots. To this tank heat was applied from the sides, so that the great heat occurred not below, as before,

(*f*) 1 W. P. C. pp. 408, 409. Cf. *Hall's Patent*, 1 W. P. C. 97; *Derosne's Patent*, 1 W. P. C. 152; *Hill's Patent*, 3 Meriv. 629; *Daniel's Patent* cited, Godson, 274.

(*g*) 3 De G. J. & S. 346; 11 L. T. (N. S.), 244.

(*h*) L. R. 5 H. of L. 205; 40 L. J. Ch. 739. Cf. *Saxby* v. *Clunes*, 43 L. J. 228.

but in the top part of the tank. Round the tank a channel was formed, so that the air might circulate freely. This kept the sides of the tank cooler than the interior, and so prevented cracking, or if a fissure did occur, it helped to heal the crack, as on contact with this atmospheric current the escaping glass became congealed. The House of Lords held that the invention was good subject-matter for a patent for a combination. Lord Hatherley, C., said: "I take it that the test of novelty is this: is the product which is the result of the apparatus for which an inventor claims letters patent effectively obtained by means of your new apparatus, whereas it had never before been effectively obtained by any of the separate portions of the apparatus which you have now combined into one valuable whole for the purpose of effecting the object you have in view?"

In *Murray* v. *Clayton*, (*i*) the Court had before it an application for an injunction to restrain the infringement of a patented machine for the making of bricks. The machine was so contrived as to make the bricks by pushing a strip of clay (previously severed from the bulk by the action of a vertical wire) against a row of fixed vertical wires, so stationed as to divide the strip into separate pieces. There was also a contrivance for removing the bricks when made without handling them. In this way twelve bricks or more could be made by one operation of the machine. It was objected that the machine was formed by the mere arrangement of common elementary mechanical materials, producing results of the same nature as those previously accomplished by other mechanical arrangements. But the Court of Appeal (reversing Bacon, V.C.) held that the machine was good subject-matter as a combination of known parts which produced a new result, or, at least, an old result in a more economical and more perfect form, making better bricks and cheaper bricks than had ever been produced before.

In *Davis* v. *Feldtman*, (*j*) the patent was for improvements in umbrellas. Pollock, B., in a judgment which was subsequently affirmed by the Court of Appeal, said: "If taken as a patent for a combination the plaintiff's patent is good, and it is not, of course, the less good because it involves principles and actual construction, that have preceded it, which are common knowledge. A patent may be good for a combination, although when it is taken to pieces there is not one single part of the process, or of the machinery called into use to create that combination, which is new in itself."

(*i*) L. R. 7 Ch. 570; 21 W. R. 498.

(*j*) 1 R. P. C. 13, 193.

In *Reynolds* v. *Amos*, (*k*) the plaintiffs brought an action for infringement of a patent for improved appliances to be used in the manufacture of ensilage. The object aimed at by the patentee was the preservation of fodder in a fresh, wholesome state. For this purpose he had devised a combination of chains with levers for tightening them when required, so as to maintain the requisite amount of pressure. It was objected that this was not subject-matter for a patent. Bacon, V.C., held the patent good. The learned judge said: "Chains are not their invention; screw-jacks are not their invention; but using them in such a manner as will produce in the result a successful, new, cheap, useful manufacture of ensilage is the invention which they claim by their patent." (*l*)

So also in the more recent cases of *Thomson* v. *Batty* (*m*) and *Thomson* v. *Moore*, (*n*) it was held that a new and successful combination of old parts of an old machine, so devised as to attain a desired improvement, viz. the reduction to a minimum of the errors arising, from mechanical and magnetic causes, in the action of a mariner's compass, was good subject-matter for a patent.

In the *American Braided Wire Company* v. *Thomson*, (*o*) the question of subject-matter was much discussed. In that case the patent was for improvements in bustles or dress-improvers. The invention consisted in the ingenious adaptation of braided steel wire to the manufacture of bustles. It was proved that bustles were old, that the wire used was old, and that braiding wire upon a core was old; but the Court of Appeal, not without some doubt, held (reversing Kekewich, J.) that there was sufficient utility and novelty in the new application of tubular wire to the making of bustles in the manner described to support a patent. And in this decision they were affirmed by the House of Lords.

In *Vickers* v. *Siddell*, (*p*) the invention consisted of an apparatus composed of a wheel and endless chain for turning heavy forgings, the wheel being internally toothed, and having a ratchet working in it, by means of which the wheel was caused to rotate, and the forging which rested in the endless chain thus turned from time to time to the extent desired. It was admitted that the elements

(*k*) 3 R. P. C. 215.

(*l*) In *Herrburger* v. *Squire* (5 R. P. C. 592), Charles, J., said this case went a long way, but was reconcilable with the authorities, on the ground that Bacon, V.C., expressly found there was invention required to make this particular combination of well-known things. See, also, Bacon, V.C., in *Sharp* v. *Brauer*, 3 R. P. C. 193.

(*m*) 6 R. P. C. 84.

(*n*) 6 R. P. C. 426; 7 R. P. C. 325.

(*o*) 5 R. P. C. 119; 7 R. P. C. 47.

(*p*) See Lord Herschell's judgment, 7 R. P. C. p. 304.

were all old. Forgings had long rested in an endless chain, the idea of turning such forgings by turning the wheel over which the chain passed was not new, and a ratchet working in teeth was a well-known device for causing a wheel to rotate. But the result of the patentee's combination was a new apparatus of an extremely simple character, which possessed the advantage of being easily moved from place to place and applied wherever wanted, and the Court of Appeal and House of Lords held that this new and useful combination of old materials was good subject-matter for a patent.

An Improvement in a known Machine is a Manufacture.—An improvement in a known machine is a manufacture within the meaning of the Statute, and good subject-matter for a patent.

Where, however, the invention consists in such an improvement the patent must be limited to that improvement only, and must distinguish it from the rest of the machine. In *Foxwell* v. *Bostock*, (*q*) the patent was for improvements in sewing machines. The real invention was the use of a shaft with three cams upon it; but the patentee gave only a general description of the machine. Lord Westbury, C., held that this was not sufficient, and that the specification should have described the improvement and defined the novelty, otherwise than by a general description of the whole machine.

This rule, however, does not apply where the invention lies not in the introduction of a single improvement into an old machine, but in the new mode of arranging old parts. In such case the patent is for the combination as a whole, which is of itself, *ex necessitate*, the novelty, and to describe the combination is sufficient.

This was decided in *Harrison* v. *Anderston Foundry Company*, (*r*) where the subject of patents for combinations was fully considered by the House of Lords. In that case the patent was for a new combination, and the judges of the Court of Session, extending the principle of *Foxwell* v. *Bostock*, had held the patent bad on the ground that the specification did not distinguish the old and the new. On appeal to the House of Lords this decision was reversed. Lord Hatherley said: "The judges extended, as it appears to me, with great respect, the doctrine of *Foxwell* v. *Bostock* in their application of it to this case. It was there held—and that, I think, was all that was held—that it is not competent to a man to take a well-known existing machine, and having made some small

(*q*) 10 L. T. (N. S.), 144. On this case, see Lord Penzance in *Harrison* v. *Anderston Foundry Co.*, L. R. 1 App. Ca. p. 592.

(*r*) L. R. 1 App. Ca. 574; see, also, *Kynoch & Co.* v. *Webb*, 17 R. P. C. 100.

improvement, to place that before the public, and say, 'I have made a better machine. There is the sewing machine invented by So-and-so; I have improved upon that. That is mine; it is a much better machine than his.' That will not do; you must state clearly and distinctly what it is in which you say you have made an improvement. To use an illustration which was adopted, I think, by Lord Justice James in another case, (*s*) it will not do if you have invented the gridiron pendulum, to say, 'I have invented a better clock than anybody else,' not telling the public what you have done to make it better than any other clock which is known. That principle was laid down in *Foxwell* v. *Bostock*, and I do not think that anything further was intended to be determined in that case. It could not have been meant in that case to say that where that happens which well may happen, that a person arranging his machinery in a totally different way from the way in which it has ever been before arranged, although every single particle of that machinery is a well-known implement, produces an improved effect by his new arrangement, that new arrangement cannot be the subject of a patent. It may be that the levers may be perfectly well known in their mode of action, and it may be that all the other separate portions of the machinery to which the patent relates may be perfectly well known; but if he says, 'I take all these well-known parts, and I adjust them in a manner totally different from that in which they have ever before been adjusted; I have found out just what it is that has made these parts, though they may have been used in machinery, fail to produce their proper effect, and it is this, that they have not been properly arranged; I have therefore reconsidered the whole matter, and put all these several parts together in a mode in which they never were before arranged, and have produced an improved effect by doing so.' I apprehend it is competent to that man so to do, and that it would be perfectly impossible for him to say what is new and what is old, because *ex concessis* it is all old, nobody ever before used it in the manner in which he has used it. That, my lords, I apprehend, is the principle of a patent for a combination." (*t*)

A Bare Principle apart from a mode of applying it is not a Manufacture.—Extensive as the meaning is which the Courts have given to the word "manufacture," they have always held that there can be no patent for a bare principle apart from a mode of applying it.

(*s*) *Parkes* v. *Stevens*, L. R. 8 Eq. 365. B. 966; Macr. P. C. 48.
(*t*) See, also, *Tetley* v. *Easton*, 2 E. &

But a patent for a mode of applying a new principle or for a new mode of applying an old principle is good subject-matter.

In *Boulton* v. *Bull*, (*u*) an objection was taken that the patent was one for a principle and therefore bad; and all the judges agreed that if that were the true construction of the specification the patent would be void. Buller, J., said: "The very statement of what a principle is proves it not to be the ground for a patent. It is the first ground and rule for arts and sciences, or in other words, the elements and rudiments of them. A patent must be for some new production from those elements themselves." (*v*) "Undoubtedly there can be no patent for a mere principle," said Eyre, C.J., in the same case, "but for a principle so far embodied and connected with corporeal substances as to be in a condition to act, and to produce effects in any art, trade, mystery, or in manual occupation I think there may be a patent." (*w*)

In *R.* v. *Wheeler*, Abbott, C.J., said: "No merely philosophical or abstract principle can answer to the word 'manufacture.' Something of a corporeal and substantial nature, something that can be made by man from the matters subjected to his art and skill, or at the least some new mode of employing practically his art and skill, is requisite to satisfy this word." (*x*)

In *Jupe* v. *Pratt*, (*y*) Alderson, B., said: "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 the other modes of carrying the same principle into effect, that being treated by the jury as piracy of your original invention."

In *Neilson* v. *Harford*, (*z*) the inventor had discovered that the application of hot instead of cold air to the mixture of iron ore and fuel in the smelting of iron, produced a remarkable economy in the manufacture of the metal. He then devised a mode of

(*u*) 2 H. Bl. 463. See, also, *Hornblower* v. *Boulton*, 8 T. R. 101; *Forsyth* v. *Riviere*, 1 Carp. 401; 1 W. P. C. 97 *n.*

(*v*) 2 H. Bl. 485.

(*w*) Ibid. p. 496.

(*x*) 2 B. & Ald. 350.

(*y*) 1 W. P. C. 146. For other examples of patents granted for applied principles, see *R.* v. *Cutler*, 1 Starkie, 354; *Jones* v. *Pearce*, 1 W. P. C. 121; *Minter* v. *Wells*, 1 W. P. C. 127; *Walton* v. *Bateman*, 1 W. P. C. 620; *Newton* v. *Vaucher*, 21 L. J. Ex. 305; *Bovill* v. *Keyworth*, 7 E. & B. 725; *Hills* v. *London Gas Co.* 29 L. J. Ex. 409; 5 H. & N. 312; *Varey* v. *Walker*, 16 R. P. C. 596.

(*z*) 1 W. P. C. 295; 8 M & W. 806.

carrying out his idea, by which he heated the air in a closed vessel next the furnace, and applied it in the way required. A patent for that mode was held good subject-matter, and during its term he enjoyed a monopoly of the use of hot blast in the manufacture of iron. "I take the distinction," said Alderson, B., "between a patent for a principle and a patent which can be supported is, that you must have an embodiment of the principle in some practical mode described in the specification of carrying the principle into actual effect, and then you take out your patent, not for the principle, but for the mode of carrying the principle into effect. In *Watt's* patent, which comes the nearest to the present of any you can suggest, the real invention of Watt was that he discovered that by condensing steam in a separate vessel a great saving of fuel would be effected by keeping the steam cylinder as hot as possible, and applying the cooling process to the separate vessel, and keeping it as cool as possible, whereas before, the steam was condensed in the same vessel; Mr. Watt carried that practically into effect, by describing a mode which would effect the object." (*a*)

In *Household* v. *Neilson*, (*b*) the same propositions of law were tersely laid down by Hope, L.J.C., in the Court of Session. "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 within 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 without the application of it to human industry, or to the 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 great, 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."

In *Crossley* v. *Potter*, (*c*) the patent was for improvements in

(*a*) 1 W. P. C. 342. See *Jessel*, M.R., on this case in *Otto* v. *Linford* (46 L. T. (N. S.), 45), where he describes it as "one of the strongest illustrations" of a patent for an embodied principle.

(*b*) 1 W. P. C. p. 683.

(*c*) Macr. P. C. 240; 2 W. P. C. 245.

weaving figured fabrics. In his specification the patentee said, "My improvements in weaving figured fabrics apply to those particular kinds of fabrics which have a terry or raised looped surface, such as coach lace, Brussels carpeting, velvets, and other woven goods having terry or raised surfaces, either plain or figured, and consist in certain means of introducing and withdrawing the wires, etc." There was no evidence that any description of terried goods, except coach lace and one carpet, had ever been made under the patent. On the evidence, Pollock, C.B., doubted if the machine as described in the specification would make carpets or velvets. "The truth," said the learned Chief Baron, "appears to me to be this, that the patent is very much like what has been attempted, viz. to take out a patent for a principle, which the law will not allow. Any man who takes out a patent must take it for a manufacture. . . . Certainly the effect of all the evidence is, that, without additional parts, which are not described, the machine would certainly not be capable of making velvet goods, and I doubt whether it is capable of making carpet goods without a deal more than the specification contains; and the mention of carpets and velvets of all sorts in this specification appears to me to have had this for its object, to patent the principle. 'I have,' says the patentee, 'described that, in making coach lace, it is a beneficial thing to have two arms with wires attached to them, and going in succession, one after the other. I proclaim to the world that nobody shall apply that or anything like it, or any substitute whatever, in the making of either carpets, velvets, or any of the terry whatever.' A patent for an invention which is merely to obstruct every subsequent improvement, which is to step in and prevent the exercise of the energy of mankind, and the introduction of other inventions adapted to the particular subject to which the invention may be applicable—a patent which has for its object to snatch and grasp at everything in all directions which may possibly come within the general language the patentee may choose to adopt in his specification—a patent, the object of which is not to benefit the world by its communication, but to obstruct, by the very general character of the claims made for conferring peculiar privileges on the patentee; such a patent as that, in my judgment, cannot be supported."

In *Hills* v. *London Gas Company*, (*d*) the question of the validity of a patent for an applied principle was again discussed. Bramwell, B., said: "It is next said that the mere application of the

(*d*) 29 L. J. Ex. 409, p. 424; 5 H. & N. 312, p. 369.

hydrated oxides to absorb the sulphuretted hydrogen from the gas is not the subject of a patent, the property of it being well known previously. With that we do not agree, the answer to that is that the question here is not properly stated, that the application of hydrated oxide is the principle. If a man were to say, I claim the use of hydrated oxide of iron for the purification of coal gas without saying I did it, it is possible the objection might be well founded; but he says here, I claim it in the manufacture of gas, in the way I have described, and he shews how it may be made practically useful: therefore this objection fails."

In *Cannington* v. *Nuttall*, (*e*) it appeared that the only thing which the patentee regarded as a new discovery (apart from his apparatus) was the application of external air to the sides of a tank. On this Lord Westbury, C., said: "It was a discovery, certainly, but it was a thing for which, independently of the other apparatus, probably no patent could have been obtained. I may construct an apparatus, and may, in point of fact, make the merit and the benefit of that apparatus depend upon the application of some natural force or property which is perfectly well known; but my invention consists in the construction of the apparatus in such a manner as to bring the natural agency or power to bear upon and effect the object which I desire to effect, and that I do by means of an apparatus constructed so as to bring into action that natural power. If, for example, I avail myself of the well-known expansive force of steam, in order to effect a new object as a more beneficial result, and I introduce that by means of an apparatus constructed for the purpose of bringing this well-known expansive power into utility for my particular purpose, I have no right of invention in the discovery of that expansive force. My invention consists in the arrangement of the apparatus in order to receive that ordinary and well-known dynamic agent, and make it a fit instrument for effecting a new result. Here 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."

In *Otto* v. *Linford*, (*f*) the patent was for improvements in gas-motor engines. Gas-motor engines and the possibility of producing

(*e*) L. R. 5 H. of L. 205; 40 L. J. Ch. 739. (*f*) 46 L. T. (N. S.), 35.

motion by a series of explosions in a cylinder containing mixed gas and air, were already well known. But the suddenness of the explosions, and the great heat generated by them, prevented these machines from coming into extensive use. It occurred to the plaintiff that these difficulties might be successfully obviated by the insertion of a cushion of air between the combustible material and the piston, and he invented an arrangement of the machinery which carried out this object. When thus reduced to practice the plaintiff's idea proved correct; the suddenness of the explosions was successfully moderated, and gas-motor engines in consequence became largely used.

In an action brought by the inventor for infringement the defendants objected (*i.a.*) that this discovery was not subject-matter for a patent, but was only a principle. The Court of Appeal, however, held that the plaintiff shewed a mode of carrying his idea into effect, and that the patent was good. Jessel, M.R., said: "The first objection is that this is not the subject-matter of a patent, because it is said that that which is claimed is the principle or, as it is sometimes termed, the 'idea,' of putting a cushion of air between the explosive mixture and the piston of the gas-motor engine, so as to regulate, detain, or make gradual, what would otherwise be a sudden explosion. Of course that could not be patented. I do not read the patent so; I read the patent as being to the effect that the patentee tells us that that is the idea that he wishes to carry out; and he claims to carry it out by substantially one or the 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 shew 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."

So, too, in *Badische* v. *Levinstein*, (*g*) Fry, J., said: "A man cannot take out a patent for an idea, but he may take out a patent, if I may say so, for an idea coupled with a practical process of effectuating that idea." And in *Young* v. *Rosenthal*, (*h*) Grove, J., said: "It must be an invention of a manufacture, an invention of an idea or mathematical principle alone; mathematical formulæ or anything of that sort, could not be the subject of a patent. For instance, supposing a person discovered that three angles of a triangle are equal to two right angles,

(*g*) 24 C. D. 156; 2 R. P. C. 73. (*h*) 1 R. P. C. 30.

that is an abstract discovery and would not be the subject of a patent."

"You cannot," said Lord Halsbury, C., in *Pneumatic Tyre Company* v. *Tubeless Tyre, Ltd.*, "appropriate to yourself a mere principle; you can only appropriate the application of the principle." (*i*)

An Old Principle applied in a New Way is a Manufacture.—A patent for an applied principle being a patent rather for the application, or *modus operandi*, than the idea, it follows that even where the principle is old and well known a patent for a new and useful mode of applying it will be good. Thus, in *Hullett* v. *Hague*, (*j*) where the patent was for a mode of hastening the evaporation of sugar by driving cool air through the boiling liquid it was shewn that the idea was well known, and that a prior patent had been granted for a mode of carrying out the same principle. But the Court of King's Bench held that as the plaintiff's mode was distinct from that of the earlier patentee his patent was good, and he was entitled to a monopoly of the apparatus he described.

In *Cannington* v. *Nuttall*, (*k*) already noticed, where the patent was for a mode of utilizing the cooling properties of air in the manufacture of glass, Lord Hatherley, C., said: "It is quite apparent, my lords, that the cooling thing, the current of air, was nothing new—it is as old as the fables of Æsop—it is as old as the man blowing his soup in order to make it cool. But so it is with every new invention—the skill and ingenuity of the inventor are shewn in the application of well-known principles. Few things come to be well known now in the shape of new principles, but the object of an invention generally is the applying of well-known principles to the achievement of a practical result not yet achieved."

In *Dangerfield* v. *Jones*, (*l*) the patentee claimed as his invention a new and improved mode of bending wood for the handles of walking-sticks, etc. The improvement consisted in a novel way of applying heat to the wood intended to be bent, so as to soften the fibres. It was objected that the application of heat to the bending of wood was old, and that the invention was not subject-matter. The Court, however, refused to adopt this contention. Wood, V.C., said: "When it is said, as one of the witnesses had stated, that because wood is bent by coachmakers and others

(*i*) 16 R. P. C. p. 79; 15 T. L. R. 105.
(*j*) 2 B. & Ad. 378.
(*k*) L. R. 5 H. of L. 216; 40 L. J. Ch. 739.
(*l*) 13 L. T. (N. S.), 143.

in a variety of ways by the application of heat to wood, you cannot have a patent for the application of heat to the making or bending of walking-sticks, that is the same sort of reasoning which was pressed ineffectually upon the Court with reference to an invention for an improvement in navigation. (The screw propeller case.) (*m*) It was said that the operation of a propelling power by presenting a screw surface to the action of the water was nothing new; that a screw propeller was an instrument for advancing a ship in the water by presenting a screw surface to the water, and that it was like the action of a windmill with reference to the wind. That reasoning, however, did not succeed. 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."

In *Gadd* v. *The Mayor of Manchester*, (*n*) the patent was for the application to gasometers of a contrivance already known in connection with pontoons and floating docks. Alluding to the authors of those anticipations, Lindley, L.J., said: "They shewed the principle, but their attention was not turned to gasometers, and they did not shew how to apply the principle to them;" and the patent for this new application of the principle was held good by the Court of Appeal.

The Application of a known Machine to the Attainment of a New Result is a Manufacture.—In the *Adamant Stone and Paving Company* v. *Liverpool*, (*o*) one of the plaintiffs' patents was for improvements in the manufacture of slabs and blocks of cement. The invention consisted chiefly in the application of a filter press to expel the water; the result being a remarkable shortening of the time within which the artificial stone hardened and solidified. At the time the patent was taken out filter presses of various kinds were well known, and had been applied to a variety of purposes, but nobody had before applied a filter press to the production of stone or stone-like substance from cement. Moreover, considering the state of public knowledge at the date of the patent, invention was required to arrive at the plaintiffs' result. On these facts Romer, J., said: "As a matter of law I consider that in the case where various different machines of a certain general class or

(*m*) *Caldwell* v. *Vanvlissengen*, 21 L. J. Ch. 97; 9 Hare, 415; 16 Jur. 115.

(*n*) 9 R. P. C. 516; at p. 526.

(*o*) 14 R. P. C. 11.

character may be well known, if a person selects and applies one specially adapted for his 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 properly 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, and the case before me falls within that principle."

CHAPTER V.

NOVELTY OF THE INVENTION.

Why Novelty is Required.—An invention, to be valid subject-matter for a patent grant, must not only be a manufacture within the meaning of the Statute of James I., it must also be new. This condition, expressly enacted by the Statute of Monopolies, was also a condition imposed by the common law. (*a*) The principle underlying it is manifest. Every patent monopoly involves a temporary surrender of public right, which the Crown, as guardian of the public good, can only sanction where it is for the ultimate advantage of the community that the surrender should be made, *i.e.* where an adequate consideration is obtained in return. The law presumes that a new and useful invention is such a consideration. But, if the protected invention is not new, the patentee has nothing to bestow upon the public at the end of his patent term, and, therefore, the Crown, in such case, at the public expense, gives everything and receives nothing.

Hence a manufacture, the secret of which is already known to the public, either through the medium of description, exhibition,(*b*) or actual user, is not one in respect of which valid letters patent can be granted. Every inventor, therefore, who comes to the Crown for a grant of letters patent, comes representing that he is the discoverer of a new invention, and it is on the faith of such representation that he obtains his grant. If his invention in fact is old, the Crown has been deceived by a false representation; and, whether that representation has been made wilfully or not, the letters patent are void. "A petitioner for a patent," said Bacon, V.C., in *Murray* v. *Clayton*, "alleges to the Crown that he has made a new and useful discovery. As a just reward for such

(*a*) See *Hasting's Patent*, Noy, Rs. 182; *Matthey's Patent*, Noy, Rs. 178; *Humphrey's Patent*; Noy, Rs. 183; *Darcy* v. *Allin*, Noy, Rs. 182; *Clothworkers of Ipswich Case*, Godb. 254.

(*b*) As to publication at international and industrial exhibitions, see post, pp. 91, 92.

discovery, assuming the allegation to be true, the Crown grants him the exclusive use of his invention. If the allegation turns out to be untrue, the grant becomes void." (*c*)

The Novelty Required is the Novelty of all that is Claimed.—It is upon this ground of a fraud on the Crown that it has been held that the novelty must be the novelty of everything claimed by the patentee as his invention; so that if any essential part of what the grantee has represented to the Crown as being his invention is not new, the whole grant becomes void because of that false suggestion.

Thus, in *Huddart* v. *Grimshaw*, (*d*) Lord Ellenborough, C.J., said that if any part of that which was the substance of the invention had been communicated to the public, or was a known thing prior to the date of the patent, the patentee could not claim the benefit of his monopoly.

In *Hill* v. *Thompson*, (*e*) the letters patent were granted for an improved method or process of smelting and working iron. The improvement introduced by the plaintiff was obtaining iron from cinder and slag which formerly had been thrown away as refuse. This was apparently new. But the plaintiffs claimed, further, the merit of having discovered that the application of lime in certain stages of the process of iron manufacture, would cure a defect in the metal known as cold short, and that, too, whether the iron was made from slag or cinder, or from fresh ore. The application of lime to iron obtained from the cinder originally used in making the iron was, however, known and practised before.

The plaintiffs having obtained an injunction, Lord Eldon dissolved it; and, on motion to revive the injunction after a verdict obtained at the trial, Lord Eldon refused to make the order, pending the result of an application by the defendants for a new trial. The Lord Chancellor said: "Not only must the invention be novel and useful, and the specification intelligible, but also the specification must not attempt to cover more than that which, being both matter of actual discovery and of useful discovery, is the only proper subject for the protection of a patent. And I am compelled to add, that if a patentee seeks by his specification any more than he is strictly entitled to, his patent is thereby rendered ineffectual, even to the extent to which he would be otherwise

(*c*) L. R. 7 Ch. 574 *n*. See, also, *Hill* v. *Thompson*, 8 Taunt. p. 401; 1 W. P. C. p. 229; 3 Mer. 622; *Brunton* v. *Hawkes*, 4 B. & Ald. p. 555; *United Horse Nail Co.* v. *Stewart*, 2 R. P. C. p. 132.

(*d*) 1 Dav. P. C. 265; 1 W. P. C. 867.

(*e*) Supra.

fairly entitled. On the other hand, 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. But, in order to its being effectual, the specification must clearly express that it is in respect of such new combination or application, and of that only; and not lay claim to the merit of original invention in the use of the materials. If there be a patent both for a machine and for an improvement in the use of it, and it cannot be supported for the machine, although it might for the improvement merely, it is good for nothing altogether, on account of its attempting to cover too much."

When this case subsequently came before the Common Pleas, that Court non-suited the plaintiff. Dallas, J., said: "If any part of the alleged discovery, being a material part, fail (the discovery, in its entirety, forming one entire consideration), the patent is altogether void; and to this point, which is so clear, it is unnecessary to cite cases." (*f*)

The decision in the above cases was followed in *Brunton* v. *Hawkes*, (*g*) decided by the Court of King's Bench in 1821. In that case the plaintiff's patent was for improvements in the construction of ships' anchors and windlasses, and chain cables or moorings. The part of the invention relating to the anchor having been proved to be old, the Court held the whole grant void. Abbott, C.J., said: "It seems to me, therefore, that there is no novelty in that part of the invention as affects the anchor; and, if the patent had been taken out for that alone, I should have had no hesitation in declaring that it was 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-chains? 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 these 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 grant. 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 a party applies for a patent, reciting that he has discovered improvements in three

(*f*) 1 W. P. C. 249.

(*g*) 4 B. & Ald. 550; 1 Carp. 405.

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. . . . 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. The patent is granted upon the recital that he has made improvements upon 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 that 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. For these reasons I am of opinion that this patent cannot be supported."

In the later case of *Morgan* v. *Seaward*, the law was similarly laid down by Parke, B. "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 a 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 is maintainable upon it." (*h*)

Where, then, a patent is granted by the Crown on a representation by the grantee that he has discovered several distinct inventions or improvements relating to the same result, each invention claimed must be new, or the grant is bad for all.

In *Gibson* v. *Brand*, (*i*) the plaintiffs' patent had been taken out for "a new or improved process or manufacture of silk and silk in combination with certain other fibrous substances." In their claim the plaintiffs said, "We restrict our claims to the eight several heads of invention mentioned in the early part of this specification, all of which we believe to be new and of great public utility;" on this the Court of Common Pleas held that the

(*h*) 1 W. P. C. 196; 6 L. J. Ex. 158; 2 M. & W. 561. Cf. *Westrupp & Gibbin's Patents*, 1 W. P. C. 554.

(*i*) 1 W. P. C. 631; 11 L. J. C. P. 177.

plaintiffs could not sustain their patent unless they shewed that each one of the eight divisions of their process was new.

In *Gamble* v. *Kurtz*, (*j*) the patent was for "improvements in apparatus for the manufacture of sulphate of soda, muriatic acid, chlorine, and chlorides." The specification claimed (*i.a.*) "iron retorts worked in connection with each other as above described." This was construed by the Court to cover the peculiar form of retorts described (in this case two-chamber retorts with separate furnaces) as well as the mode of connecting them. The means of connection were new, but the retorts were old, and the patent was held bad.

In *Templeton* v. *Macfarlane*, (*k*) the same rule was applied by the Court of Session in Scotland. In that case the patent was taken out for "machinery for a new and improved mode of manufacturing silk, cotton, linen, and woollen fabrics." The specification claimed "the mode hereinbefore described of producing or preparing stripes of silk, cotton, woollen, or linen, or of a mixture of two or more of these materials, in such a manner that the weft or lateral fibres of both cut edges of each stripe are all brought up on one side, and into close contact with each other, and the re-weaving of such stripes with the whole fur or pile uppermost into the surfaces of carpets, etc." At the trial it was found that one of the processes in the mode claimed was old. The Lord Ordinary (Lord Robertson) ruled that this did not avoid the patent. On this ruling a bill of exceptions was presented to the Inner House by the defenders and allowed. The pursuer appealed to the House of Lords, but the House held that the Court of Session were right, and that want of novelty in one of the processes of the mode claimed avoided the patent. "The judge at the trial," said Lord Cottenham, "mistook the law in supposing it to be immaterial whether all the invention, or only part of it, was new." (*l*)

In *McCormick* v. *Gray*, the patent was for improvements in agricultural machines. The plaintiff claimed protection for three parts of his machine, viz. holding-fingers, cutting-blades, and gathering-reels. It was proved by a prior publication that the holding-fingers and cutting-blades were not new. The Court of Exchequer held the patent void. Pollock, C.B., said: "I agree that what the plaintiff claims is no novelty, since a portion of it was anticipated in the year 1845, and that the plaintiff should

(*j*) 3 C. B. 432.
(*k*) 1 H. of L. Ca. 595. See, also, *Dobbs* v. *Penn*, 3 Ex. 427.
(*l*) 1 H. of L. Ca. p. 604.

have restricted his claim to a combination of the three materials forming his machine, and not have claimed each of them." (*m*)

In *Roberts* v. *Heywood*, (*n*) the patent was for an "improved machine for painting laths for Venetian blinds and for other purposes." Besides claiming the general combination the patent claimed protection for eight several parts. The eighth claim was for a shallow sliding tray, arranged and used substantially in the manner and for the purpose described. This tray was not new, and it was objected that the patent was therefore void. Hall, V.C., said: "I think it impossible, having regard to the eighth claim, to say that this is a new invention; and, having tried in every way to construe it as subsidiary, and not a distinct claim, I cannot come to such a conclusion," and the patent was accordingly held void.

In *Haslam* v. *Hall*, (*o*) the plaintiff's patent was for "improvements in refrigerating processes and apparatus for preserving meat or other food or beverages." There were three claims. By his second claim the patentee claimed the combination together of a steam-engine, and of an air-compressing and air-expansion apparatus in the improved manner described. The first and third claims were new and useful, but the second claim had been anticipated by a prior machine, and the patent was therefore held void.

Want of Novelty in a Subsidiary Claim need not Defeat a Patent.—Upon the rule illustrated in the foregoing cases the Courts have, however, grafted an exception in favour of a claim which can be shewn to be subsidiary to the main invention, and to be claimed only in relation thereto. Want of novelty in such a claim need not avoid a patent.

Thus, in *Plimpton* v. *Spiller* (*p*) the patentee claimed: (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 proved that the second claim was not new, and the defendants contended that the patent was therefore void. But Jessel, M.R., refused to adopt this construction, and held the

(*m*) 7 H. & N. p. 35; 31 L. J. Ex. 42.
(*n*) 27 W. R. 454.
(*o*) 5 R. P. C. 1. See, also, *Murchland* v. *Nicholson*, 10 R. P. C. 417; *Pether* v. *Shaw*, 10 R. P. C. 297.
(*p*) L. R. 6 C. D. p. 428; 47 L. J. Ch. 211.

second claim to be a merely subsidiary claim covering something to be used only in connection with the principal invention. On appeal this decision was affirmed. (*q*) James, L.J., after stating the second claim, said: "It appears to me that in doing that he is claiming, not a distinct and substantial invention, but he is claiming it as one of the merits and advantages of the entire construction which he has before given, and he is not in any way pretending or claiming to enlarge his monopoly; because, of course, it was a novelty so far as Plimpton's skates were novel, and he is only applying an old thing to an entirely new thing. When the new thing ceases to be patented that old thing will cease to be patented too; so that there is no pretence really for saying that he is endeavouring to obtain under the colour of that second claim something other and beyond that which the invention itself purports to be, that is to say, an invention for making a rocking skate in the manner which he has described in the first part." Brett, L.J., while adopting the same construction of this claim as subsidiary, said: "At the same time, I think it cannot be denied that if a really independent claim of something which is not new, however inadvertently or carelessly it be made, is, in fact, made on the face of the patent, the Court is bound to hold that the patent is therefore objectionable, and that the plaintiff cannot succeed. If this second claim had been in a form which would have applied to the runner of any other skate than that which is patented here, I should have thought it would have been bad, and that therefore the whole patent would have been bad, and that this plaintiff could never recover." (*r*)

A similar construction was adopted by the House of Lords in the *British Dynamite Company* v. *Krebs*. (*s*) In that case the patentee claimed, not only the mode of manufacturing dynamite, but also "the modes of firing the same by special ignition" set forth in the specification. These, or some of them, were known at the date of the patent, and it was contended in consequence that the patent was bad. In rejecting this contention on the ground that the means of explosion were not claimed in *gross* but only as appendant to dynamite, Lord Cairns said: "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

(*q*) L. R. 6 C. D. pp. 428, 433.
(*r*) See also *Dowler* v. *Keeling*, 14 T. L. R. 257; 15 R. P. C. 214.
(*s*) Goodeve, P. C. p. 93; 13 R. P. C. p. 193.

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 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 understand him to claim these means of explosion only as part and parcel of this invention."

Novelty in a Combination.—Where the patent is for a combination the novelty is the combination, and if that be new, it matters not that the component parts are old. In *Harrison* v. *The Anderston Foundry Company*, Lord Cairns, C., said: "If there is a patent for a combination the combination itself is, *ex necessitate*, the novelty." (*t*)

In *Newton* v. *Grand Junction Railway*, Pollock, C.B., said: "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." (*u*)

In *Cannington* v. *Nuttall*, Lord Hatherley, C., thus laid down the test of novelty in a combination. "I take it the test of novelty is this; is the product which is the result of the apparatus for which an inventor claims letters patent effectively obtained by means of your new apparatus, whereas it had never before been effectively obtained by any of the separate portions of the apparatus which you have now combined into one valuable whole for the purpose of effecting the object you have in view?" (*v*)

New, means New within the Realm.—"New," means new within the realm. Therefore prior user or prior publication abroad, *e.g.* in France, will not defeat a patent in England for an invention new within the Kingdom. It was at one time doubted whether or not this rule did not apply to user of a patent in Scotland as well as in foreign countries. But in *Brown* v. *Annandale*, (*w*) it was decided that a patent could not be taken out in England for an invention already known in Scotland. In *Rocbuck* v. *Stirling*, (*x*) it had already been decided in the House of Lords that a Scottish patent for an invention known in England was bad.

It has been held, however, that "the realm" for the purposes of the Statute of Monopolies does not include such of her Majesty's

(*t*) 1 App. Ca. p. 578.
(*u*) 5 Ex. 334.
(*v*) L. R. 5 H. of L. 216; 40 L. J. Ch. 739.
(*w*) 1 W. P. C. 433; 8 Cl. & F. 437.
(*x*) 1 W. P. C. 45.

colonies as have statutory powers to grant patents within their own boundaries. Thus in the case of *Rolls* v. *Isaacs*, (*y*) Bacon, V.C., held that it was no defence to an action for infringement of an English patent to adduce evidence to shew that the invention prior to the date of the grant had been in use in the colony of Natal. Referring to the representation by the patentee that he was the true and first inventor, the learned Vice-Chancellor said that the Crown will not look whether that statement is strictly true. "That is not a matter to be enquired into. The only thing that the Crown desires to be informed of is, whether the invention has been used in this realm. Where an invention is communicated by a foreigner to an Englishman, if it should be proved that it has been used in all the other regions of the world, but never here before, the invention may be the subject of a valid patent, and there is no kind of objection to it." (*z*)

(*y*) L. R. 19 C. D. 268; 45 L. T. (N. S.), 704. (*z*) L. R. 19 C. D. p. 275.

CHAPTER VI.

ANTICIPATION BY PRIOR PUBLICATION.

Common Knowledge not necessary.—Novelty being essential, the publication of an invention anywhere within the United Kingdom will avoid letters patent subsequently granted in respect of that invention. Thus, no invention already described in a book, paper, specification or drawing to which the public have had access, or which has been publicly performed or exhibited, so that others have learned the secret of performing it, is lawful subject-matter for a patent grant. Such prior description or exhibition is *ipso facto* a dedication to the public and avoids that consideration for a subsequent patent which must be presumed in every valid grant. Nor is it material to shew that any person has in fact made the article in question from such description, or that the subsequent patentee borrowed his invention therefrom or even knew of its existence. Such publication is presumed to have acquainted the public with the secret of the invention, and no subsequent monopoly can lawfully deprive them of the right to put that knowledge into practice.

To establish prior publication it is not necessary to prove common knowledge; public knowledge is sufficient, whether the invention be known to many or few. "It is admitted," said Lindley, L.J., in *Savage* v. *Harris*, (*a*) "that his specification was published in this country and was matter of public knowledge and public property, although very likely not of common knowledge, the difference between the two being obvious. There may be a publication which is quite sufficient to invalidate a subsequent patent, and there may be very few people who know of that publication, so that you cannot say that the publication is a matter of common knowledge, however truly you may say that it is a matter of public knowledge."

(*a*) 13 R. P. C. 367.

In *Humpherson* v. *Syer*, Bowen, L.J., defined prior publication as follows: "That is, in other words, had this information been communicated to any member of the public who was free in law or equity to use it as he pleased?" (*b*) Whether there has been publication or not is a question of fact. "Each case must depend upon its own circumstances; and 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." (*c*)

Publication in a Book or Specification.—In *Hill* v. *Thompson*, (*d*) the publication of the patentee's alleged invention in a dictionary in England nine years before the date of the patent was held fatal to the grant.

In *Westrupp and Gibbin's Patent*, (*e*) the Privy Council refused to recommend a confirmation of a patent when a material part of the invention had been published in a well-known book some years before, (*f*) and was likewise covered by two earlier specifications.

"If," said Lord Lyndhurst in *Household* v. *Neilson*, (*g*) "the machine is published in a book, distinctly and clearly described, corresponding with the description in the specification of the patent, though it has never been actually worked, is not that an answer to the patent? It is continually the practice on trials for patents to read out of printed books without reference to anything that has been done." "It negatives being the true and first inventor," said Lord Brougham, "which is as good as negativing the non-user. It must not be a foreign book, but published in England." (*h*)

The law was similarly laid down by Tindal, C.J., in *Stead* v. *Williams* (*i*): "If the invention has already been made public in England by a description contained in a work, whether written or printed, which has been publicly circulated, in such case the patentee is not the first and true inventor within the meaning of the Statute, whether he has himself borrowed his invention from

(*b*) 4 R. P. C. 407.

(*c*) *Per* Lord Halsbury, C., in *Pickard* v. *Prescott*, 9 R. P. C. p. 200. See, also, Tindal, C.J., in *Stead* v. *Williams*, 2 W. P. C. 143; 7 M. & G. 818; Lindley, L.J., in *Lyon* v. *Goddard*, 9 R. P. C. 527.

(*d*) 1 W. P. C. 229; 8 Taunt. 375; 3 Mer. 622; 2 B. Moo. 433.

(*e*) 1 W. P. C. 554.

(*f*) See, also, *Jablochkoff's Patent*, 8 R. P. C. 281.

(*g*) 1 W. P. C. 718.

(*h*) Cf. *Stocker* v. *Warner*, 1 C. B. 167.

(*i*) 2 W. P. C. 142. See, also, *Stead* v. *Anderson*, 2 W. P. C. 150; 16 L. J. C. P. 250.

such publication or not; because we think the public cannot be precluded from the right of using such information as they were already possessed of at the time of the patent being granted."

It is not necessary to shew that the patentee learnt his invention from the prior publication, said Lindley, L.J., in *Harris* v. *Rothwell.* "It is sufficient to shew that the invention was so described in some book or document in this country as that some English people may have been fairly supposed to have known it." (*j*)

Where the publication alleged is contained in a prior specification, it is for the Court to construe such specification and say whether or not in fact it contains a prior disclosure of the invention.

In *Booth* v. *Kennard,* (*k*) where such publication was alleged against the patentee, Pollock, C.B., said: "We think it is a question as to the plain meaning of a written document, and we think it is for the Court to construe it." So, likewise, in *Bush* v. *Fox,* (*l*) it was held that when the want of novelty was apparent from matters contained in a document or written instrument, such as a prior patent and specification, it was for the Court to take notice of the identity of the two supposed inventions, and the want of novelty, therefore, in the second.

Publication in a Foreign Book.—Nor does it make any difference that the work or specification in which the prior description has appeared, has been published in a foreign country, (*m*) provided copies have been transmitted to England and sold, or otherwise put in circulation. It is not indeed necessary to prove that any copy has actually been sold. It is sufficient to avoid a subsequent patent for the invention so described, if the book has been publicly exposed for sale, or if the specification has been made public in this country.

In *Lang* v. *Gisborne,* (*n*) Lord Romilly, M.R., said: "A publication takes place when a person who is the inventor of any new discovery, either by himself or by his agents, makes a written description of that, prints it in a book, and sends it to a bookseller to be published in this country. It is not at all necessary to

(*j*) L. R. 35 C. D. 428; 56 L. J. Ch. 459; 4 R. P. C. 225.

(*k*) 1 H. & N. 527; 2 H. & N. 84; 26 L. J. Ex. 23, 305.

(*l*) 5 H. of L. 707; 25 L. J. Ex. 251.

(*m*) *Heurteloupe's Patent,* 1 W. P. C. 553; *McCormick* v. *Gray,* 7 H. & N. 28; 31 L. J. Ex. 42; *Pickard* v. *Prescott,* 7 R. P. C. 361; *British Tanning Co.* v. *Groth,* 8 R. P. C. 121; *United Telephone Co.* v. *Harrison,* 21 C. D. 720; 51 L. J. Ch. 705; *Harris* v. *Rothwell,* 35 C. D. 412.

(*n*) 31 L. J. Ch. 770; 31 Beav. 133.

establish the fact that one volume of that book has been sold; as soon as an inventor informs the public of what his invention is, and publishes that in a book, which he sends to a publisher to sell, the moment that book is exposed in the shop for the purpose of purchase, then that becomes a complete publication in point of law. That would be the effect if it were the publication of a book in England by an English inventor, and there is no difference when the inventor is a Frenchman, or any other foreigner, who publishes a book in his own language, but sends it over to a bookseller in this country for the purpose of being sold. As soon as the book comes to this country to be sold, and is offered for sale in the public shop of a bookseller, then that becomes a publication of the invention, assuming it to be a clear and accurate description of the invention in question. It would be impossible to arrive at any other result without producing the most inextricable difficulties in law. It would be difficult to ascertain how many persons had bought the book, though the purchase of the book would be nothing if they had not read the contents. It would be impossible to say to how many persons the purchaser had lent it, who had read it. In the present case it has been proved that a public library in one of the large universities in England had actually bought the book. It may be that a thousand persons had read it before this invention had taken place, but how can that by any possibility be proved? The Courts would be involved in inextricable difficulty if the burthen of proof were thrown on a person who had made public an invention as far as he was able to make it public, to shew that the public themselves had appreciated it by buying the book, or making it common to other persons."

In *Pickard* v. *Prescott*, (*o*) it was proved that a description of the invention—an improvement in the bridges of pince-nez, or double eye-glasses—had been published prior to the date of the patent, in a French monthly journal, copies of which were sold to two public institutions and three private individuals in the United Kingdom. The House of Lords, affirming the decision of the Inner House of the Court of Session, held this a sufficient publication to defeat the patent. In such case there is a strong presumption that the public journal in which the description is contained has reached its subscribers within a reasonable time after the date of publication; and, although no evidence may be obtainable that the contents of the journal have, in fact, been read by the recipients, the Court will assume this until the contrary is shewn.

(*o*) 7 R. P. C. 366.

"But then," said Lord Halsbury, C., in the above case, "it is said that *Dr. Berry* cannot tell us that he did read it. Of course he cannot. I would not believe him if he could. Nobody, unless it is a very exceptional man, can bring his memory back, after the lapse of years, sufficiently to be able to say: 'At that particular time I read such and such a thing.' The ordinary common sense of mankind naturally leads one to the conclusion, I should say, that, taking the fact that this is a monthly publication intended to give information on the subject in which its subscribers and readers are interested at the time when it is published, and, taking the fact that it is published, not merely once every year, but once every month, because it is intended to give people the current information upon the subject, *Dr. Berry* probably did read it within a reasonably short time after he received it." (*p*)

Publication in a Foreign Language.—Though a stronger inference of publication arises where the prior description is in the English language, (*q*) a prior description in any language known to persons in England is sufficient.

In *Lang* v. *Gisborne* and *Pickard* v. *Prescott*, the prior publication was in French; in the *United Telephone Company* v. *Harrison, Cox-Walker and Company* (*r*) and in *Harris* v. *Rothwell* (*s*) it was in German.

In the last-mentioned case the plaintiff's patent had been taken out in this country in April, 1880. It was proved that the same invention had been the subject of prior patents in Germany, and that specifications in the German language, with drawings attached, had been deposited in the public library of the Patent Office in December, 1878, and February, 1880, respectively, and that the journal then published periodically by the Patent Commissioners contained amongst the list of patents granted in Germany entries of these particular patents, with a note in each case that the specifications as well as the list of applications might be consulted in the free public library of the office. It was not actually proved that any one other than the librarian had seen the specifications. Commenting on this evidence, Lindley, L.J., said: "It is necessary next to consider the effect, if any, of these specifications being in German and not in English. The fact that German is understood by many people in this country, and that persons who can read and translate German can easily be found by those who want their

(*p*) [1892] A. C. 263; 9 R. P. C. 203.
(*q*) *Harris* v. *Rothwell*, 35 C. D. 412. See Lindley, L.J., p. 428.
(*r*) L. R. 21 C. D. 720; 51 L. J. Ch. 705.
(*s*) Supra.

assistance, must, we think, be treated as common knowledge, and be judicially noticed, although not stated in the special case. . . . The conclusion at which we have arrived, and which in our opinion is most in accordance with the authorities and with the principles that underlie them, may be thus expressed. *Primâ facie* a patentee is not the first inventor of his patented invention if it be proved that before the date of his patent an intelligible description of his invention, either in English or in any other language commonly known in this country, was known to exist in this country, either in the Patent Office or in any other library to which the public are admitted, and to which persons in search of information on the subject to which the patent relates would naturally go for information. But if, as in *Plimpton* v. *Malcolmson* and *Plimpton* v. *Spiller* and in *Otto* v. *Steel*, it be proved that the foreign publication, although in a public library, was not in fact known to be there, the unknown existence of the publication in this country is not fatal to the patent." (*t*)

No Publication where Book not Accessible to the Public.—It is apparent from the above case that although the Court will usually infer upon proof of publication in this country of even a single work containing a prior description of an invention, that such description has disclosed that invention to some member of the public, it is nevertheless open to any patentee to rebut that inference by shewing affirmatively that no member of the public has in fact had access to the work in question.

In *Plimpton* v. *Malcolmson*, (*u*) it was proved that a prior patent had been taken out in America for an invention similar to that claimed by the patentee. This patent was described in an American book, a copy of which had been sent to the Patent Office Museum in this country a month prior to the date of the plaintiff's patent. The assistant librarian had marked inside the book the date of its arrival; but it had neither been entered in the list of donation books nor in the catalogue. Not being a book of sufficient importance to have a place in the public room, it was placed in a small private apartment. There was no evidence that any one at the Patent Office knew the book was there. From these facts Jessel, M.R., drew the inference that the book had remained in the private room untouched, unread, and unlooked at for ten years. "It does appear to me, sitting as a jury," said his lordship, "that I should be wanting in common-sense if I came to the conclusion that the existence of this book on the shelf in a private room in the

(*t*) 35 C. D. pp. 429, 431.

(*u*) 3 C. D. 531.

Patent Library—private in the sense of not being accessible to the public, though public in the sense that if any one had actually known of it he could have sent for the book—would be such a publication as to deprive the man who first made it known to the world of that merit—the only merit so far as the importer is concerned—which consists in making known a useful invention to the public. Therefore, on the question of novelty, I should give a verdict for the plaintiff on this ground alone." (*v*)

The same patent again came before the Court in the subsequent case of *Plimpton* v. *Spiller*. Further evidence had been obtained, which shewed that the book in question had been placed on the top shelf of a corridor of the Patent Library through which the public passed. So placed, any member of the public might have taken it down and looked at it. But there was no evidence that any one had done so. The previous evidence as to the book not being entered in the catalogue or in the donation list was not varied. Jessel, M.R., again gave judgment for the plaintiff, and was affirmed by the Court of Appeal.

"It must be not only printed in a book," said Brett, L.J., "but that book must be placed in such a position and so used that you may fairly infer or assume that the contents of the book have become known to a sufficient number of persons. Therefore, when you prove that this book was put in the Patent Library, I care not into what part, I do not say that is no evidence of its having become known to the public, but I say that when you have other facts which shew that although it was put into the Patent Library the proper inference is that nobody ever did see it there or elsewhere, then, although it has been in one sense if you please published, or in one sense if you please dedicated to the public, all I can say is that the public have not been able to take advantage of the dedication or the publication, and therefore you do not shew that it was known to the public." (*w*)

In *Otto* v. *Steel*, an attempt was made to upset the plaintiff's patent, by proving that a description of the invention was contained in a French book, of which a single copy had been sent to this country, and placed in an inner room of the British Museum. To this room the public had not general free access, but persons desiring so to do were allowed on application to inspect the titles of the books it contained, and remove them, if wanted, to the reading-room for use. The book in question was entered in the general catalogue under the author's name only, and in a special

(*v*) L. R. 3 C. D. p. 566. (*w*) L. R. 6 C. D. 412, p. 435.

French catalogue under author and subject. An English bookseller had ordered a large number of copies of this French catalogue, and sent them to his customers. But there was no evidence of any customer having ordered the book, and none of a reader in the British Museum having read it there. On these facts, Pearson, J., said: "I feel myself unable to accept this book. The question is whether or not this book has been published in this country in such a way as to become part of the public stock of knowledge in this country. It is not, to my mind, necessary for that purpose to shew that it has been read by a great number of people, or that any person in particular has got from it the exact information which it is said would have enabled *Dr. Otto* in this case to have made his machine. But, to my mind, it must be published in such a way as that there may be reasonable probability that any person, and amongst such persons, *Dr. Otto*, might have obtained that knowledge from it." (*x*)

Meeting the suggestion that proof that a book containing a description of the invention was in the library of the British Museum, must amount in law to publication, the learned judge said: "There is no decision, to my mind, that lays down such a proposition as that, and I cannot help thinking that I should be doing injustice probably to many persons if I were to say that inventions honestly made by them were to be held bad because they might have been anticipated by something to be found in a book in the library, for which nobody had ever called, and which nobody had ever read in this country. I cannot go so far as that." (*y*)

Limited Publication may be Sufficient.—With the foregoing cases may usefully be compared others in which the publication, though apparently slight, has been held to be sufficient to defeat a subsequent patent.

In the *United Telephone Company* v. *Harrison, Cox-Walker & Company*, (*z*) the plaintiffs were the assignees of two patents for the transmission and reproduction of sound by electricity. The defendants objected as to one of the patents that it was not new, on the ground that before it was taken out a similar invention had been described, with drawings, in a German scientific journal published at Berlin in 1862. Of this journal a copy had been in the Library of the Institute of Civil Engineers at Westminster for

(*x*) L. R. 31 C. D. p. 243; 3 R. P. C. p. 112.

(*y*) L. R. 31 C. D. p. 246.

(*z*) L. R. 21 C. D. p. 720; 51 L. J. Ch 705; W. N. 1882-84. Cf. *United Horseshoe Nail Co.* v. *Stewart*, 2 R. P. C. 122.

seventeen or eighteen years. The institute numbered from three to four thousand members. A copy of the journal had also been placed in the Patent Office library. A telegraphic engineer was called who gave evidence that he had seen, prior to the date of the plaintiff's patent, the copy of this journal which was in the Patent Office library; he could not read German, but he had been able to comprehend the invention by means of the drawings attached to the letterpress. On these facts, Fry, J. (though with some doubt), held that this amounted to publication and avoided the patent if the prior description covered the invention. (*a*)

Prior publication was also discussed in *Harris* v. *Rothwell*, (*b*) with special reference to the question of onus of proof. There the facts, as set out in a special case, were as follows. Prior to the date of the plaintiff's patent there existed in the library of the Patent Office two copies of two German specifications, each of which, with the drawings annexed to it, contained a description of the plaintiff's invention. Of these specifications one had been in the library more than a year, the other about six weeks. The presence of these German specifications in the library was known to the librarian, and attention had been called to the fact by the publication of English translations of their titles in the *Patent Commissioners' Journal;* moreover, the specifications themselves were in their proper places in the library, and anybody wanting to see them could have done so. Whether any person except the librarian had in fact ever seen them was not known. From these facts the Court of Appeal held that the proper inference was publication. Lindley, L.J., delivering the judgment of himself and Cotton, L.J., said: "It appears to us that on this evidence the burden of shewing that the English patentee was the first inventor in this country of his invention is again cast upon the plaintiffs, and that unless they can shew that the German specifications were not in fact seen by any one who could understand them the defendant is entitled to succeed. If the case were being tried by a jury . . . we are clearly of opinion that the judge ought at least to tell the jury to find for the defendant on the issue that the plaintiff was the true and first inventor, if they thought that the German specification had been so published in this country as to have become known to any one here, and to guide the jury on this point the judge ought to tell the jury that the invention

(*a*) But in this case the patent was upheld on the ground that the German invention was a different invention from that of the plaintiffs.

(*b*) L. R. 35 C. D. 416, at p. 427; 4 R. P. C. 225; 56 L. J. Ch. 459.

having been laid before the public in this country in the way and for the time mentioned in the special case, the invention ought to be presumed to have become known in this country in the absence of all proof to the contrary." (*c*)

What Degree of Knowledge is required in a Prior Publication.—Where a patent is attacked as wanting in novelty on account of a prior dedication to the public by means of a book, writing, or specification, it is open to the patentee, besides contending that the public have not, in fact, had access to such publication, to shew that even if they must be presumed to have had such access, the degree of knowledge thereby communicated is not such as to amount to a prior disclosure of his invention. It is, therefore, important to ascertain what amount of disclosure is necessary to invalidate a subsequent patent for the same invention. It is now well settled that the prior publication must be definite; "a vague notion floating in the air" will not do. (*d*)

"If a mere suggestion is made," said Lord Coleridge, C.J., in the *American Braided Wire Company* v. *Thomson*, "upon which the mind of an inventor has to work, and out of which the mind of the inventor produces something new which is different from, an improvement upon, and a distinct variation from the suggestion, I apprehend the fact that it has been suggested by the reading of a specification or by looking at the drawings of a specification, will not prevent his having a right to patent his invention. I suppose that all patents almost are suggested by something. It very seldom comes into the head of any man to do a thing without something or other suggesting the idea to him to do it—some physical fact, I mean, or some piece of observation. That, therefore, alone would not be sufficient." (*e*)

In *Thomson* v. *Batty*, (*f*) the plaintiff's patent was for improvements in the marine compass and the means of ascertaining and correcting its errors. It was urged for the defendants that the patent was bad for want of novelty, because the patentee two years before the date of his grant had pointed out, in a paper read to the British Association, and afterwards published in the *Philosophical Magazine*, the result he now obtained as a desideratum in science. But Kekewich, J., held that this did not amount to prior publication, on the ground that it is no anticipation of a

(*c*) In this case Lopes, L.J., was of opinion that the German specifications (in the circumstances) amounted to conclusive evidence of publication, L. R. 35 C. D. p. 431. Cf. *Humpherson* v. *Syer*, 4 R. P. C. 415.

(*d*) Per Bacon, V.C., in *Washburn* v. *Patterson*, 1 R. P. C. 157, p. 161.

(*e*) 5 R. P. C. 120.

(*f*) 6 R. P. C. 99.

patent for the patentee to intimate to the world at large before he takes out his letters patent that the attainment of a certain result is desirable, when he does not intimate at the same time the means of attaining that result.

Thus the outline sketch contained in a provisional specification has been held insufficient to establish publication. (*g*) For the description must be such a description as will work in practice without the exercise of further invention on the part of the person following the directions in the description, whether in a book or specification.

In *Betts* v. *Menzies*, (*h*) Wood, V.C., said: "I think that if a man sits down and takes out a patent from his own conjectures without ever having tried the experiment set forth in it, that will not invalidate a subsequent patent taken out and practically worked, especially when it turns out that the method prescribed by the earlier patent is practically useless. Take, for instance, the electric telegraph. Many ingenious persons had talked of the means of communicating between two places by electricity, and had discussed the mode of carrying out that idea before Messrs. *Wheatstone* and *Cooke* shewed a practically useful way of doing it." After referring to the Marquis of Worcester's book, "A Century of Inventions," and the many patents taken out from hints obtained from it, the learned Vice-Chancellor proceeded, "Such a publication as that will not suffice to invalidate a subsequent patent which is capable of being actually worked to a useful purpose."

Dealing with the amount of information which a paper anticipation must contain to invalidate a subsequent patent, Lord Westbury, in his well-known judgment in *Hills* v. *Evans*, (*i*) said: "Now, with regard to the specification of the prior patent it is not to be distinguished in principle from any other publication. The only peculiarity attending the specification of the prior patent is this, that the specification must be considered as a publication. There has been some doubt with regard to books and documents under particular circumstances, whether they can be considered as amounting to a publication. With regard to a specification there can be no doubt, because the specification is that which the patentee gives to the public, and makes matter *publici juris* in return for the privilege which he receives; but upon all principles

(*g*) *Stoner* v. *Todd*, 4 C. D. pp. 58–61. But see *Lawrence* v. *Perry*, 2 R. P. C., p. 187.

(*h*) 3 Jur. (N. S.), 358.

(*i*) 4 De G. F. & J. 289; 8 Jur. (N. S.), 528.

the specification is not to be distinguished from any prior publication contained in a book published in the ordinary manner. Now, the question is, What must be the nature of the antecedent statement? I apprehend the principle is correctly thus expressed: 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 again, "There is not, I think, any other general answer that can be given to this question than this: that 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 shewn 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 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 pure metal which is extracted from it. Again, it is not, in my opinion, true in these cases to say that knowledge, and the means of obtaining knowledge, are the same. There is a great difference between them. To carry me to the place at which I wish to arrive is very different from merely putting me on the road that leads to it. There may be a latent truth in the words of a former writer, not known even to the writer himself; and it would be unreasonable to say that there is no merit in discovering and unfolding it to the world. Upon principle, therefore, I conclude that the prior knowledge of an invention to avoid a patent must be knowledge equal to that required to be given by a patent, namely, such knowledge as will enable the public to perceive the very discovery, and to carry the invention into practical use; and this appears to be consistent with the decided cases."

Applying the rules above laid down to the case before him,

his lordship proceeded: "There is here what I have denominated apparent generality, giving no specific knowledge, no practical rule of application, but furnishing suggestions which might give a direction to inquiry, from which inquiry a specific definite amount of practical information might possibly be elicited. That unquestionably, according to the rules which we have endeavoured to ascertain, is not such information as will vitiate a subsequent patent; for it is not such information as will be sufficient to support a patent. It adds nothing to the real stock of practical knowledge of mankind, and ought not to derogate from the validity and benefit of a subsequent invention." (*j*)

"We know what is necessary," said Cotton, L.J., in *Ehrlich* v. *Ihlee*, "if there is to be an anticipation, not by the existence of an actual thing, but by description either in a specification or otherwise; that the description must be of such a character as to enable any one competent to make the machine for which the protection is claimed from the description given." (*k*)

A prior publication to defeat a subsequent patent must, then, sufficiently impart the mode of carrying out the invention, to enable any one working upon the information conveyed from such previous specification, to reckon with confidence on the result. (*l*)

In *Betts* v. *Neilson*, (*m*) Lord Chelmsford said: "I entirely agree with the opinion of Williams, J., in the case of *Betts* v. *Menzies* in the Exchequer Chamber, that the publication of a notion that a certain useful art may be discovered without any information or knowledge of the means of the discovery, cannot preclude a subsequent first inventor of those means from taking out a patent for the entire art." And in *Patterson* v. *The Gaslight and Coke Company*, (*n*) Lord Blackburn, adopting the words of Lord Westbury, (*o*) said: "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."

The law applicable to paper anticipations was again considered by the Court of Appeal in the *Cassell Gold Company* v. *Cyanide*

(*j*) This judgment was quoted with approval, and followed by Lord Chelmsford, C., in *Betts* v. *Neilson*, L. R. 3 Ch. 431; and by the Court of Appeal in *Savage* v. *Harris*, 13 R. P. C. 368.

(*k*) 5 R. P. C. 437. See, also, *Otto* v. *Linford*, 46 L. T. (N. S.), 39; *Shrewsbury* v. *Sterckx*, 13 R. P. C. 53.

(*l*) Per Lord Chelmsford in *Betts* v. *Neilson*, L. R. 3 Ch. p. 435.

(*m*) Ibid. p. 432.

(*n*) 3 App. Ca. 239, p. 245.

(*o*) *Betts* v. *Menzies*, 10 H. of L. C. p. 154.

Gold Syndicate. Smith, L.J., in that case said: "To constitute a paper anticipation the description in the prior specification must be such that a person skilled in the matter reading it would find in it the invention which is sought to be protected by the patent, and unless this can be found in the writing itself it is not an anticipation at all. In our judgment, 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 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 or more has failed to do so, for, as stated by Professor Mills, there are any number of cases known in chemistry where two things when put together act very differently from what they do apart." (*p*)

In *Stoner* v. *Todd*, (*q*) Jessel, M.R., said that no prior publication was sufficient which did not enable a workman of ordinary skill in the subject-matter of the invention to perform it. Lord Westbury, in *Hills* v. *Evans*, took a similar view. This, however, cannot now be regarded as a correct exposition of the law, the House of Lords having laid down a different rule in the *Anglo-American Brush Electric Light Company* v. *King, Brown & Company*. (*r*) The question there was whether a specification of one *Varley* was an anticipation of the plaintiff's patent. Lord Watson said: "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 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 men of science and employers of labour

(*p*) 12 R. P. C. 256.
(*q*) L. R. 4 C. D. pp. 58, 61.
(*r*) [1892] A. C. 378; 9 R. P. C. 313. See, also, Grove, J., in *Philpott* v. *Hanbury*, 2 R. P. C. 43; and Lindley, L.J., in *Savage* v. *Harris*, 13 R. P. C. 368, 369.

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."

When it is sought to Establish Publication by collating a Number of Documents.—The Court will not support a case of prior publication which can only be made out by piecing together a number of independent documents.

In *Von Heyden* v. *Neustadt*, (s) James, L.J., said: "It is contended that this invention is not novel. The burden of proving this is on the defendants, and it must be made out very clearly in order to destroy the patent of a man who at all events was the first person who, *de facto*, produced the thing to the public practically in a working state." Referring to the alleged prior publication, the learned judge proceeded: "What we have got in this case is not one clear statement by one writer, but a mass of paragraphs exhumed by the industry of the defendant's advisers from a number of publications. 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 shewn that a patentee had made his discovery of a consecutive process by studying, collating, and applying a number of facts discriminated in the pages of such works, his diligent study of such works would as much entitle him to the character of an inventor as the diligent study of the works of nature would do."

In *Moseley* v. *Victoria Rubber Company*, (t) Chitty, J., said: "The law in regard to prior publication by specification or otherwise is well settled: The antecedent statement must be such that a person of ordinary knowledge on the subject would 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. 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. . . . It is unnecessary, and would be a mere waste of time, to go through these four specifications in detail. They cover a period of some fourteen or fifteen years, and the latest of them was published nearly a quarter of a century before the plaintiff's

(s) 50 L. J. Ch. 127.

(t) 4 R. P. C. 241.

patent. Yet no one did produce, or could, from reading these specifications, have produced such an article as that produced according to this plaintiff's patent."

Prior Publication must be construed in the Light of Subsequent Knowledge.—At the same time, in determining whether or not any particular prior specification or description has so disclosed an invention as to enable the public to perform it, such document must be construed in the light of any further information bearing on the same subject which has been added to the stock of public knowledge subsequent to such publication, but prior to the date of the patent it is alleged to anticipate.

Thus, a prior specification, insufficient in itself to support a patent, may, when construed at a later date by a person whose knowledge is supplemented by subsequent discoveries, be, in the light of those discoveries, sufficient to destroy a later patent; and a specification which may in itself be insufficient to support a patent may nevertheless afford a sufficient disclosure of the invention to amount to a dedication thereof to the public." (*u*)

So likewise a prior specification may anticipate a subsequent patent for an invention different from that which such specification claims. For a specification necessarily publishes to the world a certain amount of information, more or less new, and that becomes at once public knowledge, even although the public are not allowed to appropriate it in the way in which the patentee has appropriated it, because that is protected by the patent. But, from that time forward it is known, and it may be that that information is sufficient to exclude another patent, although the earlier one cannot be proved to be an anticipation of the later one. (*v*)

Publication to Confidential Agents and Workmen.—A difficult question sometimes arises as to whether there has been publication of an invention by reason of its disclosure to persons occupying a confidential or quasi-confidential relation to the inventor. The majority of inventions, whether mechanical or chemical, necessarily involve the labour and employment of more persons than the inventor. Thus questions often arise as to whether a patentee, in availing himself of the services and opinions of others, has exceeded the limits which the law imposes upon such publications.

The general rule which may be deduced from the decided cases

(*u*) See Lord Watson in *King, Brown & Co.* v. *The Anglo-American Brush Co.*, 9 R. P. C. p. 320 (quoted, supra, p. 84); also, Bowen, L.J., in *Vorwerk* v. *Evans*, 7 R. P. C. 274.

(*v*) *Per* Kekewich, J., in *Thomson* v. *Macdonald*, 8 R. P. C. p. 8.

appears to be that the communication of an invention to some other person, if made in confidence by an intending patentee, is no publication; such person being neither in law nor in equity entitled to make a personal use of the information against the person who gave it. (*w*) But should the person so informed, in breach of his duty to the confiding inventor, disclose the invention to some third party free to make use of it, then the publication will be complete, and the right of the inventor to letters patent destroyed. (*x*) For once any member of the public, under no restriction as to secrecy, has obtained a knowledge of the invention sufficient to enable him to perform it, no subsequent patent can debar such person fr. m putting in use the knowledge he has so acquired.

The most usual case of confidential communication occurs in the case of workmen, and a useful test, to ascertain whether or not that communication amounts to publication, has been said to be the intention with which it is made. (*y*) Thus a communication made by an inventor, who contemplates taking out a patent, to workmen in his employment, with the view of prosecuting the invention into a practicable form, is no publication. But a communication made carelessly, it may be, by an inventor who has no present intention of patenting what he has discovered, to persons employed by him, may amount to a public dedication of the invention.

It may sometimes happen that an inventor, instead of employing his own workmen to make his machine, may order it to be made for him by some independent employer. Whether in such case publication necessarily results was considered but not decided in *Humpherson* v. *Syer*. (*z*) Cotton, L.J., said: "I do not think that *Widmer* can be considered as having been a servant in any way of the defendant; he was a tradesman who received an order to make a machine in accordance with the directions and on the instructions of his customer, the defendant; but it may be that knowing it was to be an experimental machine—that the defendant was making experiments—and other circumstances that we have not fully before us, he might have received those instructions under such circumstances that he was not at liberty to communicate the knowledge he had obtained to the public, or to make use of it publicly, and that he was confined to the use of that knowledge

(*w*) Per Bowen, L.J., in *Humpherson* v. *Syer*, 4 R. P. C. p. 413.

(*x*) *Gadd* v. *Mayor of Manchester*, 9 R. P. C. p. 259.

(*y*) Ibid. p. 258.

(*z*) 4 R. P. C. 411.

which he obtained, and the instructions conveyed to him only for the purpose of the defendant, who was his customer."

In *Blank* v. *Footman*, (*a*) the question of publication was discussed in regard to a design. There the plaintiff, prior to registration, had disclosed his design to one *Hummel*, with whom he was in confidential business relations, as sole agent for the sale of the goods to which the design related. The disclosure was made confidentially with a view to advice from a person having expert knowledge, and Kekewich, J., held this to be clearly no publication. *Hummel*, however, had himself afterwards submitted the design (still prior to its registration) to various persons who he anticipated would be likely to purchase the goods when made to the pattern, and some of these had in fact given him orders. This the learned judge held to be a publication, which avoided the subsequent registration of the design.

In *Winfield* v. *Snow*, (*b*) (also the case of a design) Hawkins, J., held publication to be established where it was proved that prior to registration the design had been shewn confidentially to a customer, who had originally suggested the idea it embodied, but who on seeing it had given an order for a considerable quantity of the goods.

In *Gadd* v. *The Mayor of Manchester*, (*c*) a *Mr. Terrace*, who had made the same discovery as the plaintiffs, had communicated the invention confidentially to two persons in his employment (one a brother of his own), to another brother employed at similar works, and to three other persons interested in the subject-matter of the invention. One of the three latter persons was alleged to have repeated, as a matter of news, the information so received, to a foreman, a draughtsman, and a chemist in his employment. These communications, it was contended, amounted to publication. The Court of Appeal, however (affirming the judgment of Kekewich, J.), held that the last alleged publications were mere gossip, and that the others were confidential. "The public," said Lindley, L.J., "had no access to *Mr. Terrace's* description of his invention. No one had access to that who was not confidentially consulted respecting it." (*d*)

Publication to Fellow Workmen.—While the confidental relationship existing between employer and employed will negative

(*a*) 5 R. P. C. 653; 39 C. D. 678; 57 L. J. Ch. 909. See, also, *Hunt* v. *Stevens*, W. N. [1878], 79.

(*b*) 8 R. P. C. 15. Cf. *Heinriche* v. *Bastendorff*, 10 R. P. C. 160, where Day, J., held that publication was proved.

(*c*) 9 R. P. C. 249, 516.

(*d*) Ibid. p. 528.

publication where disclosures take place between them, disclosures by one workman to his fellow employés enjoy no such privilege.

In *Saxby* v. *The Gloucester Waggon Company*, (*e*) it was objected to the validity of the plaintiff's patent that the same invention had been discovered by one *Edwards*, a superintendent in the signalling department of the London and North-Western Railway Company, under whose directions working drawings had been openly prepared and shewn to the company's mechanical engineer and also to the locomotive committee. The plaintiffs contended that these facts did not establish prior publication, as the publication in question had only been made to *Edwards*' fellow servants and employés, and that as he had not taken out a patent they were entitled to do so.

Jessel, M.R., in a judgment affirmed by the House of Lords, said: "There is no question that the right of *Edwards* to the invention was his own personal right, the mere fact of his being the superintendent of the signalling department did not prevent him inventing and patenting a new signalling apparatus. If he obtained a patent, it would not belong to the company, but to himself, and if he chose to publish it to all the other ten thousand employés of the London and North-Western Railway Company, of course that would have been a complete publication. He did publish it, in fact, to twenty-two or twenty-three of them, and, in my opinion, there is no pretence for saying that the publication of a secret which was his own to his fellow servants was less than a publication to the same individuals if they had not been his fellow servants. The confidence of the servants is a confidence only as regards the secrets of the master, not as regards the secrets of the fellow servants. I should be of opinion that it was not only discussed, but sufficiently published by *Edwards* before the date of the patent."

Publication in a Report to Government.—The description of an invention in a report made to a Government department by a public official may be sufficient publication to defeat a subsequent patent for the same invention.

In *Patterson* v. *The Gaslight and Coke Company*, (*f*) the appellant had been appointed under the City of London Gas Act, 1868, to act as one of three referees who were to enquire into the subject of the purification of gas, and report to the Board of Trade the result of their enquiries. They drew up a report, one portion of which was alleged to have been confidentially communicated by

(*e*) Griff. P. C. 56.

(*f*) 3 App. Ca. 239.

the appellant to his co-referees. This report was fully prepared by the 31st of January, 1872, but it was not at that time presented to the Board of Trade. The appellant, a month later, applied for a patent for "Improvements in the purification of coal gas;" the alleged improvements in respect of which this patent was sought were the matters confidentially communicated by the appellant for the official report, and described therein, as above stated. The provisional specification was dated the 9th of March. The report was sent to the Board of Trade on the 27th of the same month and at once made public. The patent, founded on the specification of the 9th of March, was formally sealed on the 28th of May. On these facts the House of Lords held that there was no novelty in the invention, as it had already been dedicated to the public by the prior publication to the patentee's co-referees. Lord Blackburn, in his judgment, said: "I do not mean to throw any doubt on the doctrine in *Morgan* v. *Seaward* (*g*) that a disclosure to assistants or partners of an invention, whilst it is being perfected, under an obligation to keep it secret till the patent is taken out, is not a disclosure to the public, for such persons could not make the invention known without a breach of duty. But in the present case the disclosure was to paid public officers, who could not keep it secret without a breach of duty. They were bound to make it known, and even if they, in breach of their duty, kept it back, the invention was not the less the property of the public from the time the referees knew it, which was at least as early as the date of the report."

Drawings, Models, and Public Exhibitions.—The test of prior publication being, whether the public has in a practical sense already acquired the secret of the invention, it is obvious that publication may take place by means of drawings, models, or oral explanations, as well as by written descriptions and specifications.

In *Herrburger* v. *Squire*, Lord Esher, M.R., said: "If a person has drawn a machine, without describing it at all—has drawn a picture of it, but published that picture in a book, and that book was one which any machinist would understand, and could make a machine from that picture alone, then a person cannot take out a patent in respect of a machine made like that." (*h*)

In *Winby* v. *The Manchester Tramways Company*, (*i*) a patent for improvements in points and crossings of tramways was held anticipated by a model left open to the inspection of persons

(*g*) 2 M. & W. 544.

(*h*) 6 R. P. C. 194. See, also, *Plimpton* v. *Malcolmson*, 3 C. D. 531; *Tetley* v. *Easton*, 26 L. J. C. P. 269; 2 C. B. (N. S.), 706; *Saxby* v. *Gloucester Waggon Co.*, Griff. P. C. 56.

(*i*) 8 R. P. C. 61 (p. 66).

entering the chairman's room in the offices of a company engaged in the construction of tramways. (*j*)

In *Humpherson* v. *Syer*, (*k*) Fry, L.J., held that publication was proved, on evidence, that a model of an invention similar to the plaintiff's had been made for the defendant and shewn openly in a shop, prior to the date of the patent, to a person under no obligation of secrecy.

In the *Lifeboat Company* v. *Chambers Brothers*, (*l*) the patent was for improvements in the construction of lifeboats. Two months before the patent had been taken out, announcements had appeared in newspapers describing the new boat, and a public exhibition of its qualities had been given at Glasgow, in the river Kelvin. This exhibition had been repeated before Board of Trade and Admiralty officials at the Royal Albert Dock in London. A third exhibition, also prior to the date of the patent, and followed by further newspaper notices, had been given at Portsmouth. On these facts the Court of Session held that, after such prior publication, no patent for the invention could be supported.

Protected Publication at Industrial Exhibitions.—Special provision has been made by the legislature to prevent the exhibition of inventions at industrial and international exhibitions operating as a publication which will defeat letters patent subsequently granted for such inventions.

Thus, Section 39 of the Patents Act, 1883, enacts—

"The exhibition of an invention at an industrial or international exhibition certified as such by the Board of Trade, or the publication of any description of the invention during the period of the holding of the exhibition, or the use of the invention for the purpose of the exhibition in the place where the exhibition is held, or the use of the invention during the period of the holding of the exhibition by any person elsewhere, without the privity or consent of the inventor, shall not prejudice the right of the inventor or his legal personal representative to apply for and obtain provisional protection and a patent in respect of the invention or 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 design or article, or publishing a description of the design, give the comptroller the prescribed notice of his intention to do so; and

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

(*j*) See, also, *Yates* v. *Armstrong*, 14 R. P. C. 747.

(*k*) 4 R. P. C. 407 at p. 415; but see *Ehrlich* v. *Ihlee*, 5 R. P. C. pp. 206, 207, 437.

(*l*) 8 R. P. C. 418.

By Section 3 of the Patents Act, 1886, these provisions were extended as follows to exhibitions held out of the United Kingdom:

"It shall be lawful for her Majesty, by Order in Council, from time to time to declare that sections thirty-nine and fifty-seven of the Patents, Designs, and Trade-marks Act, 1883, or either of those sections, shall apply to any exhibition mentioned in the Order, in like manner as if it were an industrial or international exhibition certified by the Board of Trade, and to provide that the exhibitor shall be relieved from the conditions, specified in the said sections, of giving notice to the comptroller of his intention to exhibit, and shall be so relieved either absolutely or upon such terms and conditions as to her Majesty in Council may seem fit." (*m*)

(*m*) The Order in Council applying sec. 39 of the Patents Act, 1883, to the Paris Exhibition of 1900 will be found in Appendix III., post.

CHAPTER VII.

ANTICIPATION BY PRIOR USER.

User means User in Public.—The novelty of an invention will be defeated if it is shewn that it was in public use within the United Kingdom at any time prior to the date of the letters patent granted in respect of it.

Public use does not mean general use by the public. It means practical use of the invention by any person in public. "The public use and exercise of an invention," said Lord Abinger, C.B., "means a use of the invention in public, not by the public." (*a*) "Public use," said Alderson, B., "means in use in public so as to come to the knowledge of others than the inventor as contra-distinguished from the use of it by himself in his chamber." (*b*)

At the same time, it is not necessary in proving prior user to shew that the user has been such as to disclose to others the knowledge of how to perform the invention. Anticipation by user is not a mere equivalent for anticipation by publication. Any practical use of an invention in public will be sufficient to defeat a subsequent grant of letters patent therefor, whether others have learnt the inventor's secret therefrom or not.

"It is obvious," said Pollock, B., in *Croysdale* v. *Fisher*, (*c*) "that in almost all cases of user it does not profess that there is a publication to the world as there is in the case of a specification, or in the case of a book that is largely disseminated, because the more perhaps as different modes of refinement and variations and improvements continue to multiply, the more does it happen that one portion of the manufacturing world does not know what is going on in, or what is being done by, another portion of the

(*a*) *Carpenter* v. *Smith*, 1 W. P. C. 543.

(*b*) Ibid.; quoted with approval by Lord Chelmsford, C., in *Betts* v. *Neilson*, L. R. 3 Ch. 436.

(*c*) 1 R. P. C. 17.

manufacturing world. Certainly still more does the public not know with very great nicety, unless concerned either as manufacturers or traders, what is going on in the laboratories or manufactories attached to any particular trade. When it is said that a process or an invention has been disclosed by means of user, it is not necessary that such user should be a user by the public proper, provided only there is a user in public, *i.e.* in such a way as contradistinguished from a mere experimental user with a view of patenting a thing which may or may not be existing."

A prior use of any material part of the invention claimed will invalidate a subsequent patent. In *Hill* v. *Thompson*, (*d*) proof that a material part of the invention had been in actual use in certain public works during a period of eight years anterior to the date of the patent was held fatal to its validity. So likewise in *Cornish* v. *Keene*, (*e*) Tindal, C.J., thus directed the jury: "The main question is whether this number three which is the principal subject of the patent, was or was not in use in England at the time of granting these letters patent. If this number three, calling it technically and compendiously by that title, was at the time these letters patent were granted in any degree of general use; if it was known at all to the world publicly and practised openly, so that any other person might have the means of acquiring the knowledge of it, as well as this person who obtained the patent—then the letters patent are void. (*f*)

User by the Patentee Himself may be Public User.—Even prior user by the patentee himself will defeat a patent grant, if that user has been a public user. Thus, if an inventor before the date of his letters patent has used publicly or sold the product of his invention the grant is void. For by such use or sale he has given his invention to the public, and he cannot take it back under cover of letters patent. (*g*) In *Wood* v. *Zimmern*, (*h*) it was proved that the patentee had himself sold articles made according to his process four months before the date of his patent. This was held fatal to the patent. "To entitle a man to a patent," said Gibbs, C.J., "the invention must be new to the world. The public sale of that which is afterwards made the subject of a patent, though sold by the inventor only, makes the patent void." This case was

(*d*) 1 W. P. C. 248, 249. See, also, *Losh* v. *Hague*, 1 W. P. C. 202; 8 L. J. Ex. 251.

(*e*) 1 W. P. C. 508.

(*f*) See, also, *Badham* v. *Bird*, 5 R.P.C. 238; *Hollins* v. *Capper*, 5 R. P. C. 289; *Podmore* v. *Wright*, 5 R. P. C. 380; *Hutchison* v. *Pattullo*, 5 R. P. C. 351.

(*g*) *Hoe* v. *Foster*, 16 R. P. C. 40.

(*h*) Holt, N. P. 58; 1 W. P. C. 82 n.

followed in *Morgan* v. *Seaward*, (*i*) where the Court of Exchequer said: "It must be admitted that if the patentee himself had before his patent constructed machines for sale as an article of commerce for gain to himself, and been in the practice of selling them publicly, that is, to any of the public who would buy, the invention would not be new at the date of the patent. This was laid down in *Wood* v. *Zimmern*, (*j*) and appears to be founded on reason; for if the inventor could sell his invention, keeping the secret to himself, and, when it was likely to be discovered by another, take out a patent, he might have practically a monopoly for a much larger period than fourteen years. Nor are we prepared to say that if such a sale was only of articles that were fit for a foreign market, or to be used abroad, it would make any difference; nor that a single instance of such a sale as an article of commerce to any one who chose to buy might not be deemed the commencement of such a practice and the public use of the invention, so as to defeat the patent."

Thus, an inventor must elect whether he will use his invention under or without the protection of letters patent. He cannot do both. Where, however, a patentee had made one or two of his patented machines prior to the date of his patent, but had not attempted to sell them, or deal with them by way of profit, this user was held insufficient to avoid the grant. (*k*)

In the case of *Betts* v. *Menzies*, (*l*) the plaintiff applied in due course for letters patent, but owing to unforeseen delays did not obtain a grant within the usual time. Meanwhile he manufactured capsules (the subject of his invention) according to his new process, but only under the cognizance of his partners and workmen; imposing upon the latter an express injunction that none of the articles should be sold. None, in fact, were sold until the patent had been granted. Lord Campbell, C.J., held that this was not a public use which ought to invalidate the patent. "Now, others had not used this before the patent was granted," said the learned Chief Justice. "It was used only by the inventor, the patentee himself, and the use of it by the servants and mechanics whom he employed must be considered to have been his use, and therefore it was not used by others. But, still, if it could be shewn that the effect was really to extend the time of the monopoly that

(*i*) Per Parke, B.; 1 W. P. C. pp. 194, 195; 2 M. & W. 544; 6 L. J. Ex. 153. See, also, Tindal, C.J., in *Gibson* v. *Brand*, 1 W. P. C. 630.

(*j*) 1 W. P. C. 42; Holt, N. P. 58; 1 Carp. P. C. 290.

(*k*) *Bramah* v. *Hardcastle*, Holroyd, 81; 1 W. P. C. 44 n.

(*l*) 28 L. J. (Q. B.), 365.

would be fatal. But the defendant has entirely failed in shewing that."

Manufacturing for Profit, though in Secret, is User.—From what has been already stated it follows that prior user for profit by an inventor himself, even where he keeps his invention secret, will be fatal to a patent grant. Were the rule otherwise a patentee, as pointed out by Alderson, B., in *Morgan* v. *Seaward*, might indefinitely prolong his monopoly by making at first in secret, and taking out a patent when he thought his invention in danger of discovery. The benefit of the patent monopoly is intended for the inventor who gives his invention promptly to the public, not for him who seeks first to enjoy the use of it secretly as long as he can. So likewise prior user by another, even if a secret user, will avoid a patent.

In *Tennant's* (*m*) case the invention was an improvement in a bleaching process. Its great utility was proved, and also the general ignorance of bleachers as to this improvement until after the plaintiff's discovery. But evidence was given that one bleacher at Nottingham had used the same means of preparing his bleaching liquor during six years anterior to the date of the patent. This bleacher had kept the process a secret from the rest of the trade, only disclosing it to his two partners, and to workmen who carried out his instructions in performing it. It was argued that the secrecy thus observed prevented this user being a prior public user. But the Court refused to adopt this view, and held that such user defeated *Tennant's* claim to the exclusive benefit of his discovery; and in principle this decision was clearly right, for had *Tennant's* patent been upheld the Nottingham bleacher could have been prevented using a process formerly freely employed by him.

In *Heath* v. *Smith*, (*n*) Lord Campbell, C.J., pointed out this hardship upon the public if in such case the patent were maintained against a person who had enjoyed a prior use of the invention. The Chief Justice said: "Now, see what that comes to. If any man makes a discovery, and uses it without taking out a patent, and does not announce it by sound of trumpet or calling in the public as spectators, he must suspend the use of his discovery if another person subsequently makes the same discovery and takes out a patent for it."

So similarly in *Cornish* v. *Keene*, Tindal, C.J., said: "If the defendants have shewn that they practised it and produced the

(*m*) 1 W. P. C. 125 n.

(*n*) 3 E. & Bl. p. 273; 2 W. P. C. 268; 23 L. J. Q. B. 166.

same result in their factory before the time the patent was obtained, they cannot be prevented by the subsequent patent from going on with that which they have done." (*o*)

Single Instance of Secret Use.—But a single instance of the manufacture of an article made by workmen under an injunction of secrecy for an inventor who is about to take out a patent, has been held not to avoid the subsequent grant.

In *Morgan* v. *Seaward*, (*p*) the evidence shewed that before the date of the patent, which was the 22nd of July, 1829, two pair of wheels had been made for *Morgan* by one *Curtis*, an engineer, at his own factory upon the principle mentioned in the patent. *Galloway*, the patentee, had given the instructions to *Curtis* under an injunction of secrecy, because he was about to take out a patent. The wheels were completed and put together at *Curtis's* factory, but not shewn or exposed to the view of those who might happen to come there. After remaining there a short time the wheels had been taken to pieces, packed up in cases, and shipped in the month of April on board a vessel in the Thames, and sent out of England for the use of a foreign company of which *Morgan* was managing director, which carried on all its transactions abroad. Shareholders of this company were resident in England. *Curtis* deposed that the wheels "were sold to the company," without saying by whom, which might mean that they were sold by *Curtis* to *Morgan* for the company; and that *Morgan* paid *Curtis* for them. *Morgan* and *Galloway* employed an attorney, who entered a caveat against any patent on the 2nd of March, and afterwards solicited the patent in question, which was granted to *Galloway* and assigned to *Morgan*.

It was objected by the defendants that these facts amounted to proof of prior user, and that the patent was void. But the Court of Exchequer refused to adopt this view. In their judgment, delivered by Park, B., they said: "We do not think that the patent is vacated on the ground of the want of novelty, and the previous user or exercise of it, by a single instance of a transaction such as this between the parties connected as *Galloway* and the plaintiff are, which is not like the case of a sale to any individual of the public who might wish to buy; in which it does not appear that the patentee has sold the article, or is to derive any profit from the construction of his machine, nor that *Morgan* himself is, and in which the pecuniary paym[illegible] may be referred merely to an ordinary compensation for the labour and skill of the engineer

(*o*) 1 W. P. C. 511. (*p*) 1 W. P. C. 170; 6 L. J. Ex. 153; 2 M. & W. 544.

actually employed in constructing the machine; and the transaction might upon the evidence be no more in effect than that *Galloway's* own servants had made the wheels; that *Morgan* had paid them for the labour, and afterwards sent the wheels to be used by his own co-partners abroad. To hold this to be what is usually called a publication of the invention in England would be to defeat a patent by much slighter circumstances than have yet been permitted to have that effect." (*q*)

Operations of this kind are, however, extremely risky and ought to be avoided by an inventor. In a recent case the use of a printing-machine (already patented in America) in the printing of a provincial paper on various occasions was held to avoid a subsequent English patent: although the importer stated that such use was secret and had only been resorted to with a view to seeing that the machine would work properly before applying for the English patent. (*r*)

Mere Delay in Applying for a Patent is not Prior User.—Although the law assumes that an inventor will apply for letters patent promptly, a patent is not avoided by merely proving that the patentee has kept his invention on the shelf, as it were, for a considerable period before making his application, provided he has not meanwhile used the invention: for such delay is no extension of the period of his monopoly.

In *Bentley* v. *Fleming*, (*s*) it was objected that the plaintiff had delayed some considerable time after his machine had been in complete working order before he applied for a patent. But Cresswell, J., overruled the objection. The learned judge said: "A man cannot enjoy his monopoly by procuring a patent after having the benefit of the sale of his invention. But you cannot contend, that if a man were to keep his invention shut up in his room for twenty years, that circumstance merely would deprive him of his right to obtain a patent for it."

In *Young* v. *Rosenthal*, (*t*) Grove, J., said: "Mere private use in the closet, mere experimental working in a laboratory, without publishing the invention, keeping it a secret with a view of a patent being taken out, would not invalidate it; but if it is once publicly used or sold in a shop, or publicly used in a carriage or on the person, or in any such way, then the public have a right to it and the patent is bad."

(*q*) 1 W. P. C. p. 195. Cf. Kay, L.J., in *Westley* v. *Perkes*, 10 R. P. C. 192.
(*r*) *Hoe* v. *Foster*, 16 R. P. C. 33.
(*s*) 1 Car. & K. 587; 1 C. B. 479.
(*t*) 1 R. P. C. 32.

Prior User need not be Continuous User.—Prior user, provided it has been public, whether for a year, or a month, or a day, will equally defeat a subsequent patent. (*u*) Nor is it necessary that the use should have been continuous and actually going on at the date of the grant. Public user years before, if proved, is sufficient. But the circumstance that the user alleged has been abandoned affords, especially in the case of an invention of high utility, strong presumptive evidence that such user was not a user of the perfect and completed invention.

In *Household* v. *Neilson*, (*v*) the Court of Session held that prior user discontinued before the date of the grant did not invalidate the letters patent. But the House of Lords refused to adopt this view of the law. "Now, I am obliged to say, with all deference to the learned judge," said Lord Lyndhurst, C., "and with all respect to the learned judges of the Court of Session, that I think in that respect they are mistaken, and that if it is proved distinctly that a machine of the same kind was in existence, and was in public use, that is, if use or if trials had been made of it in the eye and in the presence of the public, it is not necessary it should come down to the time when the patent was granted. If it was discontinued, still that is sufficient evidence in support of the prior use, so as to invalidate the letters patent." (*w*)

In the same case Lord Brougham, after pointing out that the abandonment of the user of a prior invention might be a most material factor in determining whether or not such invention had in fact proceeded beyond experiment, said: "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, and 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, or as in this case, forty years ago, it is perfectly immaterial; not immaterial to the second question, arising upon 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

(*u*) *Hoe* v. *Foster*, 16 R. P. C. 33 (per Chitty, L.J., p. 39).

(*v*) 1 W. P. C. 673; 9 Cl. & F. 788.

(*w*) Ibid. p. 709.

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." (*x*)

In *Honiball* v. *Blumer*, (*y*) the plaintiff's patent was for improvements in the construction of anchors. At the trial it was proved that a firm in Liverpool twelve years prior to the date of the patent had made and sold a single anchor similar in construction to that of the patentee. On this Martin, B., said: "I think, Sir Frederick Thesiger, there is an end of your case, assuming the jury believe *Mr. Logan*, as to which I suppose there is no doubt. I think if that anchor of *Mr. Logan's* was sold in the ordinary way of business, although it turned out a failure, as possibly may have been, if it was sold in the regular way of trade or business, there is an end of your case, and this patent cannot be supported."

In the case of *Guilbert-Martin* v. *Kerr & Jubb*, (*z*) the plaintiff's patent was for improved gauge glasses communicated from abroad by a Frenchman. It was proved by the defendants that six years prior to the date of the patent, glasses of a similar description had been used by *Crossley & Sons*, placed against boilers in their works at Halifax; they were used there as long as they lasted, probably only a very short time. They were not renewed on being worn out, and were not in actual use at the date of the plaintiff's patent. Kekewich, J., held that the user was complete, and that on the evidence the fact that the glasses had not been renewed after being worn out pointed, not to a case of abandoned experiment, but to the discovery that those glasses were not the most useful for the purpose for which they were employed.

Actual Sales not Necessary.—As is already apparent from the preceding cases, it is never necessary to prove actual sales to establish prior user.

In *Mullins* v. *Hart*, (*a*) where the patent was for a new method of manufacturing brass penholders, the defendants proved that they had manufactured penholders on the principle contained in the plaintiff's specification, some months before the date of his patent; they had no shop in which to exhibit their goods, but these penholders had been deposited in their warehouse for sale. They could not, however, prove that any of them had actually been sold. Jervis, C.J., held that this was sufficient to defeat the novelty of the plaintiff's patent.

(*x*) 1 W. P. C. 713.
(*y*) 2 W. P. C. 199; 10 Ex. R. 538; 24 L. J. Ex. 11.
(*z*) 4 R. P. C. 18.
(*a*) 3 Car. & K. 297.

Nor is it necessary to prove that the anticipation alleged was an article manufactured with the intention of being sold.

In *Hancock* v. *Somervell*, (*b*) an invention was held to have been in public use which was brought under the notice of customers in various places, though no sale was actually effected.

Thus, an article used openly for a domestic purpose will defeat a subsequent patent for a similar invention.

In *Carpenter* v. *Smith*, (*c*) the plaintiff's patent was for an improved lock. Evidence was given which shewed that a lock similar to that which was the subject of the plaintiff's patent had before been used by a *Mr. Davies*, who had placed it on his gate adjoining a public way many years anterior to the date of the patent. Lord Abinger, C.B., held that this evidence, if the jury believed it, was fatal to the grant. The learned Chief Baron said: "Now, public use means this—that the use of it shall not be secret, but public; and in that sense I must say, that if you think the lock used by *Mr. Davies* is a lock which combines the same thing, I think that is a public use of it, and is within the meaning of this clause of the patent—'public use and exercise,' as used in opposition to private and secret use. Therefore, 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."

In the subsequent case of *Young* v. *Fernie*, (*d*) Stuart, V.C., doubted if the publication in *Carpenter* v. *Smith* was such as ought in more modern times to invalidate a subsequent patent. His Honour said: "It is not, I think, the habit of mankind to go about examining the construction of the locks on their neighbours' doors or gates. Even the few men endowed with an honest curiosity in examining mechanical inventions would probably not be anxious to be found taking models of their locks or prying into the exact construction of fastenings intended to protect private property against the whole body of the public."

But in the later case of *Betts* v. *Neilson*, (*e*) Lord Chelmsford quoted and followed *Carpenter* v. *Smith* without expressing any such doubt. In that case it was alleged that the patent had been anticipated by a prior manufacturer. No sale of the alleged anticipation was, however, proved, and Wood, V.C., considered the evidence insufficient. His Honour said: "I cannot say, in the

(*b*) 39 *New London Journal*, 158. Cf. Byles, J., in *Oxley* v. *Holden*, 8 C. B. (N. S.), 666; 30 L. J. C. P. 68.

(*c*) 1 W. P. C. 534; 11 L. J. Ex. 213; 9 M. & W. 300.

(*d*) 4 Giff. 577, p. 612.

(*e*) L. R. 3 Ch. 435; 18 L. T. (N. S.), 159.

absence of a single thing produced to me by any person who is said to have purchased it, that the manufacture was achieved. I want somebody who was an habitual purchaser." On appeal, Lord Chelmsford, C., dissenting from the doctrine that a sale must be shewn to prove anticipation, said: "An article which is capable of some useful application may from circumstances be unsaleable at a particular time, and yet if manufactured, not for experiment, but in the way of trade, may prevent another patent having a claim to novelty. Nor in order to establish a public use is it even necessary that the patented article should have been previously manufactured for sale." After citing the decision in *Carpenter* v. *Smith*, the Lord Chancellor proceeded: "If, therefore, the evidence which I am about to examine established the fact that lead coated with tin by mechanical pressure, and capable of useful application, has upon any occasion been manufactured openly, not by way of experiment, but in the course of business, although not a single piece of the material was actually sold, I should hold that *Betts's* patent was invalidated."

Carpenter v. *Smith* and *Betts* v. *Neilson* were discussed in the more recent Scottish case of *Gill* v. *Coutts*. (*f*) In that case the invention was a gilding-paint compounded by a particular process. It was proved that a paint formed of similar ingredients had been used before, and on this it was contended that such use did not invalidate the patent, because the public had not been informed thereby of the way in which the paint was compounded. In rejecting this argument, Lord Traynor said: "Then as to the notion that the public must know what the article is composed of before it can anticipate a patent, I think the Sheriff-Substitute has fallen into error by misapprehending the statement often made, that there must be disclosure as well as use. But that disclosure does not mean that the public shall know as much about the article used as the maker of it knows. It means that the thing must be disclosed to the public, and not kept by the maker of it to himself. It is the use of the thing in public, as distinguished from the use in private, by the inventor. Public user involves disclosure. In the case of *Carpenter* v. *Smith*, a patented lock was held to have been anticipated by the fact that a similar lock had been used by 'an individual on a gate adjoining a public road.' There was no suggestion, in that case, that the lock on the gate had been examined by any member of the public so as to ascertain its peculiar construction, or that any such examination or knowledge

(*f*) 13 R. P. C. 125.

arising therefrom on the part of the public, was necessary to constitute public use. Public use, as Lord Abinger said in *Carpenter's* case, and the dictum is quoted with approval by Lord Chelmsford in the case of *Betts* v. *Neilson*, 'means a use *in* public, not *by* the public.' I think there is no room for doubt that the use by the defender of his own paint was of this character. It is quite true that, in order to obtain letters patent, the inventor must disclose his secret to the public in return for the monopoly conferred upon him. But such a disclosure as that is not necessary to the prior use, which will anticipate and so void a patent."

With *Carpenter* v. *Smith* the case of *Stead* v. *Williams* (*g*) may be compared. In that case the patent was for a method of paving streets with wood. It was proved that a form of wood paving, very similar to the plaintiff's, had been laid down prior to the date of the patent, to support the traffic of carriages in the covered porch of the house of *Sir William Worsley* in Yorkshire. On this evidence, Cresswell, J., directing the jury, said: "If you think that is essentially the same thing as the hexagon block introduced by the plaintiff for the purpose of making roads, then, I should say, in point of law, that makes an end of the patent, because that appears to have been introduced by *Sir William Worsley*, or to have been used by him in public—not concealed—no secrecy about it—made known to all persons who came to his house, so far as their ocular inspection could make them. It was intended to be public, not to be made a matter of merchandise, certainly, but merely for his own private use; but the knowledge of it exposed to the public an article in public use, and continued to be used down to the time in question. Therefore, if you think that is the same thing in substance as that which the plaintiff claims, I think that it was publicly used before, and that he cannot have his patent. Whether it had been used by one or used by five, I do not think it makes any difference."

In the subsequent case of *Stead* v. *Anderson*, (*h*) evidence was given to shew that the paving used at *Sir William Worsley's* was not the same as the plaintiff's invention, but essentially different in construction. Parke, B., who tried the case, was impressed by this evidence, and directed the jury that the modes of paving were not the same; but, in doing so, he expressly reaffirmed the law as laid down by Cresswell, J., in the earlier case. The learned baron said: "If the mode of forming and laying the blocks at *Sir William Worsley's* had been precisely similar to the plaintiff's,

(*g*) 2 W. P. C. 136. (*h*) 2 W. P. C. 149.

that would have been a sufficient user to destroy the plaintiff's patent, though put in practice in a spot to which the public had not free access."

In *Brereton* v. *Richardson*, (*i*) a patent for an improved tricycle was defeated on the evidence of a witness who stated that, prior to the date of the grant, he had ridden an identical machine along public thoroughfares.

In the recent case of *Taylor's Patent*, letters patent for an invention concerning improvements in the construction of domestic fire-places, was held to be void on proof that a similar grate had been in use in a private house prior to the date of the patent. (*j*)

Prior User means User with Knowledge of the Use.—The prior user which defeats a subsequent patent must not only be a public user, it must also be a user with knowledge of the use. (*k*) Therefore if a man stumbles upon an invention and uses it accidentally, as it were, without any knowledge of the value of what he uses, or the purpose to which it may be put, such user will not be fatal to a later inventor who patents the discovery in full knowledge of its valuable application.

This rule was clearly laid down by Cockburn, C.J., and Blackburn, J., in *Harwood* v. *The Great Northern Railway Company*. (*l*) In that case the patent was for improved "fish" joints for railways. It was proved that prior to the date of the patent a similar fish-joint had under the following circumstances been used on Hackney Bridge. On this bridge the engineer had employed channelled iron with bolts, for the purpose of fastening the timbers placed vertically upon each other, and it happened that at one place there was a scarf-joint which it became necessary to fish. To do this the engineer, having a channelled or grooved iron running longitudinally the whole length of the bridge to support its flooring, availed himself of that iron, as one of the plates whereby to fish the scarf-joint. This use, however, did not utilize qualities which were the most valuable factors in the invention protected by the subsequent patent; that is to say, the strengthening of the iron of the plate, and the fixing of the bolts by making the heads firm in the groove, so as to prevent them from turning. On the Hackney Bridge the channelled iron had been used simply because it was there, just as a flat surface of iron would have been used if iron so shaped had been equally available: and in

(*i*) 1 R. P. C. 165; Griff. P. C. 54.
(*j*) 13 R. P. C. 482.
(*k*) *Walton* v. *Bateman*. 1 W. P. C. 618 (per Cresswell, J.). See, also, *Muntz* v. *Foster*, 2 W. P. C. 108.
(*l*) 2 B. & S. 194; 29 L. J. Q. B. 193.

that use no knowledge was shewn of the valuable qualities for which the invention had since been patented. Cockburn, C.J., said: "The question is, whether the accidental use of a piece of machinery (forming part or the whole of a mechanical contrivance, which may be applied afterwards to some ulterior purpose), without any intention of producing the result, is such a user of the invention as prevents a patent from being taken out by another person; and this turns upon what is the meaning of the language in the Statute of Monopolies, 21 Jac. I. c. 3, s. 6, that letters patent may be granted for 'the sole working or making of any new manufactures' 'which others at the time of making such letters patent and grants shall not use.' Clearly the Statute means what others have invented and used knowingly for the same purpose for which the person who afterwards comes forward as the inventor, and obtains a patent, intends to use it. I go the length of saying that even if this had been done upon a railway, it would not have prevented a subsequent patent from being taken out. Suppose that when railway fishes were made, not of grooved but of flat iron (as they were before *Wild's* patent), a person employed in fishing the joints of a long extended line of railway, finding a piece of grooved iron, had by accident taken it up and used it in one part of the railway instead of a piece of flat iron, without any intention of producing these additional advantages which result from the application of *Wild's* invention or any thought of the advantages which such an application would produce, but still producing them; I cannot think that it would be the true construction of the Statute, and certainly it would be an impolitic and inconvenient construction, to say that a man who afterwards *bonâ fide* invented and discovered that the application of channelled iron for the holding of bolts for fishing railways would be attended with most beneficial results should be prevented from patenting his invention." And Blackburn, J., said: "A man cannot be said to 'use' a manufacture in the sense in which the word must be understood in this Statute, and as it would ordinarily be understood, when accidentally, and without any knowledge or intention, he produces that which, if it were knowingly and intentionally done, and for the purpose of trade, would be a manufacture."

The same principle was noticed in *Edison & Swan* v. *Woodhouse*, (*m*) but the Court there abstained from acting upon it and seemed to regard it as a rule of law requiring further consideration. In that case the patent was for the production of a carbon pencil

(*m*) 4 R. P. C. 99.

for use in electric lamps. The patentee having found that nearly all obtainable carbon was open to objection, by reason of its por ·ity and lack of homogeneity, invented a process by means of which this defect might be cured. This process consisted in placing the pencil of carbon in a hydro-carbon gas or liquid, and heating it to a very high degree whilst so immersed, by passing an electric current through it. The pencil when so heated decomposed the surrounding gas or liquid, absorbed the carbon therefrom, and so filled up its own pores. In this way the pencil became coated with a homogeneous layer of carbon a ıd capable of glowing with a uniform brilliancy.

It was objected by the defendants that this method (admitted to be of high utility) had been anticipated by a French chemist, *M. Despretz*, in the year 1849. The operations of *Despretz* had, however, been aimed at a different object, not the production of carbon in any special form, but the attainment of a means to fuse and volatilize it. If in the course of his experiments he had demonstrated that the porosity of carbon could be cured in the above manner, this result had not occurred to him as being a discovery of any value, and he had abandoned his researches as without result for the purpose at which they were aimed. The Court of Appeal were of opinion that *Despretz* had not in fact attained the result accomplished by the patentee. They therefore gave no decision on the point whether a prior user without knowledge of the use is sufficient to avoid a subsequent patent. They indicated, however, that when that question again arose, *Harwood* v. *The Great Northern Railway Company* would require further consideration. (*n*)

Experiment is not Prior User.

User means Practical User.—The public user which defeats a patent is a practical user. If, therefore, the user relied upon by a defendant is merely experimental, the letters patent will not be avoided thereby. (*o*) Whether the user alleged has been practical or experimental is a question of fact to be determined by the jury where the issue is tried before a jury. (*p*) On a review of the authorities it is scarcely possible to lay down general rules, as each case must depend on its own particular circumstances. It may, however, be premised as a general inference from the decided

(*n*) Per Lindley, L.J., ibid. p. 107.

(*o*) *Lyon* v. *Goddard*, 10 R. P. C. p. 342 (Esher, M.R.); *Morgan* v. *Windover*, 5 R. P. C. 295.

(*p*) Per Tindal, C.J., in *Cornish* v. *Keene*, 1 W. P. C. 519; 3 Bing. N. C. 588; 6 L. J. C. P. 225.

cases, that where the invention is one of high merit, the usefulness of which, in its patented form, the public have readily appreciated, the Court will view jealously alleged instances of prior user; especially where the alleged user has been of an isolated character, at a remote date, and speedily discontinued. In such case very direct evidence will be required to rebut the presumption which arises from the abandonment of an alleged antecedent discovery, that it was imperfect and void of utility, and therefore no anticipation of the subsequent completed invention of the patentee.

Prior User which has been Abandoned, is Generally Experiment Only.—In the case of *Lewis* v. *Marling*, (*q*) where the patent was for improvements in shearing machines which made it possible to shear from list to list, evidence was given to prove that one *Coxon* had previously made a machine for shearing from list to list; but this machine had not met with public approval, and never came into use. It was further shewn that a model resembling the plaintiffs' machine had been sent over from America and exhibited to a few persons in this country. From this model, however, no machine had actually been made; indeed, it appeared, on the contrary, that the persons in whose possession this model was had bought and used machines manufactured by the plaintiffs. Further evidence was given to shew that a specification alleged to disclose the plaintiffs' invention had been brought over from America, and two persons employed to make a machine from it. But this machine was never completed. On these facts Lord Tenderden, C.J., held that until the plaintiffs' invention came out no machine for shearing from list to list was publicly known or used in England.

In *Jones* v. *Pearce*, (*r*) the plaintiff's invention was a wheel constructed entirely of iron, and on the suspension principle, so that the weight was suspended from the upper parts of the wheel. For the defendant witnesses were called, who said that they had made a pair of wheels of similar construction for a *Mr. Strutt*, twelve years before the date of the patent, and that these wheels had been put in a cart used for carrying milk from *Strutt's* farm to his factory; in this cart they had remained until they were worn out. The witnesses further deposed that another wheel, constructed at the same time and on the same principle, had been fitted to a cart for carrying heavy stores on the public road, and used for about a year. But there was evidence that this wheel had not acted very successfully. In directing the jury, Patteson, J.,

(*q*) 1 W. P. C. 495; 10 B. & C. 22; 4 C. & P. 52. (*r*) 1 W. P. C. 122.

said: "If, on the whole of this evidence, either on the one side or the other, it appeared this wheel constructed by *Mr. Strutt's* order in 1814, was a wheel on the same principles and in substance the same wheel as the other for which the plaintiff has taken out his patent, and that was used openly in public, so that everybody might see it, and had continued to use the same thing up to the time of taking out the patent, undoubtedly then that would be a ground to say that the plaintiff's invention is not new, and if it is not new, of course his patent is bad, and he cannot recover in this action; but if, on the other hand, you are of opinion that *Mr. Strutt's* was an experiment, and 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, if I may say so, although he knew nothing of *Mr. Strutt's* wheel he remedied the defects of *Mr. Strutt's* wheel, then there is no reason for saying the plaintiff's patent is not good."

Referring to the above cases in *Carpenter* v. *Smith*, Lord Abinger, C.B., said: "I was counsel in the cases of *Lewis* v. *Marling* and *Jones* v. *Pearce*, and I recollect that those cases proceeded on the ground of the former machines being mere experiments which altogether failed." (*s*)

In *Galloway* v. *Bleaden*, (*t*) the patent was for certain improvements in the construction of paddle-wheels for propelling vessels. Tindal, C.J., in directing the jury, pointed out that the main point was, whether the invention was new as to its public use and exercise in England? "Upon that point," said the learned Chief Justice, "the law is undoubtedly now understood to be this—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—that is not such an invention as should prevent another person, who is more successful, or pursues with greater industry the chain 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; therefore, the main point in this case is, whether all that is allowed to have been done by *Mr. Field* rested in experiment, and unsuccessful experiment, not conducted to its full result, or whether it was a complete discovery of that which now forms the subject-matter of the patent. . . . The witness says, 'In 1835 we made a great many

(*s*) 1 W. P. C. 543.

(*t*) 1 W. P. C. 521, p. 525.

experiments, of which the general character was to ascertain the various qualities of wheels, chiefly cycloidal wheels, and comparing those wheels with *Morgan's* wheels. I had a very extensive apparatus constructed for the purpose of these experiments; it stood in a very public part of the premises, no person was excluded, a great many saw it. It was in the thoroughfare of the manufactory. We had between 400 and 500 employés at that time in our manufactory.' . . But that apparatus they constructed merely for the purpose of deciding on these experiments. . . . Mere experiment, afterwards supposed by the parties to be fruitless, and abandoned because they had not brought it to a complete result, that will not prevent a more successful competitor, who may avail himself, as far as his predecessors have gone, of their discoveries, and add the last link of improvement in bringing it to perfection. If that is the case, the plaintiffs are entitled to your verdict."

In *Gibson* v. *Brand*, (*u*) the same learned judge said: "It would not be sufficient to destroy the patent to shew that learned persons in their studies had foreseen, or had found out this discovery that is afterwards made public, or that a man in his private warehouse had, by various experiments, endeavoured to discover it and failed, and had given it up."

In *Bentley* v. *Fleming*, (*v*) the patent was for a card machine. There was evidence that about five or six weeks before the letters patent were obtained, the inventor had lent a machine, constructed according to this patent, and in complete working order, to one *N*——, for the purpose of trying whether it would set the teeth of the cards. *N*——'*s* room, where the machine was placed, was in a mill, and the evidence shewed that workmen were constantly going backwards and forwards to and from the room. On this, counsel for the defendant contended that the patent was bad from prior user. But Cresswell, J., overruled the objection. (*w*)

In *Stead* v. *Williams*, (*x*) Tindal, C.J., said: "As to its being publicly known in this country, I take it that there is a great difference between the knowledge of it 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 you are dealing with an article of merchandise, or with an article of ordinary use—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

(*u*) 1 W. P. C. 628.
(*v*) 1 C. & K. 587; 4 C. B. 479.
(*w*) But see Fry, L.J., in *Humpherson* v. *Syer*, 4 R. P. C. 415.
(*x*) 2 W. P. C. 126, p. 135; 13 C. P. 218; 7 M. & G. 818.

is forgotten and gone by—then another person re-introducing it may, within the meaning of this Act, be the inventor and first user of it so as to justify a patent. There is one instance where a patent was taken out for wheels on the suspension principle, bearing a proportion of the weight from the upper rim of the wheel, as well as supported on the spokes below by the perpendicular pressure. It was proved in that case that *Mr. Strutt* of Derby had used a cart with wheels on that principle some time before. After using it a year or two he threw it aside. It was totally forgotten; and some fifteen years afterwards, a man brought the thing to perfection, and took out a patent; and it was held that that former use by *Mr. Strutt* having been abandoned as a useless thing was no impediment in the way of a patent. (*y*) So also in the case alluded to of *Cornish* v. *Keene*. (*z*) An attempt had been made to introduce new elastic matters, combined, for the purpose of making braces and bandages and various articles of that sort. I remember well in that case the Chief Justice left it to the jury to say whether these were experiments. Some pieces were actually produced which had been manufactured, and some of these things which had been manufactured had been sold. It was left with the jury to say whether that was an introduction of it, so manifest, or whether it was a mere failing experiment, which had been abandoned so as to leave the way open to any new speculator in it, who yet might bring the patent to perfection."

In *Household* v. *Neilson*, (*a*) Lord Brougham said: "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 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."

In *Honiball* v. *Blumer*, (*b*) Martin, B., while expressing an opinion that the antecedent user in that case had not been mere experiment abandoned as a failure, said: "I think myself if it was really an experiment, that if *Mr. L.* had put this anchor, having invented it or manufactured it, on board the *W. H.*, or a steamboat for

(*y*) *Jones* v. *Pearce*. 1 W. P. C. 122.
(*z*) 1 W. P. C. 511; 3 Bing. N. C. 588; 6 L. J. C. P. 225.
(*a*) 1 W. P. C. p. 713; 9 Cl. & F. p. 808.
(*b*) 2 W. P. C. 199; 10 Ex. 538; 24 L. J. Ex. 11.

the purpose of trying whether it would answer, and it did not answer, and then it was returned on that ground, then I do not think that would interfere with the patent, but I do not understand that it was so," etc.

In the case of *Daw* v. *Eley*, (*c*) Wood, V.C., held that the antecedent existence of an invention not shewn to have been brought to any successful result, but which was so far similar to the protected invention, that if subsequent in date to the patent it would have been held a colourable and clumsy imitation for the purpose of effecting the same result, did not invalidate the patent by anticipation.

In *Edison & Swan* v. *Woodhouse*, (*d*) where the patent related to the incandescent electric lamp, the defendants relied on anticipation by a lamp exhibited at Newcastle by *Mr. Swann* prior to the date of the grant. The evidence, however, shewed that this lamp had not come into practical use, but remained a mere scientific curiosity. On this the Court of Appeal held that the lamp was no anticipation. Fry, L.J., said: "On the 12th March, 1879, *Mr. Swan* again described his lamp to a Gateshead audience, but it does not appear that he exhibited it; and from that time it has, so far as this case is concerned, disappeared from history, and its disappearance is, we think, cogent evidence that *Mr. Swan's* lamp, as it was exhibited, was not a practical success; that *Mr. Swan* could not do what *Mr. Edison* did, and that the difference between the carbon rod and the carbon filament was the difference between failure and success."

Prior User at a remote Date is usually mere Experiment.—In *Mosley* v. *The Victoria Rubber Company*, (*e*) the following case of prior user was chiefly relied upon. In the year 1860, twenty-three years before the date of the plaintiff's patent, one *Heartfield* was engaged experimenting in printing on indiarubber. In the course of these experiments he produced some small patterns of a similar character to the plaintiff's goods, and by similar processes. These experiments he conducted at his own house. The resulting patterns were shewn by him to a *Mr. Packham*, but nothing more was done. The patterns were thrown aside, became decomposed, and were eventually destroyed. Declining to infer prior user from this evidence, Chitty, J., said: "This evidence is wholly insufficient to establish prior user. It amounts to nothing more than mere experiments treated as of no value to the experimenter himself, and the person

(*c*) L. R. 3 Eq. 497.
(*d*) 4 R. P. C. 92.
(*e*) 4 R P. C. 241.

to whom he shewed them, but cast aside as worthless some twenty-three years before the plaintiff's patent, and suffered to remain in oblivion until they were thought of for the present trial. They did not in any respect add to the stock of public knowledge on the subject." (*f*)

In *Morgan* v. *Windover*, (*g*) it was proved by witnesses who could not be impeached that a carriage spring of construction similar to the plaintiff's had been made and fitted to a carriage forty years before. But there was no evidence of anything further having come of it. The carriage in question had not been sold, but had been made to the order of one coachbuilder by another for the use of a relative of the latter. In the Court of Appeal, Cotton and Bowen, L.JJ. (Lord Coleridge, C.J., dissenting), held that this evidence established only abandoned experiment and not anticipation. (*h*)

In *Dick* v. *Tullis*, (*i*) the Inner House of the Court of Session, reversing the Lord Ordinary, declined to avoid a patent on the evidence of two interested persons, who alleged that they had sold, many years before, articles secretly manufactured by them according to the pursuer's process. In such case unsuccessful experiment is the proper inference to draw. "It is not easy," said the Lord Justice Clerk, "to conceive that a make of belting which has so taken the market that its sale from the date of its introduction by the pursuer has risen by leaps and bounds, and now, in its ninth year, is practically equal to £100,000 per annum, should, when made and put out in hundreds at an earlier period, have left no recollection of it or trace of recollection on the mind of anybody in the trade and should have fallen so flat that it ceased to be manufactured or sold at all. One would gather that either there had been no such sales or that the sellers had not succeeded in producing the same article or anything like it." (*j*)

Profitable User may still be Experiment only.—It may occasionally happen that the nature of the invention may make it impossible for the patentee to test his discovery without some user in public,

(*f*) 4 R. P. C. 253.

(*g*) 4 R. P. C. 417; 5 R. P. C. 295; 7 R. P. C. 131.

(*h*) In the House of Lords the decision of the Court of Appeal was reversed, on the ground that there was not sufficient subject-matter to support a patent for the alleged invention. The finding of the Court below as to prior user, however, was not disturbed (R. P. C. 7, R. P. C. 131.

(*i*) 13 R. P. C. 149.

(*j*) See, also, *Jones* v. *Pearce*, 1 W. P. C. 122. In *Kane* v. *Guest*, 16 R. P. C. 442, prior user of a process occasionally resulting in a saleable product, but eventually discontinued, was held by Stirling J., to be experiment only.

and perhaps even a profitable user. In such a case the Courts, where they have considered the patentee to be dealing fairly by the public, have shewn a disposition to support the patent and treat such preliminary user as experimental.

Thus, in *Newall* v. *Elliott*, (*k*) where the patent was for an apparatus for laying down submarine telegraphic cables, it was proved that the plaintiff—who apparently *bonâ fide* believed that he could not adequately test the practicability of his invention by experiments at his own works—had constructed and used in executing a government contract for laying a cable in the Black Sea an apparatus giving effect to his invention prior to his application for letters patent. Upon this transaction a profit had been realized by the patentee. Finding the apparatus worked successfully, he then took out his patent. It was proved that great care had been taken to confine all knowledge of the apparatus to the inventor's own workpeople; nevertheless, the apparatus had been seen by a number of other persons, including a government officer, under whose supervision the cable had been shipped. No use had been made by any one of the knowledge so obtained. On these facts the Court of Common Pleas held that the proper inference was not prior user but experiment only. Byles, J., in delivering the judgment, said: "A necessary and unavoidable disclosure to others, such as here appears, if it be only made in the course of mere experiments is no publication, although the same disclosure if made in the course of a profitable use of an invention previously ascertained to be useful would be a publication—*In re Adamson's Patent*. (*l*) The answer to this third objection, therefore, depends on the fourth and last and main objection, which was this, that the use of the apparatus for profit before the date of the letters patent was a use which avoided the patent. It must be, and is, conceded on the part of the plaintiffs that an inventor's public use for profit of an invention, already ascertained by previous experiments to be useful, is a gift of the invention to the public, and avoids a subsequent patent; and it is conceded by the defendants that a use before the patent, merely experimental and tentative, does not avoid it. Now, the use here made of the invention in actually laying down the cable was a use which partook of both characters. On the one hand, it was experimental and tentative; but, on the other, the experiment itself turned out to be not only successful but beneficial to the

(*k*) 27 L. J. C. P. 337, p. 342; 4 C. B. (N. S.), 293.

(*l*) 25 L. J. Ch. 457; 6 De G. M. & G. 420.

inventor at the moment. The true question, therefore, seems to be this, Is an experiment performed in the presence of others, which not only turns out to be successful but actually beneficial in the particular instance, necessarily a gift to the world? In the case under consideration experiments on dry land were found to be indecisive, the decisive experiment still remains to be made on a large scale and in deep water. An opportunity presents itself in the course of a government contract—not a contract for the use of that particular apparatus, but a contract for laying down the cable by any means the contractor may select. The experimenter is obliged either to experiment in a way that may turn out to be useful in the particular instance, or else not to make any efficient and decisive experiment at all. The coincidence of an experiment with actual immediate profit or advantage from it, if successful, is unavoidable. Suppose even that this coincidence had been accidental. Suppose that in the course of the voyage the inventor had tried some further and new experiment with an alteration of the apparatus, which alteration had at once answered some useful purpose. Surely that further invention would have been his property. Otherwise, a man cannot have the property in an invention unless it starts from his brain so fully matured and armed that it not only succeeds at the first trial, but accomplishes on that very trial some profitable or useful purpose. If, indeed, the plaintiff in the present case had on other and subsequent voyages used his apparatus and unnecessarily delayed his application for a patent, he would have given his invention to the world. But here, the arbitrator must be taken to have found that the inventor lost no time, but applied for his patent with reasonable expedition."

With the above case may be contrasted the case of *in re Adamson* (*m*), cited in the foregoing judgment. In that case a contractor for certain harbour works had in the progress of his undertaking invented an apparatus consisting of a travelling staging and crane, which greatly facilitated the progress of the works. From the nature of the invention it could only be fully tested in a place and under circumstances which amounted to public user. After having employed the apparatus for four months on the works in question, the inventor applied for a patent. In an affidavit supporting the application it was stated that no one had used the invention except the applicant and the men working under his directions, and that the delay in applying

(*m*) 25 L. J. Ch. 457; 6 De G. M. & G. 420.

for the patent was due to the fact that it was impossible to test the efficacy of the invention except in rough weather and in the public view. Lord Cranworth, C., however, refused the application, on the ground that the four months of preliminary user constituted a dedication to the public.

The decision in this case is clearly distinguishable from *Newall* v. *Elliott*, (*n*) inasmuch as the Lord Chancellor was of opinion, on the evidence before him, that the applicant so far from having acted only in the way of *bonâ fide* experiment, had not originally intended to take out a patent at all.

In *Hoe* v. *Foster*, (*o*) the patent was for an invention connected with printing, imported from America, where it was already known and in practical use. Prior to the taking out of letters patent in this country the invention had been used on several occasions in the printing of a daily paper at Liverpool. Such user, it was contended, was merely experimental, and had been resorted to only for the purpose of testing whether the invention would work in practice. The Court, however, rejected this argument, and held that user under such circumstances was a dedication of the invention to the public, and avoided the subsequent letters patent.

No Anticipation by a Useless Machine.—It sometimes happens that the skill of an inventor lies in his applying to a useful purpose a machine or process which has formerly existed or been known only in an impracticable form, or as a chemical curiosity. Where this is so the prior existence or knowledge of the useless machine or process is no anticipation of the later application of it in a valuable form, unless it can be shewn that no further invention was required to achieve the successful result, as would be the case, for instance, where the uselessness of a machine was due to defects which any workman of reasonable skill could remedy. (*p*)

In *Jones* v. *Pearce*, (*q*) Patteson, J., directed the jury that if the anticipation relied upon by the defendant had in their opinion been a useless invention, then it did not defeat the plaintiff's patent.

In *Murray* v. *Clayton*, (*r*) James, L.J., quoted and followed the dictum of Patteson, J., in the above case. The learned Lord

(*n*) 27 L. J. C. P. 342; 4 C. B. (N. S.), 293.

(*o*) 15 R. P. C. 573; 16 R. P. C. 33.

(*p*) *Barlow* v. *Baylis*, Griff. 45 (per Brett, J.).

(*q*) 1 W. P. C. 124.

(*r*) L. R. 7 Ch. 581.

Justice said: "I am not aware of any principle or authority upon which the exhibition of a useless machine, which turns out to be 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. . Therefore, if there were defects in the German machine which made it useless, and the plaintiff afterwards made a machine in which those defects were remedied so as to make it a good machine instead of an abortive one, he would be entitled to maintain his patent."

In *Young* v. *Fernie*, (s) the patent was for a process of obtaining paraffine oil for practical purposes by heating bituminous coal. It was objected that the invention was not new; that the production of paraffine oil from coal was well known to chemists; and that means of achieving it by a heating process had been described before. The evidence shewed, however, that while this was so, no one had yet succeeded in attaining a process by which oil could be produced in such quantities and with such ease as to make the product a merchantable article; while, on the other hand, many laborious experiments had been made by different persons with this object but without success. The plaintiff's process was the first process which had really attained this result.

Stuart, V.C., held that the plaintiff's invention was good subject-matter for a patent. His Honour said: "*Mr. Fernie*, one of the defendants, has adduced in evidence a passage from the work of an eminent American chemist, *Dr. Antisell*. . . . This book contains a short history of the manufacture of paraffine oils and paraffine, and it gives the following extract from a publication by Reichenbach in 1854: 'So remained paraffine unto this hour, a beautiful item in the collection of chemical preparations, but it has never escaped from the rooms of the scientific man.' Something, therefore, remained to be ascertained, in order to the useful application of this article for economical and commercial purposes. This illustrates 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 economical and commercial purposes, that which previously existed as a beautiful item in the cabinets of men of science. What the law looks to is the inventor and discoverer who finds out and introduces a manufacture which supplies the

(s) 4 Giff. 577; 10 L. T. (N. S.), 865.

market, for useful and economical purposes, with an article which was previously little more than the ornament of a museum. It has been established, to my satisfaction, by the evidence in this case, that the plaintiff *Young* is an inventor of this class, and that his patent is entitled to the protection of the law. I find that he has ascertained, by a course of laborious experiments, a particular class of materials among many, and a particular process among many, which has enabled him to create and introduce to the public a useful manufacture, which amply supplies the market with that which, until the use of the materials and 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 paraffine and paraffine oils. This brings it within the principle stated by the Lord Chancellor in the late case of *Hills* v. *Evans*." (*t*)

(*t*) 31 L. J. Ch. 457; 4 De G. F. & J. 288.

CHAPTER VIII.

UTILITY OF THE INVENTION.

Utility Essential.—No invention is valid subject-matter for a patent grant unless it is useful. (*a*) The condition of utility, like that of novelty, is an ancient condition of the common law. At law no monopoly (involving, as it necessarily did, a temporary deprivation of public right) could be supported which did not eventually result to the advantage of the community. (*b*) A monopoly when granted by the Crown to an ingenious inventor as a reward for a useful discovery was an encouragement to others to invent, and so increase the industrial wealth of the nation. Such a monopoly was therefore justified in the public interest. But a monopoly granted to an inventor of some useless contrivance, so far from stimulating the progress of the country, merely hindered and hampered trade by conferring, at the expense of the public at large, a special privilege upon an undeserving person. (*c*) Hence, it has always been upon the assumption that he has discovered a useful invention, that an inventor has come to the Crown to ask the grant of a patent monopoly, and upon such assumed utility, in fact, is the grant always made. (*d*)

The word "utility" does not occur in the Statute of Monopolies, but this essential quality of every patentable invention is clearly preserved by that Act. In *Morgan* v. *Seaward*, Parke, B., said: "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 James I., which requires as a condition of the grant that it should not be so, for no addition or improvement of such

(*a*) Coke, 3 *Inst.* 184.
(*b*) See ante, pp. 4, 7.
(*c*) See Ashurst, J., in *Turner* v. *Winter*, 1 T. R. 605; 1 W. P. C. 8.
(*d*) See ante, pp. 7, 40.

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." (*e*) Referring to the same point in *Elias* v. *Grovesend Tinplate Company*, (*f*) Lindley, L.J., said: "The Statute of Monopolies, 21 James I., prohibits monopolies, but says in Section 6 that, 'Any declaration before mentioned against monopolies shall not extend to any letters patent'—I am reading it short—' for fourteen years for the sole working or making of any manner of new manufactures within this realm to the true and first inventor of such manufactures, which others at the time of making such letters patent shall not use.' Then comes a passage which is often forgotten, but which is of the utmost importance in dealing with patent cases—' So as also they '—that is, the letters patent—' be not contrary to the law, or mischievous to the State by raising of prices of commodities at home, or hurt of trade, or generally inconvenient.' That is to say, it does not follow that because there may be something which answers the description of a new manufacture that, although there may be some person who, in one sense, can be called an inventor, he is entitled to a patent for his new manufacture. It is very singular that the Statute of James says nothing whatever about utility, but utility has been engrafted into it because of the words to which I have called attention: that is to say, it has been found by experience to be mischievous to the State to grant patents which are not useful as well as new. I call attention to that to shew the extreme importance of those words." (*g*)

It would be superfluous to do more than glance very briefly at the authorities on a point so well established.

In *The King* v. *Arkwright*, (*h*) Buller, J., held that it was a

(*e*) 2 M. & W. 562; 1 W. P. C. 197.

(*f*) 7 R. P. C. p. 467.

(*g*) Recitals alleging the utility of the invention were inserted in early patent grants. In *Lord Dudley's Patent* (1622) the following recital is found, "We, graciously favouring and willing to cherish ingenious and profitable inventions, and finding that the working and making of the said iron, by the means aforesaid within this kingdom, will not only in itself tend to the public good thereof, but also thereby the great expense and waste of timber and wood converted into charcoal and consumed upon iron-works will be much abated, and the remnant of wood and timber within this land will be much preserved and increased; of the want whereof not only ourself in respect of provision for our shipping and otherwise, but also our subjects for many necessary uses are very sensible, and holding it agreeable to justice that the authors of so laudable and useful inventions should in some good measure reap the fruits of their studies, labours, and charges, KNOW YE," etc., 1 W. P. C. 14. See, also, the *Smalt Patents*, 1 W. P. C. 9.

(*h*) Dav. P. C. 138; 1 W. P. C. 64.

question for the jury whether the material part of the machine described in the specification was useful, and that if they were satisfied that it was not so, then the patent was void.

In *Turner* v. *Winter*, (*i*) Ashhurst, J., said that the patent would be contrary to law if the public did not derive an advantage from the communication of the invention.

In *Manton* v. *Parker*, (*j*) the utility of the invention failed, and the patent was held void.

In *Manton* v. *Manton*, (*k*) and *Bovill* v. *Moore*, (*l*) Gibbs, C.J., held that in order to support a patent monopoly the plaintiff must show that his invention is useful.

In *Russell* v. *Cowley*, (*m*) Lord Lyndhurst, C.B., said that the first question to be considered was whether the invention was new and useful.

In *Hill* v. *Thompson*, (*n*) Dallas, J., directed the jury that the invention must be useful, and Lord Eldon cited this ruling with approval.

In *Neilson* v. *Harford*, (*o*) the Court of Exchequer held that the machine protected by the patent must be one beneficial to the public.

In *Dangerfield* v. *Jones*, (*p*) Wood, V.C., said: "A mere trifling matter, a thing of no value, will not do; you must shew that you have invented something useful—a new and useful improvement in manufacture."

And in *Young* v. *Rosenthal*, (*q*) Grove, J., said: "The invention must be new and useful; to be useful it must be new. There is no utility in inventing something known before."

A Small Amount of Utility is Sufficient.—The Court will not weigh nicely the degree of utility in an invention. A very small amount of utility is sufficient to support a patent.

In *Morgan* v. *Seaward*, Alderson, B., in directing the jury, said: "It is not for you to consider to what extent the thing is useful. If it is a useful invention, then it is a subject to be protected by patent; and if, on the other hand, it is of no use, then it is not a subject to be protected by patent. The issue is whether it is of any use at all. It is not material, however, that the

(*i*) Dav. P. C. 151; 1 T. R. 602.

(*j*) Dav. P. C. 327; 1 W. P. C. 192 n.

(*k*) Dav. P. C. p. 349; 1 W. P. C. 192 n.

(*l*) Dav. P. C. p. 399. See, also, Lord Ellenborough in *Huddart* v. *Grimshaw*, Dav. P. C. 265; 1 W. P. C. 86.

(*m*) 1 W. P. C. 467.

(*n*) 3 Mer. p. 629; 1 W. P. C. p. 237.

(*o*) 3 M. & W. 806; 1 W. P. C. 331.

(*p*) 13 L. T. (N. S.), 142.

(*q*) 1 R. P. C. 30.

improvement should be great. It is sufficient if it is an improvement at all." (*r*)

In *Haworth* v. *Hardcastle*, (*s*) the patent was for an invention of machinery for taking up calicoes, muslins, linens, and other similar fabrics for the purpose of drying. The same learned judge gave a like direction to the jury, who found that the machine was new and useful on the whole, though not useful in some cases; and the Court of Common Pleas, on argument for a non-suit, held the direction right and the utility sufficient.

In *Tetley* v. *Easton*, (*t*) Pollock, C.B., said: "It is not necessary that a patent should be so useful as to exclude everything else; it is quite sufficient if on any occasion it is useful."

In *Plimpton* v. *Malcolmson*, (*u*) Jessel, M.R., said: "As regards utility, the law is very clear that a small amount of utility will do. There are so many authorities on the subject that I am almost ashamed to mention them, but nothing can be better settled. I will refer without reading them to *Neilson* v. *Harford* (*v*) and the *Household Coal and Iron Company* v. *Neilson*. (*w*) I might refer to a couple dozen cases if necessary as to the utility, and they all shew what a very small amount will do."

So likewise in *Otto* v. *Linford*, (*x*) the same eminent judge laid down a similar rule as to the amount of utility required to support a patent. There it was contended that one of the patentee's claims was for a matter which was useless; in coming to another conclusion, Jessel, M.R., said: "Therefore there is evidence of utility. It is very small indeed as regards No. 1, because that is not the one which proved most useful, but it is quite sufficient for the support of a patent, and as to this question of utility very little will do."

Again, in *Phillpott* v. *Hanbury*, (*y*) Grove, J., said: "It has been decided over and over again that the slightest amount of utility (I will not say an infinitesimal scintilla, but a very slight amount of utility) is sufficient to sustain a patent."

In the case of *Badische Anilin und Soda Fabrik* v. *Levinstein*, (*z*) Lord Halsbury, C., citing with approval the above-quoted dictum of Alderson, B., said: "Baron Alderson once said, if it was of any use to the public, a new invention could not be said to be void

(*r*) 1 W. P. C. p. 172. Cf. Coleridge, J., in *Betts* v. *Menzies*, 14 Q. B. 374.
(*s*) 1 Bing. N. C. 182; 4 Mo. & Sc. 720.
(*t*) Macr. P. C. 63.
(*u*) L. R. 3 C. D. 582.
(*v*) 1 W. P. C. 295.
(*w*) 1 W. P. C. 675.
(*x*) 46 L. T. (N. S.), 41.
(*y*) 3 R. P. C. 33. See, also, *Pirrie* v. *York Street Flax Co.* 10 R. P. C. 39; 11 R. P. C. 429.
(*z*) 12 App. Ca. 712; 4 R. P. C. 462.

for want of utility; and an admitted contribution to the useful arts of a new product can hardly be said to be of no use."

Utility does not Depend on Satisfying an Urgent Public Need.—Sufficient utility may exist in a comparatively trifling invention to make it good subject-matter for protection by letters patent. It has never been required of an inventor that he should come to the Crown only with a discovery of urgent necessity to the public. And although Sir Edward Coke says that every new manufacture to deserve the privilege of a patent must have *urgens necessitas* and *evidens utilitas*, (*a*) this, in the light of the authorities, is clearly too severe a test. A new toy may have sufficient utility to support a patent. "The amusement of children of all ages," said Kekewich, J., in *Cole* v. *Saqui*, "is a useful thing, and I see no reason why a top should not be regarded as having utility for the purposes of a patent as much as a steam engine or any other more important machine." (*b*)

In the case of the *American Braided Wire Company* v. *Thomson*, the House of Lords upheld a patent for improvements in the construction of ladies' dress improvers. Lord Herschell, in meeting the objection that the discovery was of a trifling nature, and not of something important to the public good, said: "If the demand of the public for a particular article of dress be better met by a new combination than it has been by articles previously in use, and if this new combination, though its component parts be not new, required some exercise of the inventive faculty to produce it, I think it can be protected by a patent, though it may be impossible to say that the invention is important or necessary for the public good." (*c*)

So likewise in *Young* v. *Rosenthal*, where the patent was for improvements in ladies' corsets, Grove, J., said: "I think in law utility means an invention better than the preceding knowledge of the trade as to a particular fabric. It does not mean abstract utility. Therefore, even if you are of opinion that stays are very bad things, you must not say this is useless because stays are bad things." (*d*)

An invention may have sufficient utility to support a patent in the sense of producing a better article than anything of the like kind previously known in the trade to which it relates, even when the article so produced is better in one respect only, and actually

(*a*) 3 *Inst.* 184.

(*b*) 5 R. P. C. 495; this patent was subsequently held void by the Court of Appeal, for want of novelty and invention; 6 R. P. C. 44.

(*c*) 6 R. P. C. 528.

(*d*) 1 R. P. C. p. 34.

inferior in others. For such an invention affords the public a larger area of choice in the particular class of article, and some persons may prefer the same article with one quality accentuated, others with another.

Thus, in the case of incandescent gas lighting, a mantle of greater rigidity than any used before may have, by reason of that quality, a patentable utility, even although this result is attained by a process causing a reduction of the illuminating power below that of mantles previously known.

Commenting on this in the *Welsbach Incandescent Gas Light Company* v. the *New Incandescent Company*, (*e*) Buckley, J., said: "Now, utility in patent law does not, as I understand it, mean either abstract utility, or comparative or competitive utility, or commercial utility. It was described by Grove, J., in *Young* v. *Rosenthal*, (*f*) as meaning an invention better than the preceding knowledge of the trade as to a particular fabric. I adopt this definition if the word 'better' be understood as meaning better in some respects and not necessarily better in every respect; so that, for instance, an article which is good, though not so good as that previously known, but which can be produced more cheaply by another process, is better in that it is better in point of cost, although not so good in point of quality. So here I conceive that a mantle constructed, according to prescription No. 1, of thorium pure, according to the knowledge of 1886, and which gave only 3 candles, or pure in fact, according to the knowledge of to-day, and giving only 1·3 candle, although worse as an illuminating appliance than the mantle of 1885, which gave 4 or 4·5 candles, was nevertheless better if it possessed in a greater degree the qualities of rigidity, durability, or stability. I may illustrate this by saying that, in point of fact, subsequent knowledge has shewn that it was useful, because by the subsequent discovery that a small percentage of cerium will increase its luminosity, the step which was taken in 1886 has led to the possibility of making subsequently, in 1893, a mantle which is not only durable and stable, but possesses also high illuminating power. Again, I may take another test of utility, namely, that an invention is useful for the purposes of the patent law, when the public are thereby enabled to do something which they could not do before, or to do in a more advantageous manner something which they could do before, or, to express it in another way, that an invention is patentable which offers the public a useful choice."

(*e*) 17 R. P. C. 237; 16 T. L. R. 205.

(*f*) 1 R. P. C. p. 34.

The Utility required is the Utility of All.—Although a slight amount of utility will support a patent, all that the patentee distinctly claims must be useful. If anything claimed by him as essential is useless, the patent will be void. For, as in the case of novelty, the consideration for the grant is the utility of all claimed, and it is a consideration which is whole and indivisible. Therefore if bad in part it is bad in all. (*g*)

In *Morgan* v. *Seaward*, (*h*) Park, B., said: "This brings me to the question whether this patent, which suggests that certain inventions are improvements, is avoided if there be one which is not so. And upon the authorities we feel obliged to hold that the patent is void, upon the ground of fraud on the Crown, without entering into the question whether the utility of each and every part of the invention is essential to a patent where such utility is not suggested in the patent itself as the ground of the grant. That a false suggestion of the grantee avoids an ordinary grant of lands or tenements from the Crown is a maxim of the common law; and such a grant is void not against the Crown merely, but in a suit against a third person." (*i*)

In the *United Horseshoe and Nail Company* v. *The Swedish Horse Nail Company*, (*j*) Lord Kinnear said: "The respondents particularly maintain that the patent is void, because it claims an invention which is altogether useless, and I think, upon the decisions, this contention is well founded. The defect might no doubt be remedied by disclaimer, but it appears to me settled by the case of *Templeton* v. *Macfarlane*, (*k*) and others in the same direction that while the sixth claim stands as a separate and distinct claim for a meritorious invention, the patent cannot be sustained. It is said that if a patent be taken out for a good and new invention it shall not be invalidated because the specification includes some minor claim which turns out not to be useful, provided there be no concealment, and that is a perfectly sound proposition; but the result of the decisions appears to be that the question must always be whether the useless part of the process or apparatus described is set forth in the patent as a separate invention, and, therefore, as a consideration for which the patent is granted; and, in considering the patent, I am unable to arrive at any other conclusion than this, that the patentee does set forth this very minor invention as part of the consideration for which

(*g*) See ante, p. 17.
(*h*) 2 M. & W. 561; 1 W. P. C. p. 196.
(*i*) See, also, *Travell* v. *Carteret*, 3 Lev. 135; *Alcocke* v. *Cooke*, 5 Bing. 340.
(*j*) 6 R. P. C. 8.
(*k*) 1 H. of L. Ca. 595.

he is to get his patent right, and, so long as that stands, I am unable to resist the effect of the decisions."

Utility not Required in a Non-essential Part.—But a want of utility in some part of a machine which is not essential will not vitiate a patent for the whole.

In *Lewis* v. *Marling*, (*l*) an objection was taken that the patentees claimed as part of their invention "a proper substance to brush the cloth," and directed plush to be used for that purpose; which brushing contrivance was useless. Subsequent to the filing of their specification the patentees had discovered that the brush could be dispensed with, and, in fact, was not necessary to the end in view; and it was proved that out of some thousand machines sold by them none had this apparatus attached. The objection was not allowed to prevail. Lord Tenterden, C.J., said: "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 it is an invention. When the plaintiff 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 whereby he misleads the public, his patent may be void; but it would be very hard to say that this patent should be void because the plaintiffs claim to be the inventors of a certain part of the machine not described as essential and which turns out not to be useful."

Where Several Claims, all need not be Equally Useful.—So likewise it is no objection to a patent claiming several things to shew that all the claims are not of equal utility, provided each separate claim contains some utility. And where the patentee claims several things, some of which are obviously useful, the Court will be disposed, if it can reasonably do so, to ascribe utility to the more doubtful claims, or to construe them as subsidiary to the main invention. (*m*)

"It is very old patent law," said Kekewich, J., in *Ehrlich* v. *Ihlee*, (*n*) "that in construing different parts of the claim where you have general utility, that is, utility of the invention as a whole, you are not bound to prove that each part is equally useful. Nor is it

(*l*) 1 W. P. C. p. 495; 10 B. & C. 25.

(*m*) *Badische* v. *Leivinstein*, 4 R. P. C. 449 (per Lord Herschell); *Lewis* v. *Marling*, 10 B. & C. 22; 1 W. P. C. 493.

(*n*) 5 R. P. C. 203.

a fatal objection to a patentee's claim that one part has in practice not been found to be so useful as the others, so that it has dropped out of commercial use."

In *Siddell* v. *Vickers*, (*o*) the plaintiff's patent was for an appliance for operating upon large forgings. In his specification the plaintiff claimed three processes which, though capable of combination, had for some purposes to be treated separately. One was a process by which a lever was worked by means of attachment to the crane-wheel above it, and this was clearly useful. The defendants themselves had used and were using it. The other two processes presented some difficulty. One of these, called the gas-tongs arrangement, had never been worked, and was said by the defendants to be useless. The other, the automatic action of the wheel, endless chain, and lever, had been but little used and was also alleged to be useless. At the trial, Kekewich, J., came to the conclusion that the real objection to the patent was that two of the processes were not so useful as the third, and held there was sufficient utility in each of the three processes, and, on appeal, the judgment below was affirmed.

In this case there was no evidence to shew that either of the processes objected to as lacking in utility could not be put into practical operation. The only question was, Could they be so worked as to be commercially useful? On this the learned judge said: "There is a doubt on the evidence whether the automatic action is of practical value, and some of the defendant's witnesses, men of great experience and learning, whose opinions are entitled to the highest credit, think that it is not. They are met by opinions weighty, if not of equal weight, on the other side; but I have, in addition to those opinions, the uncontradicted statements of a witness fully competent to use his eyes and to form conclusions, and he saw this machine work. *Dr. Hopkinson* tells me that he witnessed the automatic action attempted at the defendant's works, and that it did turn an ingot 'to a sensible degree'—'to an extent' as he explained it, 'that it might be very useful in the press.' From the same witness and others I must conclude that the gas-tongs arrangement, as it has been styled, will work; and though the circumstances under which it might be conveniently applied are not likely to frequently occur, so that this arrangement will probably not be a large addition to the practical information of manufacturers, yet it seems impossible to say that it will not work, or that if and when those circumstances do occur, it might

(*o*) 5 R. P. C. pp. 96, 97.

not usefully be applied to them. Both these processes, as well as the other, secure freedom from that danger which appertained to the old porter-bar arrangement. Both are more or less portable, that of the automatic action being quite as portable as that where the lever is worked by a crane, and the automatic action, certainly the gas-tongs arrangement, probably shares with the one last mentioned the enormous advantage of economy. The evidence that, by means of the plaintiff's processes, that is, by all except the gas-tongs arrangement, which has not been put into practice, the employment of many hands, and consequently the payment of large wages, is avoided, is overwhelming, and, indeed, not attempted to be denied."

The Utility Required is the Utility Suggested by the Patentee.—At the same time, the utility required is utility for the purpose for which the invention is designed. Usefulness only for some other collateral purpose is not sufficient. If the patent is taken out for one thing it will not save it to shew that it is useful for another.(*p*) Hence, if an inventor claims that his invention is capable of a far wider application than is in fact the case, its utility to a limited extent will not in such case save the patent from being invalid.

In *Easterbrook* v. *The Great Western Railway Company*, (*q*) the patent related to improvements in apparatus for actuating railway points or signals. It was proved that, though useful in application to points that were simple, where the points were complex the invention could not be relied on, and its employment was in fact fraught with danger to the public. On this Wills, J., said: "The specification here points to its universal application for railway signalling, including its use at the most complicated junctions and sidings. If it be useful for one very small and insignificant section of its proposed work, and for the rest is, as in my opinion it is proved to be, fraught with danger and death, the specification is bad, as not distinguishing between its useful and useless application. It is as consonant with good sense as I believe it to be good law, that an inventor who invites the indiscriminate use of apparatus sure to bring about disaster in the long run, if generally applied according to his invitation, cannot maintain a patent for his invention because it will do some useful work at places, and under circumstances where mechanical appliances for preventing conflict of signals are scarcely necessary at all, whilst elsewhere it is full of danger to the public."

(*p*) *Cornish* v. *Keene*, 1 W. P. C. 506 (per Tindal, C.J.). (*q*) 2 R. P. C. 201.

How far Non-user is Evidence of Want of Utility.—The fact that an invention when known has not come into use, or has after use been abandoned by the patentee himself, is strong presumptive evidence of want of utility.

In *Hinks* v. the *Safety Lighting Company*, (*r*) Jessel, M.R., said: "The thing itself" (a duplex burner for lamps) "may not be useful at all, and I am not sure that it is. . . . The reason why I am not sure is that it was never put in practice. I cannot understand a practical lamp-maker not putting in practice a useful burner for so many years. That is my reason for doubting its utility, and I very strongly doubt it."

The non-user or abandonment of an invention is not, however, conclusive proof of want of utility. In the case of *Otto* v. *Linford*, (*s*) this matter was discussed in the Court of Appeal. Jessel, M.R., said: "The next objection is that there was no evidence of utility. That is an objection of the most moderate kind. It is quite true that it has been said that it is *primâ facie* evidence of want of utility if you do not make and vend your machine; but that is subject to this observation, that you may make and vend an improvement upon it, and if you have found immediately after you have patented your invention that it can be improved, it does not by any means shew that the first invention was useless. In *Renard* v. *Levinstein*, (*t*) I was counsel for the defendant, and took the same objection. That was an invention for a dye. There the plaintiffs never sold an ounce of dye made according to the patent, because immediately afterwards the inventor had discovered an improvement, and they had always sold the improved dye, and they were obliged to call a witness and shew they had made a few ounces of dye and tried it, and that it would dye. The answer was that under the circumstances the mere fact of not selling the original dye was nothing at all. In this case we have a rather stronger illustration, because the inventor has patented three modifications, and it turns out that what he had used, made, and sold, have been almost entirely No. 3's, and that the other things sold have been almost entirely—not quite—improvements on No. 1. No. 1 itself does not appear ever to have been sold; but the plaintiff says that No. 1 will work, and he calls witnesses to prove it, and there is no evidence on the other side. Of course nothing could

(*r*) L. R. 4 C. D. p. 616; 36 L. J. Ch. p. 394; see also *Macnamara* v. *Hulse*, Car. & M. 471; 2 W. P. C. 292.

(*s*) 46 L. T. (N. S.), 35, p 41.

(*t*) 11 L. T. (N. S.), 505; 2 H. & M. 628; 13 W. R. 382.

have been easier for the other side than calling witnesses who had made machines according to No. 1; therefore, there is evidence of utility."

In the *United Telephone Company* v. *Bassano*, (*u*) it was contended by the defendants that a portion of the plaintiffs' invention had never been used by them, and was in fact useless. On this North, J., said: "The third point raised may be very shortly disposed of. It is that Edison's invention, especially the tension regulator portion thereof, is not commercially useful, and has never been in actual use. If this be so, it does not follow necessarily that the patent is bad. Lord Maclaren disposed of that argument by saying, (*v*) "It does not appear that any of the mechanical combinations described in the specification came into commercial use, probably, because as may happen in the history of even the most original and valuable inventions, these were immediately superseded by simpler constructions involving the same principle."

In *Erlich* v. *Ihlee*, (*w*) where the patent was for "improvements in mechanical musical instruments," the patentee claimed—1: A rotative music sheet, consisting of a perforated disc, formed to co-operate with valve levers; 2. The same disc, but formed in two parts, so that a longer piece of music might be played (by means of changing the half-discs while the instrument was in operation) than could be compressed into a single undivided disc.

It was contended that the second claim was bad for want of utility, on the ground that the device for changing the half-discs so as to play a longer piece of music, could not be worked in practice; and that, therefore, the patent was bad. It was shewn, by a practical experiment, that the half-discs could be made to work. But it was proved that they had not been a commercial success, and that there was no demand for this form of the machines by the public.

Cotton, L.J., in refusing to adopt this objection to the patent, said: "It was said that, in fact, these half-discs had not been sold. Well, they have not been. They have not been a commercial success; but that is not necessary. In my opinion, it is not necessary, in order to support a patent, to shew that all that is claimed is commercially a success. If it can be practically used, a very little utility is sufficient to prevent its being said that there has been a deception practised by taking this part of

(*u*) 3 R. P. C. 313.
(*v*) See *United Telephone Co.* v. *Maclean*, 9 R. 710.
(*w*) 5 R. P. C. 198 and 437.

the invention—the invention communicated to the public being the consideration in respect of which the monopoly is granted." (*x*)

On the same point, Bowen, L.J., after commenting on the experiments under claim two, and the inconvenience which appeared to attend the use of the semi-circular discs, referred to the fact that it was now possible to get longer pieces of music into circular discs than had formerly been supposed possible, and laid some stress on this in construing the doubtful claim. His lordship said: "The truth is, that with regard to this second claim and its utility, it is impossible to forget that, owing to the progress in the manufacture of these instruments, it has been found easy and practicable to compress into one whole circular disc, most of the music which it is desired to play in these instruments. But, nevertheless, there are pieces of music, I dare say, which would not easily be compressed within the compass of the circular disc, and it may be true that, for the purpose of the more extensive pieces of music, the use of semi-circular discs would be necessary. The real truth is, that for the fair construction of this specification, the second claim is one which, from its very character, and the progress of the manufacture, has become what I may call subsidiary and accidental; and I think very little utility, therefore, need be proved to make this second claim good, and to prevent its being held to be a deception of the Crown." After quoting *Otto* v. *Linford*, the learned Lord Justice proceeded: "I think the second claim points out a mode of using this novel and useful machine which widens the beneficial result you obtain, and enables you—I agree, at some sacrifice, it may be, of convenience—but still enables you, in the instrument, to deal with cases which it otherwise would not cover; and, on that ground, I think the second claim ought to be supported." (*y*)

In *Edison* v. *Holland*, (*z*) it was contended, on behalf of the defendants, that the plaintiff's patent was bad, because no successful incandescent lamps had ever been made according to the specification. It appeared from the evidence that, owing to subsequent improvements in the process, this, in fact, was so. The Court of Appeal, however, declined to recognize this as proof of absence of utility. Cotton, L.J., said: "A patent is not to be defeated simply because subsequent inventions improve the patented article, or because, in consequence of subsequent improvements, no article was, in fact, made in accordance with the specification."

(*x*) 5 R. C. P. p. 450. (*y*) Ibid. p. 455. (*z*) 6 R. P. C. 243, p. 277.

Public Appreciation is Evidence of Utility.—It is evidence of the utility of an invention to shew that the public have appreciated its value, and that large sales have been effected. (*a*)

In *Cornish* v. *Keene*, (*b*) Tindal, C.J., said: "It is an observation not to be lost sight of, that the No. 3 article is one which, according to the testimony of this witness as well as another, has had an extensive sale, and by having had an extensive sale, we are at liberty to ask ourselves how it obtained that; and, although certainly the circumstances of its being considerably cheaper would go a great way to account for that, it would not go the whole way. Therefore, you must ask yourselves whether, in making braces, garters, and other articles for which this web was originally intended, and before the improvement was applied by the public, this has made an improvement upon it before the patent was applied, and is more beneficial and useful to the public than the other was."

In *Ehrlich* v. *Ihlee*, (*c*) Cotton, L.J., discussing the question of the utility of the invention, said: "One great point in its favour is this, that, on the evidence, since this machine has been introduced an enormous number have been sold, and the old machines, which worked by the bands, have become a drug in the market; and to those who delight in such musical instruments, there can be no greater proof that this invention was useful, taken as a whole." And in *Cole* v. *Saqui*, (*d*) Kekewich, J., said: "When a man proves that, in the course of, I think, rather less than two years, he has sold 5448 dozens of this new toy—sold, I think we are entitled to assume, for the amusement of those for whom it is intended—I think that is strong evidence of utility, and conclusive until it is contradicted."

Commercial Value not Essential.—At the same time, an invention may be useful in the sense that will support a patent, although, at the time of the discovery, it cannot be made immediately commercially valuable.

In *Badische* v. *Levinstein*, (*e*) Lord Herschell said: "I do not think it is a correct test of utility to inquire whether the invented product was, at the time of the patent, likely to be in commercial demand, or capable of being produced at a cost which would make it a profitable speculation to manufacture it. The demand for a particular colour depends upon changing fashion and passing

(*a*) *Tetley* v. *Easton*, Macr. P. C. 63.
(*b*) 1 W. P. C. pp. 506, 507.
(*c*) 5 R. P. C. 449.
(*d*) 5 R. P. C. 495.
(*e*) 12 App. Ca. p. 719; 4 R. P. C. p. 466. Cf. Kekewich, J., in *Siddell* v. *Vickers*, 5 R. P. C. 96.

moods of fancy. The one which to-day may be in large demand, may to-morrow be a drug on the market. Again, a process which, at one time could not be worked at a profit on account of the expense of the materials employed, may shortly afterwards be so worked by reason of a diminution in the cost of those materials. Is the person who patents such a process to be deprived of all benefit of his invention when it becomes a commercial success, because at the time the patent was granted it could not be worked at a profit? There are abundant perils already in the path of every inventor, and I am not disposed to add to their number unless compelled to do so."

On the same point Lord Halsbury, C., expressed a similar opinion. "The element of commercial pecuniary success has, as it appears to me, no relation to the question of utility in patent law generally, though, of course, where the question is of improvement by reason of cheaper production, such a consideration is of the very essence of the patent itself, and the thing claimed has not really been invented unless that condition is fulfilled." (*f*)

In *Edison* v. *Holland*, (*g*) Cotton, L.J., in refusing to admit commercial value as a test of utility, said that commercial utility was a new term in patent law.

"A patent," said Charles, J., in *Wilson* v. *Union Oil Mills Company*, "may be a patent for a useful article; it may satisfy the condition of utility, although it may be so expensive as to be commercially useless. That is not the test at all. The question is, does it do, when put in practice by a competent man, what it assumes to do? That is the test of utility." (*h*)

(*f*) 4 R. P. C. p. 462; 12 App. Ca. p. 712.

(*g*) 6 R. P. C. 257.

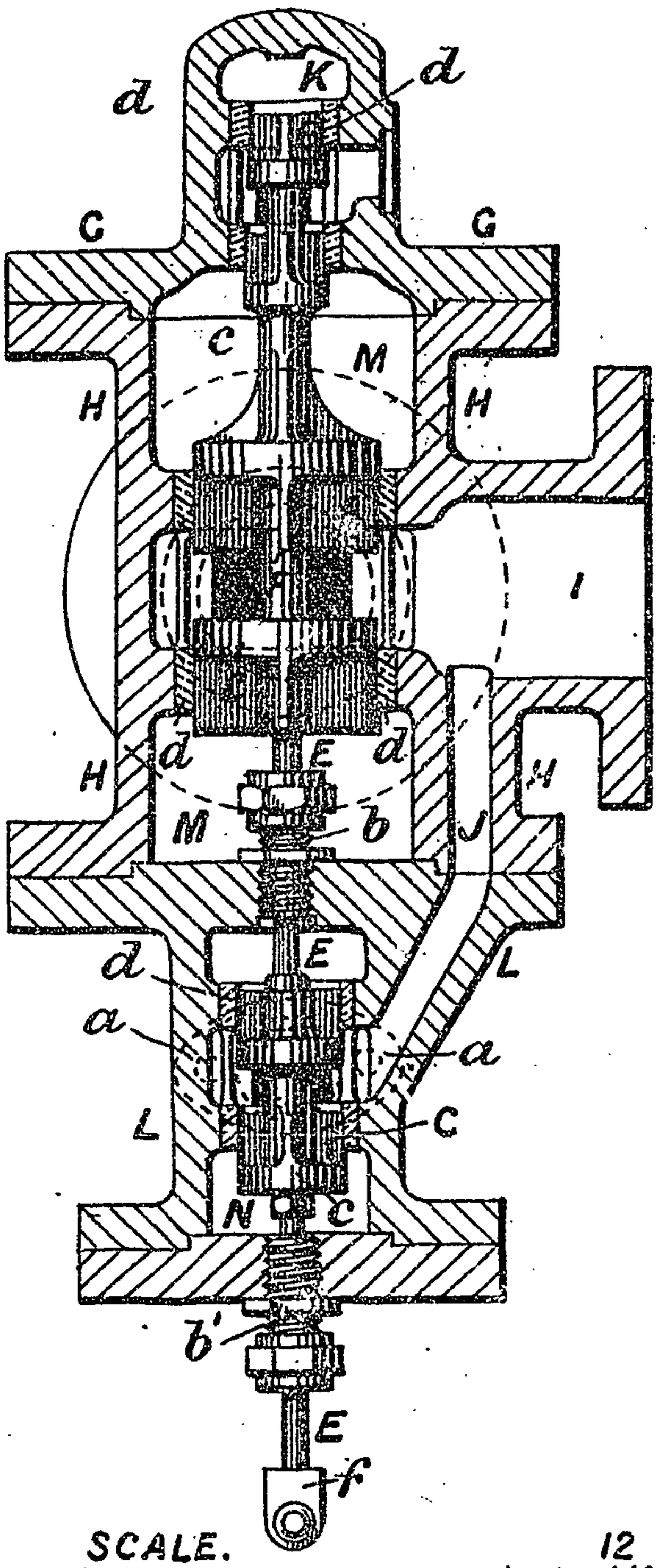
(*h*) 9 R. P. C., p. 70.

Specimen drawing for Specifications.

Border line ½ an inch from edge of paper.

A.D. 18..... No..... (.....Sheets)
Smith's Specification. Sheet.....

FIG. 1.



0 SCALE. 12
INS. INS.

Jas Smith (Applicant)
or Jones & Co.
Agents for Applicant.

Border line ½ an inch from edge of paper.

Size of paper for Specification drawing. { 13 inches by 8 inches. or 13.....16 inches.

CHAPTER IX.

ALL SUBJECT-MATTER MUST BE THE RESULT OF INVENTION.

Invention Necessary.—It is not every new and useful manufacture which can be made the subject of a patent monopoly. To be patentable, a manufacture must not only be useful and new in the sense of not having been done before, it must also be new in the sense of lying sufficiently outside the beaten track to make it not a matter of course that the public sooner or later would have stumbled upon it without the aid of an inventor. It must not be something which would naturally suggest itself to any one using an invention already known, from the use of that invention. (*a*) It must be something found out which is not included in the already existing stock of public knowledge upon the subject with which it deals. It must be something which a person of average intelligence possessed of that knowledge could not have done without the exercise on his part of a special ingenuity. (*b*) It must mean a difficulty overcome; (*c*) in a word, it must be the result of independent invention. (*d*)

The word "invention" is not to be found in the Statute of Monopolies;" (*e*) its use, however, as applied to the subject-matter of monopolies is older than that Act. In *Darcy* v. *Allin* (*f*) the famous case of monopolies, it is laid down that a monopoly may lawfully be granted to any man who brings any new trade into the realm by his own wit or invention; while in the case of

(*a*) *Vickers* v. *Siddell*, 7 R. P. C. p. 305; *Blakey* v. *Latham*, 6 R. P. C. 187.

(*b*) For this purpose the knowledge prevailing in a kindred trade is material. See *Shaw* v. *Barton*, 12 R. P. C. 282.

(*c*) *Williams* v. *Nye*, 7 R. P. C. p. 67.

(*d*) *Morgan* v. *Windover*, 7 R. P. C. pp. 134, 137.

(*e*) The word "Invention" in the Patents Act, 1883 (see s. 46), means any manner of new manufacture, the subject of letters patent and grant of privilege within s. 6 of the Statute of Monopolies. See *Gadd* v. *Mayor of Manchester*, 9 R. P. C. 524.

(*f*) Noy, 182; see ante, p. 5.

the *Clothworkers of Ipswich* (*g*) it is said that a monopoly may be granted of a new invention. The requirement that a grantee of valid letters patent must have exercised inventive ingenuity is therefore incorporated in the Statute of Monopolies by the proviso saving the pre-established rules of the common law.

That the rule of law requiring ingenuity in every patented invention is well founded in reason, is also apparent from the circumstance that patent monopolies are only supported by the law as an encouragement to enterprising persons to find out new devices beneficial to the trade and industrial prosperity of the country. Manifestly this whole purpose would be frustrated if a patent might be granted for an invention "so easy that any fool could do it," to use the words of Lord Esher, M.R., in the *Edison Phonograph Company* v. *Smith.* (*h*) To encourage such inventors would not promote, but only hamper and impede industrial progress by conferring exceptional privileges on persons who had not earned them by any exceptional merit.

There can then be no subject-matter for a patent where there is not something invented. In one sense, no doubt, to say that there must be some invention is only another way of saying that there must be novelty in what the patentee claims to monopolise; and inasmuch as a "manufacture" may be new in the popular sense, and yet not patentable, the test of invention was at one time applied by the Courts usually as a means of ascertaining whether or not a manufacture was new within the meaning which the patent law attaches to that word.

It will, however, be more convenient to consider the subject of invention under a separate heading than to treat it merely as a branch of the subject of novelty, as the tendency in all the later decisions has been to regard invention as a distinct and essential characteristic.

The question whether or not any alleged discovery so involves invention as to make it good subject-matter, is in all cases a question of fact. (*i*)

In *Lyon* v. *Goddard*, Bowen, L.J., thus laid down this proposition: "The question whether there is ingenuity in the matter of a patent is a question of fact. 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

(*g*) Godb. 252.
(*h*) 11 R. P. C. 398.
(*i*) *Lyon* v. *Goddard*, 10 R. P. C. p. 334.

tribunal like the House of Lords. We must apply our mind 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." (*j*)

Invention means more than Novelty.—Mere novelty in the popular sense, then, will not support a patent; there must, in addition, be some difficulty overcome.

In *Britain* v. *Hirsch*, (*k*) the patent was for a mechanical top, in the form of a ballet girl or other figure, with a spinning mechanism within. It was argued that this was new, and, therefore, good subject-matter. The Court of Appeal declined to adopt this view. "I do not agree," said Cotton, L.J., "with the view that when anything is done which has not been done before, that is sufficient to justify a patent being obtained for it. In my opinion, it must be a question of whether there is sufficient invention to justify a monopoly being granted by the Crown in the particular thing."

In *Lane Fox* v. *Kensington, &c., Lighting Company*, (*l*) Lindley, L.J., said: "An invention is not the same thing as a discovery. When *Volta* discovered the effect of an electric current from the battery on a frog's leg he made a great discovery, but no patentable invention. Again, a man who discovers 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. (*m*) 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

(*j*) 10 R. P. C. pp. 345, 346.

(*k*) 5 R. P. C. 226. See, also, *Cole* v. *Saqui*, 6 R. P. C. p. 44, "There must be some ingenuity in that which is new" (per Lindley, L.J.).

(*l*) 9 R. P. C. 416; [1892] 3 Ch. p. 428; 67 L. T. 440.

(*m*) *Britain* v. *Hirsch*, 5 R. P. C. 226 (at 232); *Harwood* v. *Great Northern Railway Co.* 11 H. L. C. 654; *Horton* v. *Mabon*, 12 C. B. (N. S.), 437; *Saxby* v. *Gloucester Waggon Co.* L. R. 7 Q. B. D. 305.

useful purpose for which it has never been used before, is not alone a patentable invention; but, on the other hand, the discovery how to use such a thing for such a purpose will be a patentable invention if there is novelty in the mode of using it as distinguished from novelty of purpose, or if any new modification of the thing or any new appliance is necessary for using it for its new purpose, and if such mode of user, or modification, or appliance involves any appreciable merit. It is often extremely difficult to draw the line between patentable inventions and non-patentable discoveries." (*n*)

In *Riekmann* v. *Thierry*, (*o*) Lord Halsbury, in the course of the argument in the House of Lords, said: "A thing may be new, but unless it has some invention it is not patentable." (*p*) And Lord Davey, in the same case, in dealing with the argument of counsel for the patentees, said: "If the learned counsel meant only that a new and useful article, in the production of which there is invention, is the proper subject of a patent, I suppose nobody will disagree with him. But if he means that an article which is new to the market is, therefore, proper subject-matter for a patent, irrespective of the question whether the production of it was the result of invention, I do not agree, and I am of opinion that it is not the law." (*q*)

In *Gadd* v. *The Mayor of Manchester*, (*r*) the plaintiff's invention consisted in the application of a contrivance of chains and pulleys to the bottom of a gasometer so as to secure that the bottom edges should rise evenly as the gasometer filled, and prevent it leaning out of the perpendicular and losing its stability. This object had formerly been attained by the erection of an outside framework, in which the gasometer rose and fell. It was proved that the plaintiff's contrivance was already known in connection with pontoons and floating docks, and argued that its application to gasometers was so analogous to the known use as not to be subject-matter for a patent. But the Court of Appeal (reversing Kekewich, J.) held that the practical difficulties to be overcome in the application of this known contrivance to gasometers were such as to involve experiment even by a skilled person; to require, in fact, invention, and that the plaintiff's patent was good subject-matter. Lindley, L.J., said, "A patent for the mere new use of a known contrivance, without any additional ingenuity in overcoming fresh

(*n*) See, also, *Moser* v. *Marsden*, 10 R. P. C. 358.
(*o*) 14 R. P. C. 105.
(*p*) Ibid. p. 114.
(*q*) Ibid. p. 121.
(*r*) 9 R. P. C. 516.

difficulties, is bad, and cannot be supported. If the new use involves no ingenuity, but is in manner and purpose analogous to the old use, although not quite the same, there is no invention; no manner of new manufacture within the meaning of the Statute of James. 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. (*s*) 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. . . . If, practically speaking, there are no difficulties to be overcome in adapting an old contrivance to a new purpose, there can be no ingenuity in overcoming them, there will be no invention, and the first rule will apply. The same rule will, I apprehend, also apply to cases in which the mode of overcoming the so-called difficulties is so obvious to every one of ordinary intelligence and acquaintance with the subject-matter of the patent, as to present no difficulty to any such person. Such cases present no real difficulty to people conversant with the matter in hand, and admit of no sufficient ingenuity to support a patent. If, in these two classes of cases, patents could be supported, they would be intolerable nuisances and would seriously impede all improvements in the practical application of common knowledge. They would be mischievous to the State, to use the expression in the Statute of James." (*t*)

In *Nicoll* v. *Swears*, (*u*) the invention was for a safety skirt in ladies' riding-habits. A safety skirt with a burstable seam part of the way up, so contrived that if the seam caught in the pommels it would burst and release the habit, had been patented before. The plaintiff's alleged invention was a skirt with a burstable seam the whole way up, so contrived that if the rider were thrown and the skirt caught on the pommels the seam would yield and the rider fall clear of the skirt. On this Wright, J., said: (*v*) "It is a mere discovery demonstrative of a perfectly old and perfectly obvious contrivance used for the very purpose to a certain extent, but used more usefully for the old purpose than was known before. That is not enough to constitute an invention. At most it was a discovery that this old contrivance for an old purpose worked better if it was carried a little further,

(*s*) See *Williams* v. *Nye*, 7 R. P. C. 67.
(*t*) 9 R. P. C. p. 524.
(*u*) 10 R. P. C. 240.
(*v*) Ibid. p. 244.

and if it entirely released the lady from the skirt instead of releasing the skirt from the pommel. I do not think that is sufficient matter for a patent."

If Invention is proved the Amount is not Material.—In determining whether or not a discovery is patentable, the Court, if satisfied that some independent invention has been required to accomplish it, will not enquire minutely into the amount of labour or the degree of ingenuity involved; any substantial (*w*) exercise of the inventive faculty is enough.

In *Liardet* v. *Johnson*, (*x*) Lord Mansfield said that inventions were of various kinds; some depended on the results of figuring, others on mechanism, etc., others depended on no reason, no theory, but a lucky discovery; and that water-tabbies were discovered by a man spitting on the floor.

Similarly in *Crane* v. *Price*, (*y*) Tindal, C.J., said: "In point of law the labour of thought, or experiments, 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 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 experiments and profound research, or whether of some sudden and lucky thought, or mere accidental discovery."

Likewise in *Muntz's Patent*, (*z*) Lord Brougham said: "Some of the most important inventions that have been made by the result of experience and ingenuity, applied to practical subjects, have been made with the utmost simplicity, to the greatly increased benefits of mankind."

In *Murray* v. *Clayton*, (*a*) James, L.J., said: "The machine, too, when produced, is so simple, and so completely adapted to effect its object, that one feels disposed to wonder how people could have gone on for thousands of years making bricks without ever having thought of it; but that is the case with many noted inventions—when the thing is once hit it seems a marvel that it was not hit before."

In *Otto* v. *Linford*, (*b*) Jessel, M.R., adverting to the objection that the plaintiff's invention was too simple to support a patent, said: "It may appear very simple when it is known; most great inventions do appear to be very simple when they are known."

(*w*) Per Cotton, L.J., in *Williams* v. *Nye*, 7 R. P. C. 67.

(*x*) Bull, N. P. 76. See, also, *Boulton* v. *Bull*, 2 H. Bl. 487.

(*y*) 1 W. P. C. 411; 12 L. J. C. P. p. 87; 4 M. & G. p. 605.

(*z*) 2 W. P. C. 119.

(*a*) L. R. 7 Ch. 583.

(*b*) 46 L. T. (N. S.), 39.

In *Vickers* v. *Siddell*, (*c*) a case where the patent, though on the border line, was held good, Lord Herschell said: "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 shewn 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."

Again, in *Rielcman* v. *Thierry*, Lord Halsbury, C., said: "It is certainly quite true that mere simplicity will not prevent there being invention. It is often justly urged in favour of a patent that its very simplicity is the merit of the invention;" and again, "No smallness or simplicity will prevent a patent being good." (*d*)

In *Hayward* v. *Hamilton*, (*e*) the Court of Appeal went further than has perhaps been done in any other case in supporting a patent the validity of which was challenged for want of invention. (*f*) There the patent was for improvements in pavement lights. The object of the invention was the lighting of rooms from above which were not immediately under the lighting apertures, but which had windows facing into a covered area, from the roof of which the light came. For this purpose it was necessary to throw the rays of light sideways. This was achieved by the use of glass in prismatic form, through which the light was deflected at an angle so as to fall into the chamber which it was desired to light. It was objected that the prism was old, and the frame-work old, and that there was no invention in the combination. The use of the prism let into the decks of ships for the purpose of lighting cabins was relied upon as proof of anticipation; but the Court held that the prism here being used to throw light in a special direction, and being in its shape different from the prism lights let into ship cabins, was the result of sufficient invention to support a patent. Bramwell, L.J., said: "I think the plaintiff is an inventor. I think he has found out and manufactured and patented a thing, an article, namely, a light-directing pavement light. I do not think there is any very great quantity of invention in it; it is not as though a man had set himself down to consider how he could make a sewing machine, or a grain-pressing machine;

(*c*) 7 R. P. C. 292, at p. 304.
(*d*) 14 R. P. C. 115.
(*e*) Griff. P. C. 115.
(*f*) Per Lopes, L.J., in *Blakey* v. *Latham*, 6 R. P. C. 189.

it is a much humbler piece of invention than that, and it may possibly be nothing more than that the idea struck him, and immediately the idea struck him he could apply it or carry it into execution by a very obvious apparatus. But still it is an invention, and it is not the less an invention because it required but small inventive powers to enable him to do it. One may take an illustration in this way: the screw propeller. I suppose everybody knew that a screw used as it was would act in the way a screw propeller does; but the man who thought of it, and applied it to a steamboat, which I suppose anybody could have done, if the idea suggested itself to him, would have been called the inventor of a screw propeller, or screw-propelling steamboat, as the case may be. It does not depend upon the quantity of invention." (*g*)

Tests of Invention: Public Appreciation.—While the mere simplicity of a discovery which in fact involves some invention is no objection to a patent therefor, many cases arise in which the change effected by the patentee is so slight as to make it a matter of difficulty to determine whether or not any inventive ingenuity was required to accomplish it. In such cases the Court will give weight, in favour of the patentee, to the circumstance that a want long felt, and not supplied, has been met by the discovery. (*h*)

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

In *Lyon* v. *Goddard*, (*j*) Lord Esher, M.R., said: "When he (the patentee) found it out all mechanicians can say at once, 'Dear me, what a simple thing; it did not require any invention for him to do it;' but the answer to that is, and must be always, this—'The thing was wanted; there was a thing which would not do what was wanted; by finding out some small addition I have found out the thing which would do.' That seems to me to be the strongest evidence in point of fact that there was invention, that is, that it

(*g*) On this case, see *Williams* v. *Nye*, 7 R. P. C. 67; *Reynolds* v. *Amoe*, 3 R. P. C. 215; *Sharp* v. *Brauer*, 3 R. P. C. 196.

(*h*) *White* v. *Bertram*, 14 R. P. C. pp. 512, 746; *Brooks* v. *Lamplugh*, 15 R. P. C. p. 48.

(*i*) L. R. 4 C. D. 615.

(*j*) 10 R. P. C. 343.

required skill, and it required thought, and that it is the exercise of skill and thought which has produced the new combination." (*k*)

The mere fact, however, that a patented discovery has at once a large sale is not of itself evidence that there has been invention exercised in the discovery; for such success does not in itself raise any inference that the end accomplished has baffled other persons, and therefore been a matter of difficulty.

Commenting on this in *Longbottom* v. *Shaw*, (*l*) Lord Herschell said: "Great reliance is placed upon the fact that when this patent was taken out and frames were made in accordance with it there was a large demand for them. . . . My lords, I do not dispute that that is a matter to be taken into consideration; but, again, it is obvious that it cannot be regarded in any sense as conclusive. I think that its value depends very much on certain other circumstances; if nothing be shewn beyond the fact that the new arrangement results in an improvement, and that this improvement causes a demand for an apparatus made in accordance with the patent, I think it is of very little importance. If it were shewn that the defects which this apparatus is designed to remedy, or does remedy, were defects which had been felt and the knowledge of which had come to the public, so that there was a demand for a new apparatus which did not possess these defects, and if it were shewn that that demand had lasted for a considerable time, so that men's minds were likely to have been engaged upon a mode of remedying those defects, and they were not remedied until the apparatus was devised for which the patent is taken out, no doubt that would have afforded considerable evidence that the adaptation or arrangement of the patentee was not obvious, inasmuch as you would then have a demand for some considerable time not met although known, and the fact that it was not met for a considerable time though known would indicate that the mode by which it was ultimately met could not have been so obvious as otherwise might have been supposed."

Application of Known Process or Materials to a New Use.—At the same time, the application of a known process to a new material, or of an old article to a new use, may be patentable if that application involves invention on the part of the person for the first time applying it.

In *Bamlett* v. *Picksley*, (*m*) Blackburn, J., in the Court of Exchequer Chamber, said: "There may be cases in which a thing

(*k*) Cf. *Legge* v. *Wakelam*, 10 R. P. C. 379.

(*l*) 8 R. P. C. 336.

(*m*) Griff. P. C. 42.

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

In *Penn* v. *Bibby*, (*n*) the patent was for an improvement in the bearings and bushes for the shafts of screw and submerged propellers. The invention consisted in employing wood in the construction of the bearings and bushes, in a particular ascertained manner. In an action for infringement this was held good subject-matter. The defendants moved for a new trial, which was refused. On the objection that a new application of an old thing was not patentable, Lord Chelmsford, C., said (*i.a.*): "In every case of this description one main condition 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." In this case it was alleged against the patent that the contrivance had already been in use in grindstones and water-wheels, and that its use in these was so akin to its use by the patentee that his patent could not be upheld. On this Lord Chelmsford said: "No doubt these have what may be called bearings, but they are of a totally different character and for a totally different object, from the bearings patented. In neither water-wheel nor grindstone is there a wooden bearing in which the wheel revolves; but the wheel is merely supported on wood, not encased nor submerged, nor constructed for the purpose of admitting the water to flow freely within the bearing, and the

(*n*) L. R. 2 Ch. 136.

revolutions of each of them are at an exceedingly slow pace. It is difficult to believe that bearings of this description could ever have suggested the application of wood to the bearings of screw-propellers in the way described in the patent. It is, to my mind, not merely a different application, but something in itself essentially different. It had 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* having turned his attention to the remedying this defect, devised the plan of placing fillets of wood upon the inner surface of the bearings, so as to prevent the shaft coming in 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, for the revolutions of a screw-propeller being upon an average at the rate of 120 to a minute, the metal bearing very soon wore out with the friction occasioned by this velocity, and yet the wooden bearings of the plaintiff fitted into vessels have continued serviceable without repair for some years. 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 a water-wheel or grindstone, and yet should never before have been discovered."

Mere Analogous Use Negatives Invention.—There is no such invention as will support a patent in the application of a well-known article or process to a use merely analogous to that to which it has already been applied.

In *Losh* v. *Hague*, (*o*) the plaintiff claimed protection for the application to railways of a wheel shewn to have been made and used before railways existed. In directing the jury Abinger, C.B., said: "It would be a very extraordinary thing to say that because all mankind have been accustomed to eat soup with a spoon, that a man could take out a 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 which might be applied to 50,000 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

(*o*) 1 W. P. C. 200.

them, why should he take out a patent for that? I must own, therefore, that it strikes me, if you are of opinion that this wheel has been constructed by the persons who have been mentioned long before the plaintiff's patent, that although there were no railways then to apply them to, and no demand for such wheels, yet the application of them to railways afterwards by *Mr. Losh* will not give effect to his patent."

In *Brook* v. *Aston*, (*p*) Lord Campbell, C.J., said: "There may be a patent for the application of an old process to a new purpose; but then there must be some invention in the manner in which the old process is applied. . . . Here there is no novelty in the mode of application. The machine is applied in the same manner as before to cotton and linen. Suppose that, in 1853, the machine was, in the first instance, applied to cotton thread only, and a new patent was afterwards taken out for applying the machine in the same manner to a new textile fabric, could such a patent be maintained, the machinery and mode of application being the same? Certainly not."

In *Harwood* v. the *Great Northern Railway Company*, (*q*) the leading case upon this subject, the patent was for "improvements in fishes and fish-joints for connecting the rails of railways." The invention consisted in forming a recess or groove in one or both sides of each fish, so as to reduce the quantity of metal at that part, and adapt it to receive the square heads of the bolts, which were thus prevented from turning round when the nuts were screwed on. The use of fishes as supports was old, and so, too, was the use of fishes with grooves or recesses in their outer surfaces; but the use of fishes in this improved form was new in its application to the rails of railways.

The Court of Exchequer Chamber, reversing the Court of Queen's Bench, held that this application was not subject-matter for a patent. Willes, J., said: (*r*) "It appears that the alleged invention claimed by *Wild* as his, when applied to the pieces of iron used for holding together the ends of rails to make them, for practical purposes, a continuous solid body, had previously been known and used as applied to pieces of iron used for holding together the broad sides of pieces of wood placed vertically upon one another, to make them, for practical purposes, a continuous solid body. In each case the benefit contemplated and effected

(*p*) 27 L. J. Q. B. 145; 28 L. J. Q. B. 175; 8 E. & B. 478.

(*q*) 2 B. & S. 229; 11 H. of L. C. 654; 35 L. J. Q. B. 27; 14 W. R. 1; 12 L. T. (N. S.), 771.

(*r*) 2 B. & S. 229; 31 L. J. Q. B. 198.

was effected by means of the groove, which gave lightness with strength to the binding iron, and served to hold the heads of the bolts steady whilst the nuts were being screwed on at the other end. This was the one mechanical contrivance used in each case. It was complete in itself when first invented; and, though not immediately applied, it was immediately applicable to all forms of pieces of iron used for holding together other materials by the aid of bolts having a bearing upon the pieces of iron. It required no new invention, but merely an application of the mechanical contrivance, already invented and used, to employ it upon several strips of iron, to hold together iron instead of wood, materials placed together horizontally instead of materials placed together vertically, solids the small ends of which are in contact instead of solids the broad sides of which are in contact, rails instead of beams."

On appeal to the House of Lords, the decision of the Court of the Exchequer Chamber was affirmed. (s) Lord Westbury, C., said: "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. . . . No sounder, or more wholesome doctrine, I think, was ever established than 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. The channelled iron was applied in a manner which was notorious, and the application of it to a vertical fish would be no more than the application of a well-known contrivance to a purpose exactly analogous or corresponding to the purpose to which it had been previously applied."

Commenting on the above dictum in *Elias* v. *Grovesend Tinplate Company*, (t) Bowen, L.J., said: "Lord Westbury, in *Harwood's* case, which has been cited in the House of Lords, lays down that you cannot have a patent 'for a well-known mechanical contrivance, merely'—and I emphasize that word, because everything turns on the 'merely'—'when it is applied in a manner or to a

(s) 11 H. of L. Ca. 654.

(t) 7 R. P. C. 468.

purpose which is not quite the same, but is analogous to the manner or the purpose in which it has been hitherto notoriously applied.' If you read *Harwood's* case, and observe what was the point raised and decided in the Court of Exchequer Chamber, you will see that the word 'merely' in Lord Westbury's judgment is a compendious mode of stating that it is in a case where there is no novelty in the mode of applying the old contrivance to the new purpose. In other words, 'merely' may be represented in other language by the words 'unless there is invention in the adaptation or mode of application.' That is what 'merely' means. Now, that that is clear appears from all the judgments in the case of *Morgan* v. *Windover*, (*u*) in the House of Lords."

So likewise Lord Davey, in *Riekmann* v. *Thierry*, (*v*) said the proposition accepted and laid down by the House of Lords in *Harwood* v. the *Great Northern Railway Company* (*w*) "was that 'a mere application of an old contrivance in the ordinary way to an analogous subject, without any novelty in the mode of applying such old contrivance to the new purpose, does not make a valid subject-matter of a patent.' The law thus laid down has never since been doubted, though whether it has always been consistently followed or rightly applied may be open to question. It is not enough that the purpose is new, or that there is novelty in the application, so that the article produced is in that sense new, but there must be some novelty in the mode of application. By that I understand that, in adapting the old contrivance to the new purpose, there must be difficulties to be overcome, requiring what is called invention, or there must be some ingenuity in the mode of making the adaptation."

In *Horton* v. *Mabon*, (*x*) the plaintiff's patent claimed the application of double angle-iron to the formation of hydraulic joints to telescopic gas-holders. Double angle-iron was well known, and had before been applied to a great number of cognate purposes. The Court of Common Pleas held that the plaintiff's application of it was not valid subject-matter for a patent. Erle, C.J., said: "It appears that those who had heretofore constructed telescopic gas-holders formed the hydraulic joints by riveting two pieces of angle-iron to a plate which formed the top or bottom of the cup. It was perfectly apparent and palpable that double angle-iron would answer the same purpose, and save two rows

(*u*) 7 R. P. C. 131. See post, p. 150.
(*v*) 14 R. P. C. 121.
(*w*) See ante, p. 144.
(*x*) 12 C. B. (N. S.), 450.

of rivets, and consequently much additional labour. The whole claim of the patentee, therefore, amounts to this—he informs the manufacturers of gas-holders that by the use of an article well known in the iron trade much labour and expense may be spared. That clearly is not the subject of a patent. It is nothing more than the application of a known instrument to purposes analogous to those to which it had before been applied."

In the same case Willes, J., said: "No doubt a new combination of old machinery or instruments, whereby a new and useful result is attained, may be the subject of a patent. But there must be some invention. There is none here. By making a thing in one piece instead of, as before, uniting several pieces together, the patentee no doubt effects a considerable saving of labour and expense. The merit is due to the person who first produced the article called double angle-iron. That is old and well known, and had long been applied to purposes not dissimilar to that to which the present plaintiff applies it. The mere fact of its application to gas-holders, rendering their construction better or cheaper, does not constitute a subject-matter for a patent." (*y*)

In *Tatham* v. *Dania*, (*z*) the invention was for a mode of operating on fibrous or textile materials in their passage through a series of rollers used in the process of teasing or opening in such a way that the material was presented in a more suitable form for being teased or opened by the cylinder or following cylinder. It was proved that the use of sets of rollers in a series turning at different rates of speed for the purpose of making materials of a kind similar to those to which the patentee applied his device, pass through in a form more convenient and advantageous for being operated upon by the succeeding part of the machine, was known and used in cotton spinning before this patent was granted.

Willes, J., held that this defeated the patent; the alleged invention being only the application of an old process to another state of things, different only in the circumstances and not in species.

On the necessity of invention, Willes, J., said: "I apprehend if a patentee would succeed it is necessary for him to shew not merely newness in the sense of doing a thing which has not been done before, but that he must shew newness in the shape of novelty by producing a thing which 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

(*y*) Cf. *Mackelcan* v. *Rennie*, 13 C. B. (N. S.), 52. (*z*) Griff. P. C. 214.

had been previously using another sort of tool which produced a much inferior effect, and although, therefore, the application of the other 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, but inasmuch as the tool has been used for an analogous purpose to that which all mankind knew it was useful for before, although the application was new you would not say the application was a novelty in the sense of invention so as to sustain a patent."

In *Bamlett* v. *Picksley*, (*a*) the same rule was laid down by the Court of Exchequer Chamber. There the plaintiff's patent was for the application to a machine for cutting corn and grass, of a contrivance by means of which the rate of speed in the revolutions of the cutting knife might be varied. It was proved that the same contrivance was already in use on hay-making or tedding machines. The plaintiff's counsel, however, argued that there was sufficient invention in the new application of the device to support the patent. But the Court refused to adopt this view. Blackburn, J., after referring to the contrivance as identical in the two machines, and pointing out that whether it was fitted to a machine to cut grass or to toss hay was immaterial, said: "Counsel endeavoured to argue that there was an invention in this; that although *N.* discovered the identical way of making the movement he had never applied that to the purpose of reaping and mowing machines, and that it was a new discovery for a man to say, 'that mode which was to cause the wheel to move slowly and quickly applied to one purpose, I will now apply to a new one, and that is a discovery.' I must own it is exactly identical with Lord Abinger's simile: an old broom has been used for sweeping an old carpet, and he said it is no discovery to say now that a new carpet is found out, 'I will apply the old broom to sweep the new carpet.' It is identically the same case—the very same thing." (*b*)

In *Cropper* v. *Smith*, (*c*) the plaintiff's patent claimed (*i.a.*) a floor-plate applied to a lace machine to give rigidity to the frame. This was a common expedient, well known in connection with other machinery. The Court of Appeal, reversing Pearson, J., held that this claim was an independent claim, also that it was not subject-matter, and that the patent was bad. Bowen, L.J., said: "I agree that it is difficult to define the amount of invention

(*a*) Griff. P. C. 40.
(*b*) See, also, *Bailey* v. *Roberton*, 3 App. Ca. 1079.
(*c*) 1 R. P. C. 81, p. 90.

which is necessary to make a patent good. It is quite true that most machines in these days are new combinations of old parts, and new arrangements of old principles, and that the invention often is in the application; but, on the other hand, it would be a most serious matter for trade in modern times if a familiar arrangement, which was common to other classes of machines, could be patented in its application to a new and analogous purpose. It has been decided that you cannot do that; that you must not take a familiar arrangement, which is well known in one class of machines, and patent it for a new and analogous purpose."

In *Sharp* v. *Brauer*, (*d*) the plaintiff's patent was for a new or improved window screen or blind. The device was really the application to a window, for the purpose of excluding light and air, of a screen of ordinary arrangement, commonly used in front of fireplaces. Bacon, V.C., held that the patent disclosed no invention, and was not subject-matter.

In *Blakey* v. *Latham*, (*e*) the plaintiff (who sued in his firm's name) was owner by purchase of a patent for an improved heel plate for boots and shoes. The heel plate was so made as to have attached to, and part of itself, the fastening spikes necessary to attach it to the heel of the boot. In this way nailing was dispensed with, and the metal might be worn very thin without becoming detached. These heel plates had had immense commercial success. It was proved, however, that prior to the date of the patent, plates with a turned up edge, having two prongs or nails solidly fastened to the inner surface, were in use on the front part of boots for the purpose of protecting the leather. The Court of Appeal (dismissing an appeal from Kay, J.) held the patent bad as lacking subject-matter. Cotton, L.J., said: "It is not sufficient to be new in the patent sense for the patentee to be the true and first inventor, if it is merely using that which has been used for an analogous purpose, before the date of the patent. Is there any invention in applying what was applied before to the toe of the boot to the heel of the boot? In my opinion, the application to the toe was strictly analogous to what was done here. It may be that these are better than the old ones in their mode of attachment; but the mode of attaching those clinkers to the front of the boot is strictly analogous to the way these plates are annexed to the heel of the boot. In my opinion, therefore, this patent is not good, and there is no proper subject for a patent,

(*d*) 3 R. P. C. 193.

(*e*) 6 R. P. C. 29, 184, p. 187.

having regard to what was known before, there being no invention in applying this process to the heel when it had been previously applied to fixing a plate to the toe or front part of a shoe."

In *Morgan* v. *Windover*, (*f*) the patent was for improvements in carriage springs. The plaintiff's alleged invention consisted in applying to the front portion of a carriage that substitution of composite for elliptical springs which had already been applied to the hind part. There was admittedly nothing new in the mode of affixing the springs. There was very strong evidence of the utility and advantage of the adaptation so far as the public market was concerned. The Court of Appeal, impressed by this evidence, held the patent good. But in the House of Lords this decision was reversed on the ground that there can be no invention in applying old and well-known contrivances to an analogous use; and that in such a case the utility of the result attained cannot impart a patentable quality to what is not otherwise subject-matter. "It cannot but be certain," said Lord Halsbury, C., "that the Statute of Monopolies, and the whole branch of the law founded on that Statute, make it an absolute condition to the validity of a patent, that there should be what may properly be called invention, and the application of well-known things to a new analogous use is not properly the subject of a patent." (*g*) In the same case Lord Herschell said: "The law has not been disputed that the mere adaptation to a new purpose of a known material or appliance, if that purpose be analogous to a purpose to which it has already been applied, and if the mode of application be also analogous, so that no inventive faculty is required, and no invention is displayed in the manner in which it is applied, is not the subject-matter of a patent. That I take to be well settled. . . . Now, my lords, if it had required mechanical ingenuity and skill to adapt the composite springs which had heretofore been used in the hind part of a carriage, so that it was not the mere substitution in front, in substantially the same way as the substitution had taken place at the back, but that it needed some skill and ingenuity to adapt to the front part of the carriage that which had been applied to the back. I should have thought that there was sufficient subject-matter, and that the patent could have stood. But when once it is admitted that all that can be claimed as new is the idea of putting it in the front instead of at the back, and that when once that idea was entertained, any workman told to do it would, without any instructions or any

(*f*) 5 R. P. C. 296; 7 R. P. C. 131, 446.

(*g*) 7 R. P. C. p. 134.

special mechanical skill, be able at once to do it, it seems to me that that really concludes the case against the respondents, because if their contention be well founded it would certainly be somewhat extensive in its consequences." (*h*)

There is no such exercise of the inventive faculty as will support a patent in the application to a known purpose of a new material merely analogous to a material previously used for that purpose, *e.g.* the substitution of steel springs for whalebone in the making of ladies' crinolines, (*i*) or the application of wood planking in the building of ships, to an iron frame, when such planking had been previously applied for the like purpose to a wooden frame. (*j*)

There is no invention in applying a tap which has been used over and over again to intercept or permit the flow of water, to intercept or permit the flow of wine from a bottle; (*k*) nor in applying to boiler tubes a hot-water joint well known in its application to coils, although in the one case the heat arises externally from fire, in the other internally from the water. (*l*) Nor is there any such invention as will support a patent in applying an arrangement of apparatus to water which has already been applied to oil; (*m*) nor in applying to a bicycle at rest a locking apparatus previously applied to a bicycle in motion. (*n*)

In *Tickelpenny* v. *Army & Navy Co-operative Society, Limited*, (*o*) the plaintiff's patent was for improvements in the construction and support of fire-proof walls and ceilings. The alleged invention consisted in filling hollow iron columns applied to the purpose of support with water, so that they might offer a greater resistance to the heat of fire. Kekewich, J., in holding the patent invalid, said: "It is obvious, and the evidence has established, that hollow columns were well known, and were used for the support of floors and ceilings. Is the user of them when provided with water supply, subject-matter for a patent? I could understand the particular method of supplying water being patentable, and I could understand the application of invention to removing some of the objections to water columns; but what invention is there in using columns filled with water instead of air? The user may be new, but that is not necessarily the subject-matter of a patent.

(*h*) 7 R. P. C. p. 137.

(*i*) *Thompson* v. *James*, 32 Beav. 570.

(*j*) *Jordan* v. *Moore*, L. R. 1 C. P. 624; 35 L. J. C. P. 268; 14 W. R. 769. See, also, *Albo-Carbon Light Co.* v. *Kidd*, 4 R. P. C. 535.

(*k*) *Hazlehurst* v. *Rylands*, 9 R. P. C. 8.

(*l*) *Baker* v. *Kinnell*, 9 R. P. C. 441.

(*m*) *Rose's Patents Co.* v. *Bratby*, 11 R. P. C. 198, at p. 216.

(*n*) *Singer* v. *Rudge Cycle Co.* 11 R. P. C. 463. See, also, the recent case of *Case* v. *Cressy*, 17 R. P. C. 255.

(*o*) 5 R. P. C. 405, p. 408.

It is often difficult to draw the line, and say where the invention commences—to say where there is, and where there is not, some novelty in the application. In my judgment there is clearly none in taking a familiar hollow column, and using it full of water instead of air."

Other Illustrations of Insufficient Invention.—The ascertainment that known parts of a known machine will work best at a particular distance from each other, or when given a differential motion, has been held not to imply the degree of invention requisite to support a patent.

In *Kay* v. *Marshall*, (*p*) the patent was for a new and improved machinery for preparing and spinning flax, hemp, and other fibrous substances by power. The real point of the discovery lay in placing the retaining and drawing rollers at a particular distance from each other. Before the date of the patent, machinery with a reach varying from less than one inch to thirty-six inches was known. The patentee fixed the reach at two and a half inches. The Court of Common Pleas held that this was not subject-matter for a patent, and the House of Lords affirmed the decision on the ground that there was no invention in what the patentee had done.

A similar point came before the Court in the recent case of *Herrburger* v. *Squire*. (*q*) In that case the patent was for improvements in pianoforte actions, and the patentee claimed, *i.a.* the method of centering the damper with an arm, as shewn in the figures attached to his specification. The result of this contrivance was to remove the damper from the string, and this had been secured before; there was no new combination of old parts envolved in the patentee's contrivance; it was simply an alteration in the radius of the arc in which the damper worked. The patentee had thus described his method of obtaining the greater lifting power from the string: "Instead of the damper being centered in the usual way—that is to say, centered in the body—I use an arm, G, at right angles, or nearly so, and place my centre, K, at the end of the arm, thereby gaining a greater sweep or circle, and bringing the damper-head farther away from the string." On this Charles, J., said: "Although I appreciate the fact that it is a useful thing to have done, I cannot see that it is the proper subject-matter of a patent, any more than in *Kay* v. *Marshall* (*r*) it was the

(*p*) 2 W. P. C. 34, p. 84; 8 Cl. & F. 245; 8 L. J. C. P. 261; 5 Bing (N. C.), 492.

(*q*) 5 R. P. C. 592; affirmed on appeal, 6 R. P. C. 194.

(*r*) Supra.

proper subject-matter of an invention that the drawing rollers and the retaining rollers of a spinning machine had been altered to a distance from each other at which they had never been placed before. . . . Here there is no new result, no new manufacture; and the only matter which has been invented—if invention is the proper word to use for such a thing—is really the more beneficial adjustment of the working point of the damper, and that does not seem to me to be the proper subject-matter of a patent. It is not the mere fact that something has been done which has never been done before that will support a patent—there must be invention: and a mere alteration of radial distance is not invention."

In *Ralston* v. *Smith*, (*s*) the patentee claimed a process which, by means of roliers and bowls (the rollers having grooves, flutes, or indentations around them, and revolving with greater velocity than the bowls), patterns could be embossed upon fabrics and a finish or lustre added to them by one and the same operation. Before the patent, an engraved roller and a bowl had been used, with equal surface speed, for embossing. For the process of calendering, two rollers or a roller and a bowl had been employed, having different surface speeds; and circular grooves for embossing had also been in use. There was therefore nothing new in the process of embossing with pattern rollers, and nothing new in giving a differential speed to the roller and bowl for the purpose of producing a gloss or finish, nor in the employment of circular grooves. But the plaintiff conceived the idea that the same machine, by means of gearing communicating motion from the roller to the bowl, could be made to produce any kind of pattern, and give a finish to certain fabrics by one and the same operation. After he had taken out his patent he found that his general notion was erroneous, and that only one description of roller, viz. those with circular grooves, could be successfully employed, and he therefore, by a disclaimer, limited his claim to this single application of the machine. The House of Lords held that this was not subject-matter for a patent. "What invention," said Lord Chelmsford, "was there in all this? The plaintiff does not claim to have invented any new combination of machinery . . . nor has he introduced to the world any new process; but the utmost that he can lay claim to is, that he has discovered that by giving a differential motion to different parts of an old machine, a power existing in it might be developed and

(*s*) 11 H. of L. Ca. 223. See Lord Chelmsford, pp. 255, 256; 35 L. J C. P. 49, p. 59.

brought into action. It appears to me that such a discovery is not the subject of a patent."

The exercise of mere adaptive skill and judgment in manufacture is not such invention as will support a patent. (*t*)

Illustrations of Sufficient Invention.—A person who completes by one step a process which others were on the point of discovering, may have exercised sufficient invention to support a patent. In *Badische Anilin Fabrik* v. *Levinstein*, (*u*) Lord Halsbury C., said: "The chief reliance was placed upon an argument as new as it is unsound, and for which I think there is not the least judicial authority. The argument may be stated thus: This thing is not new, because things of the same sort in analogous chemical relations had been discovered; people ought to have discovered it, or were on the brink of discovering it; therefore this true and first inventor only completed by one step the route to which chemical discoveries had been tending without his aid. Such a principle applied to patent law would be fatal to the rights of all inventors, and is, as I believe, as inconsistent with that branch of our jurisprudence as it is destitute of judicial authority and contrary to the interests of scientific research. The lid of the historical kettle shewed the mechanical power of steam; the action of light on the salts of silver was widely known; and both these things, in one sense, were steps which led up to the discoveries which they brought in their train; but, nevertheless, many true and first inventors proceeded to utilize these steps by further development into inventions which certainly have not been challenged upon the ground now contended for."

A discovery which ascertains what class of substances among many, what temperature in a wide range, and what process among many, will supply the commercial world in merchantable form with an article previously only known as a chemical curiosity, is good subject-matter, and patentable as a new manufacture. (*v*)

Usually the substitution in a well-known mechanism of a new part, analogous to an old part omitted, will not support a patent; as, *primâ facie*, such substitution imports no invention. But if the patentee can shew that this substitution could not have been effected without the exercise of ingenuity, his patent will be good. In *Ehrlich* v. *Ihlee*, (*w*) the defendants contended that the plaintiff's patent was invalid because the inventor had done nothing more

(*t*) *Beavis* v. *Rylands Glass and Engineering Co.*, 17 R. P. C. 93.

(*u*) 4 R. P. C. p. 462; 12 App. Ca. 711.

(*v*) *Young* v. *Fernie*, 4 Giff. 577.

(*w*) 5 R. P. C. 452.

than substitute in musical instruments Jacquard cards of a circular form, for Jacquard cards of the ordinary strip or band form.

In rejecting this argument, Fry, L.J., said: "It appears to me that, however plausible, it ought not to prevail. One has to consider what is involved in the substitution of a perforated disc for an ordinary strip or band, and it appears to me that invention is involved in that substitution as applied to a musical instrument. In the first place, something of thought, if not of invention, is required to see that the substitution of the one form of card for the other will carry with it any advantage. In the next place, it became necessary to invent and to prepare a disc of such a kind that the perforations shall produce the required results; notwithstanding the differential rates of motion of the peripheral and central portions of the disc, the plaintiff has so arranged the outer perforations as to produce the lower notes, and the inner to produce the higher notes. Again, in the previous instrument the motion had been horizontal, and now it had to be turned into a vertical motion, and a satisfactory mode of rotating the disc had to be applied, and all those things had to be done in such a manner that the final result should be a useful, simple, and handy instrument. In doing all that it appears to me that there plainly was invention required."

In the *American Braided Wire Company* v. *Thomson*, (*x*) the patentee's invention consisted, substantially, in the application of tubular sections of braided hard wire to the making of ladies' bustles. It was proved at the trial that the use in tubular sections of braided soft wire in the manufacture of analogous articles was old, and that it was known prior to the date of the patent that hard wire might be braided on an ordinary braiding machine by an adjustment of the mechanism. Analogous elastic substances had, of course, been used before in the making of bustles. The House of Lords by a majority held that although the patent was the adaptation of analogous new materials to a known result, yet there was sufficient ingenuity exhibited in that new application to indicate the exercise by the inventor of thought and experiment, and that therefore the patent was good.

Lord Herschell said: "It cannot be denied that both the prior patents to which I have referred afford some colour to the defendant's contention that the patentee here 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 already been applied;

(*x*) 6 R. P. C. 525.

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 defendant's 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. . . . However, the mode in which the tube of braided wire is made available as a bustle by the use of clamps applied and fixed in the manner described, appears to me to be simple and efficient and not so obvious as to occur to every one contemplating the use of braided wire for the purposes of a bustle. The result is a complete article, light, effective, not likely to get out of order, and capable of being manufactured and therefore sold cheaply. And I am unable to say that to produce a new thing combining those qualities required no invention."

In the same case Lord Macnaghten said: "I think there is here just sufficient invention to support the patent."

In *Goddard* v. *Lyon*, (*y*) the patent was for an apparatus for purifying and disinfecting. It consisted of an outer and an inner chamber, into both of which steam was conducted. The inner chamber, in which the articles to be disinfected were put, was closed by a steam-tight door. The steam in the ante-chamber was intended to maintain the temperature in the inner chamber, and prevent condensation there. The arrangement of an outer and inner chamber, in both of which steam might be used, was not new; but no prior apparatus had enabled steam to be used in the inner chamber at a high pressure. High pressure greatly expedited the process of disinfecting. It was contended that this improvement involved no invention, and was not patentable. The House of Lords, however, affirming the Courts below, rejected

(*y*) 10 R. P. C. 121, 334; 11 R. P. C. 354.

this contention. Lord Halsbury, C., said: "It is quite true that the change is but small; but if it be the case that the change was made with a view to the use of steam, at a comparatively high pressure in the inner cylinder, and consequently rapid disinfection, and that the plaintiff for the first time put before the public a machine adapted for that purpose, although the difference between that machine and any machine in prior use might be slight, it appears to me to be none the less the subject-matter of a patent." (*z*)

Selection may amount to Invention.—The selection, by experiment and research, from a number of substances known to be suitable for a particular purpose of those substances which, if used in a particular way, will produce an article of commerce better than has been produced before, is invention sufficient to support a patent. (*a*)

"Invention," said Rigby, L.J., in the *Lancashire Explosives Company* v. the *Roburite Explosives Company*, "consists, in many cases, of putting together items of common knowledge which no one else has ever thought of combining. . . . The essence of this invention appears to be that the inventor has taken a great many things that were common knowledge, and tried which of those items of common knowledge would produce a useful and new result, and he has ascertained that, following the process described by him, you will arrive at the new and useful result which he does arrive at; and I consider that that is undoubtedly invention." (*b*)

The subject of invention in patent law has been dealt with here mainly by way of illustration, for, as Lord Esher, M.R., in *Elias* v. *Grovesend Tinplate Co.*, (*c*) said, the law has nowhere attempted to say what exactly invention is, being content as cases arise to say what cannot be invention. Of all questions in patent law it is probably the most difficult to decide. (*d*)

(*z*) 11 R. P. C. p. 360.

(*a*) Per Lord Herschell, *Lancashire Explosives Co.* v. *Roburite Co.* 12 R. P. C. 478.

(*b*) Ibid. p. 482.

(*c*) 7 R. P. C. 455, p. 463.

(*d*) Per Lindley, M.R., in *Dredge* v. *Parnell*, 15 R. P. C. 84, p. 88; 14 T. L. R. p. 211. On want of invention see also the following cases: *Deutsche Nähmaschinen Fabrik* v. *Pfaff*, 7 R. P. C. 16; *Williams* v. *Nye*, 7 R. P. C. 63; *Newsum* v. *Mann*, 7 R. P. C. 307; *Longbottom* v. *Shaw*, 8 R. P. C. 333; *Embossed Metal Co.* v. *Saupe*, 8 R. P. C. 355; *Sudbury* v. *Lee*, 11 R. P. C. 58; *Wood* v. *Raphael*, 13 R. P. C. 730; 14 R. P. C. 496; *Riekmann* v. *Thierry*, 14 R. P. C. 105; *Dredge* v. *Parnell*, 15 R. P. C. 84; 16 R. P. C. 625.

CHAPTER X.

THE SPECIFICATIONS.

Specifications—Their Scope and Purpose.—Although every grant of letters patent is a mere exercise of the royal prerogative and no contractual relationship is thereby created between the Crown and the grantee, (*a*) judges have from time to time spoken of the Crown in its granting capacity as a contractor for the public, and of the patentee as the purchaser of a monopoly whom the law requires to honestly pay the full price for his privilege. (*b*) This language, loose and inaccurate as it is, (*c*) has been used because the Crown exacts as a condition of the grant a full disclosure by the patentee of the manner of performing his invention, so that the public at the conclusion of the patent term may be able to make as ample a use of the discovery as the inventor under cover of his monopoly has himself enjoyed. If such disclosure were not secured by the Crown on behalf of the public no patent for an invention could be supported, for no advantage would accrue to the public from the temporary restriction imposed upon them by the monopoly, and under the ancient rules of the common law the grant would be void. (*d*) This disclosure the patentee is required to make through the medium of his specification.

(*a*) *Feather* v. *The Queen*, 35 L. J. Q. B. 205; 6 B. & S. 257.

(*b*) Thus in *Cartwright* v. *Eamer* (cited 14 Ves. 131), Lord Eldon, then Chief Justice, said that a patent was to be considered as being in the nature of a bargain with the public, and the specification was therefore to be construed upon the same principle of good faith that regulates all other contracts. See, also, Lord Eldon's observation in *Harmar* v. *Plane* (14 Ves. 132) that he adhered to this dictum. Commenting on *Cartwright* v. *Eamer* in *Neilson* v. *Harford* (1 W. P. C. 341), Alderson, B., said: "Lord Eldon lays down the principle so long ago as 1800. He says patents are to be considered as bargains between the inventor and the public, to be judged of on the principles of good faith, by making a fair disclosure of the invention and to be construed as other bargains. That is the principle which must be taken to be the sound principle." See, also, *Walton* v. *Potter*, 1 W. P. C. 595; *Gibson* v. *Brand*, 1 W. P. C. 629.

(*c*) See ante, p. 12.

(*d*) See ante, p. 17.

"The object of the specification," said Tindal, C.J., in *Walton* v. *Potter*, (*e*) "is that it is the price which the party who obtains the patent pays for it, and it would be a hard bargain on the part of the public if he were allowed to clothe his discovery and his description in characters so dark and so ambiguous that no one could make from it when the fourteen years have expired, and he should not have paid the price for which he enjoyed the exclusive privilege, but that he should have it in his hands still for as long a period as he chooses; and, therefore, it is always a proper answer where a patent is set up, to say that you have not so described it, that it may be understood."

Again, in *Gibson* v. *Brand*, (*f*) the same learned judge said that the specification ought to be so clearly worded as to lead, without any doubt or difficulty, to the result which is the object of the patent, "because it is the price that the man who takes out the patent pays to the public for their being so long kept out of the enjoyment of the commodity or manufacture that is protected; the price he pays is, that he will lodge such an account of his own discovery and invention as will enable the public, at the expiration of fourteen years, to have as free and unreserved use of the invention as himself. Therefore, every man who is an honest man is bound to pay that price justly and fairly, and to word his specification in such a way as to be clear from all doubt."

It is therefore apparent that it was as a means of safe-guarding the interests of the public and securing to them the full disclosure of the patentee's invention, that the expedient of requiring an inventor to specify the means of performing his discovery was first introduced.

Commenting on this in *Young* v. *Rosenthal*, (*g*) Grove, J., said: "The reason of that is this, that if he did not do so when the patent expired he might have some trade mystery which people would not be able actually to use in accordance with his invention (although they had a right to use it after his invention had expired), because they would not know how to make it. . . . Therefore he is bound to do these two things, namely, to tell the public what is the nature of his invention, and to tell them how the invention is to be made in practice. Take, for instance, a chemical invention. A man might make a chemical discovery, and he might claim a patent for it, and call it by his own name, 'Thomas's This' or 'Thomas's That;' and when the patent came

(*e*) 1 W. P. C. 595. (*f*) 1 W. P. C. 629. (*g*) 1 R. P. C. 29.

to an end the public might not know the least in the world how to make it, and he would still continue by that means to have a monopoly which he had no right to continue, and which was granted to him for fourteen years only, unless it was prolonged, and then, when the fourteen years came to an end, the public might not know how his chemical invention is made. . . . he might get not only fourteen years but twice or three times fourteen years' monopoly by keeping secret his manufacture. Therefore, in the interest of the public, the law says the patentee must fairly and properly describe the nature of his invention in what is now publicly called his claim, and also the means or mode by which it can be performed." (*h*)

Origin of the Specification.—The importance of securing in a written document that full disclosure of an invention which the modern specification provides was not apparent at the date of the Statute of Monopolies. At that time new inventions as the words are now understood were practically unknown. A "new manufacture" to the draftsmen of the Act of James I. meant a new trade; and as apprenticeship was then universal, it was assumed that every patentee would work his invention with the assistance of apprentices, who, when the patent had expired, would be free to perform the invention for themselves.

The idea of conferring the invention on the public at large, at the conclusion of the patent term, would never have occurred to the mind of a Stuart lawyer, whose views of trade were moulded upon the assumption that none deserved to be free of a mystery but such as had served an apprenticeship in it. Hence in his eyes the patentee's obligations would be sufficiently discharged if the invention resulted in the establishment in the country of a new industry, even although restricted, as all trades then were, to the hands of such persons as had been apprenticed thereto.

Hence, for long, patentees were not required to specify the details of their inventions, and a vague description of the nature of an invention inserted in the body of the grant was accepted as sufficient by the legal advisers of the Crown.

The specification as a separate instrument first appears in the reign of Queen Anne, (*i*) when one of the law officers of the Crown inserted in the terms of the royal letters patent a new proviso,

(*h*) See, also, *Philpott* v. *Hanbury*, 2 R. P. C. 83.

(*i*) See Lord Blackburn in *Bailey* v. *Roberton*, 3 App. Ca. 1074. See, also, Fry, J., in *United Telephone Co.* v. *Harrison*, 51 L. J. Ch. p. 709; 21 C. D. p. 743. The first patent containing this condition appears to have been *Nasmyth's*, dated 1711. See Webster's *Letters Patent*, p. 6, n.

under which the grantee was bound, on pain of avoiding the grant, to describe and ascertain in an instrument in writing, and within a specified time after the sealing of the patent, the nature of his invention and the manner of performing it. Thus, letters patent became conditional grants, dependent for their validity upon the performance of the condition imposed by this proviso. The former general description was still retained in the body of the grant and operated as the title of the invention; but from this time it was to the document filed after the patent was granted that the public had to look for information as to the mode of carrying the patentee's discovery into practice. (*j*)

In the specification thus introduced the patentee was under the necessity of complying with two conditions; first, the specification must relate to the same invention as that of which the nature was described by the title embodied in the grant; and, secondly, it was necessary that it should fully describe the manner of making that invention. If the first of these conditions was not fulfilled the patent was bad, for in that case the Crown had granted a monopoly of one invention and the patentee had described another; if the second, the patent was equally bad, for the eventuality had then arisen under which, by the terms of one of its provisoes, the patent became void.

Practice under the Patent Law Amendment Act, 1852.—For many years one specification was deemed sufficient, and patents were granted on the vague statements of the titles of inventions, subject to the patentee subsequently filing his specification. As inventions increased, however, in number and importance, the inconvenience of this system became more and more apparent. Patents were applied for under titles of the most general character, with the object of embracing "the widest circle of the particular class of invention intended to be patented." (*k*) In the public interest it became necessary to tie the patentee down to a more detailed representation of the ambit of his invention than the vague title afforded, and to obviate the inconvenience, an amendment of the law was introduced by the Patent Law Amendment Act, 1852. (*l*) Under the provisions of that Act, the office of the former title was assigned to a preliminary specification, called the provisional specification, in which the intending patentee was required to describe the nature of his invention; while to the former specification (now called the complete specification) was still

(*j*) Per Lord Chelmsford in *Penn* v. *Bibby*, L. R. 2 Ch. 132.

(*k*) Ibid.

(*l*) 15 & 16 Vict. c. 83, s. 6.

allotted the function of informing the public how the invention could be put in practice. The provisional specification, thus for the first time introduced, was delivered by the inventor with his application for a patent, and the letters patent sealed with the proviso as formerly, that the grantee should, within a specified period, (*m*) file another specification, particularly describing and ascertaining the nature of the invention, and the manner in which it was to be performed.

Present Practice.—The Patent Law Amendment Act, 1852, is now repealed by the Patents Act, 1883, (*n*) under which, while the names and functions of the two specifications have been retained, a modification has been introduced, requiring both specifications to be filed before the grant is sealed. Hence, letters patent are now granted, not upon a condition that the inventor will fully describe the manner of performing his invention within a limited time, but upon the faith of a representation by the applicant that this has been already done. (*o*) The former condition subsequent has thus become a condition precedent; but, except as regards the date of its fulfilment, that condition remains the same.

The Title.

Considerations affecting the Choice of a Title.—Every specification ought to commence with the title of the invention to which it relates. (*p*) Such title should indicate the subject-matter of the invention. (*q*) If it does not do so, the Comptroller may require the applicant to amend it, or, in the absence of such amendment, refuse the application altogether. (*r*) From the decision of the Comptroller an appeal lies to the Law Officer, whose determination is final. (*s*)

Before the introduction of the provisional specification, patents were frequently upset on the ground of a disconformity between the title and the specification. Under the existing practice, however, any objection to the title will be taken by the officials of the Patent Office. So far as the public are concerned, no exception can now be taken to the title of an invention, except as constituting

(*m*) Six months, under this Act: 15 & 16 Vict. c. 83, s. 8.

(*n*) 46 & 47 Vict. c. 57.

(*o*) The form of letters patent now in use recites only that the inventor has by his complete specification particularly described the nature of his invention (see ante, p. 16). By s. 5 (4) of the Patents Act, 1883, a complete specification must, however, also particularly describe in what manner the invention is to be performed.

(*p*) Patents Act, 1883, s. 5 (5).

(*q*) Ibid. s. 6.

(*r*) Ibid. s. 7 (1).

(*s*) Ibid. s. 7 (2).

part of the provisional specification, and perhaps indicating a more restricted invention than that claimed in the complete specification. The early cases on the titles of inventions illustrate rather the principles upon which the Courts will act in considering the conformity of the two specifications required under the present law, than the sufficiency of the title independently of the provisional specification.

Two general rules may, however, be laid down to guide inventors in the selection of the titles of their inventions. First, the intending patentee should be careful to frame his title in language sufficiently wide to clearly cover the whole of his invention; for the title limits the ambit of the invention, which cannot be enlarged by subsequently inserting in the complete specification a wider claim. (*t*) Secondly, an inventor in choosing a title should remember that the mere generality of the words employed, provided they are not inaccurately used, is no ground of objection to a title. (*u*) It is always open to an inventor to subsequently limit his claim to less than the title originally covered, either by a disclaiming clause in the complete specification, or by an amendment of the original application. The harm done by a too general title is therefore not irreparable; whereas the vice of a title expressed in language too narrow to cover the whole invention is incurable, as there is no power of amendment except by way of excision.

In *Dart's* (*v*) case the original title read as follows: "Improved means of regulating the action of dynamo-electric machines and motors." On delivering their complete specification, the applicants, desiring, as the result of experiments, to narrow the scope of their invention, omitted from the title the words, "and motors." The case having come before the Law Officer, on appeal from the Comptroller, Sir R. E. Webster, A.G., referring to the Patents Act, 1883, said: "The question of the amendment of title is not directly dealt with by any section of the Act. Section 5 (5) provides that a specification, whether provisional or complete, must commence with the title. Under ordinary circumstances this title is intended to be in accordance with the title quoted in the

(*t*) *Croll* v. *Edge*, per Maule, J., 19 L. J. C. P. 261; 9 C. B. 479.

(*u*) The leading case in the early reports on this point is *Cook* v. *Pearce;* see the judgment of Tindal, C.J., 8 Q. B. 1044; 12 L. J. Q. B. 187; 13 L. J. Q. B. 189. For illustrations of titles formerly held too vague, see the following cases: *Cochrane* v. *Smethurst*, D. P. C. 354; *Campion* v. *Benyon*, 6 B. Moo. 71; *Bloxam* v. *Elsee*, 6 B. & C. 169, 178; *Bainbridge* v. *Wigley*, 1 Carp. 270.

(*v*) Giff. 308.

application for letters patent. Under Section 7 (1), if the title does not sufficiently indicate the subject-matter of the invention, the Comptroller-General may require that the application be amended. In my judgment, this section empowers the Comptroller to order an amendment of the title in the application if, in his opinion, the title does not sufficiently indicate the invention described in the provisional specification. . . . If the applicant merely desire to omit part of the invention described in the original title and provisional specification, I do not see that any amendment of the title and provisional specification is, of necessity, required, as I think that a proper disclaiming clause might be inserted in the complete, indicating that part only of the invention originally covered by the title of the provisional was intended to be claimed; but should the applicant think that some risk to the validity of his patent might be occasioned by such a course being adopted, it is open to him to lodge a complete, omitting the part desired to be left out, and open to the Patent Office, under Sections 7 and 9, to permit the original application and provisional to be amended by striking out the part which it is no longer desired to retain. It must, however, be distinctly understood that such an amendment in the title and provisional ought, in my opinion, to be confined to excision only, and not to amendment or other explanation, and the excision must be such as does not extend the scope of the title." (*w*)

The Provisional Specification.

Its Function and Requirements.—The function of the provisional specification is to ascertain the identity, not the entirety of the invention. (*x*) The necessity which the law has imposed upon every patentee of filing such a document is a legislative recognition of the custom which called upon every inventor who applied for a patent to give some notion of what his invention was. (*y*) "The office of the provisional specification," said Byles, J., in what has been called the leading dictum on this part of the law, (*z*) "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." (*a*)

(*w*) See, also, *Brown's Patent*, Griff. A. P. C. 1.

(*x*) *Newall* v. *Elliott*, 4 C. B. (N.S.), 293, per Pollock, C.B.

(*y*) Ibid.

(*z*) Per Kay, J., *Lucas* v. *Miller*, 2 R. P. C. 155.

(*a*) *Newall* v. *Elliott*, 4 C. B. (N.S.), 293. See, also, *United Telephone* v. *Harrison*, 21 C. D. p. 744; 51 L. J. Ch. p. 709; Patents Act, 1883, s. 5 (3). For examples of specifications, see Appendix IV., post.

The circumstance that the law allows a longer period to the inventor for filing his complete specification, shews that the provisional specification is not intended to include the details of the invention; these the inventor is assumed to be still elaborating. One of the objects of the provisional specification is to afford him protection within the ambit of his discovery, while he works out these details. At the time when the provisional specification is drawn he is presumed not to know them. (*b*)

The provisional specification, then, may be said to bear to the complete specification the relation which the title formerly bore to the old specification. It gives notice of the nature of the invention for which protection is sought, but not of the means of putting that invention into use. It is sufficient if it contains a fair general description; it is not intended to contain minute details.

"The relation which the provisional specification bears to the complete specification," said Lord Chelmsford, C., in *Penn* v. *Bibby*, (*c*) "is much the same as that which before the Patent Law Amendment Act, 1852, the title bore to the specification; and the observations of Tindal, C.J., in *Cook* v. *Pearce* (*d*) are as applicable to the provisional specification now as they were to the title formerly. That learned judge says, 'The vagueness' (he had previously spoken of the vagueness and generality) 'of the title appears to us to be an objection that may well be taken on the part of the Crown before it grants the patent, but to afford no ground for avoiding the patent after it has been granted. If such title did not agree with the specification when enrolled, or if there had been any fraud practised on the Crown in obtaining the patent with such title, the patent in those cases might undoubtedly be held void.' These remarks as applied to the title of a patent have a stronger application to the case of a provisional specification under the Patent Law Amendment Act, 1852, because the Law Officer, if he thinks the patent too large, can order it to be amended. And if no objection is made by him, the generality of the specification, to repeat the words of Tindal, C.J., affords no grounds for avoiding the patent after it is granted."

"A provisional specification," said Jessel, M.R., in *Stoner* v.

(*b*) See Tenterden, C.J., in *Crossley* v. *Beverley*, 1 W. P. C. 117; 3 C. & P. 513; 9 B. & C. 63; *Gadd* v. *Mayor of Manchester*, 9 R. P. C. 526 (per Lindley, L.J.).

(*c*) L. R. 2 Ch. 133; 36 L. J. Ch. 459.

(*d*) 8 Q. B. 1044, p. 1064; 12 L. J. Q. B. 187; 13 L. J. Q. B. 189.

Todd, (*e*) "was never intended to be more than a mode of protecting an inventor until the time for filing the final specification. It was not intended to contain a complete description of the thing, so as to enable any workman of ordinary skill to make it, but only to disclose the invention, fairly no doubt, but in its rough state, until the inventor could perfect its details." (*f*)

"A provisional specification," said Lindley, L.J., in *Woodward* v. *Sansum*, (*g*) "was never intended to contain a complete and exhaustive description of the invention; it was intended to be sufficiently specific to disclose the nature of the invention, so as to protect the inventor until the time for filing the complete or final specification, but permitting him in the meantime to perfect any details, to modify, supplement, and develop his invention, always keeping within what I may call the ambit of his invention, as disclosed in his provisional specification."

The provisional specification being the intimation of the patentee to the Crown of the discovery for which he asks letters patent, it does not lie with the public to take exception to the terms of that document. The sufficiency thereof is a matter solely concerning the Crown. And once letters patent have been sealed, no objection to their validity can be taken by the public on any alleged inadequacy of the provisional specification. (*h*)

Practice under the Patents Act, 1883.—The Patents Act, 1883, which governs the present practice, provides that the provisional specification shall commence with the title of the invention. (*i*) It must describe the nature of the invention and be accompanied by drawings if required. (*j*)

As formerly, it is not required to contain details; if it fairly describes the invention in the rough, that is sufficient. (*k*) It need not describe the advantages of the invention, and if it does, the patentee is not limited in his complete specification to such developments of his invention as possess all the advantages so described. (*l*)

The provisional specification must be left at the Patent Office with the application for letters patent. There it is referred by the Comptroller to an examiner to report whether the title sufficiently indicates the subject-matter, whether the description it contains is

(*e*) L. R. 4 C. D. 58; 46 L. J. Ch. 32.

(*f*) Cf. Lord Blackburn in *Bailey* v. *Roberton*, 3 App. Ca. 1074.

(*g*) 4 R. P. C. 178.

(*h*) *Cooke* v. *Pearce*, 8 Q. B. p. 1064; *Penn* v. *Bibby*, L. R. 2 Ch. 133; *Nickels* v. *Haslam*, 7 M. & G. p. 385.

(*i*) Patents Act, 1883, s. 5 (5).

(*j*) Ibid. s. 5 (3).

(*k*) *Pneumatic Tyre Co.* v. *East London Rubber Co.*, 14 R. P. C. 77, 573; 75 L. T. 488.

(*l*) Ibid. 14 R. P. C. p. 99.

fair, and whether the applicant has complied with the prescribed forms. (*m*) If the examiner reports unfavourably, the Comptroller may require an amendment of the specification and vary the date, so as to make the application run from the time when such amendment is complied with. (*n*) From the decision of the Comptroller an appeal lies to the Law Officer, whose determination is final. (*o*)

Under the Patent Law Amendment Act, 1852, all provisional specifications were published by the Crown authorities. (*p*) An applicant, therefore, who decided to abandon his application after obtaining provisional protection under that Act, gave his invention to the public in so far as it was disclosed by his provisional specification. Under the present Acts a different practice prevails. A provisional specification is now only published after the complete specification has also been filed, and not at all if the application is abandoned. (*q*) Hence, if an applicant is unable to complete the details of his invention within the time allowed for preparing the complete specification, he may allow his first application to lapse, without precluding himself from obtaining a patent for his invention on a subsequent application, except in so far as he incurs the risk of anticipation by some rival inventor.

The Complete Specification.

Statutory Requirements of the Complete Specification.—The provisional specification being the inventor's representation to the Crown as to the scope of the invention for which he seeks protection, the complete specification is his unreserved gift to the public (to take effect, however, only at a determinate future date) of that discovery, of which meanwhile he claims for himself the exclusive enjoyment. It is therefore at once apparent that the complete specification must contain many details which are not required to be inserted in the provisional specification. The latter may be a bare outline sketch; the former must be a completed picture.

The complete specification must set out the invention in detail. It must particularly describe and ascertain the nature of the invention and in what manner it is to be performed. (*r*) Ascertaining means making reasonably certain. (*s*) It must commence, like the provisional specification, with the title, and be accompanied

(*m*) Patents Act, 1883, s. 6.
(*n*) Patents Act, 1888, s. 2.
(*o*) Ibid. s. 2 (3).
(*p*) 15 & 16 Vict c. 83, s. 29.
(*q*) Patents Act, 1885, s. 4.
(*r*) Patents Act, 1883, s. 5 (4).
(*s*) Per Grove, J., *Philpott* v. *Hanbury*, 2 R. P. C. 33.

by drawings to illustrate it if required. (*t*) Where drawings have been left with the provisional specification it may, however, refer to such instead of repeating them. (*u*) The Acts further require that the complete specification shall end with a distinct statement of the invention claimed. (*v*) As that statement is notice to the public of what the patentee claims to monopolise, it ought to be made as clear and explicit as is reasonably possible, having regard to the subject-matter of the invention. It is, therefore, undesirable that it should be embarrassed by constant references back to the body of the specification. (*w*)

At the same time, the statutory requirement that the complete specification shall end with a distinct statement of the invention claimed is one of form only, and a failure to comply with this condition, once the Comptroller has accepted the specification, is no ground for subsequently holding the patent bad.

Referring to this in *Siddell* v. *Vickers*, (*x*) Lord Herschell said: "The Act does not provide that if this requirement is not complied with the patent shall be void, and I think it impossible to imply any such condition. There is no more warrant for doing so in this case than in the case of non-compliance with any other of the provisions of the section. The provision which immediately precedes that in question requires that a specification should commence with the title. It could hardly be gravely contended that if the Comptroller accepted a specification where the title did not occupy the first place the patent granted ought on that account to be held void." (*y*)

The complete specification ought to be in the form prescribed by the Patents Act, 1883, and signed by the applicant. But the statutory form is not intended to cover every possible application, and may be varied to meet any new case. (*z*) Where several applicants join in applying for a patent, it will be sufficient if the complete specification is signed by one of them. (*a*)

The complete specification must be left by the applicant at the Patent Office within nine months from the date of application. Otherwise the application is treated as abandoned. (*b*) But leave may be given by the Comptroller to extend the time by any period not exceeding one month. (*c*)

(*t*) Patents Act, 1883, s. 5.
(*u*) Patents Act, 1886, s. 2.
(*v*) Patents Act, 1883, s. 5.
(*w*) Per Fry, J. See *Fairfax* v. *Lyons*, 8 R. P. C. 407.
(*x*) 7 R. P. C. 307; 15 App. Ca. 496, p. 500.
(*y*) See, also, *Kelly* v. *Heathman*, 7 R. P. C. 348.
(*z*) *Grenfell & McEvoy's Application*, 7 R. P. C. 151.
(*a*) Ibid.
(*b*) Patents Act, 1883, s. 8.
(*c*) Patents Act, 1885, s. 3.

The complete specification, like the provisional, must pass the ordeal of examination by an official examiner, to whom it is referred by the Comptroller. (*d*) It is the duty of this examiner to see that it is prepared in the prescribed form, and that it describes substantially the same invention as that which is outlined in the provisional specification. (*e*) If the examiner reports unfavourably the Comptroller may refuse to accept the specification until it has been amended as he may require. (*f*) From such refusal an appeal lies to the Law Officer, with whom the ultimate determination of the matter rests. (*g*)

If the complete specification is not accepted within twelve months from the date of the application for letters patent, the application—unless an appeal is pending in respect of it to the Law Officer—becomes void. (*h*) But the time may be extended by the Comptroller for any period not exceeding three months. (*i*)

The reports of examiners are not published, and are privileged from production or inspection in all legal proceedings, unless the Court or officer having power to order discovery of them certifies that their production or inspection is desirable in the interests of justice and ought to be allowed. (*j*)

Having indicated the statutory requirements of a complete specification, it is now necessary to consider more in detail the light which the judicial decisions have thrown upon the object and scope of that instrument.

Good Faith towards the Crown.

Disconformity between the Specifications will Avoid a Patent.—In preparing his complete specification an inventor must observe strict good faith towards the Crown as the protector of the public interest. Thus, he must confine himself rigorously to the invention outlined in his provisional specification. If, having applied for letters patent for one invention, he proceeds by his complete specification to describe a different invention, or one of larger ambit, his grant will be void. In a word, there must be no disconformity between the two specifications.

The objection of disconformity is one which may be raised at any time to defeat letters patent, for the decision of the Patent

(*d*) Patents Act, 1883, s. 9 (1).
(*e*) Ibid.
(*f*) Ibid. sub-s. 2.
(*g*) Ibid. sub-ss. 2 & 3.
(*h*) Ibid. sub-s. 4.
(*i*) Patents Act, 1885, s. 3.
(*j*) Patents Act, 1883, s. 9 (5); Patents Act, 1888, s. 3.

Office to accept a complete specification is no estoppel upon any member of the public who may desire subsequently to question the validity of the grant, on grounds of disconformity.

On this point Lord Halsbury, C., in *Siddell* v. *Vickers*, (*k*) said: "It is suggested that the new machinery of the Comptroller and the examiner has superseded the power of raising any objection to the conformity of the provisional and complete specification. I am unable to take that view. I think it is an essential condition of a good patent that the invention described in the provisional should be the same as that in the complete specification, and I think the third sub-section of Section 26 preserves this as a ground upon which an action for the infringement of a patent right might be defended, and a ground upon which a patent might be revoked."

So likewise in *Nuttall* v. *Hargreaves*, (*l*) Lindley, L.J., discussing the question whether the Patents Act, 1883, had deprived a defendant in an infringement action of the defence of disconformity between the specifications, said: "In order to answer that question we must look at the further sections of the Act of Parliament, and the important one, passing by Section 14, is Section 26, Clause 3. Section 26 relates to revocation, and it says: '(1) The proceeding by *scire facias* to repeal a patent is hereby abolished; (2) Revocation of a patent may be obtained on petition to the Court; (3) 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.' In order to give effect to that section you have to consider what the effect would have been of a patentee before the Act not stating in his provisional specification the real nature of his invention, so as to identify it with the invention which he described in his complete specification. The answer to that has been settled by authority, and I think the last case of any importance was *Bailey* v. *Roberton*. (*m*) If the invention described in the two specifications is not the same the patent is bad. . . . In the face, therefore, of the twenty-sixth section, it appears to me that if in point of true construction these two specifications are not for the same invention this patent cannot be upheld."

At the same time it is manifest that the complete specification must contain details which do not appear in the provisional, and

(*k*) 7 R. P. C. p. 303; 15 App. Ca. p. 499.

(*l*) 8 R. P. C. 453; [1892] 1 Ch. 23; 61 L. J. Ch. 94.

(*m*) 3 App. Ca. 1055.

be the expression of an ampler knowledge than the patentee possessed at the date of the earlier document; for the whole object of provisional protection is to give the applicant time in which to develop and perfect the working of his invention, so that when he finally describes it he may give the fullest possible measure of useful information regarding it to the public. The law, therefore, contemplates the invention as a growing thing in the mind of the inventor; and questions of great difficulty must from time to time arise as to whether all the matters included and claimed in the complete specification legitimately flow from, and are part of, the original discovery, or are, as to some of them, matters of independent invention. In the desire to anticipate possible competitors, an intending patentee will sometimes apply for provisional protection while he has still but a crude idea of the discovery he believes himself to have made. In such case the working out of his invention may disclose results he little anticipated, and cause him to include in his complete specification matters which are really independent inventions. The temptation to thus transgress the limits which the law imposes is not lessened by the circumstance that it is in fact often most difficult to say where details cease to be developments of the original discovery and become independent inventions.

The general rule is that the patentee must not extend in his complete specification the area of the monopoly which he has indicated as the object of his application in the provisional specification; all new matters inserted in the complete specification must therefore be detail, legitimately flowing from the elaboration of the original invention described in the earlier specification.

Illustrations of this rule may be found in some of the early cases, if the dictum of Lord Chelmsford in *Penn* v. *Bibby* (*n*) be borne in mind, that the relation of the old title to the old specification is the same as that now existing between the provisional and complete specifications.

Thus, in *Cook* v. *Pearce*, (*o*) Tindal, C.J., said: "Any evidence of a design on the part of an inventor to choose a vague and general title, in order that he might avail himself at the time of the enrolling of the specification of an invention not discovered by him at the time of the taking out of the patent, or in order to prevent other subjects of the Queen from availing themselves of a discovery made by them upon the ground of its falling within the

(*n*) L. R. 2 Ch. 133; 36 L. J. Ch. 459.

(*o*) 8 C. B. p. 1064; 12 L. J. Q. B. 187; 13 L. J. Q. B. 189.

range of the general terms of the title, although such invention was different from that for which the patent was really and in truth taken out, might afford such proof of fraud upon the Crown and injury to the subject as that the vagueness and generality of the title in such cases might avoid the patent."

In *Croll* v. *Edge*, (*p*) the subject-matter of the letters patent, as originally described by the applicants in their title, was "Improvements in the manufacture of gas for the purpose of illumination, and in the apparatus used when transmitting and measuring gas." But in the specification subsequently enrolled, the patentees inserted two further words, so that it read, "For improvements in the manufacture of gas for the purpose of illumination, and in the apparatus used *therein*, *and* when transmitting and measuring gas." In consequence of this the Court of Common Pleas held the specification insufficient. Maule, J., in delivering the judgment of the Court, said: "The insertion is slight as to the number of words, but it adds most materially to the meaning of the sentence, and extends substantially the grant of the Crown; because the title, as suggested in the specification, represents the patent as being a patent for different kinds of apparatus used for two distinct things, viz., the making of gas, and the transmitting and measuring it. . . . Now, the patent granted was a patent 'for certain improvements in the manufacture of gas for the purpose of illumination, and in the apparatus used,'—not 'when manufacturing gas,' but 'when transmitting and measuring gas.' The title did not profess to comprehend improvements in any apparatus used in making gas. The patentees, in representing to the Crown the nature of the invention which they had discovered, did not give the Crown notice that they claimed the exclusive use of any apparatus for making gas. The title of the patent as described in the specification is one which comprehends as well improvements in apparatus for making gas as improvements in apparatus used in its transmission and metage. And, when the body of the specification is looked at, one main part of the patentees' claim consists of what may be, and probably is, a new mode of manufacturing clay retorts —an apparatus used in the manufacture, and not in the transmitting and measuring of gas. Any person reading the specification for the purpose of ascertaining what the patentees claim as their exclusive right, would see without doubt that a material branch of their claim, and of the patent, the specification of which they were professing to inroll, was an improvement in apparatus

(*p*) 9 C. B. 476; 19 L. J. C. P. 261.

used in the manufacture of gas. Now, no patent at all has been granted to them for that; and it appears to us to be difficult to suppose that the inrolling a specification in the terms here used can have been intended as otherwise than an attempt on the part of the grantees to remedy an oversight, and so alter and enlarge the patent. It seems to us that they have specified for a more extensive and a different patent from that which was granted to them. We therefore think the specification insufficient."

Among the later authorities on this point perhaps the most important is *Bailey* v. *Roberton*, (*q*) a case decided by the House of Lords on appeal from the Court of Session in Scotland. In that case the provisional specification stated that the object of the invention was the preservation of animal substances in a fresh state for a long time, so that when eaten they should not be distinguishable from animal flesh recently killed, and for the preservation of hides. This result the patentee said he achieved by coating animal substances with a mixed solution of gelatine and bisulphite of lime. In the complete specification, filed six months later, the patentee specified and claimed four different solutions adapted for the preservation of animal substances in various forms. The first of these, solution No. 1, was a solution of bisulphite of lime alone, unmixed with gelatine. Bisulphite of lime had been used for this purpose by a prior patentee. In an action for infringement against defenders, who had used bisulphite of lime alone, their lordships held that the complete specification, if large enough to cover the employment of bisulphite of lime for the preservation of animal substances, as practised by the defenders, would claim an invention larger than, and different from, that disclosed in the provisional specification, and would be open to the objection of want of novelty, and of want of a sufficient description of the manner in which the invention was to be performed; that therefore the patent was not valid and effectual to secure to the patentees the invention, or supposed invention, used by the defenders, though it might be valid to secure to them the invention described in the provisional specification.

"What is the invention," said Lord Cairns, "which is described in the provisional specification? That is the foundation of the whole of the claim of the appellants. Whatever be the invention which is there described, that is the invention which the appellants inform the Crown they have discovered, and in respect

(*q*) 3 App. Ca. 1055.

of which they ask for the protection of a patent, that is the invention in respect of which the patent is given to them; and whatever be that invention, it became their duty to specify it, and not another or a different invention, in the complete specification. . . . If the complete specification claims the solution No. 1, and the use of it separately as an invention pure and simple, then indeed the appellants may be able to shew that the respondents have infringed that use. But, on the other hand, they can only do so by claiming an invention through the medium of the complete specification which is not mentioned in the provisional specification, and as to the mode of exercising or applying which they cannot in that specification point out any claim or any information given to the public."

In the *United Telephone Company* v. *Harrison*, (*r*) the invention was for the transmission of sounds by electrical agency to a distance. The complete specification exceeded the provisional, and the patent was held void. The complete specification contained the following claim: "I am enabled to record the sounds produced by the human voice, or otherwise, by causing the movements of the diaphragm to be registered on paper or soft sheet metal, and then the paper may be used as an instrument to reproduce the sound upon a delicate diaphragm, by giving to the same a vibration similar to that originally given by the voice." The Court construed this as a claim to the instrument. Fry, J., said: (*s*) "It is impossible for me to read that, and not to believe it to be a claim to the instrument, whether used in combination with an electric current or not, its capacity to produce sound without any relation to the electric current having been pointed out and dwelt upon. The mode of indenting was a novelty; the mode of reproducing that sound was a novelty; and the claim appears to me to cover the phonograph in both its applications—its application to reproduce human sound directly and immediately at the spot where the voice had been spoken to it, and its application also as the transmitter of the same voice to a distance. Has that remarkable discovery so made by *Edison* been in any manner described in the provisional specification? The Statute, as we all know, requires that the provisional specification shall describe the nature of the invention; and before I proceed to consider the provisional specification in this case, I think it desirable to refer to some of the authorities which will explain the principle upon which I ought to proceed." After citing

(*r*) L. R. 21 C. D. 720; 51 L. J. Ch. 709.

(*s*) L. R. 21 C. D. p. 743.

Bailey v. *Roberton* (*t*) and *Newall* v. *Elliott*, (*u*) the learned judge continued: "Now I turn, with the light thrown by those cases as to the proper mode of construction, to the provisional specification in this case, and find that the title, which is to be read as part of the provisional specification, is, controlling by sound the transmission of electric currents, and the reproduction of corresponding sounds at a distance. And the inventor proceeds in this manner; he says, 'The vibrations of the atmosphere which result from the human voice, or from any musical instrument or otherwise, are made to act in increasing or lessening the electric force upon a line by opening or closing the circuit.'" After referring to the details of the invention, his lordship continued: "It is plain that that description refers entirely to the transmission of sound or the controlling of sound by means of electric currents or electricity in some form or other, and cannot, in my judgment, be taken to apply to an instrument which is capable of being worked in a very remarkable manner without the application of electricity in any shape or form. . . . Now, no doubt, some of those 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. . . . Supposing an inventor had, during the six months which preceded the complete specification, invented the phonograph, not as applied to the electric telegraph, but operating by itself, can it be said that that invention would have been protected by the description contained in this provisional specification of that instrument? I agree that the provisional specification need not describe the manner in which the 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 might be reproduced, not necessarily at a distance, but in the same room as that in which it was uttered, I do not think that 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."

In *Watling* v. *Stevens*, (*v*) Lord Esher, M.R., discussing an alleged disconformity between the provisional and complete specifications of the plaintiff's patent, said: "The main question which

(*t*) 8 App. Ca. 1055.
(*u*) 10 Jur. 955; 4 C. B. (N. S.), 293; see post, p. 178.
(*v*) 3 R. P. C. 151.

the parties came here to argue is that it is said that the complete specification goes beyond, and too far beyond, the provisional specification, and that therefore the whole patent is bad. I think that the law with regard to that is this: that if the complete specification sets out and claims an invention independent of that which is in the provisional specification, besides also describing that invention which is in the provisional specification, then the complete specification is bad. It would be equally bad if the invention described in the complete specification were a wholly different invention from that described in the provisional specification, because, as has been said, the patent is not given then, for the invention which is described in the provisional specification. Therefore (I must try and say it again), if there were only one invention described in the provisional application, and only one in the complete specification, but those two inventions were wholly and substantially different, the patent would be bad. So, if an invention is described in the provisional specification, which invention is also described in the complete specification, but in the complete specification another and distinct invention is described and claimed, then it is bad, because, with regard to the second invention, there is no provisional specification to cover it."

In *Nuttall* v. *Hargreaves*, (*w*) the Court of Appeal were of opinion that at the date of the provisional specification no useful invention had been made by the patentee, and that the invention claimed by his complete specification was a subsequent and independent discovery. They accordingly held the patent void for disconformity. (*x*)

The Complete Specification may include Improvements of the Invention discovered during the Provisional Protection.—While thus insisting formerly on conformity between the title and the specification, and now between the provisional and complete specifications, the Courts have always recognized the right of an inventor to the fullest latitude within the ambit of his discovery. The invention is assumed to be a growing thing in the mind of the applicant, and the law encourages him to prosecute its development during the period allowed him for preparing his complete specification. Hence, it is no disconformity to include in that document improvements and modifications which have occurred to the inventor subsequent to the date of his application for letters

(*w*) [1892] 1 Ch. 23; 8 R. P. C. 453.

(*x*) Of this case Lindley, L.J., in *Gadd* v. *The Mayor of Manchester*, said that it went further than any other. See 9 R. P. C. p. 527.

patent. On the contrary, it is the duty of the inventor to set out such improvements in his complete specification, if he has discovered them; otherwise, the public would not have, at the end of his monopoly term, the full benefit of his invention.

In *Jones* v. *Heaton*, (*y*) Tindal, C.J., said that a patentee was bound to give in his specification the most improved state of his invention up to the date of enrolling the specification.

In *Crossley* v. *Beverley*, (*z*) it was objected that the description of the invention in the specification was an attempt to extend the patentee's monopoly. In disallowing the objection, Lord Tenterden, C.J., said: "The objection really would come to this. If at the time a person applies for the patent he has in his mind an invention capable of producing the effect which he represents it to be capable of producing, and has brought that invention to a great degree of perfection, and within the time allowed by the patent for exhibiting the specification, and before the arrival of that time, he perfects his invention, and renders it more complete by the introduction of a different species of machinery, by the application of that to different mechanical parts of the machine; if so, whether that will make his patent void. No case has ever decided that, and I think it would be extremely dangerous to lay down any such doctrine. I do not see, myself, why time is allowed to prepare the specification, except upon the idea that the person, at the time he took out his patent, has not brought his machine, or whatever he has invented, to that degree of perfection which it may be supposed he is capable of bringing it to, and therefore he is allowed further time to do it."

"The specification, with new improvements," said Bailey, J., in the same case, "would still be the thing for which the patent was obtained, and I think it is most beneficial to the public to say that 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 to do so, 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; and therefore I am of opinion, in this

(*y*) 1 W. P. C. 404, n.

(*z*) 1 W. P. C. 116; 3 C. & P. 513; 9 B. & C. 63. Of this case, in *Jupe* v. *Pratt*, Alderson, B., said: "There never was a more instructive case than that": 1 W. P. C. p. 146.

case, the objection which has been taken to this patent is not to be supported."

"The filing of the provisional specification, by the express provisions of the Statute," said Lord Chelmsford, referring to the Patent Law Amendment Act, 1852, (*a*) "protects the invention for six months, and gives the patentee during this term the like powers, rights, and privileges, as might have been conferred upon him by letters patent. The object of the protection evidently is to enable the patentee to perfect his invention by experiments which, although open and known, will not be a user and publication to the prejudice of letters patent to be afterwards granted, so that he may be in a condition to describe in his complete specification, as the result of his experience, the best manner of performing the invention. It clearly appears, therefore, that the complete specification is, in a sense, supplemental to the provisional specification, not going beyond or 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 specification, as to the manner in which the invention is to be performed." (*b*)

In the case of *Newall's Patent*, (*c*) where the invention was an apparatus employed in the laying of submarine telegraph wires, the provisional specification, although giving certain details, did not mention the use of rings of iron to control the rope when going out at a rapid speed.

Referring to the insertion of this in the complete specification, Lord Chelmsford said: "It certainly might have been argued in that case that, although it was not necessary to state more in the provisional specification than the nature of the invention, yet if the inventor takes upon himself to go further and introduce a description of the manner of carrying it out, he thereby limits himself to that description, and the complete specification going beyond it rendered the patent void. But the Court of Common Pleas thought that all they had to look to was whether the provisional specification sufficiently described the nature of the invention, in compliance with the Statute, and that the not entering into a detail of all the means by which it was to be accomplished was immaterial." (*d*)

On the same subject, Lord Blackburn, in *Bailey* v. *Roberton*, (*e*)

(*a*) 15 & 16 Vict. c. 83.
(*b*) *Penn* v. *Bibby*, L. R. 2 Ch. 132; 36 L. J. Ch. 459.
(*c*) 4 C. B. (N. S.), 269.
(*d*) *Penn* v. *Bibby*, L. R. 2 Ch. 133; 36 L. J. Ch. 459.
(*e*) L. R. 3 App. Ca. p. 1075.

where the specification had also been filed under the Act of 1852, said: "When the nature of an invention has been described in the provisional specification, if something were found out during the six months 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 bit will not work so smoothly as he expected, and it is necessary to add a little supplement to it—still, the nature of his invention remains 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 shewn 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 has been 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 B., then as far as regards B. it is void, because the letters patent were granted for the invention that was described in the provisional specification, and do not cover the invention that is described in the other."

In *Lucas* v. *Miller*, (*f*) the plaintiff's patent was for an improved bicycle lamp. The lamp was constructed for suspension from the hub of the wheel between the wire spokes. In an action for infringement the defendants objected that the patent was void for disconformity, on the ground that the plaintiff had inserted and claimed in his complete specification a detail which was really an independent invention not disclosed in the provisional specification.

In overruling this objection, Kay, J., said: "After the plaintiff had lodged his provisional specification it occurred to him that he might add another small improvement, which was a mode of attaching the washers within the barrel, and for that purpose he made two rims within the two halves of the barrel, of such a kind that you could slide into them, by a kind of rotating sliding motion, a little tin case, within which the leather washer was held. Having invented that, he described it in his complete specification. . . . Now, first of all, it is said that this patent is bad because the complete specification differs from the provisional. However, that, upon the evidence before me, cannot be maintained for a

(*f*) 2 R. P. C. p. 155.

moment, because the reason why it so differs is that this rim and mode of attaching the washers was not invented at all at the time of the provisional specification. No possible objection can be raised to the complete specification because it is described there."

On the further objection that it was not only described but claimed, the learned judge said: "But, then, the answer one would make at once, without referring to authority, is this; it could not possibly be claimed in the provisional specification, because it was not invented; and, secondly, it is not the function of a provisional specification to claim anything. The claim is, in point of fact, a disclaimer: it shews what parts, and what parts only, of the whole invention you mean to protect by your patent. Here the plaintiff does not attempt to claim by his complete specification any new invention entirely separate and apart from that which was described in the provisional specification; but having described the mode of opening the lamp and barrel, it occurs to him that it would be an improvement on that particular form of lamp to which his improvement is specially adapted, to have a rim within the barrel into which he could slide these washers. Now, is that an invention so completely apart from the invention described in the provisional specification that it makes the complete specification bad, because it is a part of the claim in the complete specification? In my opinion it most clearly is not."

The question of disconformity was very fully considered in connection with the *Welch Patent*, granted for a mode of securing rubber tyres to metal rims or felloes on the wheels of cycles and other light vehicles. In the *Pneumatic Tyre Company* v. *Caswell*, (*g*) the Court of Appeal, affirming Kekewich, J., held the patent good. It was, however, again strenuously attacked on the ground of disconformity, in the later action of the *Pneumatic Tyre Company* v. the *East London Rubber Company*. (*h*) In this action the defendants contended that the patentee's provisional specification did not indicate that the invention was applicable to pneumatic tyres, but suggested its use with rubber tyres only, and that inasmuch as the complete specification claimed the invention for the purpose of attaching pneumatic tyres to cycle wheels, it exceeded the provisional and claimed a further invention. The remarkable success which pneumatic tyres were about to achieve had undoubtedly not been present to the mind of the inventor when the provisional specification of this patent was drawn, and it was accordingly

(*g*) 13 R. P. C. 164, 375. (*h*) 14 R. P. C. 77, 573.

alleged by the defendants that the enlarged claim in the complete specification was an attempt by the inventor to take advantage of those developments in the tyre industry between the filing of his two specifications which were due to the ingenuity of others. The Court, however, again upheld the patent; Romer, J., in a judgment afterwards affirmed on appeal, holding that the word rubber, as used in the provisional specification, was wide enough to include any convex rubber tyre, and that, although the patentee had originally contemplated the use of his invention in conjunction with a convex tyre of solid, or nearly solid rubber, its use with a tyre in the form of a rubber cover attaining convexity by the internal pressure of an expanded air tube was a legitimate development of the invention indicated in the provisional specification. (*i*)

The Substitution in the Complete Specification of Equivalents for Matters contained in the Provisional is Permissible.—Where the patent is for a mechanical combination it is no disconformity to vary means indicated in the provisional specification, by inserting in the complete their mechanical equivalents.

In *Watling* v. *Stevens*, (*j*) the patent was for improvements in spring-tip vans. It was contended at the trial, and subsequently in the Court of Appeal, that the patent was void, because the complete specification exceeded the provisional. The complete specification contained two claims illustrated by two figures, and claim No. 1 and figure No. 1 differed from claim No. 2 and figure No. 2. It was contended that claim No. 1 and figure No. 1 were alone within the provisional specification. But Matthews, J., at the trial declined to avoid the patent on this ground, being of opinion that the two claims, though representing different methods of attaining by combination a new and useful result, were substantially equivalent in their parts and arrangement, the one to the other. The Court of Appeal took the same view. Bowen, L.J., said, "What is the patent? Really it is for a combination or arrangement of rollers, and the pushing back or tipping, with a certain control of the angle. In the original specification the control of the angle was thought to be a very important part of the combination. But when the patentee came to the final part of the specification he thought it apparently more convenient for his general purposes to adopt a form of combination in which you

(*i*) The Welch specifications are printed in Appendix IV., post. For recent instances of disconformity see *Osmonds* v. *Balmoral Cycle Co.*, 15 R. P. C. 505; *Brooks* v. *Lamplugh*, 15 R. P. C. 33.

(*j*) 3 R. P. C. 37, 147.

do not require any very special control of the angle, and was satisfied with the minimum, as I will call it, of control. But it seems to me that, nevertheless, that form of combination is really within the ambit and scope of the invention itself; and I cannot think that, once given the idea of the rollers, the pushi- g back, and the tipping, and that the angle might, if you wanted it, be controlled by the original slotted levers or links, the variation to the present form, in which the model has been made, and in which the second figure has been drawn, is a variation in any way of principle, but a simple substitution of what really is a mechanical equivalent."

With *Watling* v. *Stevens* may be compared the case of *Woodward* v. *Sansum.* (*k*) In that case the patentee introduced into his provisional specification, not only a description of the nature of his invention, but also a detailed account of how to perform it. This, it was subsequently co[illegible]nded, limited him to the same method in his complete specification. The Court held, however, that this objection ought not to prevail, so long as the new method did not involve any departure from the nature of the invention, but was merely an alternative mode of putting the invention in practice—a transposition of mechanism with the same object and producing the same result.

C[illegible]on, L.J., said: "I think that although there is a different mode of carrying out the improvement contemplated by the plaintiff in his second patent, and described in sheet three, from that which is described in the provisional specification, the whole of it comes within the invention, the nature of which he has described in his provisional specification. It is true that in his provisional specification he has stated a different mode of carrying his invention into effect from that which he stated in sheet three of his complete specification; but if both are really within the same invention described, though not minutely but in general terms, in the provisional specification, then the patent will not be bad, simply because a different mode of carrying the same invention into operation is described in the complete specification, and even although that may be an improvement on what is described in his provisional specification, because a patentee putting in a provisional specification shewing the nature of his invention is not bound to describe the way in which that can be carried into effect and operation; but if he does describe a way of doing it, and before he files his complete specification he either

(*k*) 3 R. P. C. 357; 4 R. P. C. 177.

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

In *Gadd* v. the *Mayor of Manchester*, (*m*) the object of the plaintiff's invention was to keep the bottom rim of a gasometer always horizontal, so that the gasometer would, as it rose and fell, remain always in a vertical position, and so preserve its stability. In the provisional specification the patentee mentioned racks and cogwheels and wheels geared together with chains as the means to be employed. In his complete specification another method, in which racks and cogwheels were dispensed with—an arrangement of chains fastened at both ends but passing over ordinary fixed pulleys, was shewn. On the objection that this difference amounted to disconformity between the specifications and avoided the patent, Lindley, L.J., said: "Here again the case of the present plaintiffs is near the line; but I have come to the conclusion that the plaintiffs have not overstepped the limits within which the law requires a patentee to keep. This part of the case turns entirely on the view taken of the nature of the plaintiffs' invention. My view is that they sought and obtained protection for an invention for keeping the bottoms of gasometers horizontal without the use of an external framework, but, instead thereof, by mechanical means such as are described in the provisional specification. But the plaintiffs were not tied to those particular means. A patentee is not prevented from improving the means of carrying out the invention for which he obtains provisional protection. On the other hand, he must not, under colour of an improvement, obtain the advantages of provisional protection for an invention the nature of which he has not described in his provisional specification (see *Bailey* v. *Roberton* (*n*) and *Vickers* v. *Siddell* (*o*)). The whole object of provisional protection is to enable a patentee to work at and improve his invention without risk of invalidating his patent by premature publication or user. (*p*) The only limit set to what he can do in this respect is that the invention as finally specified

(*l*) 4 R. P. C. p. 174. See, also, *Siddell* v. *Vickers*, 5 R. P. C. pp. 426, 427; L. R. 39 C. D. 92.

(*m*) 9 R. P. C. 516; see p. 526.

(*n*) 3 App. Ca. 1055.

(*o*) 15 App. Ca. 496; 7 R. P. C. 306.

(*p*) 46 & 47 Vict. c. 57, s. 14.

must not be a different invention from that provisionally protected. Now, to hold in the present case that the arrangement shewn in Fig. 16 in the plaintiff's complete specification is an invention of a different nature from that described in the provisional specification is, in my opinion, to take too narrow a view of the plaintiff's real invention, and to miss its essential character. Although it is quite true that the object of the patent being old the patentee must be tied down to the modes of attaining that object described and claimed by him, it is, in my opinion, wrong in point of law, even in cases of this kind, to tie him down to the particular methods shewn in the provisional specification. But it is only by so tying him down that his patent can be held bad for want of conformity. Even under the present law the Court may be driven to hold a patent invalid on the ground that the invention described and claimed in a complete specification is not the same as that provisionally protected; but having regard to the provisions made for the comparison of the two documents by an official examiner (*q*) the Court ought not to decide against the validity of a patent on the ground in question, unless the two inventions are unmistakably different. If a case is on the border line the patent ought to be held good rather than bad."

In *Miller & Company* v. *Scarle*, (*r*) the invention was an improved clip for mounting the lamps of velocipedes. It was contended that the patent was bad for variance between the provisional and complete specifications. The object of the inventor was to remedy the misfittings which sometimes occurred through there being no standard size for the brackets and clips used in attaching lamps to bicycles. The remedy proposed was an arrangement of a socket by which the clip with a screw could be fastened to the bracket. In the provisional specification only one clip and one action was mentioned. The complete specification included two clips and a double action. Commenting on this Bowen, L.J., said: "I regard the addition of the double action as a development and an improved arrangement, but it is simply, to my mind, the addition of a possibly better arrangement, and of a useful mechanical equivalent. To my mind, the patentee, when the complete specification was filed, if he had this altered adjustment in his mind, was bound to disclose it to the public, and was bound to give the public the benefit of all that he knew about this mechanical equivalent, which, I will assume for the moment, to be an improved adjustment, and so doing, has he thereby invalidated his patent? It seems

(*q*) See 46 & 47 Vict. c. 57, s. 9; 51 & 52 Vict. c. 50, s. 4. (*r*) 10 R. P. C. 106.

to me nothing but a performance of his duty to the public, and there is therefore no variance which could invalidate this patent." (*s*)

The Complete Specification may Omit Matters Contained in the Provisional Specification.—The omission from the complete specification of something mentioned in the provisional will not invalidate a patent, if the character of the invention remains the same and the ambit is not enlarged. Such an omission acts in the way of a disclaimer, and the law offers no objection to a patentee curtailing his invention in this way, though it will not allow him to extend it.

In *Nickels* v. *Haslam*, (*t*) the title was "Improvements in the manufacture of plaited fabrics." The specification only shewed an improvement, and this, it was contended, avoided the grant. Tindal, C.J., said: "The case resolves itself very much into the case of *Cook* v. *Pearce*, (*u*) where an objection was taken that the title of the letters patent was larger than the specification, and the Court of Exchequer held that that ground was sustainable only where it could be inferred that some fraud had been thereby practised on the Crown, or some detriment sustained by the public."

The law was similarly laid down by Erle, C.J., in *Thomas* v. *Welch*. (*v*) "It is said in the first place that the complete specification is void, because it omits some of the inventions put forward in the provisional specification. The provisional specification describes an instrument, and then says that 'This, or another acting therewith, acts to hold the work during the insertion of the needle.' It is said that the complete specification contains nothing corresponding to this second alternative. Assuming that this is so, I do not think that the objection ought to prevail. The difference is a slight one, and injured nobody; and it might be that the patentee had something in his mind when he filed his provisional specification which he found afterwards would be useless. If such had been the case after the filing of the complete specification, he could have filed a disclaimer; but 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."

So, too, in *Penn* v. *Bibby*, (*w*) Lord Chelmsford, C., said: "Nor

(*s*) 10 R. P. C. p. 111.

(*t*) 7 M. & G. 378; 13 L. J. C. P. 146; 8 Scott (N. R.), 103.

(*u*) 8 Q. B. 1044; 12 L. J. Q. B. 187; 13 L. J. Q. B. 189.

(*v*) L. R. 1 C. P. p. 201; 35 L. J. C. P. 200.

(*w*) L. R. 2 Ch. 134; 36 L. J. Ch. 460.

is it at all necessary that the complete specification should extend to everything comprehended within the provisional specification. Perhaps a better illustration of this proposition could not be given than that which was offered during the argument. If the patentee were to introduce into his complete specification anything which was warranted by the terms of the provisional specification, and afterwards found that a part of that which he had claimed would invalidate his patent for want of novelty, or for any other reason, he might afterwards cure the objection by a disclaimer. Now, if he could be allowed to disclaim in such a case, which is a matter of indulgence, he must have a right to waive his claim to any portion of the grant which the allowance of the provisional specification had entitled him to demand."

In *Stoner* v. *Todd*, (*x*) Jessel, M.R., laid down the rule in similar terms. "When we find in the final specification that in the description of one of the subordinate matters of the invention one of the details has been abandoned, that is a notification to the public that the inventor could not work it, or thought it useless, and has consequently omitted it altogether."

In *Gaulard & Gibb's Patent*, (*y*) the provisional specification contained the words, "An unlimited number of inductive coils." This statement was found to be erroneous, and was changed in the complete specification to "a number of inductive coils," and this was held not to avoid the patent.

In the *Pneumatic Tyre Company* v. *East London Rubber Company*, (*z*) the patentee described in his provisional specification two modes of fastening rubber tyres to cycle rims, but only included one in his complete specification. On this Romer, J., said: "If, in a provisional specification which describes a valuable part of an invention, there is also described as an alternative part something which turns out not to be valuable, and is abandoned in the final specification, such abandonment does not affect the validity of the claim for the invention, disregarding the omitted alternative part, or deprive the patentee of the right to say that he first discovered and gave to the public the benefit of the valuable part which was retained." (*a*)

In *Aktiebolaget Separator* v. *Dairy Outfit Company*, (*b*) where the invention related to improvements in centrifugal separators used for separating the cream from milk, the patentee described in his

(*x*) L. R. 4 C. D. p. 60; 46 L. J. Ch. p. 33.
(*y*) 5 R. P. C. 533.
(*z*) 14 R. P. C. 77.
(*a*) Ibid. p. 98.
(*b*) 14 R. P. C. 473; 15 R. P. C. 327.

provisional specification various modes of effecting the partitioning up of the centrifugal bowl, which was the essence of his invention. In his complete specification he abandoned all of these except one, viz., placing a number of conical plates above each other inside the bowl in such a manner as to leave a narrow space between the upper surface of each lower plate and the lower surface of each upper plate, and thus produce narrow inclined radial passages. This he found was the best mode of giving effect to his invention; and it was held no objection to his patent that he had abandoned the others.

Good Faith towards the Public.

The Patentee must Make a Full and Candid Disclosure of his Invention.—An inventor must also in his complete specification observe good faith towards the public. The full disclosure of his discovery has been said to be the price by which the patentee buys his monopoly, (*c*) and that price the law expects him to pay with candour and without reserve. Any attempt upon his part to withhold any part of it will undoubtedly be fatal to his grant, should the patent be contested in a court of law. On this point many authorities might be cited.

In *R.* v. *Arkwright*, Buller, J., said: "It is clearly settled at law that a man, to entitle himself to the benefit of a patent for a monopoly, must disclose his secret and specify his invention in such a way that others may be taught by it to do the thing for which the patent is granted, for the end and meaning of the specification is to teach the public after the term for which the patent is granted, what the art is, and it must put the public in possession of the secret in as ample and beneficial a way as the patentee himself uses it. This I take to be clear law, as far as it respects the specification, for the patent is the reward which, under the Act of Parliament, is held out for a discovery; and, therefore, unless the discovery be true and fair the patent is void." (*d*)

Again, in *Turner* v. *Winter*, Ashurst, J., said: "I think that as every patent is calculated to give a monopoly to the patentee, it is so far against the principles of law and would be a reason against it were it not for the advantages which the public derive from the communication of the invention after the expiration of

(*c*) As to this phraseology see ante, p. 158.

(*d*) 1 W. P. C. 64; Dav. P. C. 61.

the time for which the patent is granted. It is, therefore, incumbent on the patentee to give a specification of the invention in the clearest and most unequivocal terms of which the subject is capable. And if it appear that there is any unnecessary ambiguity affectedly introduced into the specification, or anything which tends to mislead the public, in that case the patent is void." (*e*)

In *Hornblower* v. *Boulton*, (*f*) Grose, J., discussing the requirements of a specification, said: "The aim of the legislature is obvious; on the one hand, it was to encourage ingenious artificers and able and studious men to invent and bring forward for the use of the public new manufactures, the produce of their own ingenuity, by holding out to them the reward of fourteen years' monopoly; on the other hand, to secure to the public the benefit of the discovery, by causing to be enrolled a complete description of the thing to be done, and the manner of doing it, that others might be fully informed of it; and at the end of the fourteen years be enabled to work or make the manufacture of which the patentee was the inventor. . . . The benefit to the public is from the specification disclosing to the world how others may make or use the same manufacture; without the specification the public have not that information."

So, too, in *Lewis* v. *Marling*, (*g*) Bayley, J., said: "To support a patent it is necessary that the specification should make a full disclosure to the public. If the patentee suppresses anything, or if he misleads, or if he does not communicate all he knows, his specification is bad; but if he makes a full and fair communication, as far as his knowledge extends, he has done all that is required."

"If," said Tindal, C.J., discussing the specification in *Galloway* v. *Bleaden*, "there is a want of clearness, so that the public cannot afterwards avail themselves of it, much more if there is any studied ambiguity in it, so as to conceal from the public that which the patentee for a term is enjoying the exclusive benefit of, no doubt the patent itself would be completely void." And again: "The main question is whether it is such a fair and clear statement that a person with a competent degree of knowledge upon the subject-matter to which the patent relates would be able to make that which the plaintiff now enjoys the exclusive privilege of." (*h*)

(*e*) 1 W. P. C. 77; 1 T. R. 606; approved by Fry, J., in *Wegmann* v. *Corcoran*, 13 C. D. 77; 27 W. R. 357.

(*f*) 8 T. R. p. 100; Dav. P. C. p. 227.

(*g*) 4 C. & P. 57; 10 B. & C. 26; 1 W. P. C. 496.

(*h*) 1 W. P. C. 525.

The Specification must not be Equivocal.—The language of the specification, therefore, must not be so equivocal as to leave the public in doubt as to its true meaning.

In *Hastings* v. *Brown*, Lord Campbell, C.J., said: "It is clear that the patentee ought to state distinctly what it is for which he claims the patent, and describe the limits of his monopoly. That 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 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. The specification therefore is bad, and there must be a non-suit." (*i*)

"The law is admitted," said Coleridge, J., in the same case; "if the specification upon a fair interpretation be equivocal, it is insufficient." (*j*)

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

In *Gandy* v. *Reddaway*, (*l*) the patent was for improvements in belts or bands for driving machinery. The object of the inventor was to provide a band which would not give out through stretching, which would not be affected through variations of the atmosphere, and which would run round small pulleys without cracking. To attain these results he employed cotton canvas "hard woven," prepared in a particular manner. Different kinds of canvas were required for different sizes of pulleys. But this fact the specification did not indicate. In an action for infringement, Pearson, J., held the patent bad, and the Court of Appeal, although strongly of opinion that the invention was a useful one, affirmed his judgment.

Lindley, L.J., said: "The patentee says the object of his invention is to manufactu.. belts for driving machinery, of cotton

(*i*) 1 E. & B. p. 453.
(*j*) Ibid. p. 454.
(*k*) 3 C. D. p. 576.
(*l*) 2 R. P. C. 49.

canvas which will not give out by stretching, and will not be affected by variations of the atmosphere, and, at the same time, will run round small pulleys without cracking. He tells you what is to be used for the purpose of making these belts. . . . Cotton canvas, 'hard woven.' . . . When you come to read the specification, and read it through, there is nothing whatever to lead anybody who knows nothing at all about the matter, to come to the conclusion that one sort of hard canvas will do for one sort of pulleys, and another sort for another kind of pulleys. Persons unacquainted with the subject-matter would infer that any hard canvas prepared in this way would do for any pulleys. The evidence is striking. It shews that this is not true. The evidence shews that there are various sorts of hard canvas . . . known in the market, described and indicated by Nos. 1–10, and the evidence shews that No. 1 will not do for small pulleys, and No. 10 will not do for large pulleys, or for large machines. . . . Stopping there, that shews that the specification is misleading; but it could be got over, and it might be got over by evidence to shew that a person having the ordinary acquaintance which a workman making belts would have, would have known of that, and that nobody with a competent knowledge of the subject-matter would dream of putting No. 1 on to a small pulley, or No. 10 on to a large pulley. That might be so, but there is no evidence of it." (*m*)

The Specification must not contain False Suggestions.—If a patentee suggests in his specification materials or proportions which will not answer the purpose, the patent cannot be supported, for the public are misled. (*n*)

In *Turner* v. *Winter*, (*o*) the specification directed (*i.a.*) that the following materials were to be used in the process—"sea salt, or sal gem, or fossil salt, or any marine salt." Fossil salt was a generic term, including sal gem as well as other species of fossil salt. Sal gem, it was proved, was the only salt that would answer the purpose. The specification also professed to produce white lead as one of the results of the process. In fact, the product was only something like common white lead, and answering some of its purposes. On these facts the Court were of opinion that the patent was bad.

Ashurst, J., said: "I understand that sal gem is the only one [fossil salt] which can be applied to this purpose; so that,

(*m*) 2 R. P. C. p. 54.

(*n*) As an instance of a patent recently revoked for false suggestion, see *Owen's Patent*, 17 R. P. C. 68.

(*o*) 1 W. P. C. 77; 1 T. R. 606.

throwing in 'fossil salt' can only be calculated to raise doubts and mislead the public. That word could not have been added with any good view; it must produce many unnecessary experiments; therefore, in that respect, the specification is not so accurate as it ought to have been." (*p*)

In the same case, Buller, J., said that if the patentee only achieved his process with two or three ingredients, and yet inserted others that would not answer, the patent was void. So, too, if he made the article with cheaper materials than the specification suggested, even although the dear ones answered the purpose; for he did not enable the public to derive the same benefit from the invention as he ha[illegible]mself. (*q*)

If the invention is a simple one, the patentee must not so clothe his description of it in obscure or ambiguous words as to convey to the public the impression that the performance of the invention is a difficult and complicated operation. Such a description lacks candour, and will avoid the patent.

In *Savory* v. *Price*, (*r*) the patent was for a method of making Seidlitz powder. The specification gave three distinct recipes for preparing the ingredients, and then directed two scruples of each of the three ingredients resulting from those recipes to be dissolved in half a pint of water, in order to produce the Seidlitz powder. The result was new and useful; but it appeared that the three recipes were only common processes for preparing three well-known substances, which were sold in shops before the date of the patent, viz. Rochelle salts, carbonate of soda, and tartaric acid. If the specification had directed those three substances to be combined in the required proportions the result would have been the same Seidlitz powder. The specification, however, gave only the recipes for making these ingredients, and not their names—indicating that the making of them was part of the patent method for producing Seidlitz powder. In an action for infringement the plaintiff was non-suited. Abbott, C.J., said: "It is the duty of a patentee to specify the plainest and most easy way of producing that for which the patent is granted, and to make the public acquainted with the mode which he himself adopts. By reading this specification, we are led to suppose a laborious process necessary to the production of the ingredients, when, in fact, we might go to any chemist's shop and buy the same things ready made. The public are misled by this specification, which tends

(*p*) 1 W. P. C. p. 80.
(*q*) Ibid. p. 81.
(*r*) 1 W. P. C. 83, n.; Ry. & M. 1.

to make people believe that an elaborate process is essential to the invention; it cannot be supported."

So, too, the patent will be void if the patentee suggests generally to the public that other materials than those specified by him as suitable for carrying out his invention may be used for that purpose, when in reality he has tried by experiment and failed to discover any other material that will answer.

Thus, in *Crompton* v. *Ibbotson*, (*s*) where the patent was for an improved method of drying and finishing paper, the specification contained these words: "The invention consists in conducting paper by means of a cloth or cloths against a heated cylinder, which cloth may be made of any suitable material; but I prefer it to be made of linen warp and woollen weft, which cloth is shewn in the drawing by blue lines." It was proved that the patentee, who had tried various other materials without success for this purpose, really knew of no other conducting medium which would serve the purposes of his invention. In an action for infringement the patentee was non-suited. After argument to set aside the non-suit, Lord Tenterden said: "The patent was obtained for the discovery of a proper conducting medium. The plaintiff found, after repeated trials, that nothing would serve the purpose except the cloth described in his specification; yet he says the cloth may be made of *any suitable* material, and merely that he *prefers* the particular kind there mentioned. Other persons, misled by the terms of this specification, may be induced to make experiments which the patentee knows must fail; and the public, therefore, has not the full and entire benefit of the invention—the only ground on which the patent is obtained."

But a general statement in a specification that the invention claimed is capable of application to other purposes beyond those for which in that specification protection is claimed will not invalidate a patent. (*t*)

How far Proportions must be Specified.—A specification which states proportions which will not work is bad, being calculated to deceive the public; but where the invention consists in the use of old materials in new proportions, the specification is not bad for uncertainty merely because the inventor, after stating the best proportions, does not limit himself to those precise proportions.

In the *Patent Type-founding Company* v. *Richards*, (*u*) the specification stated that, in the manufacture of type, it had been

(*s*) Dan. & L. p. 33; 6 L. J. (O. S.) K. B. 214.

(*t*) *Cole* v. *Saqui*, 5 R. P. C. 495.

(*u*) Johnson, 381; 6 Jur. (N. S.), 39.

usual, for the most part, to employ antimony, with a small proportion of tin; that the object of the invention was to obtain harder, tougher, and more enduring type, by employing tin in large proportions with antimony, and to greatly reduce, or wholly omit, the use of lead; that the best proportions were 75 of tin and 25 of antimony, but that this might be varied to some extent; that when lead was used it should not exceed 50 parts in 100; and that when the antimony was pure, the best proportions were as given above, but that when it contained other metals, the proportion used should be diminished.

Wood, V.C., holding the specification sufficient, said: "Though the inventor does not bind himself to particular proportions, his specification states of what the essence of his invention consists, viz., 'new and large proportions.' It will be for experts in the trade to say whether a hard, tough, and enduring metal was formed by the old proportions, whether the invention is new, and whether the addition of a half or one per cent. would be an evasion of it."

So, likewise, in *Neilson* v. *Betts*, Lord Westbury said: "If, it is said, a particular detailed process be claimed, the claim is defective and void, for the proportions of the ingredients used are not given. Now, in the first place, certain proportions are given by *Betts* in his patent, and they consist in the relative thickness of the lead and tin. The lead he takes by way of preference at a thickness of a quarter part of an inch; the tin he takes by way of preference at a twentieth part of the thickness of the lead —that would be the eightieth part of an inch. But he assigns these relative proportions, not as things which are in themselves unchangeable, but as being the best for the purpose which he desired to accomplish, and they are given rather as illustrations of the mode of user of the process than as certain definite termini, which could not be exceeded or diminished either on the one side or the other. I find, therefore, no objection to the validity of the patent on the ground of the uncertainty of the proportions given, or the necessity of having more definite and certain proportions stated." (*v*)

If Ingredients Required can only be Obtained Abroad, this Fact must be Disclosed.—Any knowledge which the patentee possesses at the time of filing his specification which it will be essential to the convenience of the public performing it to know, must be disclosed.

(*v*) L. R. 5 H. of L. p. 21; 40 L. J. Ch. p. 329. As an instance of a patentee being limited to the proportions specified by him, see *Maxim-Nordenfelt Co.* v. *Anderson*, 14 R. P. C. 671; 15 R. P. C. 421.

Thus, when it was shewn that the patentee in a patent for trusses for ruptures had omitted what was very material for tempering steel, which was rubbing it with tallow, Lord Mansfield held the patent void. (*w*)

In *Sturtz* v. *De La Rue*, (*x*) the specification described one of the ingredients used in the patentee's process as "the purest and finest chemical white lead." The finest white lead which could be obtained in this country would not answer the purpose. What the patentee used was a purer material, which was imported from Germany. The specification did not disclose this fact. The patent was held void. "It is a principle of patent law," said Lord Lyndhurst, "that there must be the utmost good faith in the specification. It must describe the invention in such a way that a person of ordinary skill in the trade shall be able to carry on the process. Here, the specification says that there is to be added to the size certain proportions 'of the finest and purest chemical white lead.' A workman would naturally go to a chemist's shop, and ask for "the finest and purest chemical white lead;' the answer which he would receive would be, that there was no substance known in the trade by that name. He would be compelled to ask for the purest and finest white lead; and, according to the evidence, the purest and finest white lead that can be procured in London will not answer the purpose. It is said that there is a substance prepared on the Continent, which is white lead or some preparation of white lead; and that, by using it in the manner described in the specification, the desired effect is produced. If that be so, the patentee ought to have directed the attention of the public to that circumstance. He ought to have said, 'The purest white lead which can be obtained in the shops in London will not do; but there is a purer white lead prepared on the Continent, and imported into this country, which alone must be used.' 'The purest and finest chemical white lead' must mean the finest and purest white lead usually gotten in the general market for that commodity, unless the public be put on their guard by a statement, that what would be called very fine and pure white lead, in the ordinary sense of the trade, will not answer, but that the white lead used must be of a superlatively pure and fine quality, prepared in a particular way, and to be gotten only in a particular place. If the article is not made in this country, but may be imported, it would be necessary to mention that circumstance. . . . It appears to me

(*w*) *Liardet* v. *Johnson*, Bull, N. P. 76. (*x*) 7 L. J. Ch. 47; 5 Russ. 322.

that this specification does not give that degree of full and precise information which the public has a right to require."

In *Derosne* v. *Fairie*, (*y*) the patent was for improvements in the means of extracting and refining sugar. One of the methods was the application of a filter formed of the charcoal of bituminous schistus. The bituminous schistus commonly known in this country contained sulphuret of iron. But iron was injurious to the patentee's process, and such bituminous schistus could not be used unless the iron was first extracted. The plaintiff used a form of bituminous schistus which had undergone a process of distillation, and which had been made into charcoal in a foreign country. But his specification contained no hint that it was necessary to treat the material in order to remove the obnoxious iron, nor did it shew any means by which the iron might be extracted successfully. Lord Abinger, C.B., in directing the jury, said: "The specific point requiring your attention is as to the bituminous schistus, whether the plaintiff has fairly communicated to the world engaged in this sort of trade, what his object was. For he must give a full and true disclosure of the nature of the invention, and if he leaves any part of his invention in a state of obscurity, and does not give definite directions how to perform it, he loses the advantage of his patent. The bituminous schistus is put first, and forms, undoubtedly, a very important part of the invention, and persons not acquainted with the sciences may be well excused for not knowing what bituminous schistus is, and, *primâ facie*, it is no objection to the specification that those terms must be explained by some men of art. *Mr. Faraday* and the other chemists say there are many kinds of bituminous schistus, that they vary very much in the quantity of the sulphuret of iron which they contain, and that they do not know any process by which the sulphuret of iron can be completely expelled. The plaintiff says the sulphuret of iron ought to be expelled, but he does not state which of the various bituminous schistuses he uses, or any process of expelling the sulphuret of iron."

The jury gave their verdict for the plaintiff. But in the Court of Exchequer a rule for a new trial was made absolute. In his judgment, Lord Abinger, C.B., said he felt he ought to have ordered a non-suit at the trial. "The plaintiff was bound either to have shewn that there was some known process of extracting the iron, which he did not, or to have shewn that there was some bituminous schistus which might be found in England, with

(*y*) 1 W. P. C. 156.

the iron not entirely extracted, that yet might be used with effect."

The patentee must disclose in his complete specification each step necessary for putting his invention in use. The omission of one such step will avoid the patent. Thus, in *Gaulard & Gibb's* (*z*) *Patent*, where the invention consisted in a new system of distributing electricity for the production of light and power, the complete specification stated that the quality and value of the induced currents would depend on the special construction of the electrical generators, but there was no statement shewing in what such special construction consisted. The specification was held insufficient. Kekewich, J., said: "A patentee is bound to tell the public in his specification not only what his invention is, but how practical effect is to be given to it, and if the invention be a machine, how that machine can be manufactured. If there are many different ways of effecting the entire object, or any particular part of it, he is not bound to specify them all in detail—but he is bound to give such instances—selections, it may be, from a particular class—as will enable a competent workman to know what he ought to use, and he is further bound to refer to those instances, or the class from which they come, in language which leaves no doubt what articles are, and what are not, applicable to the production of the intended result. This is important for two reasons. First, in return for his monopoly the patentee is bound to put the public in possession, as far as description can do it, of his invention in principle and detail; and secondly, as a condition of being entitled to restrain other operators from producing his result by the same means, he is bound to tell them precisely what they cannot do except under the penalty of an injunction, with its serious consequences, and thus to indicate what can be done safely. This is not less true where the patent is for a combination than in any other case. Indeed, I am not sure that the obligation ought not in such a case to be particularly strict. If a man says, 'I claim to have protected as my invention three things combined which, though separately well known, have not been before used together,' it is reasonable and right that he should state exactly what each of these three things is; and if any of them belongs to a class comprehending several varieties, then also which of the varieties are intended; and this, of course, he can easily do, as admittedly the combined items are well known." (*a*)

A Defective Specification cannot be Cured by Supplemental

(*z*) 4 R. P. C. 525.

(*a*) Ibid. p. 534.

Instructions.—Nor will it help the patentee in such case to prove that he has supplemented his defective specification by instructions sent to his agents which remedy the defective proportions inserted in the specification.

In *Pooley* v. *Pointon*, (*b*) the patentee in the same year in which he took out his patent sent instructions to his agents correcting the specification, which had stated proportions, etc., that would not achieve the result aimed at, viz. the making of malt bread. These he subsequently still further corrected under the heading "Revised Formulæ," suggesting new proportions of the required ingredients. Pearson, J., held the patent invalid. "The proportions in the specification were nothing more than guess work; that, the patentee has shewn himself, by altering them from time to time, by issuing revised formulæ according to which his bread was to be made; and I come to the conclusion, therefore, that the specification was not that which the patentee was bound to lodge if he was to have any benefit from this patent." (*c*)

With *Pooley* v. *Pointon* may be compared the case of *Coles* v. *Baylis*. (*d*) There the patent was for a mode of preparing lithographic printing surfaces. The language of the specification was clear, and it was not suggested that the invention could not be made from the specification. But the patentee issued further instructions for the use of the stone when prepared, and it was argued that these should have been included in the specification. Bacon, V.C., refused, however, to accede to that argument. The invention, his honour pointed out, was for the preparation of the stone, not its use when prepared. The specification disclosed a perfectly successful way of preparing the stone, and the fact that the patentee issued instructions as to its employment when made was no impeachment of the patent, for they were in no way essential to the performing of the protected invention.

Unconscious Disclosure by Patentee.—In *Badische Anilin und Soda Fabrik* v. *La Société Chimique und Wilson*, (*e*) the question was discussed whether a patent would be good notwithstanding the fact that the patentee was ignorant that the presence of a particular ingredient in his process was essential to its success, if in his complete specification he specified something which included that ingredient, and so unknowingly and blindly, as it were, in fact indicated a successful mode of achieving the object in view.

(*b*) 2 R. P. C. 167.
(*c*) Ibid. p. 172.
(*d*) 3 R. P. C. 178.
(*e*) 14 R. P. C. 875; 15 R. P. C. 359.

The plaintiffs in this case claimed the production of a dye called "6 G," or di-alkyl-rhodamine ester. The specification contained (*i.a.*) the following direction, "Heat about one part of di-ethyl-rhodamine hydrochlorate, dissolved in about four parts of ethyl- or methyl-alcohol in an autoclave." Those two ingredients alone would not produce the result; in fact, the presence of a third, namely iron, was necessary. The specification contained no mention of iron as an ingredient in the process. The defendants accordingly contended that the patent was bad for insufficient specification. It was proved in evidence that autoclaves of iron (which were the cheapest obtainable) would generally be used by dye manufacturers, but that dye makers sometimes also used autoclaves protected by enamelling. The plaintiffs themselves had always used iron autoclaves, and thus unconsciously obtained the benefit of the presence of iron, by which the hydrochloric acid (the absorption of which was essential to the production of the pure product claimed) had been taken up. The Court of Appeal, affirming Wills, J., held the specification insufficient, on the ground that it gave no indication that it was essential to perform the process in autoclaves composed solely of iron.

On the question as to how far the ignorance of the plaintiffs that iron was an essential ingredient would have vitiated their patent, had they in fact described an iron autoclave as the kind of autoclave to be used in working their process, Vaughan Williams, L.J., said: "Now, assuming iron to be essential, it is plain that the patentee did not know it was essential; but if he has indicated it in the specification, he has done so by an accident. Indeed, neither *Dr. B.* nor the chemists of the defendants seem, until quite late in the hearing of the case, to have suspected the presence in this process of hydrochloric acid, or any other acid which would induce a prudent manufacturer to use a protected autoclave; but the patentee is not bound to indicate theory, only practice, and the fact that he had hit upon something which was practically essential—if he has done so by a fluke does not matter—the question is, has he so indicated an iron autoclave that a manufacturer reading the specification would naturally use an iron autoclave? . . . Even if by an accident the patentee happens to have given such a direction in his specification, that a dyer reading the specification would naturally use the iron autoclave, that is sufficient to save the patent." (*f*)

The Specification must Disclose the Best Means of Performing

(*f*) 15 R. P. C. pp. 368, 369.

the Invention known to the Patentee.—The rule of good faith requires of the patentee not only that he shall give to the public a means of working his invention, but also that he shall give them the best means known to him at the time, so that they may enjoy as ample a benefit from the use of his discovery as he has himself enjoyed. If his disclosure falls short of this, he imposes on the public, and the Courts will look with a very watchful eye to prevent such an imposition. (*g*)

Thus, if the patentee makes the article of his invention with cheaper materials than those which he enumerates in his specification, even although the latter will answer the purpose, the patent is void; for he has not placed the public in a position to derive from the discovery a benefit equal to his own. (*h*)

In *Wood* v. *Zimmer*, (*i*) the patent was for a method of making verdigris. The patentee used *aqua fortis* as one of the ingredients in his manufacture. This was not essential to the result, but it expedited it. The specification did not suggest the use of this ingredient. On an issue directed to be tried out of Chancery, the patent was held bad. Gibbs, C.J., said: "It is said that this patent makes verdigris, and that the specification is therefore sufficient. The law is not so. A man who applies for a patent, and possesses a mode of carrying on that invention in the most beneficial manner, must disclose the means of producing it in equal perfection, and with as little expense and labour as it costs the inventor himself. The price that he pays for his patent is, that he will enable the public at the expiration of his privilege to make it in the same way, and with the same advantages. If anything which gives an advantageous operation to the thing invented be concealed, the specification is bad. Now, though the specification should enable a person to make verdigris substantially as good without *aqua fortis* as with it, still, inasmuch as it would be made with more labour by the omission of the *aqua fortis*, it is a prejudicial concealment and a breach of the terms which the patentee makes with the public."

In *Bovill* v. *Moore*, (*j*) the same learned judge said it is a material consideration "whether the patentee has given a full specification of his invention, not only one that will enable a workman to construct a machine answerable to the patent but one that

(*g*) *Turner* v. *Winter*, 1 W. P. C. 77; 1 T. R. 606; *Wegmann* v. *Corcoran*, 13 C. D. 77.

(*h*) *Turner* v. *Winter*, supra; *Huddart* v. *Grimshaw*, Dav. P. C. 279.

(*i*) 1 W. P. C. 82, n.; Holt, N. P. 58.

(*j*) Dav. P. C. 361, p. 400.

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 benefit to the public than in 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 so far have 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. If *Mr. Brown*, since he obtained his patent, has discovered an improvement [in the making of lace] effected by bending the teeth [of the dividers] or adding a longer [external] tooth, he may apply that improvement, and his patent will not be affected by his using his own machine in that improved state; but if at the time when he obtained his patent he was apprised of this more beneficial mode of working and did not by his specification communicate this more beneficial mode of working to the public, that will have been a fraudulent concealment from the public, and that will render his patent void." The evidence shewed that no machine of the patentee's had existed without this improvement. "If, upon the whole of the evidence, you think this was industriously and studiously kept back from the public, that *Mr. Brown* might have an advantage over and above others that worked these machines, that will be a suppression that will avoid his patent; but if you think this was a matter which had not occurred to *Mr. Brown* at the time he invented this machine, and that it was an improvement afterwards, the validity of the patent will not be affected by it, though he will have added to his original merit of invention the further merit of being able to use his own invention more beneficially than the patent points out."

"A specification is bad," said Jessel, M.R., in *Plimpton* v. *Malcolmson*, "if the patentee, at the time he takes out his patent, knows of a more convenient and better form of performing the operation and conceals it from the public, and puts into his specification a less convenient and worse form. Thus, if it were a chemical patent, if, at the time of taking out the patent, he knew of cheap ingredients which would make the patented article, and also knew of dear ones, if he suppressed the cheap ones and only named the dear ones, that would invalidate the patent." (*k*)

(*k*) L. R. 3 C. D. 580.

But when a patentee indicates in his specification several methods, all of them more or less possible, for attaining the result in view, it is not necessary that he should specify which of these is the most or least advantageous.

In *Badische Anilin und Soda Fabrik* v. *Levinstein*, (*l*) the invention related to dyeing, and the specification was held to claim all the different isomers which could be described by a particular chemical formula and which were matters of the particular colours red and brown. The shade varied according to the isomer, and it was alleged that as one shade only had commercial value the specification should have indicated the respective advantages for dyeing purposes of the colours produced, and given specific directions how to produce that shade. In rejecting this contention, Lord Herschell said: "I will assume for the present that all the isomeric sulpho-acids of oxyazo-naphthaline arrived at by the process described in the claim produce red or brown colouring matters which may be used for dyeing. There can be no doubt that the different isomers so produced are colouring matters of varying shades of red and brown. And the specification undoubtedly does not point out what particular shade of either colour will be produced by any one of the alternative processes suggested, nor does it indicate which will be of the greatest practical value, either by reason of the colour it produces being one likely to be in demand, or from the greater economy in the cost of its production." After dealing with the test of commercial success as the gauge of utility, the learned Lord proceeded: "In the present case the products which result from the appellants' process are no doubt of varying worth, but one at least has proved to be of great commercial value, and it is not shewn that any of them are incapable of being used effectually for the purpose of dyeing. The invention of a process resulting in new products which may thus serve a useful purpose possesses, in my judgment, the requisite predicate of utility. And there is, I think, no obligation on the inventor in such a case as this to indicate the respective advantages for dyeing purposes of the different shades of colour produced."

A grant of letters patent does not preclude an inventor from improving his patented process. Hence, if he subsequently discovers that the use of one particular ingredient will best achieve the patented result, and in practice adopts that improvement, the fact that he had not pointed that out in his specification will not avoid his letters patent.

(*l*) 12 App. Ca. 710; 4 R. P. C. 464. See, also, *Kurtz* v. *Spence*, 5 R. P. C. 183.

In the *British Dynamite Company* v. *Krebs*, (*m*) the patentee's invention was the manufacture of dynamite by causing nitro-glycerine to be absorbed in porous unexplosive substances, such as charcoal, silica, paper, or similar materials. At the trial it was proved that a silicious earth found in Germany and known as 'Keiselguhr,' would, after being calcined and reduced to powder, absorb the nitro-glycerine better than any other substance, and yet retain its condition of powder. This material—the superior suitability of which the patentee had ascertained after his patent was taken out—was that used by his workmen. It was not suggested that the materials mentioned in the specification would not make dynamite, but that the patentee had not disclosed the best means. The Court of Appeal having held the patent bad, the House of Lords reversed their decision.

Lord Hatherley said: "If it had been proved that the inventor, *Nobel*, knew the best material, which turned out to be a material called 'Keiselguhr,' a silicious earth; if he had known of the existence of 'Keiselguhr' at the time, and that it would take up 75 per cent. of the nitro-glycerine, whereas some other materials, specified by the patentee, took up only 25 or 50 per cent., it would have been an objection to his patent to say that he, being in possession of the best mode of producing the most valuable dynamite, had not informed the public of that method. But there is nothing whatever to shew that he, at least, was so acquainted with that material at that time; on the contrary, it appears, as far as he was concerned, to have come to his knowledge afterwards, and of course he could not be expected to mention a material of which he had not had personal experience. But having found out that such materials as he specified had the effect of absorbing—that is, of taking up and retaining the nitro-glycerine—and that they had the effect of doing that more or less advantageously according to the particular materials used, he informed the public that all of them had that effect, and that similar materials would have the like effect in rendering the nitro-glycerine safe and useful." (*n*)

The Specification must not Leave the Public to Experiment.

A Specification which requires Experiment by the Person following its Directions is Bad.—It being the duty of a patentee to give the public a complete recipe for the performance of his invention, it

(*m*) 13 R. P. C. 190; Goodeve, P. C. 88. (*n*) 13 R. P. C. 195.

follows that a specification which does not fulfil this requirement, but, on the contrary, leaves the public to the exercise of further invention or experiment, is bad.

In the *King* v. *Arkwright*, (*o*) Buller, J., said: "If the specification be such that mechanical men of common understanding can comprehend it, to make a machine by it, it is sufficient; but then it must be such that the mechanics may be able to make the machine by following the directions of the specification without any new inventions or additions of their own."

The same rule is further illustrated in *Turner* v. *Winter*. In that case the patent was for making white lead and separating mineral alkali from common salt. Ashurst, J., said: (*p*) "If the process, as directed by the specification, does not produce that which the patent professes to do, the patent itself is void. It is certainly of consequence that the terms of a specification should express the invention in the clearest and most explicit manner; so that a man of science may be able to produce the thing intended without the necessity of trying experiments."

"A specification," said Abbott, C.J., in *R.* v. *Wheeler*, "which casts on the public the expense and labour of experiment is undoubtedly bad." (*q*)

"If the invention can only be carried into effect," said Alderson, B., in *Morgan* v. *Seaward*, (*r*) "by persons setting themselves a problem to solve, then they who solve the problem become the inventors of the method of solving it, and he who leaves persons to carry out his invention by means of that application of their understanding does not teach them in his specification that which, in order to entitle him to maintain his patent, he should teach them, the way of doing the thing, but sets them a problem which, being suggested to persons of skill, they may be able to solve. That is not the way in which a specification ought to be framed." (*s*)

In *Simpson* v. *Holliday*, (*t*) where the plaintiff's patent was for "improvements in the preparation of red and purple dyes," the patentee described his process in the following manner:— "I mix aniline with dry arsenic acid and allow the mixture to stand for some time; or I accelerate the operation by treating it to, or near to, its boiling-point until it assumes a rich purple

(*o*) 1 W. P. C. 66 n.; Dav. P. C. 106.
(*p*) 1 W. P. C. p. 80; 1 T. R. 606.
(*q*) 2 B. & Ald. 354.
(*r*) 1 W. P. C. 174.
(*s*) See, also, Parke, B., in *Neilson* v. *Harford*, 1 W. P. C. at p. 371.
(*t*) 5 N. R. 340; 13 W. R. 577; 12 L. T. (N.S.), 99; L. R. 1 H. of L. 315.

colour," etc. It was proved that in order to produce the colour it was necessary to apply heat; but some evidence was given that a competent workman would be sure to apply heat when he found the result did not follow without it.

On appeal from Wood, V.C., Lord Westbury held that the specification was bad for misdescription. His lordship said: "When it is said that an error in a specification which any workman of ordinary skill and experience would perceive and correct, will not vitiate a patent, it must be understood of errors which appear on the face of the specification, or the drawings it refers to, or which would be at once discovered and corrected in following out the instructions given for any process or manufacture; and the reason is because such errors cannot possibly mislead. But that proposition is not a correct statement of the law, if applied to errors which are discoverable only by further experiment and enquiry."

In the House of Lords the judgment of Lord Westbury was affirmed. Lord Chelmsford, C., said: "There can be no doubt of the meaning of the language used by the patentee. His invention, as he describes it, is the mixing of aniline with dry arsenic acid, for the purpose of producing a rich purple colour, and he adds, '*or* I accelerate the operation by heating to, or near to, its boiling-point.' In this description the operation itself is mixing aniline with dry arsenic acid; the addition of heat is described merely as accelerating that operation. There is nothing upon the face of the specification to shew that the invention described is not in every part of it the subject of a patent. But it was proved in evidence, and admitted by the plaintiff, that mixing aniline with dry arsenic acid without the application of heat would produce only a faint colour, quite unfit for dyeing purposes. It was contended, on the part of the appellants, that the word 'or' in the specification ought to be read 'and.' But there is nothing in the terms of the description, nor upon the face of the specification itself, which would justify the Court in thus changing the form of the expression. It was also said that there was a considerable body of evidence to shew that skilled persons, to whom the specification must be taken to be addressed, found no difficulty in working it out, and applied heat in the process as a matter of course. This, however, cannot have any effect upon the construction of the specification. It merely proves that the description, though erroneous, is not likely to mislead skilled workmen. That the description may induce the necessity of

experiments appears from the evidence of an experienced chemist, who says, 'If I found there was no action without heat I should heat it immediately.' The construction of the specification remaining untouched by the evidence, and the Court being informed that the invention which is claimed is incapable of producing the result intended, it had no other course to pursue than to pronounce the patent to be void." (*u*)

In *Hinks* v. the *Safety Lighting Company*, (*v*) where the patent related to the construction of lamp-burners, an objection was taken that the specification was insufficient and the patent bad for ambiguity. Jessel, M.R., held the objection well founded. The Master of the Rolls said: "A second point was taken on the second burner, which was a very small affair indeed, and that was this: the second burner was badly drawn; the drawing did not shew where the air was to get in. . . . It is a little thing, of very little merit; and then comes the question how far I am at liberty to correct the specification. The specification does not tell me where the opening is to let in the air. All it says is, 'A circular hole is made in the cone or deflector, through which the circular flame passes.' It is said that though there is no opening in the drawing, yet a workman could correct the drawing by putting in the opening, and he could correct it because he is told there is a cone or deflector, and the cone or deflector of the lamp means something or other which will deflect air and, therefore, there must be sufficient air to be deflected and support the light and make it burn well. But, unfortunately for that argument, a lamp may burn badly although it is patented, and the patentee said it would burn badly even though the holes were exceedingly small, or, as I understand, if there were no holes at all it would burn, but it would be an imperfect combustion. Why is a workman to know, *à priori*, that every invention will answer? I cannot say that an inventor never made an invention which did not answer. On the contrary, I am quite sure that many inventors have patented inventions that would not answer at all. Now, that being so, I am not prepared to say that when you put your specification into the hands of a skilled workman he is to exercise invention to make a lamp useful, that he is to correct it without being told anything to correct it by. This assumption was made, no doubt, by the very eminent scientific gentleman who gave evidence, *Mr. Bramwell.* Of course he could do it; he would know how to do it, and where to do it, and everything else. The

(*u*) L. R. 1 H. of L. p. 320.

(*v*) L. R. 4 C. D. 607; 46 L. J. Ch. 185

other scientific gentleman could not deny that it was possible, but I take it that is not the meaning of the patent laws. When you have such a little trumpery invention as the second, the whole merit of which is very small indeed, if you are to tell people how to do things better, you must tell them in a proper way, without the exercise of any invention or much trouble; and in my opinion this is not within the rule, and is badly specified."

In *Wegmann* v. *Corcoran*, (*w*) the patent was for "an improved machine or apparatus for treating or preparing meal." The machine included (*i.a.*) a pair of "squeezing rolls," which the specification said were to have a surface consisting of material containing so much silica as not to colour the meal or flour. "I prefer," said the patentee in his specification, "to make them of iron coated with china, and finely turned with diamond tools." The defendants alleged that the specification was insufficient. Fry, J., so found, and dismissed the action. On appeal Thesiger and James, L.JJ., affirmed the judgment of the Court below. It appeared from the evidence that the china made in England would not be hard enough for the purpose intended, and that consequently the word "china" as used in England when the specification was taken out, included many materials which would be absolutely useless for the purposes of the invention. Further, the degree of hardness in the china which the invention required was not specified. The turning of china with a diamond tool was unknown in England, and therefore indicated no degree of hardness known in the trade. And there was evidence that soft china could be turned in this way. On this, Fry, J., said: "Therefore, although I come to the conclusion that hard china is pointed out in the specification, it appears to me that the information which the plaintiff himself told us he got for the purpose of his invention from a Professor of Chemistry, (*x*) viz. that the material must contain 70, or upwards of 70 per cent. of silica, was not indicated to the person who was to act upon the specification, but that he was left to find out as best he could what amount of hardness he must reach before he could be able to use the rolls for the purpose of the invention, and that, as it appears to me, he would not have been able to discover without very considerable investigation and experiment. All that knowledge would have been necessary before the useful invention could be arrived at, and all that ought to have been communicated to the public."

(*w*) L. R. 13 C. D. 65; 27 W. R. 357.

(*x*) The invention here was one communicated from abroad.

The wording of the specification in this case suggested that iron coated with china was only a preferential mode of making the rolls, and that other materials might be used for that purpose: any material containing so much silica as not to colour the meal or flour. Upon this the learned Judge said: "It is said that the material preferred by the plaintiff is iron coated with china. But, before you can prefer one thing to another you must have several things among which the choice can be made, and if the only thing which, so far as the plaintiff has ascertained, can be shewn to answer the purpose is a particular china roll, and he leads the mind of the reader to infer that there is a whole class of silicated materials which might answer, he has, as it appears to me, been giving a misleading description of his invention. He has indicated that there is a *genus* wider than the *species* which will answer, whereas, in fact, it is only the species which will answer the purpose in question. The effect of the description is to lead the mind of the reader to the necessity of making experiments with regard to the other classes of material which are indicated." Referring further to the specification and the class of material indicated by the invention, his lordship said: "In the next place, the specification says that the material must have the hardness for the purpose set forth. That is a thing which, I repeat, as it appears to me, so far as the specification goes, can only be ascertained by experiment, and for this reason, that the process of squeezing meal in this manner by rolls, subject to this sort of operation, is a new invention, and therefore the hardness required is not known. It is not shewn by reference to any standard, and yet amount is an essential piece of knowledge before a person can satisfactorily make these rolls without further experiment. In my judgment, any china manufacturer who was instructed to make these rolls would fail to do so until the roll had been employed in the squeezing operation in a mill, and found to be either hard enough or not hard enough."

"The specification," said Smith, J., summing up the law on this subject in *Lane Fox* v. *Kensington Electric Company*, (*y*) "may call upon a workman to exercise all the actual existing knowledge common to the trade; but it must not call upon him to exercise his ingenuity or invention; (*z*) nor cast upon the public the expense and labour of experiment and trial; (*a*) and, to use

(*y*) 9 R. P. C. 247.

(*z*) *Morgan* v. *Seaward*, 2 M. & W. 544 (per Alderson, B.).

(*a*) *R.* v. *Wheeler*, 2 B. & Ald. 345; *Macnamara* v. *Hulse*, 2 C. & M. 471; *Stevens* v. *Keating*, 2 Ex. 772.

the words of Sir George Jessel in *Plimpton* v. *Malcolmson*, (*b*) taken from those of Alderson, B., it must not take the form of a problem."

Trivial Mistakes or Omissions will not be Fatal to the Patent.—While a specification is bad if it puts the public to the labour and uncertainty of further invention through the medium of experiments, trivial mistakes or omissions which a workman of ordinary skill would correct with little trouble will not avoid a patent otherwise valid.

In *Plimpton* v. *Malcolmson*, (*c*) Jessel, M.R., discussing what the specification ought to tell the public, said: "First of all, it ought to tell the workman how to do it; but it need not tell him every detail. Mr. Baron Alderson says this: (*d*) 'Now, a workman of ordinary skill, when called to put two things together, so that they should move, would, of course, by the ordinary knowledge and skill he possesses, make them of sufficient size to move. There he would have to bring to his assistance his knowledge that the size of the parts is material to the working of the machine. That is within the ordinary knowledge of every workman. He says, "I see this will not work because it is too small," and then he makes it a little larger, and finds it will work. What is required is, that the specification should be such as to enable a workman of ordinary skill to make the machine; with respect to that, therefore, I do not apprehend you will feel any difficulty.' Therefore he does not mean that the man is to shut his eyes, and copy what he sees before him; but he is to do it in an intelligent manner, and when he has made it according to the specification, and sees it will not work, and sees by the ordinary knowledge of his trade what is to be done to make it work, he is to make it work; and if the specification does not mislead, and contains enough to enable the man to do that, then it is sufficient. The other cases upon the subject are numerous. It is sufficient to say that, in my opinion, they do not conflict with what Mr. Baron Alderson lays down in *Morgan* v. *Seaward*."

In the earlier case of *Wallington* v. *Dale*, (*e*) the patent was for improvements in the manufacture of gelatinous substances and in the apparatus to be used therein. The improvements consisted in a process which rendered the employment of blood for purifying the gelatine unnecessary. The invention claimed

(*b*) L. R. 3 C. D. 531; 45 L. J. Ch. 505.

(*c*) L. R. 3 C. D. p. 570; 45 L. J. Ch. p. 514.

(*d*) 1 W. P. C. 176.

(*e*) 23 L. J. Ex. 49; 7 Ex. 888.

consisted in cutting the hides into shavings, thin slices, or films. The specification did not state whether they were to be cut wet or dry, or to what degree of thinness, or what was the minimum of heat they ought to be subjected to in the subsequent processes. It was proved that they might be cut either wet or dry, and that the thinner they were cut the better, if the fibrine texture was preserved, and that the most satisfactory result would be obtained if no more heat was used than would dissolve the gelatine in the shortest period. The specification was held sufficient.

In *Otto* v. *Linford*, (*f*) objection was taken to the plaintiff's patent on account of certain mistakes and omissions which were said to prevent the successful performance of the invention by any one following the specification. The mistakes relied on were in the drawings, but were such as a workman could easily correct.

Jessel, M.R., said: "The objection in this case is an allegation, or series of allegations, as to omissions, and a series of allegations as to mistakes in the drawings. They are both classes of objection which are quite familiar to those who have had to do with patent cases, and are always remarkable in this way, that they are never found out until the action is brought. The workman always makes the machine, and the machines are made in hundreds or in thousands, and nobody has found them out. But when you come to study the specification, and then to study the machine, you find them out. Many years ago I was counsel in a case which is not reported, but which is a very good illustration, for all that. I was counsel for some makers of a threshing machine, and a very clever threshing machine it was, and they sold thousands of them. The beaters of a threshing machine are both cut across, and they should be set opposite to one another, otherwise they will not thresh grain at all; but the stupid draughtsman, by some mistake, had put them all parallel, so that, if the machine had been made according to the drawing, it would not have threshed anything. Nobody found that out until we came into court; and Ransome & Co. had made the machines with the beaters set crosswise. Well, when it came to be discussed, the thing was too absurd; it would not have been a threshing machine at all, and, of course, the drawing was corrected by the letterpress, which told them that the thing would thresh. In these matters, therefore, it is not for us to find out how not to do it; but the workman, when he finds that the drawing does not work exactly, sets himself at once to see how

(*f*) 13 L. T. (N. S.), 35.

it ought to be done, and, in practice, the thing never arises at all."

In the case just mentioned the patentee's discovery was a means of regulating the explosions which supplied the motive power in a gas-motor machine, by the introduction of a cushion of air into the cylinder between the piston and the combustible mixture. The specification did not state what proportion of air was required to be introduced into the cylinder for this purpose, and an objection was raised that this omission was fatal to the patent. The Court, however, was of opinion that the omission was one easily remedied by the exercise of care, a matter of regulation rather than experiment, and did not avoid the grant. Jessel, M.R., said: "If a man is left without any more information, he asks, 'How much air am I to let in?' He lets in a little air, and he finds that the thing explodes as before; and he lets in some more, and he finds directly, on the mere regulation of his stop-cock, how much is required; and he finds very soon that he has let in enough, and now there is a gradual expansion, and no longer a sudden and explosive expansion. It does not appear to me that that requires invention. It requires a little care and watching, that is all. If a man told you to mix a glass of brandy and water, and to use brown brandy, and that you were to mix it till it was pale yellow, the exact quantity need not be told to you. You would soon find out when it was pale yellow. That is the object to be achieved. Nobody would say it required invention, and that is what this man tells you. But he does tell a great deal more. When you come to look at his specification he has drawings, and his drawings, with the letterpress, shew that he really does put in nearly as much air as explosive mixture. It seems to me that there is sufficient in this specification to tell the maker of the engine and the user of the engine, without requiring him to use an inventive faculty, how to make the engine, and in what proportion it will be necessary for the air to be let in—not definite proportions—but proportions, as far as proportions are wanted, to make the machine workable."

In the case of the *British Dynamite Company* v. *Krebs*, (*g*) the sufficiency of the specification was much discussed. There the patent was for "improvements in explosive compounds, and the means of igniting the same." The specification stated that the invention related to the use of nitro-glycerine in an altered condition, which was more practical and safe in use. It set out

(*g*) 13 R. P. C. 190; Goodeve, P. C. 88.

that this altered condition was effected by causing the nitro-glycerine to be absorbed in porous unexplosive substances, such as charcoal, silica, paper, or similar materials, whereby it was converted into a powder, which the patentee called dynamite or Nobel's safety powder. In this form nitro-glycerine acquired the property, when absorbed, of being in a high degree insensible to shocks, and could be burnt on a fire without exploding. After setting out three modes of firing the powder, the patentee's claim was as follows: "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 modes of firing the same by special ignition as herein set forth."

At the trial before Fry, J., it was proved that a silicious earth found in Germany, and known as Keiselguhr, would absorb the liquid nitro-glycerine far better than any other substance, and yet retain its condition of powder. This earth was first calcined, and then reduced to powder, after which it formed the principal ingredient used in the manufacture of dynamite. It was further proved that dynamite had been made from the specification of the patentee by workmen of ordinary skill by using slate and brick-dust as the absorbing medium. Fry, J., held the patent good, and gave judgment for the plaintiffs. On appeal, his judgment was reversed by Jessel, M.R., and James and Thesiger, LL.JJ., who held the specification insufficient. Referring to the use of German silicious earth, the M.R. said: "This is a new material, and a new invention altogether, and an ordinary workman could only correct it by experiment, and that is not the meaning of a patent." James, L.J., said the patentee had not given in his specification a sufficient direction as to how to take up that quantity of the nitro-glycerine which would be at once practically explosive and yet safe; and that the references to paper and silica were misleading, in that from these substances a practical commercial article could not be made.

The House of Lords reversed the Court of Appeal, and restored the judgment of Fry, J. Earl Cairns, C., referring to the specification said: "But then it is said that there is no sufficient description of the manner in which the invention is to be performed. You are not told, it is said, what quantity of the liquid is to be absorbed. You are not told whether the various absorbing substances will absorb equal or unequal quantities of the liquid. You are not told what quantity is the best to use, either of the liquid or of the absorbing substance. You are not told to what extent

the pulverization is to be carried. With regard to these objections I should be disposed to say, even were there no evidence in the case, that they did not appear to me to be objections, the force of which I should be prepared to admit. When you speak of a porous substance absorbing a fluid, if the porous substance is in one piece, you naturally expect that the absorption will continue up to the point when the porous substance can hold no more; and when the porous substance is to continue a powder, the act of absorption itself will shew the point at which the absorption must stop, lest the absorbing substance should become, not a powder, but a paste. So also as regards the choice of the porous substance. Ordinary knowledge of the properties of the substance will shew what substance will pulverize most conveniently, and what substance will absorb best." His lordship then cited the evidence shewing that workmen of ordinary skill had made the article by following the specification, and proceeded: "The scientific witnesses called by the appellants speak to the sufficiency, in their opinion, of the directions in the specification; but what is more material is that I find no workman whatever, skilled or unskilled, produced on the part of the respondents, who states that he has been, or would be, misled by the specification, or unable to make dynamite by following its directions. I therefore come to the conclusion that there is no insufficiency in the specification."

Difference between Experiment and Practice.—A patent is bad if the specification is so framed as to put the public upon experiment in carrying out any part of the directions essential to performing the invention. It is, however, often a question of considerable nicety to decide whether or not the omissions in a specification are only such as a workman acquainted with the existing knowledge of the subject-matter can supply, or such as must put upon the workman the labour and uncertainty of independent experiment. Defendants in actions of infringement frequently resort to the device of calling experts, who say they have tried to make the plaintiff's invention from his specification, and failed. Where the performance of the invention envolves operations of great delicacy, the Court views this kind of evidence with suspicion; for the rule that the public must not be left to experiment does not mean that they must be able to perform the invention on the first trial and without practice.

This distinction between experiment which vitiates a patent and practice which does not, was laid down by the Court of Appeal

in *Edison* v. *Holland*. (*h*) In that case, Lindley, L.J., said: "The defendants contend that no competent workman could have made carbon filaments according to the specification without further instructions than are given. If it be meant that few competent workmen could make them without some practice, I think the contention is well founded; but this is not sufficient to invalidate the patent. If a person is told to carbonize 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 shewn 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. . . . I feel the great difficulty of describing in words the distinction between an amount of practice without which failure is probable, but the necessity for which does not destroy a patent, and an amount of experiment and invention without which failure is certain, and the necessity for which destroys a patent. The test, however, by which to decide such a question is, I think, to be found by asking whether anything new has to be found out by a person of reasonably competent skill, in order to succeed, if he follows the directions contained in the specification. If yes, the patent is bad; if no, it is good so far as this point is concerned. . . . It is settled that a patentee who does not disclose the best method known to him of carrying out his invention, does not comply with the second of the conditions to which I have before referred. But 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."

In *Badische Anilin und Soda Fabrik Company* v. *Levinstein*, (*i*) the patent was for improvements in the production of colouring matters suitable for dyeing and printing. The specification mentioned four processes, all producing red and brown colouring matter, but matter of varying shades. It was objected that the

(*h*) 6 R. P. C. 282. (*i*) 12 App. Ca. 710; 4 R. P. C. 449.

public were left to experiment to ascertain which process produced which shade. On this Lord Herschell said: "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 shew how the colouring matters are to be produced, and that what it leaves a skilled person, of the class to whom the specification is addressed, to discover is only which of these colouring matters will answer his purpose at any particular time. There is, in my opinion, no warrant for asserting that this invalidates the patent. I may add that the evidence satisfies me, that when once the desired shade is obtained, there would be no practical difficulty in repeating the process with a reasonable certainty of producing the same result." (*j*)

To Whom the Specification Speaks.

Specifications are Addressed to Workmen of Ordinary Skill in the Subject-matter.—The object of requiring a patentee to describe his invention, and the manner of performing it, is that the public may at the end of the patent term have the use of it. The description given by the patentee in his complete specification must therefore be sufficiently clear and distinct to enable the public to put the invention in practice by following the directions therein contained. By the "public," in such case, is meant not the general public, but persons conversant with the subject-matter of the invention.

In *Arkwright* v. *Nightingale*, (*k*) Lord Loughborough said: "The clearness of the specification must be according to the subject-matter of it; it is addressed to persons in the profession having skill in the subject, not to men of ignorance; and if it is understood by those whose business leads them to be conversant in such subjects, it is intelligible."

In *Harmar* v. *Plane*, (*l*) Lord Ellenborough, C.J., said: "When Lord Mansfield said (in the case of *Liardet* v. *Johnson*) (*m*) that the meaning of the specification was, that others might be taught to do the thing for which the patent was granted, it must be understood to enable persons of reasonably competent skill in such

(*j*) 12 App. Ca. p. 720.
(*k*) 1 W. P. C., p. 61; Dav. P. C. 55.
(*l*) Dav. P. C. 318.
(*m*) Bull N. P. 76; 1 W. P. C. 53.

matters to make it; for no sort of specification would properly enable a ploughman, utterly ignorant of the whole art, to make a watch."

In *Elliott* v. *Aston*, (*n*) where the patent was for an invention for the manufacture of buttons, Coltman, J., thus directed the jury on the question of the specification: "The second point is whether the plaintiff has given such a description in his specification as would enable a workman of competent skill (it would not enable me, of course, to make anything of the sort, or any person who is not a person of skill conversant with the trade) to carry the invention into effect."

So, too, in *Otto* v. *Linford*, (*o*) Jessel, M.R., said: "The first thing to be remembered in specifications of patents is that they are addressed to those who know something about the matter. A specification for improvements in gas-motor engines is addressed to gas-motor engine makers and workers, not to the public outside. Consequently you do not require the same amount of minute information that you would in the case of a totally new invention, applicable to a totally new kind of manufacture."

Not Addressed to Workmen of Exceptional Skill.—The specification must be construed as speaking, however, to a workman of ordinary, not exceptional skill in the subject-matter. This was clearly laid down by the Court in *Neilson* v. *Harford*. (*p*) "It is to be a person only of ordinary skill and ordinary knowledge," said 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 should 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 to 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 the patent may be supported so far as relates to that."

Again, in *Beard* v. *Egerton*, (*q*) Wilde, C.J., said: "If the

(*n*) 1 W. P. C. 224.
(*o*) 46 L. T. (N. S.), p. 38.
(*p*) 1 W. P. C. 295.
(*q*) 8 C. B. 216; 19 L. J. C. P. 36.

specification be sufficiently plain to be understood by an operator of fair intelligence that is enough."

In the course of the argument in *Neilson* v. *Harford*, (*r*) Lord Abinger, C.B., said: "Where the specification uses scientific terms which are not understood except by persons acquainted with the nature of the business, the specification is not bad because an ordinary man does not understand it, provided a scientific man does; but where the specification does not make use of technical terms, where it uses common language, and where it states that by which a common man may be misled, though a scientific man would not; where it does not profess to use scientific terms, and an ordinary man reading the specification is misled by it, it would not be good."

In *Plimpton* v. *Malcolmson*, (*s*) this subject was very fully considered. Jessel, M.R., said: "In the first place, it is plain that the specification of a patent is not addressed to people who are ignorant of the subject-matter. It is addressed to people who know something about it. If it is a mechanical invention, as this is, 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 manufactories, great employers of labour, persons who have studied mechanics—not to the same extent as the first class, the scientific engineers, but still to a great extent—for the purpose of conducting manufactories of complicated and unusual machines, and who therefore must have made the subject a matter of very considerable study; and in this class I should include foremen, being men of superior intelligence, who, like their masters, would be capable of invention, and like the scientific engineers would be able to find out what was meant even from slight hints, and still more from 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. That is what I would say of the two first classes, which I will call the scientific classes. The other class consists of the ordinary workman, using that amount of skill and intelligence which is fairly to be expected from him—not a careless man, but a careful man, though not possessing that great scientific knowledge or power of invention which would enable him by himself, unaided, to supplement a defective description, or correct an erroneous description. Now,

(*r*) 1 W.P.C. 341. See, also, Crompton, J., in *Betts* v. *Menzies*, 27 L. J. Q. B. 156.

(*s*) L. R. 3 C. D. pp. 568, 569, 570; 45 L. J. Ch. pp. 513, 514.

as I understand, to be a good specification it must be intelligible to the third class I have mentioned, and that is the result of the law. It will be a bad specification if the first two classes only understand it, and if the third class do not. I do not think, when the cases come to be examined, there is really any difference between the judges on this point. Their language differs, but I do not think the cases differ. I will refer to the case of *Morgan* v. *Seaward*, (*t*) where I think it is put by Mr. Baron Alderson as well as it is put anywhere, if I may say so: 'It'—that means the specification—'ought to be framed so as not to call upon 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. You may call upon him to exercise all the actual existing knowledge common to the trade, but you cannot call upon him to exercise anything more. You have no right to call upon him to tax his ingenuity or invention.' Of course that is open to the observation that the meaning of the word 'invention' may differ to different minds, and it is sometimes impossible to draw the line between perception and invention. We had an instance of that in the present case. One man may see from a drawing that which ninety-nine men out of a hundred cannot see. The witness *Mr. Hulse* stated he had a peculiar faculty for seeing from a drawing things other people did not see, and he likened it to the man who could read music at sight—could read a piece of music he had never seen before, as compared to the ordinary mortal who enjoys no such privilege. But, again, as I said before, some people might have said that what he thinks is perception is invention. In fact, he describes it as intuitive perception, a peculiar power. Many people would call that the power of supplementing by invention what the drawing disclosed to ordinary persons. It is quite impossible to say without considering the concrete, that is, without looking at the subject-matter in respect of which you have to decide—it is quite impossible to say in the abstract what is invention and what is perception. It is, therefore, I think, to be decided by the jury, under the direction of a judge; or if there is no jury, by the judge alone, what, having regard to the subject-matter, is an invention or an exercise of perception."

In *Lister* v. *Norton*, (*u*) Chitty, J., said: "The persons to whom a specification is particularly addressed are those who are conversant with the business to which the invention relates. The

(*t*) 1 Web. 174.

(*u*) 3 R. P. C. 203.

specification is sufficient if a person of ordinary skill and intelligence in the business can understand the directions, and work upon them without experiments."

In the *British Dynamite Company* v. *Krebs*, (*v*) Lord Cairns, C., said: "When the nature of the invention is thus ascertained by the Court as a matter of construction, the Court has then to enquire whether the manner in which the same is to be performed is sufficiently described in the specification to the comprehension of any workman of ordinary skill in the particular art or manufacture, and this the Court can best do by the evidence of workmen of that description, and by the evidence of what workmen of that description have actually done under the patent."

Workmen Presumed to be Informed as to Existing Knowledge.—The specification is to be construed not only with reference to a particular class of persons to whom it is addressed, but also with reference to the existing state of knowledge in that class at the time when the patent was granted. (*w*) Thus, the patentee may assume that all the information which at the time is common knowledge in the art or science to which his invention relates is known to the persons to whom his specification is directly addressed; and he is not required to burden his specification with such details as a workman of ordinary skill would be able to supply without special directions. (*x*) Where a sketch will place such person in possession of the invention, the inventor need not elaborate all the details of a finished picture.

In *Morgan* v. *Seaward*, (*y*) Alderson, B., said that in following the directions for performing an invention contained in a specification the workman may be called upon to exercise all the actual existing knowledge common to the trade.

This rule was recognized by the Court in *Foxwell* v. *Bostock*. (*z*) "It was contended by the plaintiff's counsel," said Lord Westbury, "that a specification ought to be read by the light of the knowledge existing at the time. If, for example, some law of nature, or some fact in science be discovered and made publicly known, the specification of a patent subsequently granted may assume that such natural law or scientific fact is known to the reader, and it need not be stated or explained. Thus, to put a familiar

(*v*) 13 R. P. C. 190.

(*w*) *Foxwell* v. *Bostock*, 10 L. T. (N. S.), 148; *Badische* v. *Levinstein*, 12 App. Ca. 710.

(*x*) *Gaulard & Gibb's Patent*, 6 R. P. C. 225 (per Lindley, L.J.).

(*y*) 1 W. P. C. p. 174.

(*z*) 10 L. T. (N. S.), 148; 4 De G. J. & S. 298, p. 313.

instance, if after the law of gravitation had been discovered and made known a specification had stated or assumed certain results as being the consequences of that law, but without mentioning or referring to that cause, such specification would not have been insufficient or obscure. So the specification of a patent for a chemical discovery may be so worded as to assume a knowledge of the existing and known state of the science, provided it gives a clear description of the alleged new discovery, that is, of the addition which it professes to make to the existing knowledge. In such cases it will still be the fact that the invention will appear from the specification."

In *Badische Anilin und Soda Fabrik Company* v. *Levinstein*, (*a*) it appeared that one of the ingredients in the plaintiffs' process was a substance called naphthylamine. It was objected that the word was misleading as not distinguishing whether beta or alpha naphthylamine was intended. But it was shewn that although beta naphthylamine was discovered in 1875, yet it was not generally known as naphthylamine in 1878, the date of the patent; and that any dealer in the substance would in 1878 have understood by naphthylamine the older or alpha form. On these facts the House of Lords held that the specification, properly construed with reference to the standpoint of public knowledge at the time it was filed, was not misleading.

Lord Herschell said: "The objection is that whilst the specification throughout speaks simply of naphthylamine without any prefix, there were, at the date of the patent, two known isomers called alpha and beta naphthylamine, and that the specification is, on this account, ambiguous. In weighing the objection it is necessary to bear in mind the facts relating to these two isomers. Alpha naphthylamine had been well known for at least fifteen years prior to the patent. Beta naphthylamine was first discovered in 1875, and down to 1878 was only known by the record of laboratory experiments, and had not become an article of manufacture. Until after the discovery of beta naphthylamine, alpha naphthylamine was described simply as 'naphthylamine.' I will not go into the details of the evidence on this point, but will state the conclusions I draw from it. I am satisfied that after 1875, and down to the time of the patent, alpha naphthylamine was still sometimes spoken of as 'naphthylamine,' and that if any one had ordered 'naphthylamine' of a manufacturer, he would, without hesitation, have supplied alpha naphthylamine. Under these

(*a*) 12 App. Ca. 710; 4 R. P. C. 449.

circumstances, I entertain no doubt that any reader of the specification would understand by the word 'naphthylamine' occurring in it, the known commercial article, which until recently, at all events, had always borne that name, and not beta naphthylamine, to which the term 'naphthylamine' alone had never been applied. I am therefore of opinion that the specification is not, in this respect, open to the charge of ambiguity." (*b*)

(*b*) 12 App. Ca. p. 723; 4 R. P. C. p. 468.

CHAPTER XI.

CLAIMS IN SPECIFICATIONS.

Origin and Function of Claims in a Specification.—It has long been the custom for patentees to conclude their specifications by appending in one or more clauses a concise statement of the invention for which they claim protection. These concluding clauses were originally introduced by inventors as a matter of convenience to themselves, in order to rebut the inference which might otherwise be drawn, that everything which it had been found necessary to describe in setting forth the manner of performing the invention was claimed by the patentee.

"The purpose of claims," said Kay, J., in *Rowcliffe* v. *Longford*, (*a*) "is to shew how much of that which is described, or how little, is intended to be the subject of the patent, and to disclaim all which is not included in the claims which follow. And for this obvious reason, that in describing an apparatus so that a workman can construct it, you constantly have to include in your description, in order to make it intelligible, a great many things which you do not mean to include in your claim for a patent, and it is essential, in order to make the description intelligible to the workman who comes afterwards, when the patent has expired, and who expects to find there all directions for constructing the apparatus, to make it more large than the mere statement of that in which the essence of the invention consists. Accordingly, when you come to the claim, what the patentee says in his claim is, "Now, mind, I have written out this description for the workman who comes after to read it, to enable him to make the apparatus; but what I mean to claim is, not the whole of that, but only this which I now proceed to describe."

Claiming clauses, thus first introduced by private initiative for the convenience and protection of the patentee, remained optional

(*a*) 4 R. P. C. 287.

under the Patent Law Amendment Act, 1852, (*b*) but are now, under the Patents Act, 1883, a necessary part of every complete specification. Sub-section 5 of Section 5 of that Act provides that "a complete specification must end with a distinct statement of the invention claimed."

It has been decided, however, that this provision is directory only, and that therefore, where the Comptroller-General passes a specification which does not obey in this respect the direction of the Act, the Courts will not hold the patent void by reason of such non-compliance with the Statute. (*c*)

Perhaps the best definition of a claim is that found in the "luminous exposition" (*d*) of Lord Cottenham in *Kay* v. *Marshall*. (*e*) "What follows is merely the claim, not intended to be any description of the means by which the invention is to be performed, but introduced for the security of the patentee, that he may not be supposed to claim more than he can support as an invention. It is introduced lest in describing and ascertaining the nature of his invention, and by what means the same is to be performed (particularly in the case of a patent for an improvement), the patentee should have inadvertently described something which is not new, in order to render his description of the improvement intelligible. The claim is not intended to aid the description, but to ascertain the extent of what is claimed as new."

"The office of a claim," said Lord Chelmsford in *Harrison* v. the *Anderston Foundry Company*, (*f*) "is to define and limit with precision what it is that is claimed to have been invented and therefore patented."

In *Plimpton* v. *Spiller*, (*g*) a case prior to the Patents Act, 1883, James, L.J., in the Court of Appeal said: "Now, it is important to bear in mind that there is nothing in the Act or in the patent law which says anything about claims. A patentee gets a patent for his invention, and he is obliged to specify that invention in such a way as to shew to the public not only the mode of giving practical effect to that invention, but what the limits of the invention are for which his patent is taken out; and the real object of what is

(*b*) *Lister* v. *Leather*, 27 L. J. Q. B. 295; 8 E. & B. 1033; *Dudgeon* v. *Thompson*, 30 L. T. (N. S.), 214; *Plimpton* v. *Spiller*, L. R. 6 C. D. 426.

(*c*) Per Lord Halsbury, C., in *Vickers* v. *Siddell*, 7 R. P. C. p. 30[illegible] 15 App. Ca. p. 500.

(*d*) Per Jessel, M.R., in *Plimpton* v. *Malcolmson*, L. R. 3 C. D. 563; 45 L. J. Ch. 511.

(*e*) 2 W. P. C. p. 39; 1 My. and Cr. 383.

(*f*) 1 App. Ca. p. 579; 47 L. J. Ch. 211.

(*g*) L. R. 6 C. D. p. 426; 47 L. J. Ch. 213; see also *Edison-Bell Phonograph Co.* v. *Smith*, 11 R. P. C. pp. 401, 405.

called a claim, which is now much more commonly put in than it used to be formerly, is not to claim anything which is not mentioned in the specification, but to disclaim something. 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 is new; and that which I claim is that which I am now about to state.' That really is the legitimate object of a claim, and you must always construe a claim with reference to the whole context of a specification."

So, too, in *Jackson* v. *Wolstenhulmes*, (*h*) Cotton, L.J., said: "The object of a claim is this, to restrict and cut down what might be suggested as the claim made by the previous part of the description, so as to shew what it does consist of, and prevent the patent from being defeated in consequence of words being used which might lead to the inference that something which was not intended to be claimed was claimed, and thus the patent being defeated by there being included in the previous part of the specification that which was not new but old."

In the same case, Bowen, L.J., said: "I am of the same opinion, on the short ground that the fitting and turning is not really treated as part of the invention, nor is it claimed. It is mentioned in the previous part of the specification, but when we come to the claim at the end, the claim omits it. It must be remembered that claims are for the security of the patentees, to prevent it being said that the patentee has claimed more than can be really supported as his invention. Here the patentee has abstained from claiming the fitting and turning."

Under the Patents Act, 1883, however, a claim is more than a disclaimer, for nothing that is not claimed is now considered to be patented. (*i*)

In *Siddell* v. *Vickers*, (*j*) the office of a claim under the Act of 1883 was discussed at length in the Court of Appeal. Cotton, L.J., said: "Before this Act there was no necessity in any case for a claim. A claim was very useful, in order to prevent it being

(*h*) 1 R. P. C. 105.

(*i*) See Lord Herschell in *Parkinson* v. *Simon*, 12 R. P. C. p. 406.

(*j*) 5 R. P. C. 416; L. R. 39 C. D. 92.

contended that in the way the specification described the invention there was a claim to protect that which was old, and very frequently the object of a claim was rather to disclaim—'I do not claim so and so, but what I do claim is so and so. I do claim the whole combination. I do not claim the particular parts which are old.' Or it may be that a man would claim the whole combination; and also he would say that 'I claim so and so as being my invention.' Of course, if he did not particularize what he claimed, and there was something in the description of his invention which apparently he claimed, and which could be shewn to be old, that might vitiate the patent; but here, for the first time in this Statute, there is a requirement that there should be a statement of what the patentee claims. I understand 'distinct' to mean independently of and distinct from the mere description of the nature of his invention, and of the way in which it is to be carried into effect. He must state what he claims and what he does not claim."

A Distinct Statement of the Invention Claimed.—The Court of Appeal were divided in the above case as to the meaning of the words, a "distinct statement of the invention claimed;" Cotton, L.J., being of opinion that "distinct" referred only to the position of the claim as a separate paragraph, while Fry and Lopes, L.JJ., considered it to further imply distinctness in intelligibility as considered apart from the body of the specification —a quality lacking in the claim then before the Court.

After referring to the language of the Act, Fry, L.J., said, "It appears to me the intention of the Legislature is reasonably plain from the words I have read, but I think they are illustrated by the form that is given in the schedule to the Act, and which, having stated a given form for the statement of the invention, proceeds to conclude in this way: 'Having now particularly described and ascertained the nature of my invention, and in what manner the same is to be performed, I declare that what I claim is, 1, 2, 3, etc.; and the marginal direction is, "Here state distinctly the features of the novelty claimed."' Now I turn to this specification, and I find that it concludes in this manner: 'Having now particularly described and ascertained the nature of my said invention and in what manner the same is to be performed, I here declare that I do not limit myself to the precise details of my invention as hereinbefore specified, and as illustrated on the accompanying drawings, because equivalent modifications or variations can be made in such details and quite consistent with the principles or characteristic features of my invention.' I pause here to observe that the

author of this specification knows the distinction between the principles and characteristic features of his invention and those details which are not essential. It occurs to me that those are the very things he ought to have explained to us in his claim. He ought to have told us in his claim succinctly and distinctly what were the principles and characteristic features of his invention. But instead of that he tells the reader that there are such features and that there are such principles, but leaves him to find them out from reading the whole specification. The specification proceeds: 'And in conclusion I declare that what I claim is, the general construction, adaptation, or application, and the combination and use of the several parts, in the whole constituting improved, more simple and efficient appliances or means for working or operating on iron or steel forgings, substantially as hereinbefore set forth, and as illustrated on the accompanying drawings.' Observe, the effect of that is to throw you back by reference to the whole that has gone before, with the additional difficulty created by a direction to distinguish that which is the substance from that which is not the substance. Now, in my view, that is not a distinct statement. It is not in any proper sense a distinct statement of the invention claimed, because, as I have already said, you are thrown back upon the whole of the specification." (*k*)

Commenting on the same point, Lopes, L.J., said: "With regard to the objection that the complete specification does not end with a distinct statement of the invention claimed, I agree with Fry, L.J. I think that a distinct statement must mean something more than a separate paragraph. I think that the Legislature contemplated a distinct summary of the main features of the invention, something to which the reader might readily refer, and learn therefrom, without referring to the body of the invention, what the characteristic features of the invention claimed were. Applying this to the present case, the statement of claim here seems to me to be loose, rendering it necessary for the reader, in order to ascertain the characteristic feature of the invention, to refer to the body of the specification." (*l*)

The decision of the Court of Appeal was affirmed in the House of Lords, but no opinion was expressed by the House as to whether the specification ended with a distinct statement of the invention claimed, within the meaning of the Act. Lord Herschell, however, said that he would certainly not recommend it as an example to be followed. (*m*)

(*k*) 5 R. P. C. p. 432. (*l*) Ibid. (*m*) 7 R. P. C. 292, p. 306.

Claim where the Invention is an Improvement.—Where the patent is for an improvement in some known machine or process, the inventor must limit the claim in his specification to that improvement only, and clearly indicate wherein that improvement, as distinguished from the rest of the machine, consists. (*n*)

Referring to this in *Parkes* v. *Stevens*, (*o*) Sir W. M. James said: "It is obvious that a patentee does not comply as he ought to do, with the condition of his grant, if the improvement is only to be found, like a piece of gold, mixed up with a great quantity of alloy, and if a person desiring to find out what was new and what was claimed as new, would have to get rid of a large portion of the specification by eliminating from it all that was old and commonplace, all that was the subject of other patents or of other improvements, bringing to the subject, not only the knowledge of an ordinary skilled artisan, but that of a patent lawyer or agent. For example, supposing that a compensation pendulum was now for the first time invented, it would not do to patent improvements in clocks in general terms, and give a specification of the whole machinery of a clock, introducing somewhere in the course of the description the mode of making a compensation pendulum, and then end by claiming the arrangement and the combination aforesaid. He must say expressly, 'I claim the invention of a compensation pendulum, and I make it thus.'" (*p*)

Claim for a New Combination of Old Materials.—Where the invention is a new combination of old materials, the combination is, *ex necessitate*, the novelty, and a general claim for such a combination will be good.

It was at one time supposed that the case of *Foxwell* v. *Bostock* (*q*) had laid down a different rule, and it was argued, on the authority of that case, in *Harrison* v. the *Anderston Foundry Company*, (*r*) that a general claim to a new combination could not be sustained without a further specification of the novelty.

In *Foxwell* v. *Bostock*, however, the invention consisted not in a new combination as such, but in an improvement in a known mechanism, viz., the disposition of three cams upon one shaft in a sewing-machine; and the vice of the specification in that case lay in the fact that the patentee, instead of claiming only his

(*n*) *Kynoch & Co.* v. *Webb*, 17 R. P. C. 100; see pp. 107, 115.

(*o*) L. R. 8 Eq. p. 365; 38 L. J. Ch. p. 630.

(*p*) See, also, *Murray* v. *Clayton*, L. R. 7 Ch. 586.

(*q*) 4 De G. J. & S. 298; 10 L. T. (N. S.), 144.

(*r*) L. R. 1 App. Ca. 574. See these cases considered by the House of Lords in *Kynoch & Co.* v. *Webb*, 17 R. P. C. 100.

improvement, claimed the whole machine of which the improvement was only an incorporated part. The claim, after amendment, read as follows: "The combination and arrangement of the various parts of machinery for sewing or stitching with the use of a needle and shuttle."

In *Harrison* v. the *Anderston Foundry Company*, (s) the plaintiff's patent was for "improvements in loom-weaving." The patentees claimed generally, as a compound whole, the construction and arrangement of the parts of the mechanism described in the specification. The Court of Session in Scotland, yielding to the argument founded on the alleged meaning of Lord Westbury's judgment in *Foxwell* v. *Bostock*, held this claim bad on the face of it, as not telling the public what was new, and what disclaimed by the patentees. On appeal the House of Lords reversed this decision. Lord Hatherley, commenting on *Foxwell* v. *Bostock*, said: "It was there held—and that, I think, was all that was held—that it is not competent to a man to take a well-known existing machine, and having made some small improvement, place that before the public and say: 'I have made a better machine. There is the sewing machine invented by So-and-so; I have improved upon that. That is mine; it is a much better machine than his.' That will not do; you must state clearly and distinctly what it is in which you say you have made an improvement. To use an illustration which was adopted, I think by Lord Justice James, in another case, (t) it will not do, if you have invented the gridiron pendulum, to say, 'I have invented a better clock than anybody else,' not telling the public what you have done to make it better than any other clock which is known.

"That principle was laid down in *Foxwell* v. *Bostock*, and I do not think that anything further was intended to be determined in that case. It could not have been meant in that case to say that where that happens, which may well happen, that a person, arranging his machinery in a totally different way from the way in which it has ever been before arranged, although every single particle of that machinery is a well-known implement, produces an improved effect by his new arrangement, that new arrangement cannot be the subject of a patent. It may be that the levers may be perfectly well known in their mode of action, and it may be that all the other separate portions of the machinery to which the patent relates may be perfectly well known; but if he says, 'I take all

(s) L. R. 1 App. Ca. 574. 38 L. J. Ch. 630. See ante, p. 226.
(t) *Parkes* v. *Stevens*, L. R. 8 Eq. 365;

these well-known parts, and I adjust them in a manner totally different from that in which they have ever before been adjusted; I have found out just what it is that has made these parts, though they may have been used in machinery, fail to produce their proper effect, and it is this, that they have not been properly arranged; I have therefore reconsidered the whole matter, and put all these several parts together in a mode in which they never were before arranged, and have produced an improved effect by so doing,'—I apprehend it is competent to that man so to do, and that it would be perfectly impossible for him to say what is new and what is old, because, *ex concessis*, it is all old; nobody ever before used it in the manner in which he has used it. That, my lords, I apprehend, is the principle of a patent for a combination." (*u*)

"The claim of a combination or arrangement of parts of a machine without more," said Lord Chelmsford, in the same case, "is in itself a sufficient description of a novel invention, *i.e.* of a combination of parts which have never been combined in the same manner before. The explanation of the novelty is to be found in the description of the arrangement of the parts in the body of the specification. Whether the combination is new or not is a question of fact to be proved on a trial. It is not asserted that the description in the specification is not sufficiently explicit and clear to enable a workman of ordinary skill and information to make the thing patented. In what, then, is the claim in the specification supposed to fail? As far as can be gathered from the opinions of the judges, it is from the want of an explanation of the novelty of the invention. But if the claim is for a combination, it has been fully shewn that the claim itself is a statement and assertion of novelty." (*v*)

"*Foxwell* v. *Bostock* and the authorities upon which it is founded," said Romer, J., in *Perry* v. *La Société des Lunetiers*, (*w*) "have been explained by the Courts as amounting really to this, that where a claim is made to a general combination, if the combination is not new, but there is only an improvement in some part, then the patentee must point out and claim for the improvement, and not for the whole combination. If the claim is for a combination, and the combination is a novelty, then the patentee need not point out how far he claims novelty for particular portions which go to make up the combination." (*x*)

In *Parkes* v. *Stevens*, (*y*) the invention was a glazed lamp,

(*u*) L. R. 1 App. Ca. pp. 583, 584.
(*v*) Ibid. pp. 579, 580, 582.
(*w*) 13 R. P. C. p. 670.
(*x*) See, also, *Moore* v. *Bennett*, 1 R. P. C. 129; *Proctor* v. *Bennis*, 4 R. P. C. 333
(*y*) 8 Eq. 358; 38 L. J. Ch. 627.

having a frame of sufficient strength and suitable for cleaning, but throwing a minimum of shadow. The specification described the lamp by reference to drawings, and the claim was as follows:—"The arrangement and combination of parts, hereinbefore described and represented in the drawings annexed, in the manufacture of railway-station and other lamps." Sir W. M. James held this sufficient.

In *Murray* v. *Clayton*, (z) the plaintiff's claim was as follows: "The arrangement and construction of parts herein set forth for cutting clay into bricks. I claim particularly cutting the clay into the form of bricks by forcing the clay forward by means of a pushing board against a series of fixed wires so arranged that the clay is forced past the wires into a movable board provided with handles, so that twelve or any convenient number of bricks may be removed at the same time." The Court of Appeal held that this was a claim for the entire machine, and good as such. James, L.J., said: "I am of opinion that the plain meaning of this specification is, that the plaintiff claims the machine. The claim is not to any particular part. It is a claim for the entire machine, produced by the arrangement and construction of the parts set forth." (a)

Claim for Subordinate Integer.—Besides claiming generally a new combination of old parts, or of parts old and new, forming an entire novelty, the patentee may claim in addition subordinate parts or combinations constituting in themselves distinct entities of invention. If he desires protection for such subordinate entities he must, however, state specifically what they are, and make them the subject of distinct claims.

The judgment of Lord Cairns, C., in *Clark* v. *Adie*, (b) contains the most lucid exposition of the law on this subject. There the House of Lords held that the patentee had not claimed the subordinate integer, which alone the defendants had infringed. "In a patent claiming an entire instrument made by a consecutive number of steps," said the Lord Chancellor, "there may at the same time be what I will term, as perhaps the most convenient phrase I can think of, an invention which is a subordinate integer in the larger combination. 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

(z) L. R. 7 Ch. 570.
(a) Ibid. p. 578.
(b) 2 App. Ca. 315; 46 L. J. Ch. 585; 22 W. R. 456.

may be a step, or a number of steps, in the whole, which is or are perfectly new, or the subordinate integer may not consist of new steps, but may consist of a certain number of steps so arranged as to form a novel combination within the meaning which is attached by the patent law to the term 'combination.' In that case you may have to try a further question; you may have then to look at the patent, not merely as a patent for the whole instrument described, but as a patent which, in addition to claiming protection for the whole instrument so made, claims protection also for the subordinate invention, the subordinate integer, which enters into the combination of the whole. Suppose, my lords, 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 possibly were old in themselves, but which, put together and used as he puts them together and uses them, produces 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 extend, not only to the whole or complete thing described, but to those subordinate integers entering into the whole which I have described. But then, my lords, 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 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." (*c*)

Framing the Claim too Wide.—It is of the utmost importance that the patentee's claim should not be framed in language wider than the invention for which letters patent are sought. The Courts have always looked with disfavour upon inventors who try by the use of general and vague language to extend unfairly the range of their monopoly, and include what they have not invented.

In *Hill* v. *Thompson*, (*d*) Lord Eldon said: "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. But in order to its being effectual, the specification must clearly express that it is in respect of such new combination

(*c*) 2 App. Ca. p. 321.

(*d*) 1 W. P. C. 229.

or application, and of that only, and not lay claim to the merit of original invention in the use of the materials. If there be a patent both for a machine and for an improvement in the use of it, and it cannot be supported for the machine, although it might be for the improvement merely, it is good for nothing altogether, on account of its attempting to cover too much."

In *Crossley* v. *Potter*, (e) Pollock, C.B., said: "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 introduction of other inventions adapted to the particular subject to which the invention may be applicable; a patent which has for its object to snatch and grasp at everything in all directions which may possibly come within the general language the patentee may choose to adopt in his specification; a patent, the object of which is not to benefit the world by its communication, but to obstruct, by the very general character of the claims made for conferring peculiar privileges on the patentee—such a patent as that, in my judgment, cannot be supported."

In *Tetley* v. *Easton*, (f) the patentee, whose invention consisted of improvements in machinery for pumping water, described a wheel in his specification, and it was objected that the wheel was claimed, and that as it was old the patent was bad. Wightman, J., directed the jury that this was fatal to the specification; and the Court of Queen's Bench discharged a rule nisi for a new trial. Coleridge, J., said: "If a specification includes what is old, as well as what is new, the patentee must be taken to claim all, unless he clearly makes it appear that he does not claim that which is old." And Wightman, J., said: "It clearly appeared that the plaintiff claimed machinery composed of several elements, parts of which were old and part new. It is a settled rule of law that in describing such an invention it should be made clear on the face of the specification that the patentee does not claim as new what is old. . . . There is no doubt that, upon the authority of the cases cited, the claim is too large, and that upon this specification an action might have been maintained for an infringement by the use of the wheel alone."

In *Rushton* v. *Crawley*, (g) the patentee claimed the use and application of wool, and particularly that kind known as Russian tops, or other similar wools or fibre, in the manufacture of

(e) Macr. P. C. 245.

(f) Macr. P. C. 48; 23 L. J. Q. B. 77. See, also, *Booth* v. *Kennard*, 1 H. & N. 527; 2 H. & N. 84; 26 L. J. Ex. 23, 305.

(g) L. R. 10 Eq. 522. See also *Lees* v *West London Cycle Stores*, 9 R. P. C. 300.

artificial hair in imitation of human hair. He also claimed the use of the same material for the manufacture of crisped or curled hair for furniture upholstery and other like purposes. For the latter purposes it had been commonly used for years. In holding the patent bad, Malins, V.C., said: "The public must be told in very distinct language, in every specification, what are the articles they may use and what they may not use. Therefore, if a man makes a discovery, and, instead of limiting himself in his specification to that which properly is the discovery (if it be one), makes his specification too extensive, and claims more than he is entitled to claim, that is calculated to embarrass the public, and is, I apprehend, a fatal objection to the patent."

In *Jordan* v. *Moore*, (*h*) the invention was for improvements in the construction of ships. The patentee claimed, by his first claim, the construction of ships with an iron frame combined with an external covering of timber-planking for the sides, bilges, and bottoms. By a sixth claim he claimed the construction of iron frames adapted to an external covering of timber for the sides, bilges, and bottoms, *as described*. The validity of the sixth claim, for a frame of definite construction, was not disputed. But the first claim was impeached, as being for an iron frame of any construction. On behalf of the patentee it was argued that the first claim was limited by the sixth, and only included a frame of the described construction.

The Court, however, refused to so limit the first claim, and held the patent void. "We find nothing in the specification," said Byles, J., "requiring any definite degree of rigidity or strength, or any peculiarity of construction in the frame mentioned in the first claim. The first claim, therefore, is, according to our construction, a claim for planking with timber any iron frame of a ship." (*i*)

In *Wegmann* v. *Corcoran*, (*j*) the specification stated that the patentee preferred to make his mechanism of certain specified material—iron, coated with china. In fact, he knew of no other material suitable for the purpose. The patentee's second claim was as follows: "The application of squeezing rolls having a surface consisting of material containing so much silica as not to colour the meal or flour, and so as to have the hardness required for the purpose set forth." "It appears to me," said Fry, J., "the patentee's object in making this wide claim was this. He,

(*h*) L. R. 1 C. P. 624; 35 L. J. C. P. 268.

(*i*) Ibid. p. 635.

(*j*) L. R. 13 C. D. 65; 27 W. R. 357.

in substance, says, 'I have found out one thing, and I mean to claim everything else which will answer the purpose.' . . . Before such a claim can succeed, he must limit with exactitude the class of things he claims. I think he might have done so in one or other of two ways—by enumerating the qualities which the material must possess, or by referring to a particular substance, and saying that all other materials which had the qualities possessed by that for the purpose of this machine were within the specification. I think that, in this case, the patentee has done neither the one thing nor the other; but that, not knowing, or not caring to ascertain the class of materials which would answer his purpose, he has endeavoured to throw the drag-net of his specification so widely as to include everything which might possibly answer, and that it does, in fact, include materials which would not answer the purpose." (*k*)

Claims are a Protection to the Public.—While primarily a claim is intended as a protection to the patentee, it may also be said that it serves as a protection to the public, inasmuch as it operates as a clear warning to the public of that which they may not take or do without infringing the patentee's monopoly. And it is on the principle that the public are entitled to such notice that the Courts have gone in always requiring an inventor to distinguish in his specification, the old and the new.

In *Macfarlane* v. *Price*, (*l*) Lord Ellenborough, C.J., said: "The patentee in his specification ought to inform the person who consults it, what is new and what is old. He should say, My improvement consists in this, describing it by words if he can, or if not, by reference to figures. But here the improvement is neither described in words nor by figures, and it would not be in the wit of man, unless he were previously acquainted with the construction of the instrument, to say what was new and what was old. . . . A person ought to be warned by the specification against the use of the particular invention, but it would exceed the wit of man to discover from what he is warned in a case like this."

Claiming a Subsidiary Invention.—In framing his claiming clauses the patentee should carefully avoid claiming anything which is not actually of his own invention. As a claim covering what he has not invented, however inadvertently made, will, until disclaimed, undoubtedly render his patent void. It has been said that where the Court can do so, it will in the case of a meritorious

(*k*) L. R. 13 C. D. pp. 81, 82; see, also, *Dick* v. *Ellam*, 16 R. P. C. 414; 17 R. P. C. 196; *Kynoch & Co.* v. *Webb*, 17 R. P. C. 100.

(*l*) 1 Starkie, 199; 1 W. P. C. 75 n.

invention save the patent by reading such a claim as subsidiary to the main invention and as only claimed in connection therewith; as was done in the cases of *Plimpton* v. *Spiller* (*m*) and the *British Dynamite Company* v. *Krebs* (*n*). But it is obviously dangerous to rely on such benevolent construction, for it is impossible to predicate with any certainty when the Court will apply it. And even in *Plimpton* v. *Spiller*, which has perhaps gone further than any other case in this direction, the Court of Appeal were careful to affirm the general rule, though apparently relaxing its application.

In that case Brett, L.J., said: "At the same time, I think it cannot be denied that if a really independent claim of something which is not new, however inadvertently or carelessly it be made, is in fact made on the face of the patent, the Court is bound to hold that the patent is therefore objectionable, and that therefore the plaintiff cannot succeed. If this second claim had been in a form which would have applied to the runner of any other skate than that which is patented here, I should have thought it would have been bad, and that therefore the whole patent would have been bad, and this plaintiff could never recover." His lordship then proceeded to point out that the test question always is, Does the subsidiary claim itself increase the monopoly? (*o*)—"If you can say that the subsidiary claim in the patent cannot, under any circumstances, increase the monopoly of the patent itself, which is well claimed in the patent, it seems to me that the subsidiary claim is unimportant, is futile, has no effect, and therefore does not raise any objection to the patent. If you can bring it within the category of a subsidiary claim in the patent, you bring it within the principle stated by Lord Westbury (in *Neilson* v. *Betts*), and under those circumstances it is no objection to the patent."

In the *British Dynamite Company* v. *Krebs*, (*p*) where the patent was for improvements in explosive compounds and the means of igniting the same, the specification, after describing how the dynamite was to be made, stated three ways of exploding it, and concluded with the following claim: "I claim as the invention secured to me the mode herein set forth of manufacturing the safety powder or dynamite herein described, and also the modes of firing the same by special ignition as herein set forth." It was objected that some of those modes were not new, and that the

(*m*) 6 C. D. 412; 47 L. J. Ch. 211.
(*n*) 13 R. P. C. 193.
(*o*) 6 C. D. p. 434.
(*p*) 13 R. P. C. p. 193; Goodeve P. C. p. 93.

claim for the particular modes of ignition avoided the patent. The House of Lords, however, rejected this contention. Lord Cairns, C., having pointed out that the invention would be useless, and therefore not patentable, unless a mode of firing the dynamite was indicated, said: "I look upon the means of explosion, even assuming them to be known as applicable to 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 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 user of that which is included in the first, I cannot think that the patent should be avoided by the introduction of that which is merely useless."

In *Vorwerk* v. *Evans*, (*q*) where the patent was for "improvements in skirt waistbands, and in the method of and means for weaving webs suitable for such uses," there were two claims. The first claimed the waistband of the formation substantially as set forth and indicated hereinbefore, and in and by the accompanying drawings. The second claimed the taking-up motion, having conically formed rollers arranged and acting substantially as and for the purpose set forth and indicated. It was contended that the first claim was one to the product, the waistband alone, independently of the mode of making it. The Court of Appeal, however, held that reading the claims together, what the patentee claimed was not waistbands independently of the way by which they were produced, but a waistband made in the way pointed out by the patentee previously; that the first claim, in short, was one for a waistband, but made in the manner indicated, and the second for the mode of making it; and that the defendants had not infringed.

The following cases show how a claim of the kind suggested may be fatal to the patentee.

(*q*) 7 R. P. C. 265.

In *Roberts* v. *Heywood*, (*r*) the inventor of an improved machine for painting laths for Venetian blinds and other purposes, claimed the various parts of the machine, as well as the general construction and arrangement of the whole in combination. Amongst the parts claimed was "the shallow sliding tray, T., arranged and used substantially in the manner and for the purpose specified." This tray was a thing commonly known and used before the date of the patent. In an action for infringement, Hall, V.C., held that the claim for this tray could only be construed as a distinct claim to a separate invention, and that, as it lacked novelty, the patent was bad.

In *Cropper* v. *Smith*, (*s*) the invention consisted of improvements in lace-making machines, and the specification contained three claims. First, the whole combination or machine as described; secondly, those parts of the combination which constituted the upper portion of the machine; and thirdly, "the central longitudinal plate, C, connecting the end standards, and to which the front vertical stay cradle and back stays are secured." The whole combination was new and useful, and the first claim undoubtedly good; but the third claim, if read as a separate claim for the portion of the machine described in it, was bad, as wanting in novelty. At the trial Pearson, J., read the second and third claims as mere descriptions of what the patentee considered to be material in making up the entire combination, and not as separate claims. But the Court of Appeal, adopting a different construction, held that the claims were separate claims, and as the third was not new, found the patent bad. In giving judgment, Cotton, L.J. (*i.a.*), said: "The law is clear, and is laid down in the case in the House of Lords of *Clarke* v. *Adie*, (*t*) that where a man claims a patent for improvement in machines, he may claim for the whole of the combination which makes up that machine; but, if he thinks fit, he may do something more. To make up the entire combination there may be certain subordinate combinations, and, if he thinks he is justified in doing so, besides claiming the protection of his patent for the entire machine, that is, the combination taken as a whole, he may also claim protection and monopoly for the subordinate combination which, together, as integers, make up the entire machine. But, of course, he does it with this risk, that if he claims as the subject of his patent, and entitled to protection, not only the entire machine—the entire combination—but also the

(*r*) 27 W. R. 454.
(*s*) 1 R. P. C. 81, see p. 87.
(*t*) L. R. 2 App. Ca. 315.

subordinate combination, if it appears that any of these subordinate combinations were not novel, then his patent fails altogether. . . . When we find that the patentee claims, first of all, the general combination, with a previous declaration—I declare that I claim first so and so, second so and so, and third so and so—in my opinion, according to the fair construction of the language, and having regard to the use of the claim, it would be wrong to say that he is not intending to claim as that which he protects, 1, 2, and 3; and therefore one must deal with this as if Number 3 was, as in my opinion it is, a claim to an invention, to be protected by the patent; that is to say, he treats his claim, not only as a claim to the entire combination, but also as a claim to those subordinate combinations which are introduced into it, and help, together, with other things, to make the entire combination."

In *Cassel Gold Company* v. *Cyanide Syndicate*, (*u*) the plaintiffs' invention was aimed at the extracting of gold in a state of solution from crushed ore and commercially free from the other baser metals present in the ore. The plaintiffs' patent claimed (1) The process of obtaining gold and silver from ores and other compounds, consisting in dissolving them out by treating the powdered ore or compound with a solution containing cyanogen, or a cyanide or cyanogen-yielding substance, substantially as hereinbefore described; (2) The process of obtaining gold and silver from ores and other compounds, consisting in dissolving them out by treating the powdered ore or compound with a dilute solution containing a quantity of cyanogen or a cyanide or cyanogen-yielding substance, the cyanogen of which is proportioned to the gold or silver or gold and silver, as hereinbefore described. The use of cyanide of potassium for extracting gold, irrespective of the amount employed, was not new. For the plaintiffs it was argued that the words at the end of Claim 1, "substantially as hereinbefore described," limited that claim to the quantity of cyanide of potassium to be used in the solution to be applied to the ores in the same way as Claim 2 did, and that in neither claim was the use of cyanide of potassium at large claimed. But the Court of Appeal refused to accept this construction. "We cannot," said Smith, L.J., in delivering the judgment of the Court, "read the specification in this way. We would if we could, but we cannot do so. It appears to us that Claims 1 and 2 are independent claims, having application to the whole specification; the first making claim for the use of any cyanide of potassium in solution, irrespective of amount,

(*u*) 11 R. P. C. 638; 12 R. P. C. 232.

substantially as therein described; and the second making claim for the uses of a dilute solution containing a specified quantity of cyanide of potassium, substantially as therein described. It appears to us impossible to discard either the one or the other, or to hold that both mean the same thing, or that Claim 1 applies to one part of the specification and Claim 2 to another; for this, in our judgment, is not the true construction of the specification as framed. If the first claim had been disclaimed or omitted, we should not have been faced with the difficulty, but as it is in the specification we are unable to read it as the plaintiffs desire to do; and for this reason, and for this alone, we must, with reluctance, give judgment for the defendants, and dismiss this appeal with costs."

In *Parkinson* v. *Simon*, (*v*) it was alleged that the patent was bad because out of four claims contained in the specification three were old. Each of these claims began with the words, "In apparatus such as described," and from these words the plaintiffs argued that these claims could be supported as linked to the fourth claim, which was valid. But the House of Lords refused to adopt this construction. Lord Herschell said: "The first point to be determined is, what is the meaning of the words 'in apparatus such as described'? *Mr. Bousfield* sought to interpret those words as including the entire description of the machine contained in the specification, and, so construing it, he said that the combination referred to in the claim was only claimed in such an apparatus; if, therefore, it had been used in any previous apparatus not containing all the specialities of the plaintiffs' machine, it was not within the claim, and therefore the claim was not anticipated by it. I find it impossible to put that construction upon the words 'in apparatus such as described.' The effect of it necessarily would be to make all the four claims mean exactly the same thing, because, of course, if 'in apparatus such as described' means apparatus containing every one of the parts described, and if you only claim what you do claim in that apparatus, obviously that is a claim to a combination which is precisely the same in each of the four cases referred to. It would be perfectly senseless to mention several parts if those parts were only claimed by you in connection with the other parts which you were describing, and perhaps claiming in some of the other claims. I think that construction, therefore, is inadmissible. I do not think it is the natural construction. I think 'in apparatus such

(*v*) 11 R. P. C. 238, 505, 506; 12 R. P. C. 407.

as described' naturally refers to the general use of the apparatus specified in the first two lines of the specification, 'This invention relates to oscillating sieves used for purifying, grading, or separating middlings, grain, or other substances.' I think that, upon the true construction of this specification, any person using the combination described in Claim 2 in an apparatus of oscillating sieves would be infringing the patent."

In *Dowler* v. *Keeling*, (*w*) the patent was for improvements in hollow rivets and studs and in the process of riveting, such improvements being applicable to braces and other like articles. The complete specification contained four claims. By the first the patentee claimed a specified rivet or stud shown in a drawing, and also a combination therewith of discs and plates. The combination was good subject-matter, but the rivet or stud was lacking in novelty, and, being claimed separately, the Court of Appeal held the patent void.

A Claim to a Process which is Useless.—So, too, a patent will be bad should the patentee claim two processes or methods of achieving his purpose when one of these will not work in practice. For the reader of the specification, relying on its directions, might use the unsuccessful method or process, which would fail of its purpose from being too accurately used or performed after the patentee's instructions. (*x*)

In *Kurtz* v. *Spence*, (*y*) (an action brought to restrain threats) the patent on which the defendants relied claimed to purify sulphate of alumina by means of peroxide of manganese, whether in the hydrated or anhydrous form. The evidence shewed that the latter form was impracticable. On this Kekewich, J., held the patent bad. "The patentees," said the learned judge, "have not given that information to the public which the public have a right to demand at the hands of a patentee, or rather, they have informed the public that the result can be obtained by either of two processes, when one and only one of them will produce it, and, therefore, not having fulfilled their part of the bargain, their patent fails."

Nor will it save the patent, in such case, to shew that skilled workmen would know enough to see at once that the one process will not effect the object aimed at, and so confine themselves to the effectual process. (*z*)

(*w*) 14 T. L. R. 257; 15 R. P. C. 214.

(*x*) *Reg.* v. *Cutler*, 1 W. P. C. 76 n., per Denman, C.J. See, also, *Felton* v. *Greaves*, 3 C. & P. 611, per Tenterden, C.J.

(*y*) 5 R. P. C. 161, see p. 184.

(*z*) Ibid.

In *Simpson* v. *Holliday*, (*a*) two processes, one of which may be called the hot process, and the other the cold process, were described in the specification. The patentee denied that the processes were separate and distinct. The Court being against him on this, he then relied on the contention that even if there were two processes, the fact that one (the cold process) had been proved unworkable and of no utility did not vitiate his patent, because the specification stated that the desired result was obtained more quickly by the effectual process (the hot one), and therefore no one would think of using the cold process or be misled by it. The patentee further relied on the contention that any workman of ordinary knowledge and observation would reject the cold process and adopt the hot. Lord Westbury, C., held that the patent had been granted on a false suggestion and was bad at law. His lordship said: "If a specification alleges that a particular process, which may be slow, troublesome, and expensive, is efficient, and the statement is untrue, the vice is not removed by the fact that the same specification also describes another process, which is efficient, and which is stated to be speedy, certain, and economical. . . . If a specification describes several processes or several combinations of machinery, and affirms that each will produce a certain result, which is the object of the patent, and some one of the processes or combinations is wholly inefficient and useless, the patent will be bad, although the mistake committed by the patentee may be such as would be at once observed by an ordinary workman. I am, of course, speaking of cases where that process or machine which is inefficient is the invention or part of the invention that is claimed."

Where several claims are made, each separate claim must be new and useful, but it is not necessary that the respective claims should all be equally useful.

"A patentee who discovers a valuable invention when applied to the purpose he has chiefly in mind," said Romer, J., in the *Adamant Stone Company* v. *Liverpool*, (*b*) "does not invalidate his patent merely because he points out that it is, and claims it as being, also applicable to a subsidiary purpose of far inferior value, subject to the following observations: if the subsidiary claim is absolutely without utility, or has been anticipated, or required no invention, having regard to existing knowledge, then the patent must fail unless and until he amends his specification by confining it to the principal claim."

(*a*) 13 W. R. 577; L. R. 1 H. of L. 315; 12 L. T. (N. S.), 99. (*b*) 14 R. P. C. 22.

Construction of Claims.—A claim will be construed by the Court with reference to the specification of which it forms part, and not as a mere isolated sentence having no connection with what precedes it. (*c*)

(*c*) *Edison & Swan* v. *Woodhouse*, 4 R. P. C. p. 107; *Leadbeater* v. *Kitchen*, 7 R. P. C. 235; *Siddell* v. *Vickers*, 5 R. P. C. 416; *Edison-Bell Company* v. *Smith*, 11 R. P. C. 389. As to construction of the specification, see post, p. 255.

CHAPTER XII.

THE CONSTRUCTION OF THE SPECIFICATION.

General Rule of Construction.—The construction of specifications, like that of all other written documents, is a matter of law for the Court. But the Court will receive evidence as to the meaning of technical terms and words of art or science. (*a*)

In *Neilson* v. *Harford*, (*b*) Parke, B., in words which have frequently since been quoted as the leading dictum on this subject, said: "The construction of all written instruments belongs to the Court alone, whose duty it is to construe all written instruments, as soon as the true meaning of the words in which they are couched, and the surrounding circumstances, if any, are ascertained by the jury; and it is the duty of the jury to take the construction from the Court, either absolutely, if there be no words to be construed, as words of art or phrases used in commerce, and surrounding circumstances to be ascertained, or conditionally where those words or circumstances are necessarily referred to them. Unless this were so, there would be no certainty in the law, for a misconstruction of the Court is the proper subject of redress in a Court of error, but a misconstruction by a jury cannot be set right at all effectually."

So likewise in *Walton* v. *Potter*, (*c*) Tindal, C.J., directing the jury, laid down the general rule as follows: "As these specifications are drawn by men who are more conversant with the particular article than juries, who are selected indiscriminately from the public, and certainly much more than judges, whose knowledge is confined to one particular department, credit is given to witnesses, if they are conversant with the subject-matter of the invention, and are able to tell you, and you believe it, that they

(*a*) *Bovill* v. *Pimm*, 11 Ex. 718; *Simpson* v. *Holliday*, 12 L. T. (N. S.), 99; 5 N. R. 340; L. R. 1 H. of L. 315; *Tetley* v. *Easton*, Macr. P. C. 68.

(*b*) 8 M. & W. p. 823; 1 W. P. C. p. 370.

(*c*) 1 W. P. C. p. 595.

see enough on the face of the specification to enable them to make the article without difficulty."

The Identity of Terms in Different Specifications is a Question of Fact.—It might happen that two specifications were framed in such identical language that the Court, without admitting any evidence as to the meaning of special terms, would be bound to hold the first to be an anticipation of the second. But this as a finding of fact, rather than as a matter of legal construction. "We by no means lay down, as a general rule," said Campbell, C.J., in *Thomas* v. *Foxwell*, (*d*) "that upon a question of novelty of invention such as this, raised by the comparison of two specifications, it must necessarily be a pure question of law for the Court. The specifications may contain expressions of art and commerce, upon which experts must be examined, and there may be conflicting evidence, raising a question of fact to be determined by a jury. But it is quite clear that there may be cases in which the Court would be bound to decide the question of novelty exclusively, for the two specifications might be, *in ipsissimis verbis*, the same; and if they be in such plain and common language that the judge is sure he understands their meaning, he is bound to construe them as he does other written documents."

Such a case, however, is clearly exceptional and not to be drawn into a general rule. In *Bush* v. *Fox*, (*e*) Lord Cranworth, C., used words which appeared to suggest that where anticipation by a specification was relied on, the Court ought to decide the issue of novelty so raised on a perusal of the specifications as a question of construction and without admitting evidence. Dissenting from this in *Hills* v. *Evans*, (*f*) Lord Westbury, C., said, "Some doubt was thrown on this subject by what fell from Lord Cranworth, C., in moving the judgment of the House of Lords in the case of *Bush* v. *Fox*; (*g*) and it seems to have been supposed by Pollock, C.B., in the case of *Booth* v. *Kennard*, (*h*) and evidently was supposed by the Court of Exchequer in the case of *Hills* v. the *London Gas Light Company*, (*i*) that *Bush* v. *Fox* had laid down this rule—that it was the province of the Court to compare the two specifications, and that the Court alone, from that comparison, might arrive at a conclusion as to the identity of the subject."

After pointing out that the passage was clearly an *obiter dictum*—a mere expression of opinion, and not in any sense the

(*d*) 5 Jur. (N. S.) 37, p. 38.
(*e*) 25 L. J. Ex. 251; Macr. P. C. 183.
(*f*) 8 Jur. (N. S.), 528.
(*g*) Supra.
(*h*) 2 H. & N. 84.
(*i*) 29 L. J. Ex. 409.

ground of the decision—Lord Westbury proceeded: "It would be an unreasonable thing, therefore, to take this passage as the ground of the determination of the House of Lords. I cannot, therefore, consider the passage which I have read, notwithstanding the great and unfeigned respect which is due to the high authority of the noble and learned lord, as standing at all in the way of the conclusion which I arrive at, borne out and supported as it is by what I conceive to have been the uniform practice at Nisi Prius, that although the construction of the specification clearly is matter of law, yet if there be two specifications to be compared in order to arrive at a conclusion of fact, the right of drawing the inference of fact from the comparison belongs to the jury, and is a question of fact, and not a question of law."

In *Hills* v. *Evans*, the defendant had attempted to upset the novelty of the patent by putting in evidence various prior specifications, and it was argued that if the Court could by collating these specifications extract from them the plaintiff's invention, it would decide the question of novelty as a matter of law and not of fact. Reviewing this argument, Lord Westbury, C., said: (*j*) "That undoubtedly is a question deserving of very serious consideration. 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 the specification of an invention contains most generally, if not always, some technical terms, some phrases of art, some processes, and requires generally the aid of the light derived from what are called surrounding circumstances. It is therefore an admitted rule of law, that the explanation of the words or technical terms of art, the phrases used in commerce, and the proof and results of the processes which are described (and in a chemical patent the ascertainment of chemical equivalents)—that all these are matters of fact upon which evidence may be given, contradictory testimony may be adduced, and upon which, undoubtedly, it is the province and right of a jury to decide. But when those portions of a specification are abstracted and made the subject of evidence, and therefore brought within the province of the jury, the direction to be given to the jury with regard to the construction of the rest of the patent, which is conceived in ordinary language, must be a direction given only conditionally; that is to say, a direction as to the meaning of the patent upon the hypothesis or basis of the jury arriving at a certain conclusion with regard to the meaning

(*j*) 8 Jur. (N. S.), 257; 31 L. J. Ch. 461.

of those terms, the signification of those phrases, the truth of those processes, and the results of the technical procedure described in the specification. And so the rule is given by Parke, B., in delivering the judgment of the Court of Exchequer in the case of *Neilson* v. *Harford*." (*k*)

On the comparison of the two instruments after they have received their legal exposition and interpretation, Lord Westbury further said: "As it is always a matter of evidence what external thing is indicated and denoted by any description, when the jury have been informed of the meaning of the description contained in each specification, the work of comparing the two, and ascertaining whether the words (as interpreted by the Court) contained in specification A do or do not denote the same external matter as the words (as interpreted and explained by the Court) contained in specification B, is a matter of fact, and is, I conceive, a matter within the province of the jury, and not within the function of the Court." (*l*)

The dictum of Lord Campbell, in *Thomas* v. *Foxwell* (*m*) above mentioned, ought, it would seem, to be limited in application to cases where the specifications to be compared and collated contain neither technical terms nor any matters which are not common knowledge, otherwise it is inconsistent with the views expressed by the House of Lords in *Betts* v. *Menzies*, (*n*) a case in which (after obtaining the opinions of the judges) the House held that the identity of specifications of different dates must be a matter of evidence.

"Even if," said Lord Westbury in that case, "there is identity of language in two specifications, and (remembering that these specifications describe external objects) 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 predicate 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 significance and denote the same external objects at the date of the one specification as they do at the date of the other. This is obvious; for, if we take two specifications, dated as the present are, one in the year 1804, and the other in the year 1849, even if the terms employed in the one were identical with the terms

(*k*) 1 W. P. C. p. 370.
(*l*) Ibid.; cf. *Muntz* v. *Foster*, 2 W. P. C. 93; *Walton* v. *Potter*, 1 W. P. C. 585.
(*m*) See p. 243, ante.
(*n*) 10 H. of L. Ca pp. 152, 153.

employed in the other, supposing that each of them contains a term of art, we will assume it to be a denomination of some engine, some instrument, some drug, or some chemical compound, it may well be that the thing denoted by that name in 1804 is altogether different from the thing denoted by that name in 1849. . . . It is clear, therefore, that if you compare two specifications, even if the language of both is the same, you cannot arrive at a certainty that they denote the same external object and the same external process, unless you enter into an enquiry, and ascertain as a fact that the things specified by the noun substantive in the one specification are precisely the same as the things signified by the same noun substantive contained in the other. In all cases, therefore, where the two documents profess to describe one external thing, the identity of signification between the two documents containing the same description must belong to the province of evidence and not to the province of construction."

A Specification must be Construed with Reference to Existing Knowledge at the Date when it was Drawn.—It is therefore a further rule of construction that the specification must be construed as of the date of its publication and with reference solely to the knowledge regarding its subject-matter then existing. (*o*)

In the *British Dynamite Company* v. *Krebs*, (*p*) the law was thus stated by Earl Cairns, C.: "In determining whether the specification is sufficient, the first thing is to ascertain what the invention is. This is a question of construction, and the construction of the specification is for the Court, to be determined like the construction of any other written instrument, the Court placing itself in the position of some person acquainted with the surrounding circumstances as to the state of art and manufacture at the time, and making itself acquainted as to the technical meaning in art or manufacture which any particular word or words may have."

The Spirit in which Specifications should be Construed.—The spirit in which the Court will approach the specification it is about to construe has frequently been the subject of judicial comment, and the *dicta* as to this cannot be easily reconciled.

At one time such documents were construed with great strictness, almost as if patentees were public enemies, whose rights the Courts ought if possible to defeat. A different rule has prevailed in modern times, under which an equally extreme view has been

(*o*) See Lord Esher, M.R., in *Nobel's Explosives Co.* v. *Anderson*, 11 R. P. C. 523; *Dick* v. *Ellam*, 16 R. P. C. 414; *Welsbach Incandescent Gas Light Co.* v. *New Incandescent Co.* 16 T. L. R. 205; 17 R. P. C. 237.

(*p*) Goodeve's P. C. 88; 14 R. P. C. 192.

sometimes taken in the other direction. It may now, however, be laid down as generally accepted that it is the duty of the Court to hold "a fair hand between the patentee and the public," (*q*) and in the case of an ambiguous specification which is capable of more than one meaning, to adopt that interpretation which will support the patent. But such ambiguity must be a real ambiguity and not one manufactured for the purpose of escaping from the dilemma of a condemnatory construction. (*r*)

"Half a century ago," said Parke, B., in 1841, (*s*) "or even less, within fifteen or twenty years, there seems to have been very much a practice, with both judges and juries, to destroy the patent right, even of beneficial patents, by exercising great astuteness in taking objections, either as to the title of the patent, or more particularly as to the specification; and many valuable patent rights have been destroyed in consequence of the objections so taken. Within the last ten years or more, the Courts have not been so strict in taking objections to the specification; and they have endeavoured to hold a fair hand between the patentee and the public, willing to give 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 that proviso which is introduced into the patent for their advantage, so that the right to the patent may be fairly and properly expressed in the specification."

In *Stevens* v. *Keating*, (*t*) the same learned judge said: "Some observations have been made at the bar on the subject of patents and specifications and the different rules of construction that have been applied at different periods. I take the rule to be that you are not to intend anything in favour of a specification or a patent, and certainly not to intend anything against it; you are to deal with it just as you find it; you are to put the true and right and fair construction upon every allegation and every fact connected with it, and you are to find what is the true and fair and just result."

Mere Lawyer's Objections are not Viewed with Favour by the Court.—The Court will not now be astute to support what may be called a mere lawyer's objection; and this especially so where the invention concerned is one of high utility and merit. In *Newton* v.

(*q*) Per Parke, B., in *Neilson* v. *Harford*, 1 W. P. C. p. 310. See, also, Lord Westbury, C., in *Simpson* v. *Holliday*, 5 N. R. 340; L. R. 1 H. of L. 315; 12 L. T. (N. S.) 99.

(*r*) Per Lord Davey in *Parkinson* v. *Simon*, 12 R. P. C. 411.

(*s*) *Neilson* v. *Harford*, 1 W. P. C. p. 310. See, also, Pollock, C.B., in *Tetley* v. *Easton*, Macr. P. C. p. 65.

(*t*) 2 W. P. C. p. 187.

the *Grand Junction Railway Company*, (*u*) Rolf, B., referring to the manner in which the plaintiff's specification had in that case been criticized by the defendants' counsel said: "They discussed and scanned the language of the specification in the same sort of spirit as if it were a plea or replication specially demurred to. That is not the spirit in which a specification should be inspected. The proper mode is to construe it and see what is the good sense of it, and whether that which the patentee claims as his invention is there distinctly and clearly explained."

In *Haworth* v. *Hardcastle*, (*v*) Tindal, C.J., said: "There can be no rule of law which requires the Court to make any forced construction of the specification, so as to extend the claim of the patentee to a wider range than the facts warrant; on the contrary, such construction ought to be made as will, consistently with the fair import of the language used, make the claim of the invention co-extensive with the new discovery of the grantee of the patent."

In *Plimpton* v. *Spiller*, (*w*) an ingenious objection was taken to the patent, that a subsidiary claim in the specification was a claim to matter which was not new. On this Brett, L.J., said: "I think it is right to observe upon the nature of the objection to this suit, that it is brought to prevent the actual infringement of a real, substantial invention, and it is not now denied that that invention is a valuable invention, and that substantially it has been infringed. But then, in order to defeat the plaintiff, there is an ingenious suggestion that a minor and wholly inappreciable claim has been made of something which is not novel. The plaintiff has not complained of anybody infringing that particular part of the claim, and nobody has actually infringed that particular part of the claim. It is therefore an objection which may be properly styled to be a lawyer's objection. It is not denied that if the claim be erroneous it may be disclaimed to-morrow. Therefore, the only object of this objection is to prevent the plaintiff from obtaining that which in substance it is admitted he is entitled to claim, and, under the circumstances, I agree with the Master of the Rolls, that the Court ought to be anything but astute to support such an objection."

Obscurities in the Specification.—Obscurity in a specification occasioned by the use of loose expressions, or such mistakes as the Court can regard as mere inaccuracies in the wording of the

(*u*) 5 Ex. p. 335; 20 L. J. Ex. p. 429.
(*v*) 1 W. P. C. p. 485; 1 Bing. N. C. p. 191; 3 L. J. C. P. p. 317.
(*w*) L. R. 6 C. D. 412, p. 432; 47 L. J. Ch. 211, p. 216.

document, will not be construed as fatal to its validity, if the evidence shews that the document is intelligible, notwithstanding these defects, to a workman of ordinary skill. (*x*) But, of course, such inaccuracies must not need exceptional skill and knowledge to correct them, for that puts the public on further invention.

In *Derosne* v. *Fairie*, (*y*) Lord Abinger, C.B., said: "It must be admitted that the specification is obscure. The gentleman who composed it is not an Englishman, and he uses the word 'baked' evidently for boiling, and the word 'discolouration' for discharge from colour; but all that is conceded. One would not be disposed, from any obscure word in the specification which might be interpreted in favour of the plaintiff, taking it altogether, to deprive him of his patent."

So, again, in *Palmer* v. *Wagstaffe*, (*z*) Pollock, C.B., said: "We ought not to violate the plain meaning of language, unless it is quite clear something else was meant. For instance, 'imponderable' might be a clear mistake for 'ponderable,' or a term might be borrowed from another language and an enlarged meaning given to it, according to its original meaning, as where 'vice' was held to include a 'screw.'" (*a*)

In *Hills* v. *London Gas Light Company*, (*b*) Bramwell, B., disposing of a similar objection, said: "The next objection was, that the plaintiff's specification was insufficient on this ground: He says, 'I use the hydrated *or* precipitated oxides.' It was said that included all hydrated oxides, and inasmuch as some of the natural hydrated oxides would not do, the plaintiff's specification was bad. Now, that question turns upon this. If the plaintiff in his specification means all the hydrated oxides, it is open to that objection; but if he means only those hydrated oxides which are also precipitated, that is the artificial hydrated oxides, it is not open to that objection. It may be said that the language is in any sense ungrammatical, and that hydrated or precipitated—the whole or the part—cannot be right. To say, 'the works of Shakespeare, or Hamlet, and King Lear,' would obviously be an inaccuracy which cannot be judged by the ordinary rules of grammar, and therefore we must endeavour to find out the proper meaning of this inaccurate expression. It appears to us, upon looking at the

(*x*) Per Bowen, L.J., in *Miller & Co.* v. *Scarle*, 10 R. P. C. p. 111.
(*y*) 1 W. P. C. pp. 156, 157.
(*z*) 23 L. J. Ex. p. 218; 9 Ex. p. 501.
(*a*) *Bloxam* v. *Else*, 1 C. & P. 558.
(*b*) 5 H. & N. pp. 368, 369; 29 L. J. Ex. p. 424.

specification, that the plaintiff uses those as equivalent expressions, because he says 'hydrated or precipitated,' and that oxide of iron may be conveniently *prepared* for these purposes, and so on; and therefore it is obvious that when he uses that word 'hydrated,' he uses it as synonymous with precipitated; and consequently, when he speaks of using hydrated or precipitated oxides, he means such hydrated oxides as are precipitated. That is the construction we put upon the specification, and therefore we think that objection fails."

In *Edison* v. *Woodhouse* (first action), (*c*) the owners of three patents relating to the construction of incandescent electric lamps brought an action for infringement. The defendants objected that the second claim of one of these patents was bad for vagueness of description. The claim read as follows: "The combination of a carbon filament within a receiver made entirely of glass, through which the leading wires pass, and from which receiver the air is exhausted for the purposes set forth." In place of the filament a rod of carbon had before been used, and it was argued that the difference between the filament and the rod was only a difference of degree, and that, the degree not being specified, the patent was void.

On this objection, Fry, L.J. (delivering the judgment of himself and Bowen, L.J.), said: "The specification is, it is argued, bad, as being too indefinite and vague. To this argument it may, in our opinion, be properly replied that in a patent of this description definition is required only to such an extent as would enable a practical workman to construct the required apparatus; that there is distinct evidence that such a workman could make the required apparatus from the specification, and that no witness of the defendant's alleges that such a workman would have any difficulty or require any further experiments, and that the specification itself, as we have already shewn, contains descriptions of six forms of filament, and these descriptions, it is obvious, would afford material assistance to any workman in doubt."

In *Edison* v. *Woodhouse* (second action), (*d*) this rule was again applied by the Court in construing the specification. In that case the patentee in his specification made use of three expressions, all apparently to describe the same thing—"hydro-carbon gas," "carbon gas," and "carbonic gas." It was urged by the defendants that these expressions were calculated to mislead the public, being inaccurate terms for what the patentee employed

(*c*) 4 R. P. C. 79, see p. 92. (*d*) 3 R. P. C. 183; 4 R. P. C. 99.

them to describe, and being wide enough to include two gases which would not produce the desired result. The case was tried before Butt, J., who was of opinion on the evidence that the patentee did not mean exactly what he said in using any one of these expressions, but who also found that the specification was not misleading, as no person of ordinary knowledge, in his senses, would think of applying carbonic acid and carbonic oxide to the operation in question. The learned judge accordingly held the specification sufficient.

On appeal, the judgment below was affirmed. Disposing of this objection, Lindley, L.J., in delivering the judgment of the Court, said: "One objection is that the expression, carbon gas or liquid, in the claim is ambiguous, and too wide and misleading. It is urged that the expression includes carbonic oxide and carbonic acid, neither of which will do. But every claim in every patent must be read and construed with reference to the specification, and not as if the claim was an isolated sentence, having no connection with or reference to what precedes it. To see what is meant by carbon gas or liquid, we must turn to the specification; and when we do so, we cannot conceive that any one reading this specification fairly, with a view to understanding it, would ever dream for a moment that carbonic oxide or carbonic acid would answer the purpose, or could be meant by carbon gas. . . . The chemical experts, as might have been expected, ridiculed the notion that any one would think of trying carbonic oxide or carbonic acid. In the body of the specification we find that by 'carbon gas or liquid' is meant what the patentee calls a hydro-carbon gas or liquid, and he states that beeswax, balsam, and most oils, if pure, operate satisfactorily; and that almost any hydro-carbon will answer. The appellants on this urge that beeswax, and balsam, and oils, are not, properly speaking, hydro-carbons; and that the specification is inaccurate and misleading. The evidence shews that, in its technical sense, hydro-carbon is a chemical combination of hydrogen and carbon, and nothing else; and beeswax, balsam, and oils, are not technically hydro-carbons. They contain hydrogen and carbon chemically combined with each other, but also with other substances. But the evidence also shews that, so far as is known, every substance which is a hydro-carbon, either in its technical sense, or in the looser sense in which the patentee uses the expression, does answer the purpose; and there is no evidence that anything which answers the description of hydro-carbon, in either sense, will not answer the purpose. In this state

of the evidence it is impossible for the Court to say that the specification is open to serious objection, or is insufficient on the ground alleged. . . . If the language of a specification is clear enough to guide a competent workman, and enable him to obtain the desired result, we cannot see how a Court can hold the language insufficient in point of law. No doubt it is for the Court, and not for a workman, to construe the specification; but if a workman says it is a sufficient guide to him, and the Court believes him, the Court must hold that, as regards clearness of description, the specification is, in point of law, sufficient." (*e*)

The case of *Plimpton* v. *Spiller* (*f*) is instructive as illustrating how far the Court will go in allowing the general spirit of a specification to govern and prevail over the clumsy use of particular language. But it is only an illustration, and must not be taken as laying down principles of general application. (*g*)

In that case the patentee had claimed in his specification, first, a mode of applying rollers and runners to the footstands of skates, in order 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 in the specification. To this second claim it was objected that there was nothing novel in the mode of securing the runners to the footstands. But the Court held that, assuming this to be so, the want of novelty in the second claim ought not to invalidate the patent, because the second claim must be read as claiming a subsidiary invention, to be used only in connection with the principal invention.

"There are few patents of complicated inventions," said Jessel, M.R., "even as regards the text and drawings, where some mistake or other is not made. Accuracy, as we all know, is very difficult of attainment; and when the judge sees that there is a real, substantial invention of great merit, and the description is fairly made, so that a competent workman can make the invention, it is not his duty to endeavour to construe the patent so as to make it claim that which it is utterly absurd to suppose would be claimed, because it is so well known, as a matter of public notoriety, that nobody would think of claiming such a thing." (*h*)

Construction of the Specification not to be Determined by Experts.—Inasmuch as patent actions frequently involve an enquiry into

(*e*) 4 R. P. C. pp. 107, 108.
(*f*) L. R. 6 C. D. 412; 47 L. J. Ch. 211, pp. 90, 91 (per Bowen and Fry, LL.JJ.).
(*g*) See *Cropper* v. *Smith*, 1 R. P. C.
(*h*) L. R. 6 C. D. p. 423.

matters of a highly technical or scientific nature, the evidence of experts is often tendered by the parties. But while such witnesses may give valuable assistance to the Court as to the meaning of terms in a specification, it is not for them to construe the document itself, and statements as to their opinion upon what the specification means are wholly inadmissible. They may inform the Court regarding the facts, but the Court, in light of that knowledge, must itself construe the specification. (*i*)

"In all cases," said Lindley, L.J., in *Brooks* v. *Steele*, (*j*) "the nature of the invention must be ascertained from the specification, the interpretation of which is for the judge, and not for any expert. The judge may, and indeed generally must, be assisted by expert evidence to explain technical terms, to shew the practical working of machinery described or drawn, and to point out what is old and what is new in the specification. Expert evidence is also admissible, and is often required to shew the particulars in which an alleged invention has been used by an alleged infringer, and the real importance of whatever differences there may be between the plaintiff's invention and whatever is done by the defendant. But, after all, the nature of the invention for which a patent is granted must be ascertained from the specification, and has to be determined by the judge, and not by a jury nor by any expert or other witness." (*k*)

Benevolent Construction.—It has sometimes been said that the Court will construe a specification benevolently, and dicta to that effect are to be found in several modern cases. (*l*) The expression is not a happy one as applied to the construction of specifications in patent cases, and the doctrine was reduced to its due proportions by the Court of Appeal in *Cropper* v. *Smith*. (*m*)

"It seems to me," said Bowen, L.J., in that case, "that the 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

(*i*) See the observations of Smith, L.J., as to this in *Gadd* v. *Mayor of Manchester*, 9 R. P. C. p. 532.

(*j*) 14 R. P. C. p. 73.

(*k*) Cf. Lord Cairns, C., in *British Dynamite Co.* v. *Krebs*, 13 R. P. C. p. 192.

(*l*) See Jessel, M.R., in *Hinks* v. *Safety Lighting Co.*, L. R. 4 C. D. p. 612; 46 L. J. Ch. p. 185; and in *Otto* v. *Linford*, 46 L. T. p. 39.

(*m*) 1 R. P. C. 80, p. 89. See, also, Lindley, L.J., in *Needham* v. *Johnson*, 1 R. P. C. p. 58.

with, as between themselves and the public; and as a canon of construction accordingly, reference has been made 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 *Sheppard'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 their deed, and you must not defeat it, if effect can be given to their intention by a fair construction of the whole of the document. It is almost always coupled with another maxim, which seems to me really to be the same thing in another shape: '*Verba intentioni debent inserviri.*' 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 the patent is in question, it certainly never can 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." (*n*)

"I am clearly of opinion," said Lord Esher, in *Nobel's Explosives Company* v. *Anderson*, (*o*) "that whether the patent be a pioneer patent, or a master patent, or a patent for a first invention, or whether it be a valuable patent, or a patent for the smallest thing, or whether it be a patent for an improvement, or whatever the patent may be, the canons of construction of the patent are precisely the same. What is more, I am further of opinion that the canons of construction of a patent are the same canons of

(*n*) See this "most admirable judgment" approved in *Benno Jaffé* v. *Richardson*, 11 R. P. C. 271; *Hocking* v. *Hocking*, 6 R. P. C. 73 (per Lord Halsbury, C.); *Nobel's Explosives Co.* v. *Anderson*, 11 R. P. C. 523; and in *Tolson* v. *Speight*, 13 R. P. C. p. 721.

(*o*) Supra.

construction that are to be applied to every written instrument which has to be construed by the Court."

"You are not," said Lord Davey in *Kynoch & Company* v. *Webb*, (*p*) "to put a forced construction on the specification, as not intending to claim something that is old, because it was foolish or suicidal of the patentee to claim it."

In Construing Claims the Whole Specification must be Looked at.—Every specification must conclude with a distinct statement of the invention claimed. In construing such statements the proper course is to first read the specification through, and see what the inventor proposed to patent, and then construe the claim in the light of the information so obtained. (*q*) For a claim is not an isolated sentence having no connection with what precedes it.

"I do not think," said Lord Hatherley in *Arnold* v. *Bradbury*, (*r*) "that the proper way of dealing with this question is to look first at the claim, and then see what the full description of the invention is, but rather first to read the description of the invention, in order that your mind may be prepared for what it is the inventor is about to claim. He tells you that he has now described and particularly ascertained the nature of his invention, and the manner in which it is to be performed, and then in the claim we do not find anything asserted or claimed as his invention beyond what is found in the previous part."

In *Edison-Bell* v. *Smith*, (*s*) Lord Esher, M.R., following the above rule, said: "When objection is taken to the claim, or to any one of several claims, it is not using the true canons of construction to read that alone and to say that, without regard to what there is in the rest of the patent, that means so-and-so, or that means what is stated as the objection, and, therefore, reading it in that way, you must hold that the patent is bad. You must look at the whole of the specification, and then, having looked at the whole, if it is an objection to the claim, see what the claim, on the true construction of it, is, having regard to the whole of the instrument. . . . That is the rule which, I think, is the right one, and it is the same rule as you would apply to the construction of any instrument. Read the whole of it before you determine upon an objection to any particular part of it. When you have read the whole of it you must come back to that which is objected to, and see what is the fair construction of it, having regard to what you

(*p*) 17 R. P. C. 116

(*q*) See Lindley, L.J., in *Edison* v. *Woodhouse*, 4 R. P. C. 107.

(*r*) L. R. 6 Ch. p. 712; 24 L. T. 613.

(*s*) 11 R. P. C. pp. 395, 369.

read before. You must not distort it; you must not add to it; you must construe it as it is, but construe it fairly."

Where the claim contains the words "substantially as described and set forth," the patentee is limited in the construction of such claim by the earlier descriptive part of the specification, which will be held to control the claim. (*t*) But the patentee in such case is not tied down to the very words of the letterpress, to the exclusion of what may be included in the drawings of the specification. (*u*)

In *Maxim-Nordenfelt Company* v. *Anderson*, (*v*) where the patent was for a smokeless explosive compound, the patentee stated in his specification that he produced his explosive compound by mixing gun-cotton or pyroxyline with nitro-glycerine, nitro-gelatine, or similar material, and with oil, preferably castor oil, in, or about in, the following proportions, viz., from two to five per cent. of the castor oil, from ten to fifteen per cent. of the nitro-glycerine or the like, and the remainder of gun-cotton. The first claim was as follows—"An explosive compound consisting essentially of gun-cotton or pyroxyline mixed with nitro-glycerine, nitro-gelatine, or similar material, and with castor oil or other suitable oil for the purpose above specified." The plaintiffs contended that this claim covered any combination of the specified substances, no matter what the varying proportions were. The defendants argued that the words "in, or about in," contained in the body of the specification, governed the claim and limited the plaintiffs' invention to a combination of the named substances in, or about in, the specified proportions. The House of Lords held that the defendants' contention was right; that the proportions given by the plaintiffs (in which gun-cotton greatly predominated) were the essence of the invention, and that the manufacture of cordite, which contained fifty-eight per cent. of nitro-glycerine and only thirty-seven per cent. of gun-cotton, was no infringement of the patent.

Where a specification has once been construed by the Court, a Court of co-ordinate jurisdiction will regard such construction as binding, and follow it in a subsequent action on the same patent. (*w*) But this rule will not prevent the Court which hears the second action from exercising its judgment on the effect of fresh evidence. (*x*)

(*t*) *Brooks* v. *Lamplugh*, 15 R. P. C. 49.

(*u*) *Pneumatic Tyre Co.* v. *Tubeless Tyre*, 15 R. P. C. 243; 14 T. L. R. 341; 16 R. P. C. 79; 15 T. L. R. 105.

(*v*) 14 R. P. C. 671; 15 R. P. C. 421.

(*w*) *Hills* v. *Liverpool Gas Co.* 32 L. J. Ch. p. 30; *Slazenger* v. *Feltham*, 6 R. P. C. 132; per Bowen, L.J., in *Edison & Swan* v. *Holland*, 6 R. P. C. 252.

(*x*) See Cotton, L.J., in *Edison* v. *Holland*, 6 R. P. C. pp. 280, 281; also Lord Halsbury, C., in *Automatic Weighing Machine Co.* v. *Combined Weighing Machine Co.*, 6 R. P. C. p. 370.

CHAPTER XIII.

AMENDMENT OF THE SPECIFICATION.

Power of Amendment a Statutory Relief.—The consideration for a patent grant being one and indivisible, a failure in part is a failure in all. (*a*) If a part of the alleged invention, for example, is not new the whole grant is void, so long as the specification still claims that part, no matter how novel and meritorious the rest may be. Great hardship would therefore sometimes be inflicted on deserving and ingenious persons if the law afforded no means of curing such a defect in a patent. It may easily happen in the case even of the most diligent and careful inventor, that the drag net of his claim is thrown too wide, and some matter lacking novelty or utility inadvertently included. Where this occurs the letters patent are void by reason of the defective matter included in the claim; and if no power existed of limiting the claim by amendment to that which the patentee had in fact invented, the unfortunate inventor would lose the entire fruit of his labour and ingenuity. The expediency, therefore, of providing a remedy in such case, to save that portion of the patent which is not open to objection, is at once apparent.

No such power of amendment existed at common law. Alterations in the terms of a patent grant could only be sanctioned in the same way in which the letters patent had themselves been authorized, viz., by a second sealing with the great seal. The patentee who desired to obviate such a defect in his grant had therefore to go again to the Crown for what was in effect a new patent. A jurisdiction to amend trifling errors was, it is true, vested in the Master of the Rolls, as custodian of the records in Chancery. But this jurisdiction only extended to clerical errors, mistakes *per incuriam et ex inani inadvertentia scriptoris*. The letters patent, when a grant was made, were delivered to the grantee as evidence of his title, but the enrolment of the patent

(*a*) See ante, pp. 63, 64.

and specification remained as records in Chancery, in the keeping of the Master of the Rólls, whose right of interference with such documents only extended to seeing that they actually corresponded with the originals. (*b*)

Former Practice as to Amendments.—The hardship occasioned to patentees by the absence of any power of amendment at length attracted the attention of the Legislature. Disclaimers and memoranda of alteration were first allowed by 5 & 6 Wm. IV. c. 83. The leave of the Attorney or Solicitor General was, however, required for amendments under this Act. Once leave was given, and the disclaimer filed and enrolled, it became part of the letters patent or specification from the date of the filing. (*c*) The power of amendment thus given was, however, strictly limited to disclaimer.

Explaining the object of this Statute, in *Regina* v. *Mill*, Maule, J., said: "The principle of the enactment seems to be this: Where a patent is void for claiming too much, and the case one which appears to the Attorney General to be proper for the exercise of his discretion in allowing a disclaimer, the patent is not to be altogether avoided, but may be amended in the mode prescribed. In the exercise of this discretion great care ought to be, and no doubt is, taken that injustice be not done to third parties or to the public." (*d*)

Under this Act it was held that the grantee who had obtained the patent was the person who must enter the disclaimer, even where he had assigned his interest. (*e*) This inconvenience was removed by 7 & 8 Vict. c. 69, s. 5, which permitted assignees of letters patent to enter disclaimers. Section 15 of 12 & 13 Vict. c. 109, provided that specifications and disclaimers should be enrolled in the enrolment office of the Court of Chancery; and 15 & 16 Vict. c. 83, (*f*) required them to be filed. The last-mentioned Act also enacted that no action should be brought in respect of any infringement of a patent in connection with which a disclaimer

(*b*) See Lord Langdale, M.R., *In re Sharpe's Patent*, 3 Beav. 245, pp. 251–253. How far this jurisdiction still survives would seem to be doubtful. In any case it is now of little importance, as the Comptroller-General of Patents has ample power to amend clerical errors. See the Patents Act, 1883, s. 91, and P. R. 1890, rule 16 As to the jurisdiction of the Master of the Rolls, see *In re Johnson's Patent*, 5 C. D. 503; *In re Berdan's Patent*, L. R. 20 Eq. 346; *In re Morgan's Patent*, 24 W. R. 245; *In re Gare's Patent*, 26 C. D. 105.

(*c*) *Perry* v. *Skinner*, 2 M. & W. 471; *Reg.* v. *Mill*, 10 C. B. 379; 14 Beav. 312; 20 L. J. C. P. 16.

(*d*) 10 C. B. p. 395; 20 L. J. C. P. 16.

(*e*) *Spilsbury* v. *Clough*, 2 Q. B. 466; 11 L. J. Q. B. 109; 1 W. P. C. 255.

(*f*) The Patent Law Amendment Act, 1852.

had been filed where such infringement had occurred prior to the filing of the disclaimer, unless the Law Officer certified by his *fiat* that such action might be brought, notwithstanding the filing of such disclaimer. (*g*) By 16 & 17 Vict. c. 115, certified copies of disclaimer were made receivable in evidence. All these Statutes were repealed by the Patents Act, 1883, which, with the amending Acts, now governs the practice as to the amendment of specifications.

Discussing disclaimers under these earlier Statutes, Lord Westbury in the House of Lords in 1865 said: (*h*) "The object of the Act authorizing disclaimers was plainly this, that when you have in your specification a sufficient and good description of a useful invention, but that description is imperilled or hazarded by something being annexed to it which is capable of being severed, leaving the original description, in its integrity, good and sufficient, without the necessity of addition, then you might, by the operation of a disclaimer, lop off the vicious matter and leave the original invention as described in the specification untainted and uninjured by that vicious excess. But it was never intended that you should convert a bad specification, in the sense of its containing no description of any useful invention at all, into a good specification, by adding words that would convert what has been properly called in the Court below, 'a barren and unprofitable generality,' into a specific and definite and practical description."

Amendment under the Patents Act, 1883.—The present practice on amendments may best be considered under the following heads: (1) Amendments required by the Comptroller after receiving the examiner's report as to an application for a patent. (2) Amendments at the instance of the applicant or patentee, after the filing of the complete specification. (3) Amendments when an action is pending in regard to the patent, or after a petition for its revocation has been presented.

1. *Amendments required by the Comptroller.*

These amendments are now governed by Section 2 of the Patents Act, 1888, and Section 9 of the Patents Act, 1883. The former of those sections deals with the provisional specification, and provides that if the examiner to whom an application for letters patent has been referred reports that the nature of the

(*g*) The Patent Law Amendment Act, 1852, s. 39.

(*h*) *Ralston* v. *Smith*, 11 H. of L. Ca. p. 243; 35 L. J. C. P. p. 54.

invention is not fairly described, or that the application, specification, or drawings, has not, or have not, been prepared in the prescribed manner, or that the title does not sufficiently indicate the subject-matter of the invention, the Comptroller may refuse to accept the application, or require that the application, specification, or drawings be amended before he proceeds with the application.

Section 9 of the Patents Act, 1883, relates to the usual case of a complete specification, that is to say, where that document is left after a provisional specification has been delivered, and provides that if the examiner in such case reports that the complete specification has not been prepared in the prescribed manner, or does not describe substantially the same invention as that described in the provisional specification, the Comptroller may refuse to accept the complete specification, unless and until the same shall have been amended to his satisfaction.

In both of the above cases an appeal lies from the Comptroller to the Law Officer, whose decision in the matter is final. (*i*)

The machinery of the Acts under which specifications are referred to examiners for report does not limit the discretion of the Comptroller to requiring only such amendments as the examiner may suggest. The Comptroller may himself require an amendment to be made where he considers it necessary, whether such amendment has been suggested by the examiner or not. (*j*)

Where an applicant files his complete specification with a restricted title, the Comptroller may, under the above sections, amend the title of the provisional specification, so as to make the two documents agree; but such amendment can only be made by way of excision. (*k*)

Where the Comptroller requires an amendment to be made before an application is allowed to proceed, he may also direct that such application shall bear date from the time when the requirement is complied with. (*l*)

The Comptroller's power of requiring amendments is only intended to be exercised before the specifications have become public property: (*m*) thereafter all amendments must be made at the instance of the patentee, under the provisions of a different section, which will next be considered.

Inventors should remember that while the Comptroller has

(*i*) Patents Act, 1888, s. 2 (2) (3); Patents Act, 1883, s. 9 (2) (3).
(*j*) *C.'s Application*, 7 R. P. C. 250.
(*k*) *Dart's Patent*, Griff. P. C. 307.
(*l*) Patents Act, 1888, s. 2 (1).
(*m*) *Jones' Patent*, Griff. P. C. 313.

this ample power of amendment, it is not a matter of course that he will exercise it in favour of a careless applicant, who sends in a specification so negligently framed that a grant cannot be made upon it without amendment. (*n*) In practice, extensive amendments will not usually be allowed; and an applicant must not think that it is open to him to cast his net as widely as he pleases in his claims, and then come to the Comptroller and say it is a case for amendment. (*o*)

2. *Amendments of Specifications at the Instance of the Patentee when no Action for Infringement, and no Proceeding for Revocation of the Patent, is Pending.*

The special statutory provisions dealing with these amendments are contained in Section 18 of the Patents Act, 1883. (*p*) Commenting on that section in *re Hall and Others*, Smith, J., said: "Section 18 gives power to a patentee, when he finds out the blunder in his specification, himself to seek leave to amend his specification by way of disclaimer, correction, or explanation; and he can go, *proprio motu*, to the Comptroller and say, 'I want to amend the blunder I have got in my specification, as regards disclaimer, correction, or explanation.'" (*q*)

The Comptroller-General of Patents and the Law Officer are the special authorities in whom is vested the sole jurisdiction to permit or refuse amendments under this section. No amendment can be obtained without the consent of the Comptroller or (if the matter be appealed) of the Law Officer on appeal from the Comptroller.

If it is desired to amend a complete specification after it has been filed, but before the sealing of the letters patent, leave must be sought by the applicant himself. But once the letters patent have been sealed, any person for the time being entitled to the benefit of the letters patent may make the application. (*r*)

Application, how Made.—The application must be made by request in writing, signed by the person qualified to apply, and stating the nature of the proposed amendment and the reasons

(*n*) *Thomas & Prevost's Application*, 16 R. P. C. 69.

(*o*) *Garnett's Application*, 16 R. P. C. 154.

(*p*) See, also, Patents Act, 1888, s. 5.

(*q*) 5 R. P. C. 312; 21 Q. B. D. 137.

All applications for amendment after the complete specification has been published (even if made before that specification has been accepted) ought to be made under s. 18. See *Jones' Patent*, Griff. 313.

(*r*) Patents Act, 1883, s. 18 (1); s. 46.

for it. (*s*) The reasons are a part of the request; but the application should not apparently be refused merely because the reasons stated in the request are insufficient. (*t*) The request for leave to amend must be sent to the Comptroller-General of Patents at the Patent Office.

It may be left at the office or sent through the post. (*u*) It must be accompanied by a duly certified copy of the original specification and drawings, shewing in red ink the proposed amendment. (*v*) The request for leave to amend is, on receipt at the Patent Office, advertised by the Comptroller in the official journal. (*w*) Intimation is thus made to the public of the proposed amendment, and the reasons assigned for it. (*x*)

Opposition to Amendment.—Any one may, within one month from the first advertisement, give notice at the Patent Office of opposition to the proposed amendment. (*y*) A notice of opposition must state the grounds on which the person giving such notice intends to oppose the amendment. It must be signed by the opponent, and state his address for service in the United Kingdom. (*z*) The Comptroller has, however, allowed notices of opposition to be signed subsequently to their acceptance at the Patent Office, where, in his opinion, no prejudice was thereby occasioned to the applicant for amendment. (*a*) An unstamped copy must accompany the notice of opposition for transmission to the applicant for amendment, (*b*) to whom the Comptroller is required to give notice of the opposition. (*c*)

Evidence on the Application and Opposition.—The evidence in support of the opposition is transmitted to the Comptroller in the form of statutory declarations. The opponent has a period extending to fourteen days after the expiration of one month from the first advertisement of the application to amend, within which he may leave at the Patent Office statutory declarations in support of his opposition. A list of these declarations must at the same time be delivered to the applicant. (*d*)

The applicant has fourteen days from the delivery of this list within which to leave at the Patent Office his statutory declarations in answer, together with a list thereof for the opponent. A further

(*s*) Patents Act, 1883, *s.* 18 (1); P. R. rule 52.
(*t*) *Ashworth*, Griff. A. P. C. 6.
(*u*) P. R. rule 16A.
(*v*) Sect. 18 (1) P. R. rule 52.
(*w*) Sect. 18 (2) P. R. rule 52.
(*x*) *Ashworth*, Griff. A. P. C. 6.
(*y*) Sect. 18 (2).
(*z*) P. R. rule 53.
(*a*) *Re Codd*, Griff. P. C. 305.
(*b*) P. R. rule 54.
(*c*) Patents Act, 1883, *s.* 18 (3).
(*d*) P. R. rule 55.

period of fourteen days is allowed the opponent to deliver declarations in reply. Declarations in reply must, however, be confined strictly to matters in reply only. (*e*) A list of these must likewise be delivered to the applicant. Copies of declarations delivered may be obtained either at the Patent Office or from the opposite party. (*f*)

Neither side may leave further evidence except by permission of the Comptroller. This permission will only be given upon the written consent of the parties or by special leave on application in writing made for the purpose. (*g*) Either party applying to the Comptroller for special leave must give notice to the opposite party, who may oppose the application. (*h*)

Hearing before the Comptroller.—On the completion of the evidence, or at such other time as he may see fit, the Comptroller must appoint a time for the hearing of the case, giving the parties at least ten days' notice. (*i*) It is not necessary that the parties should attend before the Comptroller, but if either side wish to do so, they must send in an application to be heard on the prescribed form. Otherwise the Comptroller may refuse to hear them. (*j*)

The Comptroller (unlike the Law Officer) has no power either to summon witnesses or to hear evidence *vivâ voce*. He must decide the case upon the declarations. If, therefore, he finds that the application and opposition raise a direct issue of fact, he will probably allow the amendment, and leave the opponents to their remedy by way of appeal to the Law Officer, before whom the respective declarants can be summoned and cross-examined, so as to test on which side the truth lies. (*k*)

If the parties do not desire to attend before the Comptroller, he will decide the case upon the filed declarations. (*l*) Whether parties elect to attend or not, the decision of the Comptroller is usually notified to them in writing.

When leave to amend is given, the applicant must leave at the Patent Office, if required to do so, and within such time as shall be fixed by the Comptroller, a new specification and drawings (if any) as amended. (*m*)

Every amendment of a specification is advertised in the official

(*e*) P. R. rules 56 & 38.
(*f*) Ibid. 56, 39.
(*g*) Ibid. 56, 40.
(*h*) Ibid. 40, 56.
(*i*) Ibid. 56.
(*j*) P. R. rules 44, 56.
(*k*) See *Hatfield's Patent*, Griff. 288.
(*l*) P. R. rules 44, 56.
(*m*) P. R. rule 57. As to form of specification see P. R. rules 10, 30, 31; and examples Appendix IV. post.

journal of the Patent Office, and otherwise, as the Comptroller may direct. (*n*)

The Comptroller is not bound merely to permit or refuse an amendment, he may impose conditions, (*o*) but he has no power to give costs. (*p*) He may not, therefore, impose a condition that a sum of money shall be paid by the applicant to the opponent if such sum is really intended to recoup the opponent his expenses of opposing. (*q*)

Appeal to Law Officer.—From the Comptroller an appeal lies to the Law Officer, whose decision is final. (*r*) Any person intending to appeal must file a notice of his appeal in the Patent Office within fourteen days of the date of the decision it is intended to question. (*s*) The time for serving such notice, where the specific terms of an amendment which has been allowed are not settled at the hearing before the Comptroller, runs from the day on which the Comptroller forwards to the parties a copy of the amendment as officially approved. (*t*) The notice of appeal must state the nature of the decision appealed against, and whether the appeal is from the whole, or part only, and what part. (*u*) A copy of this notice must be sent to the Law Officer's clerk at the Royal Courts of Justice, and to the applicant or person opposing before the Comptroller, as the case may be. (*v*)

No appeal will be entertained of which notice has not been given within fourteen days, or such further time as the Comptroller has allowed, except upon special leave obtained on application to the Law Officer. (*w*)

Upon notice of the appeal being filed, the Comptroller transmits to the Law Officer's clerk all the papers relating to the matter under appeal. (*x*)

Seven days' notice at least of the time and place appointed for hearing the appeal is given by the Law Officer's clerk. But in special cases the Law Officer may direct a shorter notice to be given. (*y*) This notice is given to the Comptroller and the appellant, and to any person opposing before the Comptroller. (*z*)

At the hearing of the appeal the Law Officer will hear the applicant for amendment, and any person who has given notice of

(*n*) P. R. rule 59.
(*o*) *Hearson's Patent*, Griff. P. C. 310.
(*p*) *Chandler's Patent*, Griff. 273.
(*q*) *Pietschmann's Patent*, Griff. P. C. 307; overruling *re Codd*, ibid. 305.
(*r*) Patents Act, 1883, s. 18 (3).
(*s*) L. O. R. rule 1.
(*t*) *Chandler's Patent*, Griff. P. C. 273.
(*u*) L. O. R. rule 2.
(*v*) Ibid. 3.
(*w*) Ibid. 5.
(*x*) Ibid. 4.
(*y*) Ibid. 6.
(*z*) Ibid. 7.

opposition before the Comptroller, and who is, in the opinion of the Law Officer, a person entitled to be heard in opposition. (*a*) In *Bell's Application*, (*b*) the opponents urged that the amendment asked would make the invention the same as that already patented by two prior patents. Neither of these prior patents, however, belonged to the opponents, and Clarke, S.G., declined to admit the objection, holding that as to these prior patents those opponents were, under the circumstances, not persons entitled to be heard. Once, however, an opponent has a *locus standi* as a person entitled to oppose, he may rely upon specifications other than those in which he is personally interested. (*c*)

Hearing of the Appeal.—The appeal is by way of re-hearing, and except as to matters which have come to their knowledge since the decision appealed from, the parties are limited to the same evidence as was tendered below. (*d*) The Law Officer may, however, relax this rule, and admit further evidence on special application made to him for that purpose. In *Hampton & Facer*, (*e*) the decision of the Comptroller was adverse to the applicant for amendment on one point, in regard to which there was no evidence before the Comptroller; the applicant nevertheless accepted the decision *in toto*. The opponent, however, appealed, and thereupon the applicant applied to the Law Officer for leave to file further evidence upon the point on which the decision below had been given against him. Sir E. Clarke, S.G., in the circumstances, refused leave.

The Law Officer must, if either party so request, order the attendance at the hearing for cross-examination of any person who has made a declaration on the matter of the appeal, unless he is satisfied that no good ground for making such order exists. (*f*) Where either party desires the attendance of declarants for cross-examination, he should give notice of his request to the Law Officer's clerk, with a list of the witnesses to be examined. Copies of the notice and list should also be sent to the other side. Thereupon the parties attend before the Law Officer, who decides whether or not he will direct his clerk to issue summonses to the witnesses in question. (*g*) The person requiring the attendance of a witness so summoned must tender to such witness a reasonable sum for conduct money. (*h*)

(*a*) Patents Act, 1883, s. 18 (4).
(*b*) Griff. A. P. C. 12.
(*c*) *Stewart's Application*, 13 R. P. C. 628.
(*d*) L. O. R. rule 8.
(*e*) Griff. A. P. C. 14.
(*f*) L. O. R. rule 9.
(*g*) Griff. 319, n.
(*h*) L. O. R. rule 10.

Costs.—In allowing an amendment the Law Officer may impose conditions, (*i*) he may also order the payment of costs by either party, and such order may be made a rule of Court. (*j*) Costs are usually given against the unsuccessful party (*k*) but special circumstances may, in the opinion of the Law Officer, disentitle the successful party to costs. Thus, where an amendment allowed was a second disclaimer, (*l*) and where the applicant's specification had been loosely drawn, (*m*) no costs were given against the opponents.

Where costs are allowed, a lump sum is generally given. A sum of five, seven, ten, or even twenty guineas has been allowed by the Law Officer. (*n*)

Where the request for leave to amend is not opposed, or the opponent does not appear, the Comptroller may still refuse to allow the proposed amendment, or grant it subject to conditions. The Comptroller may always appear to support his own decision before the Law Officer; and if there is no opponent to argue the matter he will probably elect to do so. (*o*) As a general rule, costs will neither be given to nor against the Comptroller in such case. Very special circumstances may, however, cause this rule to be departed from. (*p*)

Where an applicant for amendment to whom leave has been refused by the Comptroller desires to obtain the decision of the Law Officer, he ought to appeal forthwith. Where, instead, the applicant made a second application to the Comptroller for leave to make the same amendments, and appealed on a second refusal, Sir R. E. Webster, A.G., although otherwise inclined to allow the amendments, refused to do so, in the absence of a satisfactory explanation of why the first refusal had not been appealed from. (*q*)

The fact that the application to amend is made late in the life of the patent is a circumstance adverse to the applicant, but not conclusive against leave being given. (*r*)

(*i*) Sect. 18 (4). As to these see post, p. 271.

(*j*) Patents Act, 1883, s. 38.

(*k*) *Re Haddan*, Griff. A. P. C. 13.

(*l*) Ibid.

(*m*) *Ashworth*, Griff. A. P. C. 9. See, also, *Allen*, Griff. A. P. C. 4.

(*n*) *Ainsworth's Patent*, 13 R. P. C. 78 (7 guineas); *Bell*, Griff. A. P. C. 11 (10 guineas); *Cochrane's Patent*, Griff. 305 (5 guineas); *Johnson's Patent*, 13 R. P. C. 664 (20 guineas, amongst three sets of opponents).

(*o*) Patents Act, 1883, s. 18 (7).

(*p*) *Lake*, Griff. A. P. C. 17.

(*q*) *Arnold's Patent*, Griff. A. P. C. 6. In this case ignorance of patent law and absence of knowledge that a right of appeal existed were held not to afford a satisfactory explanation of the omission to appeal at first.

(*r*) *Morgan's Patent*, Griff. A. P. C. 18.

In *Johnson's Patent*, (*s*) where the patent was ten years old, Sir R. E. Webster, A.G., said that this circumstance imposed on the applicant the duty of making out a very clear case, because the Law Officer had to be satisfied that the mistake sought to be corrected was an original mistake, and for this purpose had to try to put himself back in the position of the parties when the specification was originally filed.

Second disclaimers are viewed with disfavour; and where they have been allowed, costs have been refused. (*t*)

What Manner of Amendment is Permissible.—No amendment is permissible which makes the specification as amended claim an invention substantially larger than, or substantially different from, the invention claimed by the specification as it stood before amendment. (*u*) But, subject to this limitation, any amendment by way of disclaimer, correction, or explanation, either of the letterpress or drawings of a specification, may be allowed. (*v*) The amendment may even add drawings to the original specification. (*w*)

Discussing, in *Johnson's Patent*, the power of amendment conferred by Section 18 upon the Comptroller and Law Officer, Sir R. E. Webster, A.G., said: "On previous occasions, I have expressed my view that the words 'by way of disclaimer, correction, or explanation' were meant to refer to disclaiming something which was originally wrongly inserted, or to explaining something which requires explanation, having regard to the statement made in the first instance by the patentee. It must be remembered that the whole of this sub-section is subject to the words 'not substantially larger than, or substantially different from, the invention claimed' in sub-section 8 of Section 18. . . . A disclaimer is not to be used solely for the mere purpose of turning an insufficient description into a sufficient description. Of course, it is to be used for the purpose of turning an ambiguous specification into a clear specification; but not for the purpose of turning an insufficient description into a sufficient description, especially if the amendment introduces subsequent knowledge." (*x*)

Commenting on the same point in *Beck* v. *Justices'* (*y*) *Application*, the same learned Law Officer said: "My idea of the function of an explanation within Section 18, is to explain more clearly what is necessary to understand the meaning of the patentee at

(*s*) 13 R. P. C. 663.
(*t*) *Re Haddan*, Griff. A. P. C. 12.
(*u*) Patents Act, 1883, s. 18 (8).
(*v*) Ibid. s. 18 (1).
(*w*) *Lang's Patent*, 7 R. P. C. 471.
(*x*) 13 R. P. C. 660.
(*y*) Griff. A. P. C. 10.

the time he patented the invention. I do not think it is intended that he should put in subsequently-ascertained knowledge. I do not mean to lay down a hard-and-fast rule; but, speaking broadly, it was intended to permit a man to amend, correct, and explain the enunciation of his invention as he intended originally to give it."

Where the principle of an invention is amply described in the original specification, amendments merely by way of fuller description, so that the principle may be better understood, will not be allowed. A patentee is bound to describe his invention sufficiently when he files his complete specification; and, although defects appearing on the face of the specification may be amended by disclaimer, such defects must be defects consistent with the patentee intending to fulfil the conditions of the grant by properly describing his invention. (*z*)

In *Morgan's Case*, (*a*) an amendment was allowed which corrected the misdescription of a drawing by inserting a proper description, and adding to the claim the words, "substantially in the manner described."

Amendment was allowed where an applicant for a patent in respect of an invention communicated from abroad, had misdescribed the invention through misunderstanding the inventor's instructions. In this case the subject-matter was of a highly technical nature. (*b*)

An amendment which claims a different invention from that originally claimed, or which enlarges that invention, will not be allowed.

In *Lang's Patent*, (*c*) the specification originally claimed a method of making wire ropes so that the strands were laid up into the ropes the same way as the wires of the strand. The patentee (having discovered this method to be old) sought to amend so as to alter the claim to one for the application of this method to the construction of ropes by means of certain machinery. Leave was refused.

So, too, an amendment which seeks to introduce a larger term for one of narrower import, as, *e.g.* "manufacture" for "process," is inadmissible. (*d*)

In *Parkinson's Patent*, (*e*) the complete specification concluded with four claims. The fourth claim was new and useful, but the

(*z*) *Nordenfelt*, Griff. A. P. C. p. 21.
(*a*) Griff. A. P. C. 17.
(*b*) *Johnson*, 13 R. P. C. 662.
(*c*) 7 R. P. C. 471.
(*d*) *Vidal's Patent*, 15 R. P. C. 721.
(*e*) 13 R. P. C. 509, p. 513.

other three were held bad by the House of Lords. The patentee thereupon applied for leave to amend. The first three claims had claimed the combination of a sieve with side deposit surfaces tapering, or not tapering; by his proposed amendment, the patentee sought to claim the combination of the sieve and side deposit surfaces with the "other portions of the apparatus substantially in the manner hereinbefore described, so as practically to free the escaping air from particles of dust." The Law Officer refused to allow this amendment, as being, in fact, a claim for a new combination different from the naked claim in the first three claims of the original patent.

A useful test to ascertain whether or not a suggested amendment enlarges a patent, is to consider whether the proposed amendment, if allowed, will make that an infringement which would have not been one before. (*f*)

In *Moser* v. *Marsden*, where the patent was for improvements in gig mills employed in the finishing of woven fabrics, the patentee amended his claim by adding after the words, "by means of countershafts," the further words, "or any other driving motion." It was contended that this enlarged the claim and avoided the patent. On this Lord Watson said: "The alternative words so introduced occur in the original as well as in the amended claim, and, in both cases, they appear to me, when fairly construed, to have precisely the same import. I think that, in substance, they do nothing more than convey an intimation to the public having an interest in the matter, that the patentee does not claim as an essential part of the combination which he has invented, the source from which the motive-power is taken for actuating the rollers. In that view of their meaning, the words in question do not appear to me to amount to an expansion of the patent beyond the limits described, but constitute a legitimate qualification of the patentee's claim, by excluding from it a feature which he does not regard as essential." (*g*)

In *Heath & Frost's Patent*, (*h*) the invention was described as "an improved method of blasting and shot-firing in mines." The object of the patentees was to secure protection against accidental ignition without any reduction of the explosive force. The complete specification described the explosive as enclosed in two cases, an inner and an outer case, with water between the

(*f*) *Moser* v. *Marsden*, 10 R. P. C. 350; 13 R. P. C. 24.

(*g*) 13 R. P. C. 31.

(*h*) Griff. P. C. 310.

two. It stated that when the explosive was impervious to water (as, *e.g.*, dynamite would be), the inner case might be dispensed with. The patentees having found that a blasting cartridge with water surrounding the explosive was old, applied for leave to amend, by confining their invention "to a simple and cheap construction of water-tight cartridge." With this object, they proposed to strike out the whole of their specification except that part which related to the cartridge without the inner case. The amendment was disallowed, as claiming an invention substantially different from that disclosed by the original specification.

A patentee will not be allowed by amendment to set up a claim for a substantially different invention. Thus, a patentee who claims specific integers will not usually be allowed by amendment to turn his claim into one for a combination. If, however, it appears from the terms of the specification that the patentee had from the first present to his mind a claim for a combination, such amendment will be allowed.

Thus, in *Bateman & Moore's* (*i*) *Patent*, the specification appeared to have been framed upon the assumption that the patentees were entitled to claim separately the elements which composed their apparatus. The claim was divided into separate heads, under "first," "secondly," and "thirdly;" but Sir R. Bethel, S.G., being of opinion, from the body of the specification, that the patentees intended to claim their apparatus as a combination, allowed amendment to make the claim consistent therewith, by striking out "first," "secondly," and "thirdly," and substituting "or" for "secondly," and "and" for "thirdly." Otherwise he would not (he intimated) have allowed it.

Nor may a claim for a combination be turned by amendment into a claim for one only of the component integers. In *Serrell's Patent*, (*j*) the specification claimed a combination, and did not contain any claim for any minor arrangement thereunder. The patentee sought to amend by striking out the whole claim, and inserting instead a claim for a subordinate part only of the original combination; but Sir R. E. Webster, A.G., refused to allow such amendment.

A claim, however, for several independent integers may be amended so as to include only one of such integers. (*k*)

So likewise an amendment which cuts down a claim for all processes of attaining a given result to a claim for one specified

(*i*) Macr. P. C. 116.
(*j*) 6 R. P. C. 103.
(*k*) *Cochrane's Patent*, Griff. P. C. 304.

process only, is good, and does not set up a different invention. (*l*) But where a patentee has chosen to claim an improved method, apart from any particular means of giving effect to it, he will not be allowed by amendment to practically re-write his specification by inserting all the particular means, and possibly raising a doubt as to whether or not they might not be made the subject of a claim. (*m*)

Formerly, where it was doubtful whether the proposed amendment enlarged the original invention, or claimed a different invention, the Law Officer usually allowed the amendment, on the ground that it was taken at the patentee's peril, and (if granted in contravention of Section 18, sub-section 8) open to impeachment in subsequent legal proceedings. (*n*) Since the House of Lords have held, however, in *Moser* v. *Marsden*, (*o*) that the Law Officer's decision is conclusive as to the right to amend, and cannot be reviewed, it will, it would seem, be incumbent upon the Law Officer to adopt a different course, and determine every doubtful case one way or the other.

Imposing Conditions.—The Law Officer (*p*) and the Comptroller (*q*) may, in allowing an amendment, do so subject to conditions.

In the case of letters patent granted prior to the Patents Act of 1883, it was usual (*r*) to impose the condition that no action should be brought, or other proceedings taken, by the patentee in respect of infringements prior to the 1st of January, 1884, when that Act came into force. This condition was so imposed, because it seemed doubtful, in the case of such patents, whether Section 20 of the Patents Act, 1883, operated to protect infringers in respect of acts committed before January, 1884. (*s*) In the case of a patent granted since 1st January, 1884, this condition will not be imposed, unless there are very special circumstances, Section 20 being usually a sufficient protection to the public. (*t*)

What amounted to such special circumstances as would induce the Law Officer to impose the above condition beyond the 1st of January, 1884, in the case of a patent granted in 1878, was discussed in *Ashworth's Patent*. (*u*) The opponents in that case

(*l*) *Ashworth*, Griff. A. P. C. 6.
(*m*) *Nairn's Patent*, 8 R. P. C. 445.
(*n*) *Lake's Patent*, Griff. A. P. C. 16.
(*o*) 13 R. P. C. 24.
(*p*) Patents Act, 1883, s. 18 (4).
(*q*) *Hearson's Patent*, Griff. P. C. at 310.
(*r*) See *Hearson's Patent*, Griff. P. C. 309; *Cheeseborough's Patent*, Griff. P. C. 303.
(*s*) *Allen*, Griff. A. P. C. 3 (see Clarke, S.G. p. 5).
(*t*) Ibid.; *Ainsworth's Patent*, 13 R. P. C. 76, at 78.
(*u*) Griff. A. P. C. 6, at p. 9.

asserted before the Law Officer that since the matter had been before the Comptroller the patentees had been threatening an action, and argued that this was a special circumstance. On this Sir H. Davey, S.G., said: "If I saw, or if there was any evidence before me that the patent had been used for the purpose of endeavouring to obtain a monopoly larger than that which the specification as amended claims, I should consider that a special circumstance. If, for example, the patentees had been threatening persons, and endeavouring to prevent persons from making or selling wire hardened and tempered in a mode different from that which was claimed, I should consider that a special circumstance, and under those circumstances, as far as I am personally concerned, I should impose the condition that no action should be brought for anything done at any time before the amendment. But there is nothing of that kind here; and we can very well see that if on the one hand the patentee has got a patent which contains claims larger than he can support, and a patent which perhaps he is advised it would not be safe to go into Court upon without amendment, he may, for all that, have a very valuable and meritorious invention; and one would not have much sympathy for persons who were using his very meritorious invention, relying on the invalidity of the patent from some defect in the description, or from its containing claiming clauses which were larger than could be supported in Court. I, for one, should not have any sympathy with a person who had availed himself of those defects which the law has now allowed to be amended, and had infringed the real invention. If, on the other hand, they have not infringed the real invention, of course they have a good defence to the action, and they need not be afraid. It seems to me to be no reason why I should deprive the patentee of the right which he has, according to what is now the settled rule in these matters, of suing in respect of matters before the amendment, but after the 1st January, 1884, merely on the ground of the supposed hardship it would impose upon people who have not infringed the patent having to defend a patent action."

The law as to infringements prior to amendment and subsequent to the 1st of January, 1884, is now governed by Section 20 of the Patents Act, 1883, which enacts that—

"Where an amendment by way of disclaimer, correction, or explanation has been allowed under this Act, (*v*) no damages shall be given in

(*v*) Patents Act, 1883, s. 20.

any action in respect of the use of the invention before the disclaimer, correction, or explanation, unless the patentee establishes to the satisfaction of the Court that his original claim was framed in good faith and with reasonable skill and knowledge. (*w*)

In granting leave to amend by way of disclaimer the Law Officer will not generally impose special terms in an opponent's interest. But a case for doing so may occur. If, for example, the defect sought to be remedied by amendment had formed the subject of discussion between the opponent and patentee at an early date in the life of the patent, and the owner by abstaining from taking proceedings had apparently acquiesced in the view that the patent was bad, and thereby induced the opponent to create a business it was subsequently sought to attack should the amendment be granted, leave might properly be refused altogether or very special conditions imposed. (*x*)

A condition that the opponent should have leave to work the patented invention would, however, hardly be imposed in any case. (*y*)

Leave to amend under Section 18 when given is conclusive as to the right to amend (except in case of fraud), and the amendment is deemed in all courts and for all purposes to form part of the specification. (*z*) But inasmuch as the authority of the Comptroller and of the Law Officer to sanction amendments is by sub-section 8 limited to such amendments as will not make the amended specification claim an invention substantially larger than, or different from, the invention claimed before, it might seem that an amendment permitted by these authorities might still be called in question in subsequent legal proceedings if it enlarged or substantially altered the original invention.

That such an amendment might be so questioned was held by the Court of Appeal in *Van Gelder's Patent.* (*a*) But this case must now be considered to be overruled, for the House of Lords in the more recent case of *Moser* v. *Marsden* (*b*) have held that once an amendment has been allowed it is not open to the Court to entertain an objection to it, as enlarging the original claim. "In my opinion," said Lord Watson in that case, (*c*) "the very

(*w*) See *Wenham* v. *Carpenter*, 5 R. P. C. 68; *Hopkinson* v. *St. James's Electric Light Co.*, 10 R. P. C. 62.

(*x*) *Allison's Patent*, 15 R. P. C. 408.

(*y*) Ibid. per Finlay, S.G.

(*z*) Sect. 18 (9).

(*a*) 6 R. P. C. 22. As to this being the rule prior to the Patents Act, 1883, see Bowen, L.J., in above case; also Lord Blackburn in *Dudgeon* v. *Thomson*, L. R. 3 App. Ca. 34; and Bethel, A.G., in *Bateman & Moore's Patent*, Macr. P. C. 116.

(*b*) 13 R. P. C. 24.

(*c*) At p. 31.

object of the Act of 1883 was to make an amended claim, when admitted by the proper authorities, a complete substitute, to all effects and purposes, for the claim originally lodged by the patentee. The validity of the amended claim must therefore be determined in the same way, and on the same footing, as if it had formed part of the original specification; and the claim, as it stood before amendment, cannot be competently referred to, except as an aid to the construction of its language after amendment."

Where an amendment is allowed the Comptroller may require the applicant to leave at the Patent Office, within a time limited by him, a new specification and drawings as amended. (*d*).

Every amendment of a specification is required to be advertised in the prescribed manner. (*e*)

The Law Officer is not a Court, and prohibition will not lie to him, to restrain him from allowing an amendment. (*f*)

A patentee who has obtained an English patent under the International Convention is in no better position as regards amendment of his specification than an ordinary British patentee, and can claim no larger privilege. (*g*)

3. *Amendment of a Specification when an Action for Infringement or a Proceeding for the Revocation of the Patent is Pending.*

This right of amendment, given by Section 19 of the Patents Act, 1883, is not so extensive as that authorized by Section 18, which has just been considered. Here it is a right of amendment by way of disclaimer only, (*h*) and corrections and explanations are not allowed except in so far as they may be required for the purpose of defining the disclaimer. (*i*)

But disclaimer is still disclaimer, even if ninety-nine hundredths of the original patent is discarded, provided nothing new is introduced. (*j*)

Section 19, as amended by Section 5 of the Patents Act, 1888, provides as follows :—

"In an action for infringement of a patent, and in a proceeding for revocation of a patent, the Court or a judge may at any time order that

(*d*) P. R. rule 57.
(*e*) Patents Act, 1883, s. 21.
(*f*) *Van Gelder's Patent*, 6 R. P. C. 22.
(*g*) *Vidal's Patent*, 15 R. P. C. 721.
(*h*) *Armstrong's Patent*, 14 R. P. C. 747.
(*i*) *Owen's Patent*, 15 R. P. C. 755; [1899] 1 Ch. 157; 68 L. J. Ch. 63; 79 L. T. 458; 47 W. R. 180.
(*j*) *Dellwick's Patent*, 15 R. P. C. 682; [1896] 2 Ch. 705.

the patentee shall, subject to such terms as to costs and otherwise as the Court or a judge may impose, be at liberty to apply at the Patent Office for leave to amend his specification by way of disclaimer, and may direct that in the meantime the trial or hearing of the action shall be postponed."

Commenting on this section, and its relation to the prior section dealing with amendments generally, Lindley, L.J., in *Bray* v. *Gardner*, (*k*) said: "Litigation as to a patent altogether stops the application of Section 18. Then comes Section 19, which is in the nature of a proviso to Section 18, sub-section 10, and it says that if litigation is going on the Court may grant the patentee liberty to apply at the Patent Office for leave to amend, upon such terms as to costs and otherwise as the Court may impose. That is a great boon to patentees, because as regards everybody except the defendant in the particular action, the patentee is at liberty to amend his patent, and to obtain all advantages to which that amendment may entitle him. Then it is the judge's duty to see that, while granting that benefit to the patentee, he does no injustice to the defendant. As I said before, the method of preventing injustice to the defendant would be different in different cases."

This section only applies where an action or a proceeding for the revocation of a patent is pending. If an action is concluded, or has been discontinued, no leave under this section is necessary. (*l*) Nor does the section apply where an appeal is pending in an infringement action; (*m*) in such case also an amendment may be sought in the ordinary way under Section 18. Where an amendment has been allowed by the Comptroller without leave, in a case where it is doubtful if leave was not required, the Court has refused subsequently to go behind the Comptroller's decision. (*n*)

The judge has a complete discretion to grant or refuse the leave. (*o*) Where the application for leave is one of real substance, leave ought to be given, otherwise the patentee may be placed in a position of great hardship, whereas the hardship to the defendant in the action can be remedied by the terms which the judge has power to impose. It is not for the Court to try the question of the amendment; that duty the Legislature has imposed

(*k*) L. R. 34 C. D. 673; 4 R. P. C. 44; 56 L. J. Ch. 500.

(*l*) *Cropper* v. *Smith*, 1 R. P. C. 254; 28 C. D. 148; 54 L. J. Ch. 287: *Bell*, Griff. A. P. C. 10.

(*m*) *Cropper* v. *Smith*, supra.

(*n*) *Farbenfabriken* v. *Bowker*, 8 R. P. C. 389.

(*o*) *Lang* v. *Whitecross Wire Co.*, 7 R. P. C p. 392; per Lord Halsbury, C.

on a special tribunal, the Comptroller and the Law Officer. At the same time, if the proposed amendment is clearly of a trumpery nature, or such as in any case would not avail to make the patent good, the judge ought, in the exercise of his discretion, to refuse the leave asked. (*p*)

As a rule, the Court of Appeal will not interfere to vary or reverse the judge's order, once his discretion has been exercised, unless it sees clearly that the discretion has been exercised on a wrong principle, or some miscarriage of justice is occasioned thereby. (*q*)

In granting leave the judge may impose terms as to "costs and otherwise." These words "costs and otherwise" are of the widest description, and give an ample discretion to the judge to impose whatever terms he thinks fit. (*r*)

The Court will, as a general rule, impose the condition that the amended specification shall not be receivable in evidence in the action. But this is only a general rule, and may properly be departed from in special circumstances. (*s*) "By applying to amend the specification under ordinary circumstances," said Cotton, L.J., in *Bray* v. *Gardner*, (*t*) "the patentee admits that the specification, for some reason or other, either by reason of its claiming too much, or not sufficiently describing the invention, does not comply with the conditions imposed on a person taking out letters patent, and that, if the action went on without the amendment, there would be a defence open to the defendant in the particular action, on the ground that at the time the action was brought there was no valid patent. In my opinion it would be wrong, the matter being within the discretion of the Court, to allow a plaintiff, by amending a specification, to get all the advantages of that amendment, as against the defendant in the action. It would be giving him, after he had originally come to the Court with a patent which could not be relied on, power to put himself in a different position as against the defendant. Even if the consequence of amendment may be that the patentee is entitled to maintain his action in respect of previous acts which are infringements of the patent as amended, in my opinion discretion is given to the Court to say, 'You may amend if you

(*p*) *Dellwick's Patent*, [1896] 2 Ch. 705; 13 R. P. C. 591; *Armstrong's Patent*, 14 R. P. C. 747; 77 L. T. (N. S.), 267.

(*q*) *Armstrong's Patent*, 14 R. P. C. 747.

(*r*) *Lang* v. *Whitecross*, 7 R. P. C. 392.

(*s*) *Goulard* v. *Lindsay*, L. R. 38 C. D. 38; *Bray* v. *Gardner*, L. R. 34 C. D. 668; *Singer* v. *Stassen*, 1 R. P. C. 121; *Allen* v. *Doulton*, 4 R. P. C. 377; *Fusee Vesta Co.* v. *Bryant & May*, 4 R. P. C. 71; *Haslam Co.* v. *Goodfellow*, 5 R. P. C. 28; 37 C. D. 118.

(*t*) Supra.

like, pending this action, but one of the terms will be that you shall not give the amended specification in evidence, to enable you to sue on a patent which, at the time when you commenced your action you could not sue on at all.'"

Terms will also generally be imposed as to damages in respect of infringements prior to the amendment. In *Lang* v. *Whitecross Company*, (*u*) terms were imposed that no damages should be recovered in respect of past acts of infringement, and no claim made for an injunction founded on such acts. (*v*) The House of Lords, on appeal, held that the judge had rightly exercised his discretion. Lord Halsbury, C., said: "I think the learned judge meant what I should mean if I were to say, 'I think that, as a rule, a man ought not to be allowed to recover damages in respect of a past infringement, when at the date of that infringement, or alleged infringement, the specification was in such a form that he could not by law have maintained an action against the alleged infringer for doing the act,' because otherwise the result might be that an act which was lawful at the time, and not an infringement, would become, *ex post facto*, by reason of subsequent proceedings, unlawful, and an infringement, and would make the man who committed it liable for damages for which he would not have been liable at the time."

In exceptional circumstances, however, the above terms might properly be departed from. "If, however," said the learned Lord Chancellor in the foregoing case, "under the particular circumstances of the particular case the proceedings of the alleged infringer were obviously *malâ fide*, and the proceedings of the patentee obviously *bonâ fide*, and the specification, in the language of the Statute, (*w*) had been framed with reasonable diligence and skill, then the *malâ fide* intention of the infringer might well be punished by damages, and the person who had acted *bonâ fide* ought not to suffer." (*x*)

In addition to the power given to the judge to impose terms as to damages, Section 20 of the Patents Act, 1883, provides—

"Where an amendment by way of disclaimer, correction, or explanation, has been allowed under this Act, no damages shall be given in any action in respect of the use of the invention before the disclaimer, correction, or explanation, unless the patentee establishes, to the satisfaction

(*u*) 7 R. P. C. 393.

(*v*) See, also, *Codd* v. *Bratby*, 1 R. P. C. 209; *Gaulard* v. *Lindsay*, 5 R. P. C. 192; 38 C. D. 38.

(*w*) Patents Act, 1883, s. 20.

(*x*) 7 R. P. C. 393.

of the Court, that his original claim was framed in good faith, and with reasonable skill and knowledge." *(y)*

Terms will also be imposed as to costs. Here the general rule is to require the patentee to pay the costs incurred by the application for leave to apply for an amendment, and the costs of the action up to the date when such leave was given. *(z)*

Where the application for leave was made at a late stage of the trial of the action, Smith, L.J., *(a)* notwithstanding that the disclaimer allowed had cured the defect in the patent, gave judgment in the action for the defendants with costs, and the Court of Appeal held that this order was right, but that liberty might properly have been reserved to the plaintiffs to bring another action for an injunction if so advised.

Where leave to apply for amendment is given pending an action, and no terms are imposed, the defendant's proper course is to appeal against the order so made, and not rely instead upon being able to induce the Law Officer to impose conditions when the amendment is in fact allowed. *(b)*

The application for leave to apply for amendment pending an action may be made by summons at Chambers, *(c)* or by motion or in court when the case is being heard. The judge in granting leave has power to postpone the hearing of the action till the patentee's application to amend has been heard and determined. *(d)*

Where a request for leave to amend is made by or in pursuance of an order of the Court or a judge, an official or verified copy of the order must be left at the Patent Office with the request. *(e)*

Once leave to apply for amendment has been obtained, the procedure provided under Section 18, and already set forth, applies as far as possible. *(f)*

Where two actions of infringement are pending, the Comptroller is not entitled to refuse an amendment because liberty to apply has not been obtained in both. *(g)*

Where leave is obtained to amend a specification, the amendment takes effect from the time leave is given, where nothing further remains to be done by the patentee. The circumstance

(*y*) See *Wenham* v. *Carpenter*, 5 R. P. C. 68; also *Hopkinson* v. *St. James's, etc., Electric Light Co.*, 10 R. P. C. p. 62.

(*z*) *Codd* v. *Bratby*, 1 R. P. C. 209; *Gaulard* v. *Lindsay*, 5 R. P. C. 192; L. R. 38 C. D. 38; 57 L. J. Ch. 687; *Meyer* v. *Sherwood*, 7 R. P. C. 283.

(*a*) *Meyer* v. *Sherwood*, supra.

(*b*) *Hearson's Patent*, Griff. P. C. 309.

(*c*) *Singer* v. *Stassen*, 1 R. P. C. 121.

(*d*) Patents Act, 1883, s. 19.

(*e*) P. R. rule 58.

(*f*) *Re Hall*, 5 R. P. C. 312; 21 Q. B. D. 137 (per Cave, J.).

(*g*) *Re Hall*, 5 R. P. C. 307; 21 Q. B. D. 137.

that his assent in a written form to conditions imposed is not given to the Patent Office authorities and the amendment not in fact entered in the Register until some time after leave is given, does not affect the time at which the amendment comes into force, if the terms were settled and the conditions assented to by the applicant when leave was given.

In *Andrew & Company* v. *Crossley*, (*h*) the patentees obtained leave to amend, consenting to certain conditions on the 9th of June. On the 11th they started an action against certain infringers. The written assent usually required by the Patent Office to the conditions imposed on the patentee was not given until the 9th of July, and the amendment not formally recorded till the 26th of August. On these facts, the defendants contended that the amended specification was not admissible as evidence in the action, the amendment having been obtained, they alleged, without leave of the Court, when an action of infringement was pending. The Court of Appeal, however, rejected this contention, holding that the action for infringement had been commenced after the amendment was in fact complete.

(*h*) 9 R. P. C. 165; [1892] 1 Ch. 492; 61 L. J. Ch. 437.

CHAPTER XIV.

PROCEDURE ON APPLICATIONS FOR LETTERS PATENT FOR INVENTIONS.

Application, how Made.—An application for letters patent for an invention must be made on the prescribed form, and left at, or sent by post to the Patent Office. (*a*) If sent through the post, the application must be sent by prepaid letter, and is deemed to have been made at the time when the letter containing it would have been delivered in ordinary course of post. (*b*)

Any person, whether a British subject or not, may apply for letters patent. (*c*) Two or more persons may apply jointly, and have a joint grant made to them. (*d*) Where a joint application is made it is sufficient if one of the applicants is the first and true inventor. (*e*) The forms prescribed by the Patents Rules, 1890, contemplate three classes of applicants: (1) The usual case of an application by an inventor for a patent for an invention discovered in the United Kingdom or the Isle of Man. (2) An application by an importer in respect of an invention communicated from abroad. (3) An application for a patent under International and Colonial arrangements. (*f*) These forms are, however, directory only, and intended as guides, and may be varied to suit cases they do not expressly provide for. In *Grenfell & McEvoy's Patent*, (*g*) Webster, A.G., said: "I think it desirable to point out that in my opinion these forms were not intended to be absolutely the only forms which were to be used, nor were they intended to deal in terms by specific directions with every particular case. It is of course intended that the applications and

(*a*) Patents Act, 1883, s. 5 (1); P. R. rule 6. See Circular of Information, Appendix III. post.

(*b*) P. R. rule 16A. It is sufficient proof of the making of the application to prove that the letter was properly addressed and put in the post.

(*c*) Patents Act, 1883, s. 4 (1). As to the case of persons suffering from disability by reason of infancy, lunacy, etc., see s. 99.

(*d*) Ibid. s. 4 (2).

(*e*) Sect. 5.

(*f*) See Forms A, A^1, A^2, Appendix II.

(*g*) 7 R. P. C. 151. This dictum referred to the Forms of 1883, but is equally applicable to the present Forms.

the various steps shall be in accordance with the prescribed forms; but if from time to time a case arises which was not contemplated at the time the Act was passed, or the rules framed, I do not think that the Statute would fail in its operation because a form had to be slightly modified."

Formerly, if an inventor died before obtaining a patent for his invention, no patent could be granted in respect of it. (*h*) Now, however, in such case an application may be made by, and a patent granted to, his legal representative. (*i*) But such legal representative must lodge his application within six months of the decease of the inventor whom he represents.

The application must be signed by the applicant. (*j*) If there are several applicants each must sign. (*k*)

Employment of an Agent.—All other communications between the applicant and the Comptroller, and all attendances by the applicant upon the Comptroller, may be made by or through an agent duly authorized to the satisfaction of the Comptroller. (*l*) It is not necessary that the agent should be a Patent Agent, but the Comptroller may require the agent to be resident in the United Kingdom. (*m*) An agent may be authorized to act for the inventor at any time during the proceedings for obtaining the patent. The official forms provide for the authorization of an agent by endorsement on the back of the form, such endorsement being signed by the applicant or applicants as the case may be.

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

In the case of an application by the legal representative of a deceased person, such legal representative must make a declaration that he believes such deceased person to be the true and first inventor of the invention. (*o*)

The application must also in such case be accompanied by an official copy of, or extract from, the will of the deceased inventor, or the letters of administration granted of his estate and effects,

(*h*) *Marsden* v. *Saville Foundry Co.*, L. R. 3 Ex. D. 203.

(*i*) Patents Act, 1883, s. 34 (1).

(*j*) P. R. 1898, rule 2.

(*k*) *Grenfell & McEvoy's Patent*, 7 R. P. C. 151.

(*l*) *Graham* v. *Fanta*, 9 R. P. C. 164; *Jackson* v. *Napper*, 35 C. O. 162.

(*m*) P. R. 1898, rule 2.

(*n*) Patents Act, 1883, s. 5 (2).

(*o*) Ibid. s. 34 (2).

in proof of the title of the legal representative. The Comptroller may require other evidence thereof in addition. (*q*)

The Specifications.—The application must be accompanied either by a provisional or complete specification. (*r*) A provisional specification must describe the nature of the invention, and be accompanied by drawings if required. (*s*)

If an applicant desires to develop his invention, and have further time in which to perfect it and consider what matters he will make the subject of his claim, a provisional specification only will be transmitted by him with his application. (*t*) If, on the other hand, he is satisfied that his invention is already complete, and desires to obtain a patent in respect of it without delay, he will leave a complete specification with his application.

A complete specification must particularly describe and ascertain the nature of the invention, and in what manner it is to be performed. (*u*) This specification may also be accompanied by drawings. If drawings have been left with the provisional specification, it is not necessary to deliver other drawings with the complete; references therein to those already sent being in such case sufficient. (*v*)

Application to be for one Invention only.—An application must be made in respect of one invention only. (*w*)

If, however, the Comptroller inadvertently allows a patent to be sealed which includes more than one invention, no person can, in any action or other proceeding, take exception to such patent on that ground. (*x*)

Where the Comptroller takes exception to an application as including more than one invention, the applicant has the option of amending his application by severing his inventions, and may obtain for each a separate patent of the date of the original application. (*y*) No express provision has been enacted giving the applicant a right of appeal from the decision of the Comptroller

(*q*) P. R. rule 20.

(*r*) Patents Act, 1883, s. 5 (2).

(*s*) Ibid. s. 5 (3). As to the form of a provisional specification, see P. R. rule 6 (2) and Form B, Appendix II. post.

(*t*) Under the protection afforded by a provisional specification the applicant may use and publish his invention without prejudice to his right to a patent in respect thereof. See Patents Act, 1883, s. 14.

(*u*) Sect. 5 (4). For form of complete specification, see P. R. rule 6 (2) and Form C, Appendix II. post. Examples of specifications are given in Appendix IV.

(*v*) Patents Act, 1886, s. 2; P. R. rule 33.

(*w*) Patents Act, 1883, s. 33.

(*x*) Ibid.

(*y*) P. R. rule 19.

on this point; but, in fact, such appeals have been heard by the law officers. (*z*)

In *Jones' Patent*, Herschell, S.G., said: "It seems to me that the general object of the invention is the test by which the question of one invention must be decided. If you have a particular general object of an invention to make rails rest more securely, and you describe one or two or three devices of an analogous nature, cognate devices for carrying it into effect, I should say they were all one invention; but if there is no common purpose, so that you could say, 'I use this as a substitute for that,' both serving the same purpose, although there is some difference between them, but they are to serve some different purpose, there is no connection between them except that both are used in connection with rails, it strikes me, that would be two inventions. I should always allow alternative devices for producing a particular object as one invention. But, if you say I have invented six different kinds of railway-sleepers, each of which has its own merits and purposes and objects distinct, then those are six inventions." (*a*)

In *Hearson's Patent*, (*b*) the invention was described as "Improvements in apparatus for rapidly heating flowing water, *a part of which improvements is applicable to other purposes*." The provisional specification described an apparatus consisting of several parts, including improved mechanism by which the turning of the taps of a geyser otherwise than in the required order was prevented. At the end of the specification the applicant stated: "The arrangement hereinbefore described for locking water and gas cocks is applicable to oxy-hydrogen light apparatus, and to other apparatus in which two cocks, or a number of cocks, are required to be turned in a certain order."

The Comptroller having held that the application carried more than one invention, Davey, S.G., dismissed the applicant's appeal. "I think the applicant has invented, first, an improved cock, or arrangement of cocks, which he describes as applicable, not only to geysers and the particular apparatus described by him, but also to other apparatus; second, an apparatus for an improved geyser, consisting of a combination of several parts, of which one is his new and improved arrangement of cocks. Under these circumstances, I think that, in order to comply with Section 33, the applicant must omit the last paragraph of his provisional

(*z*) The Comptroller may in cases of difficulty apply to the Law Officer for directions. See Patents Act, 1883, s. 95.

(*a*) *Jones' Patent*, Griff. P. C. p. 265.
(*b*) Griff. P. C. 266.

specification and the corresponding words in his title. If he desires it, he may make a separate contemporary application for his new and improved cock, or arrangement of cocks, by itself. He may also, of course, describe the cock, or arrangement of cocks, as part of his combination or apparatus which he also claims to have invented; but he should, I think, in doing so, refer to his contemporary application, if he desires to make one."

In *Robinson's Patent*, (*c*) the applicant described his invention as being for "improvements in the art of producing and utilizing induced electrical currents for telegraphy and other purposes." The invention consisted of the employment of a certain appliance in telegraphic transmitting and receiving instruments. The Comptroller objected that the applicant was seeking to patent more than one invention, and required him to confine his application to the use of this appliance for telegraphic purposes; and make its general use the subject of a separate application if he so desired.

In affirming this decision, Herschell, S.G., said: "It is a question for you whether it answers your purpose better to protect 'the appliance' for all purposes, or to protect improved telegraphic apparatus which consists in the employment of 'the appliance' therein. I will allow either of those, but it is for you to say which will be the most to your advantage."

Address of Applicant.—The application must be accompanied by an address of the applicant, to which all notices, requisitions, and communications of every kind may be sent by the Comptroller. In particular cases the Comptroller may require an address in the United Kingdom to be given. (*d*)

Form of Document.—All documents, and copies of documents, except statutory declarations and affidavits, sent to, or left at, the Patent Office, or otherwise furnished to the Comptroller or the Board of Trade, must be written or printed in large and legible characters, and (unless otherwise directed) in the English language, upon strong, wide, ruled paper (on one side only), of a size of thirteen inches by eight inches, leaving a margin of two inches on the left-hand part thereof, and the signature of the applicants or agents thereto must be written in a large and legible hand. (*e*)

The Comptroller may require duplicates to be left. (*f*) In the case of specifications and drawings, duplicates are usually required.

(*c*) Griff. P. C. 267.

(*d*) P. R. rule 9. The address so given is binding on the applicant until he furnishes a substituted address.

(*e*) P. R. rule 10.

(*f*) Ibid.

Drawings.—Drawings are not necessary if the specification sufficiently describes the invention without them. (*g*)

Where the applicant has recourse to drawings to illustrate his description of his invention, these must not appear in the specification itself if they will require a special engraving for letterpress. (*h*)

Drawings must be made on white, hot-pressed, rolled or calendered drawing-paper, of smooth surface and good quality, and, where possible, without colour or Indian ink washes. (*i*) To ensure their satisfactory reproduction, the drawings must be executed with absolutely black Indian ink, the same strength and colour of fine and shade lines to be maintained throughout. Section lines and lines for effect, or shading lines, must be closely drawn. Reference figures and letters must be bold and distinct and not less than one-eighth of an inch in height; and the same letters should be used in different views of the same parts.

If the drawings are of a complicated nature the reference letters must be shewn outside the figure, and connected with the part referred to by a fine line.

When the scale is shewn on the drawing, it should be denoted, not by words, but by a drawn scale.

No written description of the invention should appear on the drawings.

Wood engravings, or representations of the invention, other than the drawings prepared as above described, will not be received, unless of such a character as to be suitable for reproduction by the process of photo-lithography.

The paper used for drawings must conform to one or other of the following sizes, thirteen inches at the sides by eight inches at the top and bottom, or thirteen inches at the sides by sixteen inches at the top and bottom, including margin, which must be half an inch wide.

If there are more figures than can be shewn on one of the smaller-sized sheets, two or more of these sheets should be used in preference to employing the larger size. When an exceptionally large drawing is required it should be continued on subsequent sheets. There is no limit to the number of sheets that may be sent in.

Drawings must bear the name of the applicant in the left-hand top corner, and the signature of the applicant, or his agent, in the

(*g*) P. R. rule 30.
(*h*) Ibid.
(*i*) P. R. rule 31. See this rule for the provisions regulating drawings which are here set out.

right-hand bottom corner. The number of sheets of drawings sent, and the number of each sheet, should appear in the right-hand top corner.

Where a provisional specification is left in the first instance, and the drawings are delivered with the complete specification, the number and year of the application must also be inscribed in the left-hand top corner.

Drawings must be delivered at the Patent Office either in a flat state or on rollers, to prevent folds, breaks, or creases.

Every drawing must be accompanied by a *fac simile* thereof (but without colour or Indian ink washes), marked "true copy." (*j*)

Reference to an Examiner.—An application for letters patent is on receipt referred by the Comptroller to an examiner, for consideration and report on the following points. (1) Whether the applicant has fairly described the nature of the invention. (2) Whether the specification and drawings (if any) have been prepared in the prescribed manner; and (3) whether the title sufficiently indicates the subject-matter. (*k*)

If the report is adverse, the Comptroller may refuse to accept the application, or require amendment before he proceeds. If he requires amendment, he may direct the application to bear date from the time when the required amendment is complied with. (*l*)

Before exercising his discretion adversely to the applicant the Comptroller must give at least ten days' notice to the applicant of a time when he may be heard, either personally or by his agent. (*m*) The applicant has a period of at least five days within which to notify the Comptroller whether he intends to be heard. This notification must be made in writing. The time allowed runs from the date when the Comptroller's notice would have been delivered in the ordinary course of post. (*n*)

Whether the applicant intends to be heard or not the Comptroller may, in any case, require him to submit a statement in writing within a specified time, or to attend before him and orally explain such matters as the Comptroller may require. (*o*)

The Comptroller will no doubt usually act on the examiner's report, but he is not bound by it, and not only may, but ought to, exercise his own judgment in the matter. (*p*)

Applicant's Appeal to the Law Officer.—Where the Comptroller

(*j*) P. R. rule 32.
(*k*) Patents Act, 1883, s. 6.
(*l*) Patent Act, 1888, s. 7 (1).
(*m*) P. R. rule 11.
(*n*) P. R. rule 12.
(*o*) Ibid. 13.
(*p*) *C.'s Application*, 7 R. P. C. 250.

refuses to accept an application, or requires an amendment, the applicant may appeal from his decision to the Law Officer. (*q*).

The Law Officer must, if required, hear the applicant and the Comptroller. The decision of the Law Officer as to whether or not the application shall be accepted, and on what terms, is final. (*r*)

Time for Delivering the Complete Specification.—If (as will generally be the case) the applicant does not leave a complete specification at the time of making his application, he has a period of nine months within which to do so. (*s*) In computing the time months mean calendar months, (*t*) and the day of application should be excluded. (*u*)

The Comptroller may extend the time for a period not exceeding one month, on payment of an extension fee of £2. An application for enlargement of time for leaving a complete specification must state in detail in what circumstances, and upon what grounds, such extension is applied for. The Comptroller may require the applicant to substantiate the allegations on which he asks for enlarged time. (*v*)

If no complete specification is left within the prescribed time or such further time (not exceeding one month) as the Comptroller may allow by way of enlargement, the application is deemed to be abandoned. (*w*) As the provisional specification is not published in such case, (*x*) the applicant does not by abandonment lose his right to subsequently lodge another application for the same invention. Acts of experiment or user performed under the provisional protection of an application afterwards abandoned do not amount to a dedication of the invention to the public. (*y*)

Conformity of the Specifications.—Where the applicant leaves a provisional specification only with his application and sends in a complete specification (*z*) afterwards, both specifications are

(*q*) Patent Act, 1888, s. 7 (2).
(*r*) Ibid. s. 7 (3).
(*s*) Patents Act, 1883, s. 8 (1).
(*t*) 13 & 14 Vict. c. 21, s. 4.
(*u*) *Russell* v. *Ledsam*, 14 M. & W. 582; *Williams* v. *Nash*, 28 Beav. 93; 5 Jur. (N. S.) 696.
(*v*) Patents Act, 1885, s. 3; P. R. rule 50. The Comptroller has a general power to enlarge the periods of time prescribed by the *Patent Rules*, if he sees fit. See P. R. rule 51.
(*w*) Patents Act, 1883, s. 8 (2).
(*x*) Patent Act, 1885, s. 4.
(*y*) Patents Act, 1883, s. 14. See, also, *Lister* v. *Norton*, 3 R. P. C. 199.
(*z*) Where more than one person joins in an application, though each must sign the application, it is not necessary that all should sign the complete specification: *Grenfell & McEvoy's Patent* (7 R. P. C. p. 152). But it must be signed on behalf of all; and where joint applicants quarrelled after applying for a patent and claimed the right to deliver different complete specifications, the Comptroller was held to have acted properly in refusing to accept them: see *Apostoloff's Application*, 13 R. P. C. 275.

referred by the Comptroller to an examiner to report whether the complete specification has been prepared in the prescribed manner, and whether the invention particularly described in the complete specification is substantially the same as that described in the provisional specification.(*a*)

If the examiner's report(*b*) is adverse the Comptroller may refuse to accept the complete specification, unless and until the same shall have been amended to his satisfaction.(*c*) But from such refusal an appeal lies to the Law Officer, who will if required hear the applicant and the Comptroller, and decide whether, and subject to what conditions, if any, the complete specification shall be accepted.(*d*)

Acceptance of the Complete Specification.—A period of twelve months is allowed from the date of the application for the acceptance of the complete specification, thereafter, if the specification is not accepted, the application becomes void. But this limit does not apply where an appeal is lodged against a refusal of the Comptroller.(*e*) The Comptroller may extend the time to any further period not exceeding three months(*f*) on payment of the requisite enlargement fee.(*g*)

When a complete specification has been accepted, the acceptance is advertised by the Comptroller in the *Illustrated Official Journal*, and the application, specifications, and drawings (if any) are then open to public inspection.(*h*)

Sealing the Patent.—If no notice of opposition is given,(*i*) the Comptroller causes the patent to be sealed with the seal of the Patent Office, which now has the same effect for this purpose as the Great Seal of the United Kingdom formerly had.(*j*)

The patent must be sealed not later than fifteen months after the date of application, unless such sealing is delayed by an appeal to the Law Officer, or by opposition, or through the death of the applicant.(*k*) In the last-mentioned case a period of twelve months after the death of the applicant is allowed within which the patent may be sealed to his legal representative.(*l*)

(*a*) Patents Act, 1883, s. 9 (1).

(*b*) Reports of Examiners are not published nor open to public inspection. Ibid. s. 9 (5).

(*c*) Patents Act, 1883, s. 9 (2).

(*d*) Ibid. s. 9 (2) (3).

(*e*) Ibid. s. 9 (4).

(*f*) Patent Act, 1888, s. 3.

(*g*) The scale of enlargement fees is as follows: £2 for one month, £4 for two, and £6 for three months. See P. R. 1892, schedule. As to applicant stating grounds for enlargement of time, see P. R. rule 50, and ante, p. 287.

(*h*) Patents Act, 1883, s. 10; P. R rules 21, 22.

(*i*) As to oppositions, see post, p. 290.

(*j*) Patents Act, 1883, s. 12 (1)(2).

(*k*) Ibid. s. 12 (3).

(*l*) Ibid. These grounds of exemp-

Where the Comptroller has enlarged the time allowed for leaving the specifications, a further period of four months is allowed for sealing the patent. (*m*)

Every patent is now dated as of the day of application. (*n*) Where, therefore, two applicants make separate applications in respect of the same invention, the later applicant can gain no advantage by getting his patent sealed first, for a patent afterwards sealed to the earlier applicant will take priority over and defeat the patent already obtained by the second applicant; and the fact that one patent has already been sealed in respect of an invention does not prevent the later sealing of a second patent for the same invention to an earlier applicant. (*o*)

Although the patent dates back to the day of application, no proceedings may be taken by the grantee in respect of an infringement committed before the publication of the complete specification. (*p*)

The Comptroller may refuse to seal a patent for an invention of which the use would, in his opinion, be contrary to law or morality. (*q*)

An applicant who has only obtained provisional protection is not entitled to use the word "patent" in connection with his invention, (*r*) though he may perhaps be entitled to do so after the acceptance of his complete specification. (*s*) The use of the word "patent" does not seem to be inadmissible where the patent has expired, (*t*) unless it is so used as to suggest that a subsisting patent is in existence. (*u*)

International Applications.—International and Colonial applications, in so far as they are governed by special procedure, are dealt with in a separate chapter. (*v*)

tion are strictly construed. There is no power to excuse delay due to mere inadvertence: *A. & B.'s Application*, 13 R. P. C. 63.

(*m*) Patent Act, 1885, s. 3.

(*n*) Patents Act, 1883, s. 13.

(*o*) Ibid.

(*p*) Ibid.

(*q*) Patents Act, 1883, s. 86.

(*r*) Ibid. s. 105; *R.* v. *Wallis*, 3 R. P. C. 1; *R.* v. *Crompton*, 3 R. P. C. 368.

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

(*t*) See post, p. 596.

(*u*) *Cheavin* v. *Walker*, L. R. 5 C. D. 850.

(*v*) See post Chap. XXVI. p. 598.

CHAPTER XV.

OPPOSITION TO THE GRANT OF LETTERS PATENT FOR INVENTIONS.

Right to Oppose.—The right to oppose the grant of letters patent is a statutory right, and does not exist at common law. (*a*)

The practice in regard to oppositions is now governed by the provisions of the Patents Act, 1883. Prior to the passing of that Act, oppositions were never allowed to prevail except in the clearest cases; the erroneous refusal of a good patent necessarily inflicting irreparable damage on the applicant, who was thus deprived of that monopoly to which his ingenuity entitled him, while the granting of a bad patent, on the other hand, was no irreparable injury to the opponent, who could contest the validity of the grant in any subsequent proceedings.

Thus, in *Russell's Patent*, (*b*) Lord Cranworth, C., said: "The principle upon which I have generally acted has been that where a matter is much in doubt, it is better to run the risk of putting the party opposing the grant to the costs of making out his case in some ulterior proceedings, than to withhold the great seal from the letters patent in the first instance, for the obvious reason that the one course would create a remediable, and the other an irremediable injury." (*c*)

The same rule has been acted upon, and is now well established under the present practice. In *Stuart's* (*d*) case, Sir E. Clarke, S.G., thus laid down the rule which should guide the Law Officer under the Patents Act, 1883: "The decision of the Comptroller, who said that, in his opinion, the weight of evidence was in favour of the opponent, does not exactly express the result at which, in my opinion, it is necessary that a Law Officer should arrive before he refuses the sealing of a patent. Having regard

(*a*) Per Webster, A.G., in *Everitt's Application*, Griff. A. P. C. 29.

(*b*) 2 De G. & J. 132.

(*c*) See, also, *Tolson's Patent*, 6 De G. M. & G. 422; *Spence's Patent*, 3 De G. & J. 523; and Lord Selborne, C., in *Ex parte Sheffield*, L. R. 8 Ch. 240.

(*d*) 9 R. P. C. 452.

to the fact that by allowing the issue of a patent I do not close the matter, but leave it open to the opponent to challenge, in a court of law, the validity of that patent, I do not think I ought to refuse to permit a patent to be sealed unless I am satisfied that no jury could reasonably come to a decision in favour of the applicant." (*e*)

Statutory Grounds of Opposition.—The practice as to oppositions to the sealing of letters patent is now regulated by Section 11 of the Patents Act, 1883, as amended by Section 4 of the Patents Act, 1888. Sub-section 1 of Section 11 provides as follows :—

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

The jurisdiction of the Comptroller and Law Officer under the Acts to hear opponents is therefore strictly limited; the three grounds set out above being the only grounds upon which they can do so. (*f*)

It will be convenient to consider: (1) who may oppose; (2) what grounds of opposition are permissible; and (3) the present practice on oppositions.

1. *Who may Oppose the Grant of Letters Patent.*

General Observations.

Sub-section 1 of Section 11 of the Patents Act, 1883, enacts that any person may give notice of opposition who does so within the prescribed time, and on one of the grounds permitted by the Act. Sub-section 2 provides that the Comptroller shall hear the person giving such notice, if desirous of being heard. Where, however, an appeal is made to the Law Officer, such

(*e*) See, also, Webster, A.G., in *Stubbs' Patent*, Griff. P. C. 298.

(*f*) *Von Buch*, Griff. A. P. C. 42.

opponent only has a *locus standi* to oppose as, in the opinion of the Law Officer, is entitled to be heard. No difficulty arises as to who is entitled to be heard, in respect of the first and third grounds of opposition permitted by the Acts, but in respect of the second ground (viz. that the invention has been patented in this country on an application of prior date) some ambiguity arises, as the words in this part of the section appear to place no limitation upon the class of person who may raise this objection to a grant. This, however, it is now settled, is not the meaning of the Act. No person may be heard as an opponent on the second ground of opposition who is not personally interested in the prior patent upon which he bases his opposition. (*g*)

In *Heath & Frost's Patent*, (*h*) the opponent, who was a patent agent, relied upon a prior patent belonging to his client but in which he was not personally interested. Clarke, S.G., in declining to hear him, said: "It seems to me perfectly clear from the Act that members of the public, as such, are not entitled to be heard in opposition before me. The Act expressly says that it must be 'the person giving notice and being, in the opinion of the Law Officer, entitled to be heard in opposition,' so that, besides being a person who gives notice of opposition, you must also be a person who for some reason or other comes within the class of those persons 'entitled to be heard.' It appears to me that by Section 11 it is quite clear that the only class of persons who are entitled to be heard in opposition before the Law Officer, are persons who are interested, with a legitimate and real interest, in the prior patent upon which an application is opposed, or persons who, while they have not patented the invention, have yet been the originators of it, from whom the person seeking the patent has obtained it." (*i*)

A licensee under a prior patent, (*j*) and likewise an assignee (*k*) who has manufactured under such patent, even though it has been allowed to lapse, has a sufficient interest to entitle him to be heard by the Law Officer. (*l*) But a person who is merely a

(*g*) In *Stewart's Application*, 13 R. P. C. p. 629, Webster, A.G., said that the limitation on persons entitled to be heard before the Law Officer applied equally to the hearing before the Comptroller.

(*h*) Griff. P. C. 288, p. 290.

(*i*) See, also, *R.* v. the *Comptroller General; Ex parte Tomlinson*, 16 R. P. C. 233; [1899] 1 Q. B. 909; 68 L. J. Q. B. 568; 47 W. R. 567.

(*j*) *Hill's Patent*, 5 R. P. C. 599.

(*k*) *Marsden's Patent*, 13 R. P. C. 87.

(*l*) *Glossop's Patent*, Griff. P. C. 285. If the prior patent has expired it makes no difference; see *Lancaster's Patent*, Griff. P. C. 293; *MacEvoy's Patent*, 5 R. P. C. 285.

manufacturer of the class of goods to which the prior patent relates, and is not otherwise interested in it, is not entitled to be heard. (*m*)

The foregoing limitation upon the right to oppose a patent on the ground that it relates to an invention which is the subject of a prior patent will be strictly enforced, as otherwise a vast amount of annoyance and expense of a most objectionable character might be caused to patentees. (*n*)

If the Comptroller is in doubt as to whether an opponent appearing before him ought to be heard or not, he can consult the Law Officer, whose opinion in the matter will be final. (*o*) The Court has no jurisdiction to issue a mandamus requiring the Comptroller to hear an opponent whom the Law Officer has decided ought not to be heard. (*p*)

Once, however, an opponent has a *locus standi* to oppose, he may refer to other anticipations than the prior patent in which he is personally interested, and he will be heard as to such other grounds of opposition.

"The necessity of imposing some limit," said Webster, A.G., in *Stewart's Application*, (*q*) "is that pointed out by Lord Herschell, namely, to prevent any one being able to come and raise questions of novelty before the Comptroller or before the Law Officer; but once get a lawful opponent, it is, in my opinion, in the interests, both of patentees and of the public, that that opponent should be entitled to bring to the notice of the Comptroller and the Law Officer other patents which are germaine to the particular question."

The only persons who can oppose on the ground that the invention has been patented by them on an application of prior date, are persons interested in a patent granted upon an application made in the United Kingdom prior in date to the application opposed. Hence, the provisions enabling a foreign patentee who applies for a patent in England, within seven months from the date of his application abroad, to obtain an English patent antedated to the date of his foreign patent, (*r*) do not give any *locus standi* to such person to oppose as if his English patent had been granted at the same date as his foreign patent. (*s*)

(*m*) *Hookham*, Griff. A. P. C. 32.

(*n*) Per Herschell, S.G., in *Glossop's Patent*, Griff. P. C. 285.

(*o*) Patents Act, 1883, s. 95.

(*p*) *R.* v. *Comptroller-General*, 16 R. P. C. 233; [1899] 1 Q. B. 909; 68 L. J. Q. B. 568; 80 L. T. 777; 47 W. R. 567; 15 T. L. R. 285, 310.

(*q*) 13 R. P. C. 627.

(*r*) Patents Act, 1883, s. 103.

(*s*) *Everitt's Case*, Griff. A. P. C. 28.

The prior invention on which the opposition is grounded must have been "patented." Therefore, a person interested in a prior application which has not resulted in a patent has no *locus standi* as an opponent, unless he comes under Section 15 of the Patents Act, 1883. (*t*)

That section provides that, after the acceptance of a complete specification until the date of sealing the patent, or the expiration of the time for sealing, the applicant shall have all 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, except the right of instituting proceedings for infringement. An inventor, therefore, whose complete specification has been accepted may oppose as effectually as if a patent had in fact been granted to him. (*u*)

A person interested in a prior patent is entitled to oppose in respect of that patent, even if it has expired by effluxion of time, or been allowed to lapse. (*v*)

2. *Grounds of Opposition.*

(a) That the Applicant has obtained the Invention from the Opponent or from a Person of whom he is the Legal Representative.

Where this ground of opposition is raised it may become a question of some difficulty to decide who is in fact the real inventor. In such cases it sometimes appears that the invention is really attributable to both the applicant and the opponent. Where this has been proved a patent has been sealed to them jointly. (*w*)

Giving the Opponent an Interest in the Patent.—In *Garthwaite's Case*, where the Comptroller arrived at a similar conclusion, but the parties objected to having a joint patent, a patent was sealed to each, on condition that each agreed to assign to the other one half share of his patent, and to pay one-half of the fees necessary for maintaining the patent in force. (*x*)

In *Evans & Otway's Case*, (*y*) a difficult question arose as to whether the applicant, *Evans*, or the opponent, *Cutting*, was the true inventor. *Cutting* had already himself applied for and obtained

(*t*) *Dundons' Patent*, Griff. 278.

(*u*) *L'Oiseau & Pierrard*, Griff. A. P. C. 36.

(*v*) *Lancaster's Patent*, Griff. P. C. 294; *Glossop's Patent*, Griff. P. C. 285; *Heath & Frost's Patent*, Griff. P. C. 288; *Re Stewart*, 13 R. P. C. 627.

(*w*) *Eadie's Patent*, Griff. P. C 279.

(*x*) Griff. P. C. 284.

(*y*) Ibid. 279.

a patent for substantially the same invention. The Law Officer (Webster, A.G.), after hearing testimony of a highly contradictory nature, directed a patent to be sealed, on condition that the applicant, *Evans*, assigned one half share of the patent to the opponent, *Cutting*, and *Cutting* assigned one half share of his own patent to *Evans*. Difficulties having arisen as to the carrying out of this order, it was cancelled, and no patent sealed to *Evans*, on condition that *Cutting* assigned to *Evans* one half share in the patent he had already obtained; the renewal fees to be paid half by each.

In *Luke's Patent*, (*z*) where a similar opposition was set up, it appeared that part of the invention had been discovered by the opponent, and the Law Officer directed a patent to be sealed on an agreement being filed by which the applicant undertook to secure to the opponent the full rights under the patent of a joint patentee. (*a*)

Under this ground of opposition, it is no answer to an opponent for the applicant to shew that he obtained the invention from the opponent with the opponent's consent, for such a state of facts is inconsistent with the applicant being the first and true inventor within the meaning of the patent law. (*b*)

Obtaining the Invention beyond the United Kingdom.—But it is otherwise if the applicant has obtained the invention from the opponent beyond the United Kingdom and the Isle of Man. For in such case the applicant, if he is the first importer of the invention, is a true inventor within the meaning of the patent law, no matter how he became possessed of the discovery; (*c*) and the Comptroller cannot enquire into suggestions that the applicant acquired the invention by some breach of duty or breach of contract. These are issues which the parties must contest elsewhere. (*d*)

In *Higgins' Patent*, (*e*) the opponents proposed to prove fraud out of the United Kingdom, but Sir R. E. Webster, A.G., refused to consider such evidence, saying that it mattered not even if the importer had stolen the invention abroad.

In *Griffin's Application*, (*f*) where the applicant applied for a

(*z*) Griff. P. C. 294.

(*a*) These cases really follow the earlier practice as illustrated in *Russell's Patent* (2 De G. & J. 130), where, on a dispute between master and servant as to who was the true inventor, a patent was sealed to two trustees, one for either party.

(*b*) *Marshall's Application*, 5 R. P. C. 661.

(*c*) *Edmund's Patent*, Griff. P. C. 283; *Lake's Patent*, 5 R. P. C. 415.

(*d*) Ibid.

(*e*) 9 R. P. C. 74.

(*f*) 6 R. P. C. 296.

grant in respect of an invention communicated from abroad, the opponent alleged that the invention had in fact been obtained from her in this country, and the declarations being unsatisfactory, the patent was refused. But the opponent in this case would have had no *locus standi* had the obtaining of the invention from her taken place abroad.

Where the invention sought to be patented was so similar to one for which a patent had already been granted to the opponent —who also alleged it had been obtained from him—as to manifestly be unpatentable except as an improvement upon the opponent's patent, Sir F. Herschell, S.G., only allowed a patent to be sealed on the applicant inserting in his complete specification a statement that his invention referred to improvements on the opponent's patent. (*g*)

Opposition by a Workman of the Applicant.—The suggestions made by a workman employed in making a model of an invention for the inventor cannot be patented by that workman, but in fact belong to the employer and merge in his invention. Hence he is the only person entitled to a patent for them. Therefore improvements in details suggested by such workman and embodied in the machine do not entitle that workman to oppose and stop the master's patent, on the ground that material parts of the invention have been obtained from him. (*h*)

At the same time, inventions found out by a workman while engaged in his master's employment do not necessarily, by virtue of that employment, belong to the master. (*i*) It is a question of fact in each case. The invention may be so entirely independent of anything suggested to the workman as to be clearly his own invention.

In *Heald's Case*, (*j*) the employé was held entitled to have a patent sealed in his own favour, although the company in whose employment he was contended that his discovery had been made while occupied upon their business.

Whether the person from whom the invention was obtained himself intended to patent it or not is immaterial. He is equally entitled to oppose in either case. (*k*)

Obtained the Invention.—These words mean obtained the invention which is purported to be patented, and refer to the identity of the invention, not the right of the person from whom it was

(*g*) *Hoskin's Patent*, Griff. P. C. 291.
(*h*) *David* v. *Woodley*, Griff. A. P. C. 26.
(*i*) *Heald's Patent*, 8 R. P. C. 430.
(*j*) Supra.
(*k*) *Thwaite's Application*, 9 R. P. C. 515.

obtained to be regarded as the true and first inventor. In *Thwaite's Case*, (*l*) the opponent's right to oppose was based on the allegation that a large portion of the applicant's invention had been invented by a servant in the service of the opponent who had subsequently gone into the applicant's employment. There was a considerable conflict of evidence on the declarations, raising great doubt as to whether the opponent or the servant was the inventor; but Webster, A.G., held that he would not go into an enquiry as to that, as, under the Statute, it was not relevant to the right to oppose.

Where the applicant describes an invention in his specification as his own under an earlier patent, which in fact is taken from the patent of another person, that person is entitled to oppose and have such misdescription struck out of the specification, even although the applicant only describes that prior invention in his specification and does not claim it.

On this Clarke, S.G., in *Hetherington's Patent*, (*m*) said: "It was contended that the words in Section 11 of the Act of 1883, 'having obtained the invention from him,' must be read as applying solely to the invention claimed in the specification of the patent to which the objection is made. Even if this construction were sound I should not hold myself bound to permit the sealing of a patent which bore upon its face a statement untrue in fact, and injurious to the interests of the person to whom a prior patent had been granted. But the function of the specification is to describe and ascertain the nature of the alleged invention, and the words objected to in this case purport to be part of that description. I am of opinion that the opponents were entitled to be heard in opposition to the grant, and I affirm the decision of the Comptroller, and order the appellant to pay five guineas costs."

The words "legal representative" mean the administrator or executor of a deceased person. They do not include a company holding patent rights by assignment, (*n*) nor a person holding a power of attorney for a foreign inventor. (*o*)

(b) That the Invention has been Patented in this Country on an Application of Prior Date.

This is the most usual form of opposition. (*p*) To support opposition on this ground two circumstances must concur: (1) the

(*l*) Supra.
(*m*) 7 R. P. C. 419.
(*n*) *Shiel's Patent*, 5 R. P. C. 281.
(*o*) *Edmund's Patent*, Griff. P. C. 282.

In this case the above point was decided by the Comptroller only, Webster, A.G., not dealing with the point on the appeal.

(*p*) As to patents being refused on this

prior applications relied upon must have resulted in grants of letters patent; (2) the opponent must have a personal interest in one at least of such prior applications.

By "patented in this country" is meant an invention, not only described in a prior specification, but claimed. For only that which is claimed is patented. (*q*) Therefore matters relied upon as anticipations of the later application which are merely inserted in the specification of the earlier patent by way of description, however fully they may disclose the invention of the later applicant, do not afford the owner of that earlier patent a *locus standi* to oppose. (*r*)

In this respect the words of the Statute will be strictly construed. An opponent cannot, therefore, base his opposition on the prior provisional specification of an applicant whose patent has not been sealed. (*s*) He may, however, found his opposition on the complete specification of a prior application at any time after such specification has been accepted, for an accepted complete specification has all the effect of letters patent save as regards the right to proceed for infringement. (*t*)

It will not usually do for an opponent to produce several prior patents, and shew by piecing these together that the alleged invention of the applicant has been anticipated. An invention which has to be collated from several specifications is not "patented" within the meaning of this ground of opposition.

On this point Webster, A.G., in *Ross's Patent*, (*u*) said: "I confess I should require a very clear case to stop a patent on such a ground. It by no means follows that the combination of two previous arrangements will not require invention; and although I do not lay down any rule that where you have to combine and piece together the claims in two specifications, the combination cannot amount to such a prior claim as would prevent a subsequent patent being sealed, yet, having regard to the direction given in sub-section 1 of Section 11, I think it would require a very clear case, and I am not myself satisfied that if that had been the only objection to this application I could have entertained the contention" of the opponents.

ground under the old practice, see *Tolson's Patent*, 6 De G. M. & G. 422; *Scott & Young's Patent*, L. R. 6 Ch. 274; 19 W.R. 425; *Ex parte Yates*, L. R. 5 Ch. 1; *Ex parte Manceaux*, L. R. 6 Ch. 272.

(*q*) *Von Buch's Application*, Griff. A. P. C. 42.

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

(*s*) *Bailey's Patent*, Griff. P. C. 269; *Paterson's Patent*, Griff. P. C. 295.

(*t*) Patents Act, 1883, s. 15; *Bailey's Patent*, supra.

(*u*) 8 R. P. C. at p. 478.

The Earlier Invention must be Identical with that of the Applicant.—To stop a patent on this ground there must be clear identity of invention. "I have always, since I held my present position," said Webster, A.G., in *Todd's Patent*, (*v*) "acted on the principle that it is only in the clearest possible case that a patent ought to be stopped. I am of opinion that the invention purported to be claimed in this case is so identical with that which is disclosed in the opponent's specification, that this application cannot be allowed to proceed."

Though the case must be clear, yet where the inventions are identical it is the duty of the Law Officer to decline to seal a patent, and he ought not to shrink from the responsibility of doing so; (*w*) and it is not for the Comptroller or the Law Officer in such case to suggest disclaimers, with the object of preserving for the applicant some patentable entity. (*x*)

By "identical" is meant substantially identical. The substance rather than the form is to be looked at; mere verbal differences will not save an application. (*y*)

In considering identity of inventions the Comptroller and the Law Officer will take into consideration mechanical equivalents. (*z*)

In *Ambrose Hudd Smith's Patent*, Webster, A.G., said: "It is quite incorrect to suppose that in giving judgment in *Stubbs'* (*a*) case I ever intended to suggest that the Law Officer ought not to consider mechanical equivalents as bearing on the question of identity. I entirely agree with the judgment of my then colleague, Sir Edward Clarke, in *Haythornthwaite's Case*, (*b*) and on many occasions when I had to deal with the matter previously I did consider the question of mechanical equivalents as bearing upon the question of identity." (*c*)

Whether the Prior Patent is Valid is Immaterial.—Whether the prior patent is good or bad in law, is immaterial and will not be considered. (*d*) In *Green's Patent*, (*e*) and again in *Haythornthwaite's Case*, (*f*) the applicant proposed to shew that the prior patent relied on by the opponent was bad for disconformity

(*v*) 9 R. P. C. p. 488.

(*w*) *In re McHardy's Patent*, 8 R. P. C. 432; *Newman's Patent*, Griff. A. P. C. 40: *Todd's Patent*, 9 R. P. C. p. 488.

(*x*) *Lupton & Place's Application*, 14 R. P. C. 261.

(*y*) *Boult's Application*, 10 R. P. C. 275; *Ambrose Hudd Smith's Application*, 13 R. P. C. 200.

(*z*) *Ambrose Hudd Smith's Application*, 13 R. P. C. 200; *Whittaker's Application*, 13 R. P. C. 580; *Re Bailey*, Goodeve, 57.

(*a*) Griff. P. C. 298.

(*b*) 7 R. P. C. 71.

(*c*) 13 R. P. C. p. 201.

(*d*) *Jones' Patent*, Griff. A. P. C. 34.

(*e*) Griff. P. C. 286.

(*f*) 7 R. P. C. 70.

between the specifications; but Webster, A.G., in the one case, and Clarke, S.G., in the other, refused to go into the matter. So also in *Thornborough & Wilk's* (*g*) *Case*, Finlay, S.G., declined to consider the contention that the prior patent was bad in law.

Whether the prior patent has expired or been allowed to lapse is also immaterial. (*h*)

So likewise on this ground of opposition it is not generally material to consider whether the applicant's invention discloses subject-matter to support a patent. Indirectly, however, this consideration may have weight.

"I have not to deal with subject-matter, properly so called," said Webster, A.G., in *Todd's Patent*; (*i*) "that is to say, supposing *Todd's* invention to have been the first invention brought before me, it would not matter whether it shewed no subject-matter, if it was a claim to that which had not been done before; I quite agree I have not to consider whether it is subject-matter or not. But when there is a previous anticipatory patent it is necessary to consider then indirectly the differences, and without saying whether those differences form subject-matter or not, to decide whether the differences are sufficient to differentiate that which has gone before from that which is now claimed." After pointing out that the differences in this case were not such as could envolve any invention, the learned Law Officer proceeded: "I confess that from the point of view of the public, and from the point of view of the applicant, I cannot imagine they would think that *Mr. Todd* had got good subject-matter; but, be that as it may, while I should never have entertained that question for a moment, had that stood alone, I cannot, in the exercise of my duty, allow this application to proceed." (*j*)

Insertion of Disclaiming Reference to other Patents.—The objection that the applicant's invention is so similar to that protected by the prior patent as to raise a probability that an action for infringement would lie at the instance of the prior patentee against persons working under the later patent, is no ground for refusing the grant. (*k*) But while the Law Officers will not consider questions of possible infringement, they have always recognized that where there is an existing patent, and ground for

(*g*) 13 R. P. C. 115.

(*h*) *Stewart's Patent*, 13 R. P. C. 628.

(*i*) 9 R. P. C. p. 488.

(*j*) In *Wylie & Morton's Application*, a patent was refused for a mere selection from a prior specification shewing no invention. See 13 R. P. C. 97.

(*k*) *Newman's Application*, Griff. A. P. C. 40; *Webster's Patent*, 6 R. P. C. 165; *Stell's Patent*, 8 R. P. C. p. 236; *Tattersall's Patent*, 9 R. P. C. 150.

(9th Edition)

Fig. 1

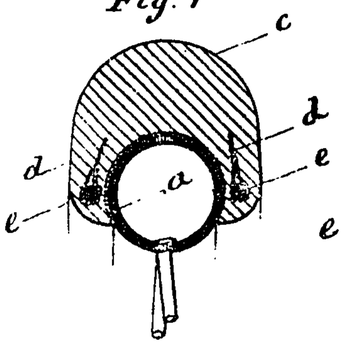


Fig. 2

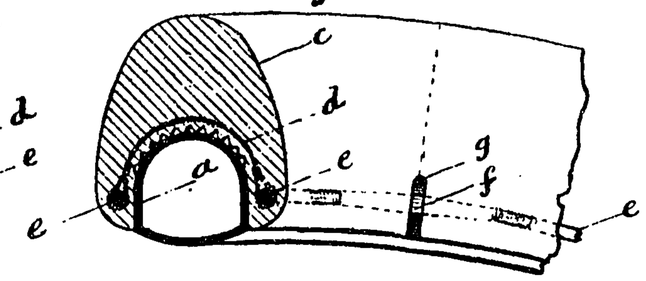


Fig. 3.

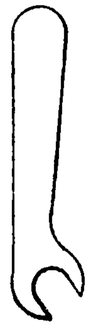


Fig 4

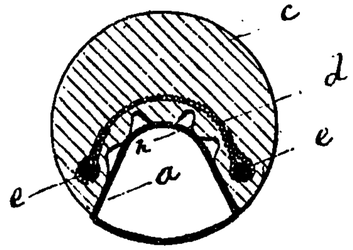


Fig. 14.

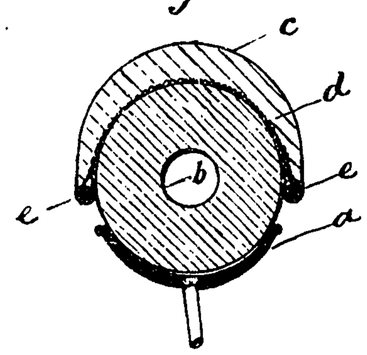


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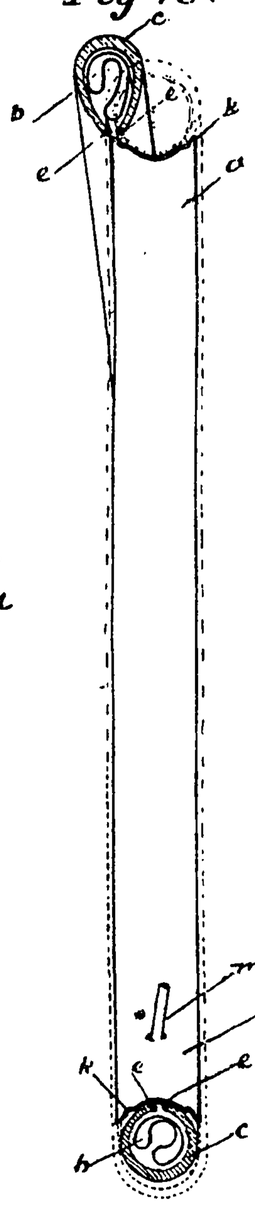


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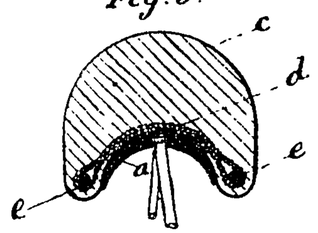


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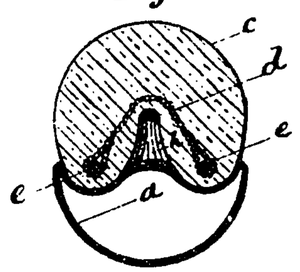


Fig 7

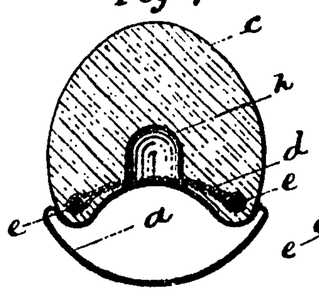


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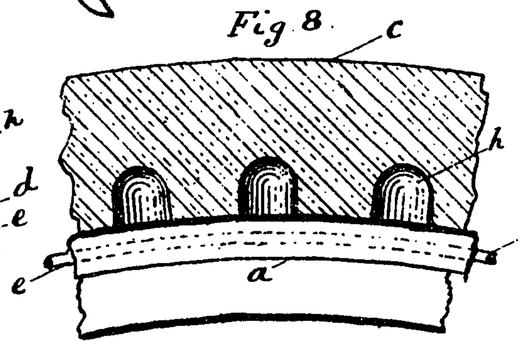


Fig 15.

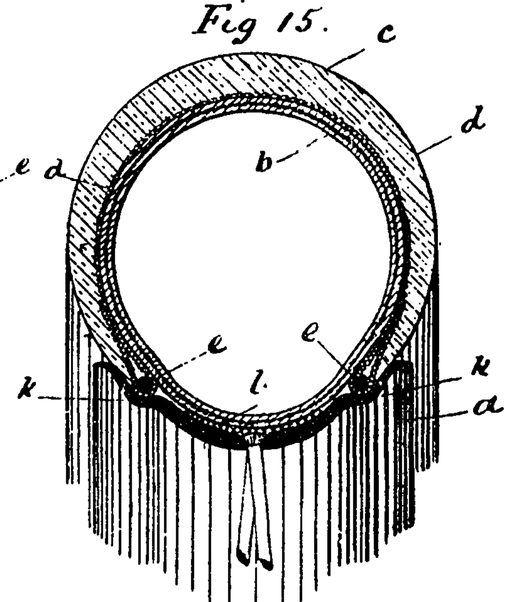


Fig. 9.

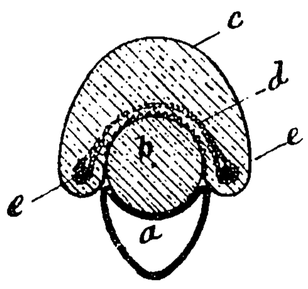


Fig 10.

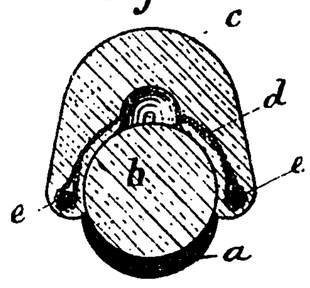


Fig 11

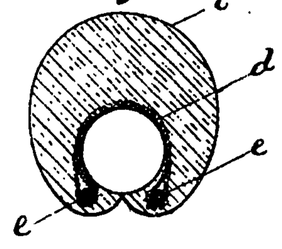


Fig 12.

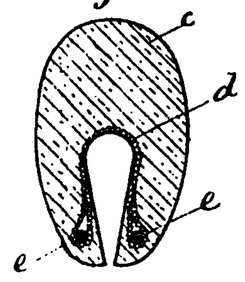


Fig 16

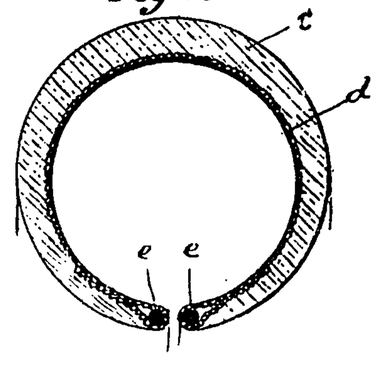


Fig 19.

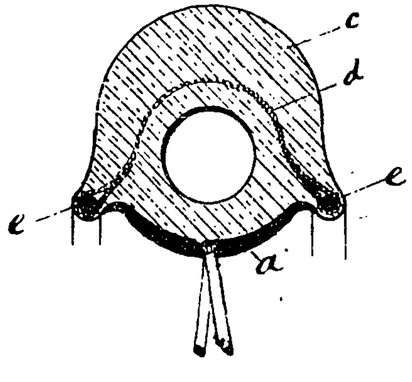


Fig. 20.

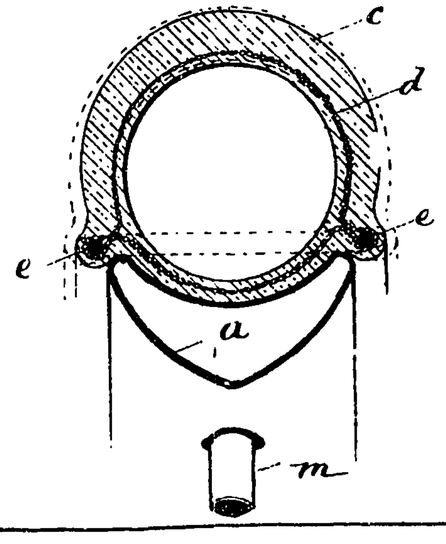


Fig. 21.

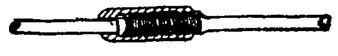
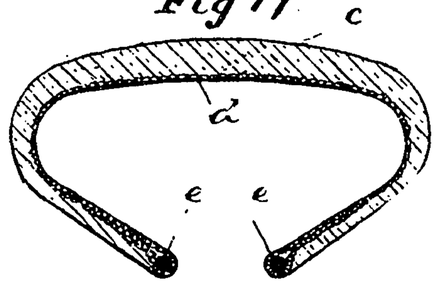


Fig 17



[This Drawing is a reproduction of the Original on a reduced scale.]

supposing that the construction of the later specification may interfere with the rights under that patent, the prior patentee is entitled to protection. (*l*) This protection is commonly given by requiring some disclaiming clause to appear on the face of the later specification.

In *Welch's Patent*, (*m*) where the application was in respect of an invention for "Improvements in the utilization of a waste product, and in the manufacture of bricks, tiles, and other articles therefrom," it was objected that a prior patent granted to one *Thomas Evans* covered the invention. The matter being one of doubt, Webster, A.G., allowed the patent to be sealed upon the insertion of the following disclaimer in the applicant's specification: "I am aware that the utilization of slate *débris* for the manufacture of bricks, tiles, and other articles, is not new, and that a process for this purpose is described in the specification of *Thomas Evans*, dated February 1, 1878, No. 431, and I make no claim to the process therein described."

At the same time, the mere fact that the later patent may be an infringement of the earlier one will not by itself entitle the opponent to a disclaiming reference. (*n*) For a disclaimer is intended primarily for the protection of the public rather than the opponent, and it will not generally be required unless the public are in danger of being misled by a specification appearing upon the face of it to have a wider scope or include a wider kind of invention than that to which the applicant is on the evidence entitled. (*o*)

It is therefore always necessary to ask, Are the public likely to be misled? In *Hill's Patent*, (*p*) Webster, A.G., said: "I frequently have to point out that a subsequent patent does no harm to a prior patentee, or those interested in a prior patent, but that for the interests of the public it is desirable that if patents overlap, the distinction between the inventions described in the later and the earlier patents should be made clear upon the face of the decisions that the Solicitor General and I have given—now a considerable number of them—pointing out this."

In *Stell's Patent*, (*q*) the same learned Law Officer put the right to disclaimers on a rather wider ground. "Many years ago, Lord

(*l*) *Newman's Application*, Griff. A. P. C. 40; *Webster's Patent*, 9 R. P. C. 165; *Stell's Patent*, 8 R. P. C. p. 236; *Tattersall's Patent*, 9 R. P. C. 150.

(*m*) Griff. P. C. 300.

(*n*) *Jones*, Griff. A. P. C. 33; *Stell's Patent*, 8 R. P. C. p. 236; *Marsden's Patent*, 13 R. P. C. p. 89.

(*o*) *Lorrain's Patent*, 5 R. P. C. 143.

(*p*) 5 R. P. C. 599.

(*q*) 8 R. P. C. p. 236.

Cairns pointed out that these disclaimers were of no value to the prior patentee except for the purpose of preventing the public being misled, or of preventing unfair dealing by means of patents which might be subsequently granted. I think that a prior patentee who asks for a disclaimer must satisfy the Comptroller, or the Law Officer on appeal that it is necessary for his protection." "The principles upon which the Law Officers have acted now for some years in allowing disclaiming clauses are, first, if it appears clear that upon the invention claimed by the prior patentee there will be a repetition of the claim to the earlier invention in the later patent; and secondly, if it is clear that the public would be misled by the later specification without disclaimer." (*r*)

The disclaimer required as a condition of the sealing of a patent may be either general or special. A general disclaimer is one indicating, by a general statement as to prior knowledge, that the patentee only claims a strictly limited invention. A special disclaimer, on the other hand, is a specific reference to a prior patent, indicating that the later patentee is aware of the earlier invention, and lays no claim to the general principle of that invention, but only seeks protection for the particular improvement upon it, or adaptation of it, which is new.

General or Special Disclaimer.—Usually a general disclaimer alone will be required of an applicant. (*s*) Where there are several earlier patents upon which the prior knowledge is founded, a general reference is the proper mode of disclaimer. (*t*) Sometimes in a general statement of prior knowledge an applicant may find it convenient to refer illustratively to prior patents as types. If he does so, the proper mode of such reference is to state what he believes that prior knowledge to be, and recite the references in support of such statement. He must not state the effect of the prior specifications, as they are written documents which speak for themselves, to be construed, if necessary, by the Court, and of which his private interpretation may be erroneous and misleading. (*u*) A statement of alleging defects in former cognate contrivances is not objectionable, if made generally and not with special reference to a particular prior invention. (*v*)

(*r*) In *Marsden's Patent* (No. 2), 14 R. P. C. 174, Finlay, S.G., adopted this dictum as defining the governing principles.

(*s*) *Kilner's Patent*, 8 R. P. C. 35; *Stell's Patent*, 8 R. P. C. 236.

(*t*) *Welch's Patent*, 8 R. P. C. 442; *Curtis & Andre's Application*, 9 R. P. C. 495; *Guest & Barrow's Patent*, 5 R. P. C. 313; *Cooper & Ford's Patent*, Griff. P. C. 275.

(*u*) Per Webster, A.G., in *Atherton's Patent*, 6 R. P. C. 547.

(*v*) *Guest & Barrow's Patent*, 5 R. P. C. 316.

Special references to prior patents are not inserted promiscuously by the Law Officers. (*w*) Such references are not desirable, unless necessary, and will not be allowed for the mere purpose of drawing the attention of the public to the existence of a prior patent relating to the same subject-matter. (*x*) The Law Officers have repeatedly laid down the rule that a disclaimer by special reference should not be inserted in a specification, unless it would be improper to let the patent be sealed without such reference. (*y*)

In *Welch's Patent*, (*z*) Webster, A.G., said: "There seems to be a constant misapprehension on the part of opponents who possess earlier patents, in imagining that their rights must be injured by the granting of a later patent. I express no opinion as to whether or not *Welch's* invention is an infringement of *Sterry's* patent. That is a matter which will, if necessary, in the event of proceedings, have to be discussed elsewhere. It is quite possible that *Mr. Welch* cannot use his invention except on making terms with *Mr. Sterry*, assuming that *Mr. Sterry* can make out that which has been claimed as the value of his invention. But I have only to consider whether it is so clear that the apparatus described in *Welch's* specification is within the previous claim or previous description—I care not which—of *Sterry*, that the public are entitled to have a statement made on the face of the specification, to shew that all that can be claimed under the later patent is something which is an improvement upon the apparatus described in *Sterry's* specification."

The same learned Law Officer, in *Barrow & Guest's Patent*, (*a*) said: "I have never considered that a prior patentee has any right to be specially named, unless the applicants are willing to name him, and unless it is clear there is no other publication except the one that is mentioned. The name is generally inserted for the purpose of the protection of the patentee, or, as I said before, the protection of the public."

It sometimes happens that the applicant's invention has manifestly been suggested by, and is only good as an improvement upon, that covered by the opponent's patent. In such cases specific references have been required to the earlier patent.

(*w*) *Barrow & Guest's Patent*, 5 R. P. C. 315; *Wallace's Patent*, 6 R. P. C. 135; *Hoffman's Patent*, 7 R. P. C. 92; *Stell's Patent*, 8 R. P. C. 236; *Kilner's Patent*, 8 R. P. C. 35.

(*x*) *Adams' Application*, 13 R. P. C. 548.

(*y*) *Marsden's Patent*, 13 R. P. C. 87; *Marsden's Patent* (No. 2), 14 R. P. C. 174.

(*z*) 8 R. P. C. 443.

(*a*) 5 R. P. C. p. 315.

In *Hoskins' Patent,* (*b*) where the invention related to "improvements in folding cots and hammock frames," this course was adopted. "It is impossible," said Herschell, S.G., "to shut one's eyes to the fact that this improved cot which *Hoskins* is seeking to patent never would have been seen or heard of but for the fact that he had before him, and had been employed to make the cot which *Needham* had patented. He gets that cot, and he finds that there is a cot which has certain advantages. All the elements which are to be found, and which are described as far as I can see as the essential elements of *Needham's* invention, are to be found in what *Hoskins* has produced. Of course the parts differ, and the mode of carrying out the idea differs, but there is not a single idea to be found in the one that is not to be found in the other arrangement, modified. The applicant's may be a very much better way —I do not know anything about that, and I do not say anything about it—I am willing to assume the statement is right, that it is a better way, but it is really doing in every detail precisely the same thing by a modification merely of the means used. Can I allow, not as being an improvement or modification of the prior patent, but as an independent patent, which the person taking it out is entitled to work independently, this apparatus or cot? I am satisfied I cannot. I am satisfied, moreover, that I should be doing a very cruel kindness to *Hoskins* if I were to allow him the patent upon his present specification, because I am satisfied there is neither any judge nor any jury who would not hold he was infringing *Needham's* patent, and therefore I should not be giving him any advantage if I were to allow the patent to go upon this specification. I should say there is no doubt that the applicant did apply a considerable amount of original thought, and I am quite prepared to believe invention, in improving the opponent's, and making a better cot. I do not, of course, say absolutely that it is a better cot, but it may be that it is so, and, if so, he ought to have the advantage of that—of all the invention that he applied to it—and so far as he has made it better he is entitled to a patent for the improvement. The appeal will be allowed with costs, but I allow the grant upon condition that *Hoskins* inserts in his complete a statement that his invention is an improvement upon *Needham's.*"

The disclaimer here eventually inserted was as follows: "This invention refers to improvements in the description of cots invented by *Geo. Hy. Needham,* for which invention a patent, No. 3332 of 1883, has been granted to him, and consists of," etc.

(*b*) Griff. P. C. 291.

A similar special reference to the opponent's patent was also inserted in *Newman's Patent* (2), (*c*) as follows: "I am aware of the prior patent granted to *Robert Adams*, dated," etc., "and I do not claim anything described and claimed in the specification of that patent, and in particular, I do not claim the apparatus as shewn and described with reference to figure 35."

In that case Webster, A.G., following the above decision of Herschell, S.G., said: (*d*) "It is not the interest of subsequent patentees that their patents should be apparently for an original invention when, as a matter of fact, they themselves admit before a Law Officer that they can only claim the particular combination which they described, and also admit that there is a description of a mere general combination, which may or may not include the particular combination that they have invented. Further, I have to consider the public interest; because it certainly is not for the interests of the public that they should be led into supposing that a description in a specification is entirely general; whereas it can only be supported as a specification of valid letters patent if the description is understood to be a description of an improvement. I shall therefore direct that this patent be allowed, some simple disclaiming clause being inserted, stating that the patentee is aware of the previous specification, and makes no general claim to the matter therein described, but only to the improvement, or some such words as were used in *Hoskin's Case.* (*e*)

In *Adams' Case,* (*f*) Finlay, S.G., while of opinion that the scientific mode of disclaiming would have been to draw the specification in an altered form, limiting the claim to certain improvements on known apparatus, yet allowed the disclaimer to be expressed by a special reference to an earlier patent, as it appeared that that course would equally indicate the limited scope of the applicant's claim, and save the entire re-casting of the specification. (*g*)

Disclaimer where the Prior Patent is a Master Patent.—Special disclaimers are, as a general rule, undesirable, because the prior knowledge which makes disclaimers necessary is often to be found in several specifications. These specifications may not all

(*c*) 5 R. P. C. 279.

(*d*) Ibid. 280.

(*e*) For other cases of a like nature, see *Levinstein's Patent*, 11 R. P. C. 348; *Maxim & Silverman's Application*, 11 R. P. C. 314; *Tattersall's Patent*, 9 R. P. C. 150.

(*f*) 13 R. P. C. 548.

(*g*) For other examples of special disclaimers, see *Welch's Patent*, Griff. P. C. 300; *Lynde's Patent*, 5 R. P. C. 663; *Wallace's Patent*, 6 R. P. C. 135; *Thornborough & Wilks' Patent*, 13 R. P. C. 115.

be brought to the attention of the Comptroller or Law Officer, and in such case a special reference to one of them might be calculated to mislead the public. (*h*) Where, however, the applicant's invention concerns a subject as to which there is a recognized master patent, the above objection to a special reference does not apply.

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

In *Newton's Patent*, (*k*) the same learned Law Officer said that specific references to earlier patents were only permissible as a general rule where there was at once substantial identity between the fundamental parts of the two inventions, and a difference which could only be justified on the ground of improvement: it being right in such case to protect by a specific reference both the public and the prior patentee.

The fact that the prior patent has already expired is no reason against inserting a special reference to it; but rather the other way, as no proceedings can any longer be taken under it in respect of infringements. (*l*)

An opponent to a grant who desires his own patent to be construed as a master patent, or as being for a pioneer invention, must bring the state of knowledge before the Comptroller by evidence.

"It seems to me," said Webster, A.G., in *Southwell & Head's* (*m*) *Application*, "that unless the parties before the Comptroller agree on a state of knowledge which is to be assumed to be the basis of both inventions, if an opponent is coming to say that a claim in an earlier patent is to be construed as being a pioneer or master claim to such an extent that he is entitled to a wide construction for the purpose of stopping future patents, he is bound to bring the state of knowledge before the Comptroller. I do not think any person who, describing in specific language a method of arriving at a given end, afterwards seeks to say that the language is to include something which is, on the face of it, different, can ask the

(*h*) Per Webster, A.G., in *Stell's Patent*, 8 R. P. C. p. 236.

(*i*) 8 R. P. C. 442.

(*j*) See, also, *Hoffman's Patent*, 7 R. P. C. 92.

(*k*) 17 R. P. C. 124.

(*l*) *Hall & Hall's Patent*, 5 R. P. C. 285.

(*m*) 16 R. P. C. p. 362.

Comptroller so to act without clearly establishing that, for the purposes of the Comptroller's decision, the earlier patent is to be regarded as being a master patent. In this case no real difficulty is created, because I happen to know something about the matter from the previous case that was before me; but I should like to lay it down, as far as I can, as a matter of practice that, if an attempt is made to limit subsequent patents by the language of a general claim, upon the ground that the patent is a master patent and is for a pioneer invention, it is the duty of the person maintaining that contention to support it before the Comptroller by evidence, unless the parties agree as to the existing state of knowledge."

Inserting References to Concurrent Applications.—Where in an opposition on the ground that the invention had already been patented by the opponent, the patent on which the opponent relied had been sealed upon an application practically concurrent with that of the applicant, the Comptroller ordered a special reference to be inserted to the opponent's patent. On appeal, however, the Law Officer reversed this decision. (*n*) Webster, A. G., said: "I may say at once that it is new to me that references have ever been inserted where the applications were practically concurrent; and I am not at all satisfied that the same principles apply where the applications are concurrent, as in cases of previous patents. References, as I have repeatedly pointed out, are required in order to caution the public that the field of knowledge has been previously occupied by inventions which are analogous to the one for which application is being made, and thereby warn them against the belief that they were dealing with an invention which covered the whole possible field. But it is clear that these considerations do not apply in the case of concurrent applications. I desire to reserve any question of what are the proper sort of disclaimers or references to be inserted, where the applications are concurrent, until the matter has been decided."

Right of the Crown to impose Terms.—The jurisdiction which the Law Officer exercises in imposing terms in cases of opposition is not a jurisdiction given in express terms by the Statute, but a jurisdiction which arises inherently from the statutory right to refuse to grant a patent which entitles the Law Officer to say, "I will not grant you, the applicant, a patent unless you assent to certain terms." Where, therefore, the applicant shews a clear claim to a grant, and the case is not complicated by *mala fides* on his part,

(*n*) *Greenhalgh's Application*, 14 R. P. C. p. 388.

or any special circumstances affecting him, the Law Officer ought not to put the applicant upon terms, and will decline to do so. (*o*)

Where it is manifest that the necessary disclaimers would go so far as to leave no patentable entity of invention the Law Officer should refuse the patent altogether. (*p*)

In deciding whether or not to insert a reference to a prior patent, the Law Officer is not bound by the construction which the Court of Appeal may have put upon that patent; for the decision of that tribunal may be reversed in the House of Lords, and does not finally determine the law. (*q*)

Sometimes, where opposition is founded on a prior patent, the evidence shews that some portion only of the applicant's invention has been patented before. In such cases, where this portion is severable, a patent has been sealed for the residue, the applicant being required to excise the anticipated claims. (*r*) In *Teague's Patent*, (*s*) Webster, A.G., gave the opponent the option of insisting on a special disclaiming reference to his patent or the omission of certain descriptive matter from the specification of the applicant. He elected the latter course.

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

In considering cases based upon this ground of opposition, the Comptroller and the Law Officers will remember that the object of having two specifications is to enable the inventor to have time to develop his invention. Therefore differences which are consistent with such progressive development will not be allowed to prevent the sealing of a patent. (*t*) On the same principle, the applicant will be allowed to cut down his invention by omitting from his complete specification matters described in the provisional specification, if on consideration he comes to the conclusion that the ambit of his original description is too large. (*u*) But if the

(*o*) *L'Oiseau & Pierrard*, Griff. A. P. C. 39; *Main's Patent*, 7 R. P. C. 13.

(*p*) *Hedge's Case*, 12 R. P. C. 136.

(*q*) *Hoffman's Patent*, 7 R. P. C. 92.

(*r*) *Hall & Hall's Patent*, 5 R. P. C. 283.

(*s*) Griff. P. C. 298.

(*t*) *Millar & Miller's Application*, 15 R. P. C. 718. In doubtful cases the patent will not be stopped: see *Anderson & Anderson's Patent*, 7 R. P. C. 323; *Cumming's Patent*, Griff. P. C. 277.

(*u*) Ibid.

opponent can shew that the four corners of the provisional specification have been exceeded, the objection will be fatal.

All fair development, however, which does not amount to an invention different from that originally protected is permissible. (*v*)

In *Wilson's Patent*, (*w*) the invention described in the provisional specification consisted in a novel method of constructing velocipede tyres, made of an outer part of hard rubber and an inner part or core of spongy rubber. Various combinations of these parts were described in which the core might be either separate from the outer portion or made in one piece with it, in the form of a strip bent round to the shape required for the tyre. A modified construction was also described as the combination of the pneumatic principle with the spongy core. In a further modification, the tyre consisted of an outer casing of hard rubber and an inner pneumatic tube separated by a thin strip of steel or wire gauze to prevent accidental puncturing of the tube. No methods of fastening the tyres to the wheels were mentioned. In the complete specification, however, these tyres were in many cases described and illustrated as fitted to specially constructed wheel-rims provided with special means for fastening the tyres, and these rims, *combined with the methods of fastening*, were the subjects of claim. On opposition for disconformity, the Comptroller held that the complete specification exceeded the provisional, and Webster, A.G., though varying that decision on appeal, required the complete specification to be amended so as to prevent the applicant claiming the means of fastening the tyres to the wheels, as distinct from the construction of the tyres themselves.

In construing the specifications to test their conformity, the Law Officer will put that construction upon the applicant's provisional specification which he believes the applicant intended it to bear at the date of filing. For this purpose it may be most material to see the original drawings of the applicant. (*x*)

3. *Practice on Oppositions to Grants.*

The Comptroller is required to advertise the acceptance of every complete specification; and from the date of acceptance the application and specifications, with the drawings (if any), may be inspected by the public. (*y*)

Notice of Opposition required.—A person intending to oppose the

(*v*) *Edwards' Patent*, 11 R. P. C. 461.
(*w*) 9 R. P. C. 512.
(*x*) *Birt's Application*, 9 R. P. C. 489.
(*y*) Patents Act, 1883, s. 10.

sealing of the patent must give notice of his proposed opposition, at the Patent Office, within two months from the date of advertising the acceptance of the complete specification. (*z*)

The notice should be in the form prescribed by the Act, (*a*) contain alike the name and address for service in the United Kingdom of the opponent, and the grounds of his proposed opposition. It must also be signed by him. The notice must be accompanied by an unstamped copy, (*b*) which is upon receipt transmitted by the Comptroller to the applicant. (*c*)

If the opponent relies on the ground that the invention has been patented in this country on an application of prior date, he must specify in his notice the number and date of such prior application. (*d*)

Care should be taken that these conditions are duly complied with, for no opponent will be allowed to raise at the hearing any ground of opposition not stated in the notice. The objection that the alleged invention is covered by a prior patent will not be allowed unless the number and date of such prior application are also duly specified in the notice. (*e*)

In *Bailey's Patent*, (*f*) the opponent sought to put in evidence before the Law Officer a specification which had come to his knowledge since the hearing before the Comptroller; but Davey, S.G., held that this was in fact raising a new ground of opposition, and declined to admit the evidence.

Amendment.--There is, however, a power of amendment in cases where the Comptroller is of opinion that such amendment will not be detrimental to the interests of the applicant. (*g*)

Under this power the Comptroller has amended a notice at the hearing by allowing the substitution of the real opponent's name for that of his agent, by whom it had been originally signed, but who had died pending the hearing. (*h*) In another case, where the prior patent relied upon was described in the notice as "My claims in Patent No. 4726—86, for a machine for measuring the height of human beings automatically," the Comptroller allowed the date and proper title to be added by amendment, being satisfied that the applicant had in fact had the means of referring to the prior patent in question. (*i*) Again, where the notice alleged that the invention, *or material parts thereof*, had been

(*z*) Patents Act, 1883, s. 11 (1).
(*a*) See Form D, Appendix, post.
(*b*) P. R. rule 34.
(*c*) Ibid. 35.
(*d*) Ibid. 36.
(*e*) P. R. rule 42.
(*f*) Griff. P. C. 269.
(*g*) P. R. rule 6.
(*h*) *Lake*, Griff. A. P. C. 35.
(*i*) *Airey's Application*, 5 R. P. C. 348.

patented in this country on applications of prior date, the Comptroller, on objection being taken to the words in italics, allowed an amendment by striking them out. (*j*)

Evidence on Oppositions.—The evidence before the Comptroller is given in the form of statutory declarations.

These must be left by the opponent at the Patent Office within fourteen days after the expiration of two months from the date of the advertisement of the acceptance of the complete specification of the patent it is intended to oppose. The opponent must at the same time deliver a list of his declarations to the applicant. (*k*)

Within fourteen days from the delivery of such list, the applicant may leave at the Patent Office statutory declarations in answer, and on so doing must deliver a list thereof to the opponent. (*l*) A further period of fourteen days is allowed the opponent to leave declarations in reply, of which also a list must be delivered to the applicant. Declarations in reply must be confined to matters in reply only. (*m*)

Copies of the statutory declarations may be obtained from the Patent Office, or from the opposite party. (*n*)

The Comptroller has power to enlarge the time for leaving declarations if he thinks fit. (*o*)

After the opponent's declarations in reply, no further evidence may be left except by leave of the Comptroller upon the written consent of the parties duly notified to him, or by special leave of the Comptroller on application in writing made to him for that purpose. (*p*) Either party making such application shall give notice thereof to the opposite party, who is entitled to oppose it. (*q*)

Statutory declarations should be drawn concisely, and should not be needlessly multiplied. (*r*)

Prior specifications, and other documents and models or drawings which are relied upon to shew prior knowledge generally, or the prior patenting of an invention, should be made exhibits. But in some cases matters not strictly in evidence have been considered. (*s*)

(*j*) *Fawcett*, Goodeve, 10. See, also, *Jones*, Griff. A. P. C. 33; *Daniel's Application*, 5 R. P. C. 413.

(*k*) P. R. rule 37.

(*l*) Ibid. 38.

(*m*) Ibid.

(*n*) Ibid.

(*o*) P. R. rule 51.

(*p*) Ibid. 39.

(*q*) Ibid. 40.

(*r*) *Brand's Patent*, 12 R. P. C. 102; *Hedge's Application*, 12 R. P. C. 136.

(*s*) See *Lancaster's Patent*, Griff. P. C. 293; *Jones's Case*, Griff. A. P. C. 34.

Where the ground of opposition is that the applicant has obtained the invention from the opponent, or from a person of whom such opponent is the legal representative, unless evidence in support of such allegation be left at the Patent Office within the prescribed time, the opposition is deemed to be abandoned, and the patent will be sealed forthwith. (*t*)

In *Dundon's Patent*, (*u*) the Comptroller heard the opposition on the point whether the invention had been patented on an application of prior date, although the opponent filed no declarations. But he treated a ground of objection that the invention had been obtained from the opponent as abandoned.

The Hearing of the Opposition.—On the completion of the evidence, or at such other time as he may see fit, the Comptroller appoints a time for the hearing of the case, giving to the parties at least ten days' notice of this appointment. (*v*) If the applicant or the opponent desires to be heard, he must send an application to that effect in the prescribed form (*w*) to the Comptroller. If such application is not sent, the Comptroller may refuse to hear the party failing to comply with this rule. (*x*)

Before the Comptroller the applicant begins, except perhaps where fraud is charged. (*y*) The Comptroller has no power to summon the declarants before him, and have them submitted to cross-examination. Where, therefore, the rival declarations raise a serious contest of fact, he will take a course which will give the parties the opportunity of carrying the case before the Law Officer. (*z*) The Comptroller has no power to award costs.

Where the parties do not apply to be heard before him, the Comptroller will consider the case upon the materials submitted, and notify his decision. (*a*)

Appeal to the Law Officer.—From the decision of the Comptroller an appeal lies to the Law Officer. (*b*) The appeal is by way of re-hearing. (*c*) An appeal will lie by an opponent against a refusal to insert a special reference to a prior patent, even when the opponent does not otherwise contest the sealing of the patent. (*d*)

An appeal likewise lies against a decision of the Comptroller allowing or refusing a patent or an application under Section 103

(*t*) P. R. rule 43.
(*u*) Griff. P. C. 278.
(*v*) P. R. rule 41.
(*w*) Form E, Appendix, post.
(*x*) P. R. rule 41.
(*y*) *Luke's Patent*, Griff. P. C. 294.
(*z*) *Evans & Otway's Patent*, Griff. P. C. 280.
(*a*) P. R. rule 41.
(*b*) Patents Act, 1883, s. 11 (2).
(*c*) Per Webster, A.G., in *Stubbs' Patent*, Griff. P. C. 298.
(*d*) *Brownhill's Patent*, 6 R. P. C. 136.

of the Patents Act, 1883, by a person who has applied for protection for his invention in a foreign state. (*e*)

Notice of Appeal.—Any person intending to appeal to the Law Officer must, within fourteen days of the decision appealed from, or such further time as the Comptroller may allow, file a notice of his intended appeal in the Patent Office. (*f*) The notice of appeal must state the nature of the decision appealed against, and whether the appeal is from the whole or part only (and in that case which part) of the decision. (*g*) A copy of this notice must also be sent to the Law Officer's clerk at the Royal Courts of Justice, (*h*) and to the other side. (*i*) The notice is sufficient if signed by the appellant's agent. (*j*) The giving of notice is a condition precedent to the right of appeal, and an appellant will not be heard upon any ground of appeal not included in his notice.

Thus, in *Bairstow's Patent*, (*k*) where the Comptroller imposed certain conditions upon the applicant, but decided against the opponent on another ground of opposition, and the applicant appealed, but the opponent gave no counter notice of appeal, the Law Officer held that he could not hear the opponent upon the point decided in the applicant's favour below, as no notice of appeal from that decision had been given. "The effect," said Clarke, S.G., "of rules 1 and 2 of the Law Officer's Rules is to limit the hearing before the Law Officers to points specifically raised by the notice of appeal; and where a notice of appeal is given as to part only of the Comptroller's decision, the person receiving such notice and desiring to question other parts of the Comptroller's decision must give a counter notice. If the original notice of appeal is only given just before the expiration of the fourteen days, the time for giving a counter notice may be extended under rule 5."

Where the Comptroller requires an amendment of the applicant's specification, and the form of such amendment is not settled at the hearing, the time for appealing runs from the date when a copy of the amendment approved by the Comptroller is forwarded to the opponent; otherwise in such case hypothetical appeals would have to be entered. (*l*)

(*e*) *Main's Patent*, 7 R. P. C. 13; *Van de Poele's Patent*, 7 R. P. C. 69.

(*f*) L. O. R. rule 1. The time may be extended by the Law Officer on application for special leave to do so: L. O. R. rule 5.

(*g*) L. O. R. rule 2.

(*h*) Notices and documents required to be sent to the Law Officer's clerk may be sent by a prepaid letter through the post: L. O. R. rule 14.

(*i*) L. O. R. rule 3; *Hill's Patent*, 5 R. P. C. 601.

(*j*) *Anderson* v. *McKinnell*, Griff. A. P. C. 24.

(*k*) 5 R. P. C. 289.

(*l*) *Chandler's Patent*, Griff. P. C. 273.

Hearing before the Law Officer.—Where a notice of appeal is filed, all the papers relating to the matter are transmitted by the Comptroller to the Law Officer's clerk. (*m*)

Seven days' notice, at least, of the time and place appointed for the hearing of the appeal is given by the Law Officer's clerk. But the Law Officer has jurisdiction to give leave to serve a shorter notice. (*n*)

The notice is given to the Comptroller, to the applicant, and to the opponent, if any. (*o*)

The proceedings before the Law Officer being, as already stated, in the nature of a re-hearing, (*p*) the evidence must be the same as that used before the Comptroller, except as to matters which have occurred or come to the knowledge of either party after the date of the decision appealed from. (*q*) This exception does not entitle a party, however, to put in further evidence if that evidence substantially goes to a ground of appeal not included in the notice. (*r*)

The Law Officer has power to admit new evidence. But leave must be obtained specially from him for this purpose. (*s*) Where such evidence went to prove fraud, leave was refused. (*t*) In another case, where the applicants, who had filed no evidence before the Comptroller, applied for leave to do so before the Law Officer, Webster, A.G., gave leave, on their paying all the costs. (*u*)

Before the Law Officer the parties have the privilege of cross-examining the witnesses. (*v*) If it is desired to cross-examine a declarant a request must be made to the Law Officer to order the attendance of the witness for that purpose. (*w*) The Law Officer has a discretion to refuse this request if made without good ground. (*x*) The person requiring the attendance of a witness must tender a reasonable sum for conduct money. (*y*)

(*m*) L. O. R. rule 4.
(*n*) Ibid. 6.
(*o*) Ibid. 7.
(*p*) See *Stubbs' Patent*, Griff. P. C. 298.
(*q*) L. O. R. rule 8.
(*r*) *Bailey's Patent*, Griff. P. C. 269.
(*s*) L. O. R. rule 8. In *Thwaite's Patent*, 9 R. P. C. 515, Webster, A.G., gave leave to call before him witnesses who had not made declarations before the Comptroller.
(*t*) *Huth's Patent*, Griff. P. C. 292.
(*u*) *L'Oiseau & Pierrard*, Griff. A. P. C. 37. Further evidence was also admitted in *Van de Poele's Patent*, 7 R. P. C. 69.
(*v*) Patents Act, 1883, s. 38.
(*w*) L. O. R. rule 9.
(*x*) Ibid.
(*y*) L. O. R. rule 10. The practice with regard to the examination of witnesses is thus stated by Griffin (see Patent Cases, p. 319): "When it is desired to claim an order for the attendance of declarants for cross-examination, a list of such persons must be left with the Law Officer's clerk, with a request for an order for their attendance: copies of the request and list should be sent to the other side. The Law Officer then requests the attendance of both parties before him with reference to the application, and if satisfied that an

Costs.—The Law Officer has jurisdiction to award costs, (*z*) and may fix their amount. (*a*) A sum is generally named where costs are given. It is not intended that the costs given by the Law Officer should amount to a full indemnity. In *Stuart's Patent*, (*b*) an exceptional case, where intricate evidence had to be considered, and the enquiry was necessarily lengthy and expensive, costs were given to the opponents to the amount of thirty guineas in respect of the hearing, and ten guineas in respect of an application to admit further evidence. "It is not the custom of the Law Officers on these appeals," said Clarke, S.G., "to attempt to give costs to such an amount as will indemnify the parties. To do so would be to seriously discourage the appeals, and to limit very much the usefulness of the office which the Law Officers fill in these matters."

In the absence of special circumstances costs generally follow the event. (*c*) Where the applicant's declarations contained equivocal statements which justified the opponents in cross-examining upon them, costs were refused to the applicant, although the opponents failed on the appeal. (*d*) "It is exceedingly important," said Webster, A.G., "especially before the Comptroller, who cannot cross-examine witnesses, that there should be the fullest good faith in the statements that are made. I am imputing to the applicant no desire to conceal; but when I have to consider what the opponents had before them, I must take him as responsible for all the consequences of his acts."

A slight alteration in the Comptroller's decision will not affect the way in which costs are given if substantially that decision is affirmed. (*e*) Where the appellant did not appear at the hearing costs were given against him; (*f*) and where the appellant (who was the opponent) had not attended before the Comptroller the Law Officer, though deciding in his favour, did not allow him any costs. (*g*) Again, where the appellant attempted to withdraw his appeal two days before the hearing, the Law Officer, on the written application of the respondent, and in the absence of a satisfactory explanation of the withdrawal, gave costs against him. (*h*)

In Ainsworth's Case, where the respondent failed to appear on

order should go, directs that summonses should be issued, which the Law Officer's clerk thereupon issues in due course."

(*z*) Patents Act, 1883, s. 38.

(*a*) L. O. R. rule 11.

(*b*) 9 R. P. C. p. 453.

(*c*) Per Webster, A.G., in *Stubbs' Patent*, Griff. P. C. 298.

(*d*) *Anderton*, Griff. A. P. C. 25.

(*e*) *Fletcher*, Griff. A. P. C. 31.

(*f*) *Dietz's Patent*, 6 R. P. C. 297.

(*g*) *Hudd Smith's Application*, 13 R. P. C. 200.

(*h*) *Knight*, Griff. A. P. C. 35.

the appeal, Webster, A.G., on this failure being subsequently explained, to his satisfaction, granted another hearing, the respondent paying the appellant's costs of the adjournment. (*i*)

If the Law Officer does not himself fix the amount of the costs allowed, he must direct by whom and in what manner the amount shall be ascertained. (*j*)

If costs ordered by the Law Officer to be paid are not paid within fourteen days after the amount thereof has been fixed or ascertained, or such shorter period as shall be directed by the Law Officer, the party to whom such costs are to be paid may apply to the Law Officer for an order for payment under Section 38 of the Patents Act, 1883. (*k*)

Re-opening Enquiry—Power of Law Officer to call in Expert.—Once the Law Officer has given his decision he will not allow the matter to be re-opened unless special circumstances are shewn. In *Thomas & Prevost's Case*, (*l*) Finlay, S.G., said: "That there is power to re-open under special circumstances I have no doubt. If there were fraud or serious mistake or miscarriage, I think there would be power to direct a re-hearing, in order to see whether justice demanded that another conclusion should be arrived at." The fact that the opponent has since the hearing before the Comptroller withdrawn his opposition is not, however, ground for so doing. "I think," said Finlay, S.G., in the foregoing case, "it would be a very dangerous thing to allow that that would be treated as a sufficient ground. The contest which takes place between the applicant and any opponent is a contest in the result of which the public have an interest. . . . When the decision has once been arrived at, it is one which ought, in the public interest, to stand, unless some such ground for re-opening it were shewn as I have already indicated."

The Law Officer may, if he thinks fit, obtain the assistance of an expert, who shall be paid such remuneration as the Law Officer, with the consent of the Treasury, shall appoint. (*m*) Hitherto, it has not been the practice of the Law Officers to avail themselves of this power. It is not the function of the Law Officer to try out such intricate questions as an expert's assistance might be necessary to determine; seeing that where a doubt exists the applicant is entitled to his patent.

In *Lake's Patent*, (*n*) a case envolving difficult chemical

(*i*) Griff. P. C. 269.
(*j*) L. O. R. rule 11.
(*k*) Ibid. 12.
(*l*) 15 R. P. C. 257.
(*m*) Patents Act, 1883, s. 11 (4).
(*n*) 6 R. P. C. 548.

questions, Clarke, S.G., said: "Whatever advice the expert gave me upon the matter, it would have to be my judgment—and the responsibility of that judgment is a considerable one in a question of this character; and I do not think that, even if advised by an expert, I should consider it right, in view of a strongly controverted question of scientific anticipation, to decide that in a way which would put a stop to the patent now asked for. I think such a question, if it is to be discussed at all, should be discussed elsewhere, where the evidence can be more thoroughly dealt with."

CHAPTER XVI.

THE REGISTER OF PATENTS.

The Register and its Contents.—Under the Patents Act, 1883, a book called the Register of Patents is required to be kept at the Patent Office. (*a*) In this Register are entered the names and addresses of the grantees of patents, notifications of assignments and of transmissions of letters patent, of patent licenses, and of amendments, extensions, and revocations of patents, and such other matters as affect the validity or proprietorship of letters patent for inventions.

The Register is *primâ facie* evidence of all matters directed or authorised to be inserted therein. (*b*)

Under the former practice two registers were kept; one a Register of Patents, in which were entered all matters affecting the validity of letters patent for inventions, such as disclaimers, payment of renewal fees, and extensions of patent terms; the other, a Register of Proprietors, in which were entered assignments, licenses, and matters concerning the ownership of patent monopolies. (*c*)

Public Inspection.—The Register of Patents (with which the former Registers are now incorporated), (*d*) is open to the inspection of the public, between the hours of ten and four, on every week-day, except Christmas Day, Good Friday, the day observed as her Majesty's birthday, days of public fast or thanksgiving, and Bank of England holidays. To these days of exception must also be added days of which notification has been given by a placard, posted in a conspicuous place at the Patent Office, and times when the Register is required for any purpose of official use. (*e*)

(*a*) Patents Act, 1883, s. 23.
(*b*) Ibid. s. 23 (2).
(*c*) See 15 & 16 Vict. c. 83, ss. 34, 35.
(*d*) Patents Act, 1883, s. 114 (1).
(*e*) Patents Act, 1883, s. 88; P. R. rule 78.

A certified copy of any entry in the Register may be obtained by any person on payment of the prescribed fee. (*f*)

Right to Register.—No patent is entered upon the Register until sealed. After sealing, the Comptroller is required to enter upon the Register the title of the invention and the name, address, and description of the patentee. (*g*)

Where a person acquires a patent by assignment, transmission, or other operation of the law, he is entitled, on proving his title to the satisfaction of the Comptroller, to have his name placed on the Register as proprietor. (*h*)

At the same time, there is no obligation upon an assignee to register his assignment if he chooses to incur the risk of not doing so. "I understand," said Lindley, M.R., in the *New Ixion Tyre Company* v. *Spilsbury*, "the words 'shall be registered,' in Section 23, as addressed to the Registrar. It is his business. He has to keep the Register; but there is no obligation on the assignee to register the assignment if he does not wish to. Of course he takes his chance, if he does not, of having his title defeated by some one else who does register; but there is no breach of any duty in not registering under Section 23." (*i*)

Whether the assignment is of the whole patent rights, or of a share only, and whether for a part or the whole of the United Kingdom, the assignee is equally entitled to be placed on the register as owner to the extent of his interest.

Application for Registration how made.—The request for registration, whether as complete or partial proprietor, should be addressed to the Comptroller and left at the Patent Office. (*j*) It must be signed by the person requiring to be registered or by his agent duly authorised; and state the name, address, and description of the person claiming to be entitled to the patent or a share or interest therein, and the particulars of the assignment, transmission, or other operation of law by virtue of which such person requires to be entered in the Register, so as to shew the manner in which, and the person or persons to whom, the patent or such share or interest has been assigned or transmitted. (*k*)

A body corporate may be registered as proprietor of a patent. (*l*) In the case of a body corporate, the request for registration should be signed by their duly authorized agent. (*m*)

(*f*) Patents Act, 1883, s. 88; P. R. rule 78.
(*g*) P. R. rule 67.
(*h*) Patents Act, 1883, s. 87; P. R. rule 86.
(*i*) 15 R. P. C. p. 571.
(*j*) P. R. rule 68.
(*k*) Ibid. 70.
(*l*) Ibid. 73.
(*m*) Ibid. 69.

Every assignment and every other document containing, giving effect to, or being evidence of the transmission of a patent or affecting the proprietorship thereof, as claimed by the request, except such documents as are matters of record (of which an official or certified copy is sufficient), must be produced to the Comptroller with the request. (*n*) The claimant for registration must also leave an attested copy of the assignment or other document of which production is required. If that document is a matter of record, the copy left must be an official certified copy. (*o*)

Effect of Registration.—The person entered on the Register is the legal owner of the patent and, subject to any rights appearing by the Register to be vested in any other person, has power absolutely to assign, grant licenses as to, or otherwise deal with the patent, and to give effectual receipts for any consideration for such assignment, license, or dealing. (*p*)

Mortgages.—Although a notification of a mortgage of a patent may properly be entered on the Register, a mortgagee is not entitled to be entered as proprietor, for in equity the mortgagor continues to be the owner. (*q*)

Assignees.—The assignments which may be registered are not confined to legal assignments by deed. Any documents operating as an equitable assignment may likewise be registered; for such documents, though they do not alter the proprietorship of a patent, "affect" it by giving the person in whose favour they operate a right in equity to have the proprietorship altered at law. (*r*)

In *Stewart* v. *Casey*, a letter in the following terms had been registered by the Comptroller: "Dear Sir,—Stewart and Charlton's Patents.—We now have pleasure in stating that in consideration of your services as the practical manager in working our patents as above for transit by steamer, or for any land purpose, we agree to give you one third share of the patents above mentioned, the same to take effect from this date. This is in addition to, and in combination with, our agreement of the 29th November last." A motion having been made to expunge the entry, the Court declined to make the order, holding that this letter operated as an equitable assignment of one-third of the patents, and as such affected the proprietorship and was properly registered. (*s*)

(*n*) P. R. rule 71.

(*o*) Ibid. 72.

(*p*) Patents Act, 1883, s. 87. But this does not defeat existing equities in respect of the patent. See *New Ixion Tyre Co.* v. *Spilsbury*, 15 R. P. C. p. 571.

(*q*) *Van Gelder* v. *Sowerby Bridge*, 7 R. P. C. 208.

(*r*) Per Bowen, L.J., in *Stewart* v. *Casey*, 9 R. P. C. p. 14.

(*s*) 8 R. P. C. 259; 9 R. P. C. 9.

Parol Agreements not Registered.—The intention of the Act is that written documents, and not mere parol licenses or agreements, shall be notified in the Register. A document to be entitled to registration must also be on its face a completed agreement between the parties to it. In *Fletcher's Patent*, (*t*) an agreement to grant a license on terms as to royalties to be mutually agreed upon was refused registration; for an incomplete agreement does not affect the ownership of the patent or give any one a legal or equitable title to it. In this case North, J., held that it was immaterial that a supplemental verbal agreement completing the terms left incomplete in the written document had subsequently been arrived at between the parties. It would have been otherwise had such second agreement been reduced to writing, in which event both documents might, as constituting one agreement, have been registered together.

Agreements Prior in Date to the Patent.—Agreements entered into some considerable time before the patent is granted ought not to be entered upon the Register as affecting the ownership.

Whether such an agreement if made just before the patent was sealed might properly be entered is doubtful.

In *Parnell's Patent*, (*u*) the agreement which it was sought to register was dated nearly three years before the sealing of the patent, and referred in general terms to patents it was proposed to form a syndicate to take up. The Comptroller refused registration, and North, J., on a motion to make the entry, held that this refusal was right.

Change of Owner's Name.—When a company or private person who is registered as proprietor of a patent changes its or his name, the Comptroller has jurisdiction under Section 87 of the Patents Acts, 1883, to enter the altered name on the Register as a change of proprietorship arising by operation of law. "It is clear," said North, J., in *ex parte New Ormonde Cycle Co.*, (*v*) "that if a company which is the proprietor of a patent changes its name, or if a lady who is the proprietor of a patent changes her name by marriage, the object and intention of the Statute is that the name of the proprietor should appear on the Register; and that is the present name of the company or person—not the name that the company or person may have had in some time past, but which for every other purpose has been given up ever since the legal change of

(*t*) 10 R. P. C. 252; 62 L. J. Ch. 938; 69 L. T. 129.

(*u*) 5 R. P. C. 126.

(*v*) [1896] 2 Ch. p. 523; 13 R. P. C. 475; 65 L. J. Ch. 785.

name, or the marriage, took place. When one looks at Section 78 and Section 87 together, it is quite clear what the Act contemplates. What is intended is that the Register shall contain a perfect record, complete up to date, of the names and addresses of the proprietors. It is for the public benefit that the Register is kept, and it ought to be kept correct up to date."

Entries by Joint Patentees.—One of two joint patentees is not entitled to have an entry put upon the Register which purports to affect or prejudice the rights of the other. If he does so, such entry will be expunged on the application of the aggrieved patentee. (*w*)

The Register is intended to be a record of facts, not of legal inferences (*x*).

Notice of Trusts not Registered.—Section 85 of the Patents Act, 1883, provides that no notice of any trust, express, implied, or constructive, shall be entered on the Register. In *Hazlett* v. *Hutchinson*, (*y*) an agreement had been entered into by the owner of certain patents with a promoter who undertook to promote a company to acquire the patents, his remuneration to be a share of the proceeds of the sale. The agreement was conditional on the formation of the company within a certain time. The patentee alleging that the condition was broken, declined to recognize the agreement further, whereupon the promoter registered an entry of the agreement at the Patent Office. But Kekewich, J., on the application of the patentee, ordered the entry to be expunged, as causing the very mischief the Act intended to prevent.

The meaning of this provision prohibiting the registration of trusts was discussed by the Court of Appeal in *Stewart* v. *Casey* (*z*). In that case it was contended that a letter which operated as an equitable assignment fell within the section. In rejecting this view, Bowen, L.J., said: "If it could be made out that an equitable assignment was not to be entered on the Register simply because it created a trust, and therefore carried with it the notice of the trust which was created; if Section 85 was to be expunged or stretched to that enormous length, then the appellants might succeed. But what does Section 85 mean? Trusts had been registered up to that time by the Patent Office; but this section intended that notices of trusts, as distinct from documents which create trusts in equity, were not to be sent to the Comptroller and entered upon the

(*w*) *Horsley & Knighton's Patent*, L. R. 8 Eq. 475, Romilly, M.R. This case was decided under the Patent Law Amendment Act, 1852, s. 38.

(*x*) *Morey's Patent*, 25 Beav. 581.

(*y*) 8 R. P. C. 457.

(*z*) 9 R. P. C. p. 15.

Register. Nobody has a right under this Act to affect the Register with the burden of a notice of a trust. That is what I think this section means. Nobody shall be in peril who may have gone to the Register and examined it, of being affected with notice of a trust or any other interest except that which appears on the Register. Then again, by Section 87, to go back for a moment to make this point clear, the assignment of the legal proprietorship of the patent is to take effect 'subject to any rights appearing from such Register to be vested in any other person.' Section 85 then becomes important. The assignee takes, subject to the rights which appear on the Register to be vested in somebody else; but nobody is to clog the Register by simply giving a notice of a trust, whether the trust is express, implied, or constructive. That does not prevent a document being entered which affects the proprietorship, nor can such document be expunged on the ground that, although it affects the proprietorship, anybody who reads the document will see there is a trust created in respect of it."

Correction of Errors in Register.—Under the provisions of the Patents Act, 1883, the Comptroller has power to correct any clerical error in, or in connection with an application for registration, as also any clerical error in the name, style, or address of a registered proprietor. (*a*)

An ampler power of correcting the Register, either by way of adding to, amending, or expunging entries is given to the Court, by Section 90 of the same Act. By that section any person aggrieved by the omission without sufficient cause of the name of any person or of any other particular from the Register, or by any entry made without sufficient cause, may apply to the Court for an order for making, expunging, or varying the entry. (*b*) The Court, on the hearing of such an application, may decide any question that it may be necessary or expedient to decide for the rectification of the Register, and may direct an issue to be tried for the decision of any question of fact, may award damages to the party aggrieved, and may make such order as to costs as it thinks fit. (*c*)

Any order of the Court rectifying the Register must direct that due notice of the rectification be given to the Comptroller. (*d*)

The application may be made by any person aggrieved. An

(*a*) Sect. 91.

(*b*) "Without sufficient cause" means not merely at the time of registration, but at any time: per Lindley, M.R., in *Batt & Co.'s Trade Marks*, 15 R. P. C. p. 539.

(*c*) Patents Act, 1883, s. 90.

(*d*) Ibid.

applicant to whom the Comptroller has refused to seal a patent is not a person aggrieved by the omission of his name from the Register within the meaning of this section. (*e*) Nor is a common informer nor a person interfering from merely sentimental motives a person aggrieved. (*f*) Such person must be a person injured or damnified in the legal sense of the word. (*g*) But the damage need not be serious or great. (*h*)

Nothing is said in the Patent Acts or Rules as to the procedure to be followed on an application to rectify the Register. (*i*) The application may be made either by summons or motion. (*j*) But although no special procedure is prescribed by the Patent Rules, the Court will require notice to be given to the party affected by the application, in order that he may have the opportunity of shewing cause against it. No particular form of notice is necessary, and in deciding whether any notice given is sufficient, the Court will deal with the matter according to the light of natural justice. All that is required is that the notice should be full, and sufficient to protect the rights of the party affected. (*k*) For though the Court requires as essential to justice that notice should be given, such notice does not go to the jurisdiction. (*l*)

Thus, in the case of *King & Company's Trade Mark*, (*m*) where the party to be affected by the application was domiciled in Ireland, a letter informing him of the proceeding and accompanied by a copy of the notice of motion was held sufficient.

Where the party concerned is a foreigner, resident out of the jurisdiction, the proper course, it would appear, is to serve notice on the Comptroller, leaving him to inform the foreigner by letter of the application and date of hearing. (*n*)

Where the registered owner or owners of a patent are resident in Scotland or Ireland, proceedings to rectify the Register may still be taken in the High Court of Justice in England, for the Irish

(*e*) *In re Trade Mark "Normal,"* 35 C. D. 231; 4 R. P. C. 123; 56 L. J. Ch. 519; 35 W. R. 464.

(*f*) *In re Apollinaris Co.*, [1891] 2 Ch. p. 224; 61 L. J. Ch. 625.

(*g*) Per Lord Selborne, C., in *Rivière's Trade Mark*, 26 C. D. p. 54; 53 L. J. Ch. 455, 578.

(*h*) *In re Apollinaris Co.*, [1891] 2 Ch. p. 225. See, also, as to "persons aggrieved," *Powell's Trade Mark*, [1893] 2 Ch. 388; 10 R. P. C. 195; [1894] A. C. 8; 11 R. P. C. 4.

(*i*) Per Lindley, L.J., in *King & Co.'s Trade Marks*, [1892] 2 Ch. p. 479.

(*j*) Per Kay, L.J. Ibid. p. 488. The Court has refused to grant the relief by way of counter-claim. *Pinto* v. *Badman*, 8 R. P. C. 181, 187.

(*k*) Per Bowen, L.J. Ibid. p. 486.

(*l*) Ibid.

(*m*) [1892] 2 Ch. 462; 10 R. P. C. 350; 62 L. J. Ch. 153.

(*n*) See *La Compagnie Generale D'Eaux Minerales et de Bains de Mer*, 8 R. P. C. 446; [1891] 3 Ch. 451.

and Scottish Courts have not exclusive jurisdiction in such case. (*o*)

The Palatine Court of Lancaster also has jurisdiction within that Palatinate. (*p*)

From the decision of the High Court an appeal lies to the Court of Appeal.

Discussing the extent to which the Court would intervene to order entries to be expunged under Section 38 of the Patent Law Amendment Act, 1852, Romilly, M.R., in *Morey's Patent*, (*q*) said: "The Court cannot go into and decide long and intricate questions of rights and titles upon this Register; that there must be some reasonable limit to the extent to which entries on it may be 'expunged, vacated, or varied' under the power contained in this section, is, in my opinion, clear. For instance, in the case of *ex parte Green*, (*r*) I was of opinion that upon a deed clearly executed for a fraudulent and improper purpose, and while the right in the patent was in another person, I might simply direct the entry to be expunged; but if a deed be perfectly good and *bonâ fide*, it would be very difficult for me to put an entry upon the Register, qualifying its effect or giving it a construction; I do not see that I could with propriety do that." (*s*)

Orders Affecting the Patent Monopoly.—Where an order has been made by her Majesty in council for the extension of a patent for a further term, or for the grant of a new patent, or where an order has been made by the Court for the revocation of a patent, or the rectification of the Register under Section 90 of the Patents Act, 1883, or otherwise affecting the validity or proprietorship

(*o*) *King & Co.'s Trade Mark*, [1892] 2 Ch. p. 481.

(*p*) 53 & 54 Vict. c. 23.

(*q*) 25 Beav. 584.

(*r*) 24 Beav. 145.

(*s*) Sect. 38 of the earlier Act (15 & 16 Vict. c. 83) was as follows: "If any person shall deem himself aggrieved by any entry made under colour of this Act in the Register of Proprietors, it shall be lawful for such person to apply by motion to the Master of the Rolls, or to any of the Courts of Common Law at Westminster in term time, or by summons to a judge of any of the said courts in vacation, for an order that such entry may be expunged, vacated, or varied; and upon any such application the Master of the Rolls or such Court or judge respectively, may make such order for expunging, vacating, or varying such entry, and as to the costs of such application, as to the said Master of the Rolls or to such Court or judge may seem fit; and the officer having the care and custody of such Register, on the production to him of any such order for expunging, vacating, or varying any such entry, shall expunge, vacate, or vary the same, according to the requisition of such order."

The terms of the present section are wider, for the Court may now "decide any question that it may be necessary or expedient to decide for the rectification of a register, and may direct an issue to be tried for the decision of any question of fact, and may award damages to the party aggrieved." Patents Act, 1883, s. 90 (2).

of letters patent, the person in whose favour such order has been made shall forthwith leave at the Patent Office an office copy of such order. The Register shall thereupon be rectified, or the purport of such order shall otherwise be duly entered in the Register, as the case may be. (*t*)

Entries as to Patent Fees.—A record of the amount and date of payment of the renewal fees is also entered in the Register. (*u*)

So likewise, if a patentee fails to make any prescribed payment within the prescribed time, or any enlargement thereof duly granted, such failure must be entered in the Register. (*v*)

Entries of Licenses.—A notification may be entered in the Register of every license granted under a patent; and for this purpose an attested copy of the license, with a request for registration, should be left at the Patent Office by the licensee. (*w*) If the licensor does not desire to disclose upon the Register the terms as to royalties, etc., on which the license is granted, these may be contained in a separate document, and incorporated by reference only in the license which is placed on the Register. In such case, however, it is necessary to produce both documents to the Comptroller, to satisfy him that the private document in fact constitutes a completed agreement between the parties. (*x*)

Entries, how Proved.—Certified copies of entries in the Register may be obtained from the Comptroller on payment of the prescribed fee. (*y*) Every certified copy is *primâ facie* evidence of the fact that the entry has been made and of its contents. (*z*) Such copies are admissible in evidence in all courts in her Majesty's dominions, and in all proceedings, without further proof or production of the originals. (*a*)

Falsification of the Register.—Any person who makes, or causes to be made, any false entry in the Register, or a writing falsely purporting to be a copy of an entry in the Register, or who produces, or tenders, or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false, is guilty of a misdemeanour. (*b*)

(*t*) P. R. rule 74.
(*u*) Ibid. 75.
(*v*) Ibid. 76.
(*w*) Ibid. 77.
(*x*) For an example of such form of license, see Appendix IV. post.
(*y*) P. R. rule 79.
(*z*) Patents Act, 1883, s. 96.
(*a*) Ibid. s. 89.
(*b*) Ibid. s. 93.

CHAPTER XVII.

ASSIGNMENTS OF LETTERS PATENT.

Right to Assign.—Letters patent may be assigned in whole or in part to one or more assignees. The power to assign is vested in the patentee by virtue of the express words of the grant, which defines the inventor in the following terms: "Hereinafter, together with his executors, administrators, and assigns, or any of them referred to as the said patentee." (*a*) If the grant did not expressly authorize assignments, none could be made, for all monopolies are illegal except such as are saved by Section 6 of the Statute of James I. (*b*)

The power to assign the letters patent, which the terms of the grant has long conferred upon the patentee, is further recognized by the Patents Act, 1883; Section 36 of which provides that "a patentee may assign his patent for any place in or part of the United Kingdom or Isle of Man, as effectually as if the patent were originally granted to extend to that place or part only." By Sections 23 and 87 notifications of the assignment of patents are required to be entered in the Register of Patents, and persons who, having become owners by assignment, have their names entered therein as proprietors, have absolute power to assign, grant licenses as to, or otherwise deal with the patents in respect of which their names are so registered.

The power to assign letters patent given by the terms of the grant itself, is thus now indirectly recognized by statutory enactment.

A patentee may assign any part or share of his patent, or his entire rights under the patent in respect of some distinct portion of the invention or of some limited geographical area. (*c*)

Formerly the number of persons to whom a patent might be

(*a*) Patents Act, 1883, schedule. See post, p. 643.

(*b*) 21 Jac. I. c. 3; *Duvergier* v. *Fellows*, 10 B. & C. 829; 1 Cl. & F. 39.

(*c*) *Dunnicliffe* v. *Mallet*, 7 C. B. (N. S.), 209; Patents Act, 1883, s. 36.

assigned was limited, (*d*) but now any number of persons, including a corporation, (*e*) may become co-owners by assignment.

Form of Assignment.—No particular form of words is required for the assignment of a patent. But as the grant is always made under seal, the assignment of a patent, or any part or share thereof, is only valid in law when likewise made by deed, (*f*) and if made by an agent, such agent must be authorized by deed for the purpose. (*g*)

Although an assignment of the legal interest in letters patent can only be made by deed, an agreement which purports to assign a patent may, though not under seal, be treated by analogy with the rule as to leases, (*h*) as an agreement to execute a legal assignment, and enforced as such.

Equitable Assignments.—Moreover, an agreement to assign a patent, if the terms and intention of the parties are clear, will operate as an equitable assignment. (*i*) Thus, as between assignor and assignee, a deed though necessary to convey the legal interest, is not required to create a contract which the Courts will recognize as binding upon the parties. (*j*) An offer contained in a letter and accepted verbally was held to constitute a good contract for the assignment of a patent in *Smith* v. *Neale*; (*k*) and in *Stewart* v. *Casey*, (*l*) an agreement contained in correspondence to give "one third share of the patents above mentioned, the same to take effect from this date," was held to be an equitable assignment and to take immediate effect as such.

An equitable assignee is not, however, in so advantageous a position as a legal assignee. He cannot sue infringers of the patent in his own name, (*m*) and his equitable title is liable to be defeated by a subsequent assignee taking a legal assignment without notice of the prior equitable interest.

An assignment may be made of the whole or part only of the letters patent. (*n*) If made after a prior assignment, of which the

(*d*) See Patents Act, 1852, s. 36.

(*e*) Patents Act, 1883, s. 117; P. R. rule 73.

(*f*) Co. Lit. 9b, 172a; Lincoln Coll. Ca. 3 Co. Rep. 63a; *Casey's Patents*, [1892] 1 Ch. pp. 110, 113.

(*g*) *Hazlehurst* v. *Rylands*, 9 R. P. C. 7.

(*h*) *Tidey* v. *Mollett*, 33 L. J. C. P. 235; *Bond* v. *Rosling*, 1 B. & S. 371; *Parker* v. *Taswell*, 2 De G. & J. 559.

(*i*) *Fletcher's Patent*, 10 R. P. C. 252; *Parnell's Patent*, 5 R. P. C. 126; *Haslett* v. *Hutchinson*, 8 R. P. C. 457.

(*j*) Such an agreement may be enforced by specific performance: *Lewin* v. *Brown*, 14 W. R. 640.

(*k*) 26 L. J. C. P. 143.

(*l*) [1892] 1 Ch. 104; 8 R. P. C. 259; 9 R. P. C. 9; 61 L. J. Ch. 61.

(*m*) *Kensington* v. *Lane Fox*, [1891] 2 Ch. 573. If he threatens an action he may be restrained by injunction.

(*n*) *In re Morey's Patent*, 25 Beav. 581; *Dunnicliffe* v. *Mallet*, 7 C. B. (N. S.), 209;

subsequent assignee has notice, such assignee is bound by such notice; (*o*) and even where the notice only suggested that a license to work and use a portion of the invention (and not an assignment) had been previously granted, the subsequent assignee was held bound none the less, for this should have put him on enquiry to ascertain the real nature of the prior interest. (*p*)

No Implied Warranty of Validity.—The Courts will not read into an assignment of a patent any implied warranty by the assignor that the letters patent assigned are valid. (*q*) Dealing with this point in *Hall* v. *Conder*, the Court of Common Pleas said: (*r*) "The plaintiff professed to have invented a method for the prevention of boiler explosions. It is not alleged that he was guilty of any fraud. He must, therefore, have been an inventor, for if he was not he must have known it, and would have been guilty of fraud in pretending to have invented. Whether he was the true and first inventor, within the meaning of the Statute of James, is another question. The first material allegation in the plea is, that the alleged invention was wholly worthless, and of no utility to the public. Now, that was a matter as much within the knowledge of the defendants as of the plaintiff. The next allegation, viz. that it was not new as to the public use thereof in England, and that the plaintiff was not the first and true inventor thereof, was also a matter as much within the knowledge of the defendants as of the plaintiff. They had the same means of enquiring into the fact, and of learning whether it had been in use, or the invention had been previously made known in England. Why, therefore, should we assume that the plaintiff meant to assert that the patent was indefeasible, and that the defendants purchased on that understanding, rather than that, each knowing what the invention was, and having equal means of ascertaining its value, they contracted for the patent, such as it was, each acting on his own judgment? We think that the latter was the true nature of the contract, and that there was no warranty, express or implied."

In *Cropper* v. *Smith*, (*s*) Cotton, L.J., said: "As a rule, people do

Walton v. *Lavator*, 29 L. J. C. P. 275; *Stewart* v. *Casey*, 8 R. P. C. 259; 9 R. P. C. 9.

(*o*) *Hassall* v. *Wright*, L. R. 10 Eq. 509.

(*p*) *In re Morey's Patent*, 25 Beav. 581.

(*q*) *Hall* v. *Conder*, 2 C. B. (N. S.), 22, 53; 26 L. J. C. P. 138; *Smith* v. *Neale*, 2 C. B. (N. S.), 67; 26 L. J. C. P. 143; *Smith* v. *Buckingham*, 18 W. R. 314; 21 L. T. (N. S.), 819; *Liardet* v. *Hammond*, 31 W. R. 710; *Cropper* v. *Smith*, 1 R. P. C. 94.

(*r*) Per Cresswell, J., 26 L. J. C. P. p. 143.

(*s*) 1 R. P. C. p. 92.

not rely on any statements made by the patentee, but they buy the patent, forming their own opinion as to whether it is good or valuable, and as to its worth; taking their chance, unless it has been established, of their failure to establish its validity when the case comes into a court of law." And in the same case, Bowen, L.J., said: "What sensible being in this world who buys a patent buys it on the strength of the assertion made by the patentee in the petition that the patent is new? We know that everybody who buys it, as a rule, takes it for what it is worth." (*t*)

Assignments in Futuro.—An assignment of a patent expressed to take effect upon the happening of some future event vests the patent in the assignee without further assignment on the happening of that event. (*u*)

Persons, however, to whom a patentee has agreed to assign his letters patent, although by virtue of such agreement they may be equitable owners, are not, as above mentioned, entitled to take legal proceedings against infringers, nor are they entitled to threaten such infringers; and, if they do so, they may be restrained by injunction. (*v*)

An assignment of a patent not yet granted may also be made by the applicant to take effect when the letters patent are obtained. (*w*)

So, likewise, an assignment of a patent coupled with an assignment of all improvements which may subsequently be effected in the invention by the assignor, is good, and will operate as an assignment of any patent subsequently granted for such invention. (*x*)

But where an assignor of letters patent who covenanted that any improvements on the inventions assigned, of which he should during the continuance of the patents become possessed, should be held to be part of the property assigned, subsequently became by purchase interested with others in two patents not relating to the assigned inventions, such patents were held not to pass to the assignee under the covenant. (*y*)

Effect of Assignment.—The legal assignee of a patent is the legal owner, and entitled to sue in respect of any infringement;

(*t*) 1 R. P. C. p. 94

(*u*) *Cartwright* v. *Arnatt*, 2 Bos. & P. 43.

(*v*) *Kensington* v. *Lane Fox*, [1891] 2 Ch. 573.

(*w*) *Parnell's Patent*, 5 R. P. C. 126. Cf. as to assignments of future acquired property *Official Receiver* v. *Tailby*, 13 App. Ca. 523.

(*x*) *Pneumatic Tyre Co.* v. *Dunlop*, 13 R. P. C. 553; *London Hosiery Co.* v. *Griswold*, 3 R. P. C. 251. Such an assignment is not contrary to public policy: *Printing & Numerical Registering Co.* v. *Sampson*, L. R. 19 Eq. 462.

(*y*) Ibid.

and where an assignment has been made to several assignees jointly, one may sue an infringer alone without joining his co-assignees. (*z*) He will only be entitled, however, in such case to such proportion of the damages recovered as represents his actual interest in the letters patent. (*a*)

Rights of Co-owners.—Where a patent is vested in several assignees, no one of them can assign the whole patent, for the disposable interest of each is limited to the extent of his own individual share. (*b*)

But any one of such assignees may himself use the invention without accounting to the rest for the profits he makes thereby: the position of joint assignees being that of co-owners who derive from the patent not so much a right to work the invention as a right to exclude the rest of the world from doing so.

If this were not the law, it might, where co-owners disagreed, be impossible to work a patented invention at all; and in any case, an indolent and parsimonious co-owner could step in and claim to share the profits solely attributable to the capital and energy of another, who had spent his time and money in pushing the invention. (*c*)

In *Steers* v. *Rogers*, (*d*) Lord Herschell, C., dealing with the respective rights of co-assignees to work the patented invention, said: "What is the right which a patentee has or patentees have? It has been spoken of as though a patent right were a chattel, or analogous to a chattel. The truth is that letters patent do not give the patentee any right to use the invention; they do not confer upon him a right to manufacture according to his invention. That is a right which he would have equally effectually if there were no letters patent at all; only, in that case, all the world would equally have the right. What the letters patent confer is the right to exclude others from manufacturing in a particular way, and using a particular invention. When that is borne in mind, it appears to me very clear that it would be impossible to hold, under these circumstances, that where there are several patentees, either of them, if he uses the patent, can be called upon by the others to pay to them a portion of the profits which he makes by that manufacture; because they are all of them entitled, or,

(*z*) *Dunnicliffe* v. *Mallet*, 7 C. B. (N. S.), 209; *Sheehan* v. *Great Eastern Railway Co.*, L. R. 16 C. D. 63.

(*a*) *Dent* v. *Turpin*, 30 L. J. Ch. 495; 2 J. & H. 139.

(*b*) *In re Horsley*, L. R. 8 Eq. 475.

(*c*) See Romer, J., in *Steers* v. *Rogers*, [1892] 2 Ch. p. 18. Cf. Lord Cranworth in *Mathers* v. *Green*, L. R. 1 Ch. 3.

(*d*) [1893] A. C. 235; 10 R. P. C. 251.

perhaps, any of them is entitled to prevent the rest of the world from using it."

In the case of a patent belonging to several persons in common, each co-owner can assign his share and sue for an infringement; (*e*) he can also work the patent himself, give licenses to others to work it, and sue for royalties payable for its use. (*f*) Further, it has been held that even if he is mortgagee of the other share, (*g*) he is entitled to retain for his own benefit whatever profit he may derive from working the patent; although it is still open to question whether he is not liable to account to his co-owners for what he receives in respect of licenses. (*h*)

In *Bergmann* v. *Macmillan*, (*i*) where the assignment was of a share in the profits arising from the working of a patent under licenses, Fry, J., held that one assignee was not entitled to an account of profits from the licensees in the absence of the other assignees; and that, in order to avoid multiplicity of actions, the account must be taken once for all in the presence of all the persons interested, and that the other assignees ought to have been joined.

While the general rule is that any one of several co-owners of a patent is entitled to work the invention, and enforce the patent against strangers, without being liable to account to the other owners, yet a special agreement for the working of a patent may create a partnership between co-owners, binding them to work it only for the common advantage, and disentitling each to more than his proportionate share of the profits. (*j*)

Position of an Assignee.—Where the assignor of a patent parts by assignment with the whole of his interest, and attempts subsequently to use the invention, he is liable to an action for infringement at the suit of his assignee, and in such action he cannot set up the defence that the patent is in fact invalid. (*k*) Nor can an assignee, as against his assignor, allege the invalidity of the patent. (*l*)

(*e*) *Lindley on Partnership*, 6th edit. p. 36; *Dunnicliffe* v. *Mallet*, 7 C. B. (N. S.), 209; *Walton* v. *Lavator*, 8 C. B. (N. S.), 162; *Dent* v. *Turpin*, 2 J. & H. 139.

(*f*) *Sheehan* v. *Great Eastern Railway*, 16 C. D. 59.

(*g*) *Steers* v. *Rogers*, [1892] 2 Ch. 13.

(*h*) Ibid.; *Mathers* v. *Green*, 1 Ch. 29. See, also, the same point discussed but not decided in *Hancock* v. *Bewley*, 1 Johns. 601; *Russell's Patent*, 2 De G. & J. 130; *Horsley & Knighton's Patent*, 8 Eq. 475.

(*i*) 17 C. D. 423.

(*j*) See *Lindley on Partnership*, 6th edit. pp. 64, 575.

(*k*) *Hocking* v. *Hocking*, 6 R. P. C. p. 72; *Walton* v. *Lavator*, 29 L. J. C. P. 275; *Chambers* v. *Crichley*, 33 Beav. 374.

(*l*) *Oldham* v. *Longmead*, 3 T. R. 439-441. Although an assignee is estopped from denying the validity of the patent assigned by him, the Court will not

On the death of a patentee the patent passes to his executors and administrators; and the executors may execute a valid assignment of the patent before registering probate. (*m*)

On bankruptcy letters patent pass to the trustee in bankruptcy; and if a bankrupt, prior to his discharge, takes out a patent, his creditors are entitled to the benefit of it. (*n*) A patentee who has become bankrupt, and whose letters patent have been sold by his trustee in bankruptcy, is not estopped from contesting the validity of the grant if subsequently sued by the purchaser for infringement. (*o*)

Assignees may petition for prolongation of a patent, but for this purpose they do not stand on the same favourable footing as an original patentee. (*p*)

Mortgages of Patent Rights.—A mortgage of a patent differs from an assignment in that a mortgagor in possession continues to be the person entitled to the benefit of the patent, and therefore remains the patentee within the meaning of Section 87 of the Patents Act, 1883, and is entitled to take proceedings in his own name against infringers. (*q*) It is no objection to such a proceeding that the mortgagees have not been joined as plaintiffs. (*r*) The mortgagor, notwithstanding the mortgage, still has substantial rights, and the general rule of law is that no man loses his right to protect his property against the wrong-doing of a stranger simply because he has mortgaged it. (*s*)

The mortgagee of a patent is not entitled by virtue of his mortgage to be entered on the Register of Proprietors. (*t*)

The equitable assignee of a patent or of the share of a patent, on the other hand, is entitled to have his assignment entered on the Register as a document which affects the proprietorship of the patent. (*u*)

The assignee of an assignee takes subject to the liabilities of

restrain him by injunction from giving evidence against such patent in an action between his assignee and third parties; nor from communicating to third parties information tending to shew that such patent is invalid. See the *London Hosiery Co.* v. *Griswold*, 3 R. P. C. 251.

(*m*) *Elwood* v. *Christie*, 10 Jur. (N. S.), 1079; 17 C. B. (N. S.), 754; 34 L. J. C. P. 130.

(*n*) *Hesse* v. *Stevenson*, 3 Bos. & B. 565; *Bloxam* v. *Elsee*, 6 B. & C. 169; 9 Dowl. & R. 215.

(*o*) *Cropper* v. *Smith*, 26 C. D. 700; 10 App. Ca. 249; 55 L. J. Ch. 12.

(*p*) *Hopkinson's Patent*, 14 R. P. C. 5; and see p. 376.

(*q*) *Van Gelder* v. *Sowerby Bridge*, 7 R. P. C. 208; L. R. 44 C. D. 374.

(*r*) Ibid.

(*s*) Per Bowen, L.J., ibid. p. 215. In such case, however, the defendants may apply to have the mortgagees joined as co-defendants (Order XVI. r. 11), which may be necessary if an account is ordered.

(*t*) *Van Gelder* v. *Sowerby Bridge*, supra.

(*u*) *Stewart* v. *Casey*, 9 R. P. C. p. 15.

the original assignee, and where the terms of the first assignment provide for an account of profits being rendered to the assignor, he may be sued direct by the assignor for not accounting. (*v*)

Where two patents were assigned with a reservation by the assignor of the right to personally work the patents in each case, such right not to be transferable, it was held that the assignor was not entitled to employ other persons with whom he had entered into partnership to manufacture for him under the patents. (*w*)

An assignee who, by the terms of his assignment, covenants to pay a royalty on any article manufactured and sold under the patent, is not thereby impliedly bound to go on manufacturing; that obligation must be imposed upon him, if at all, by an express condition. (*x*) Nor is such an assignee liable if through inadvertence and no want of good faith on his part, the patent lapses through non-payment of the renewal fees, unless he has expressly covenanted to pay them. (*y*)

The assignment of a patent is not a conveyance within the meaning of the Conveyancing Act, 1881, Section 7. (*z*) But a share in a colonial patent and a sole license to use it in a specified district, are "property" within Section 59 (1) of the Stamp Act, 1891, and an agreement for their sale in England carries *ad valorem* stamp duty as if an actual conveyance on sale. (*a*)

Copies of deeds and any other documents affecting the proprietorship in any letters patent must be supplied to the Comptroller for filing in the Patent Office, (*b*) the originals also being produced to the Comptroller when the assignee makes his request to be registered. (*c*)

Assignment to the Secretary of State for War.—The inventor of any improvement in instruments or munitions of war, his executors, administrators, or assigns, may assign to her Majesty's Principal Secretary of State for the War Department, on behalf of her Majesty, all the benefit of the invention and of any patent obtained or to be obtained for the same. (*d*)

Such assignment effectually vests in the Secretary of State for

(*v*) *Werderman* v. *Societé Generale d' Electricité*, L. R. 19 C. D. 247.

(*w*) *Howard* v. *Tweedale*, 12 R. P. C. 519.

(*x*) *In re Railway Electrical Appliances Co.*, L. R. 38 C. D. 597.

(*y*) Ibid.

(*z*) *Guyot* v. *Thomson*, 11 R. P. C. p. 554 (per Lindley, L.J.).

(*a*) *Smelting Co.* v. *Commissioners of Inland Revenue*, L. R. [1896] 2 Q. B. 179; [1897] 1 Q. B. 175; 65 L. J. Q. B. 513; 66 L. J. Q. B. 137; 45 W. R. 61, 203.

(*b*) Patents Act, 1883, s. 23 (3).

(*c*) P. R. rule 71; see ante, Register of Patents, pp. 319, 320.

(*d*) Patents Act, 1883, s. 44 (1).

War for the time being the benefit of the invention and patent. All covenants and agreements contained in the assignment for keeping the invention secret and otherwise are valid and effectual, notwithstanding any want of valuable consideration, and may be enforced by the Secretary for War for the time being. (*e*)

Where any such assignment has been made to the Secretary of State, he may at any time before the application for a patent for the invention, or before publication of the specification or specifications, certify to the Comptroller his opinion that, in the interest of the public service, the particulars of the invention and of the manner in which it is to be performed should be kept secret. (*f*)

If the Secretary of State so certifies, the application and specification or specifications with the drawings (if any), and any amendment of the specification or specifications, and any copies of such documents and drawings, shall, instead of being left in the ordinary manner at the Patent Office, be delivered to the Comptroller in a packet sealed by authority of the Secretary of State. (*g*)

Such packet shall, until the expiration of the term or extended term during which a patent for the invention may be in force, be kept sealed by the Comptroller, and shall not be opened save under the authority of an order of the Secretary of State, or of the Law Officers. (*h*)

Such sealed packet shall be delivered at any time during the continuance of the patent to any person authorized by writing under the hand of the Secretary of State to receive the same, and shall, if returned to the Comptroller, be again kept sealed by him. (*i*)

On the expiration of the term or extended term of the patent, such sealed packet shall be delivered to any person authorized by writing under the hand of the Secretary of State to receive it. (*j*)

Where the Secretary of State certifies as aforesaid after an application for a patent has been left at the Patent Office, but before the publication of the specification or specifications, the application, specification or specifications, with the drawings (if any), shall be forthwith placed in a packet sealed by authority of the Comptroller, and such packet shall be, subject to the foregoing provisions respecting a packet, sealed by authority of the Secretary of State. (*k*)

No proceeding by petition or otherwise lies for the revocation of

(*e*) Patents Act, 1883, s. 44, sub-s. 2.
(*f*) Ibid. sub-s. 3.
(*g*) Ibid. sub-s. 4.
(*h*) Ibid. sub-s. 5.
(*i*) Ibid. sub-s. 6.
(*j*) Ibid. sub-s. 7.
(*k*) Ibid. sub-s. 8.

a patent granted for an invention in relation to which the Secretary of State has certified as aforesaid. (*l*)

No copy of any specification or other document or drawing required by Section 44 of the Patents Act, 1883, to be placed in a sealed packet, shall in any manner whatever be published or open to the inspection of the public; (*m*) but the Secretary of State may, at any time by writing under his hand, waive the benefit of this provision with respect to any particular invention, and the specifications, documents, and drawings shall in such case be kept and dealt with in the ordinary way. (*n*)

The communication of any invention for any improvement in instruments or munitions of war to the Secretary of State, or to any person or persons authorized by him to investigate the same or the merits thereof, is not, and nothing done for the purposes of the investigation is, deemed to be a use or publication of such invention so as to prejudice the grant or validity of any patent for the same. (*o*)

(*l*) Patents Act, 1883, s. 44, sub-s. 9.
(*m*) Ibid. sub-s. 10.
(*n*) Ibid. sub-s. 11.
(*o*) Ibid. sub-s. 12.

CHAPTER XVIII.

LICENSES TO USE PATENTED INVENTIONS.

Patent Licenses authorized by the Terms of the Grant.—During the continuance of the patent term the patentee may license other persons to use his invention. In granting such license he does not, as in the case of an assignment, part with the ownership of the letters patent; he merely invests the licensee with an authority which exempts him from the consequences he would otherwise incur as an infringer of the patentee's monopoly. (*a*)

The right of a patentee to license persons to use his invention is recognized by the provisions contained in the form of letters patent authorized by the Patents Act, 1883; for the form of grant scheduled to that Act confers upon the patentee the sole privilege of making, using, exercising, and vending his invention "by himself, his agents, or licensees;" while, by one of the closing provisoes, the like right is expressly reserved as follows: "Nothing herein contained shall prevent the granting of licenses in such manner and for such consideration as they may by law be granted."

The License need not be under Seal.—The prohibitory part of the grant directed against infringers of the patentee's monopoly would seem to suggest that a license, to be valid, must be under seal, the prohibition forbidding the making use of, or putting in practice the invention, without the consent, license, or agreement of the patentee in writing, under his hand and seal. It has, however, long been determined that a valid license can be given otherwise than by deed.

In *Chanter* v. *Dewhurst*, (*b*) the defendants, who were licensees of the plaintiff under an agreement for the use of an invention for a patent furnace, made use of the invention, but declined to pay

(*a*) See *Heap* v. *Hartley*, 6 R. P. C. 495; *Muskett* v. *Hill*, 5 Bing. N. C. 707; *Thomas* v. *Sorrell*, Vaughan's Reps. 351; *Newby* v. *Harrison*, 1 J. & H. 393; 3 De G. F. & J. 287.

(*b*) 12 M. & W. 823; 13 L. J. Ex. 198.

the stipulated price, on the ground that the license, not being under seal, did not comply with the conditions of the letters patent, and was void.

The Court, however, declined to adopt this view, and, while deciding the case against the defendants upon the ground of their actual user of the invention under the license, expressed the opinion that, in any event, the defence that the license was not under seal would not have availed them. "To grant a license not under seal," said Alderson, B., "may be a contempt of the Crown, but does not exempt the man to whom it is granted, and who derives a benefit from it, from paying the price of it." "It is difficult," said Parke, B., "to give effect to all the words of the patent."

In the later case of *Crossley* v. *Dixon*, (*c*) the point was finally determined by the House of Lords; it being there held that a license given by a verbal agreement merely, was valid, and that the persons so licensed were estopped from denying the validity of the licensor's patent.

Therefore, notwithstanding the terms of the grant, a deed is not necessary to the legal creation of the relationship of licensor and licensee under a patent; and a license given by any agreement in writing, or even by parol, will be enforced between the parties.

In equity, a mere agreement to grant a license where the terms are concluded between the parties is sufficient, and will be enforced by the Court just as if an actual license had been granted.

Commenting on this in the *Post Card Automatic Company* v. *Samuel*, (*d*) Stirling, J., said: "The question has often arisen with reference to the sale of land, when a proposal has been made in terms by a letter, and has been accepted by a letter, subject to the preparation of a formal agreement, whether a contract had been come to between the parties; and there are cases which have gone the length of saying that until a formal agreement is prepared, the parties are not bound. But this is not a case of that nature at all. This relates to the execution of a license by the company, an instrument by which the rights of the parties are to be legally and definitely ascertained. It is much more like the granting of a lease, or the execution of a conveyance, than the preparation of a formal agreement which is to embody the agreement between the parties; and if an agreement is made for a lease in which all the terms are ascertained, and it is made subject to the execution of a formal lease by the parties, then I take it that

(*c*) 10 H. of L. Ca. 293; 32 L. J. Ch. 617. (*d*) 6 R. P. C. 562.

nobody would say that the execution of the lease was a condition precedent to there being an agreement between the parties. Here it seems to me that the true meaning of these letters was this, that the parties became bound, the one to grant, and the other to accept, a license for the use of these patent rights, such license to contain powers for the grantors of the license to sue for commuted royalties and seize the machines and revoke the license, if the instalments of £250 which were payable quarterly were not paid. That was the agreement between the parties: then it follows that in equity they stand in the same position as if they had executed a license, and the power which is stipulated for had been actually reserved."

Various Kinds of Licenses.—A patent license may be a bare license, in which case, whether exclusive or not, it is revocable at will; or it may be a license coupled with an interest in the invention to which it relates. If coupled with an interest the Court will construe it as irrevocable and binding on both parties for the full period for which it purports to be granted; though the failure to observe conditions incorporated in it may entitle the licensor to treat the license as forfeited and sue the licensee as an infringer. (*e*)

A patentee may impose what conditions he thinks fit upon his licensees; and if they accept licenses from him with knowledge of such conditions, they are bound by them. (*f*)

The license may extend to the whole or a part only of the invention. It may also limit the exercise of the privilege it confers to a specified geographical area or extend it to the whole of the United Kingdom. (*g*)

It may further limit the use of the patented article to a conditional user; *e.g.* a use only in conjunction with some other article sold by the patentee. (*h*)

There is no limit to the number of persons to whom a patentee may grant the authority of his license. Where, however, he grants an exclusive license, no further license can, it would seem, be granted by him for the same invention in respect of the same district without the breach of an implied contract with the exclusive licensee not to make such grant. (*i*)

(*e*) *Ward* v. *Livesey*, 5 R. P. C. 102.

(*f*) *Incandescent Gas Light Co.* v. *Cantelo*, 12 R. P. C. 264; *Crosthwaite* v. *Steel*, 6 R. P. C. 190; *Bown* v. *Humber Co.*, 6 R. P. C. 9.

(*g*) As instances of local licenses, see *Lovell* v. *Hicks*, 2 Y. & C. 46; *Smelting Co. of Australia* v. *Inland Revenue*, [1896] 2 Q. B. 179; [1897] 1 Q. B. 175; 45 W. R. 61, 203; 74 L. T. 694; 75 L. T. 534.

(*h*) *Incandescent Gas Light Co.* v. *Brogden*, 16 R. P. C. 179.

(*i*) See Fry, L.J., in *Heap* v. *Hartley*, 42 C. D. 470.

A Bare License.—A bare license does not amount to a grant, and passes no interest, it merely makes an action lawful which without it would be unlawful. (*j*) At common law such a license is revocable even if under seal. (*k*)

The fact that a license is exclusive does not alter its character; it still remains, in the absence of special circumstances, a bare license and, as such, revocable at will; the mere exclusiveness of the license not conferring upon the licensee any interest in the invention itself.

A bare license, therefore, whether exclusive or not, as it passes no interest to the licensee, does not entitle him to sue in his own name a person acting in violation of the patent right.

Commenting on this, in *Heap* v. *Hartley*, (*l*) Cotton, L.J., said: "It is said that this is an exclusive license, and must be construed in the same manner just as if it had been a grant of a patent right for a limited period, and for a limited space. But it is a very different thing; and some of the cases that have been referred to shew clearly the distinction between licenses which amount to a grant and licenses which do not do so. One of these cases is the ice case, (*m*) and there the Vice-Chancellor shews that where there is only a license which does not entitle the licensee to take anything away, or to acquire any property, then the license simply remains a license, that is, an authority from the person who grants it to the person who receives it, enabling him to do lawfully that which without the license he could not do. . . . In my opinion the license in this case, although it is an exclusive license, and for a limited time, can in no way be considered as a grant of the letters patent, but is simply a license to do that which without that license would be a violation of the monopoly of the patentee."

In the same case, Fry, L.J., defined an exclusive license as follows: "An exclusive license is only a license in one sense; that is to say, the true nature of an exclusive license is this. It is a leave to do a thing, and a contract not to give leave to anybody else to do the same thing. But it confers, like any other license, no interest or property in the thing. A license may be, and often is, coupled with a grant, and that grant conveys an interest in

(*j*) *Muskett* v. *Hill*, 5 Bing. N. C. 694; *Newby* v. *Harrison*, 1 J. & H. 393; *Heap* v. *Hartley*, 42 C. D. 468; *Smelting Co. of Australia* v. *Inland Revenue*, [1896] 2 Q. B. 183.

(*k*) *Wood* v. *Leadbitter*, 13 M. & W. 838; 14 L. J. Ex. 161; *Coppin* v. *Lloyd*, 15 R. P. C. 378.

(*l*) 42 C. D. p. 468; 6 R. P. C. 495.

(*m*) *Newby* v. *Harrison*, 1 J. & H. 393.

property. But the license, pure and simple and by itself, never conveys an interest in property. It only enables a person to do lawfully what he could not otherwise do, except unlawfully. I think, therefore, that an exclusive licensee has no title whatever to sue." (*n*)

An exclusive license is therefore less advantageous than an assignment of the patent right even over a limited area; (*o*) for the assignee can sue in respect of infringements within that area, whereas the licensee cannot. It would also seem that if the licensor has granted other licenses within the same district, the exclusive licensee has no remedy in respect of the injury which may thus be done him, except against his licensor.

Further, an exclusive licensee for a limited area has likewise no remedy if persons who have purchased, without notice of his license, articles made according to the patent beyond his district, proceed to sell them within it. (*p*)

A License Coupled with an Interest.—A license, however, may be something more than a bare license; it may be a license coupled with an interest, and thus amount to a grant. Where this is the case the license is not revocable at will.

The following cases illustrate the circumstances under which the Court will hold that an interest passes with the license, and gives it the character of a grant.

In *Ward* v. *Livesey*, (*q*) the license was an authority enabling the licensees not merely to make the patented articles, but also to sell them when made to any persons they liked, and at any profit they liked, provided they paid the stipulated royalty and complied with the terms and conditions of the license. This was held to be a license coupled with an interest, and, as such, not revocable at will.

In *Guyot* v. *Thomson*, (*r*) an exclusive license which had been granted under seal by the patentee, as beneficial owner for the residue of the patent term, provided (*i.a.*) that the licensee should push the sale of the invention, that the licensor should not commence proceedings against infringers without the consent in writing of the licensee, and that the licensee should have the option of terminating the license on six months' notice. This was held not to be a mere license, but a grant to use the patent

(*n*) 42 C. D. p. 470.

(*o*) As authorized by the Patents Act, 1883, s. 36.

(*p*) *Heap* v. *Hartley*, 5 R. P. C. 603; 42 C. D. 461.

(*q*) 5 R. P. C. 105.

(*r*) 11 R. P. C. 541.

coupled with obligations both on the grantor and the grantee, and, as such, almost to amount to an assignment, and to be inconsistent with a right in the licensor to revoke it.

Rights of the Licensee.—A license to manufacture and sell the patented article entitles the vendee of the licensee to vend the article again without the consent of the licensor. If the law were otherwise, the whole object of the license would be defeated. (*s*)

But the sale in England of articles manufactured abroad under a license granted under a foreign patent, is an infringement of an English patent for the same invention. (*t*)

Although every sale of a patented article by the patentee licenses by implication the use or re-sale of that article in the hands of any subsequent purchaser, it has been recently held that this implied license may be rebutted by express notice to the buyer, of a less extensive license. Thus, in the *Incandescent Gas Light Company* v. *Brogden*, (*u*) the Court held that the patentees could limit the license by notice that on selling they only authorized the use or re-sale of their invention in conjunction with another article also supplied by them; and re-sale or user without that adjunct was held to be an infringement.

A licensee cannot sue in respect of infringements of the patent; any proceedings must be taken by or in the name of the patentee. But an exclusive licensee is apparently entitled for this purpose to use the name of the patentee. (*v*)

Estoppel by License.—So long as the license continues the licensee cannot dispute the title of the licensor; he is therefore estopped from denying the validity of the patent. (*w*) Hence, it is no defence to an action for royalties that the patent has been cancelled (*x*) or found invalid in an action between the licensor and third parties. (*y*)

However invalid the patent may be, the licensee, so long as he continues to use the alleged invention under his license, is liable to pay the royalties reserved thereby.

(*s*) *Thomas* v. *Hunt*, 17 C. B. (N. S.), 183.

(*t*) *Societe Anonyme* v. *Tilghmann*, 25 C. D. 1; 53 L. J. Ch. 1.

(*u*) 16 R. P. C. 179.

(*v*) *Renard* v. *Levinstein*, 2 H. & M. 628.

(*w*) *Crossley* v. *Dixon*, 10 H. of L. Ca. 293; 32 L. J. Ch. 617; *Trotman* v. *Wood*, 16 C. B. (N. S.), 479; *Clarke* v. *Adie*, L. R. 2 App. Ca. 423; *Useful Patents Co.* v. *Rylands*, 2 R. P. C. 255; *Ashworth* v. *Law*, 7 R. P. C. 231; *Mills* v. *Carson*, 9 R. P. C. 338; 10 R. P. C. 9, p. 17; *Bassel* v. *Graydon*, 14 R. P. C. 701; *Noton* v. *Brooks*, 8 Jur. (N. S.), 115; 7 H. & N. 499.

(*x*) *African Gold Recovery Co.* v. *Sheba Gold Co.*, 14 R. P. C. 660.

(*y*) *Grover* v. *Millard*, 8 Jur. (N. S.), 713.

Nor can a person who pays for the use of a patented invention recover the money back (in the absence of fraud), should it subsequently appear that the patent is bad; for in such case both parties have contracted innocently, on the footing that the patent is good, and there is no implied warranty to bind the licensor. (*z*)

The rule that a licensee cannot dispute the validity of his licensor's patent only applies to a person who has actually obtained a license, and has no application to one who can only become a licensee by complying with certain terms and conditions. (*a*)

The terms of the agreement under which the licensee is authorized to use the invention may, however, prevent estoppel arising. Thus, in *Wilson* v. *The Union Oil Mills Company*, (*b*) the agreement was entered into "subject to an enquiry as to the validity of the plaintiff's patent," and the licensees were held entitled to put the validity of the patent in issue when sued for royalties. It would be otherwise, however, if the licensees under such an agreement worked the invention without enquiry; they could not then be heard to say that the patent was bad as an excuse for not paying for its use. (*c*)

Although a licensee is estopped from denying the validity of the patent in respect of which he has received his license, he may, if sued for royalties, shew that what he has done is beyond the ambit of the invention; and for that purpose the Court will, at his instance, enquire into the scope and meaning of the specification. (*d*) "The position of a licensee who under a license is working a patent right," said Lord Blackburn, in *Clark* v. *Adie*, (*e*) "for which another has got a patent is very analogous indeed to the position of a tenant of lands who has taken a lease of those lands from another. So long as the lease remains in force, and the tenant has not been evicted from the land, he is estopped from denying that his lessor had a title to that land. When the lease is at an end, the man who was formerly the tenant, but has now ceased to be so, may shew that it was altogether a mistake to have taken that lease, and that the land really belonged to him; but during the continuance of the lease

(*z*) *Hare* v. *Taylor*, 1 Bos. & P. (N. R.), 260; 1 W.P. C. 292.

(*a*) Per Lord Herschell, in *Bassett* v. *Graydon*, 14 R. P. C. 709.

(*b*) 9 R. P. C. 57.

(*c*) Ibid.

(*d*) See *Young* v. *Hermand Oil Co.*, 8 R. P. C. 285; 9 R. P. C. 373.

(*e*) L. R. 2 App. Ca. p. 435.

he cannot shew anything of the sort; it must be taken as against him that the lessor had a title to the land. Now, a person who takes a license from a patentee is bound upon the same principle, and in exactly the same way. The two cases are very closely analogous. In analogies there are always apt to be some differences, but I know of none in this. The tenant under a lease is at liberty to shew that the parcel of land which he and the lessor are disputing about was never comprised in the lease at all; he may shew that he took the lease of *Blackacre* from the person who granted him the lease, and that the spot of land then in question, *Greenacre*, we will suppose, is a piece of land which was never included in the lease at all, and which belongs to him (the tenant) under some other right. So may a licensee under a patent shew that, although he accepted the license, and worked the patent, and the patentee could never, therefore, so long as that license was in existence, bring an action against him as an infringer, yet the particular thing which he has done was not a part of what was included in the patent at all, but that he has done it as one of the general public might have done it, and therefore is not bound to pay royalty for it. If he has used that which is in the patent, and which his license authorizes him to use without the patentee being able to claim against him for infringement, because the license would include it, then, like a tenant under a lease, he is estopped from denying the patentee's right, and must pay royalty. Although a stranger might shew that the patent was as bad as any one could wish it to be, the licensee must not shew that."

A licensee who, when sued for royalties, relies on the defence that what he has done is not covered by his license, is practically in the position of a defendant in an infringement action, who is estopped from denying the validity of the plaintiff's patent; (*f*) and the true test of the licensee's liability in such case is found in the answer to the question whether what the licensee has done is an infringement of the licensor's patent. If so, no matter how far the invention has been modified or improved by him in his use of it, he remains liable to account under the terms of his license. (*g*)

A license may be granted for the use of an invention after provisional protection has been obtained and before the complete

(*f*) *Young* v. *Hermand*, 8 R. P. C. 285; 9 R. P. C. 373; per Lord Watson, p. 389.

(*g*) *Crosthwaite* v. *Steel*, 6 R. P. C. 190; *Useful Patents Co.* v. *Rylands*, 2 R. P. C. 255.

specification has been filed. In one case where this was done the Court refused to consider, in an action for royalties, whether the complete specification covered less than the invention disclosed in the provisional. (*h*)

Termination of the License.—When, however, the license is terminated the estoppel is gone; (*i*) and whether the termination comes by effluxion of time, or revocation, or forfeiture, makes no difference.

In *Muirhead* v. the *Commercial Cable Company*, (*j*) where the license bound the licensees for the whole period during which the patent should last, the defendants were allowed to shew that the letters patent, which had been granted in America, had expired by operation of law, as this was not denying the validity of the patent, but proving only that a right originally good had come to an end.

So, too, a licensee, when his license is not expressly limited to a definite period, may repudiate the license, after which he will not be liable to be sued for royalties but only as an infringer, when it will be open to him to contest the validity of the patent. (*k*)

If a licensee elects to take this course he must give clear notice to the licensor, (*l*) otherwise his continued use of the invention will be accounted not an infringement but a user under the license, and subject to the payment of royalties. For this purpose notice by a statement in a pleading is not sufficient. (*m*)

A licensee who continues to work the invention after he has had notice that his license has been revoked is liable to be sued as an infringer of the patent rights. (*n*) And a licensee whose license authorizes him to use the invention in connection with a particular class of article (*e.g.* lamps) loses the protection of his license if he adapts it to a different class (*e.g.* stoves), and becomes liable to be restrained by injunction as an infringer. (*o*)

A license which reserves a royalty on all articles manufactured thereunder does not impose upon the licensee the obligation to go

(*h*) *Otto* v. *Singer*, 7 R. P. C. 7.

(*i*) *Dangerfield* v. *Jones*, 13 L. T. (N. S.), 142; *Axmann* v. *Lund*, L. R. 18 Eq. 330; *Neilson* v. *Fothergill*, 1 W. P. C. 287; *Pidding* v. *Franks*, 1 Mac. & G. 56.

(*j*) 11 R. P. C. 317; 12 R. P. C. 39.

(*k*) See *Redges* v. *Mulliner*, 10 R. P. C. 27; *Crossley* v. *Dixon*, 10 H. of L. Ca. 293; 32 L. J. Ch. 617.

(*l*) As to the necessity of notice, see *Mellor* v. *Watkins*, L. R. 9 Q. B. 400. As to what notice is sufficient to entitle a licensor to enforce a forfeiture on breach of conditions, see *Ward* v. *Livesey*, 5 R. P. C. 102.

(*m*) *Cheetham* v. *Nuttall*, 10 R. P. C. 333.

(*n*) *Coppin* v. *Lloyd*, 15 R. P. C. 373.

(*o*) *Societé Anonyme* v. *Midland Railway Co.*, 14 R. P. C. 419.

on manufacturing such articles, but only to pay the royalty in respect of all such actual user of the invention. (*p*)

Where a license was expressed to terminate if the patent under which it was granted should be declared invalid by the Court, and the Vice-Chancellor of Lancaster found the patent invalid, but his judgment was subsequently reversed by consent, on terms agreed between the parties, Mathew, J., held that the condition contemplated by the license had not arisen, and that it was still in force. (*q*)

In *Cutlan* v. *Dawson*, (*r*) the license was for the period covered by the terms of the letters patent, and by any extension or prolongation thereof, and by any other letters patent to which the licensor might become entitled for any improvements, alteration, or addition to the machinery (the subject-matter of the patent) during the license term. The agreement by which the license was given contained a provision that the licensor might at his election determine the license if he desired to do so, but none giving a like right to the licensee. The Court of Appeal held, reversing the Divisional Court, that the licensee had no power to determine the license on reasonable notice.

Renewal Fees—Royalties.—A condition in an agreement for a license that the patentees will, at their own costs and charges, by all means in their power, protect and defend the letters patent from all infringements by any person, imposes upon the patentees an obligation to pay the renewal fees and keep the patent in force.

In *Lines* v. *Usher*, (*s*) where the patentees were subject to such a condition and failed to make the required payments, the licensee was held entitled to recover back royalties paid after the lapsing of the patent. Where the license contains no stipulation as to who shall pay the patent renewal fees, it would seem that these should be paid by the patentee; (*t*) though, perhaps, the licensee might properly pay them and deduct them from the next instalment of royalties. (*u*)

A license sometimes contains a covenant by the licensor for quiet enjoyment; such a covenant is not co-extensive with a covenant by the licensee to pay the royalties. If, therefore, it is broken by a failure of the licensor to pay the renewal fees, that does not absolve the licensee from further payments of royalties. (*v*)

(*p*) *Chestham* v. *Nuttall*, 10 R. P. C. 321.
(*q*) Ibid.
(*r*) 13 R. P. C. 710; 14 R. P. C. 249.
(*s*) 13 R. P. C. 685; 14 R. P. C. 206.
(*t*) See *Mills* v. *Carson*, 9 R. P. C. 338; 10 R. P. C. 9. Per Lord Esher, M.R., and Lopes, L.J.
(*u*) Ibid. per Kay, L.J.
(*v*) Ibid.

Thus, in *Mills* v. *Carson*, (*w*) the licensees covenanted absolutely, in express terms, to pay a lump sum by yearly instalments to be spread over the unexpired portion of the patent term; while the licensor, on his part, covenanted that the licensees, paying the money reserved and performing their covenants, should, at all times during the residue of the said term, peaceably and quietly hold, exercise, and enjoy the license, without any lawful interruption or disturbance by the licensor or any other person whatsoever. The patent having lapsed through non-payment of the renewal fees, the licensees alleged a breach of the covenant for quiet enjoyment, and declined to make any further payments under the license.

The Court, however, held that even assuming such breach to have been occasioned by the non-payment of the renewal fees, the licensees still remained liable on their covenant.

In *Siemens* v. *Taylor* (*x*) a license to work several patents contained a provision that the royalties to be paid should continue payable until the expiration, by effluxion of time, of all the terms of years respectively granted by the said letters patent. Under this provision it was held that royalties continued payable even on those patents which had expired, so long as any one of the several patents still remained in force.

Mere License not Assignable.—A mere license is not assignable. (*y*) But a license given to a licensee and his assigns, would no doubt, so long as it was unrevoked, estop the licensor from proceeding against the person to whom the licensee had handed on such license. And where a patentee accepts royalties from the assignee of a licensee with knowledge that the licensee has purported to assign the license, he is estopped from denying the validity of the transaction. (*z*)

A patentee who has assigned his invention has no longer the right to grant licenses. (*a*) And where an agreement has been entered into by the patentee which amounts to an equitable assignment, any licenses subsequently granted by the patentee to persons having notice of such agreement are void as against the assignor, and their invalidity is not covered by a priority of registration.

In the *New Ixion Company* v. *Spilsbury*, (*b*) the registered

(*w*) 9 R. P. C. 338; 10 R. P. C. 9.
(*x*) Ibid. 393.
(*y*) *Bower* v. *Hodges*, 22 L. J. C. P. p. 198; see, also, 13 C. B. 765
(*z*) *Lawson* v. *Macpherson & Co.*, 14 R. P. C. 696.
(*a*) *Betts* v. *Willmott*, L. R. 6 Ch. 239.
(*b*) 15 R. P. C. 567. [1898] 2 Ch. 484; 79 L. T. 229.

proprietor of certain letters patent entered into an agreement in June, 1896, to transfer his business and patents to the plaintiff company. In September, 1897, he granted a license to the defendants, who had express notice of the prior agreement. The defendants had their license entered on the Register. In October, 1897, the patents above mentioned were, in pursuance of the agreement of June, 1896, assigned by deed to the plaintiffs, who thereupon commenced an action against the defendants, claiming a declaration that the license was void and an injunction. Kekewich, J., held they were entitled to this relief, and his decision was affirmed on appeal.

Licenses to be Registered.—Copies of licenses, and any documents affecting the proprietorship in any license under letters patent, must be supplied to the Comptroller, for filing in the Patent Office. (*c*) For this purpose, an attested copy of the license must be left at the Patent Office by the licensee, with a request that a notification thereof may be entered in the Register. The licensee must also produce the original, and leave it for verification of the copy, if required. (*d*)

Stamp Duty.—It has recently been held that a sole license to work a patent in a specified district is "property" within Section 59 sub-section 1 of the Stamp Act, 1891, and that an agreement to purchase such license from the licensee is therefore chargeable with *ad valorem* duty. (*e*)

(*c*) Patents Act, 1883, s. 23 (3).
(*d*) P. R. rule 77.
(*e*) *Smelting Company of Australia* v. *Commissioners of Inland Revenue*, [1896] 2 Q. B. 179; [1897] 1 Q. B. 175; 65 L. J. Q. B. 513; 66 L. J. Q. B. 137; 74 L. T. 694; 75 L. T. 534; 45 W. R. 61, 203.

CHAPTER XIX.

COMPULSORY LICENSES.

The Board of Trade may order Licenses to be Granted.—If, on the petition of any person interested, it is proved to the Board of Trade that by reason of the default of a patentee to grant licenses on reasonable terms—

(*a*) The patent is not being worked in the United Kingdom; or

(*b*) The reasonable requirements of the public with respect to the invention cannot be supplied; or

(*c*) Any person is prevented from working or using to the best advantage an invention of which he is possessed;

—the Board may order the patentee to grant licenses on such terms as to the amount of royalties, security for payment, or otherwise, as the Board, having regard to the nature of the invention and the circumstances of the case, may deem just, and any such order may be enforced by mandamus. (*a*)

This jurisdiction to compel the granting of licenses conferred upon the Board of Trade by the Patents Act, 1883, has until recently remained dormant. Nor have the hearings of the petitions which have hitherto been presented yet resulted in clearly establishing a settled practice on all points which are likely to arise on such proceedings. Without attempting to discuss here the necessity for, or convenience of, this jurisdiction, its scope and the existing practice, so far as that practice can be gathered from the Patent Rules and the decisions of the Board, will be the subject of the present chapter.

The Tribunal.—And first as to the Tribunal. By Section 25 of the Patents Act, 1888, all things required or authorized to be done by, to, or before the Board of Trade under the Patents Act, 1883, may be done by, to, or before the President, or a secretary, or an assistant secretary of the Board. Applications for

(*a*) Patents Act, 1883, s. 22.

compulsory licenses are not, however, heard by the President, or by any secretary of the Board; for on receipt they are referred by the Board to a legal expert as referee for consideration and report, before whom, if an enquiry is necessary, the parties and their witnesses are heard. This can hardly be called a convenient form of tribunal, as the referee who hears the case has no power to do more than report, while the Board, which does not hear the evidence, grants or refuses the order for a license. As the Board is not bound to act upon the report of the referee, but may form its own view of the facts, the referee has not that control over the proceedings that he would have if the ultimate decision lay with him.

Moreover, the report of the referee is not made public, and the decision of the Board is intimated by a bare order dismissing the application, or directing a license to be granted on specified terms. Thus, no reasoned judgment is given, and the parties are left to gather as best they can the grounds of the Board's decision from such observations as may be made by the referee during the course of the public hearing before him. If this jurisdiction is to command the confidence of the public, it would seem that some other mode of exercising it, more consonant to the prevailing procedure in English Courts, will have to be adopted.

The Application is by Petition.—The application for a compulsory license is made by petition to the Lords of the Committee of Privy Council for Trade, praying that an order may be made by the Board of Trade that the patentee shall grant a license to the petitioner.

Who may Petition.—The right to present a petition is not a promiscuous right, but limited to such persons as are interested in the relief claimed. (*b*) Where the petition is founded on the circumstance that the patentee's monopoly prevents the use to the best advantage of another invention, the person possessed of that invention is an essential party to the petition; but if not in a position himself to manufacture under the license, there would seem to be no reason why he should not ask for the grant of the license to some other person who is prepared to put the invention into use on his behalf, and join such person as a co-petitioner; (*c*) for a petition may be presented by more than one petitioner, and in respect of more than one patent. (*d*)

(*b*) P. R. rule 60.

(*c*) No exception was taken to this course in the *Continental Gas Gluhlicht Petition*, 15 R. P. C. 727; Gordon, 214.

(*d*) Ibid.; *Levinstein's Petitions*, 15 R. P. C. 732; Gordon's *Compulsory Licenses*, pp. 219; *Levinstein's Petition* (*Cassella's Patent*), Gordon, p. 234.

Where the license is sought under a patent which is not being worked in the United Kingdom, or with respect to which the reasonable requirements of the public are not being supplied, any person will have an interest sufficient to support a petition who is prepared to make good the patentee's default, either by manufacturing or by supplying the requirements of the public, as the case may be. It would also seem that in these cases any members of the public whose commercial interests are prejudiced by the patentee's default, may petition. At the same time, where the interests of co-petitioners are identical, the Board might properly (and probably would) refuse to hear them separately.

In the official form of petition no mention is made of a respondent, but the patentee, when served with the petition, necessarily becomes such. (*e*)

Contents of the Petition.—A petition may be presented in respect of more than one patent. It must set out clearly the nature of the petitioner's interest, the grounds upon which he claims to be entitled to relief, the circumstances of the case in detail, the purport of the order to be made, and the terms on which it is asked for. (*f*)

In *Levinstein's Petition re Meister Lucius Patents*, the form of license which the petitioner sought was set out in a schedule to the petition. (*g*) There is nothing in the official form to suggest that the petition must be signed by the petitioner, though in the petitions hitherto presented this has generally been done. (*h*)

Procedure on the Petition.—The petition and an examined copy thereof must be left at the Patent Office, accompanied by the affidavits or statutory declarations and other documentary evidence (if any) tendered by the petitioner in proof of the default of the patentee, in respect of which relief is claimed. (*i*)

The petition and evidence are referred by the Board to a legal expert as referee, to report whether or not a *primâ facie* case for relief is made out. If the referee reports that the petitioner has not made out a *primâ facie* case, the petition will be dismissed forthwith. (*j*) If, on the contrary, the report is favourable to the petition, then the petitioner will be directed to deliver copies of the petition and evidence to the patentee. No special mode of

(*e*) *Levinstein's Petition*, Gordon, 219; 15 R. P. C. 732.
(*f*) P. R. rule 60.
(*g*) 15 R. P. C. 73; Gordon, 355.
(*h*) Gordon, p. 176.
(*i*) P. R. rule 61.
(*j*) *Chisholm's Petition re Dunlop Pneumatic Tyre Co.'s Patents*, Gordon, 280.

serving the patentee is laid down by the rules; but as to this directions may be given by the referee.

The term "patentee" in the Patents Act, 1888, means the person for the time being entitled to the benefit of the patent. (*k*)

There is no rule requiring public intimation to be given of the petition. The patentee alone is entitled to notice. There is no obligation, therefore, upon the petitioner to serve an exclusive licensee, (*l*) or any other person who may have entered into an agreement with the patentee which will be seriously prejudiced by a compulsory license; though, if such person gives notice of opposition to the petition and applies to be allowed to intervene, he will be heard by the referee. (*m*)

Evidence on Petitions.—The evidence may be tendered either in the form of affidavits or statutory declarations. In the *Wolverhampton Tyre Syndicate's Petition* it was presented by the petitioners in the latter form. (*n*)

The patentee has a period of fourteen days from the delivery to him of the petition and evidence within which to deliver evidence in opposition. This he does by leaving it at the Patent Office within the prescribed time, and likewise a copy for service on the petitioner. (*o*)

The rules do not require the patentee to deliver any formal statement by way of answer to the petition. But there is nothing to prevent his adopting this course, as was done in *Levinstein's Petition re Meister Lucius Patents*, where the patentees delivered an answer and affidavits in support of it. (*p*)

A further period of fourteen days is allowed the petitioner in which to deliver evidence in reply to the patentee. Such evidence must be strictly confined to matters in reply only. (*q*)

The referee will thereafter consider the petition and the evidence on both sides, and again report to the Board of Trade whether any further directions are necessary, or the petition may be at once heard.

The Hearing of the Petition.—The Board of Trade fix the date and place of the hearing, and have unrestricted power to regulate the procedure, subject, however, to full opportunity being given to

(*k*) Sect. 48.

(*l*) An exclusive licensee is not a patentee: *Heap* v. *Hartley*, 42 C. D. 461; 6 R. P. C. 495; 58 L. J. Ch. 790; 61 L. T. 538; 38 W. R. 136.

(*m*) *Gormully & Jeffrey's Petition*, Gordon, 249; *Wolverhampton Tyre Syndicate's Petition*, Gordon, 262.

(*n*) Gordon, 264.

(*o*) P. R. rule 64.

(*p*) 15 R. P. C. 732; Gordon, 358.

(*q*) P. R. rule 65.

the patentee to shew cause against the petition. (*r*) On the hearing before the referee, any party may appear in person, or by counsel, or by a patent agent. Either side may tender further evidence, and the referee will hear oral evidence. Persons who have made affidavits or statutory declarations may be required to attend for cross-examination; but the Board of Trade have no power to compel the attendance of witnesses. The refusal of any witnesses, however, to attend and submit to cross-examination would necessarily destroy the value of any affidavit or declaration he might have made.

On the hearing the petitioner is entitled to begin, and has a right of reply. (*s*) Although, as already noticed, the petitioner is not required to serve any one but the patentee with the petition, it is obviously desirable that all parties having an interest in the patent should be represented at the hearing. Where the patentees had entered into an agreement to grant a limited number of licences only, the licensees were allowed to appear as interveners, and the petition was amended by adding their names as respondents, "and any other person interested in the patent." (*t*)

Where it is desired thus to amend the petition an application for leave ought to be sent by letter to the Board of Trade. (*u*)

Parties Intervening.—Persons not respondents to the petition who desire to intervene in opposition to the petition should give notice at the Patent Office of their intended opposition, and support the notice with affidavits, shewing the grounds on which they claim to be heard.

In *Gormully & Jeffrey's Petition*, (*w*) the North British Rubber Company, who were not parties to the petition, alleged that they were licensees of the respondents, and had expended large sums on works and machinery; further, that the respondents had entered into a contract with them, under which the respondents were bound not to grant more than one other license beyond the license to themselves and a license held from them by another company. On these facts they claimed to be heard in opposition to the petition. Unconditional leave to appear was given by the Board of Trade.

In the same case, the *Clipper Pneumatic Tyre Company* also

(*r*) P. R. rule 66.

(*s*) *Hulton & Bleakley's Petition, re Taylor's Patent*, 15 R. P. C. 749; Gordon, 245.

(*t*) *Gormully & Jeffrey's Petition re Dunlop Patents*, Gordon, 254, 255.

(*u*) Ibid. p. 255.

(*w*) Ibid. 252, 253.

claimed to intervene, alleging that they were licensees and had paid £70,000 for their license, on the understanding that no other licenses beyond those above mentioned would be granted by the respondents. To them also unconditional leave to appear was given. (*x*)

Where the Respondent has Contracted to Grant no more Licenses.—It is not yet clear how the Board of Trade will act in ordering a compulsory license where the respondent patentee has entered into a contract with some third person under which he has bound himself not to grant any more licenses. It is obvious that in such a case great injustice might be done to a prior licensee, who had paid a large sum for his license on the footing that no further license would be granted, if he were suddenly exposed to the competition of a compulsory licensee. But the referee has stated more than once upon these applications that the Board can take no cognizance of the existence of an exclusive license, or any agreement limiting the number of licenses which a patentee may grant, as, if such were to be considered a bar to the granting of a compulsory license, any patentee would have it in his power to set the Board of Trade at nought, and wholly defeat the operation of the section. (*y*)

The point was not decided in the *Gormully & Jeffrey Petition* (*z*) above mentioned, as the intervening licensees expressed their willingness to manufacture for the petitioners, at a reasonable price, the improved article which embodied the petitioners' invention, and the hearing was adjourned to enable the parties to arrive at a private arrangement.

In *Hulton & Bleakley's Petition*, (*a*) the Board made an order for a grant of a compulsory license, notwithstanding the fact that the patentees had already granted an exclusive license for the same district. But here the exclusive licensee was only paying a moderate royalty for his license.

Reasonable Requirements of the Public.—In this petition the meaning of the words "reasonable requirements of the public with respect to the invention" came under consideration. The patentee's invention was a mechanism for rapidly printing paragraphs containing late news into a newspaper. The patentees had granted to the proprietors of an evening paper an exclusive license for Manchester and district. There were two other Manchester evening

(*x*) Gordon, 252, 253.

(*y*) *Hulton & Bleakley's Petition*, 15 R. P. C. 750; Gordon, 246; *Wolverhampton Tyre Syndicate*, Gordon, 268.

(*z*) Supra.

(*a*) 15 R. P. C. 749; Gordon, 246.

papers appealing to different sections of political opinion, and the proprietors of one of these petitioned for a compulsory license, alleging that the reasonable requirements of the public in the district were not met by the use of the invention in connection with one paper only, inasmuch as persons whose political views did not agree with those of that paper, and who therefore did not buy it, were deprived of the benefits of the invention. No other ground for granting a license was suggested. The Board endorsed the petitioners' contention that under these circumstances the requirements of the public were not being met, and made an order that a license should be granted.

Discretion of the Board.—The granting of an order for a compulsory license is a matter of discretion. Where, therefore, the license is claimed on the ground that the petitioner is possessed of an invention which the respondent's monopoly prevents him working to the best advantage, the Board will not make the order if such invention is a mere improved variety of the respondent's article, so long as the respondent is willing to manufacture for the petitioner that improved variety on reasonable terms. (*b*) But the terms must be reasonable. If fair terms are not offered the Board will intervene. (*c*)

Respondent must be in Default.—The Board has no jurisdiction unless the patentee is in default. A petitioner must therefore be prepared to shew that the respondent has refused to grant him a license on reasonable terms. He ought, therefore, before presenting his petition, to make a written application to the patentee for a license, giving him notice of the grounds upon which, if refused, he will apply for a compulsory license; otherwise a question may arise at the hearing as to whether the patentee has ever had before him materials enabling him to judge what would be reasonable terms on which to offer a license. Where he has not had such means of judging on what terms he could offer a license, his declining to do so could hardly amount to default. (*d*)

Where a petitioner can shew that an English patent owned by a foreign manufacturer is not being worked in this country, but is simply held for the purpose of blocking trade and enabling foreign-made articles to control the English market, a strong case

(*b*) *Gormully & Jeffrey's Petition*, Gordon, 260, 261; 16 R. P. C. 641; *Chisholm's Petition*, Gordon, 280.

(*c*) *Wolverhampton Tyre Syndicate's Petition*, Gordon, 279.

(*d*) In *Levinstein's Petition re Cassella's Patents*, it was contended that upon the correspondence no refusal of a license was made out. There, however, the referee held that there was default; see Gordon, p. 240.

for relief is made out. (*e*) In *Levinstein's Petition*, (*f*) where this was alleged, the Board ordered the grant of a license, although the patentees offered to supply the patented products to the petitioners, who were English manufacturing chemists, at the same price at which they were sold in countries where there was no patent.

Petitioner should be prepared to take Practical Advantage of the License.—A petitioner ought to be prepared to give practical effect to the license if granted, either himself or by some co-petitioner.

In the *Continental Gas Gluhlicht Petition*, (*g*) where the principal petitioners were a foreign company, the petition prayed the grant of a license to an English corporation, who were co-petitioners. The English company, however, withdrew from the petition during the hearing, and no order was made. But inasmuch as the usual mode of working a valuable patent is through a company formed for the purpose, the circumstance that petitioners are only a syndicate without capital, who intend to float a company to work under the license if it is granted, will not prevent the referee reporting to the Board of Trade in favour of the petition. (*h*)

It would seem that the circumstance that the petitioner has been restrained by injunction from infringing the invention of the patentee will not prevent the Board of Trade entertaining his petition; (*i*) though how far the granting of a compulsory license would relieve him from the obligation of obeying the injunction may be a matter of doubt. It is submitted, however, that working under such a license would be no breach of the injunction, for it would not, in fact, be an infringement of the respondent's patent.

Royalties under a Compulsory License.—The amount of royalty payable under the compulsory license, as well as the other terms of the license, will be fixed by the Board of Trade. What royalty shall be paid must depend on the special circumstances of each case.

In *Levinstein's Petition*, (*j*) where the dye stuffs for the production of which the license was wanted were a cheap class of goods exposed to severe competition in the market, the royalty was fixed at one halfpenny per pound of the raw material, equivalent

(*e*) *Levinstein's Petition re Meister Lucius Patents*, Gordon, 219; 15 R. P. C. 732.

(*f*) Supra. In this case the petitioners required the respondent's products for the purpose of working other chemical inventions for which they held patents.

(*g*) 15 R. P. C. 727; Gordon, 214.

(*h*) *Wolverhampton Tyre Syndicate's Petition*, Gordon, p. 271.

(*i*) *Gormully & Jeffrey's Petition*, Gordon, p. 250; 16 R. P. C. 641.

(*j*) *Re Meister Lucius Patents*, 15 R. P. C. 732; Gordon, 219.

to 10 per cent. on the net profits of the completed article, or a minimum payment of £250 per annum.

In *Hulton & Bleakley's Petition*, (*k*) where the invention for which the license was granted was a mechanical device for printing late news without seriously delaying the action of the printing press, the royalty was fixed at £20 per annum for each machine in connection with which the invention was used.

The Board of Trade has no jurisdiction to award costs where a petition is dismissed. (*l*) Nor, it would seem, where an order for a license is made, except perhaps by way of condition if the referee reports that the petitioner's conduct has put the respondents to unnecessary costs. But in none of the decisions so far reported have terms as to the payment of costs been imposed.

Enforcing Order.—The order of the Board may be enforced if necessary by mandamus. (*m*) No case of enforcing an order by mandamus has yet occurred.

(*k*) Gordon, 248. In this case the highest royalty previously paid by licensees had been £15. But for the district in which the compulsory license was to be worked an exclusive license had been granted.

(*l*) *Levinstein's Petition*, 15 R. P. C. 732; Gordon, 219; *Gormully & Jeffrey's Petition*, Gordon, 260; 16 R. P. C. 641.

(*m*) Patents Act, 1883, s. 22.

CHAPTER XX.

EXTENSION OF THE TERM OF LETTERS PATENT.

Expediency of granting Extensions of Patent Terms. — It has already been shewn how the term of letters patent for an invention was limited by the Statute of Monopolies to a period not exceeding fourteen years. (*a*) The effect of this limitation was not only to preclude the Crown from making a grant for a longer period, but also from making a second grant in respect of the same subject-matter. The Crown was thus deprived of all power to prolong the monopoly of a deserving inventor beyond the statutory period, and the only remedy open to an inadequately remunerated patentee was an application to Parliament for a private Act prolonging his monopoly. Such applications, though extremely costly and rarely successful, (*b*) were for upwards of two centuries the only means by which an inventor could obtain an extension of his patent term.

No doubt, in the majority of cases the extent to which an invention is adopted by the public is a just test of its intrinsic value; and the inference may generally be justly drawn that a patentee's failure to derive adequate remuneration from his discovery during the fourteen years of his monopoly is due to the inherent worthlessness of what he has invented. (*c*) But the rule is not of universal application, and special circumstances may rebut the inference. (*d*) Such special circumstances may arise from the apathy of the public

(*a*) See ante, p. 11.

(*b*) Per Lord Brougham, in *Morgan's Patent*, 1 W. P. C. 739.

(*c*) See *Wright's Patent*, 1 W. P. C. 576; *Simister's Patent*, 1 W. P. C. 723; *Pinkus's Patent*, 12 Jur. 233; *Herbert's Patent*, L. R. 1 P. C. 399; *Allan's Patent*, L. R. 1 P. C. 507; 4 Moo. (N. S.) 443; *Bakewell's Patent*, 15 Moo. P. C. 386.

(*d*) *Downton's Patent*, 1 W. P. C. 565; *Kollman's Patent*, 1 W. P. C. 564; *Roberts' Patent*, 1 W. P. C. 575; *Foarde's Patent*, 9 Moo. P. C. 376; *Payne's Patent*, Coryton's *Law of Patents*, p. 220; *Hardy's Patent*, 6 Moo. P. C. 443; *Lee's Patent*, 10 Moo. 226; *Houghton's Patent*, 3 L. R. P. C. 461.

in regard to the invention. Every inventor has a certain amount of *inertia* to contend with, and in some cases this *inertia* proves so formidable that the patentee succumbs before it. (*e*) Many illustrations of this might be cited. The most remarkable is that afforded by Watt's improvement in the steam engine, of which Lord Brougham, in *Woodcroft's Patent*, said: "It was so many years useless to him, not coming into immediate operation, that he had to obtain an extension of one-and-twenty years from the legislature, but for which he would have been a loser, and probably ruined, by the greatest benefit that was ever given to mankind next to the invention of printing." (*f*)

Again, the powerful opposition of influential rivals may create such circumstances. An invention which is likely to achieve a revolution in some important trade is often keenly opposed by those who, while best knowing its intrinsic value, are most interested in prejudicing the public against it. (*g*)

Or the inventor may be involved in costly litigation by the success of his invention tempting many persons to pirate it. (*h*) The temptation to infringe a patent usually varies in proportion to the merit of the invention, (*i*) and when the utility is great it sometimes happens that the profits of the unfortunate patentee are swallowed up by the expenses incurred in prolonged and ruinous litigation. (*j*)

Other circumstances may operate to deprive the patentee of his reward. Ill health may disable him from pushing his discovery into notice; (*k*) or his invention may be of such a character as only to appeal to a limited class, (*l*) or afford occasional opportunities only for its exercise. (*m*) Hence it may happen that a meritorious inventor may find himself at the close of his patent term an actual loser by the skill and enterprise which have given to the public a most valuable invention.

The importance of providing some other means than a private

(*e*) Per Lord Monkswell, in *Cocking's Patent*, 2 R. P. C. 153.

(*f*) 2 W. P. C. 32.

(*g*) *Roberts' Patent*, 1 W. P. C. 575; *Payne's Patent*, Coryton's *Law of Patents*, p. 220; *Marwick's Patent*, 13 Moo. 312; *Stafford's Patent*, 1 W. P. C. 563; *Parson's Patent*, [1898] A. C. p. 677; 15 R. P. C. 349.

(*h*) *Adair's Patent*, L. R. 6 App. Ca. 176; 50 L. J. P. C. 68.

(*i*) Per Lord Brougham, see *Whitehouse's Patent*, 1 W. P. C. 477.

(*j*) *Russell's Patent*, 2 Moo. 496; *Pettit Smith's Patent*, 7 Moo. 133; *Heath's Patent*, 8 Moo. 217; 2 W. P. C. 247.

(*k*) *Roper's Patent*, 4 R. P. C. 201.

(*l*) *Lee's Patent*, 10 Moo. 229; *Herbert's Patent*, L. R. 1 P. C. 402; *Berrington's Patent*, cited L. R. 1 P. C. 510; *Roper's Patent*, supra.

(*m*) *Stoney's Patent*, 5 R. P. C. 523. As in the case of inventions only applicable to large machines or very peculiar operations; *Southey's Patent*, 8 R. P. C. 437.

Act of Parliament for extending patent monopolies in special cases was at last recognized by the Legislature, when, in 1835, it empowered the Crown, (*n*) where the Judicial Committee of the Privy Council reported in favour of the extension of a patent monopoly, to grant new letters patent for the same invention for a term not exceeding seven years after the expiration of the first term, any law, custom, or usage to the contrary notwithstanding. The jurisdiction thus conferred on the Crown gave to the patentee at once a cheaper and easier mode of relief, so that, not only was the meritorious inventor enabled to secure a prolongation of his patent term at less cost, but also in many cases where formerly his application to Parliament would have been unsuccessful. (*o*)

The jurisdiction to extend letters patent was further regulated by 2 & 3 Vict. c. 67 and 7 & 8 Vict. c. 69. The latter Statute gave the Crown authority to grant extensions in exceptional cases for a period of fourteen years. It, moreover, allowed extensions to be granted to assignees. No modification of this branch of the law was introduced by the Patent Law Amendment Act of 1852, that Statute merely adopting the provisions already in force under the earlier Acts. These Acts were repealed by the Patents Act, 1883, and the law relating to applications for the extension of letters patent is now contained in Section 25 of that Act. This section is substantially a codification of the pre-existing law, and in *Newton's Patent* (*p*) the Judicial Committee expressed the opinion that the section was not intended to alter in any way the principles upon which their Lordships have always acted in advising the Crown upon these applications.

Application for Extension, how made.

Petition to the Queen in Council.—An application for the prolongation of a patentee's monopoly must be made by petition addressed to her Majesty the Queen in Council. The petition should be presented by the patentee. (*q*) Under the Patents Act, 1883, the term patentee includes the person for the time being entitled to the benefit of the patent. (*r*)

(*n*) 5 & 6 Wm. IV. c. 83.

(*o*) *Per* Lord Brougham, *Soame's Patent*, 1 W. P. C. 734. See also *Morgan's Patent*, 1 W. P. C. 739.

(*p*) 9 App. Ca. 592, 1 R. P. C. 177. The only material alteration affected by the Act of 1883 is that the former jurisdiction of the Privy Council under 5 & 6 Wm. IV. c. 83, s. 2, to recommend the confirmation of invalid patents, is not preserved.

(*q*) Patent Act, 1883, s. 25 (*l*). For Forms of Petitions, etc., see Appendix IV. post.

(*r*) Sec. 46.

The petition must be presented at least six months before the time limited for the expiration of the patent. (*s*) Subject to this restriction, it is desirable that the petitioner should delay as long as possible presenting the petition, as the profits made even at the close of the patent term are a material element to be considered ; for however unremunerative the previous years of a patent may have been, it is always possible that the profits of the last year may amount to a sufficient remuneration of the inventor. (*t*) Where, having regard to this consideration, a petition is, in the opinion of the Committee, presented prematurely, the hearing will be adjourned to a later date. In preparing his petition the applicant must remember that prolongation being a matter of grace and favour and not of right, it is essential that the petition should contain a full and candid disclosure of all material facts relative to the position and history of the patent. In *Clark's Patent* this had not been done, and although the matters omitted from the petition were stated by counsel for the petitioner the Board held this insufficient, laying down the principle that a petitioner seeking the grace and favour of the Crown is bound to strict truth and to the utmost candour and frankness, to *uberrima fides* in his statement. (*u*)

Hence, although the Judicial Committee have not laid down a general rule that no petition lacking in candour will be entertained, it is of the utmost importance that the petitioner should make a full and candid disclosure of his position, as any failure to do so will undoubtedly militate seriously against the success of his application. (*v*)

Procedure Rules.—New rules regulating the practice on these petitions were made by the Queen in Council in November, 1897, and all applications for the prolongation of patent monopolies must now be made in conformity therewith. (*w*)

An intending petitioner must give public notice of his intention to apply for an extension of his patent term, by advertising three times in the *London Gazette* and once at least in three London

(*s*) Patent Act, 1883, s. 25 (1). If this is not complied with there is no jurisdiction to entertain the application. *Adam's Patent*, 16 R. P. C. 1.

(*t*) *Mackintosh's Patent*, 1 W. P. C. 739.

(*u*) L. R. 3 P. C. 426.

(*v*) See *Pitman's Patent*, L. R. 4 P. C. 86, where a failure to disclose that an American patent had been taken out and allowed to expire, was held fatal to the petition. Cf. *Adair's Patent*, L. R. 6 App. Ca. 178.

(*w*) The Lords of the Judicial Committee may excuse a failure to comply with these rules (rule 7); but this power will presumably not be exercised except for good reason. They have no power to excuse a failure to comply with the Statute; *Adams' Patent*, 16 R. P. C. 1.

newspapers. (*x*) If the petitioner's place of business is situated in the United Kingdom at a distance of fifteen miles or more from Charing Cross, or if not having a place of business, he yet carries on the manufacture of anything made under his specification, at such distance from Charing Cross, he must also further advertise once at least in some local newspaper published or circulating in the town or district where his place of business is or where he carries on such manufacture. If a petitioner has no place of business and carries on no such manufacture, but resides at a distance of fifty miles or more from Charing Cross, he must also advertise once at least in some newspaper published or circulating in the town or district where he resides.

The petitioner's advertisement must state (1) the object of his petition; (2) the day on which he intends to apply for a time to be fixed for the hearing thereof; (*y*) (3) that caveats must be entered at the Council Office on or before such day so named in the advertisements.

The petition is required to be presented within one week from the publication of the last of the advertisements inserted in the *London Gazette*. (*z*) An affidavit or affidavits must accompany the petition, proving the publication of the requisite advertisements. Statements contained in such affidavits may be disputed at the hearing. (*a*)

The petitioner must apply to the Lords of the Judicial Committee to fix a time for hearing the petition. When this time has been fixed the petitioner must forthwith give public notice thereof by advertising, once at least, in the *London Gazette* and in two London newspapers. (*b*)

If the specification of the petitioner's patent has been printed, the petitioner must, not less than fourteen days before the day fixed for the hearing, lodge eight printed copies at the Council Office. When the specification has not been printed, and the expense of making eight copies of any drawing therein contained or referred to would be considerable, the lodging of two copies is deemed sufficient. Within the same time the petitioner must likewise lodge eight copies of the balance sheet of expenditure and receipts relating to the patent. (*c*) Three copies of this balance

(*x*) Rule 1.

(*y*) This day must not be less than four weeks from the date of the publication of the last of the advertisements to be inserted in the *London Gazette*. Ibid.

(*z*) Rule 2. See *Hutchinson's Patent*, 14 Moo. 364.

(*a*) Ibid.

(*b*) Ibid.

(*c*) These accounts are subsequently to be proved on oath before the committee.

sheet must also be furnished to the Solicitor to the Treasury. This provision is to enable the Attorney-General to have the opportunity of inspecting the accounts and making any enquiries which appear necessary in respect of them. (*d*) The petitioner must, on receiving two days' notice, allow the Solicitor to the Treasury, or any person deputed by him for the purpose, reasonable facilities for inspecting and taking extracts from the books of account by reference to which he proposes to verify the balance sheet at the hearing, or from which the items in the balance sheet are derived. (*e*)

Oppositions to Prolongation.—Any person may enter a caveat, addressed to the Registrar of the Council at the Council Office, against the extension. (*f*)

Any person intending to oppose the petition must enter a caveat before the day on which the petitioner applies to fix a date for the hearing. Where an intending opponent omits to enter a caveat within the prescribed period, the Board will not extend the time in his favour unless special reasons for so doing are shewn. (*g*)

An opponent who has properly entered a caveat is entitled to four weeks' notice from the petitioner of the time appointed for the hearing; he is also entitled to be served with a copy of the petition, and the petitioner must produce an affidavit of such service on the application to fix the date of the hearing. (*h*)

Opponents served with the petition must lodge at the Council Office eight printed copies of the grounds of their objections to the granting of the petition, within three weeks from the service of the petition upon them. It is not necessary to give particulars in detail of the grounds relied on. Thus, when the opponents relied on anticipation, and referred to certain documents as proving their objection, it was held that they were not confined on the hearing to the actual instances of anticipation of which notice had been given. (*i*)

Parties are entitled to be supplied at their own expense with copies of all papers lodged in respect of any petition. (*j*)

All petitions and statements of grounds of objection are required to be printed in the form prescribed by the Judicial Committee.

(*d*) Cf. *Johnson's Patent*, L. R. 5 P. C. 87.

(*e*) Rule 3.

(*f*) Patents Act, 1883, s. 25 (2).

(*g*) *Hopkinson's Patent*, 13 R. P. C. 114.

(*h*) Rule 4.

(*i*) *Ball's Patent*, 4 App. Ca. 171; 48 L. J. P. C. 24. This case was decided under the former Rules, but the words of the new Rules are the same.

(*j*) Rule 5.

Balance-sheets of expenditure and receipts must be printed in a form convenient for binding along with the petition. (*k*)

The Crown is always represented at the hearing of the petition, and does not require to enter any caveat. (*l*) The Lords of the Judicial Committee will hear the Attorney-General, or other Counsel, on behalf of the Crown on the question of granting the prayer of the petition. The Attorney-General is not required to give notice of the grounds of any objection he may think fit to take, or of any evidence which he may think fit to place before the Lords of the Committee. (*m*) As a general rule, the Attorney-General does not call evidence, but contents himself with cross-examining the petitioner and his witnesses. Where the petitioner has a good case the Attorney-General opposes lightly, and not as a trade rival might do. (*n*) He appears to watch the public interest and to assist, and, if necessary, instruct the Judicial Committee.(*o*) His duty is to see that the petitioner makes out a case for prolongation, rather than to oppose the case when made out. (*p*)

At the same time, the Attorney-General's opposition is not a mere matter of form. In every case he directs a searching enquiry by a Patent Office examiner into the novelty and character of the invention and by an accountant acting under the Treasury solicitor into its commercial history and the patentee's accounts. This is necessary in the public interest, to insure the Judicial Committee being fully informed as to all important facts bearing on the petition. No petitioner, therefore, can safely rely on concealing unfavourable circumstances from the Judicial Committee. Any want of candour will probably, even where no opponent appears, have disastrous consequences for the patentee. (*q*)

Practice at the Hearing.—The Board sit to protect the public as well as to reward deserving inventors. They will therefore require a petitioner to establish his title, whether it is disputed or not.

(*k*) Rule 5.

(*l*) *Erard's Patent*, 1 W. P. C. 557 n.; *Whitehouse's Patent*, 1 W. P. C. 474.

(*m*) Rule 8. *Livet's Patent*, 9 R. P. C. 327.

(*n*) *Allan's Patent*, L. R. 1 P. C. 507.

(*o*) *Stoney's Patent*, 5 R. P. C. 522.

(*p*) The Committee will not hear counsel on behalf of a department of the public service interested in the invention in question. The presence of the Law Officer affords sufficient protection to such interests, and they are adequately represented by him. *Wright's Patent*, 1 W. P. C. 561; *Galloway's Patent*, 1 W. P. C. 726; *Pettit Smith's Patent*, 7 Moo. P. C. 136.

(*q*) The following cases illustrate how the Attorney-General may bring to the notice of the committee matters not disclosed by the petitioner—*Livet's Patent*, 9 R. P. C. 327 (prior patent); *Standfield's Patent* (prior patents), 15 R. P. C. 17; *Hall's Patent* (triviality of the invention), 12 R. P. C. 401; *McLean's Patent* (accounts), 15 R. P. C. 418.

In cases where Counsel for the Crown admit the merit of the inventor and the inadequacy of the remuneration, and no opposition is offered to an extension of the patent term, the petitioner must still call his evidence and establish his claim to the indulgence which he craves. (*r*)

The Judicial Committee may call in the aid of an assessor, and, if they do so, fix the remuneration of such assessor. (*s*)

In considering petitions for the extension of patent monopolies, the Judicial Committee are directed by the Act of 1883 to have regard to the nature and merits of the invention in relation to the public, to the profits made by the patentee as such, and to all the circumstances of the case. (*t*) The extension of a patent term is anything but a matter of course, (*u*) and not to be claimed as of right, but conceded rather as an extraordinary privilege by way of equitable reward. (*v*) Thus an applicant for prolongation is always required to shew extraordinary merit and inadequate remuneration.

In considering these applications the Board allow their judicial discretion to be influenced by any such circumstances as would properly have weight with a sensible and reasonable person. (*w*)

It will be convenient to consider the authorities under the headings suggested by Section 25 (4) of the Patents Act, 1883.

I.—*The Nature of the Invention in Relation to the Public.*

Special Character of an Invention.—The nature of the invention will be considered by the Judicial Committee where the patentee has failed to bring his invention into general use, for the purpose of seeing whether this failure is due to the worthlessness of the invention or to special circumstances beyond the control of the inventor. (*x*)

In *Berrington's Patent* the inventor had totally failed to introduce his invention into public use, but as the invention (an improved

(*r*) *Cardwell's Patent*, 10 Moo. P. C. 490; *Darby's Patent*, 8 R. P. C. 380; *Joy's Patent*, 10 R. P. C. 89.

(*s*) Patents Act, 1883, s. 28 (2).

(*t*) Ibid. s. 25 (4).

(*u*) *Derosne's Patent* (per Lord Brougham), 4 Moo. P. C. 448; 2 W. P. C. 1; *Morgan's Patent*, 1 W. P. C. 738; *Jones's Patent*, 1 W. P. C. 577; *Pitman's Patent*, L. R. 4 P. C. 87; *Norton's Patent*, 1 Moo. P. C. (N. S.) 339; *Perkin's Patent*, 2 W. P. C. 18; *Pettit Smith's Patent*, 7 Moo. P. C. 137; *Honiball's Patent*, 9 Moo. 393.

(*v*) *Hill's Patent*, 1 Moo. P. C. (N. S.), 264; per Sir J. T. Coleridge.

(*w*) *Hill's Patent* (per Sir J. T. Coleridge), 1 Moo. (N. S.), 264.

(*x*) *Southworth's Patent*, 1 W. P. C. 487.

knapsack) was one which could only be used by the Government, the Board, in view of its peculiar nature, recommended an extension of the patent. (*y*) Similar weight was given to the peculiar nature of the invention in *Stoney's Patent*. (*z*) In that the case invention, which had not come into use, was for improvements in sluices and flood-gates. In recommending an extension of the patent term, Sir W. Grove said: "There is also another matter which has always been considered by this Court, and that is that the invention is not one which would promote itself, if I may use the expression. This is not a case like that of some of those little improvements in forks or knives, in fire-places, or things of that sort, which if once known, the public will necessarily have for their own convenience. On the contrary, this is an invention which only appeals to a small number of minds, is only used in a small number of cases, and requires a considerable outlay, and consequently it is not an invention of daily use, nor one of that class which rapidly gets into daily use; it is exceptional therefore in that respect." (*a*)

In *Southby's Patent*, (*b*) which was for improvements in apparatus for refrigerating, the patentee, although he had made a very meritorious discovery, had occupied nearly the whole of his patent term in trying to effect further improvements in his machine instead of pushing his invention as originally patented. On this failure to put the invention into use, Lord Hobhouse said: "Then there comes the fact that the machines have never been used. No doubt, as a rule, the non-user of an invention is proof or strong presumption of its non-utility. But that depends upon the opportunities which the trade have had of making use of the machines; and where those opportunities have been very rare, as in the case of some inventions only usable for large machines, or in very peculiar operations, the presumption of non-utility from non-user is small. In this case, which, as far as I know, is unique in that respect, the non-user has arisen from the conviction of the patentee himself that he has not brought his principle into such practical action as would justify him in offering a machine to the public or to the trade. Their lordships think, under the circumstances, that non-user is accounted for so as to rebut the presumption of non-utility which arises from it."

In the later case of *Semet & Solway's Patent*, the nature of the

(*y*) Cited in *Allan's Patent*, L. R. 1 P. C. 510; see *Bate's Patent*, 8 W. P. C. 739 n.

(*z*) 5 R. P. C. 518.

(*a*) Ibid. p. 523. Cf. also *Jones's Patent*, 1 W. P. C. 579.

(*b*) [1891], A. C. 432; 8 R. P. C. 437.

invention was also considered as rebutting the inference usually drawn from a failure to bring it into general public use during the patent term. There the patent was for improvements in apparatus for coking and distilling coal. In recommending an extension, the Judicial Committee said: "The invention appears to be one which from its very nature cannot reasonably be expected to come at once, or within a short period, into general use. Its adoption necessitates the destruction of existing and the erection of new apparatus, and will therefore, in all probability, be gradual, as the old-fashioned apparatus wears out." (*c*)

Nature of the Invention as Bearing on Merit.—The Judicial Committee will also consider the nature of the invention for the purpose of seeing whether it is calculated to confer some great benefit upon the public. (*d*)

In *Woodcroft's* case, the patent was for improvements in revolving paddles for propelling boats. (*e*) Lord Brougham said: "Now, we always take into account also, independently of the evidence, the nature of the invention. It appears to my mind that there is a clear step in the progress of steam navigation, and in the construction of that very useful instrument in steam navigation, the screw, for the purpose of propulsion. The step made is as to the increase of velocity, and its overtaking the water as it goes on, and that is obviated by a very refined and ingenious contrivance, and speaking as a scientific man merely, an original one—I mean substituting for a rectilinear screw wound round the cylinder, a curvilinear screw wound round the cylinder. I am of opinion, speaking upon scientific principles, that these are ingenious and important novelties in this matter. It is introducing a new mathematical principle, as well as a new mechanical principle, and I hold it to be a highly important improvement." (*f*)

Again, in *Houghton's Patent,* (*g*) their lordships considered favourably the nature of a discovery which had provided a new raw material in a trade of vital public interest, in which raw materials were scarce. James, L.J., said: "It appears to their lordships that the discovery is one of great importance, inasmuch as it is the application of a very valuable new material for the purpose of making paper pulp, which material is fibrous and not cellular, being produced from wood, a material which nobody

(*c*) 12 R. P. C. p. 16 (per Lord Watson).

(*d*) Per Romilly, M.R., in *Norton's Patent*, 1 Moo. P. C. (N. S.), 343.

(*e*) 2 W. P. C. 32.

(*f*) 2 W. P. C. 32.

(*g*) L. R. 3 P. C. 461; 7 Moo. P. C. (N. S.), 309.

ever supposed to be capable of producing such pulp; and produced by a process which has been shewn to be practically efficient for the purpose; and which, if it answer (and there seems a probability that if the trade could be induced to adopt it, it must), will be a great benefit, inasmuch as it is a valuable addition to the number of raw materials in a trade in which raw materials are very scarce and dear." So, too, the nature of inventions as tending to promote the safety of the public is viewed with favour by the Judicial Committee.

In *Hardy's Patent*, (*h*) the invention was for improvements on the axletrees of railway carriages. The Committee gave great weight to the nature of the invention, as calculated to secure increased safety in travelling, and Lord Brougham described the inventor as "a public benefactor, if ever there was one."

In *Lee's Patent*, (*i*) where the invention also related to railway travelling, similar weight was given to its nature.

In *Herbert's Patent*, (*j*) the invention was for improvements in constructing and mooring light-vessels and buoys. In recommending an extension, their lordships viewed with much favour the nature of the invention as providing night-guards for shipping in our channels. Sir William Erle said: "No one who is at all conversant with the litigation arising out of accidents from collisions in those channels, can fail to appreciate the advantage which such an invention as this may prove to be to the shipping interest."

In *Roper's Patent*, (*k*) where the invention was a life-saving raft, much weight was given to "the great utility of the invention in saving life."

In *Joy's Patent*, (*l*) the invention related to improvements in steam engines. By a regulation of the steam in its access to the piston a great saving in fuel was effected. It was estimated that in nine years' use of the patent this saving had amounted to £70,000. The patentee had been inadequately rewarded, and an extension of seven years was allowed.

Special Nature of an Invention may militate against Prolongation.—On the other hand, the nature of the invention in relation to the public may be an objection to the continuance of a monopoly in respect of it. Thus, in *McDougal's Patent*, (*m*) the Board, in refusing

(*h*) 6 Moo. P. C. 441.
(*i*) 10 Moo. P. C. 226.
(*j*) L. R. 1 P. C. 399; 4 Moo. P. C. (N. S.), 300.
(*k*) 4 R. P. C. 201.
(*l*) 10 R. P. C. 89.
(*m*) L. R. 2 P. C. 1; 37 L. J. P. C. 17; 5 Moo. P. C. (N. S.), 1.

to recommend an extension of the patent term, indicated as one of the grounds of such refusal the nature of the patent as being for a disinfectant; a discovery, the unrestricted use of which, in the interest of public health, ought not to be postponed.

II.—*The Merits of the Invention in Relation to the Public.*

The Merit must be Exceptional.—A high degree of merit must be made out. (*n*) The Judicial Committee will not lightly postpone the enjoyment by the public of its vested right to the free use of the patentee's invention, on the termination of the patent term, and any extension implies such a postponement. (*o*) Thus, it is not merely the degree of utility which is required to support a patent at law which will induce the Privy Council to extend a patent term. (*p*) In *Stoney's Patent*, (*q*) Sir William Grove said: "The theory of patents is that they are granted *ex mero motu* by the Crown on the recommendation of the legal advisers of the Crown upon *primâ facie* novelty and *primâ facie* merit. But to induce the Lords of the Privy Council to extend a patent, there must be something more than that; in other words, there must be more merit than would merely support a patent in a court of law."

In *Beanland's Patent*, (*r*) the extension was refused on the ground of want of merit. Lord Hobhouse said: "In this case, as regards the invention itself, there is no novelty in any portion of it. It is agreed that a hinged quadrant is not new; that lifting levers are not new, and that it is not new to apply a lifting lever to a hinged bar or quadrant. All that is new is that these contrivances are fitted with cords, and have been applied to fastenings and the openings of windows. It is a neat contrivance, but it has none of that merit which belongs to a person who strikes out a new principle, nor, as their lordships think, is there that merit which belongs to a person who makes a difficult and not easily seen combination of old principles."

To enable the Board to gauge the merit of the invention it is necessary that they should know the state of knowledge at the time the letters patent were granted. (*s*) The petition should therefore refer to any prior patents for similar inventions, so that

(*n*) *Saxby's Patent*, L. R. 3 P. C. 292; 7 Moo. P. C. (N. S.), 82 (per Lord Cairns).

(*o*) *Hill's Patent*, 1 Moo. P. C. (N. S.), 258; 9 L. T. (N. S.), 101.

(*p*) *Saxby's Patent*, supra. See, also, *Cocking's Patent*, 2 R. P. C. 151.

(*q*) 5 R. P. C. 518.

(*r*) 4 R. P. C. 489.

(*s*) *Fountain Livet's Patent*, 9 R. P. C. 327; *Standfield's Patent*, 15 R. P. C. 17.

the committee may see exactly what step in advance was made by the invention of which an extended monopoly is asked.

Although a strong case of merit must always be made out, the Committee will not weigh degrees of merit in golden scales. In *Woodcroft's Patent*, Lord Brougham said: "If there is considerable merit with originality and some considerable usefulness to the public that is sufficient." (*t*)

Merit considered apart from Remuneration.—The Judicial Committee will consider the merits of the invention apart from the question of the patentee's remuneration, and even where the remuneration has been *nil*, exceptional merit is still required. (*u*) It is impossible to define generally in what merit consists. In its degrees it may vary indefinitely, and what degree is required in the circumstances of any given case rests entirely in the discretion of the Judicial Committee. In *Hill's Patent*, (*v*) Sir John Coleridge said: "Now, one may strictly be an inventor within the legal meaning of the term—no one before him may have made and disclosed the discovery in all its terms as described in his specification—but this may have been the successful result of long and patient labour, and of great and unaided ingenuity, without which, for all that appears, the public would never have had the benefit of the discovery; or it may have been but a happy accident or a fortunate guess; or it may have been very closely led up to by earlier, and in a true sense, more meritorious, but still incomplete experiments. Different degrees of merit must surely be attributed to an inventor under these different circumstances. The moral claim to an extension of time may in this way be indefinitely varied, according as the circumstances approach nearer to the one or the other of the above suppositions. The same principle will apply to the consideration of benefit conferred upon the public. The extent of the benefit conferred must vary in each case with the circumstances."

Merit may lie in the difficulty attending the discovery as well as in the utility of the invention when it is found out. In *Swaine's Patent*, (*w*) both these classes of merit combined. Their lordships said: "We consider the invention as very meritorious, the result of a great deal of labour, care, and science, and that it is extremely useful in its effects."

(*t*) 2 W. P. C. 31.

(*u*) Per Lord Hobhouse, in *Beanland's Patent*, 4 R. P. C. 491. See, also, *Hall's Patent*, 12 R. P. C. 401.

(*v*) 1 Moo. (N. S.), 258; 9 L. T. (N. S.), 101.

(*w*) 1 W. P. C. 559.

Simplicity does not Negative Merit.—At the same time, it is not to be inferred that the merit is in proportion to the extent of the step taken by the patentee in making his discovery; a very small step may imply the greatest merit.

In *Soames's Patent*, (*x*) Lord Brougham said: "It is very fit that their lordships should guard against the inference being drawn, from the small amount of any step made in improvement, that they are disposed to undervalue that in importance; if a new process is invented, if new machinery is invented, if a new principle is found out and applied so as to become the subject of a patent right, embodied in a manufacture, then, however small it may be in advance of the state of science or of art previous to the period of that step being made, that is no reason whatever for undervaluing the merits of the person who makes a discovery in science, or an invention in art, because the whole history of science, from the greatest discoveries down to the most unimportant—from the discovery of the system of gravitation itself, and the fractional calculus itself, down to the most trifling step that ever has been made—is one continued illustration of the slow progress by which the human mind makes its advance in discovery."

In *Stoney's Patent*, (*y*) Sir William Grove said: "As to the simplicity of the invention, that is a matter upon which it is very difficult to express an opinion. Some of the most valuable inventions have been very simple in their character, and yet they have struck the world as a great novelty when they were first made, and the question of invention is very much a question of degree. Sometimes to see a thing which everybody else has not seen shews a high degree of inventive faculty, sometimes it shews little or none, and its merits can only be estimated by the particular matter to which it is applied, and by the general opinion of scientific men, or men acquainted with the particular subject with which the invention deals when it has been made known. There is no scale by which you can measure the merit in an invention, further than general opinion, and the opinion of people well acquainted with the subject. The best testimony to the merit of an invention is that it is a requisite unknown before, and which works efficiently."

In *Hazeland's Patent*, (*z*) the invention was an improved machine for planing wood: the point of the invention was the use of a thick elastic roller to feed the wood to the planing knife; the result was an extraordinary rapidity in the operation of planing and a great

(*x*) 1 W. P. C. 729. (*y*) 5 R. P. C. 518, p. 522. (*z*) 11 R. P. C. 467.

saving of labour. In recommending an extension of this patent for seven years the Committee said that the mere simplicity of the invention was no objection to prolongation, as it embodied a distinct step in advance of previous knowledge.

In *Semet & Solvay's Patent*, (*a*) which related to improvements in apparatus for coking and distilling coal, Lord Watson said: "Although the invention is apparently a very simple one, it is proved to be of considerable commercial utility. It not only effects a saving in the cost of maintaining the coking apparatus, but it yields a much larger percentage of coke with a considerably increased amount of the products of distillation. Their lordships have, under these circumstances, had no difficulty in coming to the conclusion that the invention is of sufficient merit to justify them, if the other circumstances of the case be favourable, in recommending an extension of the patent."

Merit in Relation to the Public.—The merit required is merit in relation to the public.

In *Johnson's Patent*, (*b*) letters patent had been taken out in England for an invention also patented in America, France, and Belgium. An extension of the patent had been granted in America, and the value of the invention was great; but it was shewn that the articles protected were manufactured exclusively in America and thence imported into England. The Committee refused prolongation. James, L.J., said: "What are the merits of the case? The merits of the case, so far as regards the English patent, appear to their lordships to be *nil*. The patentee, by taking out a patent in England, has in effect secured to himself a monopoly during a period of fourteen years of the sale of articles manufactured in America, and exported from America here, which would have been manufactured there and exported to this country quite in the same way if no English patent had been taken out, but with this difference, that the patentee would not have had the monopoly of his patent, and would not, therefore, have had any opportunity of securing the monopoly of prices. The merits, therefore, so far as regards the introduction of the invention into this country, seem to their lordships to be nothing."

Merit in the Case of an Importer.—The merit of an importer is less than that of an inventor. In *Soames's Patent*, (*c*) Lord

(*a*) [1895], A. C. 78; 12 R. P. C. 10; 64 L. J. Ch. 41.

(*b*) L. R. 4 P. C. 75; 8 Moo. P. C. (N. S.), 291.

(*c*) 1 W. P. C. 729, p. 733.

Brougham said: "We are now sitting here judicially, and it is an argument against the patent that it was imported and not invented. I do not say it takes away the merit, but it makes it much less." An importer, however, who has spent large sums in introducing a useful invention, may establish a strong case for prolongation. Thus, in *Berry's Patent*, (*d*) an extension was granted for seven years to an importer of a foreign invention, whose adventurous spirit and outlay of capital had so benefited the public as to afford solid grounds of reward.

In *Claridge's Patent*, (*e*) the extension was refused. There the importer, who had introduced, not a piece of complicated machinery, or a manufacture of difficulty or science, but something in general use at Paris, had formed a joint stock company, which had been induced to pay him £8000 for the invention. The Committee held that the importer had not taken upon himself much responsibility or perseverance, and that this was an adequate remuneration "for the introduction of a well-known substance from a foreign land."

Merit in the Case of an Assignee.—The merit of an assignee differs necessarily from the merit of an inventor. The test of an assignee's merit may be said to be the measure of the assistance rendered by him to the inventor in bringing the invention into public notice. (*f*) It sometimes happens that the inventor of a useful invention lacks the means required to advertise and push his invention; in such cases the public would never get the good of the patentee's discovery, unless the patentee were able to find some one willing to afford him financial assistance, either by taking the whole patent off his hands, or by taking a share of the patent, or by advancing him a loan upon it. When the invention is of high merit, the Court has always viewed with favour a party rendering such assistance to an impecunious patentee; but in granting an extension to an assignee, it has usually protected the interests of the original inventor by imposing terms on the assignee so as to secure to the inventor a share of the profits likely to accrue from the extension of the monopoly. (*g*)

Thus, in granting extensions to assignees the Board have regard not only to the merit of the assignee in aiding the patentee,

(*d*) 7 Moo. P. C. 187.

(*e*) 7 Moo. 394.

(*f*) *Norton's Patent*, 1 Moo. (. S.), 339; 11 W. R. 720.

(*g*) See *Whitehouse's Patent*, 1 W. P. C. 477; 2 Moo. P. C. 496; *Jones's Patent*, 1 W. P. C. 579; *Hardy's Patent*, 6 Moo. 445; *Markwick's Patent*, 13 Moo. 313; 8 W. R. 333.

but also to the interests of the inventor himself. By favourably listening to the application of the assignee, their lordships consider that they are, though not directly, yet mediately and consequentially conferring a benefit upon the inventor; seeing that if extension was in no case granted to an assignee, the chance of the patentee making an advantageous conveyance of his patent would be materially diminished, and his interest thereby damnified. (*h*)

At the same time, if the price paid by the assignee to the original inventor has afforded the inventor adequate remuneration, no useful purpose is served in prolonging the monopoly, and extension will be refused. (*i*)

In some cases the assignee has been put upon terms to secure that the patentee shall participate in any profits obtained through the prolongation. In *Russell's Patent*, (*j*) the inventor, a mechanic, had assigned his interest to the petitioner, who was his master. The Privy Council, before recommending an extension, required the petitioner to execute an instrument, securing £500 per annum to the inventor. In *Hardy's Patent*, (*k*) the assignees were put upon similar terms to secure the further remuneration of the inventor. In *Herbert's Patent*, (*l*) the patentee, who had assigned half of the patent, petitioned jointly with his assignees, but died before the petition came on for hearing. An extension was granted to the assignees, but only on their undertaking to hold a moiety for the representative of the patentee.

Where the interests of the patentee are already safeguarded, terms will not be imposed on the assignees. In *Houghton's Patent*,(*m*) the assignment, which had been made to a *bonâ fide* company, was paid for partly with 121 paid-up shares in the company, of the nominal value of £50 per share. An extension of seven years was granted without terms.

When the patentee has made a fair profit out of his invention and the assignee has expended large sums without remuneration, terms in favour of the patentee will not be imposed. (*n*)

In *Soames's Patent*, where assignees had paid £800 for the

(*h*) *Morgan's Patent*, 1 W. P. C. 737; *Pitman's Patent*, L. R. 4 P. C. 84; 8 Moo. P. C. (N. S.), 293.

(*i*) *Hopkinson's Patent*, [1897] A. C. 249; 14 R. P. C. 5; *Finch's Patent*, 15 R. P. C. 675.

(*j*) 2 Moo. 497.

(*k*) 6 Moo. 44, s. 1.

(*l*) L. R. 1 P. C. 399; 4 Moo. P. C. (N. S.), 300.

(*m*) L. R. 3 P. C. 461; 7 Moo. P. C. (N. S.), 309; cf. *Davies' Patent*, 11 R. P. C. 27.

(*n*) *Bodmer's Patent*, 6 Moo. 468; *Porter's Patent*, 2 W. P. C. 196.

patent and spent largely upon it without remuneration, so that the invention had proved to them a *damnosa hereditas* and the Court considered the public to have gained something by their public spirit and activity, an extension was granted without terms. (*o*)

When the assignee has expended nothing on the patent he has no merit, and an extension will not be granted him. (*p*) So, too, where it was shewn that the patentee himself had made a good profit and that the petitioner had purchased the patentee's stock-in-trade at a fair value, and had been no loser by the transaction, extension was refused. (*q*)

Assignments by way of Commercial Speculation.—The committee are not disposed to encourage assignments by way of commercial speculation. So, where a joint stock company purchased a patent of small merit from an inventor for a large sum and otherwise incurred large expenditure, the Judicial Committee held that the company had entered into a commercial speculation with a full knowledge of all the circumstances, and that the disappointment of their expectations was no valid reason for prolonging the monopoly. (*r*)

In *Barff's & Bower's Patent*, (*s*) the inventiou had been assigned to a company which had paid the patentees a considerable sum, and worked the invention at a loss. In refusing to recommend an extension of the patent, Lord Watson said: "The cases of *Claridge's Patent* and of *Norton's Patent* appear to their lordships to establish the principle that an assignee who has acquired a patent that is the subject of a commercial adventure is not entitled to obtain a prolongation when the inventor could have no legitimate interest in making such an application himself. In one of those cases the decision of the Board went expressly upon the ground that the applicants were a commercial company, and that the original inventor was dead, and could have no further interest in the patent. In this case the original patentees, the inventors, are alive; but they are, for all practical purposes, for all purposes of the present question, in the same position as if they were simply dead, because they would no longer have any interest to ask for a prolongation on their own account, because they have been sufficiently remunerated at the expense of the patent. Now, there

(*o*) 1 W. P. C. 735. See also *Foarde's Patent*, 9 Moo. 376.

(*p*) *Normand's Patent*, L. R. 3 P. C. 193; 6 Moo. P. C. (N. S.), 477.

(*q*) *Quarrill's Patent*, 1 W. P. C. 740.

(*r*) *Claridge's Patent*, 7 Moo. 398. See, also, *Pitman's Patent*, L. R. 4 P. C. 84; 8 Moo. P. C. (N. S.), 293.

(*s*) [1895] A. C. 675; 12 R. P. C. 383.

is no case to be found in which this Board has given an extension of a patent to an assignee which did not rectly or indirectly tend towards the benefit of the original inventor, who would, had there been no assignment, have been in a position to claim an extension himself." (*t*)

A similar course was taken by the Board in *Hopkinson's Patent*,(*u*) where the petitioners were also a company. There the patentee owed his remuneration to the company, which had incurred loss through the patent. Lord Hobhouse said: "Their lordships consider that they would be departing both from authority and from sound principle, if they were to hold that this company occupies the position of an inventor who has been inadequately remunerated. The company entered on a purely commercial speculation, which, unluckily for them, has up to the present time proved unremunerative. They did not assist to perfect or bring out the invention; they purchased it, or at least the beneficial interest, out and out, from a prior assignee of the inventor, who has, in one way or another, been well paid, and has now no claim or interest to ask for an extension. It is, therefore, impossible for their lordships to make such a report as, under Section 25 of the Act, is the necessary condition of extension." (*v*)

III. *The Profits of the Patentee as such.*

An extension of the patent monopoly being only granted when the patentee has been inadequately remunerated, the Judicial Committee always require a petitioner to place before them a clear and complete statement of the profit and loss attributable to the invention. Without such disclosure their lordships cannot judge of the inadequacy of the remuneration already received. (*w*) Hence, where the accounts have appeared unsatisfactory on the face of them, the Committee, treating them as lying on the very threshold of the case, have sometimes refused the petition without going into evidence or considering the merits of the invention. (*x*)

The Petitioner's Accounts.—The accounts then presented by a petitioner should be clear and plain on the face of them. The

(*t*) 12 R. P. C. 386.

(*u*) 14 R. P. C. 5. See, also, *Carmont's Patent*, 14 R. P. C. 239.

(*v*) See, also, *Clark's Patent*, 16 R. P. C. 431.

(*w*) *Deacon's Patent*, 4 R. P. C. 119.

(*x*) *Saxby's Patent*, L. R. 3 P. C. 292; 7 Moo. P. C. (N. S.), 82. *Clark's Patent*, L. R. 3 P. C. 421; 7 Moo. P. C. (N.S.), 255. *Weild's Patent*, L. R. 4 P. C. 89. *Houghton's Patent*, L. R. 3 P. C. 461; 7 Moo. P. C. (N. S.), 309. But, see *Betts' Patent*, 7 L. T. (N. S.), 577; 1 Moo. (N. S.), 49.

patentee must not present ambiguous accounts, trusting that the Committee will unravel their meaning; for their lordships cannot undertake to analyse accounts (*y*).

In *Saxby's Patent,* (*z*) Lord Cairns said: "It is the duty of every patentee who comes for the prolongation of his patent to take upon himself the onus of satisfying this Committee in a manner which admits of no controversy as to what has been the amount of remuneration which in every point of view the invention has brought to him, in order that their lordships may be able to come to a conclusion whether that remuneration may be fairly considered a sufficient reward for his invention or not. It is not for this Committee to send back the accounts for further particulars, nor to dissect the accounts for the purpose of surmising what might be their real outcome if they were differently cast; it is for the applicant to bring his accounts before the Committee in a shape which will leave no doubt as to what the remuneration has been that he has received."

The accounts must shew the actual profits and expenditure. Mere estimates will not do; (*a*) nor a general statement that there has been neither profit nor loss. (*b*)

In *Lake's Patent,* (*c*) accounts were presented differing from the books which had been kept. These accounts had been prepared by an accountant. It being stated that the books had been kept on a wrong system, the Board held the accounts insufficient, and declined to admit evidence in explanation of them; stating that a petitioner's application is really an *ex parte* one; and, therefore, full and clear information must be given; for the Committee will not, even when opponents appear, go into the accounts, as a Court would do which was conducting an enquiry between partners. (*d*)

At the same time, this rule, though generally acted upon, may be waived in exceptional circumstances.

"Their lordships do not mean to say," said Lord Hobhouse in the above case, "that there might not be a case in which it would be proper to unravel and investigate accounts. Frauds might have been committed, or there might have been some peculiarity of the business which would render that necessary by some

(*y*) *Perkins' Patent*, 2 W. P. C. 14 (per Lord Campbell). See, also, *Adair's Patent*, L. R. 6 App. Ca. 179.

(*z*) L. R. 3 P. C. 292; 7 Moo. P. C. (N. S.), 82. See, also, *Duncan and Wilson's Patent*, 1 R. P. C. 257; 50 L. J. C. P. 68.

(*a*) *Normand's Patent*, 3 L. R. P. C. 193; 6 Moo. P. C. (N. S.), 477.

(*b*) *Quarrill's Patent*, 1 W. P. C. 740.

(*c*) [1891] A. C. 240; 8 R. P. C. 227; 60 L. J. P. C. 57.

(*d*) Ibid.

proceedings, either here or with the aid of the Crown, before the parties arrived at this stage of the business. But then a special case should be made for that purpose. In this case the petition tells us nothing about the necessity of going through these operations; it does not explain why the books were kept in this way, or why it is now proper to alter the accounts; it does not even shew that they are to be altered, it merely states that the petitioner is inadequately remunerated, and then lays the accounts upon the table, from which, as I said before, their lordships cannot judge whether the fact is so or not."

In *Darby's Patent*, (*e*) where the Committee were satisfied that the patentee had incurred heavy loss through the patent, they excused an inability to prove the loss with accuracy.

In *Thorneycroft's Patent*, (*f*) it appeared by the accounts that handsome profits had been made by the petitioners upon boilers supplied by them for ships built by others, but that on the boilers fitted into their own ships there had been a loss of 10 per cent. No explanation was given of this circumstance. In declining to recommend a prolongation, Lord Davey said: "In the absence of any explanation, the facts proved are consistent with the existence of some error of judgment, miscalculation, or other defect in the petitioners' mode of carrying on their business of boat building, and their lordships cannot accept the evidence as proof that no profit was, or could have been made, in working the patented invention."

Profits Year by Year.—The profits year by year ought to be shewn, for their lordships, in estimating the merit of the invention in relation to the public, consider the ratio of increase or decrease in the profits over the respective years. (*g*) Thus, where the sales under a patent which has at first had little popularity shew a tendency to increase in the later years, the Committee will view this circumstance with favour as shewing a growing, if late, appreciation by the public of a valuable invention. (*h*) Thus, in *Cocking's Patent* the accounts shewed profits and loss as follows: 1871–73, £277 3*s.* profit; 1873–75, £50 loss; 1875–83, £830 1*s.* 11*d.* profit; and between 1883–85, £527 5*s.* 10*d.* profit. Their lordships

(*e*) 8 R. P. C. 380.

(*f*) 16 R. P. C. 204; [1899] A. C. 415. An invention for water tube boilers.

(*g*) *Perkin's Patent*, 2 W. P. C. 15.

(*h*) *Downton's Patent*, 1 W. P. C. 565; *Swaine's Patent*, 1 W. P. C. 559; *Roberts' Patent*, 1 W. P. C. 573; *Ryder's Patent*, Pract. Mech. Journ. vol. vii. p. 238; *Houghton's Patent*, L. R. 3 P. C. 461; 7 Moo. P. C. (N. S.), 309; *Cocking's Patent*, 2 R. P. C. 153; *Hardy's Patent*, 6 Moo. 441; *Church's Patent*, 3 R. P. C. 95; *Beanland's Patent*, 4 R. P. C. 489.

viewed with favour the increased profits of the later years, as shewing that the invention, though at first unsuccessful, had latterly been in the way of success, although that success had not lasted long enough to remunerate the inventor, and an extension was recommended. (*i*) So, on the other hand, where the demand for the article has diminished, and the sales have fallen off, that circumstance is unfavourable to an extension. (*j*) In such a case their lordships will not undertake the wide range of speculation required to consider whether the falling off is due to depression of trade or to general influences of that kind. (*k*)

The profits made year by year are also material with reference to the number of years for which extension may be recommended. (*l*) The expenditure incurred, as well as the profits made, should be shewn year by year; for it is necessary to know whether the expenses are to be apportioned against years of large business and profit, or against years in which no business has been done. (*m*)

The profits which a patentee may make in the closing year of his monopoly are material and should be shewn, for it is always possible that the profit of the last year may bring the remuneration up to what is adequate. (*n*)

Patent Accounts to be Distinct Accounts.—The patent accounts must be presented distinct from those of any other business in which the patentee may happen to be engaged. (*o*) The patentee ought therefore from the first to keep a separate account for his patent. For the Committee assume that every patentee knows he may eventually have a claim to an extension of his monopoly, and they expect him, when the necessity arises, to be ready to give the clearest evidence of everything received on account of the patent. (*p*)

In *Willans & Robinson's Patent*, (*q*) where the invention was the adaptation of an air buffer to control the moving parts of high-speed single-acting engines, very full accounts were presented by the petitioners. It was admitted, however, that the engines sold

(*i*) 2 R. P. C. 153. See, also, *Smith's Patent*, 2 R. P. C. 14.

(*j*) *Beanland's Patent*, 4 R. P. C. 491; *Yates & Kellett's Patent*, 12 App. Ca. 147; 4 R. P. C. 150.

(*k*) *Beanland's Patent*, supra.

(*l*) *Perkin's Patent*, 2 W. P. C. 15. In this case, the patent being otherwise satisfactory, an adjournment was granted to allow of the accounts being recast.

(*m*) *Yates & Kellett's Patent*, 12 App. Ca. 147; 4 R. P. C. 150. For examples of accounts, see Appendix IV. post.

(*n*) *Macintosh's Patent*, 1 W. P. C. 739, note.

(*o*) *Clark's Patent*, 16 R. P. C. 431.

(*p*) *Belt's Patent*, 1 Moo. (N. S.), 61; 7 L. T. (N. S.), 577; *Saxby's Patent*, L. R. 3 P. C. 292; 7 Moo. (N. S.), 82; *Duncan & Wilson's Patent*, 1 R. P. C. 257; *Willacy's Patent*, 5 R. P. C. 695.

(*q*) 13 R. P. C. 550.

by the patentees owed their popularity, at least in part, to the use of another patented invention relating to a central valve, and no attempt had been made in the accounts to apportion between the two patents the profits attributable to each. The petitioners urged that owing to the working of their business it was not possible to do this. The Board refused prolongation, stating that on the accounts as presented they could not say that the remuneration had been inadequate.

Manufacturer's Profit.—The rule that the patentee must disclose all the profits made by him which are attributable to the invention requires that where an inventor is likewise manufacturer of the patented article the accounts must shew his manufacturer's profits. In such case it is usually the patent which gives him his market, and secures the sales. (*r*)

In *Hill's Patent*, their lordships said: "It is to be remembered that the accounts which a patentee renders in support of such a petition as the present are not such as might be proper between two several claimants on the returns of a mercantile firm, but such as shew what profits made by a firm or individual are in a large sense attributable to the possession of the patent-right, those which without the patent would not have existed at all; not, of course, excluding all just deductions for labour, capital, etc. If, but for the patent there would have been no manufactory, then the net profits of the manufacturer are in that large sense attributable to the patent. With it the manufacturer has a monopoly. . . The patent may be said to create his trade, at least to develop it to an extent which would be impossible without it; it cannot be reasonable, then, that when called on to state what profits he owes to the patent, the patentee should withhold these, which he estimates at two-thirds of his total profits, from the account. Their lordships cannot satisfactorily discharge their duty unless they have the whole case before them; they must know the whole remuneration; different considerations may be applicable to different parts of it; but if to any extent the patentee has received his remuneration by the making and selling the patented article, the profits on that sale must be disclosed and taken into account." (*s*)

(*r*) *Muntz Patent*, 2 W. P. C. 119 (per Lord Brougham); *Bett's Patent*, 1 Moo. (N. S.), 49; *Hill's Patent*, 1 Moo. (N. S.), 267; 9 L. T. (N. S.), 101; *McInnes's Patent*, L. R. 2 P. C. 54; 5 Moo. P. C. (N. S.), 72; 37 L. J. P. C. 23; *Saxby's Patent*, supra.

(*s*) 1 Moo. (N. S.), 270; 9 L. T. (N. S.) 101.

So, too, in *Saxby's Patent*, Lord Cairns said: "It has been decided more than once, by this Committee, that when a patentee is also the manufacturer, the profits which he makes as manufacturer, although they may not be in a strict point of view profits of the patent, must undoubtedly be taken into consideration upon a question of this kind. It is obvious that in different manufactures there will be different degrees of connection between the business of the applicant as a manufacturer and his business or position as the owner of a patent. There may be patents of some kind which have little or no connection with the business of the manufacturer, and there may be patents of a different kind, where there is an intimate connection with the business of the manufacturer, and the possession of the patent virtually ensures to the patentee his power of commanding orders as a manufacturer." (*t*)

Thus, in a patent for railway signals, where the owners of the invention were likewise manufacturers of the patented articles, the Court considered that railway companies, knowing the interest of the owners in the perfect making of the articles, would be more likely to purchase from them than from other makers, and consequently viewed the manufacturing profits as in a large degree the product of the patent. (*u*)

Foreign Profits.—The Court must know all the profits made by the patentee, whether made in this country or abroad. Therefore, where an English patentee has likewise obtained foreign patents for the same invention, he must disclose his profits on the foreign patents as well as on the English one. (*v*). In a recent case it was argued that the words of Section 25 sub-section 4 restricted the enquiry as to profits, and that in naming the profits of the patentee the legislature had intended to confine the enquiry to the profits of the patentee as such only, and that a disclosure of the profits of foreign patents was not now necessary, but the Judicial Committee took a different view, and followed the old practice; adding that the words of the section were indicative of one class of profits which must be considered, and not restrictive of the Committee's discretion, and that at least they would go into the consideration of general profits as falling under "all the circumstances of the case." (*w*)

So, too, the accounts must include all profits which may have

(*t*) L. R. 3 P. C. p. 295; 7 Moo. (N. S.), 82.

(*u*) Ibid.

(*v*) *Newton's Patent*, 9 App. Ca. 592; 1 R. P. C. 177.

(*w*) Ibid. See also *Pieper's Patent*, 12 R. P. C. 292.

accrued to the patentee from articles made for exportation and sale abroad. (*x*)

And of course the rule as to the inclusion of manufacturer's profits applies to a patentee's foreign patents as well as to English patents. For all the profits, whether in one county or another, must be shewn. (*y*)

Profits made by other Persons.—Besides knowing what the patentee has earned by his invention, the Judicial Committee further require that it should be clearly shewn to them what the public have had to pay for it. In *Trotman's Patent*, (*z*) it was said that a petitioner should include in his statement of account, not only his own profits, but also all profits attributable to the patent made by other persons; and that if a patentee had so dealt with his patent rights as to put it out of his power when the time arrived for asking for a renewal of his term to give the requisite evidence under this head in support of his application, his petition would be refused. (*a*)

In this case the inventor, with the object of avoiding the expense of himself erecting works for the manufacture of his invention, had given licenses, and the Court held that it was not sufficient merely to disclose the royalties received, but that the manufacturing profits of the licensees should also have been shewn. (*b*)

In *Thomas & Gilchrist's Patent*, (*c*) one-third of the patent had been assigned to persons who held a free licence, and had worked on a large scale under that licence. The profits made under the licence were not disclosed. On this Lord Hobhouse said: "All the profits that were made by virtue of the assignment of the third share in the patent are properly profits of the patent so far as the manufacturing profits are assignable to the patent, and all the profits that have been made by the use of a free licence, as compared with profits made by other persons who have paid royalties for their licence, are also profits of the patent. The accounts shew absolutely nothing of those two items. How large they are we do not know. We could not tell without further accounts to what extent that remuneration has gone beyond the amount admitted.

(*x*) *Hardy's Patent*, 6 Moo. P. C. 441.

(*y*) *Johnson's Patent*, L. R. 4 P. C. 75; 8 Moo. P. C. (N. S.), 291. In this case the English profits were £5400. But in America £16,000 had been derived from the invention. Extension was accordingly refused. See also *Thomas & Gilchrist's Patent*, 9 R. P. C. 367; *Davies' Patent*, 11 R. P. C. 27.

(*z*) L. R. 1 P. C. 118; 3 Moo. P. C. (N. S.), 488.

(*a*) Ibid.

(*b*) Ibid.

(*c*) 9 R. P. C. 367.

Upon that ground their lordships think that this case falls distinctly within the principle of *Saxby's* case. . . . They hold that the accounts are inadequate, and that the petition must be dismissed with costs."

At the same time, in many cases it would be obviously impossible to give an account of the profits of every licensee, and the correct rule would seem to be that the special circumstances of the case must in each instance be taken into consideration. (*d*)

Patent assigned to a Company.—So, too, where the patentee has transferred his rights, either in whole or in part, to a company, it is essential that there should be deposited, not only an account of the patentee's profits, but also of the profits of the company. (*e*) If a company petitions, the petition should state whether any, and what, dealings have taken place in the shares.

Where a patentee had sold his invention to a limited company, who had worked it for some years, and the petitioner gave no information as to the dealings in the company's shares, the accounts were held insufficient. Lord Watson said: "There is another point upon which no information is given, and which ought not to be lost sight of. In this case it appears that a joint stock company, which must have been incorporated in terms of an Act of Parliament, because it is a limited company, carried on business for eight years. What the public paid in respect of that will depend upon two things, first, upon the trade with regard to the patent, and, in the second place, upon their dealing with shares upon the Stock Exchange. That has been pointed out already in more than one case as a matter very seriously affecting the question." (*f*)

In *Barff's & Bower's Patent*, (*g*) Lord Watson, during the argument, said: "There ought to be always a statement in these cases—having regard to observations that have been made by this Board from time to time—when a company come as petitioners, as to whether any, and if so what, dealings have taken place in the shares. In one case we dismissed an application because it appeared that the individual members of the company had benefited themselves by the sale of shares."

Deductions allowed from Gross Profits.—In gauging the profits of a patent, the Judicial Committee consider what the *nett* profit has been. The patentee has, therefore, always been allowed to

(*d*) 9 R. P. C. p. 372.

(*e*) *Deacon's Patent*, 4 R. P. C. 119. The profits of an exclusive licensee should be shown: *Shone's Patent*, 9 R. P. C. 438.

(*f*) *Lane Fox's Patent*, 9 R. P. C. 413.

(*g*) [1895] A. C. 675; 12 R. P. C. 383.

make certain deductions from the gross profits. The expenses of taking out the patent, the cost of experiments necessary to perfect the invention, and the outlay incurred in pushing it, may be deducted. (*h*)

But the deductions must not be in the form of sums stated as mere estimates; and where expenses are deducted, the expenses should not be generally thrown together in a round sum, but clearly explained and made out in detail.

In *Clark's Patent*, (*i*) the following was one of the items set off in the accounts against the profits of the invention: "By travelling, office, printing, and incidental expenses for proposed patent docks at Portsmouth, Vancouver Island, Bermuda, Marseilles, Bordeaux, Toronto, Brindisi, Brest, Constantinople, Amsterdam, Rio Janeiro, Melbourne, Liverpool, Falmouth, Lisbon, Genoa, Cuba, Jamaica, Calcutta, Barcelona, Cadiz, etc., in respect of which no separate accounts have been kept, but the total of which exceeds £2000; being, in fact, that proportion of the general expenses of the petitioner's office and staff of assistants in his profession of a civil engineer which he considers fairly attributable to his efforts to establish docks on his system at the several places mentioned." The Committee disapproving of this as a sum stated merely as an estimate, the accounts were held insufficient.

In *Willacey's Patent*, (*j*) utility was not made out as to the whole patent, but only as to the third combination; the accounts included deductions for expenses incurred in pushing the patent, but did not shew how far these deductions were fairly referable to the third combination only. The Committee intimated that on different accounts the extension of the third part of the patent might have been granted, but under the circumstances it was with regret refused.

Deductions by way of Salary to Inventor.—The patentee is entitled to deduct a sum for remuneration for his time and labour in superintending the working of the invention and pushing it into public notice, where he does work which might have been done by some one hired for the purpose. (*k*) But as a charge of this kind will be narrowly watched, (*l*) the patentee must be prepared to satisfy the Judicial Committee that he has really been devoting

(*h*) See *Roberts' Patent*, 1 W. P. C. 575; *Galloway's Patent*, 1 W. P. C. 729; *Bett's Patent*, 7 L. T. (N. S.), 577; 1 Moo. P. C. 19.

(*i*) L. R. 3 P. C. 421; 7 Moo. P. C. (N. S.), 255.

(*j*) 5 R. P. C. 695.

(*k*) *Roberts' Patent*, 1 W. P. C. 574.

(*l*) *Carr's Patent*, L. R. 4 P. C. 539.

his time to the development of the invention during the whole of the period over which the deduction is made. (*m*)

In *Wield's Patent*, the Committee disapproved of items charged for the patentee's personal allowance after he had become incapable of conducting business or giving any active superintendence to the invention. (*n*) What sum the patentee may deduct as a *quantum meruit* for his personal services must in each case depend on the particular surrounding circumstances. (*o*) It is obvious that the value of a patentee's time must vary very greatly according to the knowledge and skill he possesses. In *Perkin's Patent*, (*p*) where the superintendence of the invention required great attention, skill, and knowledge of the trade, a charge of £400 for thirteen and a half years (£5400 in all) was allowed to the patentee. (*q*) So, too, in *Carr's Patent* a charge of £400 was allowed during some years, on the ground that the patentee was a gentleman of science and great mechanical skill, whose time was fully as valuable as the price he set upon it. (*r*)

A patentee is not entitled to deduct, however, for time spent by him in visiting and superintending the works of his licensees. (*s*)

A foreign patentee resident abroad is entitled to deduct the expense he has been put to in employing an agent to push the invention in England. (*t*)

Deduction of Legal Expenses.—Where the patentee has been involved in litigation, he may deduct the loss arising from legal expenses. (*u*) But he must furnish the Judicial Committee with the means of ascertaining with precision the amount of his legal outlay. The item should not be put down merely in a lump sum, the Committee being left to feel its way as to how that sum is made up and can be justified, but the patentee must give them all the light in his power on such a deduction.

Where the patentee in some cases of expensive litigation made settlements under compromises, and gave up claims to costs to

(*m*) *Furness's Patent*, 2 R. P. C. 175.

(*n*) L. R. 4 P. C. 89; 8 Moo. P. C. (N. S.), 300.

(*o*) *Bailey's Patent*, 1 R. P. C. 1. Whether it be £400 or £4000 must depend on the circumstances of the particular case (per Lord Blackburn).

(*p*) 2 W. P. C. 17.

(*q*) See, also, *McInnes's Patent*, L. R. 2 P. C. 54; 37 L. J. P. C. 23; 5 Moo. P. C. (N. S.), 72; and *Cocking's Patent*, 2 R. P. C. 151.

(*r*) L. R. 4 P. C. 539. See *Joy's Patent*, 10 R. P. C. 89, where £400 was also allowed.

(*s*) *Trotman's Patent*, L. R. 1 P. C. 118; 3 Moo. P. C. (N. S.), 488.

(*t*) *Poole's Patent*, L. R. 1 P. C. 514; 36 L. J. P. C. 76; 4 Moo. P. C. (N. S.), 452.

(*u*) *Bett's Patent*, 1 Moo. (N. S.), 62; *Galloway's Patent*, 1 W. P. C. 729; *Roberts' Patent*, 1 W. P. C. 575; *Kay's Patent*, 1 W. P. C. 568.

which he had an apparent title, the Committee disapproved of this deduction taking the form of a general unexplained lump sum. (*v*)

Deductions made must have Reference to Patent only.—Where a patentee, who is also a manufacturer, deducts general manufacturer's charges, the charges must be shewn to be directly attributable to the patent only. In *Duncan & Wilson's Patent*, the petitioners, besides working the patent, did a general business, and the accounts did not distinguish the charges incurred for the patent from those of the rest of the business. Cartage, shipping, and travelling expenses and another large sum for advertising and commission were put down to be deducted from the profits of the patent, though it seemed clear that these were all the expenses of the kind which had been incurred in the whole business. This was held insufficient. (*w*)

A petitioner will not be allowed to give evidence regarding deductions which he has not entered in his accounts or referred to in his petition; for the public interest requires that notice of all proposed deductions should have been given to facilitate those whose duty it is to watch the patentee's accounts. (*x*)

Loss of Books not Generally Excused.—It must not be forgotten that the onus of satisfying the Judicial Committee is on the patentee, so that allowance will not generally be made for such circumstances as may have put it beyond his power to give the information required. (*y*) In *Markwick's Patent*, the absence of proper accounts was explained on the ground that the patentee's books had been lost in the Bankruptcy Court. Evidence was given to shew that they could not be found, and had probably been destroyed as waste paper. But the Committee refused to proceed until an account, verified by affidavit, was submitted to the Attorney-General. And this was done. (*z*) In *Adair's Patent*, (*a*) the petitioner had made up his accounts after the destruction of a number of his books by rats; the Committee rejected the accounts as resting on no valid foundation. In *Yates & Kellett's Patent*, (*b*) the accounts did not shew the profits clearly, but were confused by the insertion of matters relating to other business. The petitioner sought to excuse this on the ground that the books had been destroyed. But their lordships, while recognizing that

(*v*) *Hill's Patent*, 1 Moo. (N. S.), 258; 9 L. T. (N. S.), 101.
(*w*) 1 R. P. C. 257.
(*x*) *Bailey's Patent*, 1 R. P. C. 1.
(*y*) *Bett's Patent*, 1 Moo. (N. S.), 61; *Willacy's Patent*, 5 R. P. C. 695.
(*z*) 13 Moo. 310.
(*a*) L. R. 6 App. Ca. 176.
(*b*) L. R. 12 App. Ca. 147; 4 R. P. C. 150.

the books might have been destroyed honestly, and with no intention to conceal the truth, said the petitioner could not escape the consequences. "A man," said Lord Hobhouse, "is bound to shew what his profits have been before he can come for a renewal of a patent. If he destroys his books he destroys the very means upon which he must rely for a renewal of his patent." (*c*)

Opponents are not entitled to see the petitioner's accounts for purposes of inspection before the hearing. (*d*) The object of requiring copies to be left at the office (*e*) is in order that the Law Officer may have the opportunity of examining and testing the accounts by making inquiries respecting them, if necessary. (*f*)

In *Johnson & Atkinson's Patent*, where the rule as to this had not been complied with, and the accounts had not been filed till the morning of the day of hearing, the Judicial Committee refused to look at them, but allowed an adjournment. (*g*)

IV.—*All the Circumstances of the Case.*

Laches of an Inventor.—The extension of letters patent being a grant by way of equitable reward, and not a claim of right, the applicant is bound to strict good faith. He must shew good faith in his conduct during the term of years for which he has already enjoyed his monopoly. Thus, he must shew that during that period he has used all reasonable means to make the most of his discovery, and to enlist the public support. "A patentee must not lie idle, but must do his best reasonably to promote his invention." (*h*) The Committee must be satisfied that all reasonable means have been used to make the patent productive, and that, despite such means, the remuneration has been inadequate. (*i*)

In *Norton's Patent*, (*j*) Romilly, M.R., said: "Their lordships think that, if nothing has been done with this patent for the period of ten years, during which the petitioner has had it, it must be either because the patent itself cannot be practically employed for any useful or beneficial purpose, or because the petitioner has purposely abstained from endeavouring so to

(*c*) See, also, *Lawrence's Patent*, 9 R. P. C. 85.

(*d*) *Bridson's Patent*, 7 Moo. 499.

(*e*) P. C. Rules, 1897, R. 3.

(*f*) *Johnson & Atkinson's Patent*, L. R. 5 P. C. 87.

(*g*) Ibid. See, also, *Deacon's Patent*, 4 R. P. C. 119.

(*h*) Per Sir W. Grove, in *Stoney's Patent*, 5 R. P. C. 523.

(*i*) *Honiball's Patent*, 9 Moo. 393.

(*j*) 1 Moo. (N. S.), 339, p. 341; 11 W. R. 720.

employ it. If the former were the case, that would furnish a decisive reason why their lordships should not grant an extension of the patent; or, on the other hand, if the fact be that this patent can be put to a useful and beneficial purpose, but the petitioner has abstained from doing so, their lordships are unable to understand, and would require to have it explained to them, why it should not have been put to a useful and beneficial purpose during the ten years that the petitioner has been possessed of it. Their lordships think it would be setting a bad precedent, which would lead to injurious consequences, if they were to countenance that species of wilful delay. It may well happen in the progress of discovery and improvement that is daily taking place in every department of science and art, that inventions and discoveries might be made applicable to the particular subject-matter of some patent which, in conjunction with, and as an addition to it, might be of great value to the inventors, but which not only could not be put into practice without making use of the previous invention, but for which patents had been obtained on the faith that, on the expiration of the patent for the original invention itself, they would become profitable. And if their lordships were to permit a patentee to keep his patent unemployed for a period of ten or twelve years in the expectation that such a state of things might arise, and then, when it arose, come and ask for an extension of the patent, on the ground that he had not obtained sufficient remuneration for it, he would be obtaining an undue and an unfair advantage; that would be making use of the intentional non-employment of his invention in order thereby to obtain a share of the profits properly due to the inventions of others, and would thus frustrate the object for which the monopoly granted by letters patent was created, viz. the rewarding of inventors for their merit, and thereby to encourage them in making discoveries useful to mankind."

In *Dolbear's Patent*, it appeared that no proper attempt had been made to push the patent commercially between 1882 (when it was taken out) and 1894. In the absence of any sufficient explanation of this, prolongation was refused. (*k*)

In *Pieper's Patent*, (*l*) a failure to push the invention during a period of two years after the patent was taken out was viewed with disapproval by the Committee.

When Delay will be Excused.—At the same time, an inventor who has been guilty of laches will not be prejudiced thereby if

(*k*) 13 R. P. C. 203.

(*l*) 12 R. P. C. 292.

he can shew some reasonable excuse for the delay. Pecuniary difficulties and the absence of the necessary funds required to push a patent have been held to afford good ground of excuse. (*m*)

In *Roper's Patent*, it was found that a long illness, the result of an accident, had interfered with the pushing of the patent, and the Court granted an extension for seven years. (*n*). But in *Patterson's Patent*, where the invention had not been brought before the public till within a short time of the expiration of the first monopoly, the Court refused to accept in justification of this delay the fact that the patentee had been prevented from pushing his invention in consequence of disputes which had arisen out of an agreement he had made with other parties for working the patent. Lord Langdale said: "The petitioner has been unfortunate; but even admitting that it was impossible for him to come to terms with the persons who he at first joined, still it was his own act that he joined them." (*o*)

The Full History of the Patent must be Disclosed.—The Judicial Committee also require the utmost good faith in the statements placed before them by the applicant. And this rule applies to the facts generally, as well as to the accounts. (*p*) In *Clark's Patent*, it was laid down that a petitioner seeking the grace and favour of the Crown is bound to strict truth, and the utmost candour and frankness, to *uberrima fides*. (*q*) In his petition the applicant should disclose fully and truthfully all facts which it may be material for the Judicial Committee to consider. The whole history of the patent should appear on the face of the petition. (*r*) Therefore, when no mention was made by a petitioner of works at Malta, for which a contract had been made nine months before the petition was presented, and the petition, while purporting to disclose all the receipts and advantages derived from the patent, only stated that the petitioner had every reason to believe that his system was greatly approved, and would shortly be adopted at Malta and other places, the Committee held the non-disclosure of the Malta works to amount to a want of candour and frankness on the part of the petitioner, and refused his application as lacking in that strict truth, *uberrima fides*, which the Crown requires of those who are seeking its favour. (*s*)

(*m*) *Downton's Patent*, 1 W. P. C. 565; *Norton's Patent*, 1 Moo. (N. S.), 342 (but here extension was refused after ten years' delay by a person of ample means); *Bakewell's Patent*, 15 Moo. 386.

(*n*) 4 R. P. C. 201.

(*o*) 6 Moo. 469, p. 470.

(*p*) Ibid. 470.

(*q*) L. R. 3 P. C. 426 (per James, L.J.).

(*r*) *Standfield's Patent*, 15 R. P. C. 17.

(*s*) Ibid.

In *Johnston's Patent*, (*t*) the petition referred to foreign patents having been taken out for the same invention, but did not state fully the facts respecting those patents. On this James, L.J., said that the Committee thought it very desirable that in petitions for prolongation every matter applicable to the patent should be stated.

In *Pitman's Patent*, (*u*) where there was an American patent which had been renewed on expiration, the Committee expressed the opinion that there ought to have been a full disclosure of all the circumstances relating to this patent.

In *Adair's Patent*, (*v*) the petitioner stated that he had exhibited his invention in foreign countries, and endeavoured to push it there; but did not mention the fact that he had obtained several foreign patents, two of which had been allowed to expire. This, it was held, should have been disclosed.

The circumstance that foreign patents for the same invention have been allowed to lapse, while not an absolute bar to prolongation, is a matter of weight against the applicant, and must be disclosed. (*w*). So likewise the fact that foreign patents have run out is an objection to the prolongation of an English patent.

In *Carl Pieper's Patent*, (*x*) Lord Watson said: "The patent sought to be prolonged is one of four, three of which were issued in continental countries; one of them expired four years ago, and the last of them expired two years ago, since which date the patent in question has still been current, and her Majesty's subjects exposed to some degree of prejudice which was not occasioned to the inhabitants of any other country. Their lordships are not prepared to say that, in these circumstances, there can be no renewal of the patent; but they are certainly prepared to go this length, that the circumstance of its being the last patent, the sole survivor, in these circumstances is a great obstacle to granting a renewal of it."

Assignment of Patent to Sham Company.—In *Horsey's Patent*, (*y*) the petition was presented by a limited company, and the plain meaning of the petition, on the face of it, was that a company

(*t*) L. R. 4 P. C. 75; 8 Moo. (N. S.), 291.

(*u*) L. R. 4 P. C. 84; 8 Moo. (N. S.), 293.

(*v*) 6 App. Ca. 176; 50 L. J. C. P. 68.

(*w*) *Semet & Solvay's Patent*, 12 R. P. C. 17. As to this, the cases decided under the Patent Act of 1852, such as *Hill's Patent* (1 Moo. (N. S.), 263), *Winan's Patent* (L. R. 4 P. C. 93), and *Blake's Patent* (L. R. 4 P. C. 535), would seem to be no longer binding authorities; see *Livet's Patent*, 9 R. P. C. 327; *Pieper's Patent*, 12 R. P. C. 292.

(*x*) 12 R. P. C. 294.

(*y*) 1 R. P. C. 225.

had been f "med independently of the patentee, with which the patentee had made an agreement, and to which he had assigned his patent. In reality the company was a sham. Seven persons had been given seven nominal shares as a compliance with the Companies Acts. The persons really interested were the patentee and another person who had lent him money, and the application was practically solely on their behalf. The invention had merit, and the past remuneration had not been adequate, but the Board refused to recommend an extension, on the ground that the petitioners, in representing a *bonâ fide* company to have been formed, when, in fact, no real company existed, had shewn a want of candour towards the Crown.

Exclusive Licenses.—Exclusive licenses are usually viewed unfavourably by the Judicial Committee, as tending to interfere with the enjoyment of the invention by the public; and where such licenses have been granted, their surrender will generally be required on prolongation. (*z*) In *Lyon's Patent*, (*a*) the Judicial Committee imposed the condition that licenses should be granted on equal terms to all, and fixed the extreme limit of the royalty to be paid at 10 per cent. upon the selling price of each machine.

In *Cardwell's Patent*, (*b*) it appeared that the patentee had granted an exclusive license to a company, and had also covenanted that, at the expiration of the patent, he would use his interest to obtain a renewal of the monopoly, and that the petition was presented in pursuance of the above covenant. Their lordships refused to grant any extension on grounds of public policy, considering that, under the circumstances, the application was substantially the application of other persons than the petitioner.

In *Parson's Patent*, (*c*) however, prolongation for five years was granted to a petitioner who had granted an exclusive license to a company, without exception being taken to that license by the Committee. But in this case the petitioner's sole prospect of adequate remuneration depended upon the successful working of this license by the company, in which he was himself a considerable shareholder.

Validity of the Patent not usually Considered by the Committee.—It is no part of the duty of the Judicial Committee to adjudicate on the validity or invalidity of the patent. (*d*) That is a matter to

(*z*) *Darby's Patent*, 8 R. P. C. 380; *Lyon's Patent*, 11 R. P. C. 537; *Shone's Patent*, 9 R. P. C. 438.

(*a*) Supra.

(*b*) 10 Moo. 488.

(*c*) [1898] A. C. 673; 15 R. P. C. 349.

(*d*) *Bett's Patent*, 1 Moo. (N. S.), 49; 7 L. T. (N. S.), 577; *Heath's Patent*, 8

be decided elsewhere, and the extension, if granted, does not in any way affect the subsequent determination of that question. (*e*)

Therefore, their lordships have refused to look nicely into the questions of novelty and utility, where some degree of novelty and utility were *primâ facie* apparent, (*f*) to enquire whether or not the patent has lapsed through an omission to pay the patent fees. (*g*) So, too, the circumstance that the patent has been held invalid by a Court of first instance, from which appeal may be made, is not fatal to prolongation. (*h*) When the validity of the patent is doubtful, the Judicial Committee (if satisfied that the remuneration is inadequate) will give the patentee the benefit of the doubt, and grant an extension. (*i*)

In *Kay's Patent*, an extension was granted on the merits, although the patent was at the time the subject of litigation; (*j*) and in *Heath's Patent*, a larger extension was granted on account of pending litigation, in which the validity of the patent was attacked, as it seemed certain that considerable time would elapse before the patentee could get the good of his extended term. (*k*)

Validity, when Considered.—The Judicial Committee will, however, so far consider the validity of a patent as to see whether or not it is, on the face of it, manifestly and grossly illegal. Where this is clear, or nearly so, their lordships will not grant an extension. (*l*)

In *Woodcroft's Patent*, Lord Brougham said: "Where there is a disputed right as to the validity of the patent, and where the validity of the patent itself must come in question, two things are to be considered. First, is the case to prove the invalidity of the patent, to prove the patent void, clear, past all ordinary and reasonable doubt? Or, secondly, does the case hang so doubtful that their lordships would retire from its consideration, and not, because it is not necessary, decide the question here? In the former instance, namely, where it is a clear case, their lordships will not grant an extension; first, because they do not see merit; and, secondly, because they will not put the parties against whom the patent right is granted and is sought to be extended, to the

Moo. 224; *Pinkus's Patent*, 12 Jur. 233; *McDougal's Patent*, L. R. 2 P. C. 1; 37 L. J. P. C. 17; *Stewart's Patent*, 3 R. P. C. 9.

(*e*) *Woodcroft's Patent*, 2 W. P. C. 81; *Galloway's Patent*, 1 W. P. C. 725.

(*f*) *Stoney's Patent*, 5 R. P. C. 522; *Church's Patent*, 3 R. P. C. 95.

(*g*) *Dolbear's Patent*, 13 R. P. C. 205.

(*h*) *Lane Fox's Patent*, 9 R. P. C. 411.

(*i*) Per Lord Brougham, *Woodcroft's Patent*, 2 W. P. C. 30; *Pinkus's Patent*, 12 Jur. 234; *Saxby's Patent*, L. R. 3 P. C.; *Cocking's Patent*, 2 R. P. C. 153.

(*j*) 3 Moo. 24.

(*k*) 8 Moo. 224.

(*l*) *Kay's Patent*, 3 Moo. 24; *Stoney's Patent*, 5 R. P. C. 522.

vexation, trouble, and expense either of bringing a *scire facias* to repeal the letters patent, or of sustaining an action for infringement. But when the matter hangs very doubtful, when there is conflicting evidence, where upon the construction of the specification, on the patent, or in any other way, questions of law or questions of fact, as it may be, shall arise, their lordships have not been used to refuse to exercise their discretionary powers, vested in them by the legislature, of recommending an extension, merely because elsewhere the validity of the patent may reasonably be contested." (*m*)

The Committee will take into consideration the meaning of the specification and the general character of the claims advanced in their probable bearing on the public interest. Thus, in *McDougal's Patent*, (*n*) they found that the invention for which the petitioner asked an extension was not the invention described in his specification.

In *McInnes's Patent*, (*o*) an extension was refused on the ground (*i.a.*) that, looking to the wide terms of the specification, it would be contrary to public interest to grant a prolongation of such a patent. Sir W. Erle said: "Their lordships also, taking into consideration, with reference to the public interest, that the individual substance for the application of which the patent is sought to be prolonged, is not specifically defined, every kind of metallic soap being within the limits of the specification, are of opinion that many questions affecting the patent might be raised if any metallic soap was used by the public in ignorance of the specification being as wide as it is." But the mere obscurity of a specification will not prevent an extension, if a sufficient claim can be read out of it. (*p*)

Where it appears that the patentee has not dealt candidly with the public, but has kept out of his specification an important part of his invention, prolongation will be refused. In *Livet's Patent*, (*q*) Lord Hobhouse said: "The petitioner's specification is so framed as to make success dependent on expanding the flues in 'certain scientific proportions.' Those proportions are not defined by any measurements or by reference to the objects aimed at, or to the conditions under which the flues are to work. They remain

(*m*) 2 W. P. C. 30. In *Burlingham's Patent* (15 R. P. C. 195), the case of a patent with an admittedly bad claim was discussed, but the Board did not decide what they would do in such case.

(*n*) L. R. 2 P. C. 1.

(*o*) L. R. 2 P. C. 54; 5 Moo. P. C. (N. S.), 72; 37 L. J. P. C. 23.

(*p*) See *Napier's Patent*, 6 App. Ca. 174; 50 L. J. P. C. 40.

(*q*) 9 R. P. C. 327, p. 332.

in the knowledge of the patentee; and in point of fact we find that, except to an insignificant extent, his profits have been earned by building furnaces, and that there is no instance of the grant of a licence under which the licensee has constructed his own furnace. Their lordships do not doubt that the petitioner has constructed furnaces of great merit, but apart from his skill in construction they fail to see that his invention is of great merit, or that he has imparted to others the knowledge which might enable them to do the work which he has done himself."

Novelty as a Test of Exceptional Merit.—Although the Judicial Committee will not usually go into the question as to whether the novelty of a patent is sufficient to support it at law, but will abstain from expressing an opinion on that point, yet they will consider whether or not the novelty is sufficient to constitute exceptional merit, for novelty of a minute description is not meritorious. (*r*)

Extension of Part of the Patent only.—Where their lordships have been favourably impressed with a portion of a patent, and not with the rest, they have granted an extension of the part only. In *Bodmer's Patent*, (*s*) the Committee extended a part of the patent only, there being no evidence that the other parts had been worked. In *Lee's Patent*, (*t*) the grant covered a variety of inventions, but only two of these were brought before the notice of the Committee, viz. an invention relating to axles, and an invention relating to brakes. Their lordships found that the first did not appear to have been used, and was not at all likely to be used. They recommended an extension of the patent so far as it related to the second only.

In *Napier's Patent*, (*u*) the invention was for a differential brake. This brake in its application to windlasses and cranes had been proved to be of considerable utility. Other machines were mentioned in the specification as suitable for having this brake applied to them; but the Privy Council, holding that there was no evidence of the utility of the invention in these cases, confined the prolonged patent to windlasses and cranes.

Where the Patent has been Improved upon.—It is no objection to the extension of a patent that the original invention has been improved upon, if otherwise a proper case is made out (*v*). Indeed,

(*r*) *Stewart's Patent*, 3 R. P. C. 7.
(*s*) 8 Moo. 282.
(*t*) 9 Moo. 227.
(*u*) 6 App. Ca. 174; 50 L. J. P. C. 40; see, also, *Willacy's Patent*, 5 R. P. C. 695; *Church's Patent*, 3 R. P. C. 95.
(*v*) *Galloway's Patent*, 1 W. P. C. 727; *Bodmer's Patent*, 8 Moo. 284.

such a circumstance is rather in the petitioner's favour. (*w*) But if the applicant has taken out himself a more recent patent for an improvement of his invention which is of such a nature that it will practically give him a continued monopoly, this is a circumstance adverse to prolongation of the prior patent (*x*). Nor is it an objection that the applicant's invention consists of improvements on an expired imported patent. (*y*) Nor that the patentee has altered his mode of manufacture under the patent if the merit is not diminished. (*z*). In *Southby's Patent*, (*a*) the patentee having devoted much time and labour to perfecting the invention (which related to improvements in refrigerating apparatus), a subsequent patent for a mode of getting over a difficulty in starting the machine was, inasmuch as other modes of obviating this difficulty might be devised, deemed not to be a bar to prolongation, as it did not appear to the Board to afford sufficient protection to secure future remuneration to the inadequately remunerated patentee.

Adequate Remuneration.—What is adequate remuneration must depend on the circumstances of each particular case. In an invention of trifling importance a nominal sum may be sufficient, whereas in a patent of great public utility many thousands of pounds may be less than the inventor has deserved. In *Hill's Patent*, (*b*) their lordships said: "The principal question always is, has the individual patentee under all the circumstances received what in equity and good sense may be considered a sufficient remuneration? On his own part, of course, there must have been no want of good faith or prudent exertion; and, further, as the loss to the public may be important in the consideration, it may be necessary in some cases not to confine the enquiry to the state of things at the date of the patent, but to regard also the circumstances existing at the time when the application is made."

Where there has been no profit at all, (*c*) or where the profits have been exceeded by the patentee's expenses, (*d*) the inadequacy of the remuneration (provided the merit and utility of the invention

(*w*) *Soame's Patent*, 1 W. P. C. 735.

(*x*) *Nussey & Leachman's Patent*, 7 R. P. C. 22.

(*y*) *Bovill's Patent*, 1 Moo. P. C. (N. S.), 348.

(*z*) *Heath's Patent*, 8 Moo. P. C. 217; 2 W. P. C. 247.

(*a*) [1891] App. Ca. 432; 8 R. P. C. 433.

(*b*) 9 L. T. (N. S.), 101; 1 Moo. P. C. (N. S.), 258.

(*c*) *Houghton's Patent*, L. R. 3 P. C. 461.

(*d*) *Swaine's Patent*, 1 W. P. C. 560; *Stafford's Patent*, 1 W. P. C. 561; *Jones' Patent*, 1 W. P. C. 579; *Napier's Patent*, 6 App. Ca. 174.

and the good faith of the inventor are made out) will be obvious.

In *Robert's Patent*, (*e*) where the invention was for improvements in the spinning jenny, the accounts shewed a gross profit of £35,988, against which a sum of £29,044 was put for expenses. This left an apparent net profit of £6,944. But the patentee's premises had been attacked and burnt down by an ignorant mob, who resented the improvements introduced by his discovery, and the losses he thus incurred (after allowing for insurance) had not only swallowed up the whole of his profit, but left him a loser to the amount of £10,154. In this case an extension for seven years was granted.

The circumstance that the patentee's profits have only been made in the last years of the monopoly is no reason for granting a prolongation where such profits amount to an adequate remuneration to the inventor. (*f*) Indeed, in the last year alone, a sufficient remuneration may be obtained. (*g*)

The following cases may be cited by way of illustration. In *Pitman's Patent*, (*h*) where the invention had been assigned for £400, a profit of £3,000 was held sufficient.

In *Ryder's Patent*, (*i*) a profit of £7,000, made during the last four years of the patent, was held adequate remuneration. In *Bailey's Patent*, (*j*) £8,038 16*s.* 4*d.* was held adequate. In *Johnson's Patent*, (*k*) for improvements in the sewing machine, £4500 was held sufficient, having regard to the fact that £16,000 had been made on an American patent for the same invention.

On the other hand, in *Perkin's Patent*, (*l*) £6,576 was held inadequate in view of the exceptional utility of the invention. In *Joy's Patent* (*m*) a profit of £6,000, and in *Davies's Patent* (*n*) of £11,000, was held insufficient. The largest sum which has hitherto been held an inadequate remuneration is £20,000. (*o*)

A patentee is not entitled to rely upon losses which have been incurred through unskilfulness in the management of his business, as evidence of inadequate remuneration. (*p*)

Period of Extension.—The Crown has usually granted extensions

(*e*) 1 W. P. C. 573.

(*f*) *Ryder's Patent, Pract. Mech. Journ.*, vol. vii. p. 238.

(*g*) *Macintosh's Patent*, 1 W. P. C. 759.

(*h*) L. R. 4 P. C. 84.

(*i*) *Pract. Mech. Journ.* vol. vii. p. 238.

(*j*) 1 R. P. C. 1.

(*k*) L. R. 4 P. C. 75; 8 Moo. (N. S.), 291.

(*l*) 2 W. P. C. 6.

(*m*) 10 R. P. C. 89.

(*n*) 11 R. P. C. 28.

(*o*) *Thomas's Patent*, 9 R. P. C. 367.

(*p*) *Thorneycroft's Patent*, [1899] A. C. 415; 68 L. J. P. C. 68; 16 R. P. C. 204.

for periods of shorter duration than seven years, but the length of an extension, like the extension itself, must necessarily depend on the peculiar circumstances of each case. In a considerable number of cases extensions of seven years have been given, and in some cases extensions of ten years have been recommended by the Committee. (*q*) But such an extension has always been treated as unusual, and now, under the Act of 1883, it can only be given in exceptional cases. (*r*)

In *Stoney's Patent*, where the invention was for improvements in sluices and flood-gates, their lordships, in granting an extension for the unusually long term of ten years, said: "As to the duration of the term of prolongation, the matter, no doubt, is a difficult one, upon which the minds of separate judges would never be likely to hit off independently the exact number of years for the term—it must depend very much upon the view which each mind takes of the particular invention to be dealt with, and, moreover, it must also depend, not only on the want of remuneration in the past, but upon the probability of remuneration in the future, and how soon that remuneration is likely to be attained. Now, in the case of a common application such as I have spoken of, relating to improvements of daily use, when the patent once becomes known, and known to be useful, it will get rapidly into use; and if by some means it has been ignored by the public, and the patentees come before the Court for a prolongation of their patent, the mere advertisement, if I may so call it, of the petition for the prolongation of the patent, would materially assist and start the invention; and that, in the case of an invention of common and daily use, would probably lead to its getting into rapid application, and to its becoming rapidly remunerative to the patentee. But this is not an invention of that description. It is from its nature an invention which cannot be very largely used, and which only applies to peculiar cases, namely, where sluices are wanted for large bodies of water, to regulate the flow of that water, and to do it without friction and without substantial leakage. It can, therefore, only be profitably applied, at all events in certain large undertakings, which must be few and far between. The best hope for the patentee in the case is the Manchester Ship Canal. He is not, as I understand, yet retained in that case, but there seems every reasonable prospect that his invention will be applied to that canal. If so, that will, in itself, it is hoped, afford the

(*q*) *Ruthven's Patent*, *Pract. Mech. Journ.* 2nd series, vol. viii. p. 159; *Stoney's Patent*, 5 R. P. C. 520.

(*r*) 46 & 47 Vict. c. 57, s. 25 (5).

patentee considerable remuneration. But that is only one case, and he may, and probably will, have but a comparatively small number of other cases; and, therefore, it will take him a considerable time before he can fairly get remuneration, considering the very long time, namely, fourteen years, for which he has devoted himself to this invention, and the isolated nature of the invention in the sense that there can only be here and there a few cases of its applicability, and but rare chances of its being applied. Under these circumstances, my lords think that this is an exceptional case within the meaning of the Statute, and that there should be a prolongation of this patent granted for the term of ten years. (*s*)

In *Darby's Patent*, (*t*) the invention was a broadside steam-digger for land cultivation. It was of high merit, and the inventor had sustained a loss of £8000. The Board, while intimating that they would only in rare cases advise a prolongation for more than seven years, recommended one for ten in this instance, as they thought the losses made would not be recovered in a shorter period. Lord Hobhouse said: "The power to her Majesty in Council to extend the term is not exceeding seven years, or, in exceptional cases, fourteen years, and it is only in rare cases that their lordships report to her Majesty that the term of prolongation or extension should be more than seven years. In this case they think that there are exceptional circumstances. They think that the patent is of more than usual merit—more so than the patents which commonly come before them. They have regard to the great losses that the patentee has suffered, which it is fair to him he should have some opportunity of recovering, and which it is not likely he can recover in any short space of time, even in seven years, seeing the great difficulty there is in introducing such machines into use." (*u*)

(*s*) Per Sir W. Grove, 5 R. P. C. 523, 524.

(*t*) 8 R. P. C. 380; see p. 384.

(*u*) The following cases shew the periods for which extensions of letters patent have been granted:—For three years, see *Kay's Patent* (1 W. P. C. 568; 3 Moo. 24), *Deacon's Patent* (4 R. P. C. 119); for four years, *Hardy's Patent* (6 Moo. 445), *Mallet's Patent* (L. R. 1 P. C. 308); for five years, *Downton's Patent* (1 W. P. C. 565), *Wright's Patent* (1 W. P. C. 561), *Lowe's Patent* (2 W. P. C. 158), *Perkin's Patent* (2 W. P. C. 6), *Bodmer's Patent* (6 Moo. 468), *Payne's Patent* (Coryton, 220), *Smith's Patent* (7 Moo. 133), *Herbert's Patent* (1 L. R. P. C. 399), *Johnson & Atkinson's Patent* (5 L. R. P. C. 87), *Cocking's Patent* (2 R. P. C. 151), *Church's Patent* (3 R. P. C. 95), *Southby's Patent* (8 R. P. C. 433), *Lyon's Patent* (11 R. P. C. 537), *Semet & Solvay's Patent* (12 R. P. C. 10), *Parson's Patent* (15 R. P. C. 349); for six years, *Whitehouse's Patent* (1 W. P. C. 477), *Russell's Patent* (2 Moo. 496), *Honibal's Patent* (2 W. P. C. 196), *Berry's Patent* (7 Moo. 187), *Derosne's Patent* (2 W. P. C. 1), *Foarde's Patent* (9 Moo. 376), *Schlumberger's Patent* (9 Moo. 1), *Carr's Patent* (4 L. R. P. C. 539); for

Extension how given.—If the Judicial Committee report that the patentee has been inadequately remunerated, her Majesty in Council may extend the term of the monopoly for a further period not exceeding seven or (in exceptional circumstances) fourteen years. (*v*) Instead of prolonging the original patent the Crown may grant the extension in the form of a new patent for the invention. (*w*) The usual practice now is to direct a fresh patent to be sealed for the period allowed.

Where an extension is recommended by the committee, the grant is made to those having the legal estate in the original letters patent at the time of the petition. (*x*)

The Crown, in granting an extension of a patent monopoly, may impose such restrictions, conditions, and provisions as the Committee may see fit to recommend. (*y*) The terms upon which assignees are usually put for the protection of the interest of the original inventor or his representatives have been already noticed; (*z*) also the practice of sometimes limiting the extension to a portion only of the original patent.

Prior to the Patents Act, 1883, it was the custom of the Committee, acting as guardians of the public interest, to require the petitioner in certain cases to make concessions to the public, as a condition of the prolongation.

Thus, in *Mallet's Patent*, (*a*) where a license of an almost exclusive character had been granted to one manufacturing firm, the patentee was required to grant licenses of as ample a nature to as many of the public as chose to apply for them. In *Hardy's Patent*, (*b*) the petitioners were put on terms to sell the protected article at a certain fixed price.

Where the invention is likely to be of use in the public service the patentee has been required to concede to the Crown the right

seven years, *Erard's Patent* (1 W. P. C. 557), *Swaine's Patent* (1 W. P. C. 559), *Kollman's Patent* (1 W. P. C. 564), *Roberts' Patent* (1 W. P. C. 573), *Heath's Patent* (8 Moo. 217), *Hughes' Patent* (4 App. Ca. 175), *Napier's Patent* (6 App. Ca. 174), *Houghton's Patent* (3 L. R. P. C. 461), *Bischof's Patent* (1 R. P. C. 162), *Roper's Patent* (4 R. P. C. 201), *Smith's Patent* (2 R. P. C. 14), *Shone's Patent* (9 R. P. C. 438), *Joy's Patent* (10 R. P. C. 89), *Davies' Patent* (11 R. P. C. 27), *Hazeland's Patent* (11 R. P. C. 467); for ten years, *Ruthven's Patent* (*Pract. Mech. Journ.* 2nd series, vol. viii. p. 159), *Stoney's Patent* (5 R. P. C. 520), *Darby's Patent* (8 R. P. C. 380), *Currie & Timmis' Patent* (15 R. P. C. 63).

(*v*) Patents Act, 1883, s. 25 (5).

(*w*) *Smith's Patent*, 2 R. P. C. 14.

(*x*) *Southworth's Patent*, 1 W. P. C. 575; *Heath's Patent*, 2 W. P. C. 247; *Downton's Patent*, 1 W. P. C. 565; *Bodmer's Patent*, 6 Moo. 469; *Pettit Smith's Patent*, 7 Moo. 156; *Newton's Patent*, 14 Moo. 156.

(*y*) Patents Act, 1883, s. 25 (5).

(*z*) See p. 374, supra.

(*a*) L. R. 1 P. C. 308.

(*b*) 6 Moo. 445.

to use his invention without a license.(*c*) As, however, the Patents Act, 1883, (*d*) makes provision for compelling a patentee to grant licenses on reasonable terms where the Board of Trade decide that they ought to be granted, and for securing to the servants of the Crown the benefit of an invention on such terms as the Treasury, after hearing all parties interested, may direct, it is conceived that in future the Judicial Committee will not impose terms in such cases, but leave the patent to the operation of these sections, as was done in *Smith's Patent.* (*e*)

In *Goucher's Patent*, it was held that the Judicial Committee have no jurisdiction to grant a second extension, after one prolongation has been given. (*f*)

Costs of the Petition.—The costs incident to proceedings for the prolongation of letters patent are in the discretion of the Committee, whose orders as to costs are enforceable, as if they were Orders of the High Court. (*g*)

Their lordships have always shewn a disposition to encourage a fair opposition. In *Westrupp & Gibbins's Patent*, (*h*) Lord Lyndhurst said: "My opinion on the subject of costs is this: If a party to oppose does come and oppose, and opposes successfully, if we do not give costs, we shall discourage persons coming to protect the interests of the public." It is generally the case that private opposers have better means of stating the objections to the continuance of a patent than the Law Officers of the Crown, however experienced and able they may be; (*i*) and as the Committee court the fullest enquiry, and desire to know all that can be alleged against the patent which is the subject of the application, it is in the public interest to encourage *bonâ fide* opposition. (*j*) Hence, where such opposition is fair and successful, it would be unjust that the expense should not in part fall on the patentee whose petition is the occasion of it. (*k*)

In *Jones's Patent*, Parke, B., said a fair opposition "ought not to be made at the expense of the parties opposing." (*l*) But where the evidence led by an opposer has been vexatious and irrelevant, and the Committee have been unfavourably impressed by his witnesses, costs have been refused despite the success of the

(*c*) *Pettit Smith's Patent*, 7 Moo. 133; *Lancaster's Patent*, 2 Moo. (N. S.), 189; *Hughes' Patent*, 4 App. Ca. 174; *Napier's Patent*, 6 App. Ca. 174.

(*d*) See ss. 22 & 27.

(*e*) 2 R. P. C. 14.

(*f*) 2 Moo. (N. S.), 532.

(*g*) Patents Act, 1883, s. 25 (7).

(*h*) 1 W. P. C. 554.

(*i*) *Jones's Patent*, 9 Moo. 43 (per Parke, B.).

(*j*) *Wield's Patent*, L. R. 4 P. C. 89.

(*k*) *Hill's Patent*, 1 Moo. (N. S.), 271.

(*l*) 9 Moo. 43.

opposition. (*m*) Costs may be taxed before the registrar, who has a full discretion to disallow payments to expert witnesses. (*n*)

As it is often difficult, however, to decide minute points as to costs, the Judicial Committee sometimes award the opposers a lump sum for costs, to be divided amongst them. In *Jones's Patent*, where there were two opponents, £100 was given. (*o*) In *Hill's Patent*, where the opposition (there were six opponents) had involved great expense, and had been fair and successful, £1000 was directed by the registrar to be paid for distribution amongst the opposers. (*p*)

In *Johnson's Patent*, the same practice was adopted, and £500 was directed to be paid by the applicant to the opposers. (*q*) So also in *Wield's Patent*, a like lump sum of £500 was given as costs, between two sets of opposers. (*r*)

In *Thomas's Patent*, (*s*) one set of costs was given amongst the opponents. In *Hopkinson's Patent*, (*t*) £400 was ordered to be paid as a lump sum for costs. In that case there were seven sets of opponents.

Where the petition is abandoned, the petitioner will generally be directed to pay the costs of those who have lodged notice of objection. (*u*) But costs being matter of discretion, this rule is not absolute. In such a case, however, the presumption is in favour of the opposers. (*v*)

In *Milner's Patent*, one set of costs was given to the opponents viewed as a body; or, in the alternative, taxation on an order. (*v*)

In *Bridson's Patent*, (*w*) (where the petition never came to a hearing) all the opposers got their costs.

On the other hand, where the Committee have been of opinion that there was no proper ground for opposition, the opposers have been made to pay the extra costs occasioned by their opposition. (*x*)

(*m*) *Honiball's Patent*, 9 Moo. 378; *Muntz's Patent*, 2 W. P. C. 122. In *Church's Patent* (3 R. P. C. 95) costs were refused to successful petitioners.

(*n*) P. C. Rules, R. 6.

(*o*) 9 Moo. 43.

(*p*) 1 Moo. P. C. (N. S.), 258; 9 L. T. (N. S.), 101.

(*q*) L. R. 4 P. C. 75; 8 Moo. P. C. (N. S.), 291.

(*r*) L. R. 4 P. C. 89; 8 Moo. P. C. (N. S.), 300.

(*s*) 9 R. P. C. 367; see, also, *Lane Fox's Patent*, 9 R. P. C. 411.

(*t*) 14 R. P. C. 5; see, also, *Dolbear's Patent*, 13 R. P. C. 203.

(*u*) *Macintosh's Patent*, 1 W. P. C.; *Bridson's Patent*, 7 Moo. 499; *Hornby's Patent*, 7 Moo. 503; *Morgan Brown's Patent*, 3 R. P. C. 212.

(*v*) *Milner's Patent*, 9 Moo. 39.

(*w*) 7 Moo. 499.

(*x*) *Downton's Patent*, 1 W. P. C. 565.

Order for Prolongation.—As above stated, the usual practice now, when a petition is favourably entertained, is to direct a new patent to be sealed for the period of prolongation allowed. An office copy of the order must be left forthwith at the Patent Office by the person in whose favour it is made. (*y*)

(*y*) P. R. rule 74.

CHAPTER XXI.

RIGHTS OF THE PATENTEE UNDER HIS LETTERS PATENT: THE LAW OF INFRINGEMENT.

Privileges of the Patentee derived from the Patent Grant.—The privileges of the patentee being derived from the patent grant, their scope and operations must be gathered from the terms of the letters patent.

The form of letters patent now used by the Crown in grants to inventors contains the following provisions. "*Know ye, therefore, that we, of our especial grace, certain knowledge, and mere motion, do by these presents, for us, our heirs and successors, give and grant unto the said patentee our especial license, full power, sole privilege, and authority, that the said patentee by himself, his agents, licensees, and no others, may at all times hereafter, during the term of years herein mentioned, make, use, exercise, and vend the said invention, within our United Kingdom of Great Britain and Ireland, and Isle of Man, in such manner as to him or them may seem meet, and that the said patentee shall have and enjoy the whole profit and advantage, from time to time accruing by reason of the said invention, during the term of fourteen years from the date hereunder written of these presents.*"

These words of grant are immediately followed by a prohibitory clause, inserted for the protection of the patentee, and intended to secure to him the full enjoyment of his monopoly. "*And to the end that the said patentee may have and enjoy the sole use and exercise and the full benefit of the said invention, we do by these presents, for us, our heirs and successors, strictly command all our subjects whatsoever within our United Kingdom of Great Britain and Ireland, and the Isle of Man, that they do not at any time during the continuance of the said term of fourteen years either directly or indirectly make use of, or put in practice, the said invention, or any part of the same, nor in any wise imitate the same, nor make or cause to be made any addition thereto or subtraction therefrom, whereby to*

pretend themselves the inventors thereof, without the consent, license, or agreement of the said patentee in writing under his hand and seal, on pain of incurring such penalties as may be justly inflicted on such offenders for their contempt of this our Royal command, and of being answerable to the patentee according to law for his damages thereby occasioned."

The Extent of the Monopoly.—The privilege vested in the patentee is thus the right to make, use, exercise, and vend the invention within the prescribed area; and this is granted to him alone, to the exclusion of all other persons, in order that he may have and enjoy the whole profit and advantage from time to time accruing from the invention during the term of his letters patent.

No one, therefore, may within the prescribed area, and during the prescribed time, make, use, exercise, or vend the invention without the sanction of the patentee.

The prescribed time is the fourteen years of the patent grant, and it begins to run from the date of the acceptance of the complete specification at the Patent Office, though no proceedings can be instituted against infringers until the patent has been sealed. (*a*) If an extension of the patent term is granted for a further period, such period must also be included. But the monopoly does not cover any interval which may elapse between the conclusion of the first term and the date of prolongation by a subsequent grant. (*b*)

The area of the monopoly is the United Kingdom of Great Britain and Ireland and the Isle of Man. The Channel Islands are no longer included as they were under the Patent Law Amendment Act of 1852. (*c*)

Infringement by Manufacture.—Any person manufacturing the patented article without the sanction of the patentee is an infringer of the patent, and liable as such. Nor will an infringer be the less liable because he procures the invention to be made in England by some one else, (*d*) or manufactured abroad, if he thereafter imports it into the United Kingdom. At the same time, the making which is prohibited is a making for profit either direct or indirect; *i.e.* a making calculated to interfere with the benefit which the patentee would otherwise derive from his invention.

Experiment is not Infringement.—It is no infringement, therefore,

(*a*) Patents Act, 1883, s. 15.

(*b*) See *Russell* v. *Ledsam*, 14 L. J. Ex. 353; 14 M. & W. 574; 16 L. J. Ex. 145; 16 M. & W. 641; 1 H. of L. Ca. 687.

(*c*) 15 & 16 Vict. c. 83, s. 18.

(*d*) *Gibson* v. *Brand*, 1 W. P. C. 631; 4 M. & G. 179; *Incandescent Gaslight Co.* v. *Brogden*, 16 R. P. C. 179. In this case the defendant handed orders on to a private maker, receiving a commission of 5 per cent. This was held an infringement.

of a patent to make the patented article by way of *bonâ fide* experiment merely.

"No doubt," said Jessel, M.R., in *Frearson* v. *Loe*, "if a man makes things merely by way of *bonâ fide* experiment, and not with the intention of selling and making use of the thing so made for the purpose of which a patent has been granted, but with the view of improving upon the invention the subject of the patent, or with the view of seeing whether an improvement can be made or not, that is not an invasion of the exclusive rights granted by the patent. Patent rights were never granted to prevent persons of ingenuity exercising their talents in a fair way. If there be neither using nor 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." (*e*)

User is Infringement.—Using or exercising the invention is likewise an infringement.

In *Betts* v. *Neilson*, (*f*) the defendants sought unsuccessfully to escape from the consequences of unauthorized use of a patented invention, on the ground that such use by them had been *in itinere* only. In that case, metal capsules manufactured abroad were placed by a Scottish brewer upon beer bottles in Scotland intended for exportation. These bottles were then sent through England, for export, none of the beer being consumed there. The capsules were an infringement of an English patent, and the patentees claimed an injunction and damages. Lord Chelmsford and (on appeal) the House of Lords held they were entitled to both, as the capsules performed their function during the whole period of transit, and had therefore been used while in England.

In this case, it was suggested for the defendants that the user of the capsules was passive only and not active, and therefore no infringement. In rejecting this contention, Lord Chelmsford, C., said: "I do not appreciate the distinction which was pressed upon me in argument, between an active and a passive use of a thing, and the difference suggested on that ground between this case and *Caldwell* v. *Vanvlissengen*. (*g*) The screw propeller in the one case, though in motion during its use, was just as passive an agent as the capsules in the present case. It is the employment of the machine or the article for the purpose for which it was designed which constitutes its active use; and whether the capsules were

(*e*) L. R. 9 C. D. pp. 66, 67.
(*f*) L. R. 3 Ch. 436; 34 L. J. Ch. 537; L. R. 5 H. of L. 1.
(*g*) 9 Hare, 415.

intended for ornament, or for protection of the contents of the bottles upon which they were placed, the whole time they were in England they may be correctly said to be in active use for the very objects for which they were placed upon the bottles by the vendors. If the beer, after being purchased in Glasgow, had been sent into England, and had been afterwards sold here, there can be no doubt (I suppose) that this would have been an infringement, because it would have been a profitable user of the invention, and I cannot see how it can cease to be a user because England is not the final destination of the beer." (*h*)

At the same time, it has been held that Custom House agents who pass an infringing article through the Custom House and obtain permission for landing and storing it in premises belonging to the importers, do not exercise such a user as makes them personally liable to the patentee. (*i*)

"The Court of Chancery," said James, L.J., in *Nobel's Explosives Company* v. *Jones*, "has always held a hand over agents; but then, it appears to me, they must be actually agents. They must be agents who are agents in the making, in the using, in the exercising, or in the vending of the invention. . . . If it were to be said that any person who had anything to do, either directly or indirectly, with the means by which the goods got from one place to another was to be liable to an action at law, or an injunction in a suit by the plaintiffs, it would be giving a wide and most injurious encouragement to idle and vexatious litigation." (*j*)

As in the case of infringement by making, infringement by user may be negatived by shewing that the user has been by way of experiment only.

At the same time, the Court will narrowly scrutinize the defence of user for experiment only, and will not allow it to prevail if satisfied that the user has been for profit, or with the object of obtaining profit, though even to a limited extent.

On this ground, in *Frearson* v. *Loe*, the Court held the defendant liable. "Where you see a man using a machine," said Jessel, M.R., "as this defendant has done, under claim of a right to use it, and under that claim of right he makes a quantity of goods, even though a small quantity, I cannot call that an experiment within the meaning of the rule as to experiments. He has made a machine, and, knowing it to be an infringement of the

(*h*) L. R. 3 Ch., p. 439; see, also, *British Motor Syndicate* v. *Taylor*, 17 R. P. C. 189.

(*i*) *Nobel's Explosives* v. *Jones*, 17 C. D. 721; 8 App. Ca. 5.

(*j*) L. R. 17 C. D. pp. 742, 743; 50 L. J Ch. p. 586.

patent, he claims the right to make and use it, and his experiment is made to see how his machine works. That is the experiment, as he calls it, putting his machine to work from time to time, and then making screws according to the other patent, and making the screws with the view of trying the screws themselves. It does not appear to me, when I consider the circumstances under which the defendant made these alleged experiments, that I ought to treat this as coming within the rule which prevents mere experiments being subject to the liability of action being brought against those who make them, and to the costs of an injunction being granted against them." (*k*)

So, too, where the experimental user is for the advantage of the person using the machine, even when pecuniary profit does not directly result, such user is an infringement.

In the *United Telephone Company* v. *Sharples*, (*l*) the defendant alleged that his use of certain pirated instruments was confined to experiment by himself, and to the instruction of his pupils, whom he permitted to take the apparatus to pieces, on account of its cheapness. In rejecting the contention that this was not a user of the patented invention, and an infringement, Kay, J., said: "To say that to buy a telephone which is an infringement of an English patent for the purpose of instructing your pupils who are learning the business, to let them use and experiment with it, to let them, if they please, pull it to pieces, for the purpose of saving the expense of using the patent telephone, and experimenting with, or pulling that to pieces, to say that that is not a user in this country is a thing which I cannot accede to. It seems to me plainly to be a user."

In *Proctor* v. *Bailey*, (*m*) where the invention was an apparatus for the distribution of coal over a fire surface, the defendants endeavoured to escape liability on the ground that their user of the invention had been experimental only. It was proved, however, that several of these automatic stokers had been used in the defendant's works during a number of months, reducing the necessity for hand firing, or the use of other mechanical means for keeping up the supply of coal in their furnaces, and thus conducing to the more economical management of their business. Under these circumstances such user was held to be more than

(*k*) 9 C. D. p. 67.

(*l*) 29 C. D. 164; 54 L. J. Ch. 633.

(*m*) 6 R. P. C. 106; L. R. 42 C. D. 390; 59 L. J. Ch. 12; 38 W. R. 100; 61 L. T. (N. S.), 752. See, also, *Muntz* v. *Foster*, where the quantity made was considered by Tindal, C.J., as too considerable to be consistent with mere experiment; 2 W. P. C. p. 101.

experimental, and to constitute an infringement of the plaintiff's patent.

User on Foreign Vessels in British Waters.—By section 43 of the Patents Act, 1883, it is enacted that—

"A patent shall not prevent the use of an invention for the purposes of the navigation of a foreign vessel within the jurisdiction of any of her Majesty's Courts in the United Kingdom or Isle of Man, or the use of an invention in a foreign vessel within that jurisdiction, 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.

"But this section shall not extend to vessels of any foreign State of which the laws authorize subjects of such foreign State, having patents or like privileges for the exclusive use 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 Courts, 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." (*n*)

No Infringement unless used for the same Purpose as the Patentee.—To establish infringement by user, however, it must be shewn that the infringer is using the invention for the same purpose as that claimed by the patentee.

In *Higgs* v. *Goodwin*, (*o*) the patent was for a method of precipitating the animal and vegetable matter in sewage water so as to make the same applicable to agricultural and other useful purposes. This result the patentee achieved by employing a chemical agent—hydrate of lime. The defendants, a Local Board of Health, having first treated sewage by filtration, deodorized the resultant liquid by adding hydrate of lime. This was held to be no infringement, the object of the patent being the production of a useful manure, while the defendants aimed only at purifying the sewage, and rejected all the sewage matter. (*p*)

In *Fletcher* v. *The Glasgow Gas Commissioners*, (*q*) where the patent related to improvements in cooking-stoves and ranges, the respondents used in their mechanism a latch similar to one used by the complainer, but for a diametrically opposite purpose; the latch in one case being designed to keep a door open, in the other to keep it closed, and this was held to be no infringement.

(*n*) Cf. 15 & 16 Vict. c. 83, s. 26, now repealed; *Caldwell* v. *Vanvlissengen*, 21 L. J. Ch. 97; 9 Hare, 415.

(*o*) 27 L. J. Q. B. 421; E. B. & E. 529.

(*p*) See, also, *Lister* v. *Eastwood*, 9 L. T. (N. S.), 766.

(*q*) 4 R. P. C. 389.

Infringement by Sale.—The patent grant confers an exclusive right to vend the patented article, and although the word "vend" does not occur in the Statute of James, letters patent for inventions have for hundreds of years been drawn so as to give the patentee an exclusive right to vend his invention, and the Courts, acting upon this, have always regarded a sale as an infringement. (*r*)

Therefore the mere seller of an infringing article who has not himself made the article in question, and who may even be ignorant of the fact that it is an infringement of a patent monopoly at all, is none the less liable to the patentee.

"It is true," said James, L.J., in *Von Heyden* v. *Neustadt*, (*s*) "that the Statute of James only mentions 'the sole working or making of any manner of new manufacture within this realm.' But it is to be observed that the Statute gives no right to the inventor. The Statute is a Statute for abolishing and forbidding monopolies, and the sixth section, under which the Crown acts in these matters, is a mere proviso excepting from the operation of that Act certain patents or grants of privileges which are to be 'of such force as they should be if that Act had never been made, and of none other.' And it is from the ancient power and prerogative of the Crown, so saved and preserved, that every patentee derives his monopoly. What the Crown could lawfully do, and has lawfully done, after that Statute is shewn by the uniform tenor of the letters patent which have since been issued—issued by the advice and authority of every law officer and every holder of the Great Seal for upwards of two centuries and a half. Nor has there been any straining of the old Statute in what has been so done. All that was required was to assume that, when the Crown's right to grant the sole privilege of working or making was saved, there was saved with it the power to make such privilege effectually profitable to the true inventor. We see no reason to doubt the conclusion arrived at in *Elmslie* v. *Boursier*, (*t*) that the sole right granted by the Crown 'to make, use, exercise, and vend the invention within the United Kingdom,' and the right to 'have and enjoy the whole profit, benefit, commodity, and advantage accruing and arising by reason of the said invention,' includes a monopoly of the sale in this country of products made according to the patented process, whether made in the realm or elsewhere."

(*r*) *Badische* v. *Dawson*, 6 R. P. C. 396. The sale of an article in the making of which a patented product is an essential ingredient is an infringement: *Saccharin Corporation* v. *Anglo-Continental Chemical Works*, 48 W. R. 444; see, also, *British Motor Syndicate* v. *Taylor*, 17 R. P. C. 189.

(*s*) L. R. 14 C. D. 232, 233; 50 L. J. Ch. p. 130.

(*t*) L. R. 9 Eq. 217; 39 L. J. Ch. 328.

Thus the sale in England of articles made in France, according to an English patent, is an infringement of that patent. (*u*) "I am clearly of opinion," said Kelly, C.B., in *Wright* v. *Hitchcock*, (*v*) "that if a man takes out a patent by means of which an article is made at a considerably less cost than the same article was produced before at, one who buys and sells such articles—I do not say on a single occasion, for each case must be determined on its own circumstances; but when he becomes, in the way of trade, a buyer and seller of quantities of such articles—knowing them to be manufactured by a machine which is, *de facto*, though unknown to him, itself an infringement, such buying and selling is an infringement by him of the patent. If the law were otherwise, then when a man has patented an invention, the profit of which consists in selling articles manufactured by means of the invention, another might, by merely crossing the Channel, and manufacturing abroad, and selling in London for far less than the original price, but also at a trifle less than the price charged by the patentee, articles made by the patented process, wholly deprive the patentee of the benefit of his invention. It is therefore impossible to suppose that an exclusive right to vend is not given, and the defendants have therefore infringed the plaintiff's right, and it is immaterial whether it was or was not known to them that *Orr's* machine was identical with the plaintiff's."

It is equally an infringement of the patent monopoly to import into England articles bought abroad which are an infringement of an English patent, even when such importation is immediately followed by exportation after re-sale to a foreign customer. (*w*) Nor apparently will the circumstance that the goods so dealt in are, in fact, never landed in the United Kingdom negative infringement, provided they are brought for trans-shipment into British waters. (*x*)

But a foreign manufacturer who sells and delivers an infringing article outside the United Kingdom cannot be made liable as an infringer in the English Courts, even if he so acts with knowledge that such article is bought for importation into England. (*y*)

So, too, a person who (without the licence of the patentee) manufactures and offers for sale a patented article is liable as

(*u*) *Elmslie* v. *Boursier*, L. R. 9 Eq. 217.

(*v*) L. R. 5 Ex. p. 47; 39 L. J. Ex. p. 103.

(*w*) *United Telephone Co.* v. *Sharples*, 2 R. P. C. p. 31.

(*x*) *Nobel's Explosives Co.* v. *Jones*, L. R. 17 C. D. 721; 50 L. J. Ch. 582.

(*y*) *Badische Anilin* v. *Johnson*, 14 R. P. C. 405, 919; [1897] 2 Ch. 322; 66 L. J. Ch. 497; 76 L. T. 434; 45 W. R. 481.

an infringer even if no sale is effected. (*z*) But the sale of materials which may be used for making a patented article, to a person other than the patentee, even if the vendor knows they are to be used by such person for that purpose, in breach of the patentee's rights, is no infringement for which an action will lie.

In *Townsend* v. *Haworth*, (*a*) where the patent was for a process of preserving cloth from mildew, the sale of the chemical compounds used by the patentees was held to be no infringement of the patent right.

"No judge," said Jessel, M.R., "has ever said that the vendor of an ordinary ingredient does a wrong if the purchaser coming to him says, 'I want your compound. I wish to try the question with the patentee.' No one would doubt that that sale would be perfectly legal. You cannot make out the proposition that any person selling any article, either organic or inorganic, either produced by nature or produced by art, which could in any way be used in the making of a patented article, can be sued as an infringer because he knows that the purchaser intends to make use of it for that purpose. What is every person prohibited from doing? He is prohibited from making, using, or vending the prohibited articles, and that of course includes, in the case of machinery, the product, if I may say so, of the machinery which is the subject of the patent. It is that which is produced by the patent. But has any one ever dreamt before this case, that that extends to the component articles which enter into the patent?"

A sale of parts adapted for fitting together would, however, probably be held to be an infringement. (*b*) So, too, a person who contracts to put the ingredients together puts the invention in practice, even if he employs a sub-contractor to do part of the work. (*c*)

In the *Incandescent Gas Light Company* v. the *New Incandescent Mantle Company*, (*d*) *Tossel*, one of the defendants, argued that he had not infringed, as he had only sold fittings for use with gas mantles. It was proved, however, that *Tossel* was selling gas-fittings intended for use with infringing mantles made by the other defendants, and that, in this way, *Tossel* was carrying on a trade, in conjunction with the other defendants, in adjuncts

(*z*) *Oxley* v. *Holden*, 8 C. B. (N. S.), at p. 686.

(*a*) L. R. 12 C. D. 831, n.

(*b*) Per Pearson, J., *United Telephone Co.* v. *Dale*, 25 C. D. 778, p. 782; 53 L. J. Ch. 295.

(*c*) *Sykes* v. *Howarth*, 12 C. D. 826; 48 L. J. Ch. 769.

(*d*) 15 R. P. C. 81.

indispensable to the use of their infringing mantles. On this Mathew, J., held that the defendant *Tossel* had also infringed.

In *Innes* v. *Short*, (*e*) a vendor who invited his customers to use in an infringing manner the articles he sold was held to be himself guilty of infringement.

Whether Repairing is Infringement.—It is no infringement of a patent to merely repair a patented article. But if the process of repairing is carried so far as to result in what is really a new article made according to the patented invention, the person executing such repairs will be liable as an infringer.

In the *Dunlop Pneumatic Tyre Company* v. *Neal*, (*f*) the defendant undertook to repair a worn-out cycle tyre by providing a new case and fitting the wires of the worn-out tyre into it. The result was, in effect, a new cycle tyre made according to the patented invention.

In holding this to be an infringement, North, J., said: "In my opinion, the authority or license given by the fact of sale is to use the tyres till worn out. Simple repairs may be done by a person without a license from the manufacturer; but when the whole thing is taken, and practically a new tyre sold with only the old wires in it, I think there is no license to use these old wires for the purpose of putting them into and making up precisely the combination claimed by the patent."

So, too, where repairing a patented article necessarily involves the introduction anew of some component part, itself the subject of a patent claim, such repairing can only be effected (without infringement) by some person holding a license from the patentee of that component part. (*g*)

Infringement by Licensee.—Once a patented article is lawfully made and sold, its re-sale and subsequent use in the hands of another purchaser is protected. For, by sale, the patentee licenses the use of the article in the hands of any future buyer, and such buyer is no infringer. (*h*) A patentee may, however, by notice to a purchaser, impose conditions which will have the effect of giving such purchaser a limited license only. Where this is done, the use of the invention by a licensee who exceeds the limits of his license is an infringement.

Thus, although every sale of a patented article by the patentee

(*e*) 14 T. L. R. 492.

(*f*) [1899] 1 Ch. 807; 16 R. P. C. 247; 47 W. R. 632; 80 L. T. 746; 68 L. J. Ch. 378.

(*g*) *United Telephone Co.* v. *Nelson*, W. N. [1887], 193.

(*h*) *Thomas* v. *Hunt*, 17 C. B. (N. S.) 183.

implies a license to the buyer to re-sell, or otherwise use the article as he shall think fit, such implied license may be excluded by an express license of more limited scope; *e.g.* by a license that the article shall only be used or sold in conjunction with another article made by the same patentees. In the *Incandescent Gas Light Company* v. *Brogden*, (*i*) the plaintiff company sold their gas mantles subject to a limited license, which was printed as follows on every box in which their mantles were sold: "The Incandescent Gas Light Company, Limited, in supplying the mantle contained in this box, grant a limited licence to the purchaser to use or sell the same, on the express condition that neither the purchaser, nor any other person into whose hands the same may come, shall use or sell the said mantle except in connection or for use with burners sold or supplied by the company, and any other sale or use will amount to infringement of the company's patents. The company supply mantles for the purpose of renewals at the nominal price of 1*s.* 3*d.*, subject to the limitations above set forth."

This license was held by Kennedy, J., to be binding upon any person buying with notice of it, and a user or sale in contravention of its terms to be an infringement, in respect of which damages could be recovered.

Liability of Aliens for Infringement.—In *Caldwell* v. *Vanvlissengen*, (*j*) it was argued that, although the patentee's monopoly extended to the whole of the United Kingdom, it did not operate to prevent the subjects of foreign powers using the invention within that area. In rejecting this contention, Turner, V.C., said: "Foreigners coming into this country are, as I apprehend, subject to actions for injuries done by them whilst here to the subjects of the Crown. Why, then, are they not to be subject to actions for the injury done by their infringing upon the sole and exclusive right which I have shewn to be granted in conformity with the laws and constitution of this country? And if they are subject to such actions, why is not the power of this Court, which is founded upon the insufficiency of the legal remedy, to be applied against them as well as against the subjects of the Crown? It was said that the prohibitory words of the patent were addressed only to the subjects of the Crown; but these prohibitory words are in aid of the grant, not in derogation of it, and they were probably introduced at a time when the prohibition of the Crown could be enforced personally against parties who ventured to

(*i*) 16 R. P. C. 179.

(*j*) 21 L. J. Ch. 97; 9 Hare, 426.

disobey it. The language of this part of the patent does not, therefore, appear to me to alter the case."

Nor is it any answer to an action for infringement of a patent to prove that the infringer has only acted under the orders of a foreign sovereign. "If parties in England," said Cotton, L.J., in *Vavasseur* v. *Krupp*, (*k*) "are doing that which is an infringement of a patent, they cannot justify it by saying that some one, who has no power to authorize them to use the patent, has authorized them to do so."

Unauthorized Acts of Workmen.—An infringement is none the less an infringement because it is committed by workmen in disobedience to express orders to the contrary. If so committed in the service of an employer, such employer will be liable, as an infringer, to the patentee.

In *Betts* v. *De Vitre*, (*l*) Lord Chelmsford, C., said: "I will assume that the orders not to work in a particular manner were given, and that the disobedience to those orders was secret, although the evidence hardly warrants this conclusion. But granting all this to be the case, I should still hold that the directors were liable. A master is responsible for all the acts of his servant which are done in the execution of his duty. If a coachman drives his master's carriage where he is ordered to go, and by negligent driving does an injury, the master is responsible; but if he takes a carriage without permission, and employs it for his own purpose, he alone is answerable for any injurious consequences which arise during his use of it. The alleged infringement of the plaintiff's patent took place in the company's works, and in the course of the performance of the proper duties, in which the workmen were engaged. Those who have the control of the working are responsible for the act of the subordinates, and it is not sufficient for them to order that the work shall be so done that no injury shall be occasioned to any third person. That, of course, must be avoided, whether orders to that effect are given or not; but the directors were bound to take care that their orders were obeyed, and if there was a violation of them, whether openly or secretly, they are liable for the consequences."

In *Montgomerie* v. *Paterson*, (*m*) a case decided in the Court of Session, it was argued that the mere granting of licenses to third parties to infringe a patent was itself an infringement. The Court, however, refused to adopt this view. "I am not able to hold," said Lord Kyllachy, "that a patent is infringed by the mere

(*k*) L.R. 9 C.D. p. 359. (*l*) L.R. 3 Ch. p. 442. (*m*) 11 R.P.C. 221, p. 237.

granting of licenses, authorizing or permitting third parties to use the patented process or some equivalent. I asked at the debate whether there was any authority for this proposition, and it was admitted that none could be found. In the absence of such authority, I do not feel justified in holding that a person who does no more than give another a license to infringe a third party's patent is himself an infringer."

At the same time, a person found in possession of infringing articles, although no actual user can be proved against him, will be restrained by injunction from infringing the patent in question; his possession of such articles raising the presumption that he intends to use them. (*n*)

Letters Patent bind the Crown.—A patent has to all intents the like effect against her Majesty the Queen, her heirs and successors, as it has against a subject. (*o*)

Formerly letters patent were read with an exception in favour of the Crown, that being the general rule in the construction of Crown grants, and this exception was held to extend to those acting on behalf of and as agents for the Crown. (*p*) But not to contractors carrying out a contract entered into with a public department of government. (*q*)

Though the Crown is now as much bound by the prohibition in letters patent as a subject, yet for the protection of the public service it has been enacted that—

"The officers or authorities administering any department of the service of the Crown may by themselves, their agents, contractors, or others, at any time after the application for a patent, use the invention for the services of the Crown on terms to be before or after the use thereof agreed on, with the approval of the Treasury, between those officers or authorities and the patentee, or in default of such agreement, on such terms as may be settled by the Treasury after hearing all parties interested." (*r*)

Intention not Material to Infringement.—Considering the principles of infringement more in detail, it may first be observed that intention or *mens rea* is no necessary ingredient of infringement. Whether the infringer knows or not that he is infringing the patentee's monopoly is wholly immaterial: even proof that he did

(*n*) *Adair* v. *Young*, 12 C. D. 13; see, also, *The United Telephone Co.* v. *London & Globe Telephone Co.*, 1 R. P. C. 117; 26 C. D. 766; 32 W. R. 870.

(*o*) Patents Act, 1883, s. 27 (1).

(*p*) *Feather* v. *The Queen*, 35 L. J. Q. B. 200; 6 B. & S. 257.

(*q*) *Dixon* v. *The London Small Arms Co.*, L. R. 10 Q. B. 130; 1 C. B. D. 384; L. R. 1 App. Ca. 632; 44 L. J. Q. B. 63; 46 L. J. Q. B. 617.

(*r*) Patents Act, 1883, s. 27 (2).

not know of the existence of the monopoly upon which he has trespassed will not in itself constitute a defence to an action of infringement.

In *Heath* v. *Unwin*, (*s*) the judges in the Court of Exchequer had at one time expressed a contrary opinion, but this they afterwards withdrew when the case came before the House of Lords. "In delivering the judgment of the Court of Exchequer in a former stage of this case," said Parke, B., in giving his opinion to the House, "I stated the opinion of the Court to be, that there could be no indirect infringement if the defendant did not intend to imitate at all. That part of the judgment has been since justly objected to in *Stevens* v. *Keating*, and no doubt we were in error in that respect. There may be an indirect infringement as well as a direct one, though the intention of the party be perfectly innocent, and even though he may not know of the existence of the patent itself." (*t*)

"We think it clear," said Wilde, C.J., in *Stead* v. *Anderson*, "that the action (of infringement) is maintainable in respect of what the defendant does, not what he intends." (*u*)

"I am satisfied," said Bramwell, B., in *McCormick* v. *Gray*, "that there is no difference between making a thing with one intent and another. If a man may do a thing he may do it with whatever intent." (*v*)

So, too, in *Nobel's Explosives Company* v. *Jones*, Lord Blackburn pointed out that to support an action of infringement it was not necessary to shew that what was complained of was done knowingly. "I do not think that it would be material, in order to support an action for the infringement of their (the plaintiffs') property, to shew that it was knowingly infringed. Whether it was done knowingly or not, it would equally be an infringement of their property." (*w*)

"The right of the patentee," said Cotton, L.J., in *Proctor* v. *Bennis*, "does not depend on the defendant having notice that what he is doing is an infringement. If what the defendant is doing is, in fact, an infringement, his having acted *bonâ fide* and honestly will not protect him from an injunction." (*x*)

(*s*) 13 M. & W. 593; 14 L. J. Ex. 156.

(*t*) 5 H. of L. Ca. p. 537; 25 L. J. C. P. p. 19.

(*u*) 2 W. P. C. 156; 16 L. J. C. P. 251.

(*v*) 7 H. & N. p. 39; see, also, *Newall* v. *Elliott*, 13 W. R. p. 18; 10 Jur. (N. S.), 958.

(*w*) 8 App. Ca. p. 12; 50 L. J. Ch. 582; 42 L. T. (N. S.), 754; see, also, *Walton* v. *Lavator*, 29 L. J. C. P. 279; *Plimpton* v. *Spiller*, 4 C. D. 288; *Wittman* v. *Oppenheim*, 27 C. D. 260; 54 L. J. Ch. 56; *Young* v. *Rosenthal*, 1 R. P. C. 29; *Geary* v. *Norton*, 1 De G. & S. 9.

(*x*) L. R. 36 C. D. p. 760; 4 R. P. C. 357; 57 L. J. Ch. 22; see, also, *Proctor* v. *Bailey*, 6 R. P. C. 106.

Ambit of the Invention.—Although intention is no part of infringement, and the wrongdoer is equally liable whether he intends to invade the patentee's monopoly or not, there can be no infringement unless that monopoly is actually invaded. It is, therefore, necessary in every case of alleged infringement to first clearly ascertain what the limits of the monopoly claimed are; in other words, what is the preserve from which the public are fenced off by the prohibitory words of the grant, for unless that is trespassed upon there is no infringement. This is sometimes called the area or ambit of the invention.

Once the area of monopoly is defined it becomes possible to ascertain whether what the infringer has done amounts to an invasion of the rights of the patentee. Where the identical thing of which the patentee has the monopoly is done, the infringement will be clear; but in most cases distinctions and differences will be found to exist, (*y*) and difficult questions will sometimes arise as to whether what is done amounts to independent invention, or conceals, under non-essential differences, a substantial identity with the protected discovery.

Essence of the Invention to be Ascertained.—In such cases the Court, having ascertained in the first instance the ambit of the invention, will then proceed to consider what is its essential and characteristic feature, what, to quote the words of Lord Cairns, is its "pith and marrow," for unless these are found in the alleged infringement there will be no invasion of the patentee's monopoly. But, on the other hand, if the infringer has availed himself of these, no matter how disguised and concealed, he is a trespasser on the patentee's monopoly, and liable as such, for the wrong he has committed. (*z*)

"I think," said Bowen, L.J., in *Hocking* v. *Hocking*, "it will be found that the true view is that which was laid down in the House of Lords, and which has been acted on in many cases: that you must ask yourself whether the substance and pith of the invention is taken substantially. A mere addition to the original machine will not prevent the new machine from being an infringement; nor will diminishing or subtracting this or that part of the original machine necessarily prevent an infringement of it from taking place. You must recall yourself, after making

(*y*) "No infringer of patents is such a blunderer at the work of infringing as to go and make a thing exactly like the patent." Per Esher, M.R., in *Peckover* v. *Rowland*, 10 R. P. C. p. 238.

(*z*) See *Dudgeon* v. *Thomson*, 3 App. Ca. 39 (per Lord Cairns, C.).

allowance for the subtraction, to the question whether in substance the invention has been borrowed.

"I think there is this further common-sense maxim to be borne in mind, and that is, that as what you have to consider is not whether there has been an improvement on the old machine, but whether the old machine has in fact been plundered, you must not be led away by the mere terminology which the patentee uses in describing his machine; for example, supposing that the addition made or the subtraction made is one which, in strict language, prevents the original terminology of the patentee from being applicable as accurately to the new machine as it would have been to the old machine, although that, I think, is a fact to be considered, yet it is not the determining standard. You must still go back and ask yourself, not what the machine is properly called which is said to infringe, but what it is in substance, and whether it has in substance taken the invention which has been described in the patent. That seems to me to be a sensible canon to bring to bear on the question of infringement." (*a*)

Identity of purpose, not of name, is therefore the true test of infringement. Things may be called by the same name and yet perform totally different functions in different inventions. "This thing," said Lord Cottenham, in *Cutler's Patent*, "may be called a pin, and may be correctly called a pin, and the other no doubt may be called a pin, but it is not because they go by the same name they are to be considered as identical; they are not used for the same purpose in any one respect." (*b*)

The case of *Dudgeon* v. *Thomson* (*c*) affords a good illustration of the importance of grasping the essence of the invention as a test of infringement. In that case the patent was for a new or improved expander of boiler tubes. The apparatus alleged to be an infringement consisted of three rollers in the form of tapering cylinders, placed together round a central cylinder, which by its rotation gave motion to these wedge-formed tapering cylinders. The whole operated as a revolving wedge inserted in the tube, and caused its expansion by rotation. The plaintiff's apparatus, on the other hand, consisted of cylindrical rollers, into the centre of which a tapering plug was introduced as an expander, which operated on the tube by driving out these cylinders, and so creating a heavy continuous pressure on the inside of the tube.

(*a*) Per Bowen, L.J., in *Hocking* v. *Hocking*, 4 R. P. C. 442, 443; approved by Lord Watson in S. C. 6 R. P. C. 78.

(*b*) 1 W. P. C. 427.

(*c*) L. R. 3 App. Ca. 42.

The House of Lords being of opinion that the essential feature of the plaintiff's invention was the central plug creating lateral pressure, held that the defendants had not taken the essence of the invention, and that their apparatus was therefore a different mode of attaining the same result, and no infringement.

Wider Ambit of a Master Patent.—In construing the ambit of an invention with the view of ascertaining whether what a defendant has done is an infringement of the patent rights, the Court will deal more liberally with a patent for a pioneer invention which strikes out some new track of discovery and may be described as a master patent, than with an invention which is in the nature of an improvement and the subject-matter of which has already been the subject of prior patents.

"Where the thing is wholly novel," said Wood, V.C., in *Curtis* v. *Platt*, (*d*) "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 a right to extend very largely the interpretation of those means which he has adopted for carrying it into effect. . . . One looks more jealously at the claims of inventors seeking to limit the rights of the public at large for effecting that which has been commonly known to all the world long ago. Of course no patent can be taken out for effecting this as a new object, but only for effecting it by a new means. What those means may be, and what is the extent of a claim which the patentee has a right to insist upon as to those means, is often a matter of much difficulty."

So likewise in *Proctor* v. *Bennis*, (*e*) the same distinction was laid down by Fry, L.J. "It appears to me that the cases and the reason of the case, draw a broad distinction between combinations which are old as regards their elements, and old as regards the object to be attained, and combinations which though old as regards the elements, are new as regards the mode of putting them together, and new as regards the object to be attained. I think that a comparison of what was said in *Curtis* v. *Platt*, where

(*d*) L. R. 3 C. D. 136, n.

(*e*) 4 R. P. C. p. 361.

a broad distinction was drawn by Lord Hatherley between old and new objects, with what was said by Lord Cairns in the case of *Clark* v. *Adie* (*f*) in indicating the second mode (*g*) in which the combination might be infringed in that case, and with what was said by the present Master of the Rolls in the case of *Nordenfelt* v. *Gardner*, (*h*) goes to shew that there is a broad line of distinction to be drawn between cases of combination for an old object and cases of combination for a new object, and, as I have already said, reason, as I think, goes a long way with those authorities."

At the same time, the Courts will not construe the ambit of a master patent so widely as to conflict with the well-established rule that there can be no patent for a principle. For even where an invention attains an entirely new result, the Courts will not prevent another inventor attaining the same result by essentially different means.

Improvements are still Infringements.—It affords no answer to an action of infringement to shew that the article or process complained of is, in fact, an improvement upon the plaintiff's patent, if the original invention has been taken. An infringement which embodies improvements is none the less an infringement. (*i*)

"Although the respondents' invention," said Lord Chelmsford in *Saxby* v. *Clunes*, (*j*) "is a decided improvement upon the appellant's, yet, if in carrying it out they make use of any part of the appellant's invention to which his patent extends, and which is new and material, they are liable for an infringement."

"If," said Lord Esher, M.R., in *Needham* v. *Johnson*, (*k*) "the defendants have used the plaintiffs' combination, and also something added to it, that combination remaining a necessary part of their machine, but the addition to it being an improvement, and if they have used that, but without acknowledgment, that is to say, without acknowledgment that they are using an improvement, that would be an infringement, no doubt. If they had invented such a machine as I have described, they would have been entitled to take out a patent, not for that machine, as a new machine, but for an improvement upon the plaintiffs' machine. If they had claimed the improvement on the plaintiffs' machine, they could not use their improved machine without paying the

(*f*) 2 App. Ca. 320.

(*g*) By taking the essential characteristics. See, also, *Incandescent Gas Light Co.* v. *De Mare*, 13 R. P. C. 301, 559.

(*h*) 1 R. P. C. 61.

(*i*) See *Neilson* v. *Harford*, 1 W. P. C. 310; *Russell* v. *Ledsam*, 14 M. & W. p. 581; *Bateman* v. *Gray*, Macr. P. C. 102; *Young* v. *Rosenthal*, 1 R. P. C. 32, 33.

(*j*) 43 L. J. Ex. 241.

(*k*) 1 R. P. C. p. 53.

proper price to the plaintiffs for having used their machine although improved. If they used it without paying, they would infringe."

"If the pith and marrow of the invention is taken," said Bowen, L.J., in *Wenham Gas Company* v. *Champion Gas Company*, (*l*) "it is no excuse to say that you have added something or omitted something, even if the addition or omission be useful and valuable. The superadding of ingenuity to a robbery does not make the operation justifiable. The fact that that new lamp which is the result of having taken the invention of another person is an improvement upon that other person's idea, does not excuse the person who borrows what is not his."

In the *North British Rubber Company* v. *Macintosh*, (*m*) the patentee's invention (which related to improvements in tyres or rims for cycles) was the combination of an outside flexible tyre, that could easily be renewed (because it was not in itself a complete tube), and an inside complete tube, capable of inflation, so that when the inside tube was inflated the flexible tyre was kept on to the grooved, dove-tailed, metal tyre by the pressure of the sides of the flexible tyre against the groove. The defendants had taken the plaintiff's invention, subject to the following alterations. They had increased the size of the outside flexible tyre and the thickening of its edges, also the dove-tailing of the metal-grooved tyre, 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. With these alterations they were able to employ for their inflatable inside tubes a more elastic tube, viz. one made wholly of india-rubber, instead of one composed of cloth and indiarubber combined, as mentioned in the plaintiffs' specification. "Take it," said Romer, J., in holding this to be an infringement, "that so far as the patentee is concerned, he has indicated, by the reference to the cotton, that he does not contemplate his inside tube being too elastic, or being made wholly without cotton; and then suppose a man subsequently finds that by much increasing the grip referred to in the patent, he can, without risk of blowing out the outside tyre, make the inside tube more elastic than the patentee thought, and wholly drop the cotton. Would this enable him with impunity, and without being considered an infringer, to take and use the whole of the patentee's invention, so long as he employed the increased grip, and the more elastic inside tube? I think not. He would still be taking and using the essence of the invention (of that which was patented), and would be an infringer, though

(*l*) 9 R. P. C. 49, p. 56.

(*m*) 11 R. P. C. 477.

his particular tyre might be an improvement of that precisely indicated by the patentee in the body of his specification." (*n*)

Where, therefore, a patentable improvement upon an existing patent is discovered by some person other than the patentee, such person, although not precluded by the prior invention from patenting his discovery, cannot, if his use thereof is dependent on the use as well of that prior invention, put his discovery into practice during the term of the original patent *without* the license of the original patentee. (*o*)

If modifications which improve a patented inv ntion do not excuse its use by an unauthorized person, *a fortiori*, alterations which make it worse will not do so. (*p*)

"It is not," said Mathew, J., in *Cheetham* v. *Nuthall*, (*q*) "because an inferior article is produced that there has not been an infringement of the patent."

Where detrimental variations are introduced for no good purpose the Court will conclude that they are merely adopted to conceal the piracy and prevent its becoming apparent. (*r*) A clumsy imitation is none the less an infringement because it is an inferior copy. (*s*)

Infringement by Taking a Part of the Invention.—It is not necessary to constitute infringement of a patent, that all that is claimed by the patentee should be taken. Taking any essential part of the invention is an infringement of the monopoly.

"All that has to be looked at in questions of infringement," said Pollock, C.B., in *Newton* v. the *Grand Junction Railway Company*, (*t*) "is whether the defendant has pirated a part of that to which the patent applies." "If part of the property in the invention is taken," said Lord Blackburn, in *Dudgeon* v. *Thomson*, "there is an infringement, however much that may be disguised or sought to be hidden. If that is detected by the patentee, and if what is taken is really part of his property given to him by the letters patent, he has a right to proceed against the infringer, however ingeniously the colours may have been contrived to conceal the fact that there has been a taking of part of the property." (*u*)

(*n*) 11 R. P. C. p. 488.

(*o*) Per Tindal, C.J., in *Crane* v. *Price*, 1 W. P. C. 410; see, also, *Harmar* v. *Playne*, 11 East, 111; *Lewis* v. *Davis*, 3 C. & P. 502; *Ex parte Fox*, 1 W. P. C. 431. As to compulsory licenses, see *ante*, p. 349.

(*p*) See *Moore* v. *Thompson*, 7 R. P. C. pp. 334, 335.

(*q*) 10 R. P. C. 333.

(*r*) Per Lords Halsbury and Bramwell, in *Moore* v. *Thompson*, supra.

(*s*) *Crampton* v. *Patent Investments Co.*, 6 R. P. C. 287.

(*t*) 5 Ex. p. 334; see, also, *Hinde* v. *Osborne*, 1 R. P. C. 64.

(*u*) 3 App. Ca. p. 53.

"You not only have no right to steal the whole," said James, V.C., in *Parkes* v. *Stevens*, (*v*) "but you have no right to steal any part of a man's invention; and the question in every case is a question of fact—Is it really and substantially a part of the invention?"

No Infringement to take Part where a Combination only is claimed.—Where, however, the patent is for a combination merely, and none of the component parts are claimed separately, it is no infringement to take one of such parts. For parts which are not claimed are not protected. (*w*) Thus, in *Parkes* v. *Stevens*, (*x*) the plaintiff claimed generally a special arrangement and combination of parts in the making of railway lamps. One of the elements in the plaintiff's combination was a spherical sliding door. The defendant put a similar door into his own lamp, and was held entitled to do so, as this was no infringement of the combination, which alone was the subject of the plaintiff's claim. (*y*)

In considering whether or not a patent which is alleged to have been infringed is for a combination only, it is not material to ask whether the word combination occurs in the specification. Dealing with this contention in *Proctor* v. *Bennis*, Cotton, L.J., said: (*z*) "The argument that a man who claims the use of certain mechanical means in connection with certain other things does not claim a combination, to my mind really requires no answer. A combination is the use of certain things in connection with others to produce a machine, and that is what is here claimed."

Where taking Part of a Combination is Infringement.—Although to infringe a combination patent it must generally be shewn that all essential parts have been taken, there are cases where the taking of a part only of the combination may be an infringement of the patentee's monopoly. This will be so when the inventor claims, not only the whole combination, but also separate parts of it as independent entities. Where this is so, the taking of any part so claimed will constitute an infringement of the patent. This form of infringement was lucidly explained as follows by Lord Cairns, C., in dealing with a patent for a mechanical apparatus in *Clark* v. *Adie*: (*a*) "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

(*v*) L. R. 8 Eq. p. 367; 38 L. J. Ch. p. 631.

(*w*) *Davies* v. *Townsend*, 16 R. P. C. 497.

(*x*) L. R. 8 Eq. 358; 5 App. Ca. 36; 38 L. J. Ch. 627.

(*y*) See, also, *White* v. *Fenns*, 15 W. R. 348; 15 L. T. (N. S.), 505.

(*z*) 4 R. P. C. p. 352.

(*a*) L. R. 2 App. Ca. 315; 46 L. J. Ch. 588.

be that which 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 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."

All the Parts of a Combination need not be taken to constitute Infringement.—Where the patentee claims only a combination, the combination itself, and not the parts composing it, constitutes the invention. The true test of infringement, therefore, in such case is not whether all the component parts have been taken, but whether the essence of the combination as a whole has been taken.

Thus, any substantial union of the essential parts for the same object will be an infringement, even where all the parts have not been taken or where mechanical equivalents have been substituted for some of them. (*b*)

In *Harrison* v. *Anderston Foundry Company*, (*c*) Lord Penzance said: "The case of *Lister* v. *Leather* has been cited and commented upon as an authority for the proposition that a patent for a combination covers and protects all subordinate combinations or

(*b*) *Osmond* v. *Hirst*, 2 R. P. C. 265. (*c*) 1 App. Ca. 593.

parts, or at least such of them as are 'new and material.' It is plain, however, that that case did not go this length. It decided nothing more than this, that though the patent is for a combination, it does not follow that there can be no infringement of it unless every part of that combination, without exception, is pirated. What the Court said was that the taking of a subordinate part or parts of the combination might be, not that it necessarily would be, an infringement of the patent; and that, whether it would be so or not, depended, as the Court of Error said, 'Upon what the parts taken were, how they contributed to the object of the invention, and what relation they bore to each other.' This only amounts to saying that on a question of infringement the essential nature of the invention will be regarded; and that there may be cases in which, though the patent is for an entire combination of numerous parts, a collusive imitation of that invention may be effected though some detail of the combination is omitted or changed, which is a doctrine familiar enough in patent law."

The argument that an alleged infringement of a combination was no infringement because it differed from the plaintiff's combination, both by additions and omissions, was discussed by the Court of Appeal in *Proctor* v. *Bennis*. "In my opinion," said Cotton, L.J., in that case, (*d*) "additions and omissions may be very material in considering whether in fact the machine of the defendant is a taking of the machine of the plaintiff, that is to say, an infringement of the combination which the plaintiff claims; but if that is not so, then the mere fact that there are certain parts omitted or certain parts added, if he really has taken the substance and essence of the plaintiff's combination, cannot prevent his machine from being an infringement of the plaintiff's."

In *Osmond* v. *Hirst*, (*e*) a marking apparatus, in which the colouring matter was communicated to the marking wheel by contact with another wheel or disc revolving in a tank charged with colouring matter, was held to be infringed by a similar combination in which the function of the rotating disc was performed by a revolving brush.

In *Laine* v. *Herold*, (*f*) a patent for a chemical compound for killing beetles was held to be infringed by the use of a similar compound, with immaterial additions, for the same purpose.

In *Nordenfelt* v. *Gardner*, (*g*) it was alleged that the defendants

(*d*) 4 R. P. C. p. 354; 57 L. J. Ch. p. 19.
(*e*) 2 R. P. C. 265.
(*f*) 9 R. P. C. 447.
(*g*) 1 R. P. C. 61.

had infringed the plaintiff's patent by taking two of its subordinate combinations. The patent was for an improved battery gun, of which the defendants were said to have taken the feeding apparatus and the magazine. The case was tried before Huddleston, B., without a jury, who ordered an injunction. On appeal this decision was reversed, the Court of Appeal holding that the patent had not been infringed.

In his judgment, Lord Esher, M.R., construing the specification, said: (*h*) "That seems to me to claim the feeding apparatus as a combination, and to claim the combination, and 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 those 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; 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 new patent can be made with regard to the new machine, except by claiming the invention as an improvement, and by shewing distinctly what the addition is, so as to shew 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 matérial subtraction, I should think that it was a new combination. But an alteration by substitutes, 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 a putting in of a new material element which is different from any of the elements of the former."

Although it is not necessary that all the parts of a combination

(*h*) 1 R. P. C. p. 65.

should be found in an infringement, it is necessary that all the *essential* parts should be taken; for the omission of even one essential factor constitutes the remaining ingredients, in fact, a new combination; and the granting of a patent for one combination does not preclude another inventor attaining the same end, by a simpler combination, with fewer ingredients. Indeed, some of the most meritorious inventions have consisted in the discovery that a well-known commercial result could be attained with the omission of some ingredient, or without the necessity of some step, previously believed to be indispensable.

Applying this principle in *Gwynne* v. *Drysdale*, (*i*) the Lord President of the Court of Session said: "I am not to be understood as saying that an infringer, by merely omitting some immaterial part of the mechanism described in the specification, or substituting for such immaterial part some mechanical equivalent, will escape conviction if his machine contains all the essential and characteristic features of the patented combination. But, if in the machine of an alleged infringer any material part of the patented combination is omitted, then the combination used by the alleged infringer is a different combination from that of the patentee. The omission of one material part may be an improvement, or the reverse. The possibility of dispensing with it may be a valuable discovery, or the omission may be made merely for the purpose of avoiding an infringement; but, in either case, the combination of the patentee, minus an essential part of it, is no longer his combination."

In *Needham* v. *Johnson*, (*j*) the plaintiff's patent was for improvements in machinery for depurating fluids. The object of the invention was described as being the employment of paper as a filtering medium under high pressure. The patentee's second claim claimed "forming continuous supply-and-discharge conduits by simple contact of the frames substantially as described and shewn." The plaintiff's conduits (for supply and discharge) were continuous pipes with holes. The defendant's had a continuous discharge-pipe with holes, but they had not a continuous supply-pipe. Instead, they had a series of holes, or perforations, placed so that the liquid passed through them in columns, as liquid would pass through a pipe. In the abstract the contrivances looked the same, but when the purpose of the patentee was borne in mind, the difference became apparent; for the defendant's series of holes could not be used for the purposes of a paper-filter at all.

(*i*) 3 R. P. C. 65.

(*j*) 1 R. P. C. 48, 1884.

Lopes, L.J., having held at the trial that the defendant had infringed, the Court of Appeal reversed this decision. Lord Esher, M.R., said: (*i.a.*) "Can these frames (in the defendant's apparatus), which form a passage of successive holes at the necessary distance, which may be a considerable distance, can they, in any ordinary sense of the word, be said to form a physical or mechanical conduit or pipe through which anything is to pass? They conduct the liquid so that it forms a hydrostatic column. They do that; but do they do that by making themselves into a conduit or pipe? I come to the conclusion that they do not, and that, therefore, in the centre of the defendant's machine there is not a physical, mechanical conduit or pipe, or anything which is only colourably different from that. If so, one of the essential elements of the plaintiff's combination is not used in the defendant's machine, and something else is used which is necessary for the defendant's machine, that is, something which is not a conduit, because if it were a conduit in the defendant's machine, if it were a physical conduit caused by the impact of the two things together, the defendant's machine would not work. . . . It seems to me that, under those circumstances, the combination in the defendant's machine is not the same as the combination in the plaintiff's machine."

Infringement by Colourable Variations.—The infringer of a patented invention does not usually take the invention in all its details, variations are generally introduced to disguise the piracy, (*k*) and it is always a question of degree as to whether such variations constitute differences sufficiently substantial to negative infringement. Mere trifling differences, alterations in non-essential details, will not, however, protect an infringer.

The law upon this was well laid down to the jury by Tindal, C.J., in *Walton* v. *Potter*. (*l*) "Where a party has obtained a patent for a new invention or a discovery he has made by his own ingenuity, it is not in the power of any other person, simply by varying in form or in immaterial circumstances the nature or subject-matter of that discovery, to obtain either a patent for it himself or to use it without the leave of the patentee, because that would be in effect, and in substance, an invasion of the right. And, therefore, what you have to look at upon the present occasion is, not simply whether in form or in circumstances—that may be more or less immaterial—that which has been done by the

(*k*) See Lord Esher, M.R., in *Peckover* v. *Rowland*, 10 R. P. C. 238.

(*l*) 1 W. P. C. 586, 587.

defendants varies from the specification of the plaintiff's patent, but to see whether in reality, in substance, and in effect the defendants have availed themselves of the plaintiff's invention."

Where, to the eye, the two things are so similar that it is necessary to search carefully to discover differences, a strong *primâ facie* case of infringement is at once made out. But such *primâ facie* case may, on further examination and comparison, be rebutted by the discovery of some essential difference. (*m*)

In *Plimpton* v. *Malcolmson*, (*n*) the defendant took the plaintiff's invention bodily, excepting one detail, which he varied for the worse by substituting a fixed steel spring for a rubber spring or buffer, which could be tightened or loosened as required, and this was held a clear infringement. So, too, in *Hinde* v. *Osborne*, (*o*) the substitution of a flexible wire for a pin pivot was held an infringement; in *Osmond* v. *Hirst*, (*p*) the substitution of a revolving brush for a rotating disc; and in *Macdonald* v. *Fraser*, the adoption of an air-pump in place of bellows. (*q*)

Infringement by Substitution of Equivalents.—Where the infringer takes the substance of the patented invention, but varies the form by omitting certain parts and introducing elements known to be equivalents for the parts so omitted, he is said to infringe by the substitution of mechanical or chemical equivalents.

Discussing infringement by mechanical equivalents in *Dudgeon* v. *Thomson*, (*r*) Lord Cairns, C., said: "Now, my lords, what I understand by that is this, if there is a patented invention, and if you, the defendant, are found to have taken that invention, it will not save you from the punishment or from the restraint of the Court that you have at the same time that you have taken the invention, dressed it up colourably, added something to it, taken, it may be, something away from it, so that of the whole of it may be said, as is said in this injunction, here is a machine which is either the plaintiff's machine or differs from it only colourably. But, underlying all that, there must be a taking of the invention of the plaintiff. There used to be a theory in this country that persons might infringe upon the equity of a Statute; if it could not be shewn that they had infringed the words of a Statute it was said that they had infringed the equity of the Statute, and I know there is, by some confusion of ideas, a notion sometimes

(*m*) See Jessel, M.R., in *Thorn* v. *Worthing Skating Rink Co.*, 6 C. D. 417, n.
(*n*) 3 C. D. 531; 45 L. J. Ch. 505.
(*o*) 1 R. P. C. 221; 2 R. P. C. 64.
(*p*) 2 R. P. C. 265.
(*q*) 10 R. P. C. 386; 11 R. P. C. 169.
(*r*) 3 App. Ca. 34; see pp. 44, 45.

entertained that there may be something like an infringement of the equity of a patent. My lords, I cannot think that there is any sound principle of that kind in our law; that which is protected is that which is specified, and that which is held to be an infringement must be an infringement of that which is specified. But I agree it will not the less be an infringement because it has been coloured or disguised by additions or subtractions, which additions or subtractions may exist and yet the thing protected by the specification be taken notwithstanding."

Instances of Mechanical Equivalents.—The following cases illustrate infringement by mechanical equivalents.

In *Murray* v. *Clayton*, (*s*) the plaintiff's machine, which was an improved apparatus for the making of bricks, was so contrived as to cut by the reciprocating action of a vertical wire from clay delivered on the table of the machine a strip long enough to make twelve bricks. This strip of clay was then pushed forward by the action of the machine against a series of fixed wires which divided it into separate bricks of the proper dimensions. The defendants in their machine effected the first operation by a wire acting not vertically but radially, and the second by passing the wires through the clay by the action of a movable frame in which they were set.

In holding this to be an infringement, James, L.J., said: "It appears to me that the defendants have simply made transposition, that is, that instead of moving the clay against the wires they have made the wires move against the clay. It appears to me that what *Mr. Pole* has said on the subject in his evidence is perfectly accurate. He describes the details of what is done by the plaintiff's machine, and what is done by the defendant's machine, and he says this amounts simply to inverting the relative motions of the parts in regard to each other, the essential action and the result produced being identical in the two cases. That is exactly the case of a colourable variation. This machine, which was made by the defendants after they had seen the plaintiff's machine in use, effects the same object; but according to the evidence (which is not contradicted) it effects it by an enormously greater expenditure of power, as to which we may refer to the language of Lord Hatherley in *Daw* v. *Eley*, (*t*) to the effect that a clumsy imitation of a patented machine or a patented article may be an infringement although it is not such as would have been an anticipation defeating the plaintiff's right." (*u*)

(*s*) L. R. 7 Ch. 570. (*t*) L. R. 3 Eq. 496. (*u*) L. R. 7 Ch. p. 585.

In *Ehrlich* v. *Ihlee*, (*v*) the plaintiff's invention (a form of hand organ) consisted in the combination of a stationary wind chest and a circular rotating music sheet, which, by reason of perforations it contained, operated as it revolved, upon levers attached to the fixed mechanism, and so produced the music. The defendants adopted the plaintiff's idea, but inverted the functions of the parts, by making the music sheet a fixture, and causing the wind chest and mechanism to rotate beneath it. This was held a clear infringement. (*w*)

In *Moss* v. *Malings*, (*x*) the invention was a method of securing a firmer grip on the handles of tennis racquets. The patentee attained this result by longitudinal grooves on the opposite sides of the handle, the defendants by building up protuberances along the handle at intervals. It was contended that this was a new idea, and no infringement. On this North, J., said: "It is clear to my mind that if the plaintiff's is a good patent, this is an infringement of it, and for this reason. The new idea, when carried out in the handle, is an extension of surface for grasping by the hand, coupled with the making of certain parts raised and certain parts depressed, so as at the same time to give a greater surface, and to give greater holding power, or, in other words, to enable you to hold it equally tightly with less pressure from the hand at the time. . . . A suggestion has been made that there is a difference in this way, that what the plaintiff has done has been simply to take what you call a solid handle and groove out certain indentations in it, whereas the defendant's is totally different, because he has taken what I call again a solid handle, and he has built up certain ribs or put certain protuberances upon it. The result in both is the same; there are alternate elevations and depressions, and whether those are produced by cutting out the intervening bits, or building up the ribs so as to leave holes between the two, seems to me entirely immaterial." (*y*)

In the *United Telephone Company* v. *Bassano*, (*z*) the plaintiffs' patent claimed the combination for telephonic purposes of a diaphragm or tympan with tension regulators operating in a closed circuit. The essence of the invention was a vibrating plate or substance to be operated upon by the human voice, and which in

(*v*) 4 R. P. C. 115; 5 R. P. C. 437.

(*w*) See, also, *Crampton* v. *Patent Investments Co.*, 5 R. P. C. 382; 6 R. P. C. 287; *Barrett* v. *Vernon*, 25 W. R. 343.

(*x*) 3 R. P. C. 373. In the later case of *Slazenger* v. *Feltham* this patent was held invalid by the Court of Appeal for want of subject-matter: 6 R. P. C. 233.

(*y*) 3 R. P. C. 379.

(*z*) Ibid. 295, p. 313.

its turn operated upon the tension regulator. The defendants suggested that their mechanism was no infringement, because they did not use a diaphragm; but the Court held that a board in the defendants' apparatus in fact performed the function of the diaphragm, and that the infringement was made out. On this the defendants urged that the board in question was not an essential part of their apparatus, which could be worked without it. The Court of Appeal declined, however, to consider this contention, on the ground that in the infringement in fact complained of the board was present, and therefore whether the defendants' mechanism would or would not work without it was immaterial to the issue in dispute.

In the later case of the *United Telephone Company* v. *St. George*, (*a*) the defendants' apparatus consisted of a disc of carbonized leather behind a mouthpiece, and a ball of carbonized wood suspended by means of a flexible metallic conductor, so as to rest lightly by gravity against the leathern disc. They claimed that the instrument thus constituted contained neither of the elements of the plaintiff's combination, and did not operate in a closed circuit. Stirling, J., held, however, that the defendants' disc was in effect a diaphragm, that the combination of disc and ball constituted a tension regulator within the meaning of the plaintiff's specification, and that the infringing instrument in fact operated in a closed circuit.

In *Murchland* v. *Nicholson*, (*b*) an apparatus for milking cows was fitted with a valve to relieve vacuum pressure. The patentee's valve was formed by a tube connected at one end with the pipes in which the vacuum was set up, and open at the other. The open end rested in a vessel of water, and was so adjusted that when the vacuum drew up into the tube a column of water of a certain height, air found its way up the tube and prevented the vacuum from becoming excessive. The respondents used an apparatus in which they obtained the desired automatic regulation of the vacuum by using an ordinary valve with a lever held down by a weight, the amount of the vacuum being regulated by the position of the weight on the lever. This was held by the Inner House of the Court of Session to be the substitution of a mechanical equivalent, and an infringement of the complainer's patent.

In *Benno Jaffé und Darmstaedter Lanolin Fabrik* v. *Richardson & Company*, (*c*) the patent was for an improved method of

(*a*) 3 R. P. C. 321.
(*b*) 10 R. P. C. 417.
(*c*) 11 R. P. C. 93; 261 (affirmed).

manufacturing a product called lanolin from wool fat. The object of the inventor was to utilize for practical and especially pharmaceutical purposes the fatty matters known to be contained in sheep wool. It was known that by washing sheep wool with alkali, a liquor containing cholesterine fats mixed with soap and other impurities could be obtained. The invention consisted in a special mode of treating this liquor, by which the cholesterine fats were freed from fatty acids and other impurities, and a new product, called lanolin, obtained, which was not liable to become rancid. The ingredients of the liquor obtained by the alkali washing were of different specific gravities, and the inventor, by separating them by means of the mechanical action of a centrifugal machine, was able to extract the pure and unadulterated fat.

The defendants produced a product which they called anaspaline. This, putting aside an immaterial ingredient, was merely lanolin. They produced it by the same means, except that, instead of using the speedy action of a centrifugal machine, they relied on a depositing process. In holding this to be an infringement, Romer, J., said: "They appear to me to have taken the essence, or what is sometimes called the pith and marrow, of the invention. The use of the centrifugal machine was not of the essence of the patented invention. That machine was a well-known method of separating mechanically materials of different specific gravity, and was, to my mind, referred to in the specification as being, and because it was the most speedy and efficient known means for effecting the separation. The mechanical separation, by allowing gravity to act on such materials when deposited in a vessel in the ordinary way, is a well-known equivalent, though not so speedy or efficacious, and the defendants cannot, by adopting this, when they in all essential matters take and use the plaintiff's invention, be heard to say that they are not using that invention or infringing the patent."

In the *British Tanning Company* v. *Groth*, (*d*) the plaintiff's patent was for an improved process and apparatus for tanning by aid of electricity. The invention consisted in the application of electricity to a method of tanning by means of a rotatory drum. This was achieved by passing an electric current through the tanning liquor in the drum. The rotatory drum method of tanning was old and well known. Under it the liquor and the hides were all put inside a revolving cask or drum, which had pegs or other means by which, in the interior of the revolving cask or drum, the

(*d*) 8 R. P. C. 113.

hides were from time to time lifted up and splashed down, or churned about in the liquor. The plaintiff's specification limited his claim to the use of electricity in connection with this mode of tanning. The defendants also used electricity for tanning, but in combination with a different mechanical treatment. In their apparatus the hides were made to revolve on an axis in the tanning fluid electrically treated. This was held to be a distinct method, and no infringement of the plaintiff's patent.

In *Miller* v. *The Clyde Bridge Steel Company*, (e) the pursuer's patent was for a combination of apparatus for turning over and moving metal masses in machinery for rolling metals. There were four claims each for a combination, and in each combination a "lifter" was included as an essential part. This lifter was the apparatus which the patentee used for turning the masses of heated iron when lying on the rollers. It was a species of fork. One prong lifted and tilted the metal over, which was then received in the hollow of the fork and kept in its place by the other prong. Thus the metal was placed and kept in a suitable position for entering into a new set of rolls. The lifter was attached to the ram of an hydraulic engine placed under the rollers, and upon a movable carriage, so that the lifter might be brought to a convenient place for the exercise of its functions.

The defenders used two hydraulic oscillating engines, each placed on a movable carriage. The ram was jointed to a lever arm, which again was connected with the carriage by a pin, round which it turned. The arm could thus be raised from the horizontal to the vertical or slightly past the vertical, and in its motion it turned the metal. The operation of turning was performed by the defenders' apparatus when the metal rested on the rollers; the metal being received and held in position by a corresponding arm attached to the ram of the other engine. While thus held in position the metal could be pushed along the rollers so as to enter any set of rolls. This combination contained no fork, the arms not being connected in any way. The Inner House of the Court of Session held this to be no infringement. Lord Rutherford Clark said: "The defenders use no fork which turns and receives the metal. With them the turning is effected with separate and unconnected arms. It is said that the two arms when brought together form the pursuer's lifter. I do not think so, for, being unconnected, they cannot form a fork. It seems to me that I have put the case fairly when I say that the defenders dispense with the

(e) 8 R. P. C. 198.

fork, which is the essence of the pursuer's invention, and use a separate contrivance of their own to effect the same end."

Where the Doctrine of Mechanical Equivalents does not Apply.—Where the object attained is old and the only novelty consists in the substitution of better equivalents for those already known and used to the same end, the doctrine of mechanical equivalents does not apply; and the patentee cannot bring within his specification any equivalent which he has not described and claimed, so as to make its use an infringement of his patent right. (*f*)

"There are some things," said Lord Halsbury, C., in *Tweedale* v. *Ashworth*, (*g*) "wherein a principle properly so-called is invented, and the infringer may take the principle and may alter the details, and yet it is very obvious that he has, in truth, 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 in such case very often 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. But there are some cases in which, although the principle is common to a great variety of manufacturers, there may be a good subject-matter of a patent in the particular mechanical mode by which that principle is carried into operation."

In *Curtis* v. *Platt*, (*h*) the plaintiff's patent was for improvements in mules, and the object of the invention was to effect certain changes in the action of the mule without the intervention of an eccentric boss and rods and levers, as described in prior patents. "For the efficient agency of this machine," said Lord Westbury, "it has been found necessary that there should be a shaft with cams upon it, and it has also been found necessary that there should be some means of arresting the shaft, staying the shaft once or twice, or even four times, during a single rotation, thereby producing breaks or pauses for spaces of time in the rotatory motion of the shaft. These pauses or breaks have been at various times attempted to be produced in various ways. *Mr. Roberts* had one mode, namely, by the operation of a wheel with spaces. That proving not adequate to the end, another mode was discovered of breaking the rotatory motion, producing pauses in the rotation by the operation of a clutch box. The application of that to the shaft was made, as far as I am informed, in the first instance by the

(*f*) *Tweedale* v. *Ashworth*, 9 R. P. C. 126; per Lord Watson, p. 128.

(*g*) Ibid. p. 126.

(*h*) 11 L. T. (N. S.), 245, at p. 247.

patent of *Lakin* and *Rhodes*. *Mr. Wain* (the patentee) then applied himself to what he denominates 'an improvement upon the patent of *Lakin* and *Rhodes*.' Now, it has been vigorously contended before me, that I am not to take *Mr. Wain's* invention as he himself describes it, and that I ought not to allow him to be limited to his own description of its being an improvement; that I ought to take his invention as containing in itself a new and original principle. I cannot so take it. I must take *Mr. Wain's* patent as being specific mechanism, directed to a certain end that was previously well known; directed to facilitate a certain result, the benefit of which had long been discovered; directed to produce in a more simple and easy manner a particular operation of the clutch-box, which was itself only a means to an end. I cannot but think that in patents of this 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 other person is, on the same principle, entitled also 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."

In *Gosnell* v. *Bishop*, (*i*) Bowen, L.J., commenting on the above case, said: "What is the law laid down in *Curtis* v. *Platt*? Precisely what the Lord Justice has said, that where you get a specific mechanism directed to a certain end which was previously well known, directed to facilitate a previous result the benefit of which had been previously discovered, then in a patent of that description the doctrine of mechanical equivalents is not applicable, and that any other person is entitled to the use of old and known principles, provided he does not take substantially the means in which the excellence of the patent alone consists."

In *Garrard* v. *Edge*, (*j*) the invention related to improvements in presses for pressing tiles. Machines adapted to this purpose were well known and consisted of three principal parts: the box or lower die, the stamper or upper die, and the lifter. The plaintiff's mechanism contained all these common elements. The essence of his invention, however, was the reversibility of certain parts of the mechanism. The defendant's machine contained the same common elements, but its essence lay in the fact that certain

(*i*) 5 R. P. C. 159.

(*j*) 6 R. P. C. 563.

parts were renewable; and the patentee being limited to his special mechanism, this was held to be an independent mode of attaining the desired result, and no infringement. "The defendants," said Fry, L.J., "proceed by an entirely different mode of operation. They reject reversible plates. They say they reject them for a good reason, because they say the worn surface which has been used as the working surface does not make a good basis or support for the other surface when turned against the upper plate—the upper or lower as the case may be. That may be or may not be the case, but they do not proceed upon the use of a reversible plate. They proceed upon the principle of having renewable plates, and of enabling the person using the machine before that renewable plate has been obtained, or without putting it on to use the upper or the lower surface, as the case may be, of the stamper or the lifter as itself a working surface. I think, therefore, that the whole machine—the combination—has not been taken, and that no essential part of it has been taken." (*k*)

In *Richardson* v. *Castray*, (*l*) the invention related to an apparatus for manufacturing wine glasses. Part of the patentee's contrivance consisted of two boards connected by a hinge and spring, so as to be self-acting. The object aimed at being old, the inventor was held to be limited to his special mechanism, and to have no remedy against persons using a mechanism consisting of two boards hinged and fitted with a loop which acted as required on the pressure of a workman's hand.

In *Tweedale* v. *Ashworth*, (*m*) the invention related to that part of a carding machine which is known as a "flat." 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 called its foundation. For the efficiency of the carding machine it is necessary that the surface of the brush shall be perfectly level, and remain so in course of working. The attainment of this result had been found to depend on the manner in which the foundation of the brush was fastened to the bar of metal upon which it rested. At the date of the patent there were two known modes of attachment, rivets, or stitching with wire thread. Both methods were liable to result in a puckering of the foundation, and inequalities in the surface of the brush. The plaintiff's invention consisted in effecting the necessary fastening

(*k*) 6 R. P. C. p. 569.
(*l*) 4 R. P. C. 265.
(*m*) 7 R. P. C. 426; 8 R. P. C. 49; 9 R. P. C. 121.

by thin strips of metal, one on each side of the bar, used in the following manner. One edge of each strip was moulded so as to grip firmly the outer edge of the foundation, the other edge of the strip being moulded so as to fit and grip a ridge cast upon the back of the bar. After a strip had been so 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, while the edges of the foundation were, by the encasing metal, protected from fraying and from becoming a receptacle for waste.

The defendants effected their attachment first by the use of a metallic clip on one side of the bar. They then by means of a steel comb stretched the elastic material to the other side, where, by applying a similar clip, they held it in position. This, having regard to the narrow ambit of the invention, was held in all the Courts to be no infringement.

"The plain object of the invention as described in the specification," said Lord Watson, "is to substitute better mechanical equivalents for those already known and used as a means to the same end. It follows that, in construing the appellant's specification, the doctrine of mechanical equivalents must be left out of view. He cannot bring within the scope of his invention any mechanical equivalent which he has not specifically described and claimed." (*n*)

In *Nettlefolds* v. *Reynolds*, (*o*) the patentee had described his invention as comprising "a rotating cylindrical die and a stationary curved die employed for progressively forming helical threads upon screw blanks, which are caused to roll round the concave face of the stationary die." The specification referred throughout to rotary machines and no others. That metal screws could be made by pressure was well known at the date of the patent, and having regard to the existing state of knowledge the only patentable novelty in the plaintiffs' invention was the particular method of making screws by rotating cylindrical dies working against circular fixed dies cut and used as described in the specification. The defendant's machine also made screws by pressure, which resembled in all respects those of the plaintiffs, but the dies used in his machine were straight, not cylindrical, and were made to pass backwards and forwards over one another, each die moving

(*n*) 9 R. P. C. 128.

(*o*) Ibid. 270.

and assisting to form the thread upon the screw. This, in the circumstances, was held to be no infringement, as in such case the doctrine of mechanical equivalents did not apply. "This," said Romer, J., "is not in my judgment a case where the plaintiffs can invoke in their favour the principle with reference to infringements commonly called that of mechanical equivalents. To establish a case of that kind, where an improvement in detail in a well-known class of machines alone is patented, the Courts appear to have thought that as a rule the patentee ought to shew one of two things: first, that a new article has been produced by the patented invention; or secondly, if not, that then some new and valuable principle was involved in, or was first brought into public use by the invention. I find neither of these grounds here." (*p*)

In the *Ticket Punch Register Company* v. *Colley*, (*q*) the invention related to ticket punching machines. The plaintiffs' improvement was a peculiar mode of holding back, and then releasing the punch in the machine by which the punching of the ticket and the registering of the punch were effected at one time. This they achieved by a very ingenious locking device, by which the punch was held back until released by the rising of a pin in it, this rising being caused by the insertion of the ticket. The fundamental idea, the essence, of the invention was first holding the punch back and then releasing it. The defendants attained the same result, but in an essentially different way. They did not lock or hold back their punch at all, but started with an unlocked machine. It was argued by the plaintiffs that the result being the same the defendants' device was a mere equivalent for the plaintiffs', and therefore an infringement. Rejecting this contention, Lindley, L.J., said: "Before any question of mechanical equivalents can arise, the conclusion must be arrived at that the substance of the invention has been taken. Then, if the differences are really immaterial, from that point of view, they ought to be neglected. But if two persons solve the same mechanical problem in two substantially different ways, starting from different conceptions, and both succeed, neither method of solution can be treated as the mechanical equivalent of the other, although each method may involve the use of well-known contrivances, and much may therefore be common to both." (*r*)

It must always be remembered that where the alleged

(*p*) 9 R. P. C. p. 285.
(*q*) 12 R. P. C. 171; see, also, *Jardine* v. *King, Mendham & Co.*, 13 R. P. C. 411, 615.
(*r*) 12 R. P. C. 184.

infringement omits the essential feature of the patented invention there is no invasion of the patentee's monopoly; therefore in such case the doctrine of mechanical equivalents has no application. (*s*)

New Process Aimed at an Old Result.—So likewise where the invention is a new process for attaining an old result, the patentee is entitled only to protection for his process, and it is no infringement to attain the same result by a different process.

In *Hutchinson* v. *Pattulo*, (*t*) the invention was an improved treatment of oils and fats for lubricants, the object being to thicken the oil. The patentee's method was to subject the oil or fat to the action of heat while exposed to the air in shallow layers. The defenders attained the same result by heating the oil with steam, and blowing air through it when so heated, and this was held to be no infringement.

New Combination Directed to Achieve a New Result.—Where, however, a new combination of well-known appliances is directed to the attainment of a new result, the patentee, as above mentioned, is not limited to the precise combination which he has patented, but is allowed a wider ambit for his monopoly.

In *Proctor* v. *Bennis*, (*u*) the plaintiff's patent was for an improved mechanical stoker, which, by a self-acting mechanism, distributed coal at intervals over the fire surface. Other mechanisms had been invented before, for feeding coal into furnaces automatically, but the means employed under the plaintiff's patent were altogether new; the result being produced by the intermittent radial action of a flap or door. By this device the plaintiff was able to obtain not only better but new results. The mechanism consisted in the employment of tappets, shafts, and springs, in connection with doors. The defendant did not use the identical apparatus of the plaintiff, but in both machines the automatic motion was radial, and in both it was intermittent. In both the radius was moved in one direction by tappets, and in the opposite direction by a spring. There was this difference, however, in the plaintiff's machine, the shaft was impelled by the tappets and by the spring, in the defendant's the radius itself was so impelled. Hence the radius in the plaintiff's machine was attached to the shaft, whereas in the defendant's it

(*s*) See *Pneumatic Tyre Co.* v. *Tubeless Tyre*, 15 R. P. C. 236; 16 R. P. C. 77; *Allen* v. *Abraham Pyatt & Co.*, 15 R. P. C. 723; 16 R. P. C. 135; *Cooper* v. *Baedeker*, 16 R. P. C. 363; *Griffiths* v. *Birmingham Stopper Co.*, 16 R. P. C. 383.

(*t*) 5 R. P. C. 351.

(*u*) L. R. 36 C. D. 740, 764; 4 R. P. C. 333; 57 L. J. Ch. 11, 24.

worked on a pin. Thus, all the defendant did by way of variation was to substitute the pin for the shaft as the centre on which the radius acted, and by impelling the radius itself instead of impelling the shaft fixed to the radius, he produced in substance precisely the same radial action as was produced in the plaintiff's machine. The Court of Appeal held this to be a clear infringement, the variations being mere mechanical equivalents.

"Now, in *Curtis* v. *Platt* (*v*) and other cases," said Bowen, L.J., "it has been said that where the patentee has claimed a particular mechanical device for effecting the object in view, he must be held strictly to that device. But when you are considering an absolutely new invention with a novel result, you cannot apply that rule without recollecting that the result effected is new, as well as the combination, and that when there is really an ingenious novelty in the idea that the combination will produce a new result, that novelty in the idea is part of the merit of the very combination." (*w*)

A patent for a combination of old and well-known elements may therefore have some novel principle underlying it, which will entitle the patentee, not only to protection against infringement by the use of the identical combination, but also against infringement of the combination (so far as it embodies that novel principle) by mechanical equivalents.

This rule is well illustrated in the series of cases in which the *Automatic Weighing Machine Company* sued for infringements of *Everitt's* patent.

Everitt's invention was a combination of weighing mechanism with a coin mechanism for weighing and recording weights. (*x*) Weighing mechanism, indicating mechanism, and the use of a coin to actuate machinery, were all well known. But the patentee's combination was so contrived that there was a break in the connection between the weighing mechanism and the indicating part of the machine which recorded the weight. Hence, while the weighing part of the mechanism acted whenever the person to be weighed stepped on to the platform of the machine, the result remained concealed from view until the break in the connection with the indicator was made good. Dropping a penny into a slot in the machine completed this connection by freeing a stop, and

(*v*) 11 L. T. (N. S.), 245.

(*w*) 4 R. P. C. p. 359; see, also, Smith, L.J., in *Ticket Punch Co.* v. *Colley*, 12 R. P. C. 171; *Aktiebolaget Separator* v. *Dairy Co.*, 15 R. P. C. 334; *Presto Gear Case Co.* v. *Simplex Co.*, 15 R. P. C. 642.

(*x*) See *The Automatic Weighing Machine Co.* v. *Combined Weighing Machine Co.*, 6 R. P. C. 120, 371.

so caused the weight to be shewn on the external face of an index dial. The Court held that underlying this combination was the novel principle of utilizing a break in the connection between the weighing and indicating mechanism for the purposes of automatic weighing, and that this was the essence of the invention, and that so far as that feature of the invention was concerned the patentee was entitled to protection against infringement by mechanical equivalents, although all the elements of the machine were old and well known.

In the *Automatic Weighing Machine Company* v. *The International Hygienic Society*, (*y*) the defendants' machine included a revolving dial, upon which the weight was marked when the person desiring to be weighed stepped on to the weighing platform. This dial was concealed by two shutters, carried by a spindle, disconnected with the weighing mechanism. The insertion of the coin operated a lever which moved the shutters away and disclosed the marking. This was held an infringement by mechanical equivalents.

In the machine of the *Combined Weighing Machine Company*, (*z*) a coin and weighing mechanism were also combined. But the mechanism did not ascertain the weight the moment the person to be weighed stepped on to the platform of the machine. A coin had first to be placed in position, and driven in by external pressure on a push-piece: this operation, by liberating a catch, freed the mechanism, and set the machine in motion. This also was held to be an infringement. "The sole question, it seems to me," said Kekewich, J., "that I have to decide is—is that difference, is that necessity of applying the pressure by means of the external button, sufficient to distinguish one machine from the other? To my mind it is a trivial difference, and to say that it made a distinction between the two machines would be to uphold a colourable difference; and whatever ingenuity may attach to the defendants' machine, however honest it may be as an independent discovery, I think that, according to law, it cannot be allowed to be used when the plaintiffs have a patent for what I consider to be substantially, though not precisely, the same thing." (*a*)

In the *Automatic Weighing Machine Company* v. the *National Exhibitions Association, Limited*, (*b*) the weighing and recording

(*y*) 6 R. P. C. 475.

(*z*) *The Automatic Weighing Machine Co.* v. *The Combined Weighing Machine Co.*, 6 R. P. C. 120, 371.

(*a*) Ibid. p. 125.

(*b*) 8 R. P. C. 345; 9 R. P. C. 41.

parts of the mechanism were also separated in the defendants' machines. Here, too, a coin was used, which, entering the slot, fell down a shoot, and pressed a spring contact against a fixed contact piece, and thus permitted a current of electricity to flow, which energized a magnet. This magnet so energized attracted the armature of a lever, and by releasing an arm brought the indicating mechanism into operation, which, on being set in motion, followed the weighing mechanism, and so recorded the weight. This likewise was held to be an infringement.

In the *Automatic Weighing Company* v. *Fearby*, (*c*) the defendant's weighing and indicating mechanisms were likewise disconnected. The insertion of a penny formed a coupling between an exterior handle and a lever. This handle, if then turned by the person being weighed, moved the lever, and drew down an arm; by this operation the indicating mechanism was set free, and falling down by its own weight followed the weighing mechanism, and shewed the result. This, following the last case, Romer, J., also held to be an infringement as containing the three ingredients of the plaintiffs' combination, viz. a break in the weighing and indicating mechanism, the use of a penny to allow the indicating by gravity to follow the weighing part, and an arrest of the indicating mechanism at the same point as that reached by the weighing part.

With these cases may be compared the case of the *Automatic Weighing Machine Company* v. *Knight*. (*d*) The defendant's machine in that case had no break between the weighing and indicating mechanisms; but was so contrived that a stop was put on the whole machinery—weighing and indicating alike. Hence the mechanism would not act until a lever was raised which the stop held in position. The dropping of a penny into the machine removed this stop, and so released the lever. The machine, formerly locked, thus became free, and all the mechanism acted at once. This was held an independent contrivance, and no infringement of the company's patent. "It appears to me not to be an infringement or anything near it," said Lindley, L.J. (*e*) "It is not a mere variety of indicating apparatus. It is not using the penny actuating apparatus which the plaintiff has adapted to the indicating part of the weighing machine at all, but it is seizing the general idea of dispensing with an attendant—seizing the general idea of applying to weighing machines the use of a penny, an idea which, as applied to various forms of mechanism, is extremely old, and applying the thing in a totally different way. There is no colourable imitation of it.

(*c*) 10 R. P. C. 442. (*d*) 6 R. P. C. 113; 297. (*e*) 6 R. P. C. 309.

It is a different mechanism applied not to the indicating apparatus at all, but to something totally different."

Equivalents must be Known as such at Date of the Patent.—The doctrine of infringement by equivalents is subject, however, to this limitation, which will be found principally to apply in the case of chemical patents, that the equivalents used must be such as were known to be equivalents at the date of the patent; otherwise they constitute new discoveries, and as such may themselves be made the subject-matter of a patent grant.

In *Heath* v. *Unwin*, (*f*) Parke, B., said: "The specification must be read as persons acquainted with the subject would read it at the time it was made; and if it could be construed as containing any chemical equivalents, it must be such as are known to such persons at that time; but those which are not known at the time as equivalents, and afterwards are found to answer the same purpose, are not included in the specification; they are new inventions." In the same case, Williams, J., said: "There is ample evidence that to melt together oxide of manganese and carbonaceous matter with steel and iron, will serve as an equivalent for the melting together of carburet of manganese with steel or iron in producing the desired result. But there is no evidence that at the time of the patent and specification this was known to persons of ordinary skill in chemistry. And I fully agree with the doctrine which has been repeatedly laid down in the course of the discussion of this cause, that though the use of a chemical or mechanical substitute which is a known equivalent to the thing pointed out by the specification, and claimed as the invention, amounts to an infringement of the patent; yet, if the equivalent were not known at the time of the patent and specification, the use of it is no infringement." (*g*)

In *Nobel's Explosives Company* v. *Anderson*, (*h*) the plaintiffs' patent was for improvements in the manufacture of explosives. The invention consisted in combining nitro-glycerine and nitro-cellulose (soluble in ether-alcohol), in a horny substance capable of being reduced to grains suitable for use as a propeller of projectiles. These two highly explosive substances so combined tamed each other, and resulted in a product called "ballistite." The defendant made a powder called "cordite," which was formed

(*f*) 5 H. of L. Ca. 505, at p. 538; 25 L. J. C. P. 8; 13 M. & W. 583.

(*g*) 2 W. P. C. 302. See these principles applied by Pearson, J., in *Badische Anilin* v. *Levinstein*, 24 Q. B. D. 170. See, also, *Stevens* v. *Keating*, 2 W. P. C. 189; *Fabriques de Produits Chimiques de Thann* v. *Caspers*, 15 R. P. C. 94.

(*h*) 11 R. P. C. 115, 519.

by combining nitro-glycerine with *insoluble* nitro-cellulose. It was contended by the plaintiffs that this was the mere use of a chemical equivalent, and an infringement of their patent. Romer, J., and the Court of Appeal held, however, that insoluble nitro-cellulose was not known to be an equivalent of soluble nitro-cellulose at the date of the plaintiffs' patent, that the fact that it could be safely combined with nitro-glycerine was a new discovery, and that the defendant had not infringed. In the House of Lords this decision was affirmed. Lord Herschel, C., said: "No doubt there may well be cases where a chemical compound patented would protect against the manufacture of the compound in which one of the ingredients differed, where there had been a substitution for one chemical ingredient of that which was known to all chemists to be a mere chemical substitute for the other, producing the same reactions, it might be, or in some other way recognized as the equivalent of the other, so that any chemist would know that merely to change this particular ingredient, and substitute the other for it would make no real difference in the compound. . . . But what is the evidence that in 1888 any chemist would have known that wherever soluble was mentioned in this patent insoluble might be understood as a substitute in its action in all respects equivalent to the other? The evidence seems to me to be the other way." (*i*)

A patentee is under no obligation to inform persons infringing his patent that they are invading his rights. If he does not do so, he does not thereby preclude himself from subsequently suing such infringers. (*j*) It is otherwise, however, where by his own conduct he induces the commission of an infringement, as by sending an agent to purchase the article on the sale of which he intends to sue." (*k*) Whether or not an infringement has been committed is usually a mixed question of law and fact. Though cases may arise in which the absence of any evidence of infringement is so clear that the Court would properly hold that there was no case for the defendant to answer. (*l*)

"The question of infringement," said Lord Wensleydale, in *Seed* v. *Higgins*, (*m*) "is one of mixed law and fact. The construction of the specification is for the Court, with the aid of such facts as

(*i*) 12 R. P. C. 167, 168.

(*j*) Per Cotton, L.J., in *Proctor* v. *Bennis*, 4 R. P. C. 333; 36 C. D. 740, at 760; 57 L. J. Ch. 11.

(*k*) *Kelly* v. *Batchelar*, 10 R. P. C. 289; *United Telephone* v. *Henry*, 2 R. P. C. 11; but see *Dunlop Pneumatic Tyre Co.* v. *Neal*, 47 W. R. 632; 80 L. T. 746.

(*l*) See *De La Rue* v. *Dickenson*, 7 E. & B. 738.

(*m*) 8 H. of L. Ca. p. 565; 30 L. J. Q. B. p. 317.

are admissible, to explain written documents. In deciding whether there has been an infringement, there is a question of fact wholly for the jury, viz. what the defendants have done; and if scientific evidence is necessary fully to elucidate the case on either side, it is, no doubt, admissible; and, in determining the question of infringement, the judge must apply what the jurymen find to be true. The opinion of scientific witnesses is only 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. The Court alone is to decide questions of law."

"Where infringement," said Lord Campbell, C., in the same case, (*n*) "depends merely on the construction of the specification, it is a pure question of law for the judge; but where the consideration arises, how far one machine, or a material part of one machine, imitates or resembles another in that which is the alleged invention, it generally becomes a mixed question of law and fact, which must be left to the jury."

In deciding whether or not there has been an infringement, the Court will consider all the circumstances of the case. Thus, the fact that the infringer was at one time a workman in the employment of the plaintiff, and familiar with the plaintiff's invention, is a móst material circumstance.

In *Crampton* v. *Patents Investment Company*, (*o*) Lord Esher, M.R., said: "When you come to talk of an infringement, you must look at all the circumstances of the case. Here you find that the plaintiff was a workman in a manufactory where this patent of the defendant was being carried out. You find that this workman suddenly leaves that employment, suddenly goes into business to sell electric bells, without informing his employer; you find that he not only goes into business to sell electric bells, but that he takes out a patent himself. When you look at that patent of his, about which he never said anything to anybody, you find that it is as nearly as possible the same as the defendant's, or you find that it is so like it that it requires all the skill of the learned counsel who has argued before us to discover any difference in it."

(*n*) H. of L. Ca. p. 561.

(*o*) 6 R. P. C. 294.

CHAPTER XXII.

REMEDY OF THE PATENTEE.

ACTION FOR INFRINGEMENT OF THE PATENT RIGHT.

Introductory.

Former Remedies.—The general principles of the law of infringement have already been discussed. The remedies open to a patentee for the protection of his monopoly when invaded will now be considered.

These remedies, to be effectual, must be twofold: they must ensure alike compensation for the wrong sustained, and protection against the recurrence of the injury.

Prior to the Statute of Monopolies, a jurisdiction in protection of patent rights was exercised by the Court of Star Chamber, which treated persons invading such monopolies as being guilty of a contempt of the royal prerogative. (*a*)

By the Statute of Monopolies, however, it was enacted that all questions affecting the force and validity of letters patent should be heard, tried, and determined in the Courts of Common Law, according to the common laws of the realm, and not otherwise. (*b*) Thus the jurisdiction of the Star Chamber, which had often been used oppressively, was taken away, and the patentee was left to vindicate his patent rights only in Courts where their validity could be tested by the rules of the common law.

But just as the Court of Star Chamber had proved an unsatisfactory tribunal to the public as against the patentee, so the Courts of Common Law proved unsatisfactory to the holder of the patent right; for while they gave him damages against an infringer, they had no jurisdiction to order an account of the profits of the wrong-doer (if the plaintiff preferred that relief), or an injunction to restrain the recurrence of the injury. Where the

(*a*) See Webster's *Letters Patent*, p. 42, n.; also Coryton's *Treatise*, p. 262.

(*b*) 21 Jac. I. c. 3, s. 2.

law thus failed the patentee, equity came to his aid by granting him discovery, an account, and an injunction. (*c*)

But equity followed the law; therefore, inasmuch as a patent was a legal privilege granted upon the *ex parte* representation of the grantee, and never guaranteed to be valid by the Crown, it was necessary, where an infringer challenged the validity of the patent, to afford him an opportunity of testing the patentee's title in a Court of law before equity granted him final relief. This meant putting the plaintiff on terms to bring an action in one of the Common Law Courts. But time was required to prosecute an action at law, and during the period of delay involved, the continued infringements of the defendant might be doing the patentee most serious injury. Hence it became the practice of the Court of Chancery to grant the further remedy of interlocutory relief for the purpose of protecting the patentee's property till the legal right could be ascertained. (*d*) To do this, the Court assumed, for the time being, the validity of the plaintiff's patent, and, on that basis, granted an injunction to protect it. But in order that this assumption might be tested, it put the plaintiff on terms to bring an early action at law, so that the defendant might be able to test the validity of the patent right. The inconvenience of this system of relief, under which the patentee was sent first to one Court and then to another before he could get satisfaction, led to enactments which gave jurisdiction to the Courts of Common Law, on the one hand, to grant injunctions, (*e*) and to Courts of Equity on the other, to determine every question of law and fact incident to the relief claimed. (*f*)

The effect of this legislation was to withdraw the trial of patent actions almost entirely from the Common Law Courts. Referring to the first of these enactments, the Patent Law Amendment Act, 1852, (*g*) Lord Westbury, C., in *Young* v. *Fernie*, said: "I construe the Statute as laying down the rule for the future, that these things shall be heard and determined in this Court. . . . I do not think that anything more inconvenient can be suggested than that where there are mixed questions of law and fact, the one bound up with the other and scarcely capable of being separated, an attempt should be made to cut the cause

(*c*) See Cotton, L.J., in *Proctor* v. *Bailey*, 6 R. P. C. 541, 542; 59 L. J. Ch. 12, 13.

(*d*) *Harman* v. *Jones*, 1 Cr. & Ph. 299.

(*e*) See 15 & 16 Vict. c. 83, s. 42; *Gillins* v. *Symes*, 15 C. B. 362; 24 L. J. C. P. 48.

(*f*) 15 & 16 Vict. c. 86, ss. 61, 62; 21 & 22 Vict. c. 27; 25 & 26 Vict. c. 42, s. 2.

(*g*) 15 & 16 Vict. c. 83.

in halves, and to send one-half of it to be tried by a jury in a Court of Common Law, reserving the other half for determination in this Court." (*h*)

Present Remedies—The Tribunal.—By Section 30 of the Patents Act of 1883, (*i*) it is now enacted that, "*In an action for infringement of a patent, the Court or a judge may, on the application of either party, make such order for an injunction, inspection, and account, and impose such terms and give such directions respecting the same and the proceedings thereon as the Court or a judge may see fit.*" (*j*) The words in this Act, "Court or a judge," are sufficiently wide to include all the judges of the High Court, whether sitting in the Queen's Bench or Chancery Division, but owing to the additional facilities afforded by the practice on the Chancery side, for the trial of the questions usually involved in patent disputes, actions concerning the infringement of patent rights are now generally tried in that Division.

By the same Statute actions for infringement of letters patent are now tried without a jury, unless the Court directs otherwise. (*k*) Such actions nearly always involve mixed questions of law and fact, and often depend largely on the construction of written documents, which it is the province of the Court to determine. Moreover, any questions of fact involved are generally of a scientific nature, requiring for their solution the close application of a trained mind to the evidence, and are therefore matters as to which a jury would probably in any case follow the direction of the judge. (*l*) Hence now, unless some issue of fraud arises, there would seem to be little reason for having recourse to a jury in the trial of patent actions.

The Court, if it thinks fit, may have the assistance at the trial of a specially qualified assessor, and either party has the right to require that an assessor shall be called in. The remuneration to be paid to such assessor is determined by the Court. (*m*) Hitherto the assistance of an assessor has been little sought.

Although patent actions are now usually entered in the Chancery

(*h*) 1 De G. J. & S. 354; 1 H. of L. 63.

(*i*) The former equitable and common law jurisdictions are now vested in the judges of the High Court, and where the rules of law and equity conflict those of equity are to prevail (see Judicature Act, 1873, s. 25 (11)).

(*j*) See, also, the Judicature Act, 1873, s. 25 (8).

(*k*) Patents Act, 1883, s. 28 (1).

(*l*) As to the unsuitability of a jury for the trial of these cases see Lord Selborne in *Patent Marine Inventions Co.* v. *Chadburn*, L. R. 16 Eq. 448. A jury was ordered in the following cases: *Young* v. *Rosenthal*, 1 R. P. C. 29; *Westinghouse* v. *Lancashire Railway*, 1 R. P. C. 229; *Edge* v. *Harrison*, 8 R. P. C. 74.

(*m*) Patents Act, 1883, s. 28 (1) & (3).

Division of the High Court, they may be sent down for trial to the Assizes, if, by reason of the residence of the parties or from some other cause, it is more convenient to have a local venue. (*n*)

In addition to the judges of the High Court, the Vice-Chancellor of the County Palatine of Lancaster has jurisdiction to try patent actions. (*o*) But County Courts have not the machinery suitable for trying such cases, and their jurisdiction would seem by implication to be excluded by Section 9 of the Patents Act, 1883. Moreover, as a patent is in the nature of a franchise, a County Court judge could not try any action in which the validity of a patent was put in issue. (*p*)

The Parties to the Action.

Plaintiffs.—In an infringement action the general rule is that all persons having any interest, whether legal or equitable, in the letters patent ought to be before the Court, and where not willing to be plaintiffs should be joined as defendants. The reason is that where an account may be ordered or damages given, it is expedient that the account should be taken or the damages assessed once for all in the presence of all parties interested. (*q*) Hence, where an injunction and delivery up or destruction of the infringing articles only are claimed, one of several owners may sue alone, without joining his co-owners, for such a course in no way prejudices a defendant, (*r*) against whom neither an account nor an enquiry as to damages is sought.

Again, where a patent has been mortgaged, the mortgagor may sue alone without joining his mortgagee. For in equity the mortgagor is still regarded as the owner, and the fact that his rights are to a certain extent vested in another person does not prevent him from suing to stop an infringement of them. (*s*)

So likewise, if an invention can be severed into distinct portions, the owner of one portion may sue alone for infringements of that

(*n*) *Fairbairn* v. *Household*, 2 R. P. C. 195; *Edmond's Patent*, 6 R. P. C. 355; *Leadbeater* v. *Kitchen*, 7 R. P. C. 235; *Varey* v. *Walker*, 16 R. P. C. 596.

(*o*) 53 & 54 Vict. c. 23. This jurisdiction (claimed before) was expressly conferred upon the Lancaster Court by the above Statute. No similar enactment has been passed giving a like jurisdiction to the Palatine Court of Durham.

(*p*) See *R.* v. *County Court Judge of Halifax* [1891], 2 Q. B. 263; 60 L. J. Q. B. 550; 8 R. P. C. 338.

(*q*) *Bergmann* v. *Macmillan*, 17 C. D. 423; *Dent* v. *Turpin*, 2 J. & H. p. 143; 30 L. J. Ch. 495; *Davenport* v. *Richards*, 3 L. T. (N. S.), 503; *Westhead* v. *Keene*, 1 Beav. 295; 8 L. J. Ch. 89.

(*r*) *Dent* v. *Turpin*, 2 J. & H. p. 143. See, also, *Sheehan* v. *Great Eastern Railway Co.*, 16 C. D. 59; 50 L. J. Ch. 68. It seems doubtful how far this case is now an authority.

(*s*) *Van Gelder* v. *Sowerby*, 7 R. P. C. 208; 44 C. D. 374; 59 L. J. Ch. 583; *Fairclough* v. *Marshall*, L. R. 4 Ex. D. 37.

part, for all damages recoverable in respect of such infringement would in any case belong to him, and not to the owners of the other portions of the patent. (*t*)

A mere licensee of a patent is not a person having an interest in the patent, he is only a person permitted to use the invention, and thus able to do lawfully that which but for his license would be an unlawful act. He cannot therefore sue an infringer, and the circumstance that his license is exclusive will not entitle him to do so. "The license, pure and simple and by itself," said Fry, L.J., in *Heap* v. *Hartley*, (*u*) "never conveys an interest in property; it only enables a person to do lawfully what he could not otherwise do, except unlawfully. I think therefore that an exclusive licensee has no title whatever to sue."

Although a licensee cannot sue third persons for infringements of the patent right, he can, if his licence is irrevocable and exclusive, maintain an action against his licensor where such person acts in breach of the licence so exclusively given. (*v*)

Nor is a mere agent for the sale of the patented article entitled to bring an action against an infringer. (*w*)

A legal assignee of the patent may sue for its infringement; (*x*) but before doing so he should be careful to complete his title by registration, though, once the assignment is registered, he may recover damages as from the actual date of assignment. (*y*)

The action may also be brought by the assignee or trustee of a bankrupt patentee, (*z*) and by any person in whom the letters patent are vested as trustee for beneficiaries; (*a*) also by an equitable assignee. (*b*)

Where a patent is vested in several persons as tenants in common, and one dies, the right of action in respect of infringements already committed survives to the others, who may recover the whole of the damages. (*c*)

(*t*) See Erle, C.J., in *Dunnicliffe* v. *Mallett*, 7 C. B. (N. S.), 209; 29 L. J. C. P. 70; *Van Gelder* v. *Sowerby*, 7 R. P. C. 208; 44 C. D. 374; 59 L. J. Ch. 583.

(*u*) 42 C. D. 461; 5 R. P. C. 603; 6 R. P. C. 495; 58 L. J. Ch. 730; see, also, *Derosne* v. *Fairie*, 1 W. P. C. 155; *Newby* v. *Harrison*, 1 J. & H. 393; cited 2 H. & M. p. 633; but see contra, *Renard* v. *Levinstein*, 2 H. & M. 628; *Thorn* v. *Worthing*, 6 C. D. 415, n.

(*v*) *Guyot* v. *Thomson*, 11 R. P. C. 541; [1894] 3 Ch. 388; 64 L. J. Ch. 32; 71, L. T. (N. S.), 416.

(*w*) *Adams* v. *North British Railway Co.*, 29 L. T. (N. S.), 367.

(*x*) *Electric Telegraph Co.* v. *Brett*, 20 L. J. C. P. 123; 10 C. B. 838.

(*y*) *Chollet* v. *Hoffman*, 26 L. J. Q. B. 249.

(*z*) *Bloxam* v. *Elsee*, 6 B. & C. 169; 1 C. & P. 558.

(*a*) R. S. C. Order 16, rule 8.

(*b*) *Actien Gesellschaft* v. *Temler*, 16 R. P. C. 447.

(*c*) *Smith* v. *London & North Western Railway Co.*, 2 E. & B. 69; Macr. P. C. 203.

Where a patent is granted to two persons jointly and one dies the grant passes by survivorship to the other, in whom the whole interest becomes vested, and who alone thereafter can give effect to any prior agreement entered into by both owners for its assignment. (*d*)

In this respect a patent does not differ from other property. "It was scarcely disputed," said Cozens-Hardy, J., in the *National Company* v. *Gibbs*, "that a grant, whether by the Crown or by a private individual, of any ordinary species of property to *A. B.* and *C. D.*, their executors, administrators, and assigns, would create a joint tenancy or joint interest, and not an interest in common. This is not a rule of tenure or of real property law. It applies to an assignment of a policy of assurance as much as to an assignment of a term of years. But it was urged that letters patent are of such a peculiar quality and nature that different principles of interpretation ought to be applied. I am unable to follow this argument. The right or privilege granted by the Crown by the letters patent is an exception from the general prohibition contained in the Statute of Monopolies. It is for all purposes to be regarded as property. It passes in bankruptcy as part of the assets of a bankrupt. On the death of a patentee duty is payable on it as part of the assets of the deceased, and I can see no justification in principle, nor has any authority been produced, for holding that a grant for letters patent to two persons, their executors, administrators, and assigns, creates anything more than a joint interest, which will survive on the death of one of them, unless there has been severance of the joint interest." (*e*)

Defendants.—The actual infringer is the proper defendant. Thus, where the infringement occurs in the course of work done under a contract, the contractor who carries out the work, and not the architect who indicates what is to be done, is the person who ought to be sued. (*f*) Custom House agents, who arrange for the storing and transhipment in an English port of an article which infringes an English patent, do not thereby make themselves liable as infringers, and ought not to be joined as defendants. (*g*) But carriers who bring infringing articles into England are liable, and may be restrained by injunction. (*h*)

(*d*) *National Co.* v. *Gibbs*, 16 R. P. C. 339: but see this case in C. A. 16 T. L. R. 348.

(*e*) Ibid. p. 343.

(*f*) *Denley* v. *Blore*, 38 *London Journal*, 224.

(*g*) *Nobel's Explosives Co.* v. *Jones*, 8 App. Ca. 5; 50 L. J. Ch. 582.

(*h*) *Washburn Manufacturing Co.* v. *Cunard Co.*, 6 R. P. C. 403.

A person who merely prepares the materials from which the infringing article is made is not liable as an infringer, and should not be joined as a defendant. (*i*)

Thus, where a machine had been altered so as, in fact, to become an infringement of letters patent, it was held that an action would not lie against a smith who did nothing more than find the materials required for the alteration. (*j*)

The directors of a public company may be liable for acts of infringement committed by workmen employed in their service, even where such workmen have acted in disobedience to express orders. Although the master in whose employment the infringement is committed is the proper defendant, his servants by whom he has committed the breach of patent right are equally liable, and may themselves be joined as defendants. If so joined, it is no answer for them to shew that in what they did they only conformed to the orders of their employer. (*k*)

In *Sykes* v. *Howarth*, (*l*) where the patent consisted in the application of cards or strips of leather covered with wire to rollers at wide distances, a person who contracted to clothe rollers and supplied to a "nailer" cards of such width that when applied to the rollers they must of necessity leave wide spaces, and who himself paid the nailer and so made him his agent for putting them on, was held to have infringed the patent, though he alleged that his business was that of a card-maker only and did not include the nailer's work.

Where an infringing manufacturer sells the patented article, both the manufacturer who makes and the purchaser who uses the infringement are liable to the patentee and may be joined as co-defendants in one action, (*m*) the patentee being entitled to an account against the manufacturers and damages against the person using the article wherever it be found. (*n*) For a judgment obtained against the manufacturer does not operate to license the use of the illicit articles sold by him in the hands of purchasers. So long as the articles are used there is continuing damage, and the patentee is entitled to follow them into every man's hand. (*o*)

But where a plaintiff company sued the makers of piratical

(*i*) *Townsend* v. *Haworth*, 12 C. D. 831, n.

(*j*) *Savage* v. *Brindle*, 13 R. P. C. 266.

(*k*) *Betts* v. *Neilson*, 6 N. R. 221; *Betts* v. *De Vitre*, L. R. 3 Ch. 429; 37 L. J. Ch. 325; *Adair* v. *Young*, 12 C. D. 18.

(*l*) L. R. 12 C. D. 826.

(*m*) *Proctor* v. *Bennis*, 36 C. D. 740; 4 R. P. C. 333; 57 L. J. Ch. 11.

(*n*) *Penn* v. *Bibby*, L. R. 3 Eq. 308; 36 L. J. Ch. 277.

(*o*) Ibid.

articles, and on motion for an interlocutory injunction accepted an order under which the defendants paid certain sums into court to represent royalties, and undertook to keep an account till the trial, it was held that no interlocutory injunction could be obtained by the plaintiff company against customers who had purchased the infringing articles from the first defendants, to restrain them from using such articles. (*p*)

Although foreign subjects committing acts of infringement in the United Kingdom are liable to be sued therefor, (*q*) the Court has refused to allow property of a foreign Sovereign which was an infringement of an English patent to be detained in this country against the will of that Sovereign (*r*).

It frequently happens that a patentee finds that his rights are being infringed by several persons at the same time. In such case he is in the difficult position of having to either commence a number of actions at once, or incur the risk if he only proceeds against one infringer in the first instance, of being refused interlocutory relief in the other cases on the ground of delay. The most prudent course for a patentee to adopt under such circumstances was indicated as follows by Wood, V.C., in *Bovill* v. *Crate*. (*s*) "After getting information of case after case of infringement, he might select that which he thought the best in order to try the question fairly, and proceed in that case to obtain his interlocutory injunction. He might write at the same time to all the others who were *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.' I do not think any Court could complain of a patentee for taking the course I am suggesting. That is one way in which the difficulty might be avoided."

In the *North British Rubber Co.* v. *The Gormully, etc., Company*, (*t*) it was argued that a patentee acting as above suggested might find himself in great difficulties, as the infringers might ignore his communications altogether, or meet them with a flat refusal.

(*p*) *Pneumatic Tyre Co.* v. *Goodman*, 13 R. P. C. 723.

(*q*) *Caldwell* v. *Vanvlissengen*, 9 Hare, 415; 21 L. J. Ch. 97.

(*r*) *Vavasseur* v. *Krupp*, L. R. 9 Ch. 351.

(*s*) L. R. 1 Eq. 388, p. 391.

(*t*) 12 R. P. C. 17.

On this Chitty, J., said: "According to my experience of mankind, that kind of offer is not met with the absolute refusal which counsel for the plaintiff assumed it would be encountered with. Then if there is no answer, and the defendants, or proposed defendants, are all desirous of throwing obstacles in the way of the plaintiff, and putting him to expense, the course appears to be that the plaintiff must issue as many writs as he finds necessary." (*u*)

In *Edison Bell Phonograph* v. *Hough*, (*v*) the plaintiffs stated that they had been harassed by numerous infringements by persons of no substance, who, when sued, contested the matter up to trial, and then disappeared. Stirling, J., while refusing an interlocutory injunction, made allowance for the hardship from which the plaintiffs suffered by requiring the defendant to pay a sum into court, and expediting the trial of the action.

Joinder of Parties.—Where parties who ought to have been joined as plaintiffs or defendants are not before the Court, the proper course is for the Court to direct that such parties shall be joined, and not to dismiss the action on the ground of their absence. (*w*). Whether any additional party ought to be joined will depend on the special circumstances of each particular case; the rule being, that if the presence of any further party is necessary to enable the Court to effectually and completely adjudicate upon and settle all the questions involved, such party should be joined. (*x*) Where a defendant, after the issue of the writ, sold his business to a company, and sought to join that company as co-defendants, leave was refused. (*y*)

But where a defendant who had been indemnified after action by the makers of articles, the use of which was complained of, applied to join such makers (under Order 16, rule 48) as co-defendants; this was done and costs were eventually given against such co-defendants on appeal. (*z*)

The Court will not, however, compel a plaintiff patentee to sue persons other than the original defendant, merely because such other persons are equally guilty of infringement.

In *Moser* v. *Marsden*, (*a*) the plaintiff sued the user of certain weaving machines, which he alleged were infringements of his

(*u*) 12 R. P. C. p. 21.

(*v*) 11 R. P. C. 594.

(*w*) *Van Gelder* v. *Sowerby*, L. R. 44 C. D. 391, p. 394; R. S. C. Order 16, rule 11.

(*x*) R. S. C. Order 16, rule 11.

(*y*) *Briggs* v. *Lardeur*, 2 R. P. C. 13.

(*z*) *Edison* v. *Holland*, 3 R. P. C. 396; L. R. 33 C. D. 497; L. R. 41 C. D. 28; 6 R. P. C. 243.

(*a*) [1892] 1 Ch. 487.

patent. Thereupon the maker of the machines (who claimed to manufacture them under a foreign patent of his own) sought permission to be joined as a defendant in the action, fearing that the original defendant would not properly contest the issue, and alleging that a verdict for the plaintiff would prejudice his interests by frightening away customers.

The Vice-Chancellor of Lancaster having made the order under a rule of the Palatine Court, identical with Order 16, rule 11, the Court of Appeal reversed his decision. "Can it be said," asked Lindley, L.J., "that the rule prevents the plaintiff from proceeding against a defendant without having to litigate with everybody who may be in any way affected, however indirectly, by the action? It appears to me that it does not. The counsel for the applicant grounded his argument on the allegation that *Montfort's* interest would be affected by the decision in this action. It is true that his interest may be affected commercially by a judgment against the defendant, but can it be said that it would be legally affected? Can we stretch the rule so far as to say that whenever a person would be incidentally affected by a judgment he may be added as a defendant? No case has been cited that goes so far as that: *Vavasseur* v. *Krupp* (*b*) and *Apollinaris Co.* v. *Wilson* (*c*) are the nearest to the present case. But in both those cases the proceedings affected the property of persons not before the Court. I can understand the application of the rule where the property of a third party is affected. He may well say, 'I am not to be deprived of my property in my absence.' But this case does not come up to that. In my opinion the Vice-Chancellor has construed the rule too widely." (*d*)

The Writ.

Commencement of the Action.—No action can be brought until the patent is sealed; nor in respect of any infringements committed prior to the publication of the complete specification. (*e*) In an infringement action the writ is generally endorsed with a claim for an injunction, an account or damages, and the delivery up or destruction of all infringing articles in the possession of the defendant. (*f*)

(*b*) 9 C. D. 351.
(*c*) 31 C. D. 632.
(*d*) [1892] 1 Ch. pp. 489, 490.
(*e*) Patents Act, 1883, ss. 13, 15.
(*f*) The rules governing the service of the writ are the same as those applicable to other actions in the High Court. As to endorsements, see forms, Appendix IV., post.

The defendant has eight days in which to enter an appearance after the service of the writ. Prior to the appearance of the defendant no further step can be taken in the action by the plaintiff without the leave of the Court. The plaintiff may, however, apply *ex parte* for an interim injunction. (*g*) Such an application should not be made except in cases of the greatest urgency. If made at all it should be made at once, otherwise it will not be granted. (*h*) The application may even be made before the service of the writ and leave obtained to serve notice of motion for an injunction with the writ, so as to save the time which would be lost in waiting for the defendant to appear. (*i*)

After the defendant has appeared the plaintiff may apply to the Court for an interlocutory injunction. In the Queen's Bench Division the application is made on summons to a judge at Chambers; in the Chancery Division, on motion in open court. (*j*) The object of an interlocutory injunction is to restrain the defendant until the trial of the action, or further order, from continuing the infringement complained of. An application for an injunction before the hearing of the action is a matter of practice and procedure within Section 1 sub-section 4 of the Judicature Act, 1895, and an appeal against its refusal lies direct to the Court of Appeal. (*k*)

The principles upon which the Court proceeds in granting or refusing this relief will now be considered in detail.

Interlocutory Relief.

Principles upon which the Court acts.—Where a patentee applies to the Court for relief by way of an interlocutory injunction, the Court, in adjudicating upon the application, seeks as far as possible to maintain the *status quo* and avoid interfering with the respective positions of the parties who are subsequently to decide the questions in issue at the hearing. (*l*) The Court considers what it can most satisfactorily do provisionally, and especially looks to the degree of convenience and inconvenience to the parties concerned.

In *Thomson* v. *Hughes*, (*m*) where the plaintiff's patent was due to expire in six weeks from the date of the motion, North, J., in

(*g*) *Moser* v. *Jones*, 10 R. P. C. 368.

(*h*) *Greer* v. *The Bristol Tanning Co.*, 7 R. P. C. 1.

(*i*) R. S. C. Order 52, rule 9.

(*j*) A Master has no power to grant an injunction: see Order 54, rule 12.

(*k*) *McHarg* v. *Universal Stock Exchange*, [1895] 2 Q. B. 81; 64 L. J. Q. B. 498.

(*l*) Per Lord Langdale, M.R., in *Bridson* v. *McAlpine*, 8 Beav. 230.

(*m*) 7 R. P. C. 71, p. 76.

refusing an injunction on the balance of convenience, said: "If the defendant goes on making this card, and the plaintiff succeeds, the plaintiff will get full relief by way of damages, or by an account of profits in respect of all cards of this pattern made by the defendant between the present time and the expiration of the patent, which is some six weeks or so hence. On the other hand, if an injunction is granted, and the defendant should turn out to be successful, upon the ground that what he is doing is not an infringement of the patent, which is not a point that has been actually decided in any suit commenced for that purpose, he would be entitled to damages under the undertaking of the plaintiff as to damages, but I do not see how the Court could arrive at a fair solution of the question what damages really had arisen; how much worse he really was by reason of the injunction having been granted, and his having been thereby prevented from undertaking work which he otherwise might have had. Of course the profit he might have got by such work as could be ascertained could be given, but it would be impossible to say what orders he might have got if he could have executed them, but which he has not got because he could not, and further, what other things might have been done by him, in respect of which the power of executing these orders deprived him of the opportunity of earning money. It seems to me that the plaintiff can lose little, if anything, if I do not grant an injunction, and he is successful. The defendant may lose a great deal if I grant an injunction and he should turn out to be successful."

The Court will not grant an injunction lightly, but will carefully consider the validity of the patent and whether or not the acts complained of are infringements. (*n*) For the Court proceeds upon the assumed validity of the patent, (*o*) and if that should subsequently be defeated at the trial great hardship might be imposed on the defendant by an interlocutory injunction.

In *Holophane* v. *Berend*, (*p*) it was urged by the plaintiffs that the defendants' trade being still of slender dimensions, no great harm could result from the granting of an injunction against them, whereas the plaintiffs' trade, which was large, would be seriously prejudiced by the refusal of an injunction, owing to the inferiority of the goods with which the defendants were flooding the market. (*q*) Kekewich, J., however, refused the injunction, being satisfied that

(*n*) *Bridson* v. *M'Alpine*, supra.

(*o*) Per Lord Cottenham in *Bacon* v. *Jones*, 4 Myl. & Cr. p. 436.

(*p*) 15 R. P. C. 18.

(*q*) Cf. Turner, L.J., in *Davenport* v. *Jepson*, 4 De G. F. & J. p. 448.

there was a serious issue to be tried as to the validity of the patent.

In the *Electric Telegraph Company* v. *Nott*, (r) the plaintiffs were the owners of three patents of eight, five, and three years' standing respectively. The Court refused to grant them an interlocutory injunction, as there appeared to bo great doubt on the question of the alleged infringement. Lord Cottenham, C., said: "Where the application to the Court is to protect and assist a legal right, if there be a doubt as to the validity of the legal right, or as to the acts complained of being a violation of such legal right, it becomes the Court to be extremely cautious in administering its equitable jurisdiction by way of injunction, and such caution is requisite for two reasons; first, because if the legal right ultimately fail, or if the acts complained of turn out to be no violation of the legal right, the Court has then interfered without any authority whatever, the authority being merely derivation from the legal right, and in aid and protection of it. Secondly and principally, because in this Court there is no comparison between the evil of an error in refusing an injunction, and the evil of an error in granting an injunction. That in ordinary cases an injunction, if improperly granted, causes infinitely more mischief to the defendant than the delay of granting the injunction can possibly cause to the plaintiff. The Court ought to be extremely cautious, and not, as a general rule, to give its aid to the legal right by injunction unless satisfied—the legal right being disputed—that in the result such legal right would be established, or—the legal right not being disputed—that the acts complained of were a violation of it."

In *Shillito* v. *Larmouth & Company*, (s) the plaintiffs moved for an interlocutory injunction upon a patent of ten years' standing. The defendants denied the novelty of the invention and the infringement. Bristowe, V.C., considered the infringement sufficiently made out, and granted the injunction. On the question of infringement, he said that it was not necessary to satisfy the Court beyond all doubt on the point. "The fair rule to go by is this: Is the Court satisfied, for the purposes of the interlocutory application, that the alleged infringement is sufficient to satisfy the Court that there is a *primâ facie* case of actual infringement which will be proved at the trial when the case is tried out? . . ."

Even where infringement has not yet taken place, the plaintiff may be entitled to an injunction if he can satisfy the Court that

(r) 2 Coop. 41.

(s) 2 R. P. C. 1.

infringement is threatened. For the Court will interfere to restrain a threatened injury.

"On principle," said Jessel, M.R., in *Frearson* v. *Loe*, (*t*) "there is no reason why a patentee should not succeed in obtaining an injunction without proving actual infringement. I think so for this reason. Where the defendant alleges an intention to infringe, and claims the right to infringe, the mischief done by the threatened infringement of the patent is very great, and I see no reason why a patentee should not be entitled to the same protection as every other person is entitled to claim from the Court from threatened injury, where that threatened injury will be very serious. No part of the jurisdiction of the old Court of Chancery was considered more valuable than that exercise of jurisdiction which prevented material injury being inflicted, and no subject was more frequently the cause of bills for injunction than the class of cases which were brought to restrain threatened injury as distinguished from injury which was already accomplished."

In *Dowling* v. *Billington*, (*u*) the only infringements proved were infringements either between the filing and acceptance of the specification, or after action brought; yet, as this shewed an intention to infringe on the part of the defendant, an injunction was granted, although under the circumstances no damages could be recovered.

No injunction will be granted, however, if the Court is satisfied that the defendant does not intend to continue his infringements. (*v*) Still, actual infringement is presumptive evidence of an intention to continue that course of conduct, and the Court will not refuse an interlocutory injunction in such case merely because the defendant at the hearing promises to discontinue his infringements. (*w*)

"Undoubtedly," said Cotton, L.J., in *Proctor* v. *Bailey*, (*x*) "wherever a person has done a wrongful act in infringing a patent, *primâ facie* that is ground for granting an injunction, because when a man has done a wrongful act the probability (unless there is anything which prevents that probability arising) is that he will continue it; and the patentee who is injured by that act is entitled, in a Court of Equity, to prevent a repetition of that wrongful act."

(*t*) L. R. 9 C. D. 65; 26 W. R. 138; 27 W. R. 183.

(*u*) 7 R. P. C. 191.

(*v*) *Proctor* v. *Bailey*, 6 R. P. C. 542; L. R. 42 C. D. 390; 59 L. J. Ch. 12; 38 W. R. 100; 61 L. J. (N.S.), 752; *Dunlop Pneumatic Tyre Co.* v. *Stone*, 14 R. P. C. 263.

(*w*) *Losh* v. *Hague*, 1 W. P. C. 200.

(*x*) 6 R. P. C. p. 542.

In *Lyon* v. the *Mayor of Newcastle*, (*y*) however, where the defendants, though in possession of infringing articles, had, when written to, denied actual user, and offered an undertaking not to use the infringing machines pending the trial of the action, Kekewich, J., held a motion for an interlocutory injunction unnecessary, and dismissed it with costs, although the validity of the patent had been established in a prior action.

Where the patent in protection of which an interlocutory injunction is sought is about to expire the relief will usually be refused. (*z*) But where numbers of infringing articles have been fraudulently manufactured, at the close of a patent term, prior to its expiration, with the object of flooding the market the moment the term has run out, the Court will grant an injunction restraining the sale of such articles; and this even after the patent has expired. (*a*)

In *Crossley* v. *Derby Gas Company*, Lord Brougham, C., said: (*b*) "The point has never yet been decided; but I am of opinion that the Court would interfere, even after the patent has expired, to restrain the sale of articles manufactured previous to its expiration in infringement of a patent right; and that a party would not be allowed to prepare for the expiration of a patent by illegally manufacturing articles, and immediately after its expiration to deluge the market with the produce of his piracy; and thus reaping the reward of his improbus labour in making it. The Court would, I say, in such case restrain him from selling them even after the expiration of the patent."

When the Court will Grant Relief.—It will now be convenient to consider the cases in which the Court, if infringement is made out, will generally grant an interlocutory injunction. These may be grouped under the following heads: (1) When the validity of the patent has already been established in a previous action. (2) When the patent is of old standing and the enjoyment under it has been uninterrupted. (3) When the validity of the patent is not in issue.

1. *When the validity of a patent has been established in a previous action.*

In this case, once the Court is satisfied that infringement has taken place, the plaintiff is entitled to an interlocutory injunction.

(*y*) 11 R. P. C. 218.

(*z*) *Betts* v. *Gallais*, L. R. 10 Eq. 392.

(*a*) *Crossley* v. *Derby Gas Co.*, 4 L. J. Ch. 26.

(*b*) Ibid. Cf. Turner, L.J., in *Smith* v. *London & South Western Railway Co.*, Kay, 416; 23 L. J. Ch. 562.

A prior decision of the Scottish Courts, (*c*) and even the award of an arbitrator, (*d*) in favour of the patentee have been held sufficient proof of the validity of the patent to justify the application of this rule.

The reason of this rule was thus explained by Lord Romilly, M.R., in *Bovill* v. *Goodier*: (*e*) "The law attaches superior rights to a patentee who has established the validity of his patent, to those which belong to a patentee who has not done so. The former stands on a different footing, and though the patent may be contested by fresh persons, he will receive protection until the invalidity of it is shewn. The distinction hitherto made by Courts of Equity has been that where the validity of the patent has not been the subject of any legal proceedings, the patentee must prove its validity at law before the Court of Equity will protect him; but having once established its validity, then the Court of Equity will protect him against another person until that person proves its invalidity."

"In what position would a patentee be placed," said Wood, V.C., in *Davenport* v. *Goldberg*, (*f*) "if he is to try his right *ab initio* against every separate infringer *in infinitum*? That certainly is a view of his rights which has never been adopted by this Court." (*g*)

The patentee's right to relief by way of interlocutory injunction is all the stronger if he can shew that the defendant has in fact been indemnifying a defendant in the former action; (*h*) or that the defendant is a mere cover for a former infringer, who is thus seeking to deprive the patentee of the benefits which have accrued to him under an earlier action. (*i*) In such case an interlocutory injunction has been upheld, notwithstanding the circumstance that an appeal in the first action had been taken to the House of Lords, and the second defendants offered to pay royalties pending such appeal. (*j*)

Where the prior action relied upon has been won by the patentee through the defendant failing to appear at the trial, the same inference of validity will not be drawn in the patentee's favour. But where this happened in two successive actions

(*c*) *Dudgeon* v. *Thompson*, 30 L. T. (N. S.), 244.

(*d*) *Lister* v. *Eastwood*, 26 L. T. 4.

(*e*) 35 L. J. Ch. p. 435; L. R. 2 Eq. 200.

(*f*) 2 H. & M. 286.

(*g*) See, also, *Edison-Bell* v. *London Phonograph Co.*, 11 R. P. C. 193; *Moser* v. *Marsden*, 10 R. P. C. 368.

(*h*) *Farbenfabriken* v. *Dawson*, 8 R. P. C. 397.

(*i*) *Moser* v. *Sewell*, 10 R. P. C. 365.

(*j*) Ibid.

brought by the same plaintiff, Chitty, J., held that the patent was sufficiently established to justify the granting of an interlocutory injunction against a new infringer. (*k*)

In the *Pneumatic Tyre Company* v. *Marwood*, (*l*) it was suggested that the value of a previous decision in favour of the patentees must be discounted, because the former defendants had not been in a position to call the best expert evidence. But the Court declined to allow any such suggestion to minimize the weight attaching to the judgment already obtained, and granted an injunction.

The circumstance that a patentee has compromised actions previously brought by him in respect of the same patent, is not in his favour, but will not necessarily disentitle him to interlocutory relief. The Court in such case may still grant an injunction if satisfied that the patentee may fail to obtain compensation should he be left to his remedy in damages. (*m*)

2. *When the patent is of old standing, and the enjoyment under it has been uninterrupted.*

The rule that prolonged possession under colour of title is sufficient *primâ facie* evidence on which to base an interlocutory injunction has long been recognized by Courts of Equity. (*n*)

In *Hill* v. *Thompson*, (*o*) the leading case as to this, Lord Eldon, while dissolving an injunction granted on a patent of three years' standing and one year's user, laid down the rule as follows: "The principle upon which the Court acts in cases of this description is the following; where a patent has been granted, and there has been an exclusive possession of some duration under it, the Court will interpose its jurisdiction, without putting the party previously to establish the validity of his patent by an action at law. But where the patent is but of yesterday, and, upon an application being made for an injunction, it is endeavoured to be shewn in opposition to it that there is no good specification, or otherwise that the patent ought not to have been granted, the Court will not, from its own notions respecting the matter in

(*k*) *Edison-Bell Phonograph* v. *Bernstein*, 14 R. P. C. 158.

(*l*) 13 R. P. C. 347.

(*m*) *Bracher* v. *Bracher*, 7 R. P. C. 421. In this case the defendants were a company of small means who might not have been able to pay damages given against them.

(*n*) As to this doctrine of equity, see Lord Eldon in the *Universities of Oxford and Cambridge* v. *Richardson*, 6 Ves. 689.

(*o*) 3 Mer. 622; 1 W. P. C. p. 231.

dispute, act upon the presumed validity or invalidity of the patent, without the right having been ascertained in a previous trial."

So too in *Harmer* v. *Plane*, (*p*) where an injunction had been granted on a patent of thirteen years' standing, Lord Eldon, C., upheld the injunction on appeal, although there was strong ground for contending that the patent was bad on the face of the specification. "Where the public have permitted a reasonably long and undisputed possession under colour of the patent," said the learned Chancellor, "the Court has thought, upon the fact of that possession proved against the public, that there is less inconvenience in granting the injunction, until the legal question can be tried, than in dissolving it at the hazard that the grant of the Crown may in the result prove to have been valid. The question is not really between the parties upon the record; for, unless the injunction is granted, any person might violate the patent; and the consequence would be that the patentee must be ruined by litigation. In the case of *Boulton* v. *Bull*, (*q*) therefore, though a case of great doubt, upon which some of the ablest judges in *Westminster Hall* disagreed, yet, upon the ground of the possession by the patentees against all mankind, the injunction was granted until the question could be tried."

In *Beeston* v. *Ford*, (*r*) Lord Lyndhurst, C., said: "There may be considerable doubt as to the validity of a patent, still, if there has been a long exclusive enjoyment, the doctrine of the Court is that an injunction shall go to protect the patent until the question of its validity is duly determined at law."

In *Bickford* v. *Skewes*, Shadwell, V.C., acted on this rule and protected by injunction a patent of six years' standing, holding that the Court was bound to look to the fact of such enjoyment under the patent as a sort of practical answer to theoretical objections taken to the specification. (*s*)

In *Stevens* v. *Keating*, (*t*) the plaintiffs were the assignees of two patents of twelve and six years' standing respectively. The defendants denied the infringement and said that the plaintiffs' specification was bad. But Shadwell, V.C., granted the injunction, and on appeal Lord Cottenham, C., confirmed the order. His lordship said: "In the case of patents the rule steps in and says long and uninterrupted possession shall be *primâ facie* evidence of title, which ought to be respected, and it comes,

(*p*) 14 Ves. 132.
(*q*) 2 H. Blackstone, 453; 3 Ves. 140.
(*r*) 2 Coop. Ch. Ca. 68.
(*s*) 1 W. P. C. 213; see, also, S. C. 8 L. J. Ch. 188.
(*t*) 2 W. P. C. 176; 2 Phill. 333.

therefore, to the case I have so frequently had occasion to advert to. *Primâ facie* in that state of the case the Court is not at liberty to exercise a discretion as to whether the patent is good or not. . . . Here I have a patent of 1834, very extensively acted on from the year 1834 to 1846, under which the plaintiff has not only claimed, but, as far as it appears, exclusively exercised the right of manufacturing and selling the composition of those three substances; and it comes therefore within the rule of the cases referred to, that under such circumstances, though the Court will give every facility to the defendant that he may not be unnecessarily restrained for a longer period of time than may be absolutely essential to ascertain the right by trial at law, yet that it is a case in which there is that long and undisturbed possession under a patent right which precludes the Court, according to the practice laid down, from refusing to interfere by injunction till the right shall be ascertained by trial at law." (*u*)

In *Muntz* v. *Foster*, (*v*) the patent was disputed, and there was conflicting evidence as to its novelty, but it was a patent of eleven years' standing, and Knight-Bruce, V.C., granted an injunction. On appeal, Lord Lyndhurst, C., in affirming the order, said: "The patentee has been in possession of his exclusive privilege for several years, and the Court will not, on any suggested defect of the specification, allow that privilege to be disturbed, until the title has been decided in a court of law."

In *Caldwell* v. *Vanvlissengen*, (*w*) objections were taken to the specification, but the Court granted an injunction, on the ground of possession for eleven years. Turner, V.C., said: "The question, whether the Court will interfere to protect a patentee before he has established his right at law, or will suspend its interference until the right at law has been established, appears to me to depend on very simple principles. It is part of the duty of this Court to protect property pending litigation; but when it is called upon to exercise that duty, the Court requires some proof of title in the party who calls for its interference. In the case of a new patent this proof is wanting: the public, whose interests are affected by the patent, have had no opportunity of contesting the validity of the patentee's title, and the Court therefore refuses to interfere until his right has been established at law. But in a case where there has been long enjoyment under the patent (the

(*u*) See also the same learned judge in the *Electric Telegraph Co.* v. *Nott*, 11 Jur. 273; 16 L. J. C. P. 174; 2 Coop. 41.

(*v*) 2 W. P. C. 95.

(*w*) 9 Hare, 415; 21 L. J. Ch. 97.

enjoyment, of course, including use), the public have had the opportunity of contesting the patent; and the fact of their not having done so successfully affords at least *primâ facie* evidence that the title of the patentee is good; and the Court therefore interferes before the right is established at law. In the present case, I think the plaintiffs have proved such a case of enjoyment under the patent, and of their title having been maintained at law against the several attempts which have been made to impeach it, that the Court is bound at once to interfere for their protection, unless there are sufficient grounds for withholding its interference."

In *Newall* v. *Wilson*, (*x*) the defendants relied on an alleged publication of the invention three years before the date of the patent. The patentee had already on four occasions successfully vindicated his patent rights against infringers; but on none of those occasions had the evidence now relied on been given. The patent, however, was nearly twelve years old, and the Lords Justices (reversing the Master of the Rolls) granted an interlocutory injunction on the ground of long enjoyment, notwithstanding the possibility of the fresh evidence upsetting the patent. (*y*)

In *Davenport* v. *Jepson*, (*z*) Turner, L.J., dealing with a patent of eleven years' standing, said: "The rule is well settled that this Court assumes the validity of a patent and grants an injunction where there has been long and quiet enjoyment under it." (*a*)

In *Heugh* v. *Magill*, (*b*) an injunction was sought to restrain the infringement of a patent which was for improvements in a machine the subject of a prior substratum patent, and which could not be used without the license of the original patentees. The patent in protection of which an injunction was sought had been taken out ten years before this application, but the original patent had only expired the year before. In these circumstances, Jessel, M.R., held that the undisturbed possession of the new patent did not commence until the substratum patent had expired, and that there had not been a sufficiently long enjoyment to entitle the plaintiff to an injunction.

In *Briggs* v. *Lardeur*, (*c*) the patent was of ten years' standing,

(*x*) 2 De G. M. & G. 282; 19 L. T. 161.

(*y*) See the judgment of Lord Cranworth.

(*z*) 1 N. R. 173, 307; 4 De G. F. & J. 440, at 447.

(*a*) See, also, *Betts* v. *Menzies*, 3 Jur. (N. S.), 357, and *Davenport* v. *Richards*, 3 L. T. (N. S.), 503, in both of which cases injunctions were granted by Wood, V.C., on patents of nine years' standing.

(*b*) W. N. 1877, p. 62.

(*c*) 1 R. P. C. 126.

and its validity during that period had not been called in question. In granting an injunction, Pearson, J., said: "Whether this patent is a good patent or not, I think I ought not to consider at all on the present motion, unless I can see on the face of this patent that it is so irretrievably and hopelessly bad that it is absolutely impossible that it could be supported. In a case so plain as that, I doubt not that I might consider it on interlocutory motion; but when the patent has been in existence for ten years, and has not been challenged at the end of ten years, I think this Court ought to give credit to the patent and ought to assume, at all events upon the interlocutory motion, that for the purpose of the interlocutory motion the patent is a good patent; of course leaving it entirely open until the case comes on for trial to determine that the patent is as bad a patent as ever was taken out." (*d*)

Long Possession means Undisturbed Possession.—To entitle the patentee to the protection of an interlocutory injunction, he must shew not only long enjoyment but likewise undisturbed enjoyment. If the defendant can prove to the Court that the invention of which the plaintiff claims the exclusive enjoyment has been openly used by other persons during the term of the letters patent, this will rebut the inference which the Court usually makes in the patentee's favour from the fact of the long enjoyment. Thus, in *Collard* v. *Allison*, (*e*) although the patent was one of twelve years' standing, and the infringement admitted, the Court refused an injunction when it was shewn that the patentee's possession under the patent had not been exclusive, Lord Cottenham laying it down that the absence of exclusive enjoyment neutralized the length of time for which a patent had been enjoyed, and created an exception from the rule stated by Lord Eldon in *Hill* v. *Thompson*.

In *Curtis* v. *Cutts*, (*f*) where the patent was more than thirteen years old, and its validity was the only question in issue, Lord Cottenham, after observing that if the enjoyment had been exclusive the patentee would have been entitled to an injunction, said: "But the rule upon which the Court acts in granting an injunction, where the validity of the patent alone is disputed, requires, not merely that there shall have been possession and enjoyment under the patent, but such possession and enjoyment must have been undisturbed and exclusive. Now, the answer negatives an exclusive

(*d*) See, also, *Rothwell* v. [illegible], 3 R. P. C. 379, where the patent was one of six years' standing.

(*e*) 4 Myl. & Cr. 487.

(*f*) 8 L. J. Ch. 184; 2 Coop. Ch. Ca. 60.

possession of the privilege to make the machines. It states that since the patent was granted, persons, not claiming under the patent, have manufactured machines upon the principle sought to be protected by it. There is an end, therefore, of the case of exclusive possession and enjoyment. The injunction granted by the Vice-Chancellor must be dissolved."

Disturbance of the patentee's enjoyment will not, however, defeat his right to an injunction where the patentee has taken proceedings successfully against the prior infringers. For although the establishment of a patent's validity at law is not conclusive against any other subsequent infringer, and will not preclude such infringer from disputing the patent, still, the Court considers the success of a patentee in vindicating his patent right as a strong circumstance in his favour when he seeks relief by interlocutory injunction. (*g*)

It is not necessary that a patentee should actually have gone to trial in vindication of his patent right against infringers. If they have submitted and recognized his title, that will be sufficient.

In *Rothwell* v. *King*, (*h*) it was proved that the patent had been infringed on four prior occasions, and that on each of those occasions the infringers had desisted, so that the patentee had not in any case proceeded to the trial of an action. On this Bristowe, V.C., said: "It is quite true that in those cases there may not have been actions, but if a party is doing a thing, and it is brought to their knowledge that they are disturbing another man's patent, and they acquiesce in the view that they are doing so, then an action is not necessary. It would be a very hard thing to hold that no compromise, or arrangement, or giving up, or acquiescence, would do unless there was an action."

Enjoyment means User.—Enjoyment of a patent right must include user. If the patent for which protection is sought is of old standing, but has only recently been put in use by the patentee, the rule as to the Court favouring long enjoyment does not apply.

In *Caldwell* v. *Vanvlissengen*, (*i*) Turner, V.C., said long enjoyment, of course, included use. In *The Electric Telegraph Company* v. *Nott*, (*j*) Lord Cottenham, C., said: "Where a patent has existed for some time and there has, during this time, been a user under the patent, it is an assertion of a title against all the world."

(*g*) *Davenport* v. *Jepson*, 4 De G. F. & J. 440; *Hayward* v. *Pavement Co.*, 1 R. P. C. 207; *United Telephone Co.* v. *St. George*, 3 R. P. C. 33.

(*h*) 3 R. P. C. 379.

(*i*) 9 Hare, 415; 21 L. J. Ch. 97; cf. Shadwell, V.C., in *Stevens* v. *Keating*, 2 W. P. C. 176; 2 Phill. 333.

(*j*) 2 Coop. Ch. Ca. 47.

In *Plimpton* v. *Malcolmson*, (*k*) the plaintiff's patent was one of ten years' standing, but no evidence of user under the patent was given, except user of recent date. Jessel, M.R., in refusing an interlocutory injunction, said: "Where a patentee comes to this Court for interim protection on the ground of previous enjoyment, he must shew that there has been an actual public user of his patent. In this case there is no evidence of actual user for any number of years."

No Injunction where the Patent is Recent and its Validity in Dispute.—The general rule as to long enjoyment implies of necessity the converse proposition, that where the patent is new, is "but of yesterday, and it is endeavoured to be shewn in opposition to it that there is no good specification, or otherwise that the patent ought not to have been granted," (*l*) the Court will not interfere in its defence.

Coles v. *Baylis* (*m*) is the only case in which this rule appears to have been departed from. There the plaintiff's patent was only of eighteen months' standing. The defendant disputed its validity, and objected that the specification incompletely disclosed the knowledge in the possession of the plaintiff at the time when the patent was taken out. Bacon, V.C., however, held that the defendant had by his own conduct proved the novelty of the invention, and granted an injunction, although there was an intricate question of law to be tried at the hearing.

With *Coles* v. *Baylis* may be compared the cases of *Lister* v. *Norton* (*n*) and *Jackson* v. *Needle*. (*o*) In the former case, Chitty, J., discussing the meaning of the word "recent" as applied to a patent, said: "As to what is exactly a recent patent, and what is a patent of sufficient account to support an injunction, that is a matter, no doubt, more or less of discretion. But the discretion is limited by the practice; and, according to my recollection of the practice, a patent three years old would not be sufficient where it is disputed."

In *Jackson* v. *Needle*, (*o*) Bacon, V.C., made an order for an interlocutory injunction on a patent of eight months' standing of which the validity was disputed, but the Court of Appeal discharged the order. "The Court," said Baggallay, L.J., "abstains from interfering by injunction in the case of a recently dated patent where there is really a substantial question to be tried."

(*k*) L. R. 20 Eq. 37.
(*l*) See Lord Eldon in *Hill* v. *Thompson*, 3 Mer. 624.
(*m*) 3 R. P. C. 178.
(*n*) 1 R. P. C. 114.
(*o*) Ibid. 174.

"Where the proprietor of recen · granted letters patent," said Kekewich, J., in *Holophane* v. *Berend*, (*p*) "the validity of which has not been established by legal process, seeks an injunction against an alleged infringer, the Court declines to interfere by interlocutory injunction, and leaves the patentee to establish the validity by formal proceedings. . . . Of course there are exceptions. It will not do for a defendant coming here as against the proprietors of letters patent simply to say, 'I challenge the validity.' There must be something more than that. The Court must be satisfied that there is an honest intention of trying the question, and not only an honest intention of trying the question, but that there is something to be tried."

3. *When the Validity of the Patent is not in Issue.*

Where the validity of the patent is not in dispute different considerations arise. Here, as between the parties to the action, it must be assumed that the plaintiff's patent right is good, and consequently, in such case, where the infringement is clearly established, the Court will protect even a recent patent by interlocutory injunction.

The issue of validity may be excluded, either through the defendant not electing to raise it, or through the relations of the parties being such that, as against the defendant, the Court must assume it in the plaintiff's favour.

In *Clarke* v. *Ferguson*, (*q*) the plaintiff's patent was not disputed by the defendants, who were the manufacturers employed by the plaintiff to make his patented articles, but the defendants alleged that they had invented an improvement, and were applying for a patent, and asked that the two patents might be vested in trustees for the benefit of both parties. Though the patent was only three months old, Stuart, V.C., granted an injunction.

The defendant, as in the case last mentioned, may, by reason of some special relation towards the plaintiff, be precluded from disputing the validity of the patent. Thus, he may be a licensee working under a license granted by the patentee, and as such estopped during the continuance of his license from denying the title of his licensor. (*r*) Or he may be the original patentee

(*p*) 15 R. P. C. p. 19.

(*q*) 1 Giff. 184.

(*r*) *Bowman* v. *Taylor*, 2 Ad. & E. 278; 1 W. P. C. 292; *Smith* v. *Scott*, 28 L. J. C. P. 325; 5 Jur. (N. S.), 1356; *Hills* v. *Laming*, 23 L. J. Ex. 60; *Noton* v. *Brooks*, 7 H. & N. 499; 8 Jur. (N. S.) 155; *Crossley* v. *Dixon*, 10 H. of L. Ca. 293; *Lawes* v. *Purser*, 26 L. J. Q. B. 25; 6 E. & B. 930.

himself, who has assigned his patent, and is acting in breach of that assignment; when, also, he will be precluded from alleging as against his assignee that the patent he has assigned is invalid. (*s*)

Again, he may have been in partnership with the plaintiff, and working the patent with him during a series of years; (*t*) or he may have submitted to judgment in a previous action for prior infringements of the same patent. (*u*) In both of these cases he will be precluded from disputing the validity of the patent.

Practice on Interlocutory Injunctions.

Where the Defendant is Willing to Keep an Account.—Usually the Court will not order an injunction if the defendant is willing to keep an account pending the trial of the action. (*v*) But if he refuses to do so, or does not appear, and so an undertaking to keep an account cannot be obtained from him, the Court will protect the patentee by granting the injunction. (*w*)

In one case where the defendants had offered in a letter to keep an account, the Court, while refusing an injunction, still required a formal undertaking as to the account to be given. (*x*)

Where an undertaking is given, a defendant is as much bound thereby as he would be by an injunction, and must comply strictly therewith. (*y*)

Delay is Fatal to Relief.—A plaintiff who seeks an interlocutory injunction must apply to the Court without delay. Any delay amounting to laches on his part will disentitle him to this form of relief.

In *Bridson* v. *Benecke*, (*z*) the plaintiffs ascertained in January, 1848, that their patent was being infringed. In the April following they warned the defendants, but did not file their bill for relief till the end of December. On the 15th of January, 1849, they

(*s*) *Chambers* v. *Crichley*, 33 Beav. 18; *Pneumatic Tyre Co.* v. *Friswell*, 13 374; *Oldham* v. *Langmead*, 3 T. R. 439. But in the case of bankruptcy a patentee is not estopped from disputing the validity of his letters patent as against a purchaser from his trustee: *Cropper* v. *Smith*, 10 App. Ca. 249; 2 R. P. C. 17.

(*t*) *Muntz* v. *Grenfell*, 2 W. P. C. 88; 7 Jur. 121; 2 Coop. 61, n.

(*u*) *Gurcher* v. *Clayton*, 11 Jur. (N. S.), 107.

(*v*) *Holophane* v. *Berend*, 15 R. P. C. R. P. C. 15; *Actien Gesellschaft* v. *Temler*, 16 R. P. C. 447.

(*w*) *Clarke* v. *Nichols*, 12 R. P. C. 310. But see *British Tanning Co.* v. *Groth*, 7 R. P. C. 1, where in the special circumstances an injunction was refused even when the defendant refused to keep an account.

(*x*) *Thomson* v. *Hughes*, 7 R. P. C. 71.

(*y*) Ibid.

(*z*) 12 Beav. 1.

gave notice of motion for an injunction. Apart from the circumstance of this delay the plaintiffs had a strong case, for their patent was thirteen years old, and had been established in prior litigation. Lord Lonsdale, M.R., in refusing an injunction, said: "I think that a party coming for the assistance of this Court to protect a legal right, not absolutely established against the party who is alleged to have infringed it, ought to come at an early period. I do not say at the earliest possible period, because that would be putting an application for an injunction on notice, where all parties have an opportunity of being heard, in the same condition as an injunction *ex parte*, which it would not be expedient to do."

In *Bovill* v. *Crate*, (*a*) the plaintiff knew of the infringement in August, 1864. In the November following he communicated with the defendant, and was told in reply exactly what the defendant was doing. In January, 1865, the plaintiff wrote again to the defendant, and, receiving no reply, threatened legal proceedings in April, but did not file his bill in Chancery till July. This delay was held by Wood, V.C., to disentitle him to relief by injunction.

In *Greer* v. *Bristol Tanning Company*, (*b*) a delay of three weeks was held sufficient to defeat the plaintiff's right to interlocutory relief.

In the *North British Rubber Company* v. the *Gormully, &c., Company*, (*c*) the plaintiffs, who had already established their patent in an action against prior infringers, came for an interlocutory injunction after a delay of twenty-two months. During this period the defendants had been establishing and pushing a growing trade. The Court held this delay fatal to the application.

"I am not aware," said Chitty, J., "having regard to patents, that there is any substantial ground of distinction between an interlocutory injunction upon a patent right and upon any other. The principles appear to me to be substantially the same, and the general rule of the Court is that a person who comes to ask for that remedy, which is granted with despatch, and for the purpose of protecting rights until the trial, should come promptly." (*d*)

In *Edison-Bell* v. *Hough*, (*e*) a delay of six months was held to militate against granting an injunction. In *Leonhardt* v. *Kallé*, (*f*)

(*a*) L. R. 1 Eq. 388; see, also, *The Patent Type Founding Co.* v. *Walter*, 29 L. J. Ex. 207; Johns. 727; *Johnson* v. *Wyatt*, 2 De G. J. & S 25; see, also, Wood, V.C., in *Smith* v. *London & South Western Railway Co.*, Kay, 408; 23 L. J. Ch. 562.

(*b*) 2 R. P. C 268; see, also, *Thomson* v. *Batty*, 4 T. L. R. 36; *Lister* v. *Norton*, 1 R. P. C. 116.

(*c*) 12 R. P. C. 17.

(*d*) Ibid. p. 20. In this case the defendants undertook to keep an account and paid £500 into court.

(*e*) 11 R. P. C. 594.

(*f*) Ibid. 534.

and in *Aluminium Company* v. *Domeiere*, (*g*) a delay of a year was held to bar the plaintiffs' right; while Stirling, J., in *Dunlop Pneumatic Tyre Company* v. *Stone*, (*h*) held a delay of three months sufficient to disentitle the plaintiffs to interlocutory relief.

Persons who assert legal rights are bound to come promptly; and, *à fortiori*, persons who assert only equitable rights. (*i*)

In *Actien Gesellschaft, &c.* v. *Temler*, (*j*) the plaintiffs had an agreement for the assignment of the patent, but the assignment had not been carried out. After acquiring their equitable title, they delayed for nine months before moving for an injunction. On account of this delay the injunction was refused, but the defendant was put on an undertaking to keep an account.

The delay which is fatal, is delay after knowledge of the infringement. If the plaintiff is in ignorance, or lulled into security by circumstances entitling him to believe that no infringement is going on, he will be excused from the consequences of his delay. (*k*)

Delay, when Excused.—In the following cases the delay was held not to have disentitled the plaintiff to relief. (*l*)

In *Losh* v. *Hague*, (*m*) Shadwell, V.C., granted relief although there had been a delay of three months, during a portion of which the plaintiffs had been making enquiries as to what the infringers were doing.

In the *United Telephone Company* v. the *Equitable Telephone Company*, (*n*) the facts were peculiar. The defendants, in February, 1887, wrote to the plaintiffs stating that they intended to manufacture and sell the *Swinton* telephone, and inviting the plaintiffs to inspect it, and take proceedings if they thought fit. The plaintiffs, who took no notice of this letter, eleven months later commenced their action for infringement, and moved for an interlocutory injunction. To explain their delay the plaintiffs filed evidence shewing that, on the advice of their solicitor, they had purposely abstained from embarking in expensive litigation with what they believed to be a bubble company, until the infringing instruments had actually been manufactured and sold by the defendants.

The Court accepted this explanation, and granted the injunction. Chitty, J., said: "It is often stated that, on applications

(*g*) 15 R. P. C. 32.

(*h*) 14 R. P. C. 263.

(*i*) *Actien Gesellschaft, &c.* v. *Temler*, 16 R. P. C. (p. 449).

(*j*) Ibid.

(*k*) *Crossley* v. *Derby Gas Co.*, 1 W. P. C. 120; 4 L. J. Ch. 26.

(*l*) See, also, *Caldwell* v. *Vanvlissengen*, 21 L. J. Ch. 97; 9 Hare, 415; 16 Jur. 115; *Osmond* v. *Hirst*, 2 R. P. C. 265.

(*m*) 1 W. P. C. 201.

(*n*) 5 R. P. C. 233.

for interlocutory injunctions, delay is fatal; and that may be taken to be a very fair ordinary working proposition; but in each case the circumstances must be examined. I can put a case at once where there might, in one sense, be an apparent delay, but in which the delay would afford no defence to the motion. I take the case of a man writing a letter to an owner of land in possession, saying, 'I intend to cut your trees, and I give you notice that I shall come in and cut down your trees.' The plaintiff considers this to be an idle threat, and a year or two may elapse, and nothing is done. Then, when afterwards the plaintiff finds that the defendant is going to act upon that threat, the plaintiff institutes his action and asks for an injunction. In such a case as that, the mere threat, which would have been sufficient to found an injunction, would not be sufficient to afford a defence to the motion for an injunction; because the plaintiff would be entitled to say, 'I treat it as an idle threat, and until something is really being done upon it, I shall not proceed.' A wrong-doer cannot force his adversary prematurely into litigation; and, although, on the facts I have stated, in such a case the plaintiff would be entitled to his injunction, I do not consider he would lose his right by delaying to move till some act was done in the way of execution of the threat. Is a plaintiff bound, on a mere threat of this kind, to begin an action against a company of this class—a company whose means are extremely feeble, and who will not, in all probability be able to answer the expense of such a litigation as that of which this is an example? I think not. I think he is entitled to wait, after the threat is made, for a reasonable time, to see what has been done in execution of the threat, and that, it appears to me, is what the plaintiffs did."

The circumstance that a plaintiff who seeks an interlocutory injunction has so held his hand in regard to some other infringer as to have barred his right to interlocutory relief against that person, is no ground for refusing him such relief against a defendant in regard to whom he has shewn no such laches. (*o*)

Where the Defendant has Extensive Works which the Injunction will Stop.—The object of the Court in granting an interlocutory injunction is to prevent mischief, (*p*) therefore, where a direction to the defendant to keep an account will do the plaintiff ample justice, an injunction will rarely be granted. (*q*) Still, the plaintiff's

(*o*) *Pneumatic Tyre Co.* v. *Warrilow*, 13 R. P. C. 284.

(*p*) Per Lord Eldon, in *Neilson* v. *Thompson*, 1 W. P. C. 278.

(*q*) *Jones* v. *Pearce*, 1 W. P. C. 122.

strict right is to have the injunction—an account being discretionary. (*r*)

Where the injunction will have the effect of stopping extensive works, and will therefore be likely to do the defendant irreparable mischief should the plaintiff eventually fail, Lord Cottenham, C., said that the Court would not be justified in granting the injunction unless the plaintiff's title was established beyond all possibility of doubt. (*s*)

In *Muntz* v. *Foster*, (*t*) however, Lord Lyndhurst affirmed an injunction granted in defence of a patent of eleven years' standing, but of which the novelty was disputed, although the defendants alleged that the injunction would stop their works, and throw from forty to fifty people out of employment. (*u*)

But where the plaintiff stood by and allowed the defendants to erect blast furnaces and practise the invention, in the expectation that the defendants on making proof of its utility would pay a royalty as others had done, and the defendants refused to pay such royalty and disputed the validity of the patent, Lord Cottenham, C., dissolved the injunction, despite the fact that the patent was of more than twelve years' standing, saying that although the plaintiff might be fully entitled to his royalty, in expectation of which he had allowed the defendants to go on using his invention, it would, on the other hand, be extremely hard to tell the defendants that they shall not use the works which, with the plaintiffs' knowledge, they have prepared at a very considerable expense. To stop the works by injunction under such circumstances, said the Lord Chancellor, would be to invert the purpose for which an injunction is used, and to create mischief rather than prevent it. (*v*)

In *Plimpton* v. *Spiller*, Brett, J.A., dealing with the stoppage of trade arising from an injunction, said: "There will be a hardship on the one side or on the other, and the question is, On which side does the balance appear to lie? Now, if the trade of a defendant be an old and an established trade, I should say that the hardship upon him would be too great if an injunction were granted. But when, as here, the trade of the defendant is a new trade, and he is the seller of goods to a vast number of people, it

(*r*) *Renard* v. *Levinstein*, 2 H. & M. 631 (per Wood, V.C.).

(*s*) *Neilson* v. *Forman*, 2 Coop. Ch. Ca. 61, n.

(*t*) 2 W. P. C. 92.

(*u*) See, also, *Davenport* v. *Jepson*, 4 De G. F. & J. 445.

(*v*) *Neilson* v. *Thompson*, 1 W. P. C. 285; 2 Coop. Ch. Ca. 61 n.

seems to me to be less inconvenient, and less likely to produce irreparable damage, to stop him 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. Therefore, as a rule of conduct, I think that in such a case as this it is better, where the trade of the defendant is a new one—and not an old established trade—and where there are likely to be many customers of the new trade, to say that you will act against the new trade by injunction, whereas if he were carrying on an old trade you would act in the other way." (*w*)

In the *United Telephone Company* v. *Tasker*, (*x*) the Court, to prevent the injunction ruining the defendant's business, required the plaintiffs to undertake to supply the defendants, who had been using pirated machines, with lawful instruments until the hearing of the action.

In the *North British Rubber Company* v. the *Gormully Company*, (*y*) Chitty, J., gave weight to the circumstance that the defendants had established a growing trade, and, on the defendants' suggestion, directed them to pay a sum into court to represent royalties, and keep an account pending the trial, as a more convenient course than granting an interlocutory injunction. In this case the plaintiffs, however, had been guilty of delay.

Where the Court refuses an interlocutory injunction it may dismiss the motion with costs; or order the motion to stand over till the trial, (*z*) leaving the question of costs to be decided at the hearing; or it may, while refusing the injunction, put the defendant on terms to keep an account pending the trial of the action. (*a*)

Undertaking as to Damages.—When an interlocutory injunction is granted it is the practice of the Court to require the plaintiff on whose behalf the injunction is ordered to give an undertaking to abide by any order the Court may make in the defendant's favour for damages, should it subsequently appear that the plaintiff's patent is invalid or that from some other reason the plaintiff was not entitled to an injunction. Even where the case for an interlocutory

(*w*) L. R. 4 C. D. 292, 293.

(*x*) 5 R. P. C. 633.

(*y*) 12 R. P. C. 17.

(*z*) *Crosskill* v. *Evory*, 10 L. T. 459; *British Tanning Co.* v. *Groth*, 7 R. P. C. 1.

(*a*) *Cochrane* v. *Smethurst*, D. P. C. 356 n.; *Jones* v. *Pearce*, 1 W. P. C. 544; 5 M. & G. 208; 12 L. J. C. P. 179; *Edison-Bell* v. *Hough*, 11 R. P. C. 594; *Dunlop Pneumatic Tyre Co.* v. *Pneumatic Tyre Co.*, 14 R. P. C. 263; *Holophane* v. *Berend*, 15 R. P. C. 18; *Leonhardt* v. *Kallé*, 11 R. P. C. 534; *Pneumatic Tyre Co.* v. *Friswell*, 13 R. P. C. 15; *Crosskill* v. *Tuxford*, 5 L. T. 342; *Neilson* v. *Fothergill*, 1 W. P. C. 287.

injunction is clearly made out this rule will be applied. (*b*) This rule aids the Court in that which is its great object on these applications, viz.—to abstain from expressing any opinion upon the merits of the case until the hearing. (*c*) The rule applies as well to injunctions obtained on notice of motion as on *ex parte* applications.

"If any damage has been occasioned by an interlocutory injunction," said James, L.J., in *Graham* v. *Campbell*, (*d*) "which, on the hearing, is found to have been wrongly asked for, justice requires that such damage should fall on the voluntary litigant who fails, not on the litigant who has been without just cause made so." (*e*)

Evidence on Applications for Interlocutory Injunctions.—Where relief is sought by means of an interlocutory injunction, the Court will act on the evidence in the affidavits before it. (*f*)

The legal title of the plaintiff, as well as the particulars of the infringement of which he complains, should be clearly set out. He ought to state that he is the first and true inventor, or if he is an assignee, that the patentee is the first and true inventor, and shew how his title is derived from the patentee. Also that at the time of the application he believes the patent to be valid.

"When a party comes for an injunction against the infringement of a patent," said Lord Lyndhurst in *Sturtz* v. *De La Rue*, (*g*) "he ought to state that he believes, at the time when he makes the application, that the invention was new, or had never been practised in this kingdom at the date of the patent. It is not enough that it was believed to be new at the time when the patent was taken out."

So, likewise, it will not be sufficient to allege the infringement complained of generally with a mere, "I am informed and believe." For it is a rule which the Courts will strictly enforce, that where a suitor states his belief of a fact on an interlocutory motion he must also state the grounds of such belief. The Court will not grant an injunction on mere suspicion, and if the particulars of infringement are not set out, the plaintiff's evidence will have little weight. (*h*)

(*b*) *Newby* v. *Harrison*, 3 De G. F. & J. 287; *Renard* v. *Levinstein*, 2 H. & M. 628; 11 L. T. (N. S.), 766; 13 W. R. 382.

(*c*) Per Kindersley, V.C., in *Wakefield* v. *Buccleuch*, 11 Jur. (N. S.), 524.

(*d*) L. R. 7 C. D. 494.

(*e*) See, also, *Moser* v. *Jones*, 10 R. P. C. 368; *Fenner* v. *Wilson*, 10 R. P. C. 287; *Edison-Bell* v. *Bernstein*, 14 R. P. C. p. 159; *Plimpton* v. *Spiller*, 4 C. D. 286.

(*f*) Per Lord Eldon in *Hill* v. *Thompson*, 1 W. P. C. 230; *Mayer* v. *Spence*, 1 J. & H. 87.

(*g*) 5 Russ. 329.

(*h*) *Germ Milling Co.* v. *Robinson*, 1 R. P. C. 217.

"The rule of the Court is," said Rigby, L.J., in the *Saccharin Corporation* v. the *Chemical and Drugs Company*, (*i*) "that on interlocutory applications only is information and belief to be received at all, and that in that case, which is the only case where information and belief is admitted as evidence, you must shew the nature of that information. I will only refer to what the late Master of the Rolls, Sir George Jessel, said in the case of the *Quartz Hill Gold Company* v. *Beal*. (*j*) In a case of an interlocutory application, 'and where an affidavit is made upon information and belief, the rules of the Court require that the deponent should state what are the grounds of his information and belief'—of course he is talking of the case before him, of an interlocutory application—'and that he does not do, he only says they'—those are the assertions—'are untrue to the best of his knowledge, information, and belief, not saying what the best of his knowledge is, and it may be nothing at all. There is, therefore, no evidence as to the truth of the allegations in the circular.' I think that is true and sound law, and to say simply, 'I am informed and believe,' is not evidence, and does not constitute an affidavit evidence at all."

Although the Court has power to require the attendance of persons who have sworn affidavits for the purpose of cross-examination at the hearing of the motion, this power is but rarely exercised; and where witnesses are summoned to attend for this purpose, their cross-examination will not be allowed to develop into a general trial of the matters in issue, as if it were the hearing of the action. (*k*)

So, likewise, where a defendant files affidavits in opposition to an interlocutory injunction, it is not sufficient for him to allege generally his information and belief that the plaintiff's patent is invalid; he must point out in what respect the patent is bad and set out the grounds of his belief. (*l*)

In *Whitton* v. *Jennings*, (*m*) a bill was filed for an injunction to restrain the infringement of a patent or for leave to bring an action at law. The defendant stated by his answer that the invention was not novel and that the patent was therefore invalid. The plaintiff, without filing an affidavit as to the novelty of the

(*i*) 15 R. P. C. p. 55.

(*j*) L. R. 20 C. D. p. 508.

(*k*) *Bracher* v. *Bracher*, 7 R. P. C. 421; *Saccharin Corporation* v. the *Chemical & Drugs Co.*, 15 R. P. C. 56. Here the cross-examination allowed was before the Court of Appeal.

(*l*) *Read* v. *Andrew*, 2 R. P. C. 119.

(*m*) 1 Dr. & S. 110.

invention and the validity of the patent, moved for an interlocutory injunction. Kindersley, V.C., refused the injunction and the leave to bring an action unless the plaintiff produced a clear and distinct affidavit that the invention was new and the patent valid; but allowed the motion to stand over.

In *Read* v. *Andrew*, the patent was fourteen years old, and the evidence filed in support of the motion was clear, distinct, and explicit. The defendants having insufficient evidence to resist the motion, applied for an adjournment and offered to keep an account. But Bacon, V.C., refused to grant an adjournment, saying that he did not credit the defendants' statement that they had not had time to meet the case. "It is not a complicated case; it relates to plain, patent facts which, as far as they imply knowledge of the practice to the defendants, are within their plain knowledge; they can read the patent; they know the practice; they can say, and could have said within eight and forty hours as well as within any other period, what they have to say about the validity of the patent." (*n*)

Uberrima Fides Necessary.—Where the application is made *ex parte*, the plaintiff must shew *uberrima fides*, and disclose for the information of the Court all the facts in his knowledge, so that the Court may be able to judge fairly on the whole case. Otherwise any injunction obtained will be liable to be dissolved by the Court when the concealed facts are discovered. (*o*)

In *Gardner* v. *Broadbent*, (*p*) where the plaintiff, who was the assignee of the inventor, simply stated his belief that as purchaser he had a valid patent, the Court held the statement insufficient. Stuart, V.C., said: "When the plaintiff applied for an *ex parte* injunction, his affidavit ought to have stated clearly and distinctly that he believed the patentee from whom he purchased the patent was the original and true inventor, and that he believed that the invention had not been practised at the time when the patent was granted."

Disobeying the Injunction.—Defendants who disobey an injunction granted against them are guilty of contempt, and liable to imprisonment, and it is no answer for them to shew that the order had not been served, if in fact they were aware that an injunction had been granted against them. (*q*)

(*n*) 2 R. P. C. p. 122.

(*o*) *Dalglish* v. *Jarvie*, 2 McN. & G. 231.

(*p*) 4 W. R. 767; 2 Jur. (N. S.), 1041.

(*q*) *United Telephone* v. *Dale*, L. R. 25 C. D. 778; *Avory* v. *Andrews*, 51 L. J. Ch. 414; 46 L. T. 279; 30 W. R. 564. See the Scottish case of *Harvie* v. *Ross*, 4 R. P. C. 234, where a fine and costs were imposed instead.

Where the disobedient defendants are a company, the directors are liable to be committed. (*r*)

A defendant who has submitted to an injunction will not be allowed on a motion for attachment for breach of that injunction to allege the invalidity of the plaintiff's patent, or that his own prior acts were not infringements. (*s*)

An undertaking to keep an account is as binding on the defendants as an injunction would be, and must be faithfully observed. (*t*)

On a motion to commit for contempt, costs may be given as between solicitor and client to the party moving, (*u*) but not to the respondent if the motion is dismissed; for such costs are in the nature of an indemnity to the plaintiff where the respondent is not in fact committed. (*v*)

A motion to commit should not be made unless there is a clear case of contempt. Its use will not be encouraged as a machinery merely for getting an apology and costs. (*w*)

Expediting the Trial of the Action.—Sometimes when a motion for an interlocutory injunction is unsuccessful the plaintiff seeks to obtain an order expediting the trial of the action. This necessarily involves, however, postponing other litigants, and usually such an application will not be granted; the rule upon which the Court acts being that where an injunction is not given, the damages awarded at the trial are a full and adequate compensation for any loss meanwhile sustained by the plaintiff.

In *Farbenfabriken* v. *Bowker*, (*x*) the plaintiffs not being in a position to press their motion for an interlocutory injunction, asked that the trial of the action might be expedited, on the ground that the trade to which their patent related (dyeing) was subject to constant innovations, and the commercial value of their patent might at any time be destroyed by the introduction of some new dye; they also relied on the circumstance that the defendant, by underselling them with infringing articles, was destroying their trade.

In refusing the application, Stirling, J., said: "The patent is for the usual term, and I confess I do not think that the mere fact that the patentee is apprehensive that his monopoly may practically not be found to extend over the whole term, ought to give

(*r*) *Spencer* v. *Ancoats Vale Co.*, 6 R. P. C. 68.

(*s*) *Moore* v. *Thomson*, 6 R. P. C. 626; 7 R. P. C. 325.

(*t*) *Thomson* v. *Hughes*, 7 R. P. C. 71.

(*u*) *Spencer* v. *Ancoats Co.*, 6 R. P. C. 68.

(*v*) *Plating Co.* v. *Farquharson*, L. R. 17 C. D. p. 57; Griff. P. C. 187.

(*w*) Ibid. p. 56.

(*x*) 8 R. P. C. 136.

him a right to have his cause tried before those of other suitors, who have used the ordinary diligence in coming to the Court. It is said that the defendant is offering infringing articles at greatly reduced prices to the public, and that the plaintiff's sales are falling off, and that such falling off is attributable to the offers made by the defendant of his spurious articles. As regards that, I think that it simply comes to this. The plaintiff is, unfortunately, by the practice of the Court, unable to obtain an interlocutory injunction. He consequently is suffering injury in the meantime, if his case be well founded. In the view of the Court, that loss which he suffers will be made good by the damages which he will obtain at the trial, or by the account of profits which may be given him. Under these circumstances, I see no special ground which should have sufficient weight given to it to induce me to advance the case so as to give it priority over other actions."

Where the plaintiffs had been harassed by numerous infringements by persons of small means, who contested the patent right up to trial, and then failed to appear, Stirling, J., being of opinion that they were not entitled to an interlocutory injunction, expedited the trial of the action, on grounds of the special hardship of their position. (*y*)

The Pleadings.

Statement of Claim.—The pleadings in a patent action are governed by the ordinary rules which apply to actions in the High Court, (*z*) and are only peculiar in this respect, that there must be delivered with the statement of claim particulars of breaches, setting out the instances of infringement in respect of which the plaintiff claims relief; (*a*) and with the defence particulars of objection, stating the objections, if any, upon which the defendant relies to establish the invalidity of the plaintiff's patent. (*b*)

It is not necessary for the plaintiff to allege the novelty of the invention in the statement of claim, as the allegation of the grant throws upon the defendant the onus of disputing it; (*c*) nor that the fees requisite to keep the patent in life have been paid. (*d*)

The plaintiff must shew his right to sue by pleading the grant of the letters patent under which he claims his monopoly, and his

(*y*) *Edison-Bell Phonograph* v. *Hough*, 11 R. P. C. 594.
(*z*) R. S. C. Orders 19, 21.
(*a*) Patents Act, 1883, s. 29 (1).
(*b*) Ibid. s. 29 (2).
(*c*) *Amory* v. *Brown*, L. R. 8 Eq. 664; 38 L. J. Ch. 593.
(*d*) *Sarazin* v. *Hamel*, 32 Beav. 145.

title thereto, either as original grantee or by assignment. But it has long been decided that he need not set out the contents or effect of the specification. (*e*)

In the statement of claim the infringement complained of need only be alleged generally, as the details are set out in the necessary particulars of breaches.

The statement of claim will conclude with a claim for an injunction, an enquiry as to damages, or an account and delivery up to the plaintiff or destruction of all infringing articles in the possession or control of the defendant. Costs need not be claimed, unless the plaintiff has obtained in a prior action a certificate that the validity of his patent has been in issue; in which case the certificate and a claim for costs as between solicitor and client should be added. (*f*)

If the defendant makes default, and does not deliver a defence within the time prescribed by the rules, the plaintiff may set down a motion for judgment. (*g*) But where there were several defendants, and some put in a defence and some did not, Chitty, J., refused leave to set down the action on motion for judgment against the defendants in default, on the ground that the other defendants might at the trial upset the patent. (*h*)

Defence.—In his defence a defendant may deny the infringement and impeach the patent, or he may rely upon either of those defences.

In *Hocking* v. *Hocking*, (*i*) the defendant denied the infringement, and pleaded further that if the plaintiff's patent was construed so widely as to include his apparatus, it was bad for want of novelty, and named certain prior specifications. The Court of Appeal held this alternative plea redundant, as disclosing no defence which was not covered by the first plea, but refused to strike it out as calculated rather to assist than embarrass the plaintiffs, by giving them and the Court information which might be useful at the trial.

If the defendant decides to dispute the plaintiff's right to his monopoly, under the letters patent, various other defences are open to him.

He may plead that the grantee of the letters patent sued upon

(*e*) *Kay* v. *Marshall*, 2 W. P. C. 39; *Westhead* v. *Keene*, 8 L. J. Ch. 89; 1 Beav. 289.

(*f*) *Pneumatic Tyre Co.* v. *Chisholm*, 13 R. P. C. 488. For forms of statements of claim and defences, see Appendix IV.

(*g*) R. S. C. Order 27, rule 11; *United Telephone* v. *Smith*, 61 L. T. 617.

(*h*) *Actien Gesellschaft* v. *Remus*, 12 R. P. C. 94. This notwithstanding Order 27, rule 3.

(*i*) 3 R. P. C. 292.

was not the true and first inventor of the invention patented. (*j*) This plea goes further than a plea of want of novelty, and it would seem that particulars of objection delivered under it must state who the first inventor was. (*k*) It is the proper plea where the patentee is a first importer and it is intended to contest that claim. It should not be pleaded if all that the defence intend to suggest by it is that the invention is not new. (*l*)

By the plea that the alleged invention is not new, the defendant alleges that the letters patent are void because the plaintiff's invention was in use by or otherwise known to the public prior to the date of the grant. That is all; he does not thereby contest the sufficiency of the subject-matter of the grant or of the specification. (*m*)

The particulars under this plea must state the time and place of the previous publication or user alleged. (*n*)

It is also open to the defendant to plead that the alleged invention is not useful. This plea, which is a compendious mode of alleging that the letters patent are void because the monopoly they purport to legalize is prohibited by the Statute of Monopolies as being contrary to the law, mischievous to the State, to the hurt of trade, and generally inconvenient, (*o*) has, after some doubt as to the correctness of its form, (*p*) now been authorized by the form of defence to a patent action contained in the Appendix to the Rules of the Supreme Court. (*q*)

A plea that the alleged invention is not subject-matter for a patent grant is a proper defence where the defendant proposes to contend at the trial that the plaintiff's invention is not a "manufacture" within the meaning of the Statute of Monopolies, *e.g.* that it is a mere abstract principle, and not capable of being made the subject of a patent grant. (*r*)

A defendant may also rely by way of defence upon any ground which at the commencement of the Patents Act, 1883, would have been available as a ground of repealing letters patent by *scire*

(*j*) 21 Jac. I. c. 3, s. 6.

(*k*) *Siddell* v. *Vickers*, 5 R. P. C. 85; but see *Russell* v. *Ledsam*, 11 M. & W. 647; 12 L. J. Ex. 439.

(*l*) *Thomson* v. *Macdonald*, 8 R. P. C. 9; *Morgan* v. *Windover*, 7 R. P. C. 449; see also *Kurtz* v. *Spence*, 5 R. P. C. 161; 4 R. P. C. 427.

(*m*) See *Walton* v. *Potter*, 1 W. P. C. 598, n.; 11 L. J. C. P. 138; *Walton* v. *Bateman*, 1 W. P. C. p. 623; *Bateman* v. *Gray*, 22 L. J. Ex. 290; Macr. P. C. 115.

(*n*) Patents Act, 1883, s. 29 (3).

(*o*) 21 Jac. I. c. 3, s. 6. Per Parke, B., in *Morgan* v. *Seaward*, 1 W. P. C. p. 197; 2 M. & W. p. 5.

(*p*) See *Jupe* v. *Pratt*, 1 W. P. C. 151, and *Morgan* v. *Seaward*, supra.

(*q*) See *Annual Practice*, 1900, vol. ii. App. D, s. vi. p. 72.

(*r*) See *Walton* v. *Potter*, 1 W. P. C. 598, n.

facias. (*s*) Thus, he may plead that there is disconformity between the specifications, that the complete specification is ambiguous and calculated to mislead, that it does not distinguish the old from the new, that it does not sufficiently describe the manner of performing the invention, and that it does not disclose the best mode of performing the invention known to the patentee at the time it was filed; or that the letters patent are void as being in derogation of a prior grant by the Crown, or as made upon a false suggestion by the grantee.

The defendant may further plead that the letters patent have lapsed through non-payment of the patent fees; (*t*) or that the infringement complained of was committed prior to the publication of the complete specification, (*u*) or prior to an amendment of the specification. (*v*)

A defence is embarrassing if the Court cannot find out without a minute criticism of each paragraph what the defendant means. (*w*)

In an action on a contract between two parties for the working and development of a patented invention, the defendant may raise any issue open to him on the contract, such as fraud or want of consideration, but he cannot set up defences as if the action were one of infringement, and in that form dispute the validity of the patent. (*x*)

The Particulars.

Particulars of Breaches.—By Section 29 of the Patents Act, 1883, (*y*) it is provided that the plaintiff in an action for infringement of a patent must deliver with his statement of claim, or by order of the Court or judge, at any subsequent time, particulars of the breaches complained of; and that at the hearing no evidence shall, except by leave of the Court or a judge, be admitted in proof of any alleged infringement of which particulars are not so delivered. (*z*)

(*s*) Patents Act, 1883, s. 26 (3).

(*t*) Ibid. s. 17.

(*u*) Ibid. s. 13.

(*v*) Ibid. s. 20.

(*w*) *McDougall* v. *Partington*, 7 R. P. C. 216.

(*x*) Ibid.

(*y*) 46 & 47 Vict. c. 57.

(*z*) Apart from Statute, the Court has jurisdiction to order particulars of breaches to be delivered to the defendant, in order that the defendant may not be taken by surprise at the trial (*Bulnois* v. *McKenzie*, 1 W. P. C. 260; 4 N. C. 127; 5 Scott, 419; 6 Dowl. P. C. 21; *Perry* v. *Mitchell*, 1 W. P. C. 269; *Electric Telegraph Co.* v. *Nott*, 4 C. B. 468; 16 L. J. C. P. 174). The Patent Law Amendment Act, 1852 (15 & 16 Vict. c. 83, s. 41), required the plaintiff in any action for the infringement of letters patent in any of her Majesty's Superior Courts of Record at

The statute does not prescribe any special form in which these particulars must be stated, but in preparing them it is important to remember that the object of requiring them to be given is to prevent the defendant being taken by surprise at the trial. (*a*) They ought, therefore, to be so drawn as to give the defendant full and fair notice of the case he will have to meet. (*b*) If they do this they are sufficient. The plaintiff must also remember that his evidence will at the trial be restricted to such breaches as are alleged in his particulars. (*c*)

"The object of having these particulars," said Wood, V.C., in *Needham* v. *Oxley*, (*d*) "is to give the defendant fair notice of what the complaint against him is, not to tie the plaintiffs down to the precise terms of any verbal definition, or to make the trial of the issue turn upon a point of form. Full and fair notice the defendant is entitled to."

In that case the particulars specified certain machines made by the defendants for certain named persons, and this was held sufficient, an attempt to get particulars of the respects in which each machine infringed being defeated.

The Court will distinguish between the particulars required of a plaintiff alleging infringement and of a defendant alleging that the plaintiff's patent is bad, inasmuch as the facts of his own infringement must be well known to the defendant, whereas in particulars of objections the plaintiff may be wholly without knowledge of the matters relied on to establish the invalidity of his patent. (*e*)

In *Batley* v. *Kynoch*, where the case was plain and simple, it was held sufficient to produce the article complained of (a cartridge) and make it an exhibit; and the Court declined to order the plaintiff to specify what particular parts of his specification he alleged were infringed. (*f*)

The plaintiff must give the defendant notice of all the

Westminster, or in Dublin, to deliver with his declaration particulars of the breaches complained of, and confined the evidence at the trial to those cases of infringements of which particulars had been given. The practice thus introduced as to Courts of Common Law was adopted by the Courts of Equity (see *Curtis* v. *Platt*, 35 L. J. (N. S.), Ch. 853; *Finnegan* v. *James*, L. R. 19 Eq. 72; 44 L. J. Ch. 185.

(*a*) *Batley* v. *Kynoch*, L. R. 19 Eq. 229; see, also, *Petman* v. *Bull*, 3 R. P. C. 390; reported as *Ledgard* v. *Bull*, 11 App. Ca. 648. Forms of Particulars are given in Appendix IV. post.

(*b*) Ibid.

(*c*) Patents Act, 1883, s. 29.

(*d*) 1 H. & M. 248.

(*e*) *Talbot* v. *La Roche*, 15 C. B. 310; *Ledgard* v. *Bull*, L. R. 11 App. Ca. 648.

(*f*) L. R. 19 Eq. 229; cf. *Egleton* v. *Nichols*, 7 R. P. C. 423.

infringements upon which he intends to rely at the trial. It will not do for him to set out instances by way of illustration only, and so reserve to himself the right to give evidence at the trial of other infringements of a like nature.

Thus, in the *Patent Type Founding Company* v. *Richards*, (*g*) where the plaintiffs, in reply to an order for further particulars of breaches, enumerated certain instances, and added, "The plaintiffs state these particular instances by way of example only, and not so as to preclude them from proving any of the infringements mentioned in the former particulars of breaches;" these words were ordered to be struck out. Again, in *Church* v. *Wilson*, (*h*) where the plaintiffs' particulars of breaches alleged that they complained "in particular, by way of illustration, of the following instances." The words "in particular, by way of illustration," were ordered to be struck out.

In *Haslam* v. *Hall*, (*i*) the plaintiffs stated in their particulars that, "by way of example and not of limitation," they complained of machines fitted by the defendants on board the ship *Selembria*. The defendants objecting to such particulars, the Court made an order confining the plaintiffs to the infringements on the *Selembria* unless they gave further names. (*j*)

Where, however, the plaintiffs complained generally of the defendant making and selling pictures made by a special process, and added, "One of such pictures was made and sold by the defendant to one *C.* on the 27th April, 1854; but plaintiff states this by way of example only, and not so as to preclude him at the trial from insisting on other infringements," the Court of Common Pleas refused to order further particulars, apparently on the ground that the instance given being representative of all the others, there was no likelihood of surprise. (*k*)

In *Elsey* v. *Butler*, (*l*) the patent was for "improvements in the manufacture of lace, in twist-lace machinery, and in apparatus employed therein." The plaintiff delivered particulars of breaches, alleging that the defendant had infringed "by the production in a twist-lace machine, or in twist-lace machines, of lace fabrics in the manner described in the specification of the said patent, p. 3, l. 22 to p. 9, l. 39, or in a manner only colourably differing therefrom; and by the use of the improved combinations of apparatus therein

(*g*) 2 L. T. (N. S.), 359.
(*h*) 3 R. P. C. 123.
(*i*) 4 R. P. C. 203.
(*j*) See, also, *Ehrlich* v. *Ihlee*, 5 R. P. C. 39.
(*k*) *Talbot* v. *La Roche*, 15 C. B. 310.
(*l*) Griff. 96; 1 R. P. C. 189.

described, and also in particular by the production in a twist-lace machine, or in twist-lace machines, of fabric known as 'double-tie Swiss net' in the manner described in the specification of the said patent, p. 6, l. 57 to p. 7, l. 38, or in a manner only colourably differing therefrom, and by the use of the improved combinations of apparatus therein described." These particulars were held sufficient by Pearson, J.

Again, where the defendant was not the manufacturer of the articles complained of, the Court has been less exacting in limiting the plaintiff to the cases actually specified in his particulars.

Thus in *Tilghman* v. *Wright*, (*m*) the particulars of breaches were as follows: "The defendants have infringed the plaintiff's patents in the statement of claim mentioned, by importing into this country, selling, exposing for sale, using, and otherwise dealing with glass globes, shades, or moons, having their surfaces wholly or in part ground, roughened, or obscured by the projection against such surfaces of a stream of sand, or other suitable similar material." The defendants having applied for better particulars, Pearson, J., while requiring the plaintiffs to specify particular instances, allowed, as in *Talbot* v. *La Roche*, (*n*) general words to be added, so as not to confine the plaintiffs solely to those instances.

Where the plaintiff has not sufficient information to deliver full particulars of all the infringements he believes to have been committed, his proper course is to interrogate the defendant, and, if necessary, amend his particulars thereafter.

In *Russell* v. *Hatfield*, (*o*) where the defendant also was a manufacturer, the plaintiff alleged in his particulars of breaches sales to a specified railway company and other persons. On this the defendant applied for better particulars, but the plaintiff alleging that he did not at the time know the names of the other persons with whom the sales had been effected, but was going to interrogate, his particulars were held sufficient, pending the defendant's answers to interrogatories.

The object of the particulars of breaches being to tell the defendant what the plaintiff says he has done in infringement of the patent, it is not their office to answer an interrogatory as to the construction of the specification. Therefore, the defendant cannot compel the plaintiff to construe his patent in his particulars of breaches. (*p*)

It is not generally necessary that the particulars of breaches

(*m*) 1 R. P. C. 103; Griff. 216.
(*n*) See supra.
(*o*) 2 R. P. C. 144; Griff. 204.
(*p*) *Wenham* v. *Champion*, 8 R P. C. 22.

should specify the parts of the plaintiff's patent alleged to be infringed by referring to the lines and pages of the specification. (*q*) But where the specification includes several claims, and the plaintiff only complains of infringement of some of these, the particulars of breaches ought to indicate which. (*r*)

Where the infringer is a seller only, and not a manufacturer of the articles complained of, the plaintiff, although less strictly tied down to the actual instances specified by him in his particulars, will usually be required to give more detailed information as to the manner in which he alleges his patent to be in fact infringed by the defendant's sales; for the mere seller of an article has not the knowledge possessed by a manufacturer as to the processes by which it is made. (*s*)

Particulars delivered may from time to time be amended by leave of the Court or a judge. (*t*)

Infringements of which no notice has been given in the particulars of breaches cannot (except by leave) be given in evidence at the trial. (*u*)

Particulars of Objections.—In an action of infringement the defendant must deliver with his statement of defence, or by order of a Court or a judge, at any subsequent time, particulars of any objections on which he relies in support thereof. If the defendant disputes the validity of the patent, the particulars delivered by him must state on what grounds he disputes it, and if one of those grounds is want of novelty, the time and place of the alleged previous publication or user must be given. At the hearing no evidence shall, except by leave of the Court or a judge, be admitted in proof of any objection of which particulars are not so delivered. (*v*)

Notice of the objections upon which the defendant intended to rely were formerly required to be given to the plaintiff under 5 & 6 Will. IV. c. 83, s. 5, and under Section 41 of the Patent Law Amendment Act, 1852. Discussing the notice of objections required by the first of these Statutes, Tindal, C.J., in *Fisher* v. *Dewick*, (*w*) said the object of requiring notice to be given to the

(*q*) *Cheetham* v. *Oldham*, 5 R. P. C. 624.

(*r*) Ibid.; see, also, *Haslam* v. *Hall*, 4 R. P. C. 203; *Lamb* v. *Nottingham*, *Seton on Decrees*, vol. i. p. 557; *Wrenn* v. *Wield*, L. R. 4 Q. B. 213.

(*s*) *Mandelberg* v. *Morley*, 10 R. P. C. 256.

(*t*) Patents Act, 1883, s. 29 (5).

(*u*) *Henser* v. *Hardie*, 11 R. P. C. 421. As to particulars in an action for infringement of a chemical patent, see *Cassella* v. *Levinstein*, 8 R. P. C. 475.

(*v*) Patents Act, 1883, s. 29 (2) (3) (4); *Perry* v. *Société des Lunetiers*, 13 R. P. C. 670; see Forms, Appendix IV. post.

(*w*) 1 W. P. C. 267; 4 Bing. (N. C.), 706; 7 L. J. C. P. 279; see, also, *Jones* v. *Berger*, 1 W. P. C. 544; 12 L. J. C. P. 179.

plaintiff "was not to limit the defence, but to limit the expense to the parties, and more particularly to prevent the patentee from being upset by some unexpected turn of the evidence." In another case under the same Act, Lord Abinger, C.B., said that the legislature never intended that the defendant should argue his case in particulars of objection. (*x*) The object, therefore, of the earlier Acts in requiring the defendant to give notice of his objections was to provide the plaintiff with fair notice of the case to be made against him, and to prevent his being taken by surprise at the trial.

Dealing with the provisions of the present Act, Bristowe, V.C., in *Boyd* v. *Horrocks*, (*y*) said: "I take it that the real meaning of this Act, as it was of the former Act, is not to bear oppressively upon either party, but to require each party to give so much information as shall enable an action to be tried with the least expense, and as few materials as are consistent with a due trial, so that the case shall not be encumbered with a mass of proof which, when the action comes on for trial, may be absolutely nugatory and useless." "The object of particulars," said Lindley, L.J., in *Holliday* v. *Heppenstall*, "is simply to prevent surprise." (*z*)

The defendant should state his particulars as concisely as possible, and avoid alleging instances of objection upon which he does not intend to rely at the trial. (*a*) In *Allen* v. *Oates*, (*b*) Kekewich, J., in commenting on the frequency with which long lists of objections were given, when only one or two were really relied on by the defendant, suggested that it might be desirable to have the particulars reviewed by some officer of the Court, so as to settle the real issues before trial.

Where the defendant intends to allege that the plaintiff's patent is bad, because some person other than the patentee is the actual inventor of the invention, the objection that the patentee is not the true and first inventor is a proper one to take. Formerly when this objection was taken it was held that the defendant in making it need not state who the true and first inventor was; (*c*) but now it would seem that such information ought to be given. (*d*)

(*x*) *Heath* v. *Unwin*, 10 M. & W. 687.
(*y*) 3 R. P. C. p. 287.
(*z*) 6 R. P. C. p. 328.
(*a*) *Thomson* v. *Batty*, 6 R. P. C. 84, p. 97.
(*b*) 15 R. P. C. 303.
(*c*) *Russell* v. *Ledsam*, 11 M. & W. 647; *Heath* v. *Unwin*, 10 M. & W. 684; *Bulnois* v. *McKenzie*, 4 Bing. N. C. 127; 6 Dowl. 215.
(*d*) See Kekewich, J., in *Morgan* v. *Windover*, 7 R. P. C. 449.

If, however, the defendant only intends to allege that the plaintiff's patent is not new, or that it contains no invention, he ought not to raise as a particular of objection that the patentee was not the true and first inventor. For in such case this objection is devoid of meaning. (*e*)

Where a defendant alleges that the plaintiff's patent is bad for want of novelty, he may mean either (1) that its novelty is defeated by the state of general public knowledge at the date of the grant; or (2) by actual prior user; or (3) by a prior publication of the invention.

It will be convenient to consider these grounds of objection separately.

1. *Anticipation by Public Knowledge.*

Where a defendant relies upon this objection it is not necessary to specify the particular works by which he proposes to prove the state of general knowledge.

"I do not know," said Cotton, L.J., in *Holliday* v. *Heppenstall*, (*f*) "how far you are to go back as regards general public knowledge, if you are to refer to the books which give that, or upon which the general public knowledge was acquired. Are you to go back to spelling books or anything of that sort? You must prove by witnesses in a general way, and, if necessary, by reference to well-known works, that that was the state of general public knowledge at the time when the specification was filed."

In the same case, Lindley, L.J., in answering the question, What has the defendant to do if his defence is common knowledge? said: "All he has to do is to say so, and that the state of knowledge was such that there is no novelty in the patent. Having said that he need not go on in support of that to give all the evidence he intends to adduce to prove it. He need not put down every chemical book in which dyeing by aniline has been discussed and explained to shew what is common knowledge." (*g*)

Thus, as will be shortly indicated more at length, anticipation by public knowledge differs from anticipation by prior publication, for in the latter case the particulars of the publications relied on must be given. Where, however, the defendant relies to prove his objection of common knowledge upon a single

(*e*) See Kekewich, J., in *Thomson* v. *Macdonald*, 8 R. P. C. p. 9; *Pneumatic Tyre Co.* v. *Cassiccll*, 13 R. P. C. 187.

(*f*) 6 R. P. C. p. 326; L. R. 41 C. D. 114; 58 L. J. Ch. 330.

(*g*) Ibid. p. 328; see, also, *The English and American Machinery Co.* v. *Union Boot and Shoe Co.* 11 R. P. C. p. 374; *Siemens* v. *Karo*, 8 R. P. C. p. 377.

specification, he must give the plaintiff notice of that specification; (*h*) the reason being apparently that such an objection is not really one of common knowledge, but of anticipation by prior publication. (*i*)

2. *Anticipation by Prior User.*

Where the objection to the patent is founded on prior user, (*j*) the defendant must specify particularly the instances of alleged user on which he relies, giving the plaintiff express notice of the time and place of use, and of the address of the user. (*k*) The object of this is to enable the plaintiff to investigate the circumstances of the cases alleged against him, and prepare his evidence for the trial. In such particulars the defendant, where he relies on prior machines, ought to indicate what particular machines he relies on, and not allege generally—machines at the works of such and such a firm. (*l*) But he need not state what particular part of the plaintiff's invention the machine anticipates, for that the plaintiff can ascertain for himself on inspection. (*m*)

In *Smith* v. *Lang*, (*n*) the defendant alleged by way of objection the prior use, sale, or public exhibition of wire ropes made according to the alleged invention by one *W.* from the year 1832 to 1862. This was held insufficient, and further particulars were required.

Where the defendant, as in the case last mentioned, alleges prior user generally over a number of years, the plaintiff, instead of applying for better particulars, may interrogate him as to the names and addresses of the alleged prior users, and, if so interrogated, the defendant will be compelled to answer. (*o*) The object of particulars being to prevent surprise, the defendant must give such particulars as will enable the plaintiff to identify the anticipations relied upon; and not such as will leave it open to the defendant to say at the trial, "I meant something different from what you have inferred." (*p*)

In *Scott* v. *Hull Steam Fishing Company*, (*q*) the particulars

(*h*) *English and American Machinery Co.* v. *Union Boot and Shoe Co.*, supra.

(*i*) *Solvo Laundry Co.* v. *Mackie*, 10 R. P. C. p. 70. As to prior publication, see ante, p. 71, Chap. VI.

(*j*) As to prior user, see ante, p. 93, Chap. VII.

(*k*) *Birch* v. *Mather*, L. R. 22 C. D. 629; 25 L. J. Ch. 292; Patents Act, 1883, s. 29 (3); *Flower* v. *Lloyd*, 20 Sol. J. 860; 45 L. J. Ch. 746.

(*l*) *Boyd* v. *Farrar*, 5 R. P. C. 33.

(*m*) Ibid.

(*n*) 7 R. P. C. 148.

(*o*) *Alliance Syndicate* v. *MacIvor*, 8 R. P. C. 321; 39 W. R. 487; see, also, *Birch* v. *Mather*, L. R. 22 C. D. 629.

(*p*) *Scott* v. *Hull Steam Fishing Co.*, 13 R. P. C. 206.

(*q*) Ibid.

delivered alleged anticipation by a number of prior makers, but did not indicate which particular make of each respective maker the defendants relied on. This, inasmuch as each maker might have several ways of making the same thing, was held to be insufficient.

3. *Anticipation by Prior Publication.*

Where the novelty of the patent is contested on the ground of prior publication of the invention, the particulars must specify in detail the specifications or books relied upon by the defendant to prove his case, the object being to enable the plaintiff to identify the alleged anticipations.

Sometimes the Court will order a defendant to specify by pages and lines the precise parts of the prior specifications upon which he relies. (*r*) Though this is not the general rule, (*s*) it will be done where the prior specifications relied on are intricate and complicated. But not where the specifications are simple, or where the defendant *bonâ fide* relies upon the whole. (*t*)

In *Boyd* v. *Farrar*, (*u*) the defendant relied on anticipation by a number of prior specifications, to which he gave references by pages and lines. The plaintiff, whose patent was of a complicated character, asked for particulars as to what portions of his patent the prior specifications were alleged to anticipate. Kay, J., required these further particulars to be given. "The objection of the defendant, as I gather, is that his hands will be tied if he gives these particulars; but that is the very object of giving and requiring particulars—that his hands may be tied, (*v*) and that the plaintiff may, before the matter comes into Court to be determined on evidence, have stated exactly that upon which the defendant intends to rely, and certainly to say that the particulars would tie the hands of the man who gives them, and that that is an objection to them, is practically to say, 'No, I will not give you any particulars, I will give you general statements,' which is not the law."

In *Harris* v. *Rothwell*, where the matters involved were also intricate and the plaintiff's specification had six claims, Chitty, J., required the defendant to amend his particulars of objection in

(*r*) *Heathfield* v. *Greenway*, 11 R. P. C. 19; *Nettlefolds* v. *Reynolds*, 8 R. P. C. 410.

(*s*) *Holliday* v. *Heppenstall*, 6 R. P. C. 320; *Siemens* v. *Karo*, 8 R. P. C. p. 378.

(*t*) *Sidebottom* v. *Fielden*, 8 R. P. C. 266; *Nettlefolds* v. *Reynolds*, 8 R. P. C. 410.

(*u*) 5 R. P. C. 36.

(*v*) But see *Nettlefolds* v. *Reynolds*, 8 R. P. C. p. 417: per Lindley and Fry, L.JJ.

such a way as to shew to which of the plaintiff's claims each objection was directed. (*w*)

In *Fowler* v. *Gaul*, (*x*) the defendants delivered particulars of objection referring to certain patents and specifications as anticipations of the plaintiff's patent, and alleging that the plaintiff's specification claimed some of the matters specified and patented in such prior patents. The plaintiff objecting to such particulars, it was held by a divisional Court that the defendants must deliver further particulars shewing what parts of the specifications and patents relied on were anticipations of the plaintiff's patent, and what parts were alleged to be claimed by the plaintiff's specification.

Where the defendant alleges anticipation by books, he must in his particulars give the plaintiff such information as will enable the plaintiff to find the part of the particular book relied upon.

In *Harris* v. *Rothwell*, (*w*) the defendants referred to a whole book and also to certain parts of it. But the Court ordered the reference to the whole book to be struck out.

Insufficiency and Variance of Specifications.—Where the defendant objects that the specification of the patentee is insufficient, he must particularise his objection by stating in what respects the specification is so insufficient. (*z*) Thus, it is not enough for the defendant to allege merely that the specification is not such as a competent workman could construct a machine from. He must point out wherein the defect lies; but he cannot be required to tell the plaintiff how to cure the defect. (*a*) So, likewise, it will not suffice to allege generally disconformity between the specifications; particulars must be given of how the invention claimed by the complete specification differs from that outlined in the provisional. (*b*)

Particulars of objection delivered and proved by one defendant may be relied upon by another in the same interest, even when that other defendant has not attacked the validity of the patent. (*c*)

Where a defendant suspects that a ground of opposition exists as to which he is without proper information, his proper course is not to insert in his particulars what he only imperfectly knows,

(*w*) 3 R. P. C. 245; 1 Griff. 109.

(*x*) 3 R. P. C. 247.

(*z*) *Heathfield* v. *Greenway*, 11 R. P. C. 20.

(*a*) *Crompton* v. *Anglo-American Corporation, Limited*, 4 R. P. C. 197; 35 C. D. 283; 56 L. J. Ch. 802.

(*b*) *Anglo-American Brush Corporation* v. *Crompton*, 34 C. D. 152; 4 R. P. C. 27; 56 L. J. Ch. 167.

(*c*) *Smith* v. *Cropper*, 10 App. Ca. 249.

but to wait till he has obtained full information and then apply for leave to amend. (*d*)

Amending Particulars.—Particulars of breaches and particulars of objection may be from time to time amended by leave of the Court or a judge. (*e*) The application should be made by summons at chambers; but it may be made at the trial of the action. (*f*)

Leave to amend may be given after the trial on appeal by the Court of Appeal. (*g*) But the Court of Appeal does not encourage such amendments, and will exercise this jurisdiction with great care; as the necessary effect of allowing substantial amendment at that stage is to re-try the case on appeal, as if the Court of Appeal were a Court of first instance. Thus, in the *Shoe Machinery Company* v. *Cutlan*, (*h*) the Court of Appeal refused to allow a defendant who had fought his case before Romer, J., on twelve alleged instances of anticipation to amend by adding seven new anticipations; the remedy of presenting a petition for revocation still being open to him if his new anticipations were objections which ought to prevail.

Under the Patent Law Amendment Act of 1852, it was decided that where particulars of a vague nature were delivered, it was for the party objecting to them to apply for further particulars, as otherwise any matters falling within the general statement would be admissible at the trial. (*i*) Thus, in *Hull* v. *Bollard*, (*j*) Pollock, C.B., held that an objection of public user "in corn-mills for many years previously," was sufficient to admit evidence of user at certain mills in Cheshire, notwithstanding that the Statute required the particulars to specify the place or places of prior user.

The words of the Patents Act, 1883, are, however, more stringent than those in the earlier enactment; for, after providing that where a defendant disputes the validity of a patent for want of novelty, he must state the time and place of the previous publication or user alleged by him, (*k*) it expressly enacts that no

(*d*) *Aktiebolaget Separator* v. *Dairy Co.*, 13 R. P. C. 725.

(*e*) Patents Act, 1883, s. 29 (5).

(*f*) *Otto* v. *Sterne*, 2 R. P. C. 139; *Blakey* v. *Latham*, 6 R. P. C. 29; *Allen* v. *Horton*, 10 R. P. C. 412; *Westley* v. *Perkes*, 10 R. P. C. 186; *Badische Anilin Fabrik* v. *Société Chimique*, 14 R. P. C. 881.

(*g*) R. S. C. Ordor 58, rule 4; *Cropper* v. *Smith*, 1 R. P. C. 81; 2 R. P. C. 17; 26 C. D. 700; *Shoe Machinery Co.* v. *Cutlan*, 12 R. P. C. 530; 44 W. R. 92; 65 L. J. Ch. 44; see, also, the Irish case of *Pirrie* v. *York Co.*, 11 R. P. C. 429.

(*h*) [1896] 1 Ch. 108; 12 R. P. C. 530; 65 L. J. Ch. 44.

(*i*) *Sugg* v. *Silber*, 2 Q. B. D. 493.

(*j*) 1 H. & N. 134; 25 L. J. Ex. 304.

(*k*) Sect. 29 (3).

evidence shall be admitted (except by leave) in proof of any objection of which particulars are not *so delivered*. (*l*)

The Court has a full discretion to grant or refuse the amendment. Where an applicant seeks by amendment to introduce new matter, the *onus* is upon him to satisfy the Court that the omission from the original particulars of the breach or objection sought to be added was not due to any want of diligence or proper care on his part.

Thus, in *Moss* v. *Malings*, (*m*) where the defendant applied for leave to add new objections at the trial, but did not produce an affidavit shewing that the new matter could not have been discovered earlier, leave was refused. Leave will usually be given where the Court is satisfied that the information upon which the amendment is sought only came to the applicant's knowledge recently. (*n*)

Generally, leave to amend particulars will only be granted on terms. The party seeking leave to amend will be required to pay the extra costs thereby occasioned to the other side; (*o*) and in the case of particulars of objection, the amendment will sometimes only be allowed upon the condition that the plaintiff shall have the option to discontinue the action within a specified time, all costs incurred subsequent to the delivery of the original particulars of objection being paid to him by the defendant. (*p*)

Following the above rule in *Ehrlich* v. *Ihlee*, Chitty, J., said: "It seems to me that that order is a fair order, adapted to ordinary circumstances, and one which, speaking for myself, I should adopt by way of general rule, and for these reasons: the plaintiff is told, in the first instance, as he must be told, what are the objections to the validity of his patent, and, seeing these objections, he determines to proceed with his action. Afterwards some further objection is put in, and that changes the aspect of the case so far as he is concerned; and the order provides that, although on discontinuing subsequently to the delivery of the new particulars of objections, he shall pay the general costs of the action, yet he is to get the costs intermediate between the delivery of the two sets

(*l*) Sect. 29 (4).

(*m*) 3 R. P. C. 373; 33 C. D. 603; see, also, *Shrewsbury Tyre Co.* v. *Morgan*, 13 R. P. C. 75.

(*n*) *Parker* v. *Maignen*, 5 R. P. C. 207; *Pirrie* v. *York*, 11 R. P. C. 431.

(*o*) *Otto* v. *Steel*, 2 R. P. C. 139; *Parker* v. *Maignen*, 5 R. P. C. 208; see, also, *Penn* v. *Bibby*, L. R. 1 Eq. 548.

(*p*) See *Baird* v. *Moule*, 17 C. D. p. 139, n.; *Edison Telephone* v. *India Rubber Co.*, 17 C. D. 137; *Ehrlich* v. *Ihlee*, 4 R. P. C. 115; *Solvo Laundry* v. *Mackie*, 10 R. P. C. 69; *Badische Anilin Fabrik* v. *Societé Chimique*, 14 R. P. C. 881.

of particulars, because there has never been any issue with regard to the new particulars of objection. The plaintiff says, 'There are certain objections to my patent. Well, I meet these.' Then there comes a new objection, which he may not have been aware of at the time, and he says, 'In these circumstances I now find, knowing what the intricacies of the patent law are, that there is a valid objection to my patent which I was not aware of before, and I will discontinue my action.' That is the common case, and, I think, therefore, that this form of order is the proper order in an ordinary case." (*q*)

The above practice does not, however, amount to a binding rule in all cases. For the Patents Act, 1883, gives a discretion to the judge, which no practice, however inveterate, can take away.(*r*)

Inspection.

Jurisdiction and Object of Order.—In an action for infringement of a patent, the Court or a judge may, on the application of either party, make such order for inspection, and impose such terms and give such directions respecting the same and the proceedings thereon, as the Court or a judge may see fit. (*s*)

Order 50, rule 3, of the Rules of the Supreme Court also provides that it shall be lawful for the Court or a judge, upon the application of any party to a cause or matter, and upon such terms as may be just, to make any order for the detention, preservation, or inspection of any property or thing, being the subject of such cause or matter, as to which any question may arise therein, and for all or any of the purposes aforesaid, to authorize any persons to enter upon or into any land or building in the possession of any party to such cause or matter, and for all or any of the purposes aforesaid, to authorize any 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.

The jurisdiction to order inspection in patent suits was originally an equitable jurisdiction exercised only by the Court of Chancery. By the Patent Law Amendment Act, 1852, jurisdiction to order inspection in patent actions was conferred on the Courts

(*q*) 4 R. P. C. 117.

(*r*) Per Esher, M.R., in *Woolley* v. *Broad*, [1892] 2 Q. B. 318; 61 L. J. Q. B. 808. The above form of order was refused by Kay, J., in *Pascall* v. *Toope*, 7 R. P. C. 129. In *Wilson* v. *Wilson*, 16 R. P. C. 315, an order was made following *Woolley* v. *Broad*.

(*s*) Patents Act, 1883, s. 30; see Forms, Appendix IV. post.

of Common Law. (*t*) But this jurisdiction was held to extend only to the inspection of machines or instruments in use, and not to apply to books. (*u*)

The principles upon which the Court will act in ordering or refusing inspection are the principles upon which the Court of Chancery has always acted. (*v*)

The object of the Court in ordering inspection is to enable the issues before it to be properly tried, and not determined on evidence which may be mere conjecture. (*w*) But the Court has a wide discretion in the matter, and must be satisfied (1) that the party seeking inspection has a case to be tried, and (2) that inspection is required to place that case properly before the Court. (*x*)

Where the plaintiff can shew that inspection is material and really wanted for the purposes of the cause, he may obtain an order on notice to the defendant at any time after the issue of the writ of summons, even before the statement of claim is delivered. (*y*) A defendant may apply, on notice to the plaintiff, at any time after entry of appearance in the action. (*z*)

The affidavits in support of an application for inspection must shew the grounds upon which the order is alleged to be necessary to the party applying. Where the applicant did not allege in his affidavits that inspection was necessary to his case, and the other side deposed that it was not, inspection was refused. (*a*) The applicant should set out in his affidavit not only that he believes inspection to be necessary, but also the grounds of that belief; for if the Court thinks that belief to be founded on nothing more than suspicion, inspection will not be ordered.

In the *Germ Milling Company* v. *Robinson*, (*b*) where the patent was for an elaborate process of manufacturing meal and flour so as to separate the germ part of the grain from the meal and flour product, the plaintiff in the fifth paragraph of his affidavit in support of an order for inspection said: "The defendants are extensive corn millers at Deptford Bridge Mill, Greenwich, and

(*t*) 15 & 16 Vict. c. 83, s. 42.

(*u*) *Vidi* v. *Smith*, 3 E. & B. 969; 23 L. J. Q. B. 342.

(*v*) *Holland* v. *Fox*, 23 L. J. Q. B. 360; *Meadows* v. *Kirkman*, 29 L. J. (N. S.), Ex. 205; per Pollock, C.B., *Patent Type Founding Co.* v. *Lloyd*, 5 H. & N. 192; *Shaw* v. *Bank of England*, 29 L. J. Ex. 26.

(*w*) Per Lord Eldon, in *Bovill* v. *Moore* (1815), 2 Coop. 56.

(*x*) *Piggott* v. *Anglo-American Telegraph Co.*, 19 L. T. (N. S.), 46; see, also, *Amies* v. *Kelsey*, 22 L. J. Q. B. 84.

(*y*) *Amies* v. *Kelsey*, 22 L. J. Q. B. 84; *Drake* v. *Muntz Metal Co.*, 3 R. P. C. 43; Griff. 78; R. S. C. Order 50, rule 6.

(*z*) Order 50, rule 6.

(*a*) *Batley* v. *Kynoch*, L. R. 19 Eq. 90.

(*b*) 1 R. P. C. 217.

they have recently introduced therein machinery for reducing wheat into meal and flour by means of rolling and sifting, and I verily believe that the defendants are now manufacturing wheat into flour by means of my said invention, and by the process or means described in my said specification, or only colourably differing therefrom." Kay, J., in refusing to order inspection, said: "The first thing I have to consider is, What sort of evidence is that? There is a rule in this Court that where a person states, as he may in an affidavit upon an interlocutory motion, his belief of a fact, he must state the grounds of that belief. What are the grounds of that belief? There are absolutely none; I mean there are none stated. That means this, then: I suspect; 'I suspect' (because 'I believe' without any grounds is only 'I suspect') 'that the defendants are manufacturing according to my process.' Thereupon, without any particular, without any evidence which the Court ought to look at as being evidence of infringement, the plaintiff comes to the Court and says, 'Grant me inspection.' The defendants' answer in effect, because I am not giving the words, is 'I have a great many processes in my mill which are trade secrets, which I do not want people to inspect.' That is a very good answer until the plaintiff makes out a strong ground for inspection; but in point of fact, the whole of this pleading and evidence before me now only amounts to this: for this reason, which is not expressed, I, the plaintiff, say, 'I suspect the defendants are infringing this elaborate process of mine.' If he had said, 'The nature of the flour they produce is such that it could not have been done by any other process,' and satisfied the Court of that, that would be one thing, and it would come very nearly to the well-known case before Lord Eldon in which inspection was granted. (*c*) But he says nothing of the kind; and this is really no more than this, taking the pleadings and affidavits and everything which is before me, 'I suspect, and I will not tell you the grounds for suspecting, that the defendant is infringing this elaborate process of mine, and I ask for leave to go and look into his works to see whether I can make a case against him or not.' This is not the way in which the Court can grant inspection; and, therefore, at present I decline to make any order on the motion."

So, likewise, the Court will not order a roving inspection; (*d*) or one merely to satisfy the applicant's curiosity. (*e*) It must be

(*c*) *Bovill* v. *Moore*, 2 Coop. 56.

(*d*) *Cheetham* v. *Oldham*, 5 R. P. C. 621, 622.

(*e*) *Piggott* v. *Anglo-American Telegraph Co.*, 19 L. T. (N. S.), 46.

satisfied that inspection is essential to the case of the party applying; and even then it will carefully exercise its discretion in the matter, having due regard to the interests of the parties; for inspection is never a matter of absolute right. (*f*) "The Court is always reluctant," said Lord Halsbury, C., in *McDougall* v. *Partington*, (*g*) "to grant inspection where it may be injurious to one side, and where the right depends on a question which has yet to be determined in the cause."

Trade Secrets.—Sometimes the party resisting an order for inspection objects that the order ought not to be made, as it will place his opponent in possession of valuable trade secrets. (*h*) This objection will not, however, prevent the Court making the order in a proper case. (*i*) But the Court will sometimes give weight to this objection, so far as to appoint some independent person to make the inspection, and to report to the Court. Thus, in the *Plating Company* v. *Farquharson*, (*j*) where the infringement complained of was the use of a process of nickel plating, Jessel, M.R., made an order that Professor Dewar, as analyst, should be allowed access to the defendant's works at all reasonable times (on giving two days' previous notice) to see the defendant's method of making his solutions and the materials used, and the method of the defendant in using those solutions in the process of nickel plating, and to take samples of the solutions and report to the Court the facts, and his opinions founded thereon; no disclosure of the report, or of facts, or opinions obtained or arrived at, to be made by Professor Dewar without the leave of the Court. At the trial this report was perused by the judge, and the leading counsel on both sides, but not otherwise disclosed, and no cross-examination of Professor Dewar was allowed.

In *Badische* v. *Levinstein*, (*k*) the defendants, who relied upon a secret process, were given the option of disclosing it or not, at the trial. They elected to do so, and the evidence was taken *in camera*, reporters and public being excluded.

In an action for infringement of a chemical patent the Court will not order the production of books containing such trade secrets of the defendants as the analysis of the products which they employ in the process they are carrying on, until the plaintiff

(*f*) *Piggott* v. *Anglo-American Telegraph Co.*, 19 L. T. (N. S.), 46; *McDougall* v. *Partington*, 7 R. P. C. 472.

(*g*) 7 R. P. C. p. 473.

(*h*) *Piggott* v. *Anglo-American Telegraph Co.*, 19 L. T. (N. S.), 46.

(*i*) *Bovill* v. *Moore*, 2 Coop. 56.

(*j*) Griff. P. C. 187; see, also, *Flower* v. *Lloyd*, W. N. 1876, 169 & 230.

(*k*) 24 C. D. 156.

has established the validity of his patent. When, however, the plaintiff has done this an application for production of such books may properly be made to the judge at the trial. (*l*)

"It appears to me to be evident," said Bowen, L.J., in *Rawes* v. *Chance*, (*m*) "that one litigant is not entitled to see the books containing the processes of the other litigant unless he wants it for the purposes of justice; and it seems to me to be a corollary only from that broad proposition to say that he is not entitled to see the books and papers of his antagonist until the time comes in the litigation when he wants it for such purposes. . . . What would be the opposite result? Why, that any patentee who is not working himself, might, by bringing an action for infringement against a working competitor, see laboratory processes in the books under the plea that he wanted it to prove infringement, and that he ought to succeed in getting it for that purpose, unless it could be shewn that he could not possibly want it for the purpose of infringement. The answer is, the hands of justice are not so tied; you can wait until the necessary moment comes before you give that which may turn out at that particular moment to be wanted."

Taking Samples.—The Court, in addition to ordering inspection, will also, if necessary, order samples to be taken. (*n*) Apart from the provisions of Order 50, rule 3, the Court has inherent jurisdiction to do this.

Thus, in the *Patent Type Founding Company* v. *Walter*, (*o*) Wood, V.C., said: "The jurisdiction of this Court to order inspection, and, if necessary, the taking of samples for the purpose of a suit here has scarcely been contested. If a precedent is wanted, the case of *Russell* v. *Cowley* is in point. There specimens were allowed to be taken away, though the necessity for so doing was scarcely so great as in the present case; and that the Court when it orders inspection will not stop short of what is necessary to make the jurisdiction of the Court effectual was laid down in the case of the *East India Company* v. *Kynaston*." (*p*)

In the *Patent Type Founding Company* v. *Walter*, the following order was made: "Liberty to the secretary of the company and *Dr. Frankland* (an analytical chemist) to inspect the type used for

(*l*) *Rawes* v. *Chance*, 7 R. P. C. 280; R. S. C. Order 31, rule 20. It would be otherwise, however, if it could be shewn that such books were relevant to the issue of the validity of the plaintiff's patent.

(*m*) 7 R. P. C. p. 281.

(*n*) *Russell* v. *Cowley*, 1 W. P. C. 457; R. S. C. Order 50, rule 3.

(*o*) Johnson, 727, p. 729.

(*p*) 3 Bligh, 153.

printing the *Times*. The defendant to deliver to the plaintiffs a competent part, not exceeding four ounces of type so used: liberty to apply. Costs to be costs in the cause." (*q*)

Foreign Manufacturers and Licensees.—Inspection of a process in a foreign manufactory cannot be granted by English Courts. But in such case the onus (where there is doubt) is upon the defendants to clearly shew that their process differs from that of the plaintiffs. (*r*)

Nor will the Court order inspection of the process used by the licensees of one of the parties to an infringement action, the Court having no control over licensees. (*s*)

The Court, in fact, will not make an order for inspection unless the articles it is desired to inspect are the property, or under the control, of the person against whom the order is made. (*t*)

In *Rylands* v. *Ashley's Patent Bottle Company*, (*u*) the defendants having applied for inspection, the plaintiff deposed that the machines of which inspection was sought belonged to a limited company, of which the plaintiff was director, the company not being parties to the action, and also that he was engaged in making improvements of the machines referred to, for which he was applying for letters patent, and it would be injurious to give inspection to a rival. The defendant's solicitor deposed that he believed the machines were in the power of the plaintiff. The Court held that it was not necessary that the machines should be the property of the plaintiff; and that, although under the circumstances the plaintiff ought not to be obliged to give inspection of any modifications, it would aid the Court to have inspection of the machines; that the plaintiff must make a further affidavit saying whether any of the machines were still in existence without modifications: that there was a *primâ facie* case for saying he could procure inspection, and that he must make a *bonâ fide* application to the limited company to give inspection to the defendants, and make a further affidavit as to the result of such application.

Where an order is made for inspection of machinery, the Court will not generally require the party against whom such order is

(*q*) Johnson, p. 732; see also *Germ Milling Co.* v. *Robinson*, 3 R. P. C. 11, where 93 samples were taken by the plaintiffs.

(*r*) *Betts* v. *Wilson*, L. R. 5 H. of L. 11: per Lord Westbury.

(*s*) *Germ Milling Co.* v. *Robinson*, 3 R. P. C. 13.

(*t*) *Garrard* v. *Edge*, 6 R. P. C. 372; 58 L. J. Ch. 397; *Sidebottom* v. *Fielden*, 8 R. P. C. 266, 270.

(*u*) 7 R. P. C. 175.

made to work the machinery in the presence of the other side. (*v*) But in a special case it may be desirable that the machinery should be so worked. (*w*)

In the *Singer Sewing Machine Company* v. *Wilson*, (*x*) where it was alleged that the defendant had a stock of infringing machines, no order to inspect the stock as a whole was made, but the defendant was required to verify on affidavit the various kinds of machines sold by him, and to produce one of each class for inspection. (*y*)

Where the Court is of opinion that inspection on one side only will be inconvenient, and tend to make the proper determination of the matters in issue more difficult on the trial of the action, it will require inspection to be given by both sides. (*z*)

In the *Germ Milling Company* v. *Robinson*, the plaintiffs having obtained an order to inspect the defendant's process and taken samples of the products, the defendants applied for a similar order against the plaintiffs. Kay, J., made the order, saying that in doing so he looked rather to the convenience of the Court than the parties, as he thought that the Court at the trial might be in difficulties if the inspection had only been on one side. (*a*)

An application for an order for inspection should only be made after notice to the other side. But in exceptional circumstances it has been heard and the order made *ex parte*. (*b*)

The right to inspection does not depend on the promptness with which the application is made, therefore laches which would be fatal to an interlocutory injunction is no ground for refusing inspection. (*c*)

In the Chancery Division the application for an order for inspection is made by motion in Court or on summons at chambers; in the Queen's Bench Division, by summons at chambers. (*d*)

(*v*) *Drake* v. *Muntz Metal Co.*, Griff. 78; 3 R. P. C. 43; *Sidebottom* v. *Fielden*, 8 R. P. C. 269.

(*w*) See North, J., in *Rylands* v. *Ashley's Patent Bottle Co.*, 7 R. P. C. 175; also *Russell* v. *Cowley*, 1 W. P. C. 457; *Davenport* v. *Jepson*, 1 N. R. 307.

(*x*) 5 N. R. 505; 13 W. R. 560.

(*y*) But see *Drake* v. *Muntz Metal Co.*, where Bacon, V.-C., said he had no power to require an affidavit to be made by the defendant: Griff. 78; 3 R. P. C. 43.

(*z*) *Russell* v. *Cowley*, 1 W. P. C. 457; *Davenport* v. *Jepson*, 1 N. R. 307. (See this case for form of order.)

(*a*) 3 R. P. C. 11. See also *Cheetham* v. *Oldham*, 5 R. P. C. 622.

(*b*) *Hennessy* v. *Bohmann*, W. N. 1877, p. 14.

(*c*) *Patent Type Founding Co.* v. *Walter*; Johnson, 727.

(*d*) See R. S. C. Order 54, rule 12; Order 55, rule 15.

Interrogatories and Discovery.

Interrogatories.—In an action of infringement, interrogatories may be delivered by either side for the examination of the opposite party, but only on leave obtained from the Court or a judge. (*e*) The interrogatories must be strictly limited to matters in issue in the action, and questions in the nature of cross-examination are not allowed. (*f*)

The statutory provision as to the delivery of particulars of breaches and of objections in patent actions do not affect the right of parties to also interrogate as in other actions. (*g*)

When leave to interrogate is applied for the party seeking leave must produce to the Court or judge the interrogatories which he proposes to administer to his opponent. (*h*) And where such opponent is willing to concede the object to which an interrogatory is directed, either by delivering particulars or making admissions, or disclosing documents, leave to interrogate in regard to that matter will be refused. (*i*) While thus the approval of the Court must be obtained to all proposed interrogatories, they are not to be regarded as settled by the Court, (*j*) and the mere fact that any given interrogatory has been allowed does not preclude the party interrogated from objecting to answer it on any good ground. (*k*) Although an appeal lies against the decision of a judge allowing interrogatories, the Court of Appeal is unwilling to interfere with the judge's discretion, and no such appeal will succeed unless gross injustice has been done. (*l*)

The party seeking to interrogate must pay into court a sum of at least five pounds (*m*) as security for costs, before delivering his interrogatories. If this payment is not made, the party interrogated is under no obligation to answer. (*n*)

The object of interrogatories and discovery is to enable parties who believe they have a case to prove that case, and not to fish out a case, where they are in doubt whether one exists. (*o*) In the Chancery Division leave to interrogate will not usually be given

(*e*) R. S. C. Order 31, rule 1.
(*f*) Ibid.
(*g*) *Birch* v. *Mather*, 22 C. D. 629; *Crossley* v. *Tomey*, 2 C. D. 533.
(*h*) Order 31, rule 2.
(*i*) Ibid.
(*j*) *Tye* v. *Willoughby*, 38 Sol. J. 338.
(*k*) *Peek* v. *Ray*, [1891], 3 Ch. 282.
(*l*) Ibid.: per Lindley, L.J.
(*m*) A further sum of ten shillings for any additional folio above five: Order 31, rule 26.
(*n*) *Eder* v. *Attenborough*, 23 Q. B. D. 135.
(*o*) *Daw* v. *Eley*, 2 H. & M. 725.

to a plaintiff before he has delivered his statement of claim, or to a defendant before the delivery of his defence. In the Queen's Bench Division discovery on either side is not generally allowed until after the delivery of the defence, as only then are the issues defined. (*p*)

Where the party to be interrogated is a body corporate, or a joint stock company, or any other body of persons, empowered by law to sue or be sued, whether in its own name or in the name of any officer or other person, the opposite party may apply for an order allowing him to deliver interrogatories to any member or officer of such corporation, company, or body. (*q*)

Interrogatories must be answered by affidavit filed within ten days or such other time as a judge may allow. (*r*) If the answer is insufficient, an application should be made to the Court or a judge for an order for a further answer. The judge may order such answer to be given either by affidavit or *viva voce*. (*s*)

Interrogatories are intended to assist the party administering them to prove his own case, not to search out the evidence of his opponent and ascertain the names of the opposite witnesses. (*t*)

A defendant in an infringement action may interrogate the plaintiff as to what portions of the plaintiff's patent he is charged with having infringed. But he cannot interrogate the plaintiff as to the construction of the specification, for that is a matter to be subsequently determined by the Court. (*u*) Therefore interrogatories, the relevancy of which depends on the construction of the patent, are inadmissible, for at that stage it is too early to construe the patent. (*v*)

Although a party cannot require his opponent to put a construction upon his patent in an answer to an interrogatory, he is not precluded from asking questions which involve references to specifications. Thus, a defendant may ask whether some part of

(*p*) *Mercier* v. *Cotton*, 1 Q. B. D. 424; 64 L. J. Q. B. 184; *Mellor* v. *Thompson*, 49 L. T. 422; *Harbord* v. *Monk*, 9 C. D. 616.

(*q*) Order 31, rule 5; see *Benno Jaffé* v. *Richardson*, 10 R. P. C. 137.

(*r*) Ibid. Order 31, rule 8.

(*s*) Ibid. Order 30, rule 11.

(*t*) *Daw* v. *Eley*, 2 H. & M. 729; *Bovill* v. *Smith*, L. R. 2 Eq. 459; *Delta Metal Co.* v. *Maxim*, 8 R. P. C. 169. But where defendants alleged by their particulars of objection prior manufacture and sale generally for fifty years prior to the patent in London, North, J., allowed the plaintiffs to interrogate the defendants as to the names, places and dates of such prior users and use. See *Alliance White Lead Syndicate* v. *McIvor*, 8 R. P. C. 321; *Birch* v. *Mather*, 22 C. D. 629.

(*u*) *Moseley* v. *Victoria Rubber Co.*, 3 R. P. C. 352; *Delta Metal Co.* v. *Maxim*, 8 R. P. C. 172.

(*v*) *Delta Metal Co.* v. *Maxim*, 8 R. P. C. 171.

the plaintiff's invention is not a mere mechanical equivalent for a contrivance described in some other named specification, or whether that other specification does not contain some device claimed by the plaintiff; for these are questions of fact. (*w*)

"The defendant," said Giffard, L.J., in *Hoffman* v. *Postill*, (*x*) "has a right to ask all questions which are fairly calculated to shew that the patent is not a good patent, or that what the plaintiffs allege to be an infringement is not an infringement. It is almost impossible, where you have antecedent publications in a book or antecedent patents which are alleged to destroy the novelty of the succeeding patent, whether it be in examining the parties by interrogatories, or in examining witnesses, to avoid the necessity of referring to those documents, and asking a variety of questions respecting them, some of which are more proper for the Court, but many of which are absolutely essential in order to enable the Court to come to a proper conclusion as to the legal effect of the different specifications."

Where interrogatories are answered, they should be answered fully. (*y*) Everything shewing, or tending to shew, the fact of infringement must be set out in the answer to the full extent of the interrogatory. (*z*)

A defendant is entitled to discovery as to all matters of fact which are or may be material to his case; and where he relies on the invalidity of the plaintiff's patent, everything that is material to shew that, is part of his case. (*a*)

Discovery of the names and addresses of the defendant's customers, which is inadmissible before infringement is proved, may be had after the trial of that issue; (*b*) and the circumstance that such discovery may expose other persons to actions is no ground for refusing to give the fullest information. (*c*) On an enquiry as to damages the plaintiff is entitled to know not only the names of the defendant's customers, but also the prices of his sales. (*d*)

In an action against a licensee for an account, the defendant must answer interrogatories as to the names and addresses of customers with whom he has effected sales. (*e*)

(*w*) *Hoffmann* v. *Postill*, L. R. 4 Ch. 673.

(*x*) Ibid. p. 681.

(*y*) *Swinborne* v. *Nelson*, 16 Beav. 416; 22 L. J. Ch. p. 335; *Elmer* v. *Creasy*, L. R. 9 Ch. 69; 43 L. J. Ch. 166.

(*z*) *De La Rue* v. *Dickenson*, 3 K. & J. 391.

(*a*) *Hoffman* v. *Postill*, L. R. 4 Ch. 678.

(*b*) *Murray* v. *Clayton*, L. R. 15 Eq. 115.

(*c*) *Tetley* v. *Easton*, 18 C. B. 643.

(*d*) *American Braided Wire Co.* v. *Thomson*, 5 R. P. C. 375.

(*e*) *Ashworth* v. *Roberts*, 7 R. P. C. 451; L. R. 45 C. D. 623; 60 L. J. Ch. 27.

Interrogatories tending to incriminate the person answering them or to expose him to penal consequences, need not be answered. (*f*)

Discovery.—Any party to an action of infringement may, without filing an affidavit, apply to the Court or a judge for an order directing any other party to the action to make discovery on oath of any documents which are, or have been in his possession or power, relating to any matter in question in the action. The judge has a discretion to make or refuse the order, or to adjourn the application. Discovery will not be ordered unless it is necessary for disposing of the action, or for saving costs. (*g*)

Where a party has made an affidavit of the documents in his possession, the Court will not generally allow the other side to interrogate him as to documents, for that amounts to a cross-examination upon his affidavit, which is inadmissible. But if the Court is satisfied that some particular relevant document, undisclosed by the affidavit, may be in his possession, it may, on special application, allow an interrogatory as to that; but only on a *primâ facie* case being shewn. (*h*)

Where the documents disclosed by an affidavit of documents shewed that the party making the affidavit probably had other relevant documents in his possession, the Court of Appeal held that the proper remedy was for the other side to apply for an order that a further affidavit should be made, such order to be in general terms, but specially referring to the particular documents known not to have been disclosed. (*i*) In this case it was laid down that the order ought to be made in a general form, because the Court assumes that where particular documents have been withheld there may be others which the deponent, under an equally erroneous opinion as to relevancy, has also failed to disclose. (*j*)

At what Time Discovery will be Ordered.—It is often material to consider the time at which the discovery is asked; if premature, it may be refused on that ground. (*k*) Thus, interrogatories directed to matters not necessary for the trial of the action are inadmissible, even if these matters may subsequently need to be enquired into. (*l*) Where, for instance, infringement is admitted,

(*f*) As to this and the other grounds generally on which answers may be refused, see the *Annual Practice*; R. S. C. Order 31, rule 1, and notes.

(*g*) R. S. C. Order 31, rule 12.

(*h*) *Hall* v. *Truman*, 29 C. D. 307; *Edison* v. *Holland*, W. N. [1888], p. 31; 5 R. P. C. 217.

(*i*) *Boun* v. *Sansom*, 5 R. P. C. 510.

(*j*) Ibid. per Bowen, L.J.

(*k*) R. S. C. Order 31, rule 20.

(*l*) *De La Rue* v. *Dickenson*, 3 K. & J. 388; 29 L. T. 194.

and the only issue the validity of the patent, questions regarding the names of the defendant's customers will not be allowed till after the trial, as they are not relevant until the plaintiff has established the validity of his patent. (*m*)

In *Benno Jaffé* v. *Richardson*, (*n*) interrogatories were delivered by the plaintiffs asking the defendant, *seriatim* (following the plaintiffs' specification), whether he had used the processes claimed by the plaintiffs. The defendants, who impeached the validity of the patent, declined to answer some of the interrogatories, on the ground that at that stage of the proceedings, before the validity of the patent had been established, they were not relevant; it being possible that the issue of infringement might never have to be tried. North, J., in ordering further answers, said: "A very salutary alteration has been made by giving the Court a discretion now which it used not to have, both as to saying whether discovery shall be given at a particular stage or postponed to a later stage, as well as that of refusing it altogether. But if that means what it is contended it does mean, that in every patent action in which invalidity is set up—that is to say, in every patent action ever launched—there is first to be a deliberate trial before the judge and jury, if necessary, of the validity of the patent, and that it is only after that has been settled there are issues to be raised, and discovery obtained by interrogatories and otherwise, with regard to the question of infringement, the benefit gained by getting rid of the waste of time and money in answering interrogatories will be far more than made up for by the increased waste of time and money involved in having two trials of every patent action in which the plaintiff succeeds in establishing his patent instead of one. In my opinion, that is not the meaning of the rules, and it would have a very bad effect if that was so. It is intended to give the Court the opportunity of saying that discovery should not be given before the trial of the action, unless it is wanted for the purposes of the trial, that is to say, if a mortgagor wants to redeem an estate, and it is denied that he has a right to redeem at all, it is quite useless going into any questions of accounts until it is known whether there is such a right or not, and then if that right is established at the trial, the taking the accounts afterwards is a matter of course. . . . But in the case of a patent it is different. No doubt validity is one thing, and infringement another; but they both have to come on to be tried at the same time, and

(*m*) *Lister* v. *Norton*, 2 R. P. C. 68; *Crossley* v. *Tomey*, 2 C. D. 533.

(*n*) 10 R. P. C. p. 139; 62 L. J. Ch. p. 712.

the parties must come before the Court ready to deal with both cases at the one trial. If the present contention was right, that discovery was to be postponed until the validity of the patent was tried, discovery by interrogatories would be refused altogether, because it could not practically be given then."

Privilege.—Certain matters are privileged from discovery either by interrogatories or disclosure of documents.

Thus, no party is bound to answer interrogatories as to what advice has been given him by his solicitor; and documents which have come into existence merely to be communicated to a party's solicitor for the purpose of litigation, actual or intended, either as materials for briefs or for his advice or consideration are privileged from production. (*o*)

"The true principle," said Lord Cottenham, in *Nias* v. *North Eastern Railway Company*, (*p*) "is, that parties are to be at liberty to communicate with their professional advisers with respect to matters which become the subject of litigation, without restriction, and without the liability of being afterwards called upon to produce or discover what they shall so have communicated; whether a bill is or is not actually filed at the time is, to my mind, a matter of perfect indifference." (*q*)

This privilege is, however, limited to communications with legal advisers, and does not extend to patent agents. Thus, where the solicitor was also a patent agent, the Court held that the privilege only attached to the communications made to him in his capacity as solicitor. (*r*)

In *Westinghouse* v. *Midland Railway Company*, (*s*) reports and letters sent to the company by its officers after the company had been warned that it was infringing a patent, were held not to be privileged.

Affidavits and notes of evidence in a former infringement action have been required to be produced. (*t*)

Sometimes when a defendant is interrogated as to the process by which he arrives at the product alleged to be an infringement, he seeks to shelter himself from answering on the ground that his process is a trade secret, which he ought not to be called upon to divulge. In such case the Court, if satisfied that the

(*o*) *Haslam* v. *Hall*, 5 R. P. C. 9.

(*p*) 3 My. & Cr. 357.

(*q*) See, also, Lord Selborne, C., in *Minet* v. *Morgan*, L. R. 8 Ch. 367.

(*r*) *Moseley* v. *Victoria Rubber Co.*, 3 R. P. C. 351; 55 L. T. (N. S.), 482.

(*s*) 48 L. T. (N. S.), 98, 462.

(*t*) *Bown* v. *Sansum*, 5 R. P. C. 510; *Thomson* v. *Hughes*, 7 R. P. C. 187.

objection is taken *bonâ fide*, will as far as possible protect the defendant. (*u*)

But the mere plea of a secret process is no ground for refusing discovery where the nature of that process is material to the issues in the action. (*v*)

"I quite agree," said Kekewich, J., in *Ashworth* v. *Roberts*, (*w*) "that a mere plea of secret process is not sufficient to defeat discovery; but, on the other hand, interrogatories must not be made the means of unfair treatment of a man who is fighting fairly, and I think the Court is, and will be, strong enough to prevent his being obliged to disclose that which need not be disclosed for the purposes of the trial of the action."

In *Renard* v. *Levinstein*, (*x*) Wood, V.C., while requiring the defendant to answer whether he used the materials mentioned in the plaintiff's specification, and whether other additional materials, excused the defendant from stating what preparations he employed and from naming the other materials he used, when the defendant alleged that full answers would disclose secrets on which his trade depended.

In another case where this objection was taken to answering questions in Court on the trial, Pearson, J., appointed a neutral expert to inspect the defendant's process and report. (*y*)

Trial of the Action.

Procedure on Trial.—The Court or a judge may at any time order different questions of fact arising in the same action to be tried by different modes of trial, or that one or more questions of fact be tried before others. (*z*) The Court has refused, in an infringement action, to try the question of infringement separately from that of the validity of the patent where both were in issue. (*a*)

Where it has seemed probable that the trial of one issue would decide the whole action, that issue has been taken first. (*b*)

Under the Arbitration Act, 1889, the Court has power to compulsorily refer actions involving any prolonged examination of documents, or any scientific investigation which cannot be

(*u*) *Benno Jaffé* v. *Richardson*, 10 R. P. C. 139; 62 L. J. Ch. 712.

(*v*) *Ashworth* v. *Roberts*, 7 R. P. C. 451.

(*w*) Ibid. p. 455.

(*x*) 3 N. R. 665.

(*y*) *Badische* v. *Levinstein*, 24 C. D. 156; 2 R. P. C. 73

(*z*) R. S. C. Order 36, rule 8.

(*a*) *United Telephone Co.* v. *Mottishead*, 3 R. P. C. 213.

(*b*) *Richardson* v. *Castray*, 4 R. P. C. 265; *Badham* v. *Bird*, 5 R. P. C. 238.

conveniently conducted by the Court through its ordinary officers, to a referee or arbitrator for trial. (*c*) This jurisdiction has not been exercised hitherto in patent cases. (*d*)

Evidence.—On the trial of the action the plaintiff begins, and where (as will usually be the case) the validity of the patent as well as the infringement is disputed, he must first prove his title to the monopoly. This should be done by producing the letters patent sealed with the seal of the Patent Office. (*e*) Where the plaintiff is not the original patentee, but an assignee, the devolution of the patent and the registration of the assignment in the Register of Patents must be duly proved.

The registration may be proved by the production of a certified copy of the entry in the register. (*f*) Specifications, disclaimers, and other documents in the Patent Office, or extracts from them, may be proved by printed or written copies purporting to be certified by the comptroller and sealed with the seal of the Patent Office. (*g*)

Where the patent is attacked on the ground of want of subject-matter, evidence may be called in chief to shew that the invention was only found out after experiments and labour. (*h*)

The specification must be left to speak for itself, as its construction, like that of any other written document, is for the Court alone to decide. The patentee, therefore, may not be called to state what he meant by it; though, like any other expert, he may be called to assist the Court by explaining the state of knowledge at the date when it was filed. (*i*)

Apart from the rule excluding oral evidence in explanation of written documents, a specification which required to be supplemented by statements of the patentee to enable the public to perform the invention would be bad. Technical expressions and terms of art may, however, be explained by witnesses conversant with the subjects to which they relate.

Where the sufficiency of the specification is challenged, evidence must also be given to prove that a person following the instructions contained therein can successfully perform the invention. For this purpose a workman of average skill and knowledge in the

(*c*) Sect. 14.

(*d*) As to a similar jurisdiction under the Judicature Act, 1873, s. 57, see *Saxby* v. *Gloucester Waggon Co.*, W. N. 1880, p. 28. But this case was prior to the Patents Act, 1883.

(*e*) Patents Act, 1883, ss. 12 (2) & 81.

(*f*) Ibid. ss. 23 & 89.

(*g*) Ibid. s. 89.

(*h*) *Thierry* v. *Riekmann*, 12 R. P. C. 417.

(*i*) Per Lord Herschell, in *Badische* v. *Levinstein*, 12 App. Ca. pp. 717, 718.

subject-matter of the patent is preferable to a highly trained person or scientific expert, whose skill might lead him to perform the invention even when the specification was defective, by correcting rather than following its directions. (*j*)

It may happen, however (as in the case of a chemical patent), that the invention is some extremely subtle process, which can only be described in novel terms of abstruse science which have not yet passed into the vocabulary of the practical chemist; in such case it is not only permissible, but necessary, to call a theoretical witness of the most advanced knowledge to prove the sufficiency of the specification, for he alone is the class of person to whom such a specification is addressed. (*k*)

Evidence of Experts.—Experts in giving their evidence have a tendency to become advocates rather than witnesses; when this happens their evidence is not viewed with much favour by the Courts. (*l*) The subject-matter of patent actions is, however, so technical and complicated as to make it generally impossible to dispense with this class of evidence.

Experts are usually called to explain the working of the invention and indicate its characteristic features. Such witnesses are also required to prove the existing state of knowledge at the time of the patent grant, and to shew what step in advance the patentee has made. But when expert witnesses pass from statements of fact to expressions of opinion, it is necessary to elicit the grounds of their opinions, for such opinions are, in themselves, no evidence, and, apart from the grounds on which they are based, ought to have no weight with the Court. (*m*)

Thus, in proving the infringement complained of, it is not permissible to ask an expert witness whether, in his opinion, what the defendant has done amounts to infringement of the plaintiff's patent; for that is the question the Court, and not the witness, has to determine. (*n*) But such a witness may be asked to indicate in what respects, if any, the defendant's method or process differs from that of the plaintiff, and whether any such differences or variations are or are not mechanical or chemical equivalents. (*o*)

In this way the grounds upon which a witness arrives at his

(*j*) See Jessel, M.R., in *Plimpton* v. *Malcolmson*, 3 C. D. 569.

(*k*) Per Fry, L.J., in *Badische* v. *Levinstein*, 29 C. D. 406; Griff. P. C. 37.

(*l*) *Thorn* v. *Worthing*, 6 C. D. 416, n.

(*m*) *Seed* v. *Higgins*, 8 H. of L. Ca. 550; *Leadbeater* v. *Kitchen*, 7 R. P. C. p. 247; *Brooks* v. *Steele*, 14 R. P. C. p. 73.

(*n*) *Parkinson* v. *Simon*, 11 R. P. C. p. 506 (per Esher, M.R.).

(*o*) *Ticket Punching Co.* v. *Colley*, 12 R. P. C. 186 (per Smith, L.J.).

conclusion are evidence, though the conclusion itself is inadmissible.

"It is necessary," said Lindley, L.J., in *Brooks* v. *Steele*, (*p*) "to examine each patent separately, and to ascertain first what the patented invention really is; and, secondly, whether the defendants have used that invention. In this, as in all cases, the nature of the invention must be ascertained from the specification, the interpretation of which is for the judge, and not for any expert. The judge may, and indeed generally must, be assisted by expert evidence to explain technical terms, to shew the practical working of machinery described or drawn, and to point out what is old and what is new in the specification. Expert evidence is also admissible, and is often required to shew the particulars in which an alleged invention has been used by an alleged infringer, and the real importance of whatever differences there may be between the plaintiff's invention and whatever is done by the defendant. But, after all, the nature of the invention for which a patent is granted must be ascertained from the specification, and has to be determined by the judge, and not by a jury, nor by any expert nor other witness. This is familiar law, although apparently often disregarded when witnesses are being examined."

Proof of Infringement.—The plaintiff must prove that the defendant has put the invention in practice without his authority. Making, using, or selling, are all equally infringement. (*q*) If the defendant is charged merely with selling or using, the plaintiff will also have to prove that the articles sold or used were not made by himself or his agents; (*r*) for an article made and sold by the patentee, unless sold with a restricted licence, is licensed for re-sale or subsequent use in the hands of any other person.

The owner of an English patent manufactured the patented article in France as well as in England. In a suit to restrain the sale of the article in England, the plaintiff proved that it was not made at his manufactory in England, but could not prove that it was not made at his manufactory in France. The bill was dismissed with costs by James, V.C.; and, on appeal, the decision below was affirmed. Lord Hatherley, C., said: "I apprehend that, the onus being upon the plaintiff to shew, not merely that the thing made is his own patented article, but that it has been unlawfully sold, he must be prepared to swear distinctly that it is not manufactured

(*p*) 14 R. P. C. p. 73.
(*q*) See ante, p. 403, Chap. XXI.
(*r*) *Betts* v. *Willmott*, L. R. 6 Ch. 239.

by him or his agent. Suppose that he had three houses of manufacture—one in the north of England, one in the west of England, and one in London—I cannot doubt that it would be his duty, in making out his case before a jury, to prove not only that the article was of the same description as the patented articles, but that it was not made by himself; and, for that purpose, he would have to call as witnesses persons who had control of his houses in the north and west, as well as in London, to shew that the article was not made by them." (*s*)

Where the patentee shews that from the construction of the article complained of it is almost certain that it must have been made according to his method, this is *primâ facie* evidence of infringement, and if not rebutted by the defendant proving that in fact the article was not so made—is sufficient to support a verdict for the plaintiff. (*t*) Thus in *Huddart* v. *Grimshaw*, (*u*) Lord Ellenborough, C.J., reviewing the evidence, said: "*Mr. Rennie* says, I know of no other mode than *Mr. Huddart's* for producing this effect, and in proportion as that is deviated from the strands will be worse; this piece of rope (*v*) exhibits to the eye that gradation of length in the different shells which he should expect to find in *Mr. Huddart's* invention. I should state that this is certainly what is called *primâ facie* evidence of its having been made by that method; when one sees it agree in all its qualities when it is produced with a rope actually made upon *Mr. Huddart's* plan, it is *primâ facie* evidence, till the contrary is shewn, that it was made upon his method, and therefore, as against him it should seem, supposing this patent in full force and a valid one, it is reasonable, fair evidence, in the absence of contrary evidence, to presume that it was made that way."

In *Hall* v. *Jarvis*, (*w*) the plaintiff's invention consisted in a method of burning off the superfluous fibres from lace or net without injuring the fibre. This he accomplished by applying a gas flame to the surface of the fabric. It was proved that lace delivered by the defendants had the exact appearance it would have presented if dressed according to the patented process. It was also proved that one of the defendants had a gassing machine on his premises; that his gas fittings had been tampered with,

(*s*) *Betts* v. *Willmott*, L. R. 6 Ch. p. 243.

(*t*) See *Neilson* v. *Betts*, 5 H. of L. p. 11 (per Lord Westbury); *Thorn* v. *Worthing*, 6 C. D. 416 n. (per Jessel, M.R.).

(*u*) 1 W. P. C. 91.

(*v*) The infringement complained of.

(*w*) 1 W. P. C. 100.

and that the gas consumed by him had been largely in excess of the amount required for mere lighting purposes. On this evidence, Abbott, C.J., directed the jury to find a verdict for the plaintiff.

The principle that where the article complained of closely resembles the patented invention, the Court will assume that it has been made by an infringing process until the contrary is shewn, is specially applicable in the case of a foreign made article, as the patentee in that case cannot have inspection of the defendant's process or manufactory, and has therefore no means of more direct proof. (*x*)

If, however, the Court is satisfied that the article might have been made by another process, this principle has no application.

In the *Cartsburn Sugar Company* v. *Sharp*, (*y*) the complainers sought protection against the acts of the respondents, who, they alleged, were selling in Scotland cubes of sugar made in America by an apparatus for which the complainers held a patent by assignment.

"It is said that as the manufacture complained of had taken place in America," said Lord Kinnear, "it was incumbent on the respondents, upon the principle which received effect in the case of *Neilson* v. *Betts*, to prove by negative evidence that it was not manufactured according to the process. I think no such *onus* lies upon the respondents in the present case, because there can be no question on the evidence that such articles as were sold by the respondents may have been produced by machinery which involved no infringement of the complainers' patent. That being so, it lay upon the complainers to prove their case, and as they took a commission to America for the purpose of proving it, there could have been no difficulty in their obtaining a sufficient description of the machine to which it is alleged they have traced the cubes of sugar sold by the respondents, to enable them to establish the infringement, if infringement there was." (*z*)

In the *Welsbach Incandescent Gas Light Company* v. *New Incandescent Company*, (*a*) the plaintiffs relied for proof of the infringement complained of, upon admissions in defendants' answers to interrogatories, and Buckley, J., held these to afford sufficient proof.

Amending the Particulars.—As already noticed, both sides at the trial are tied down by their particulars, (*b*) and unless

(*x*) *Neilson* v. *Betts*, 5 H. of L. 11.
(*y*) 1 R. P. C. 179.
(*z*) Ibid. p. 186.
(*a*) 17 R. P. C. 237; 16 T. L. R. 205.
(*b*) Supra, pp. 484, 488, 494.

leave is given to amend, are not entitled to call evidence outside the particulars delivered. The Court has, however, a discretion under Section 29 (4) of the Patents Act, 1883, independently of the provisions dealing with amendment, to admit fresh evidence at the trial, the object of giving such discretion being to enable the Court to get at the real facts and do justice between the parties. (*c*)

The Court does not encourage applications at the trial for leave to amend the particulars, as such applications where granted must generally involve an adjournment to give the other side the opportunity of meeting the fresh evidence thus admitted. In *Moss* v. *Malings*, (*d*) North, J., said he would only grant leave to amend at the trial if satisfied that the matter of the amendment was recently discovered and could not with reasonable diligence have been discovered before. In *Shrewsbury* v. *Morgan*, (*e*) an infringer applied at the trial for leave to amend by raising the new objection that the patent was bad by reason of variance between the title and the claims; but Romer, J., refused the application as being made too late.

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

It will be noticed that the amendment here provided for is only by way of disclaimer (*g*). It sometimes happens that during the trial of an action the patentee discovers that the drag-net of his claim has been thrown too wide, and that a patent otherwise good is avoided by the inclusion in the claim of something which is not new. Such a patent can be saved by disclaimer.

If the judge is satisfied at the trial that the proposed disclaimer will not make the patent good, he ought to refuse leave. (*h*) If he does so the Court of Appeal will not interfere with the exercise of his discretion unless clearly satisfied that injustice has been done. (*i*)

(*c*) *Britain* v. *Hirsch*, 5 R. P. C. 231.

(*d*) 3 R. P. C. 373; 33 C. D. 604; Griffin, 167.

(*e*) 13 R. P. C. 75

(*f*) Patents Act, 1883, s. 19. See Amendment of the Specification, pp. 274-279, supra.

(*g*) *Owen's Patent*, [1899] 1 Ch. 157; 68 L. J. Ch. 63; 79 L. T. 458; 47 W. R. 180.

(*h*) *Armstrong's Patent*, 14 R. P. C. 747; see, also, *Dellwick's Patent*, [1896] 2 Ch. 705; 13 R. P. C. 591.

(*i*) Ibid. As to amendment pending action but prior to trial, see ante, p. 278.

Leave in any case will only be given on terms. The words "costs and otherwise" are of the widest description, and give the judge an ample discretion to impose any terms he may think the justice of the case requires. (*j*)

The conditions that no damages shall be asked or injunction claimed in respect of anything done prior to the amendment have been held to be proper terms. (*k*) And generally the plaintiff will be required to pay all the costs of the action up to the time of the amendment. But each case depends on its own circumstances.

In *Meyer* v. *Sherwood*, (*l*) Smith, L.J., gave leave to apply to amend the specification at the close of the trial; the comptroller allowed the amendment, and the defect in the specification was apparently cured; notwithstanding which, Smith, L.J., gave judgment for the defendants with costs, and the Court of Appeal held that this was right (the application to amend having been made so late), but suggested that liberty might properly have been reserved to the plaintiffs to bring another action for an injunction if so advised.

In *Chatwood's Patent Company* v. *Mercantile Bank of Lancashire*, (*m*) liberty to apply for leave to amend the specification was given twice in the same action by North, J.

Models, if produced at the trial, ought to be properly proved and put in evidence. But the Court has looked at a model, not in evidence, to aid it in understanding the descriptions of counsel. (*n*)

Once a model has been produced and put in evidence at the trial, the party producing it must, if the case is appealed, produce it in the Court of Appeal in the same state in which it was when used below. He must not tamper with it even for purposes of cleaning and renovation. (*o*)

Matters Res Judicata.—Where a Court has construed the specification of a patent, an inferior Court or a Court of co-ordinate jurisdiction will follow that construction in a subsequent action on the same patent, for the construction is a question of law. (*p*)

(*j*) *Lang* v. *Whitecross*, 7 R. P. C. p. 392.

(*k*) Ibid.; *Ludington Cigarette Machine Co.* v. *Baron Cigarette Machine Co.*, 17 R. P. C. 25.

(*l*) 7 R. P. C. 287.

(*m*) 17 R. P. C. 23.

(*n*) *Boyd* v. *Horrocks*, 6 R. P. C. 125.

(*o*) *Winby* v. *Manchester Steam Tramways Co.*, 8 R. P. C. 63.

(*p*) *Edison* v. *Holland*, 6 R. P. C. 243; see, also, *Slazenger* v. *Feltham*, 6 R. P. C. p. 234 (per Cotton, L.J.). In this case the Court of Appeal held that Kekewich, J., was right in following a prior decision of North, J., on the same patent, that it had

But the findings of one Court on questions of fact will not debar another Court from trying the same questions of fact over again upon other evidence in an action against another infringer. (*q*) Where, however, the second action is against the same defendant he will not be allowed to dispute the validity of the patent (even on new evidence) if that issue has been found against him in the first action, as it is then *res judicata* between the parties. (*r*)

On this principle a defendant who has submitted to an injunction cannot in a subsequent action for infringement dispute the validity of the patent which he has already admitted by his submission. (*s*)

Surprise.—If a party to an action is taken by surprise at the trial, his proper course is to apply for an adjournment. If he does not do so, but elects to take his chance of a verdict, the Court of Appeal will not afterwards, when that verdict has gone against him, allow him to adduce fresh evidence on appeal. (*t*)

Secret Process.—Where defendants alleged that the process they followed was a trade secret, the Court allowed their evidence at the trial to be heard *in camera.* (*u*)

Irrelevant Issues.—In action of infringement when the plaintiff does not allege that the defendant threatens or intends to continue infringing, evidence of acts of infringement subsequent to the issuing of the writ is inadmissible, and if no infringement prior to the writ is proved, the defendant is entitled to judgment. (*v*)

The Court will not generally go into issues, the trial of which is not necessary to its decision. Thus, where the patent is found invalid the question of infringement will generally become immaterial. (*w*)

Costs where Defendant Submits.—Sometimes a defendant on being sued by the patentee submits, and a question arises as to whether the plaintiff is entitled to proceed only to recover his costs.

In *Upmann* v. *Elkan*, (*x*) (a trade mark case), Lord Romilly

sufficient utility and invention to be good subject-matter. See also *Dunlop Pneumatic Tyre Co.* v. *New Ixion Co.*, 16 R. P. C. 16; *Tweedale* v. *Ashworth*, 16 R. P. C. 142.

(*q*) *Shaw* v. *Day*, 11 R. P. C. 189; see, also, *Slazenger* v. *Feltham*, 6 R. P. C. 130. Anticipation is a question of fact.

(*r*) *Shoe Machinery Co.* v. *Cutlan*, 13 R. P. C. 395.

(*s*) *Moore* v. *Thomson*, 7 R. P. C. 325.

(*t*) *Barcroft* v. *Smith*, 14 R. P. C. 172

(*u*) *Badische* v. *Levinstein*, 2 R. P. C. 73; 24 C. D. 156; 52 L. J. Ch. 704.

(*v*) *Shoe Machinery Co.* v. *Cutlan*, 12 R. P. C. 357; [1896] 1 Ch. 667; *Welsbach Incandescent Gas Light Co.* v. *Dowle*, 16 R. P. C. 395.

(*w*) *Tubeless Pneumatic Tyre* v. *Trench Tyre Co.*, 16 R. P. C. 291.

(*x*) L. R. 12 Eq. 140; L. R. 7 Ch. 130; 41 L. J. Ch. 246.

(affirmed on appeal by Lord Hatherley, C.) held that defendants guilty of a mere technical infringement, who on having it brought to their notice, offered before bill filed to give the plaintiffs all reasonable assistance for the enforcement of their rights against the real infringers, ought not to be made to pay costs.

So, too, in *Betts* v. *Willmott*, (*y*) James, V.C., held that an innocent vendor of an infringing article, who was willing to stop selling, and who before suit gave full information to the patentee, ought not to have costs given against him, or, in fact, to be sued at all.

In the *American Tobacco Company* v. *Guest*, (*z*) (also a trade mark case), where the infringement was trifling, the plaintiff, though held to be entitled to his injunction, was refused costs. (*a*)

Where, however, the infringement, though innocently committed, is substantial, the fact that the infringer on receiving the writ and notice of motion acquiesces in all that the plaintiff wants, has been held to be no reason for not giving the plaintiff the costs of the writ and motion for an injunction. (*b*)

A patentee is not bound to give notice to an infringer before commencing an action against him; but if he does so, and is offered complete satisfaction, his wiser course is generally to accept satisfaction and not commence legal proceedings.

Thus, in *Lyon* v. the *Mayor of Newcastle-on-Tyne*, (*c*) where the plaintiff before action was informed that the defendants did not dispute his patent right, and had not used, and were prepared to undertake not to use the machine complained of, Kekewich, J., held that a motion for an injunction was unnecessary, and on the defendants giving the undertaking originally offered, allowed them their costs of the motion.

Each case must, however, depend on its own particular circumstances, and if from the conduct of the defendant the patentee is justified in suspecting a want of good faith, and fearing a recurrence of the injury, he is entitled to protect himself by obtaining an injunction.

A party to an action who advertises an unfair report of the proceedings on an interlocutory motion therein, for the purpose of putting before the trade and his own customers a version of facts

(*y*) 18 W. R. 947; see, also, *Nunn* v. *D' Albuquerque*, 34 Beav. 595.

(*z*) 9 R. P. C. 218; L. R. [1892] 1 Ch. 630; 61 L. J. Ch. 242.

(*a*) See, also, *Jenkins* v. *Hope*, 13 R. P. C. 57.

(*b*) *Upmann* v. *Forester*, 24 C. D. 231 (per Chitty, J.); *Wittmann* v. *Oppenheim*, 27 C. D. 260; 54 L. J. Ch. 56 (per Pearson, J.).

(*c*) 11 R. P. C. 218.

which will lead to his own profit, is liable to be committed for contempt, and even where he gives an undertaking not to continue the advertisement, may be made to pay the costs of the motion. (*d*)

Injunction.

Three remedies are open to the patentee who has successfully prosecuted an action against an infringer—an injunction, delivering up or destruction of the infringing articles, and damages, or an account of profits. These will now be considered.

Where an Injunction is the Proper Remedy.—Where the Court is satisfied that infringement has been committed, and that there is a probability that it will be repeated, an injunction will usually be granted. In such a case the plaintiff has *primâ facie* established his right to an injunction, and the Court will require exceptional circumstances to be shewn to induce it to refuse this relief. (*e*)

There must, however, be a probability that the infringement is going to be repeated. An injunction is a remedy against future injury, and the Court will not make the order if satisfied that no such injury is likely to occur.

"It is not because a man has done a wrong," said Cotton, L.J., in *Proctor* v. *Bailey*, (*f*) "that an injunction will be granted against him. If a man has done a wrong which will not be continued, at common law damages may be obtained for the wrong done, which the common law says is sufficient indemnity for that wrong; but then the Court of Chancery says this in the exercise of its extraordinary jurisdiction: 'We will not be satisfied with that; we will grant an injunction because a wrongful act has been done, in order to prevent that wrongful act;' and they grant an injunction where a wrongful act has been done, and the Court is satisfied of the probability of the continuance of the wrongful act."

"An injunction, be it borne in mind," said Fry, L.J., in the same case, "is granted under a preventative jurisdiction of this Court, is addressed to the prevention of an injury which is about to be done, or which the Court sees the probability of being done, and is not rightly described as a protective jurisdiction. . . . What has been pressed upon us, and what is really the only ground,

(*d*) *Edlin* v. *Pneumatic Tyre Agency*, 10 R. P. C. 317; cf. *Fenner* v. *Wilson*, in which the advertisement issued was held by the Court of Appeal not to amount to a contempt. But an undertaking not to repeat it was required: 10 R. P. C. 113.

(*e*) *Shelfer* v. *City of London Electric Lighting Co.*, [1895] 1 Ch. 317 (per Lindley, L.J.).

(*f*) 6 R. P. C. pp. 541, 542; 59 L. J. Ch. 13; 38 W. R. 101; 61 L. T. 754; 42 C. D. 393.

on the part of the plaintiff, is that the defendants have, whilst admitting that they did what they did, said, 'We had a right to do it'—as I think a very foolish and idle statement on the part of the defendants, but regarded in the light of the existing circumstances, a statement which seems to me not to raise the probability of a repetition of the wrongful acts of the defendants." (*g*)

Where an Injunction will be Refused.—The exceptional circumstances which will justify the Court in refusing an injunction when an infringement is proved, and future infringements probable, were discussed by the Court of Appeal in *Shelfer* v. *City of London Electric Lighting Company.* (*h*) After laying down the rule that in such cases an injunction will usually be granted, Smith, L.J., said: "There are, however, cases in which this rule may be relaxed, and in which damages may be awarded in substitution for an injunction. In any instance in which a case for an injunction has been made out, if the plaintiff by his acts or laches has disentitled himself to an injunction, the Court may award damages in its place. . . . In my opinion, it may be stated as a good working rule that—(1) If the injury to the plaintiff's rights is small, (2) and is one which is capable of being estimated in money, (3) and is one which can be adequately compensated by a small money payment, (4) and the case is one in which it would be oppressive to the defendant to grant an injunction: then damages in substitution for an injunction may be given. There may also be cases in which, though the four above-mentioned requirements exist, the defendant by his conduct . . . has disentitled himself from asking that damages may be assessed in substitution for an injunction. It is impossible to lay down any general rule as to what, under the differing circumstances of each case, constitutes either a small injury, or one that can be estimated in money, or what is a small money payment, or an adequate compensation, or what would be oppressive to the defendant. This must be left to the good sense of the tribunal, which deals with each case as it comes up for adjudication."

In *Jenkins* v. *Hope*, (*i*) where the value of the infringing goods sold by certain defendants amounted to about nine guineas only, and those defendants were willing to give a perpetual undertaking not to infringe, North, J., being satisfied that they had acted in ignorance of the plaintiff's patent right, refused an injunction against them, as he did not consider that under the circumstances

(*g*) 6 R. P. C. pp. 545, 546.
(*h*) L. R. [1895] 1 Ch. p. 321.
(*i*) 13 R. P. C. 57.

he ought to give the plaintiff the opportunity of advertising these defendants' names as persons who had infringed his patent.

In *Marshall* v. *Marshall*, (*j*) where the defendant was outside the jurisdiction, an injunction was sought against him and his agents. The Court refused the order, because, as it was only enforceable by attachment, it could not be made effective against the principal offender, but only against the minor wrong-doers—his agents within the jurisdiction.

Here, however, the principal infringer was resident in Scotland, and the patentee had therefore his remedy by an action in the Scottish Courts; a circumstance which influenced the Court in refusing the relief.

Where the principal defendants were a company with their registered office in Scotland, but holding property in England, the Court granted an injunction; as an injunction can be enforced against a company by sequestration of its property. (*k*)

In *Elmslie* v. *Boursier*, (*l*) an injunction was granted against a French manufacturer who was importing into England goods made in infringement of an English patent.

To induce the Court to grant an injunction a probability of future injury must, as above stated, be shewn. Thus, where the only infringement proved had been discontinued five years before action, an injunction was refused. (*m*)

But past infringement of recent date is *primâ facie* evidence of an intention to continue the wrong done; (*n*) and if just before action a defendant has committed infringement for profit, he will not escape an injunction by saying he will not do it again; for the proper inference from a very recent act of misfeasance is a probability that it will be repeated. (*o*)

Where, however, the infringer has acted in ignorance of the patent right, the same inference does not arise from past infringement; and the Court in such case has refused an injunction (*p*) or accepted an undertaking instead. (*q*)

Proof of Past Infringement not Required.—Nor is it necessary to entitle a patentee to an injunction that actual past infringement should be proved. The Court looks to the future rather than the

(*j*) 38 C. D. 330.

(*k*) *In re Burland's Trade Mark*, 41 C. D. pp. 544, 545.

(*l*) L. R. 9 Eq. 217.

(*m*) *Proctor* v. *Bailey*, 6 R. P. C. 538; 42 C. D. 390; 59 L. J. Ch. 12.

(*n*) Ibid.

(*o*) Ibid.: per Cotton, L.J.; 6 R. P. C. pp. 544, 545; see, also, *Geary* v. *Norton*, 1 De G. & S. 9.

(*p*) *Hudson* v. *Chatteris Engineering Co.*, 15 R P. C. 438.

(*q*) *Jenkins* v. *Hope*, 13 R. P. C. 57.

past, and although an inference as to the future may be drawn from past conduct, yet mere threats or other evidence of an intention to infringe in future are sufficient to induce the Court to grant an injunction without any proof of effect having yet been given to such threats. (*r*)

In *Frearson* v. *Loe*, (*s*) Jessel, M.R., said: "I am not aware of any suit or action in the Court of Chancery which has been successful on the part of a patentee without infringement having been proved; but, in my opinion, on principle, there is no reason why a patentee should not succeed in obtaining an injunction without proving actual infringement. I think so for this reason. Where the defendant alleges an intention to infringe, and claims the right to infringe, the mischief done by the threatened infringement of the patent is very great, and I see no reason why a patentee should not be entitled to the same protection as every other person is entitled to claim from the Court from threatened injury where that threatened injury will be very serious. No part of the jurisdiction of the old Court of Chancery was considered more valuable than that exercise of jurisdiction which prevented material injury being inflicted, and no subject was more frequently the cause of bills for injunction than the class of cases which were brought to restrain threatened injury as distinguished from injury which was already accomplished. It seems to me, when you consider the nature of a patent right, that where there is a deliberate intention expressed, and about to be carried into execution, to infringe certain letters patent under the claim of a right to use the invention patented, the plaintiff is entitled to come to this Court to restrain that threatened injury."

In *Adair* v. *Young*, (*t*) the Court granted an injunction against a defendant, the master of a ship into which pumps made in infringement of the plaintiff's patent had been fitted, although no user of the pumps in British waters was proved against the defendant—the Court being satisfied that if not restrained by injunction he would, in fact, use the pumps in breach of the patent right.

In *Dowling* v. *Billington*, (*u*) no actionable infringement was proved, but the defendants had infringed between the filing and acceptance of the complete specification, and after the

(*r*) See *Proctor* v. *Bailey*, 6 R. P. C. p. 542 (per Cotton, L.J.); *Frearson* v. *Loe*, 9 C. D. 65 (per Jessel, M.R.).

(*s*) Supra.

(*t*) 12 C. D. 13.

(*u*) 7 R. P. C. 191; cf. *Shoe Machinery Co.* v. *Cutlan*, 12 R. P. C. 357.

commencement of the action, and the Court of Appeal in Ireland held this evidence of an intention to infringe and granted an injunction accordingly.

Term and Scope of Injunction.—Usually an injunction will only be granted for the period covered by the life of the patent; when the patent term has run out the injunction falls with the monopoly. (*v*) Thus, also, where the patent is upset on some ground of invalidity in a subsequent action, any injunction granted in respect of it ceases to operate. (*w*)

An injunction granted on proof of one form of infringement binds the defendant as to that and all other possible forms of infringing the same letters patent. If, therefore, the same defendant repeats his infringement in some new form after an injunction has been granted, the proper remedy of the patentee is not to commence a new action, but to move to attach the defendant for contempt in acting in breach of the injunction already granted. (*x*)

As an injunction will generally be granted for the duration of the patent term only, the Court will usually refuse this relief where the letters patent in aid of which it is sought have expired before the hearing, or are then about to expire; (*y*) for, in the first case, there will be nothing upon which the injunction can operate, while in the second, damages will as a rule be a sufficient remedy.

Where, however, it appeared that a quantity of infringing goods had been manufactured just before the expiration of the patent, with the object of having such goods ready to throw upon the market as soon as the monopoly was at an end, Lord Lyndhurst, C., granted a perpetual injunction to restrain the sale of such goods both before and after the term limited by the patent grant. (*z*)

Third parties are not defendants, and an injunction will not be granted against them; although they may be ordered to pay costs (*a*). If a plaintiff in an infringement action finds, while the action is pending, that he has a direct claim against a third party

(*v*) *Daw* v. *Eley*, L. R. 3 Eq. 496.

(*w*) Ibid.

(*x*) *Thomson* v. *Moore*, 6 R. P. C. 445.

(*y*) *Davenport* v. *Rylands*, L. R. 1 Eq. p. 306; *Betts* v. *Gallais*, L. R. 10 Eq. 392; *British Motor Syndicate* v. *Universal Motor Co.*, 16 R. P. C. 113; *Welsbach Incandescent Gas Light Co.* v. *New Incandescent Co.* 16 T. L. R. 205; 17 R. P. C. 237.

(*z*) *Crossley* v. *Beverley*, 1 R. & M. 166, n.; 1 W. P. C. 119; see, also, *Crossley* v. *Derby*, 4 L. J. Ch. 26 (per Lord Brougham, C.).

(*a*) *Edison & Swann* v. *Holland*, 6 R. P. C. p. 286.

he ought to apply to amend, and add him as a co-defendant. (*b*) Where such an application had not been made to the Court below, the Court of Appeal refused to join third parties as co-defendants in the appeal. (*c*)

A defendant who has in error consented to a perpetual injunction going against him, has been allowed to withdraw such consent. (*d*)

In the *Welsbach Incandescent Gas Company* v. *Daylight Mantle Company*, (*e*) the secretary of the defendant company had been made a co-defendant. He had taken no part in the acts of infringement, but appeared and put the fact of infringement in issue. An injunction was granted against him, but no damages.

Enforcing Obedience to the Injunction.—When a defendant disobeys an injunction which has been granted against him, the patentee's remedy is a motion to commit. (*f*) It is not necessary that the order for the injunction should have been served, but knowledge that the injunction has been granted must be brought home to the offender.

"If there is a breach of an injunction immediately after it has been ordered, and before there has been time to pass and enter the order and to serve it on the defendant, the Court will enquire whether the defendant knew of the making of the order, and the defendant will not be allowed to escape by any subterfuge. If he was in court when the order was made, he will not be allowed to say he did not hear it; if he was just outside the court, having left it in order that he might not hear the order actually pronounced, he will not be allowed to say he did not know of it." (*g*)

If, however, the plaintiff, by his long delay in having the order drawn up, or otherwise by his conduct gives the defendant reason to think that he does not intend to enforce the injunction, that is an answer to a motion to commit. (*h*) Committal will not be ordered lightly. The case must be strictly made out on the affidavits. (*i*) The Court will not encourage motions to commit where no real case for committal can be made out, and all the mover wants is an apology and costs. (*j*)

(*b*) *Edison* v. *Holland*, 6 R. P. C. p. 285.
(*c*) Ibid. p. 286.
(*d*) *Elsas* v. *Williams*, 1 T. L. R. 145.
(*e*) 16 R. P. C. 344, p. 356.
(*f*) *Plimpton* v. *Spiller*, 4 C. D. 287; *Thomson* v. *Moore*, 6 R. P. C. 445.
(*g*) Per Pearson, J., in *United Telephone Co.* v. *Dale*, 25 C. D. pp. 784, 785.
(*h*) Ibid. p. 786.
(*i*) *Dick* v. *Haslam*, 8 R. P. C. 196.
(*j*) *Plating Co.* v. *Farquharson*, 17 C. D. 49.

Defendants who disobey an injunction render themselves liable to a motion to commit, even where they act in the *bond fide* belief that they are not guilty of any infringement. (*k*) But where the intention of the offenders has been clearly innocent, the Court has refused to construe their conduct as a contempt, or order their committal, though it has made them pay the costs of the motion. Such costs may properly be given on the higher scale, but not (where the respondent is innocent) as between solicitor and client. (*l*)

In *Lyon* v. *Goddard*, where the defendants swore that they had acted in ignorance and with no intention of breaking the injunction, the Court directed that attachment should issue, but not be enforced, if within a fortnight the defendants delivered up their machines and paid the costs of the motion as between solicitor and client. (*m*)

On a motion to commit, the Court, it would seem, cannot order the offender to account for the profits made by his breach of the injunction; but, indirectly, it can compel him to do so, by making non-committal conditional on his submitting to an account. (*n*) If satisfied that the respondent has wilfully disobeyed the injunction, the Court, where it does not commit, will order him to pay the costs of the motion as between solicitor and client, as the price of non-committal and an indemnity to the mover. (*o*)

In *Steele* v. *Hutchings*, where the plaintiff did not press for committal, this course was followed by Jessel, M.R. (*p*)

In *Lyon* v. *Goddard*, where an order was made for committal, these costs were given. (*q*) But such costs are never given to the respondent where the motion fails, not even where the motion has been a mere waste of the time of the Court. (*r*)

In the case of a company, an injunction can be enforced by moving to sequestrate its property, and commit the directors under whose orders the acts complained of have been committed.

In *Spencer* v. *Ancoats Rubber Company*, (*s*) where no order was made on the motion, the respondents were put to their election, the alternatives being an account of profits and delivery up of infringing articles, or sequestration against the company and

(*k*) *Spencer* v. *Ancoats Rubber Co.*, 6 R. P. C. 46; see, also, *Incandescent Gas Light Co.* v. *Sluce*, 17 R. P. C. 173.

(*l*) Ibid. p. 68.

(*m*) 11 R. P. C. 115.

(*n*) Ibid.

(*o*) Ibid.: *Plating Co.* v. *Farquharson*, 17 C. D. 49; *Spencer* v. *Ancoats Rubber Co.*, 6 R. P. C. pp. 66, 67.

(*p*) W. N. 1879, p. 18.

(*q*) 11 R. P. C. 115.

(*r*) *Plating Co.* v. *Farquharson*, supra.

(*s*) 6 R. P. C. 68.

committal against the directors; costs also were given, both against the company and the directors, the directors only to be liable personally in the event of the company failing to pay.

In the *Lancashire Explosives Company* v. the *Roburite Company*, (*t*) the plaintiffs moved to commit the manager and chairman of the respondent company, and, besides costs, asked the Court to direct an enquiry as to damages. Kekewich, J., commented on the unusual form of the motion, but both parties being willing that the substantial question as to whether the respondent company had infringed should be decided by the Court, and it being admitted by the plaintiffs that they did not seek for committal, the motion was heard, both before the learned judge and in the Court of Appeal, very much as if it were an action for infringement. As it was dismissed with costs, the question of ordering an enquiry as to damages did not arise. But Kekewich, J., intimated that, in his opinion, a motion for sequestration, and not for committal, would, in this case, have been the better form of bringing the matter before the Court.

An appeal lies to the Court of Appeal and to the House of Lords, from a refusal to commit. (*u*)

Delivery Up, or Destruction of Infringing Articles.

An Old Remedy in a New Form.—Where infringement is proved against a defendant, the Court will now order the infringing articles in his possession to be delivered up to the plaintiff, or destroyed, or marked so as to prevent their being sold or again put in use. The order will only be made in respect of articles in the possession and control of the defendant. (*v*)

This jurisdiction is not based upon any provision in the letters patent themselves, and is comparatively new.

At one time letters patent usually contained provisions forfeiting articles made in contravention of the patentee's monopoly, and authorizing him to search for such articles. Thus, in the letters patent granted by James I. to *John Gilbert*, in 1618, for a water-plough, or dredger, there are clauses forfeiting all engines, instruments, or devices, made, erected, framed, used, or employed, in resemblance to, or in imitation of, the patentee's invention; and, providing that goods forfeited under the patent may be sold, a

(*t*) 13 R. P. C. 435, 436.

(*u*) Ibid. In the House of Lords, 14 R. P. C. 303; see, also, *Jarmain* v. *Chatterton*, 20 Q. B. D. 493.

(*v*) *Chadburn* v. *Mechan*, 12 R. P. C. 135.

moiety of the proceeds going to the Crown, and a moiety to the patentee. (*w*)

Although these conditions are found in ancient grants, the common law denied their validity, and laid down the principle that no forfeiture can arise by royal patent. (*x*) No forfeiture clause, therefore, is now found in letters patent for inventions. Nevertheless, the Court has recently assumed a jurisdiction in infringement actions over infringing articles under the control, or in the possession, of the defendant.

Betts v. *De Vitre* (*y*) appears to have been the first reported case in which this jurisdiction was exercised. There Wood, V.C., made an order for an enquiry as to what infringing articles the defendants had in their possession, all articles so certified, to be destroyed in the presence of the managers and solicitors of the plaintiffs.

Next, in *Tangye* v. *Stott*, (*z*) the plaintiffs prayed a decree that all pulleys in the custody of the defendants and made in infringement of the plaintiffs' patent might be delivered up; and the same learned Vice-Chancellor made an order requiring the defendants to make an affidavit specifying such articles, and to deliver them up to the plaintiffs within seven days of the filing of the affidavit.

In *Plimpton* v. *Malcolmson*, Jessel, M.R., made a similar order in the following terms: "And let the defendant forthwith upon oath deliver up to the plaintiff, or break up, or otherwise render unfit for use, all roller skates, or parts of roller skates, so manufactured or let for hire by, or by the order, or for the use, of the defendant in infringement of the said letters patent as aforesaid, which are in the possession, custody, or power of the defendant or his servants or agents." (*a*)

Again, in *Frearson* v. *Loe*, (*b*) the same learned judge ordered the defendant either to deliver up to the plaintiff or destroy in his presence any infringing machinery in the defendant's possession or power.

So, likewise, in *Badische Anilin* v. *Levinstein*, (*c*) Pearson, J., ordered all infringing dye stuffs in the possession of the defendants

(*w*) Rymer's *Fœdera*, vol. xvii. fo. 12 (Pat. 16 Jac. I. p. 5); see, also, *Baker's Smalt Patent*, 1 W. P. C. 12, n.; *Lord Dudley's Patent*, 1 W. P. C. 15.

(*x*) See Coke, 2 *Inst.* 47; *Hasting's Patent*, Noy, 183; *City of London's Case*, 8 Coke, *Rep.* 125 (a), 127 (b); *Horne* v. *Ivy*, 1 Siderfin, 441.

(*y*) 2 Giff. 628; 3 De G. F. & J. 217, 309; 34 L. J. Ch. 289 (1865).

(*z*) 14 W. R. 386; *Seton on Decrees*, 5th edit. (1891), vol. i. p. 565.

(*a*) *Seton on Decrees*, 5th edit. vol. i. pp. 565, 566.

(*b*) L. R. 9 C. D. 67.

(*c*) 24 C. D. 176.

to be verified by affidavit, and at their option either delivered up to the plaintiffs or destroyed. A similar order for verification was made in *Westinghouse* v. *Lancashire Railway Company*. (*d*) But in that case the plaintiff was to be at liberty to inspect and mark the articles (a brake apparatus) so verified, and no order for delivery up was made.

In *Siddell* v. *Vickers*, (*e*) where the patent related to mechanical appliances for operating on large forgings in iron and steel, Kekewich, J., in view of the nature of the invention, declined to order delivery up or destruction of the infringing apparatus. The Court of Appeal took a like course in *Lancashire Explosives Company* v. *Roburite Company*. (*f*)

Where the infringement is limited to parts of a machine, the order will also be limited to those parts. (*g*)

In *Moser* v. *Marsden*, (*h*) where the infringement consisted in parts of a machine, the Court of Appeal made an order that the infringing articles should be delivered up to the plaintiff, or destroyed, or rendered unfit for use.

In the *Welsbach Incandescent Gas Company* v. *Daylight Mantle Company*, (*i*) an order for delivery up of infringing articles was made; the plaintiffs undertaking that if notice of appeal was given by the defendants within a month, the articles so delivered up would be retained in the plaintiffs' possession pending the appeal.

The object of the Court in making an order for delivery up or destruction of infringing articles is not to punish the defendant, but to protect the plaintiff; therefore, where such an order is not required in the plaintiff's interest, it will not be made, for its effect would be merely mischievous. (*j*)

For the protection of the plaintiff the Court will require the defendant by its order to file an affidavit verifying on oath the articles in his possession which infringe the plaintiff's patent. (*k*)

Property still in Defendant.—Although the Courts will thus order the infringing articles in the possession of the defendant to be delivered up or destroyed, they have never claimed to effect a

(*d*) 1 R. P. C. 253.

(*e*) 5 R. P. C. 101.

(*f*) 12 R. P. C. 483.

(*g*) *Automatic Weighing Machine Co.* v. *Fearby*, 10 R. P. C. 442; *Edison-Bell* v. *Smith*, 11 R. P. C. 389; *Howes* v. *Webber*, 12 R. P. C. 470; *Shoe Machinery Co.* v. *Cutlan*, 12 R. P. C. 357.

(*h*) 10 R. P. C. 364; see, also, *Otto* v. *Steel*, 3 R. P. C. 120.

(*i*) 16 R. P. C. 355.

(*j*) *United Telephone Co.* v. *London & Globe Telephone Co.*, 26 C. D. 776.

(*k*) *Washburn Co.* v. *Patterson*, 1 R. P. C. 191; *Edison-Bell* v. *Smith*, 11 R. P. C. 406.

forfeiture and divest the defendant of his property in such articles.

"The property," said Cotton, L.J., in *Vavasseur* v. *Krupp*, (*l*) "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, and does this as the most effectual mode of protecting the plaintiff's rights, not on the footing that there is no property in the defendant."

A plaintiff, therefore, where articles are delivered up, cannot sell such for his own profit; he is only entitled to their custody, so that the defendant shall not use them.

In the *United Telephone Company* v. *Walker*, (*m*) the defendants sought to set off against the damages payable by them the value of the instruments delivered up under the judgment. Commenting on this Chitty, J., said: "It was said by the defendants there ought to be a set-off as against these damages of the value of the instruments which had been given up under the judgment. That appears to me to be absolutely untenable. The judgment is that those instruments should be delivered up, and the plaintiffs have not to pay for them in any form. That is one of the penalties which the patent law imposes on the infringer."

Marking Infringements.—When the Court does not order delivery up of infringing articles it will sometimes order them to be marked to prevent their being put into circulation to the patentee's injury. (*n*)

Damages or an Account.

These Remedies Alternative only.—In addition to an injunction and delivery up or destruction of infringing articles, the patentee may claim damages or an account of profits.

Formerly in Courts of Equity an account was a remedy

(*l*) L. R. 9 C. D. pp. 358, 359.

(*m*) 4 R. P. C. 67.

(*n*) *Needham* v. *Oxley*, 8 L. T. (N. S.), 604; *Plimpton* v. *Malcolmson*, Seton, 565; *Westinghouse* v. *London & Yorkshire Railway Co.*, 1 R. P. C. 229; *Badische Anilin* v. *Levinstein*, L. R. 24 C. D. 156.

ancillary only to an injunction. Therefore where an injunction was refused, no account could be obtained, and the patentee was left to obtain redress for the wrong he had suffered by way of damages in an action at law. (*o*) But now every judge of the High Court has jurisdiction in an infringement action to order an account or an enquiry as to damages whether an injunction is granted or not. (*p*) A successful plaintiff cannot, however, have both damages and an account against the same infringer. He must elect which remedy he will take; for in asking for damages he treats the defendant as a wrong-doer, an infringer of the patent right; whereas in taking an account he condones the infringement and treats the defendant as an agent or trustee called upon to account for the profits made by him in the unauthorized use of the invention. These two forms of relief are therefore inconsistent, and the patentee cannot at one and the same time reprobate and approbate. (*q*)

"The account and the enquiry as to damages," said Lord Chelmsford in *Betts* v. *Neilson*, (*r*) "have each of them a different object: one is to ascertain what loss the plaintiff has sustained, the other, what profit the defendant has acquired by the infringement of the patent. It might be that the party infringing had sold the patented article at an under-price, so that the amount of his profit would be no measure of the plaintiff's loss. And even in cases where there has been no such underselling, the plaintiff may have sustained damage far beyond what the gains of the defendant would compensate."

Damages.

Measure of Damage where the Patentee does not himself Manufacture.—Where the patentee did not himself manufacture, but granted licenses for that purpose to others at a fixed royalty, Wood, V.C., held that he could not recover as a part of his damages a manufacturer's profit, much less the profit he would have made if every unlicensed machine had been sent to him to be fitted with his

(*o*) Hindmarch, p. 361; *Smith* v. *London & South Western Railway Co.*, Kay, 408; *Price* v. *Bauwen*, 4 K. & J. 727; *Hocking* v. *Fraser*, 3 R. P. C. 7; *Proctor* v. *Bailey*, 6 R. P. C. 538; *Betts* v. *Gallais*, L. R. 10 Eq. 392.

(*p*) Patents Act, 1883, s. 30; *Sayers* v. *Collyer*, L. R. 28 C. D. p. 108.

(*q*) *Betts* v. *Neilson*, L. R. 5 H. of L. Ca. 1; 40 L. J. Ch. 317; *Betts* v. *De Vitre*, L. R. 6 H. of L. 319; *United Horse Shoe Nail Co.* v. *Stewart*, 3 R. P. C. 143; 13 App. Ca. p. 412; 5 R. P. C. 260; *American Braided Wire Co.* v. *Thompson*, 7 R. P. C. 158; 44 C. D. 274.

(*r*) L. R. 3 Ch. p. 440. Roversed in so far as it gave both damages and an account against same defendant. See supra.

invention; but that he was limited to the sum represented by the royalties which would have been paid him had the defendants manufactured under his license. (*s*)

"Here is a case," said the learned Vice-Chancellor, "where the patentee is not in the habit of manufacturing the articles to which the patent applies, or, at all events, very seldom does so; but he has been in the habit of granting, not general shipbuilders' licenses, but a particular license of 2*s*. 6*d*. per horse-power for each ship which is about to be built with his invention. The defendants accordingly, if they had applied, as they ought to have applied, to the plaintiff, would have had to pay 2*s*. 6*d*. per horse-power for every ship which they built with his invention. That is the amount which the plaintiff got from everybody else; and it does not appear to me that he is entitled to anything more from the defendants." (*t*)

In this case it appeared that some of the persons who had purchased the invention from the defendants had already paid the royalty direct to the patentee; in respect of such infringements, Wood, V.C., held that nothing further could be recovered by the patentee, as his loss had already been made good.

In the *English and American Machinery Company* v. *Union Boot and Shoe Company*, (*u*) the plaintiffs only granted licenses to use their machines, and did not offer them for sale in England. The defendants had sold nine for exportation. Stirling, J., varying the Chief Clerk's certificate, held that the sum to which the plaintiffs were entitled by way of damages was the amount represented by the profits from licenses of which they had been deprived.

Where the Patentee Manufactures. — Where, however, the patentees are themselves the manufacturers of the patented article which they sell, they can recover a manufacturer's profit; and in such case the true measure of their damage is the amount of profit which they would have made if they had themselves effected the defendants' sales, deducting a fair percentage in respect of any sales which may be found to have been due to the particular exertions of the defendants. (*v*)

Different considerations arise, however, where the infringement is committed in connection with an article in which the patentee does not himself deal.

Thus, in the *Pneumatic Tyre Company* v. the *Puncture Proof*

(*s*) *Penn* v. *Jack*, L. R. 5 Eq. 81; 37 L. J. Ch. 136.

(*t*) Ibid. p. 85.

(*u*) 13 R. P. C. 67.

(*v*) *United Horse Shoe Nail Co.* v. *Stewart*, 5 R. P. C. 260; 13 App. Ca. 401.

Tyre Company, (*w*) the defendants had infringed by applying bicycle tyres which were an infringement of the plaintiffs' patent to machines of a lower grade than the bicycles in connection with which the plaintiffs used their invention. An enquiry as to damages having been directed, the plaintiffs contended that their damage was to be measured on the footing that but for the infringement, they would have themselves made the number of sales effected by the defendants. The Master having acceded to this proposition, the defendants moved to vary the certificate and reduce the damages, on the ground that it was wrong to assume that the plaintiffs would have effected with their high grade machines the sales made by the defendants, seeing that the plaintiffs did not cater for the lower class of buyer by making the cheaper article. The defendants further contended that the proper measure of damage was what the plaintiffs would have earned in royalties on the machines sold had the defendants been licensees. Wills, J., having reduced the damages, the plaintiffs appealed against the reduction. The Court of Appeal held, however, that the sum assessed by Wills, J., was, in fact, the correct amount. But that, as the action was one to compensate the plaintiffs, they were only entitled to such a sum as represented the actual loss occasioned to their trade by the sales of the defendants; and, therefore, that the mode suggested of arriving at that loss by treating the defendants as licensees was inadmissible, and (seeing that the plaintiffs did not grant licenses) impossible of application, for there was no means of ascertaining what royalty they would have accepted for the use of their invention.

Where the Infringer takes Part only of the Invention.—The circumstance that an infringer only uses a small part of the patented invention may be very material, where the claim against him is for an account of profits, but it is quite irrelevant where the claim is for damages.

In the *United Horse Shoe Nail Company* v. *Stewart*, (*x*) the Court of Session having on such ground given nominal damages only, the House of Lords reversed their decision.

"When a patentee," said Lord Watson, "elects to claim the *profits* made by the unauthorized use of his machinery it becomes material to ascertain how much of his invention was actually appropriated, in order to determine what proportion of the net

(*w*) 15 R. P. C. 405; 16 R. P. C. 209. See *Gavioli* v. *Shepherd*, 17 R. P. C. 157, where the defendant's evidence that he could not have afforded to buy the patentee's machine was held to negative damage altogether.

(*x*) 13 App. Ca. 412; 5 R. P. C. 266.

profits realized by the infringer was attributable to its use. It would be unreasonable to give the patentee profits which were not earned by the use of his invention. But the case is altogether different when the patentee of machinery, who does not grant licenses, claims *damages* from an infringing manufacturer, who competes with him by selling the same class of goods in the same market. In that case the profit made by the infringer is a matter 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 license, by patent 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."

If the defendants have, in fact, infringed they will not be heard to say that they could have done the same amount of business without using the plaintiff's invention, and that therefore the plaintiffs have suffered no damage. In view of their actual infringement such a contention is entirely beside the mark. (*y*)

Such Loss only as is the Natural Consequence of the Infringement is Recoverable.—The loss which a patentee can recover in damages is such loss as is the natural consequence of the acts of infringement complained of; other damage is too remote. (*z*) This is the universal rule of law in actions founded on tort and equally applicable in patent cases.

What is the amount of loss in any particular case can rarely be determined by exact arithmetical calculations. It is hardly ever possible to arrive precisely at what the amount of the patentee's sales and profits would have been but for the infringement. As a rule a general estimate must be made, assessing the damage as a jury would assess it; (*a*) not by mere guessing. "As if," said Lord Esher, M.R., in *Ungar* v. *Sugg*, "you were tossing up for the thing, but it must come to a mere question of what, in the mind of the person who has to estimate them, was a fair sum." (*b*)

(*y*) 5 R. P. C. p. 268; see, also, *Boyd* v. *Tootal*, 11 R. P. C. 175.

(*z*) *United Horse Shoe & Nail Co.* v. *Stewart*, 5 R. P. C. 268; 13 App. Ca. 401; *British Insulated Wire Co.* v. *Dublin Tramway Co.*, 17 R. P. C. 14.

(*a*) See Lord Halsbury, C., ibid. p. 264; Lord Watson, p. 267. See, also, *American Braided Wire Co.* v. *Thomson*, 5 R. P. C. 541.

(*b*) 9 R. P. C. 117.

Loss by Reduction of Prices.—Sometimes the competition of infringers who undersell the market so affects the patentee's trade that to save his business he reduces his prices to meet this unlawful competition. A question then arises whether he is entitled to recover from the offender as damages the diminution of profit so occasioned.

This question was much discussed in the *United Horse Shoe & Nail Company* v. *Stewart* (*c*) and the *American Braided Wire Company* v. *Thomson*. (*d*) In the first of those cases the patent was for a waste saving machine which resulted in the more economical production of nails. Here the pursuers had in self-defence reduced their prices on various occasions. Such reductions had, however, always been made in anticipation of those of the defenders, and to a figure a little below their price. (*e*) The pursuers alleged they were compelled to this course by the defenders' unlawful competition, and claimed damages in respect of such reductions. The Court, however, was of opinion that the action of the pursuers in reducing their prices was not occasioned solely by the trade of the defenders, but to a large extent by the lawful competition of other makers, and gave no damages in respect of these reductions.

"I think," said Lord Macnaghten, "the claim for loss of profit by reason of the reduction of price must be rejected. I do not think that was the natural or direct result of the respondents' acts. The appellants seem to have had no difficulty in ascertaining where the competing nails were made, and in coming to the conclusion that they were produced by machinery which infringed their patent rights. The appellants must be taken to have believed in their case. If they believed that the respondents were infringing their rights, and relied on obtaining redress in due course of law, it appears to me that it was not a reasonable course on their part to reduce the price so as to injure their own trade. On establishing their rights they would be entitled either to the profits which the respondents might have made, or to the damages which they could prove they had sustained. In lowering their prices they seem to me to have been prompted by a desire to provide for the contingency of their failing in their action, and by an anxiety to drive their rivals from the field, whether they were right or wrong." (*f*)

(*c*) 5 R. P. C. 260; 13 App. Ca. 401.
(*d*) 7 R. P. C. 152.
(*e*) See Cotton, L.J., distinguishing this case in *American Braided Wire Co.* v. *Thomson*, 7 R. P. C. p. 160.
(*f*) 5 R. P. C. 269; 13 App. Ca. 416.

In the *American Braided Wire Company* v. *Thomson*, (*g*) the same point was discussed, and the plaintiffs were allowed to recover the loss, but not as damages for reduction of price. Here the facts were somewhat different. The plaintiffs had not reduced prices until after the defendants had first done so, and on each occasion of a reduction they had only come down to the price at which the defendants were then selling. Moreover, the article sold was not one in which there was already a general trade, but one which no person but the plaintiffs could lawfully make. The Official Referee, to whom the enquiry to assess the damages had been referred, found as a fact that but for the unlawful competition of the defendants the plaintiffs would have effected, at the original price, not only their own sales but also those made by the defendants; and the Court being unable to disturb this finding on the evidence, held that the plaintiffs were entitled to recover damages on this footing, *i.e.* not as arising from a reduction of price, but as directly occasioned by the wrongful conduct of the defendants.

"It appears to me," said Lindley, L.J., "to be an entire fallacy to say in this case that the plaintiffs are seeking damages for selling at reduced prices. They are not doing anything of the sort. In the Scotch case they were, and it was precisely that controversy and that contention of theirs which was negatived by Lord Macnaghten. In the Scotch case there was competition of the most formidable kind of other nails besides those made by the patentees' process, and entirely exclusive of the competition by the infringers of the patent. . . . The patentees there were claiming, or seeking to claim, and endeavouring to substantiate, not the damages properly referable to, and occasioned by, the wrongful act of the defendants, but they were claiming that which the plaintiffs here do not claim at all—they were claiming damages in respect of the reduction of price." (*h*)

Commenting on the above cases in *Alexander* v. *Henry*, (*i*) Kekewich, J., stated the law as laid down by them as follows: "Because a trader has reduced the prices of the article which he is offering to the public, you must not therefore assume, notwithstanding that there is an infringer in the market, that he is really injured by the reduction of prices. He may have done it merely as a matter of policy; he may have been influenced by many reasons; and to jump to the conclusion that because a manufacturer has thought fit to reduce his prices, therefore the reduction

(*g*) 7 R. P. C. 152. (*h*) Ibid. 161. (*i*) 12 R. P. C. p. 367 (a trade mark case).

—that is to say, the difference between the original price and the reduced price is an injury caused to him by the infringer, to be measured by that difference in money, is really coming to a conclusion without premises, ignoring possible and even probable facts which might influence the result. Again, if you find facts from which a reasonable man might conclude that the reduction in price was the result of the infringement, then you at once get on entirely different lines, and you then come to the conclusion that the loss is the natural consequence of the infringement, and is caused to the manufacturer directly by what the infringer does. Then you have no difficulty in measuring the damage by the loss in money, and visiting that on the head of the infringer."

In *Boyd* v. *Tootal*, a claim for damages, on the ground that the conduct of the infringers had increased the cost at which the plaintiffs produced their machines, and had prevented their keeping up the price, was held too remote. (*j*)

In the *Pneumatic Tyre Company* v. the *Puncture Proof Tyre Company*, (*k*) Lord Russell, C.J., said that in assessing the damages the injury done to the patentee by his articles being shouldered out of the market, and the injury to his trade reputation by inferior articles being put before the public were both to be considered.

Damages obtained against the Seller will not License an Infringing Article in the Hands of Buyers.—The circumstance that a patentee has recovered damages or an account against a manufacturer of infringing articles does not preclude him from thereafter suing the persons who are using pirated articles bought from such manufacturer.

"It has never been held in this Court," said Wood, V.C., in *Penn* v. *Bibby*, (*l*) "that an account directed against a manufacturer of a patented article, licenses the use of that article in the hands of all the purchasers. The patent is a continuing patent, and I do not see 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." (*m*)

Nor are the damages which may be recovered from such users merely nominal; substantial damages may be given. "The Courts would never," said Robinson, V.C., in *Boyd* v. *Tootal*, "have directed accounts and enquiries the way that they have done, if they considered that the damages that the plaintiff had

(*j*) 11 R. P. C. p. 184.
(*k*) 16 R. P. C. 209.
(*l*) L. R. 3 Eq. 308; *Penn* v. *Jack*, L. R. 5 Eq. 81; 37 L. J. Ch. 136; *Boyd* v. *Tootal*, 11 R. P. C. 184.
(*m*) L. R. 3 Eq. 311.

sustained by a person who had used an infringing machine were merely nominal." (*n*)

In the *United Telephone Company* v. *Walker*, (*o*) the defendants were sued for using articles in respect of which the plaintiffs had already obtained judgment for £50 (agreed damages) against *Orme*, the manufacturer. They contended that no second action would lie in regard to these articles, which had been freed from objection by the damages paid by *Orme*. Rejecting this contention, Chitty, J., said: "That contention, it appears to me, cannot be for one moment maintained. *Orme* was a manufacturer, and he had parted with a certain number of instruments, in respect of which the present defendants are sued. A large number, I understand, out of the 140 were supplied by *Orme* to the defendants. The damages that were taken by the plaintiffs in their action against *Orme* were only in respect of his infringement, and nothing more, and the patentees (the plaintiffs) are entitled to pursue the instruments into other hands, and to recover from them damages in respect of that other infringement. If a royalty had been paid by *Orme*, equal to the total royalty payable in respect of each instrument, any such instrument, though disposed of by *Orme*, would, as I am at present advised, have been what I have termed a free instrument in the market, and the plaintiffs would have suffered no loss in respect of that; in other words, they would have taken from *Orme* that which would have amounted to a complete license to deal with those instruments, and so the purchasers of those instruments would have been freed from any liability in respect of them. But that is not what was done. The £50 was only the agreed amount of damage against *Orme*, and it was part of the order that *Orme* should give the names of his purchasers, and the instruments which he had supplied to them, in order that the plaintiffs might pursue those instruments into the hands of the purchasers or their assigns."

Settlement with one Defendant does not Bar Right to Damages from Others.—The circumstance that the plaintiff has accepted damages on a reduced scale from infringers who have settled with him before action, is no bar to his right to recover his full damages from others who have not availed themselves of that offer.

In *Boyd* v. *Tootal*, the plaintiffs had issued a circular offering to take damages at 4*s*. per spindle on all infringing machines from such infringers as paid without litigation. This offer they said they made at a rate considerably less than their actual damage to induce a friendly settlement. It was argued that this offer

(*n*) 11 R. P. C. 179.

(*o*) 4 R. P. C. 63; 56 L. T. 508.

precluded them from afterwards recovering their full damage, which was 7*s.* per spindle, from users who had declined to settle. Robinson, V.C., following *Penn* v. *Bibby*, (*p*) rejected this contention. "That seems to me to be entirely covered by the case before Wood, V.C., in which he says that litigants may be sued for a larger sum, that is, for the true amount of damages, and the fact that the plaintiffs have settled with certain people on a lower basis is not to be taken finally as the complete measure of damage that the plaintiffs have sustained. In fact, it would be most unreasonable, for it is always worth a litigant's while to take off something from his claim for the sake of peace, especially in a case like the present, where he is endeavouring to keep the good-will of the persons who have been using his patent." (*q*)

Innocence of Infringer no Answer to Claim for Damages.—As innocence of an intention to infringe is no answer to an action of infringement, a defendant is not relieved from his liability to pay full damages by shewing that he acted in ignorance of the patent right.

In *Boyd* v. *Tootal*, (*r*) one set of defendants had taken over the machines complained of with the purchase of a mill, knowing little or nothing about them. The House of Lords having ultimately determined, in the action of *Boyd* v. *Horrocks*, (*s*) that those machines were an infringement of the plaintiff's patent, the patentee instituted proceedings against these defendants, and recovered damages for the full amount of his loss, through their unauthorized use of his invention.

Where the plaintiffs inadvertently omitted to ask for damages at the trial, Kay, J., varied the minutes of decree on a subsequent motion by adding an enquiry as to damages. (*t*)

Damages will not be given against third parties, though they may be made liable in costs. (*u*)

Where a patent belongs to tenants in common and one dies, damages recoverable for infringement of the patent right accrue to the survivor. (*v*)

(*p*) L. R. 3 Eq. p. 312 (per Wood, V.C.).

(*q*) 11 R. P. C. p. 184.

(*r*) Ibid. 175, see p. 185; cf. *Davenport* v. *Rylands*, L. R. 1 Eq. 308.

(*s*) 9 R. P. C. 77.

(*t*) *Edison* v. *Holland*, 5 R. P. C. 483; cf. *Fritz* v. *Hobson*, 14 C. D. 561.

(*u*) *Edison & Swan* v. *Holland*, 6 R. P. C. p. 286. It would be otherwise if they were made defendants by amendment: ibid. See Lindley, L.J.

(*v*) *Smith* v. *London & North Western Railway Co.*, 2 E. & B. 69; see, also, *National Society for the Distribution of Electricity* v. *Gibbs*, 68 L. J. Ch. 503; 80 L. T. 524; 15 T. L. R. 336; [1899] 2 Ch. 289.

Assignees of a patent may recover damages in respect of infringements committed before the date of their assignment, for they succeed to all the rights and property of their predecessors in title. (*w*)

Mode of Assessment.—Where damages are awarded to a successful plaintiff the Court will not usually itself try the question of the amount. That will be referred to be the subject of a separate enquiry. But if the damage is manifestly of a trivial character the Court will assess it. (*x*)

In *Cole* v. *Saqui*, (*y*) where the damages were nominal, Kekewich, J., refused an enquiry, and himself assessed the amount at 40*s*. In *Ungar* v. *Sugg*, (*z*) the damages were problematical, and the Court of Appeal said the judge should not have referred them to the chief clerk, but assessed them himself.

In the *Incandescent Gas Light Company* v. *Brogden*, (*a*) the plaintiffs were given an enquiry as to damages at their own risk as to costs, which were reserved, the judge doubting whether the quantum of damage was more than nominal.

Where the infringement has been substantial an enquiry as to damages will generally be more advantageous to the plaintiff than an account of profits. (*b*)

When damages are claimed the profits made by the infringer are wholly immaterial, the sole object of the enquiry being to ascertain what direct loss the plaintiff has suffered by reason of the defendant's wrongful acts. (*c*)

Enquiry when Directed.—Whenever the assessment of the damage involves an examination into matters which cannot be conveniently dealt with by the judge at the trial, such as accounts and details of business transactions, an enquiry will be directed. But there appears to be no power, once the case has been tried by a judge alone, to direct the assessment of the damages by a jury.

Discussing this in the *American Braided Wire Company* v. *Thomson*, Kekewich, J., said: "The old practice of the Court of Chancery was to refer everything in the way of damages or

(*w*) *United Horse Shoe & Nail Co.* v. *Stewart*, 13 R. P. C. 417.

(*x*) *Dicks* v. *Brooks*, 15 C. D. p. 40; 49 L. J. Ch. 819; *United Telephone* v. *Sharples*, 2 R. P. C. 32.

(*y*) 5 R. P. C. 496, 497.

(*z*) 9 R. P. C. 117.

(*a*) 16 R. P. C. 179.

(*b*) See, however, *English & American Machinery Co.* v. *Union Boot & Shoe Co.*, where the reverse was the case: 13 R. P. C. 67.

(*c*) *United Horse Shoe & Nail Co.* v. *Stewart*, 5 R. P. C. 260; 13 App. Ca. 401, p. 413.

compensation or anything of that kind to the chief clerk, or, before the days of the chief clerks, to the master; or, in modern times, there was a power to call in an expert to guide the Court. That power remains under the Judicature Acts, and we have besides that a large power of referring questions of difficulty to gentlemen who are appointed for the purpose, and who are called official referees. (*d*) Beyond that, with the consent of the parties, the Court is enabled to refer questions to a special referee; (*e*) but I know of no means by which the Court can get over a difficulty of this kind other than those indicated in the way I have mentioned. The Court must try itself, with the assistance of an expert, referring matters of detail to the chief clerk, or it must send it to a referee. What I am asked to do is to go beyond that and to adopt entirely a different course, and direct a trial by jury. Now, it has not been suggested that the words of any order directly enable me to do that. The second part of Order XXXVI., which deals with the mode of trial, is all pointed to the trial of the action being one trial, which takes place either with or without a jury, with or without assessors, and so forth, but to one trial of the action; or there may be, no doubt, independently of the trial, but for the purposes of the trial, an issue of fact, or an issue of law, directed in order that the result of that may come before the Court at the trial. That part of that order has nothing whatsoever to do with an assessment of damages directed by the judgment to be assessed, and one would not expect to find anything of the kind there. As a matter of fact, there is nothing there. Cases have arisen, no doubt, in which questions of fact and questions of damages have been ordered to be tried by the Chancery Division, at the Assizes, or in the Queen's Bench Division in London; and in the case of *Fennessy* v. *Rabbits*, (*f*) which has been mentioned, the Court did that very thing where, by the submission of the defendants to the rest of the relief asked, the plaintiffs' claim was reduced merely to one of damages, which was the only issue at the trial. That was very properly and naturally sent to the Queen's Bench Division, in order that it might be tried by a jury. It seems to me that I have no power to divest myself of this difficult task of ascertaining these damages. They must be ascertained by the officer of the Court in the ordinary way, with the power of coming back to the Court to vary the certificate, and so forth." (*g*)

(*d*) See R. S. C. Order 36, rules 57 & 57A.
(*e*) See Arbitration Act, 1889, ss. 13, 14.
(*f*) 56 L. J. (N. S.), 138.
(*g*) 5 R. P. C. pp. 541, 542.

Discovery in Aid of the Enquiry.—The plaintiff is entitled to discovery in aid of his enquiry as to damages. And the defendant may be ordered to file an affidavit stating what infringing articles he has made or sold, and giving the names and addresses of the persons to whom he has sold them.

In *Murray* v. *Clayton*, the defendants sought to withhold these names unless the plaintiff would give an undertaking not to proceed against such purchasers. The Court, however, insisted on full information being given.

"As a matter of course," said Bacon, V.C., "in prosecuting that enquiry, (*h*) the plaintiff is entitled to have from the defendants the fullest possible discovery. That is so well settled that no case can be referred to in which the practice is called in question. Among other things, the plaintiff is entitled to that which the order gives him, the names and addresses of the persons to whom machines were sold. . . . The defendants apprehend 'that if they were to furnish the plaintiff with the names and addresses of the persons to whom they have sold machines, the plaintiff might feel inclined to attack them, and issue process against them; and that, as a consequence, the business of the defendants would be injured.' That is a consideration to which I can in no degree attend. If the inconvenience which they apprehend should ever happen, it will be in consequence of that which, as the law now stands, has been decided to be a wrong done by the defendants. They cannot excuse themselves or avoid the discovery which is asked, because of any consequences which may ensue from their wrong-doing. . . . I cannot interfere so as to prevent the plaintiff taking any proceedings he may be advised to take." (*i*)

In the *American Braided Wire Company* v. *Thomson*, Kekewich, J., made an order that the defendants should disclose the names of their customers and the prices at which they had sold, notwithstanding an appeal was pending to the House of Lords. (*j*)

Form of Enquiry.—In directing an enquiry as to damages the proper form is to enquire "what damage the plaintiff has sustained," not "what damage, if any," as it would be in a trade mark case.

The reason of this is explained by Wood, V.C., in *Davenport* v.

(*h*) As to damages.

(*i*) L. R. 15 Eq. pp. 118, 119, 120; 42 L. J. Ch. 192. See, also, *Powell* v. *Birmingham Vinegar Brewery Co.*, 14 R. P. C. 1 (a trade mark case).

(*j*) 5 R. P. C. 378.

Rylands as follows: "There is this difference between the case of a trade mark and that of a patent: in the former case the article sold is open to the whole world to manufacture, and the only right the plaintiff seeks is that of being able to say, 'Don't sell any goods under my mark.' He may find his customers fall off in consequence of the defendant's manufacture; but it does not necessarily follow that the plaintiff can claim damages for every article manufactured by the defendant, even though it be under that mark. On the other hand, every sale without license of a patented article must be a damage to the patentee." (*k*)

The order for an enquiry as to damages will generally contain a direction that the defendant pay to the plaintiff the amount found against him.

In *Cunningham* v. *Colling*, (*l*) the order was to pay within twenty-one days after the filing of the chief clerk's (now the master's) certificate of the result of the enquiry.

Where a defendant admits infringement by his defence, and the plaintiff elects to move for judgment on the admissions, under Order XXXII., rule 6, he accepts the negative as well as the affirmative allegations of the defence, and is only entitled to an enquiry as to damages in respect of the admitted instances of infringement. All evidence of other infringements will therefore be excluded at the enquiry. (*m*)

The plaintiff is entitled to have the damages assessed down to the date of the enquiry; or, if the patent has expired during action, down to the date of its expiration. (*n*)

No damages are recoverable in respect of infringements prior to the publication of the complete specification; (*o*) nor (where the specification has been amended) prior to that amendment, unless the patentee establishes, to the satisfaction of the Court, that his original claim was framed in good faith, and with reasonable skill and knowledge; (*p*) nor where the infringement occurred after a failure by the patentee to pay his patent fees within the prescribed time and before the enlargement thereof, under Section 17 of the

(*k*) L. R. 1 Eq. p. 308; 35 L. J. Ch. p. 206.

(*l*) *Seton on Decrees*, 5th edit. vol. i. p. 567. See, also, *Plimpton* v. *Malcolmson*, ibid. 565; and *Wenham* v. *Carpenter*, 5 R. P. C. 70. Both of these last were cases of an enquiry as to profits.

(*m*) *United Telephone* v. *Donohoe*, 31 C. D. 401.

(*n*) See *Davenport* v. *Rylands*, L. R. 1 Eq. 302; *Fox* v. *Dellestable*, 15 W. R. 194; *Fritz* v. *Hobson*, 14 C. D. 557; *British Insulated Wire Co.* v. *Dublin Tramway Co.*, 17 R. P. C. 14; also R. S. C. Order 36, rule 58.

(*o*) Patents Act, 1883, s. 13.

(*p*) Ibid. s. 20; *Wenham* v. *Carpenter*, 5 R. P. C. 68; *Hopkinson* v. *St. James's Co.*, 10 R. P. C. 62.

Patents Act, 1883, if the Court which tries the action refuses to give any damages in respect of such infringement. (*q*)

Where an enquiry as to damages is directed, the costs are generally reserved for consideration after the enquiry has been held. (*r*)

Reviewing the Finding at the Enquiry.—Where an enquiry as to damages is ordered, either party, if dissatisfied with the result, may move to have the certificate varied. On the hearing of the motion, the judge, if the evidence below appears to him to have been unsatisfactory, will hear further evidence. (*s*) But this is not usual, and will only be done in exceptional circumstances.

In any case, however, the judge is not bound by the certificate as he would be by the finding of a jury, and may vary it if he thinks proper, (*t*) whether it be the certificate of the Master or the finding of an official referee. (*u*)

At the same time, the Court will remember that the official referee, or the master (as the case may be), has had the witnesses before him and seen how they gave their evidence, and will not therefore differ from his decision willingly.

"Where the evidence," said Kekewich, J., in *Alexander* v. *Henry*, "is all in writing, then, of course, the Court is in a very different position; but when the evidence is oral, it would be presumptuous, dangerous, mischievous, in my opinion, for the judge, with only the transcript of the shorthand notes, or the referee's own notes before him, to say that this, that, or the other conclusion must follow, because it is the necessary consequence of the grammatical meaning of certain language used by persons who may have been lying, or stating facts in language which they did not themselves understand, or did not mean to be understood in the sense which it grammatically bears." (*v*)

In the *Pneumatic Tyre Company* v. the *Puncture-Proof Tyre Company*, (*w*) the Court of Appeal, on an appeal from Wills, J., who had varied the master's certificate as to damages, expressed the opinion that such an appeal ought to be heard as the Court would hear a motion for a new trial after a verdict given by a jury,

(*q*) Patents Act, 1883, s. 17 (4) (b).

(*r*) *United Telephone Co.* v. *Fleming*, 3 R. P. C. 282; *United Telephone Co.* v. *Patterson*, 6 R. P. C. 142; *Jenkins* v. *Hope*, 13 R. P. C. 60; *Aktiebolaget Separator* v. *Dairy Co.*, 15 R. P. C. 338; *Incandescent Gas Co.* v. *Brogden*, 16 R. P. C. 179.

(*s*) *English & American Machinery Co.* v. *Union Boot & Shoe Co.*, 13 R. P. C. 66.

(*t*) Ibid.

(*u*) *Alexander* v. *Henry*, 12 R. P. C. 366.

(*v*) Ibid.

(*w*) 16 R. P. C. 209; per Lord Russell, C.J., p. 216.

and that the test was not whether the finding was one the Court would have given, but one at which a jury could reasonably have arrived, on the evidence.

Where, however, the enquiry is referred, by consent, to a special referee, his finding is as binding on the parties and the Court, as that of an arbitrator would be.

Account of Profits.

Disadvantages of an Account.—Instead of an enquiry as to damages, a patentee may claim an account of profits; where he does so, he elects to take, by way of compensation, what the defendant has made out of the infringement of the patent. If the wrong-doer has been underselling the patentee in the market, this will probably be less than he might have recovered in damages. In any case, an account of profits is a doubtful remedy, because of the difficulty of working it out.

"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," said Lindley, L.J., in *Siddell* v. *Vickers*. "One sees it, and I, personally, have seen a good deal of it, in partnership cases, where the capital of a deceased or outgoing partner has been left in the trade; an account has been directed of the profits made in respect of his 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 that form very rarely result in anything satisfactory to anybody. The litigation is enormous, the expense is 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 enquiry as to damages rather than launch upon an enquiry as to profits." (*y*)

In the *Automatic Retort Company* v. *Mayor, &c., of Salford*, Romer, J., stated that an account of profits would mean great expense, delay, and difficulty in Chambers, and the parties agreed instead to an account of what, in lieu of damages, would be a

(*y*) 9 R. P. C. pp. 162, 163.

proper sum to pay by way of royalties for the use of the infringing apparatus. (*z*)

Sum to be arrived at on taking an Account.—The sum to be ascertained in taking an account of profits is the sum which represents the money value of the advantage which the infringer has derived from the use of the patent over and above what he would have got from the use of means or processes open to the public. (*a*) It is therefore material, on the taking of the account, to enquire what profits the defendants were making before they used the patentee's invention, as these, contrasted with the profits made subsequently, afford a clue to the proportion of their profits attributable to the infringement. It is not conclusive, as other factors, such as economy in production, and so forth, may enter in; but it is a most important factor in the problem, and will throw upon the defendants the onus of shewing whether such other factors exist, and to what extent they vitiate the inference which would otherwise be drawn. (*b*)

In *Siddell* v. *Vickers*, where the defendants contested the right of the plaintiff to enquire into their transactions prior to the infringements complained of, Kekewich, J., ordered them to file a further and better affidavit, disclosing the cost to them of manufacture, before and after they used the plaintiff's invention, adding, "I do not mean from time immemorial, but from such time as will enable a comparison to be made." (*c*)

The patentee is entitled to discovery in aid of the account, and the defendant will be compelled to produce his books and disclose his business transactions, so far as they relate to the infringements in question: (*d*) and this, too, even when the decision is under appeal, unless the account has been stayed. (*e*)

Where no profits have been made by the infringer an account will be refused. (*f*) Where the admitted profits were very small the plaintiff was given an account, but warned that if he did not prove more profit than the defendants admitted, he should have to bear the costs of the enquiry. (*g*)

The order for an account will generally contain a direction that the defendant pay to the patentee within a specified time the sums

(*z*) 14 R. P. C. 471, 472.

(*a*) See Lord Kinnear, in *United Horseshoe and Nail Co.* v. *Stewart*, 3 R. P. C. 143.

(*b*) *Siddell* v. *Vickers*, 6 R. P. C. 467.

(*c*) Ibid.

(*d*) *Saxby* v. *Easterbrook*, L. R. 7 Ex. 209.

(*e*) Ibid.

(*f*) *Bergmann* v. *Macmillan*, 17 C. D. 427.

(*g*) *Jenkins* v. *Hope*, 13 R. P. C. 60 (per North, J.). See, also, *United Telephone Co.* v. *Patterson*, 6 R. P. C. 142.

found to have been made by the defendant through his unlawful use of the invention. (*h*)

As in the case of an enquiry into damages, the taking of an account will in the Chancery Division be referred to the master or to a referee, whose certificate or report is subject to review by the Court.

Where the judge has directed an account to be taken before the master, and that officer has held his enquiry, the judge ought not, if he finds it necessary to discharge the certificate, to remit the account to be taken afresh before an official referee. In such case the proper course is to send the account back to the master with directions; and this is so even where it becomes clear that the account ought in the first instance to have been sent to an official referee. (*i*)

As in the case of an injunction, a plaintiff may forfeit his right to an account by laches. (*j*)

Costs.

General Costs of the Action.—The general rule is, that the costs are given to the successful party. The judge, however, has a discretion, subject to this, that if the case is tried with a jury the costs must, except where good cause exists for a contrary order, follow the event. (*k*)

Generally speaking, the successful litigant is entitled to costs. "As I understand the law as to costs," said Jessel, M.R., (*l*) "it is this, that where a plaintiff comes to enforce a legal right, and there has been no misconduct on his part—no 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. There may be misconduct of many sorts: for instance, there may be misconduct in commencing the proceedings, or some miscarriage in the procedure, or an 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. It is, for instance, no answer, where a plaintiff asserts a legal

(*h*) *Holland* v. *Fox*, 3 E. & B. p. 986; *Plimpton* v. *Malcolmson*, *Seton on Decrees*, vol. i. 567; *Wenham* v. *Carpenter*, 5 R. P. C. 70.

(*i*) *Siddell* v. *Vickers*, 11 R. P. C. 163.

(*j*) *Crossley* v. *Derby*, 1 Myl. & Cr. 428.

(*k*) R. S. C. Order 65, rule 1.

(*l*) *Cooper* v. *Whittingham*, 15 C. D. 502; 49 L. J. Ch. 754 (copyright case).

right, for a defendant to allege his ignorance of such right and to say, 'If I had known of your right I should not have infringed it.'"

Counsel and Expert Witnesses.—The costs of more than two counsel will not usually be allowed; but in exceptional circumstances three have sometimes been allowed on taxation. (*m*) Luxuries must be paid for by the party indulging in them. Thus, the costs of drawings on the borders of counsel's brief, to assist him in understanding his case, will not be allowed, nor the cost of the attendance at the trial of a solicitor's clerk as well as the solicitor. (*n*) Special costs, to a moderate extent, are allowed for scientific witnesses, (*o*) and sometimes a fee for the time devoted by them out of court to preparing for the evidence they are to give. (*p*) But no sums approaching the fees actually paid by litigants to experts of eminence are ever allowed on taxation. For the costs chargeable under a taxation between party and party are merely such costs as are necessary to enable the adverse party to conduct the litigation, and no more. (*q*)

Shorthand Notes.—The costs of shorthand notes of the evidence are not generally allowed, though it is usual in the case of an appeal to allow the costs of a shorthand note of the judgment. (*r*)

It is therefore desirable where shorthand notes are taken that the respective parties should arrange before the trial how the expense of these shall be met. The proper arrangement would seem to be to agree to make such costs, costs in the action. (*s*)

In *Ungar* v. *Sugg*, (*t*) where shorthand notes had been taken of the proceedings before the chief clerk in the enquiry as to damages, the Court of Appeal expressed the strongest opinion that this was a horrible waste of money.

(*m*) *Betts* v. *Clifford*, 1 J. & H. 74; *Cousens* v. *Cousens*, L. R. 7 Ch. 48; *Betts* v. *Cleaver*, L. R. 7 Ch. 516; *Smith* v. *Buller*, L. R. 19 Eq. 473; 45 L. J. Ch. 880; *Automatic Weighing Machine Co.* v. *Hygienic Society*, 6 R. P. C. 475; *Leonhardt & Co.* v. *Kallé & Co.*, 12 R. P. C. 306; *Palmer Tyre, Limited*, v. *Pneumatic Tyre Co.*, 16 R. P. C. 496.

(*n*) *Smith* v. *Buller*, supra.

(*o*) *Batley* v. *Kynoch*, L. R. 20 Eq. 632; 33 L. T. (N. S.) 45.

(*p*) *Smith* v. *Buller*, supra. Fifteen guineas for two days' work were allowed in this case.

(*q*) Ibid.

(*r*) *American Braided Wire Co.* v. *Thomson*, 7 R. P. C. 163. Where, however, the judge and both parties had used the notes day by day in the trial below, the Court of Appeal allowed the costs; see *Castner Kellner Alkali Co.* v. *Commercial Corporation, Limited*, 16 R. P. C. 251; [1899] 1 Ch. 803. The shorthand notes were also allowed by Wills, J., in *Palmer Tyre, Limited*, v. *Pneumatic Tyre Co.*, 16 R. P. C. 496.

(*s*) *Moseley* v. *Victoria Rubber Co.*, 57 L. T. 148; 4 R. P. C. 255. As to right of solicitor to recover costs of shorthand notes from his client, see *Osmond* v. *Mutual Cycle Co.* 48 W. R. 125; [1899] 2 Q. B. 488.

(*t*) 9 R. P. C. 113.

Costs of necessary models will be allowed to a moderate extent. (*u*)

Costs on Certificate of Validity.—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. (*v*)

To get the benefit of such a certificate in a subsequent action, the plaintiff must plead it. (*w*)

Sometimes a defendant, who by his defence has contested the validity of the patent, does not appear at the trial, when judgment is obtained in his absence; or appears, and allows judgment to go by consent. Whether a certificate of validity ought in such cases to be given by the judge seems doubtful, conflicting decisions as to this being found in the reports.

In *Stocker* v. *Rodgers*, (*x*) a case tried before Erskine, J., at the Gloucester Assizes in 1843, where a verdict by consent was taken for the plaintiff for 40*s*., that learned judge refused to certify that the validity of the patent had come in issue, saying, "My certificate would affect third parties; and it would be possible in a case like the present for two parties by collusion to consent to a verdict in favour of a patent, and if they could obtain a certificate under the third section of the Statute, to use it afterwards to the injury of another party who was really contesting the validity of the patent." (*y*)

Inasmuch as the judge has a discretion to give or refuse the certificate, it would seem that the above is the sound principle for him to act upon, and in *Peroni* v. *Hudson*, (*z*) where the defendant did not appear, Kay, J., refused to certify. But in recent cases certificates have been given, both where defendants did not appear (*a*) and where actions were compromised at the trial.

In *Tweedale* v. *Ashworth*, where the question of the validity of the patent though put in issue was not seriously contested, as the plaintiff failed to prove infringement, a certificate was given. (*b*)

(*u*) *Bailey* v. *Kynoch*, L. R. 20 Eq. 632.

(*v*) Patents Act, 1883, s. 31.

(*w*) *Pneumatic Tyre Co.* v. *Chisholm*, 13 R. P. C. 488.

(*x*) 1 C. & K. 99.

(*y*) This was under 5 & 6 Wm. IV. c. 83, s. 3.

(*z*) 1 R. P. C. 261.

(*a*) *Haydock* v. *Bradbury*, 4 R. P. C. 74; *Edison* v. *Edison*, 11 R. P. C. 33; *Delta Metal Co.* v. *Maxim*, 8 R. P. C. 248.

(*b*) 7 R. P. C. 436. See, also, *Auto-*

In *Birch* v. *Harrap*, (*c*) where the Court of Appeal (reversing the judge below) held the patent good subject-matter, but found no infringement, they granted the plaintiff a certificate of validity.

In *Haslam* v. *Hall*, (*d*) Stephen, J., granted a certificate to the plaintiff, although the patent was found invalid. It is difficult to see how such a certificate could be of the slightest use, for even if the patentee cured the patent by amendment, no judge would be likely to allow an action in which the patentee had been proved to have no good patent to entitle him to costs as between solicitor and client in a subsequent action.

A certificate of validity can only be granted to a patentee, and therefore cannot be obtained by a defendant who defeats a patent. (*e*)

Whether a certificate that the validity of a patent has been in issue can be given in an action against a patentee for threats is doubtful (*f*)

In *Badische* v. *La Société Chimique*, (*g*) where one claim in the patent was held bad, Wills, J., granted a certificate as to the rest.

The application for a certificate that the validity of the patent has been in issue should be made to the judge who tried the case, and in court at the close of the trial, but it may be made in chambers. (*h*) Where the Court of Appeal reverses the decision of the judge below the Court of Appeal may grant a certificate. (*i*)

It was at one time held that the Vice-Chancellor of Lancaster had no jurisdiction to give such a certificate, (*j*) but this is no longer the case. (*k*)

A certificate is not a "judgment" or "order" within Section 19 of the Judicature Act, 1873, and no appeal lies in respect of the granting or refusal of it. (*l*)

Where a certificate that the validity of a patent has been in

matic Machine Co. v. *Knight*, 6 R. P. C. 120. In *Morris* v. *Young* (12 R. P. C. 464, 465), the House of Lords seem to have doubted the propriety of doiug this. Cf. *Garrard* v. *Edge*, 6 R. P. C. 375, where, infringement being proved, the judge declined to go into the issue of validity merely to enable a certificate to be given, and refused the certificate.

(*c*) 13 R. P. C. 615.

(*d*) 5 R. P. C. 27.

(*e*) *Badische* v. *Levinstein*, 29 C. D. 419.

(*f*) *Crampton* v. *Patents Investment Co.*, 5 R. P. C. 404. In *Kurtz* v. *Spence* (5 R. P. C. 184), Kekewich, J., held it could not.

(*g*) 14 R. P. C. 892. See, also, *Haslam* v. *Hall*, 5 R. P. C. 1.

(*h*) Judicature Act, 1873, s. 39.

(*i*) *Cole* v. *Saqui*, 6 R. P. C. 45 (a certificate as to particulars); R. S. C. Order 58, rule 4.

(*j*) *Proctor* v. *Sutton*, 5 R. P. C. 185.

(*k*) 53 & 54 Vict. c. 23.

(*l*) *Haslam* v. *Hall*, 20 Q. B. D. 491; 5 R. P. C. 144.

issue has once been granted, the Court will not grant another certificate in respect of the same patent in a second action. (*m*)

Where a certificate has been given, the circumstance that the second defendant does not dispute the validity of the patent has been held to be no reason for refusing to give the plaintiff the benefit of his certificate and costs as between solicitor and client in the second action. (*n*)

The second action must have been begun subsequent to the giving of the certificate, otherwise the section does not apply. (*o*)

The judge, however, may certify in the second action that the plaintiff ought not to have solicitor and client costs.

In *Otto* v. *Steel*, where the patent was impeached in the second action on grounds different from those taken in the first, Pearson, J., refused the plaintiff solicitor and client costs, although he held a certificate of validity. (*p*)

In the *Automatic Weighing Machines Company* v. the *National Exhibitions Association*, (*q*) Vaughan-Williams, J., considered that the lax manner in which the plaintiffs' specification was drawn had given rise to the litigation, and on that ground refused solicitor and client costs, despite the plaintiffs' success in a previous action.

The circumstance that the defendant in the subsequent action has acted innocently, and with no knowledge of the patent right, is also a good ground for certifying that he shall not pay solicitor and client costs. (*r*)

Where the Court thinks that the action is vexatious, and that the plaintiff, though technically in the right, ought not to have persisted in his action, the plaintiff may properly be deprived of the costs to which the certificate would otherwise entitle him. (*s*)

But here, as in all other cases where a discretion is given, no hard and fast rule can be laid down to fetter its exercise. Usually in the absence of special circumstances the Court will not certify against solicitor and client costs being given to the holder of a

(*m*) *Edison* v. *Holland*, 6 R. P. C. p. 287; but see *Otto* v. *Steel*, 3 R. P. C. p. 120.

(*n*) *United Telephone* v. *Townshend*, 3 R. P. C. 10; *United Telephone* v. *St. George*, 3 R. P. C. 339; *United Telephone* v. *Patterson*, 6 R. P. C. 140 (in this case the defendant had paid £75 into court) but see Charles, J., in *Automatic Weighing Machine Co.* v. *Hygienic Society*, 6 R. P. C. 480, and *Boyd* v. *Tootal*, 11 R. P. C. 175.

(*o*) *Automatic Weighing Machine Co.* v. *Hygienic Society*, 6 R. P. C. p. 480; L. R. 3 Eq. 308; *Automatic Weighing Machine* v. *Comb'ned Weighing Machine*, 6 R. P. C. 126.

(*p*) *Otto* v. *Steel*, 3 R. P. C. 120.

(*q*) 8 R. P. C. 352.

(*r*) *Boyd* v. *Tootal*, 11 R. P. C. 185.

(*s*) *Proctor* v. *Sutton*, 5 R. P. C. 184.

certificate of validity; (*t*) for, in the absence of good reason to the contrary, he is entitled to such costs. (*u*)

Costs of Particulars.—The costs of particulars of breaches and particulars of objection are specially provided for, apart from the general costs of the infringement action, by the Patents Act, 1883. (*v*) Section 29 sub-sect. 6 enacts that on taxation of costs, regard shall be had to the particulars delivered by the plaintiff and by the defendant; and they respectively shall not be allowed any costs in respect of any 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. A certificate may be obtained either in respect of particulars of objection or particulars of breaches. (*w*)

The application should be made at the trial, to the judge who tried the case. It may, however, be made within a reasonable time after; (*x*) but if so made the costs of the application will not be allowed. Although the Court is not restricted to giving the certificate at the trial only, it must, before deciding, have materials upon which to do so. Therefore, where a plaintiff discontinued his action after the defence had been delivered, Romer, J., declined to certify that the defendant's particulars of objection were reasonable and proper, as, without a trial, he had no means of judging of them. (*y*)

"I cannot certify," said the learned judge, "unless I have the materials before me which enable me to make a certificate; that is to say, unless I know sufficient of the case, and what is to be said on one side or the other, to enable me to certify that these particulars of objection are reasonable. Now, as a fact, I have no materials before me, and I cannot have, unless I were to enter into a sort of half-trial of the action, and that I cannot do."

At the same time, it is not always necessary that there should have been a trial of the action to enable particulars to be certified. They may be certified without being proved, if the judge is satisfied

(*t*) *Fabriques de Produits Chimiques* v. *Lafitte*, 16 R. P. C. p. 68.

(*u*) *Welsbach Incandescent Gas Co.* v. *Daylight Mantle Co.*, 16 R. P. C. 354.

(*v*) As to the former practice, see 15 & 16 Vict. c. 83, s. 43; *Honiball* v. *Blumer*, 10 Ex. 538; 24 L. J. Ex. 11; *Batley* v. *Kynoch*, L. R. 20 Eq. 635.

(*w*) *Kane* v. *Guest*, 16 R. P. C. 443; *Haslam* v. *Hall*, 5 R. P. C. 23.

(*x*) *Rowcliffe* v. *Morris*, 3 R. P. C. 145. In this case judgment was given on Nov. 12, and a certificate granted on March 29 following. *Duckett* v. *Sankey*, 16 R. P. C. 357.

(*y*) *Wilcox & Gibbs* v. *James*, 14 R. P. C. 523; [1897] 2 Ch. 71; 66 L. J. Ch. 525; 45 W. R. 474; see, also, *Rothwell* v. *King*, 4 R. P. C. 399.

that they are reasonable and proper. (*z*) Some interlocutory proceeding may have been taken in the action, and evidence adduced, from which the Court can form an opinion as to the propriety or reasonableness of the particulars. (*a*)

Where the Court has felt that it had not sufficient materials in which to judge of the particulars, it has sometimes, as a term of giving leave to discontinue the action, required the plaintiff to pay to the defendant the costs of his particulars of objections, as if they had been certified to be reasonable and proper. (*b*)

Where the decision of the judge below is reversed on appeal, a difficulty may arise as to certifying the particulars.

In *Morgan* v. *Windover*, the Court of Appeal affirmed the decision of Kekewich, J., in the plaintiff's favour, but was reversed by the House of Lords. The Lords having only determined the question that the patent was invalid for want of subject-matter, the defendants applied to the judge below for a certificate that they had proved their particulars of objection. Commenting upon the difficulty in which he was placed in having to decide the point three years after the hearing, Kekewich, J., said he could not re-hear the case for this purpose, but must do the best he could in the circumstances. (*c*)

In the later case of *Morris* v. *Young*, the House of Lords themselves granted the certificate (*d*) as to certain particulars of objection considered before them.

Where the Court of Appeal reverses the decision of the judge below, it can certify as to the particulars in the action, just as the judge who tried the case could have done. (*e*)

But, if it dismisses the appeal, it would seem that the Court of Appeal cannot vary the certificate given by the judge below as to particulars; for, the certificate being neither a judgment nor an order, apparently no appeal will lie as to it alone. (*f*) This point has not, however, been expressly decided in regard to particulars. (*g*)

In every case the question must arise as to whether the Court to which the application is made has sufficient materials upon

(*z*) *Phillips* v. *Ivel Cycle Co.*, 7 R. P. C. 77.

(*a*) See the case last cited; and Stirling, J., in *Middleton* v. *Bradley*, 12 R. P. C. 390.

(*b*) *Boake* v. *Stevenson*, 12 R. P. C. 228; *Bethel* v. *Gage*, 14 R. P. C. 700.

(*c*) 7 R. P. C. 446; see also the observations of the Court of Appeal in *Cole* v. *Saqui*, 40 C. D. p. 134; and of Stirling, J., in *Germ Milling Co.* v. *Robinson*, 3 R. P. C. 260.

(*d*) 12 R. P. C. p. 465.

(*e*) *Cole* v. *Saqui*, 6 R. P. C. 41; 40 C. D. 132; R. S. C. Order 58, rule 4.

(*f*) Cf. *Haslam* v. *Hall*, 5 R. P. C. 144; 20 Q. B. D. 491 (certificate of validity).

(*g*) See Lindley, L.J., in *Cassel Co.* v. *Cyanide Co.*, 12 R. P. C. p. 305.

which to certify. Where the Court of Appeal has decided a case on one issue, it has refused to go into other evidence outside that issue, merely in order to inform itself as to whether a certificate for particulars ought to be given. (*h*)

"You are inviting us," said Lindley, L.J., in *Longbottom* v. *Shaw*, (*i*) "to hear a great number of objections in order to give you costs. If we had heard them, we should know all about the costs, but I do not feel disposed to investigate those points for the purpose of giving costs."

In the same way, the judge at the trial has frequently refused a certificate in regard to particulars not gone into before him, through the action being disposed of on some other issue. (*j*)

In *Mandelberg* v. *Morley*, (*k*) the plaintiffs submitted, when the case was called on, to have their action dismissed with costs. Stirling, J., refused to give the defendants a certificate for their particulars of objection.

In *Badham* v. *Bird*, (*l*) the defendants were allowed a certificate for such particulars as had been used by them on cross-examination.

Where the Court has been satisfied, however, that it was just and reasonable, under the circumstances of the litigation, that the particulars should have been given, it has allowed such particulars, notwithstanding their not having been gone into at the trial.

Where a certificate is not given as to particulars, the parties, in the absence of any special direction to the contrary, bear their own costs; for, being outside the general costs of the action, the taxing master has no power to enquire into the particulars. Where, therefore, one party thinks that he has been put to costs by improper and vexatious particulars delivered by the other, he ought to apply to the Court to direct the taxing master to see whether any proceedings have been taken improperly by the other side, and to direct that he shall get the costs occasioned by such improper proceedings. (*m*)

It is not necessary that the party applying for a certificate should be entitled to the general costs of the action. A certificate may be, and often is, given to the losing party where the

(*h*) *Longbottom* v. *Shaw*, 6 R. P. C. 143; *Boyd* v. *Horrorks*, 6 R. P. C. 162.
(*i*) Page 147.
(*j*) *Newsum* v. *Mann*, 7 R. P. C. 307.
(*k*) 12 R. P. C. 35; 64 L. J. Ch. 245.
(*l*) 5 R. P. C. 238.
(*m*) *Garrard* v. *Edge*, 7 R. P. C. 139.

successful litigant has contested matters in respect of which he has proved to be in the wrong. (*n*)

In granting certificates under Section 29 of the Patents Act, 1883, the Court aims at securing to the party delivering the particulars the costs of everything reasonably and properly inserted in them, although such party may fail to prove the specific objection under which the detailed particulars may be ranged. (*o*)

Costs of Separate Issues.—Where, as will usually be the case in patent actions, separate issues in law or fact are involved, the costs, unless otherwise ordered, follow the event on each particular issue. (*p*)

In *Badische Anilin* v. *Levinstein*, (*q*) the infringement, though denied by the defendants, was proved at the trial, but the patent was found invalid on appeal. The Court of Appeal, whilst giving the defendants the general costs of the action, upheld the certificate of Pearson, J., that the plaintiffs had proved their particulars of breaches.

"It seems to me," said Bowen, L.J., "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 reasonable as regards their own interests, 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." (*r*)

Costs on Higher Scale.—Under Order LXV., rule 9 of the Rules of the Supreme Court, costs on the higher scale may be allowed either generally or as to any particular application made or business done in any cause or matter, if on special grounds arising out of the nature and importance or difficulty or urgency of the

(*n*) L. R. 29 C. D. 419; 2 R. P. C. 118. See, also, as to apportioning costs, *Wegmann* v. *Corcoran*, 27 W. R. 357; cf. *Nordenfelt* v. *Gardner*, 1 R. P. C. 75; *Pooley* v. *Pointon*, 2 R. P. C. 173; *Kane* v. *Guest & Co.*, 16 R. P. C. 443.

(*o*) This was stated to be the correct working rule by Lindley, M.R., after consultation with the other members of the Court of Appeal and with the Taxing Masters; see *Castner-Kellner Alkali Co.* v. *Commercial Corporation, Limited*, 16 R. P. C. p. 276; [1899] 1 Ch. 803; 68 L. J. Ch. 402; 80 L. T. 476; 47 W. R. 534.

(*p*) R. S. C. Order 65, rule 2.

(*q*) L. R. 29 C. D. 366; 2 R. P. C. 118.

(*r*) 29 C. D. p. 419.

case, the Court or a judge shall so order or direct the taxing master.

No appeal usually lies on a mere question of costs; but where costs depend on conditions an appeal lies as to whether such conditions exist. Hence, an appeal lies under this order as to whether special grounds exist enabling the judge to order costs on the higher scale. Where, however, the Court of Appeal finds that such grounds exist they will not interfere with the exercise of the judge's discretion. (*s*)

Special reason, then, must be shewn before costs on the higher scale can be given. (*t*)

The circumstance that an action involves a quantity of scientific evidence, or necessitates special knowledge on the part of those concerned in it, is such special reason. (*v*) But where the enquiry is one of fact only, and not scientific, costs should not be given on the higher scale. (*w*)

It may happen, however, that although the case could have been tried without scientific witnesses, the conduct of one side in bringing such witnesses has compelled their opponents to do likewise; in such case the opponents if successful may properly be awarded costs on the higher scale. (*x*)

On the other hand, where the necessity for the scientific evidence arose from the unfortunate wording of the specification, Vaughan-Williams, J., refused to give the plaintiff costs on the higher scale. (*y*)

In *Fraser* v. *Brescia Steam Tramways Company*, (*z*) Kekewich, J., said that the difficulty of a case meant difficulty from a professional point of view, that is, whether the case was one requiring greater industry, greater learning, and more time and expense than the majority of cases. Thus, a case involving a long examination, preparation of models, and expert evidence, is a proper case for costs on the higher scale. (*a*)

Similarly, in *Farbenfabriken* v. *Bowker*, Romer, J., gave costs on the higher scale, on the ground that the case was one of great

(*s*) *Paine* v. *Chisholm*, [1891] 1 Q. B. 531.

(*t*) *Grafton* v. *Watson*, 51 L. T. (N. S.), 145 (per Lindley, L.J.).

(*v*) *Moseley* v. *Victoria Rubber Co.*, 4 R. P. C. p. 255; 57 L. T. (N. S.), 148; *Edison* v. *Holland*, 5 R. P. C. 483; *Hopkinson* v. *St. James Lighting Co.*, 10 R. P. C. 62; Muirhead v. Commercial Cable Co., 12 R. P. C. 64.

(*w*) *American Braided Wire Co.* v. *Thomson*, 44 C. D. 296; 7 R. P. C. 163.

(*x*) *Ellington* v. *Clark*, 5 R. P. C. 328; 58 L. T. (N. S.), 022.

(*y*) *Wenham* v *Champion*, 8 R. P. C. 320.

(*z*) 56 L. T. (N. S.), p. 772.

(*a*) *Wenham* v. *May*, 4 R. P. C. 310.

difficulty, involving much trouble to the solicitors and other persons engaged in it. (*b*)

The simplicity of a case when it comes into court may be due to the expenditure of unusual time and trouble out of court in overcoming difficulties and clearing the issues. In such case costs on the higher scale may properly be given. (*c*)

Where successful appellants did not at the hearing of the appeal ask for costs on the higher scale, but moved for such costs subsequently, the Court of Appeal, although allowing higher costs, gave no costs of the motion, as the application should have been made when the appeal was heard. (*d*)

Stay of Execution pending Appeal.

Stay of Injunction.—Sometimes the defendant applies for a stay of execution pending appeal. An appeal does not in itself operate as a stay, (*e*) and the general rule is that in the case of an injunction a stay will not be granted. (*f*) But each case depends largely upon its own special circumstances. If a stay is granted as to the injunction, the defendant will generally be put on terms to keep an account. (*g*) Sometimes the injunction is suspended by consent, the defendants undertaking to keep an account.

If the defendant is engaged in executing orders for the article complained of, and the question of infringement is one of difficulty and doubt, the Court is more disposed to stay the injunction pending appeal. (*h*)

In *Proctor* v. *Bennis*, Cotton, L.J., said: "This is an application to stay the execution of a judgment pending an appeal to the House of Lords. I say stay the execution, because restraining the plaintiffs from putting in force the injunction, or saying that it is not to be put in force pending that appeal to the House of Lords, is staying execution. In my opinion, on the facts before us, there is no case for that at all. If it appeared that the defendant *Bennis* was now making machines which we have decided to be an infringement of the plaintiff's patent, then, in order not to stop his

(*b*) 8 R. P. C. 397.

(*c*) *Fraser* v. *Brescia Steam Tramways Co.*, 56 L. T. (N. S.) 771. See, also, *Davies* v. *Davies*, 56 L. J. Ch. 486.

(*d*) *Automatic Weighing Machine Co.* v. *Combined Weighing Machine Co.*, 6 R. P. C. 372.

(*e*) R. S. C. Order 58, rule 16.

(*f*) *Otto* v. *Steele*, 3 R. P. C. 121.

(*g*) *Hocking* v. *Fraser*, 3 R. P. C. 7; *Kaye* v. *Chubb*, 4 R. P. C. 27; *Lyon* v. *Goddard*, 10 R. P. C. 136; *North British Rubber Co.* v. *Mackintosh*, 11 R. P. C. 489; *Ducketts* v. *Whitehead*, 12 R. P. C. 191; *National Opalite Syndicate* v. *Ceralite Syndicate*, 18 R. P. C. 658.

(*h*) *Ducketts* v. *Whitehead*, 12 R. P. C. 191; *Boyd* v. *Horrocks*, 5 R. P. C. 580.

manufacture of those machines while the question is still before the House of Lords, I think it might be right, subject to terms, to stop the injunction being enforced; but it appears to me that the object is to prevent the effect of our judgment deterring those who would otherwise buy machines, he saying he is not now making any of the machines. In my opinion, therefore, there is no reason for granting this stay." (*i*)

But where defendants, after warning that they were infringing a patent, accepted orders, and proceeded to execute them deliberately, with their eyes open, the Court refused a stay (the plaintiffs standing on their strict rights), although the orders under execution were for public authorities, and it would have been a convenience to the public to grant it. (*j*)

In *Nordenfelt* v. *Gardner*, (*k*) the injunction was stayed so far as related to the defendants supplying arms to the Government.

In *Hopkinson* v. *St. James's Company*, (*l*) the injunction, in consequence of the inconvenience the public would suffer if it were immediately enforced, was suspended for six months, an account of profits being kept meanwhile.

Enquiry as to Damages.—Sometimes the Court, while refusing to stay the injunction, will grant a stay as to the enquiry into damages or the account, (*m*) on condition that notice of appeal is given within a fortnight, or some other specified time. (*n*)

In the *Automatic Retort Company* v. *Mayor, etc., of Salford*, the enquiry as to damages was allowed to proceed, but the judge directed the amount found to be paid into Court if the appeal was still pending. (*o*)

Costs.—A stay is not generally granted as to costs, the usual practice being for the defeated party to pay over the costs awarded against him if taxation is completed before the appeal is heard—the solicitor of the other party undertaking to return them if the appeal is allowed. (*p*)

Stay by the Court of Appeal.—An application for a stay pending

(*i*) 4 R. P. C. 363.

(*j*) *Lyon* v. *Goddard*, 10 R. P. C. 348.

(*k*) 1 R. P. C. 63.

(*l*) 10 R. P. C. 62.

(*m*) *Humpherson* v. *Syer*, 4 R. P. C. 189; *Siddell* v. *Vickers*, 5 R. P. C. 101; *Brooks* v. *Lamplugh*, 14 R. P. C. 620.

(*n*) *Hocking* v. *Fraser*, 8 R. P. C. 7; *Pneumatic Tyre Co.* v. *Leicester Tyre Co.*, 15 R. P. C. p. 168; *Presto Gear Case Co.* v. *Simplex Co.*, 15 R. P. C. 644; *Pneumatic Tyre Co.* v. *Leicester Co.*, 16 R. P. C. 50.

(*o*) 14 R. P. C. 472.

(*p*) *Ticket Punch Co.* v. *Colley*, 12 R. P. C. p. 10; *Deeley's Patent*, 12 R. P. C. 75; *Muirhead* v. *Commercial Cable Co.*, 12 R. P. C. 64; *Chadburn* v. *Mechan*, 12 R. P. C. 135; *Automatic Retort Co.* v. *Salford*, 14 R. P. C. 472; *Castner-Kellner Co.* v. *The Commercial Corporation, Limited*, 15 R. P. C. 662; *Dick* v. *Ellam*, 16 R. P. C. 424.

an appeal to the Court of Appeal will not be entertained by that Court, unless it has first been made to the Court below. (*q*)

The Court of Appeal will not grant a stay of execution pending an appeal to the House of Lords, unless the circumstances of the case are exceptional. (*r*)

In the *North British Rubber Company* v. *Gormully*, (*s*) a stay was granted for three weeks, £500 being paid into Court by the appellants; but the Court intimated that whatever the result of an application to the House of Lords might be the Court of Appeal would not itself extend the stay lightly.

Where a stay is desired pending an appeal to the House of Lords, the intending appellant should not apply at the conclusion of the hearing, but move for a stay on some subsequent day. (*t*)

Appeal.

When an Appeal Lies.—An appeal lies to the Court of Appeal under Section 19 of the Judicature Act, 1873, from any judgment or order—and by the interpretation clause, "judgment" includes "decree," and "order" includes "rule;" but no appeal lies in respect of a certificate. "At the time the Act of 1873 was passed," said Fry, L.J., in *Haslam* v. *Hall*, "there was another well-known method of expressing judicial determinations, namely, by certificate. For instance, certificates under the Patent Act had been enforced by the various Statutes for many years—certainly since the Statutes of William IV.; there were certificates as to special juries, there were certificates if an action was brought to try a right under 3 & 4 Vict., and there were certificates on summonses—properly attended by counsel. In all these, and I dare say many other instances, certificates were known, and if the legislature had been minded to give a right of appeal in respect of those certificates it clearly would have been expressed in the Statute. The Statute is silent as to them, and, in my judgment, there is no right of appeal." (*u*)

So likewise there is no right of appeal as to a question of costs

(*q*) R. S. C. 58, rule 17; *Young* v. *Kershaw*, *Times*, Aug. 9, 1899.

(*r*) *Castner-Kellner Alkali Co.* v. *Commercial Corporation, Limited*, 16 R. P. C. 251; *Lyon* v. *Goddard*, 10 R. P. C. 350 (per Esher, M.R.); *Proctor* v. *Bennis*, 4 R. P. C. 363; *Edge* v. *Johnson*, 9 R. P. C. 142; *Johnson* v. *Edge*, 9 R. P. C. 150; *North British Rubber Co.* v. *Gormully*, 14 R. P. C. 302, 303; *Lancashire Explosives* v. *Roburite Co.*, 12 R. P. C. 483. See, also, *Penn* v. *Bibby*, L. R. 3 Eq. 308.

(*s*) Supra; cf. *Lucas* v. *Miller*, 17 R. P. C. 165.

(*t*) *Proctor* v. *Bennis*, 4 R. P. C. 363; *Lyon* v. *Goddard*, 10 R. P. C. 348; *Lancashire Explosives Co.* v. *Roburite*, 12 R. P. C. 483.

(*u*) 5 R. P. C. 145.

merely. (*v*) But where costs depend on some special grounds, as, *e.g.* where costs on the higher scale are awarded, the Court of Appeal will review the judge's decision, so far as to determine whether or not such special grounds in fact exist, but not so as to question the discretion of the judge in acting upon them, if found. (*w*)

To give an unrestricted right of appeal the judgment or order must be final—if it is merely interlocutory no appeal lies without leave; (*x*) for which application must first be made to the Court below; if refused there, the application may be renewed in the Court of Appeal. (*y*) But the Court of Appeal will not grant leave if it has not first been sought from the judge below. (*z*)

Although, as above stated, the general rule is that no appeal lies from an interlocutory order without leave, yet, if the application is for an injunction or a receiver, leave is not necessary. (*a*)

Practice on Appeals.—All appeals to the Court of Appeal are by way of re-hearing. But this does not mean that the Court will re-hear the case, and judge of the witnesses and evidence as a Court of first instance would do. (*b*) Appeals are brought by notice of motion in a summary way. (*c*)

Notice of appeal, in the case of a final order, must be given before the expiration of three months from the decision appealed from; (*d*) if the order is interlocutory, before the expiration of fourteen days. (*e*) But the Court of Appeal may by special leave extend the time. The time for appealing is calculated in the case of an order in chambers from the time when it was pronounced, or when the appellant first had notice of it; in other cases, from the time when the judgment or order is signed, entered, or otherwise perfected; in the case of applications, from the date of refusal. (*f*)

The notice is in the case of any judgment, or of a final order, a fourteen days' notice. In the case of appeal from an interlocutory order it is a four days' notice. (*g*)

(*v*) Judicature Act, 1873, s. 49.

(*w*) *Paine* v. *Chisholm*, [1891] 1 Q. B. 531.

(*x*) Judicature Act, 1894, s. 1 (b).

(*y*) Ibid.

(*z*) R. S. C. Order 58, rule 17; *Young* v. *Kershaw*, *Times*, Aug. 9, 1899.

(*a*) Judicature Act, 1894, s. 1 (b, ii.).

(*b*) *Haggenmacher* v. *Watson*, 14 R. P. C. p. 634.

(*c*) R. S. C. Order 58, rule 1.

(*d*) R. S. C. Order 58, rule 15.

(*e*) Ibid.

(*f*) Ibid. Where part of the relief sought is granted and part refused the appellant is entitled to see the exact form of order before deciding whether he will appeal or not, unless the simplicity of the order renders this unnecessary; see *Shelfer* v. *City of London Co.*, [1895] 1 Ch. 287.

(*g*) R. S. C. Order 58, rule 3.

If a respondent gives notice of a cross appeal the periods of notice are respectively eight and two days. (*h*)

The appellant may appeal from all or part only of the judgment or order. If from part he must specify what the part is of which he complains. (*i*)

The grounds of appeal need not be specified in the notice, unless a new trial is asked for, in which case it will apparently be safer to set out the grounds. (*j*)

Evidence and Amendment.—If on appeal it is desired to refer to the oral evidence given below, the appellant should apply to one of the judges of the Court of Appeal through his clerk, to ask the judge who tried the case to send to the Court of Appeal a copy of his notes. If this has not been done the appeal will be ordered to stand over at the appellant's cost. (*k*)

The Court of Appeal will not look at a shorthand note of the evidence taken by a clerk of one of the solicitors in the action. A shorthand note to be referred to must have been taken by a professional shorthand writer. (*l*)

The Court of Appeal has all the powers of amendment that a judge of the High Court would have had, and has a full discretion to admit on the hearing of the appeal further evidence as to questions of fact. It may make any order that the judge below might have made, and any further order that the nature of the case may require. (*m*)

Its jurisdiction in the case of a patent action is just the same as in the case of any other appeal. (*n*)

The Court of Appeal will, however, only admit fresh evidence on appeal reluctantly; (*o*) and special grounds for doing so

(*h*) R. S. C. Order 58, rule 7. He need not do so, however, if he does not propose to contend that the order below should be varied.

(*i*) R. S. C. Order 58, rule 1.

(*j*) R. S. C. Order 39, rule 3. This rule was made when these appeals were heard by a Divisional Court; now they go direct to the Court of Appeal: Judicature Act, 1890, s. 1.

(*k*) *Ellington* v. *Clark*, 38 C. D. 332.

(*l*) As the Court of Appeal will not allow the costs of a shorthand note of more than the judgment, the parties should agree before trial as to how the costs of the note of the evidence shall be met. The best mode would seem to be an agreement that they shall be costs in the action: *Moseley* v. *Victoria Rubber Co.*, 4 R. P. C. 255.

(*m*) Order 58, rule 4; *Shoe Machinery Co.* v. *Cutlan*, [1896] 1 Ch. 111. It may grant a certificate as to particulars; see *Cole* v. *Saqui*, 6 R. P. C. 45; L. R. 40 C. D. 132.

(*n*) *Shoe Machinery Co.* v *Cutlan*, supra. Per Smith, L.J., pp. 111, 112. As to an appeal against an injunction by defendants who have become bankrupt, see *United Telephone Co.* v. *Bassano*, 31 C. D. 630.

(*o*) *Walker* v. *Hydro-Carbon Syndicate*, 3 R. P. C. 254.

must always be shewn. (*p*) Discussing what circumstances would amount to special grounds, Lindley, L.J., in *Hinde* v. *Osborne*, said: "I cannot understand that as meaning that the Court of Appeal ought to grant leave to adduce fresh evidence simply because a man has failed at the trial and he thinks he can get more evidence, which, if he had got it before, would have enabled him to succeed on the trial. That cannot be. There must be some ground shewn to satisfy the Court that there is some evidence now forthcoming which, with due diligence, he could not have got, and it must, moreover, in accordance with the usual practice, be evidence—not merely the swearing by affidavits or anything of that kind—but something in the nature of the production of a lost document, or something of that sort, which will not expose the parties to a mere flood of affidavits made up to meet the blots and the defects which have been disclosed upon the first trial." (*q*)

When the evidence proposed to be admitted on appeal had been used in the Court below for cross-examination purposes, leave was refused. (*r*) Where the defendant had deliberately elected below to raise only the question of infringement, the Court of Appeal refused to admit evidence to prove the invalidity of the patent. (*s*)

Allegations of counsel that witnesses below were acting in conspiracy, unsupported by anything appearing on the evidence, afford no ground for admitting further evidence on the appeal. (*t*)

In *Spencer* v. *Ancoats Company*, (*u*) on a motion for sequestration and committal, leave was given to file further evidence, the other side to have an opportunity of replying to it; and both sides to be entitled to cross-examine on the new affidavits before an examiner, if they so desired.

Security for Costs.—Where a respondent desires to get security for the costs of the appeal, he ought to apply to the appellant before moving for security. (*v*) An uncontradicted affidavit that the appellant has given a bill of sale on all his visible property is sufficient evidence to induce the Court to order security to be given. (*w*) In *Garrard* v. *Edge*, on this evidence £20 was ordered to be paid into court as security for the costs. But no costs of the motion were given. (*x*)

(*p*) R. S. C. Order 58, rule 4.
(*q*) 2 R. P. C. p. 47.
(*r*) *Walker* v. *Hydro-Carbon Syndicate*, 3 R. P. C. 253
(*s*) *Hinde* v. *Osborne*, 2 R. P. C. 47.
(*t*) *Haggenmacher* v. *Watron*, 14 R. P. C. p. 634 (per Lord Esher).
(*u*) 6 R. P. C. 54, 55.
(*v*) *Garrard* v. *Edge*, 7 R. P. C. 144.
(*w*) Ibid.
(*x*) Ibid.

An intending appellant may advertise for trade subscriptions in support of his appeal, and also for evidence to prove anticipation, and offer a reward therefor without committing a contempt of court. (*y*)

Appeal to the House of Lords.—From any order or judgment of the Court of Appeal an appeal lies to the House of Lords. (*z*) Such appeal must be brought within a year. (*a*)

In the *American Braided Wire Company* v. *Thomson*, the Court of Appeal declined to allow the appellants to pay the damages, pending an appeal to the House of Lords, into court instead of to the plaintiffs. Such an order will not be made unless the Court of Appeal is satisfied that the appellant will probably not be able to get the money repaid in the event of the appeal being successful." (*b*)

Where an application for this purpose is made, it ought to be by separate motion (*c*)

The Court of Appeal will not, unless the circumstances are exceptional, grant a stay of execution pending an appeal to the House of Lords. (*d*) The fact that the plaintiff's patent is about to expire is not by itself a ground for granting such stay of execution. (*e*)

(*y*) *Plating Co.* v. *Farquharson*, 17 C. D. 49.

(*z*) Appellate Jurisdiction Act, 1876, s. 1. See Forms of Notice and Petition of Appeal to the House of Lords, Appendix IV. post.

(*a*) Standing Orders, Nov., 1867, Order 1.

(*b*) 7 R. P. C. 163.

(*c*) Ibid.

(*d*) See cases cited ante, p. 558, note (*r*).

(*e*) *Taylor* v. *Annand*, 16 T. L. R. 84, p. 86. In *Lucas* v. *Miller*, 17 R. P. C. 165, a stay was granted.

CHAPTER XXIII.

REMEDIES OF THE PUBLIC.

1. *Action against the Patentee for Threats.*

Remedy under the Statute of Monopolies.—Inasmuch as grants to inventors are not guaranteed by the Crown, but always liable to be defeated if shewn to be contrary to law, it is manifest that threats issued by a patentee against persons whom he believes to be infringing his monopoly are issued at the peril of the patentee, and may be totally unjustifiable. Hence, a legal remedy is obviously required for the protection of the public, in cases where the person issuing such threats proves, when challenged, to have no valid patent right to support his pretensions.

Section 4 of the Statute of Monopolies (*a*) might have been supposed to provide such a remedy. For by that section it is enacted that any person hindered, grieved, disturbed, or disquieted by pretext of any monopoly or letters patent, may have his remedy by action at the common law upon that Statute for treble damages and double costs. No advantage, however, seems to have been taken of this remedy by the public, as the early reports do not contain any reference to a decision under this section, (*b*) and although it is still unrepealed, the legislature has recently provided another remedy by Section 32 of the Patents Act, 1883. Prior to that Act the Courts had held that an action for damages and an injunction would lie (independently of any express enactment) against a patentee who *mala fide* issued threatening circulars containing untrue statements. (*c*) In such action, however, it was

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

(*b*) A recent attempt to enforce the provisions of s. 4 of 21 Jac. I. c. 3 was not viewed with favour by the Court; Mathew, J., holding that no proceedings could be taken under this section against a person suing on a patent which was invalid, but capable of being cured by disclaimer. See *Peck* v. *Hindes*, 14 T. L. R. 164; 15 R. P. C. 113.

(*c*) *Wren* v. *Wield*, L. R. 4 Q. B. 730; 38 L. J. Q. B. 327; *Burnett* v. *Tak*, 45 L. T. (N. S.), 743; *Anderson* v. *Liebig's Co.*, 45 L. T. (N. S.), 757; *Sugg* v. *Bray*, Griff. P. C. 210; 1 R. P. C. 45; 2 R. P. C. 223.

held that the circumstance that a patentee did not follow up his threats by legal proceedings was not by itself evidence of *mala fides*. (*d*)

Action under the Patents Act, 1883.—The remedy provided by Section 32 of the Patents Act, 1883, is not so ample as that originally given under the Statute of Monopolies. Any person aggrieved through circulars, advertisements, or otherwise, with threats of legal proceedings or liability, by a person claiming to be the patentee of an invention, may under this section bring an action for an injunction and damages, if the alleged manufacture, use, sale, or purchase to which the threats relate was not or would not have been in fact an infringement of any legal rights of the person making such threats.

But no action lies under this section, however unfounded the threats may be, where the person making them, with due diligence commences and prosecutes an action for infringement. (*e*) "The meaning of this," said Bowen, L.J., "is that the sword of Damocles should either not be suspended at all, or should fall at once." (*f*) The *bona fides* of the person threatening is therefore now immaterial; his only defences are: (1) That the matters in respect of which he issued his threat are infringements of his patent right; or (2) that he has commenced and prosecuted an action for infringement with due diligence.

Discussing the section in *Skinner* v. *Perry*,(*g*) Smith, L.J., said: "This is an absolute prohibition against a person threatening, unless the threatener brought himself within either of the two saving clauses at the end of the section. My reading of the section is that you shall not threaten legal proceedings, unless the manufacture to which the threat applies infringes the legal right of the threatener, or unless the threatener is about to forthwith bring an action to shew the validity of his threats. If he cannot bring himself within these two what I call saving clauses at the end of the section, then the section absolutely forbids a man threatening legal proceedings with regard to a patent at all, and in my opinion it is *nihil ad rem* to say that what he

(*d*) *Halsey* v. *Brotherhood*, 15 C. D. 514; 19 C. D. 386; 49 L. J. Ch. 786; 51 L. J. Ch. 233. Overruling *Rollins* v. *Hinks*, L. R. 13 Eq. 355, and *Axmann* v. *Lund*, 18 Eq. 330. In *Clark* v. *Adie*, threatening circulars were sent by the patentee to the customers of a licensee under the patent; an injunction was granted, this being in contravention of the license: 21 W. R. 456, 764.

(*e*) *Colley* v. *Hart*, L. R. 44 C. D. 179; 6 R. P. C. 17; 7 R. P. C. 101; 62 L. T. (N. S.), 424; 38 W. R. 501.

(*f*) See *Skinner* v. *Perry*, 10 R. P. C. 8.

(*g*) Supra. See, also, *Douglass* v. *Pintsch*, 13 R. P. C. 681.

did was on a privileged occasion, because the section says you shall not threaten, unless you come within those two provisions at the end."

This action may be tried at Assizes, (*h*) and either party may claim a jury. Usually, recourse has not been had to a jury; but in *Appleby's Twin Roller Chain Company* v. *Eadie*, (*i*) where a trade libel was also pleaded, the plaintiffs obtained an order for trial before a special jury.

What is a Threat within the Meaning of the Act.—It will be convenient now to consider what constitutes an actionable threat within the meaning of the section. A threat may be a statement having reference to future as well as past acts.

It was at one time supposed that the language of the section only contemplated threats having reference to completed acts. This view received countenance from the language used by Bowen, L.J., in *Challender* v. *Royle*. (*j*) The learned Lord Justice in that case said: "I think the threat which is the subject-matter of the action must not be merely a warning about something that is going to be done, but must be a threat about an act done, a threat of legal proceedings or liability in respect of an alleged manufacture, use, sale, or purchase of an invention, not in respect of a proposed manufacture, use, sale, or purchase. It seems to me that that interpretation is confirmed by the subsequent language in the section, where the words employed are that an injunction and damages may be obtained if the alleged manufacture, use, sale, or purchase, was not in fact an infringement, the condition imposed under the word 'if' pointing, it seems to me, to an act done which is alleged by the patentee to be an infringement, but which may not really be an infringement. Again, when you come to the proviso, you find that an action for infringement of the patent is to be the means by which the section may be avoided, implying, I think, that there has been something done which is asserted to be an infringement of the patent. I think, then, that threats would not fall within the section if they were mere threats or warnings as to something which might be done in the future."

In the later case of *Johnson* v. *Edge*, (*k*) the Court of Appeal, however, dissented from the above dicta of Bowen, L.J. "The Lord Justice went on to say, as I understand him," said Lindley, L.J., "that he doubted whether this section would apply unless

(*h*) *Appleby's Twin Roller Chain* v. *Eadie*, 16 R. P. C. 330.

(*i*) Supra.

(*j*) 56 L. J. Ch. p. 1005; 36 C. D. p. 441.

(*k*) [1892] 2 Ch. 1; 9 R. P. C. 142; 61 L. J Ch. 262.

there had been an actual infringement. I should like to qualify that by saying that I think, upon the true construction of this section, the section might apply to an intended infringement, provided that you could shew that the intended infringement, if carried out, would be an actual infringement. I can understand a man issuing a prospectus, and issuing circulars and notices, to the effect that he was going to make something which would be an infringement of the patentee's right. I am not prepared to say that the patentee could not threaten to stop him, and bring himself within the section. I should not like to say that the section would not apply to such a case simply because the threat preceded the actual damage. I doubt whether it would not. I also doubt whether Bowen, L.J., in *Challender* v. *Royle* meant to address his mind to such a case as that. He had not got it before him."

"I can conceive one case of future infringement," said Kay, L.J., in the same case, "which would come entirely within the mischief which this section was intended to provide against. Suppose a man issued a circular, saying, 'I have a patent for such and such an article. I understand that Messrs. A. and Co. have recently erected a large manufactory for the purpose of manufacturing articles which, if made, will be an infringement of my patent.' Can it be said that a case like that would not come within the mischief intended to be provided against by this section? Could not Messrs. A. and Co. bring an action against the person who issued that circular for an injunction? I should wish at least to suspend my opinion on that subject until that point comes before the Court of Appeal to be tried." (*l*)

That the view of Lindley and Kay, L.JJ., as above expressed is the sounder construction of the section would seem to admit of little doubt; especially considering that the whole object of issuing threatening circulars must be the prevention of future intended acts of infringement either by frightening the makers of pirated articles from making and selling them or their customers from purchasing and using them. Nor does the proviso that due diligence in bringing and prosecuting an infringement action shall be a good defence, appear to raise any serious difficulty to this interpretation, seeing that an action will

(*l*) [1892] 2 Ch. p. 12. See, also, Kekewich, J., in *Kurtz* v. *Spence*, 5 R. P. C. 171; 57 L. J. Ch. 240. In this last case the plaintiffs had not yet erected their plant and machinery for making the articles in respect of which they were threatened; but an injunction was granted.

lie for an injunction to restrain an intended infringement even where no acts of infringement have already been committed.

The words "or otherwise" in the section, after "by circulars, advertisements," are not *ejusdem generis* with circulars and advertisements; they extend the meaning of those words, and are not limited by them, for the section is an absolute prohibition. (*m*)

"I agree," said Bowen, L.J., in *Skinner* v. *Perry*, (*n*) "that you should not find out the mischief in order to extend the remedy; yet if the mischief is obvious, and apt words are to be found in the section, nothing is plainer than that you ought to expound an Act of Parliament so as to deal with the whole mischief that is disclosed. What is the explanation of the addition of the words 'circulars or advertisements'? I think it is rather to enlarge the words 'or otherwise' than to cut them down. It might well be doubted whether a threat which was not addressed to a particular person, or was not addressed to a particular customer, could be said to be a threat if it was couched in the general form of an advertisement issued to the world or a circular issued to the trade. It might be said it is not a threat at all; 'I am only informing you of the way in which I intend to do my business.' The Statute says circulars and advertisements nevertheless may contain threats, and using those words so as to sweep into its net every kind of threat, the result will be that a man is not paralysed in his trade by having an action on a patent suspended before his eyes without the opportunity given to him to determine the suspense at once, and to bring the question which is raised by his antagonists to a speedy and immediate issue."

Threats by Letters.—The section includes threats by letters. (*o*) The letter need not be written direct to the person aggrieved; it is sufficient if it is written to one of his customers, or to a person using his invention. (*p*) Nor need it necessarily contain any statement as to the threatener being himself a patentee. If the Court is satisfied at the trial that the defendant had his own patents in his mind when he wrote, and that the letter was intended to

(*m*) *Driffield* v. *Waterloo Co.*, 31 C. D. 638; 3 R. P. C. 46; 55 L. J. Ch. 391; *Combined Weighing Machine Co.* v. *Automatic Co.*, 42 C. D. 665; 6 R. P. C. 502; 58 L. J. Ch. 709; 38 W. R. 233; *Barrett* v. *Day*, 43 C. D. 435; 7 R. P. C. 54; *Skinner* v. *Perry*, 10 R. P. C. 1; [1893] 1 Ch. 413.

(*n*) 10 R. P. C. 8.

(*o*) *Driffield* v. *Waterloo Co.*, 3 R. P. C. 46; Griff. P. C. 80; *Barrett* v. *Day*, 7 R. P. C. 54; *Willoughby* v. *Taylor*, 11 R. P. C. 45; *Hoffnung & Co.* v. *Salsbury*, 16 R. P. C. 375.

(*p*) *Johnson* v. *Edge*, [1892] 2 Ch. 1; *Burt* v. *Morgan*, 4 R. P. C. 278; *Colley* v. *Hart*, 44 C. D. 186; 7 R. P. C. 101; *Kensington Lighting Co.* v. *Lane Fox*, [1891] 2 Ch. 577; *Skinner* v. *Perry*, 9 R. P. C. 142.

hamper or interfere with the plaintiff's sales, that is an actionable threat. (*q*) Thus, in *Douglass* v. *Pintsch*, (*r*) Romer, J., held the following letter to a railway company, one of the plaintiff's customers, to be within the section: "I am in receipt of your letter of yesterday's date, and understand that you have given *Mr. Douglass* the order for the gas buoy lanterns, no price having been asked from my company. As we have supplied hundreds of lanterns, and *Mr. Douglass* has, so far as I know, not made one, I am much surprised at this. I am afraid this matter will lead to a great deal of difficulty and unpleasantness, and you must not be surprised if my company applies for an injunction against *Mr. Douglass* to restrain him from selling his gas buoy lanterns."

In *Kurtz* v. *Spence*, (*s*) Kekewich, J., held threats to be within the section which were contained in a correspondence expressed to be "without prejudice," and entered into with a view to a settlement without litigation.

A threat contained in a letter which is not withdrawn is a continuing threat, and the defendants will not escape an injunction by striking out of their defence the plea of infringement. (*t*)

A threat is none the less a threat from being conveyed in a private letter. (*u*)

There is nothing in the Act to limit the cause of action to threats in writing only, therefore a verbal threat made at an interview will be within the section, (*v*) but in such case the plaintiff would have more difficulty in proving his case, as an action brought upon threats conveyed in conversation only would probably produce a considerable conflict of testimony.

A complaint that the plaintiff's machine, though not in itself an infringement, is being used by third parties in an infringing manner would seem not to be within the section. But the Court will grant an injunction if the form of the complaint is such as to cause people to believe that the invention itself is complained of. (*w*)

When a General Warning may be a Threat.—Nor is a mere general warning that a patentee intends to stand upon his rights

(*q*) *Douglass* v. *Pintsch*, 13 R. P. C. 673; [1897] 1 Ch. 176; 65 L. J. Ch. 919; 75 L. T. 332; 45 W. R 108.

(*r*) Supra.

(*s*) 5 R. P. C. 161; 57 L. J. Ch. 238.

(*t*) *Driffield* v. *Waterloo Co.*, 31 C. D. 638; Griff. P. C. 80; 3 R. P. C. 46.

(*u*) *Dowson* v. *Drosophore*, 12 R. P. C. 100.

(*v*) See *Kurtz* v. *Spence*, 57 L. J. Ch. 241; 5 R. P. C. 161; *Dowson* v. *Drosophore*, 11 R. P. C. 536.

(*w*) *Burt* v. *Morgan*, 4 R. P. C. 280.

an actionable threat; it must be directed against some person. (*x*) "I cannot suppose," said Lindley, L.J., "that the section prevents a patentee from saying that which the patent itself implies, namely, that anybody infringing must expect legal proceedings to be taken against him. I do not think it can mean that. It is merely saying what everybody knows already. That is not a threat against anybody in particular."

But a circular, though framed in general terms, may, when sent to dealers in the articles concerned, amount to a direct threat to such persons. In one case a circular had been issued by the patentee in the following terms: "Notice to grocers and others. Information of extensive violations of *Mr. William Edge's* patent rights has been received. All parties are warned not to infringe these rights." This was issued by the patentee as a wrapper round goods of his own manufacture, and several such circulars were received by the customers of the plaintiffs. This was held to be a threat within the meaning of the section. "That circular," said Mathew, J., "was sent out with the goods of the defendant, and warned everybody who took those goods that the person taking them might find himself envolved in liability for an infringement of the patent right alleged here, if he bought other goods of a similar nature. It seems to me that that is what this section aims at." (*y*)

Pleadings and Particulars.—In an action for threats, the plaintiff may plead that the defendant's patent upon which the threats have been issued is invalid. (*z*) If he has not done so in the statement of claim, he may raise this issue in his reply. (*a*) By proving this he negatives the defence that the threats were justifiable because he was an infringer, for there can be no infringement where there is no valid patent right. (*b*) But where the plaintiff raises this issue, he must deliver to the defendant particulars of the objections on which he relies, and, on the question of validity, the defendant will be entitled to begin and to have a reply. (*c*)

Where the defendants in an action for threats owned several patents, and did not specify in the advertisement containing the threats complained of, which of their patents those threats referred

(*x*) *Challender* v. *Royle*, 36 C. D. 425; *Johnson* v. *Edge*, [1892] 2 Ch. 1.

(*y*) *Johnson* v. *Edge*, supra.

(*z*) *Kurtz* v. *Spence*, 36 C. D. 770; 4 R. P. C. 427; *Challender* v. *Royle*, 36 C. D. 443; *Herrburger* v. *Squire*, 5 R. P. C. 581; 6 R. P. C. 194; *Dowson* v. *Drosophore Co.*, 12 R. P. C. 100.

(*a*) *Dowson* v. *Drosophone Co.*, supra.

(*b*) *Challender* v. *Royle*, supra.

(*c*) *Kurtz* v. *Spence*, 36 C. D. 770, per Cotton, L.J., p. 774.

to, North, J., on an application by them for particulars of objection, made an order that the plaintiffs should deliver particulars of objection within three weeks after the defendants gave to them a list of the letters patent upon which they intended to rely to justify their threats.

The Court of Appeal, while approving this order, added that the defendants ought not only to state what the patents were on which they relied, but also that they relied on no others. (*d*)

The defendant is also entitled to particulars of the threats complained of, but not to the names of the customers of the plaintiff whom the plaintiff has promised to indemnify against such threats. (*e*)

Where the threats complained of were verbal statements alleged to have been made by agents of the defendants, the defendants were held entitled to particulars as to the names of such agents.

Although *mala fides* is not necessary to support an action on threats under Section 32, it will generally be well to plead it; (*f*) to support the alternative right of action at common law to which the defence that an action of infringement has been begun with due diligence is no answer.

Defences to the Action.—It is not the object of the section to prevent a patentee from warning persons who, in fact, are infringing his rights, that he intends to take proceedings. Persons who are infringers deserve to be threatened, and, therefore, whether the patentee follows up his threats by legal proceedings or not, the Court will not come to their assistance. Hence it is provided that infringement proved against the plaintiff is a good answer to an action for threats.

It is likewise a good defence to prove that the person making the threats has with due diligence commenced and prosecuted an action for infringement of his patent rights. (*g*) This in substance is a defence of *bona fides* in making the threats and affords proof that the person threatening in fact believes in the validity of his letters patent. (*h*)

The words "due diligence" have been the subject of judicial

(*d*) *Union Electrical Power & Light Co.* v. *Electrical Storage Co.*, 38 C. D. 325; 5 R. P. C. 329, see p. 333.

(*e*) *Law* v. *Ashworth*, 7 R. P. C. 86; *Dowson* v. *Drosophore Co.*, 11 R P. C. 536; 12 R. P. C. 95.

(*f*) *Colley* v. *Hart*, 44 C. D. p. 192.

(*g*) Patents Act, 1883, s. 32; *Dunlop Pneumatic Tyre Co.* v. *New Seddon Pneumatic Tyre Co.*, 76 L. T. 405.

(*h*) Cf. *Axmann* v. *Lund*, L. R. 18 Eq. 330; 43 L. J. Ch. 655; and see Cotton, L.J., in *Challender* v. *Royle*, 36 C. D. pp. 439, 440.

interpretation in various cases. An action begun before the threats sued upon were made, has been commenced with due diligence. (*i*)

In deciding the question of due diligence the time to be considered is not the time when the defendant first knew of the alleged infringement, but the time of issuing the threats; (*j*) and from that time, three months is a reasonable period within which to commence an action. (*k*)

In *Herrburger* v. *Squire*, a delay of fourteen months after issuing the threats was held to negative due diligence. (*l*)

In *Johnson* v. *Edge*, (*m*) a manufacturer issuing threats brought an action against certain rivals for fraudulently passing off as his, goods manufactured by themselves. Subsequently, when sued by these rivals in respect of threats to their customers, he amended by adding a claim for infringement. This claim was held not to be an action brought with due diligence, and to afford no defence to the proceedings in respect of the threats.

In *Colley* v. *Hart*, (*n*) the threats were made in a circular issued on the 15th of September; on the 22nd of the same month the plaintiff commenced an action on that circular. On the 6th of December following the defendant followed up his threats by an action against the plaintiff for infringement. North, J., held that there was no want of due diligence in commencing the action; but pointed out that every case must depend on its own circumstances, and that it was not possible to lay down a general rule.

Where a threats action has been promptly commenced against a patentee he is not guilty of undue delay if he waits before commencing proceedings for infringement against the plaintiff, to see whether he cannot raise his action by way of counter-claim; and for this purpose he is entitled to wait for, and have reasonable time to consider, the statement of claim. (*o*)

No patentee is bound to raise his action by a counter-claim; but it is inexpedient to fight the same issue in two actions and incur double costs. To avoid this, the proper course is for the parties to arrange a stay in the threats action, so that unnecessary costs may not be incurred. (*p*)

(*i*) *Berliner* v. *Edison-Bell Co.*, 16 R. P. C. 338; *Day* v. *Foster*, 7 R. P. C. 54.

(*j*) *Challender* v. *Royle*, 36 C. D. 425.

(*k*) Ibid. p. 437.

(*l*) 5 R. P. C. 594.

(*m*) 9 R. P. C. 142; [1892] 2 Ch. 1.

(*n*) 44 C. D. 179.

(*o*) Ibid. p. 188.

(*p*) *Combined Weighing Machine Co.* v. *Automatic Co.*, 6 R. P. C. 509. See, also, Lord Halsbury in *Automatic Co.* v. *Combined*, 6 R. P. C. 370, 371; *Edlin* v. the *Pneumatic Tyre Agency*, 10 R. P. C. 316.

In *Edlin* v. the *Pneumatic Tyre Agency*, (*q*) the threats had gone on over a period of three years, but during that time the parties had been in negotiation, and no application had been made to the Court to restrain the threats. An action in respect of these threats having at last been brought, the defendants applied for inspection of the plaintiff's machines to satisfy themselves that they were in fact infringements; after inspection they issued a writ for infringement, and Chitty, J., refused, in the particular circumstances, to hold that this action had not been commenced with due diligence.

If, however, it is apparent that the action for infringement would never have been brought had not the action been commenced for the threats, the proper inference will be that there has not been due diligence. (*r*)

The circumstance that an action in respect of threats may be defeated by the defendant subsequently starting an action for infringement, although at the time the writ was issued there was no defence, has been judicially noticed as somewhat of an anomaly. (*s*) Nevertheless it is clear, upon the authorities, that an infringement action commenced after service of proceedings in an action for threats may still be an action brought with due diligence within the meaning of the proviso to Section 32. (*t*)

It must, however, be a *bonâ fide* action, and not commenced collusively, merely with a view to setting up a defence under the proviso. "It is my opinion, and I ought to express it," said Cotton, L.J., in *Challender* v. *Royle*, "that, in order to bring the case within this proviso, the action must be an honest action, an action honestly brought in order to test the validity of the patent or the fact of infringement, whichever may be in question." (*u*) Moreover, the action must be brought in respect of the same class of infringement as that to which the threats relate. An action in respect of infringements of a different character does not meet the exigency of the proviso, and is no defence. (*v*)

The infringement action must not only have been begun, it must also have been prosecuted with due diligence. (*w*) But the Act

(*q*) Supra. See, also, *English & American Machine Co.* v. *Gare Machinery C.*, 11 R. P. C. 627.

(*r*) *Appleby's Twin Roller Chain* v. *Eadie*, 16 R. P. C. 330.

(*s*) *Combined Weighing Machine Co* v. *Automatic Co.*, 6 R. P. C. p. 508; 42 C. D. 665; 58 L. J. Ch. 709.

(*t*) Ibid.; *Colley* v. *Hart*, 7 R. P. C. 101; 44 C. D. 179; *Mackie* v. *Solvo Co.*, 9 R. P. C. 466; *English & American Machine Co.* v. *Gare*, 11 R. P. C. 627.

(*u*) 36 C. D. p. 438.

(*v*) *Combined Weighing Machine Co.* v. *Automatic Co.*, 6 R. P. C. 507.

(*w*) See *Household* v. *Fairburn*, 2 R. P. C. 140; Griff. P. C. 131.

does not say, and the section does not mean, that it must have been carried to a successful issue, (*x*) nor necessarily that it must have been prosecuted to trial. If the patentee, having duly commenced his action, carries it on until he is satisfied by the objections delivered that his patent is invalid, he not only may but ought to discontinue, and will not lose the protection of the section by so doing. (*y*)

The action contemplated by the proviso is not necessarily an action against the plaintiff in the threats action; where a patentee has threatened various persons it is sufficient if he has brought an action for infringement with due diligence against any one of them. Thus, an action brought against a customer of the aggrieved person was held a sufficient defence in *Challender* v. *Royle*. "In my opinion," said Cotton, L.J., in that case, "the proviso is satisfied if an action to test the validity of the patent or the fact of infringement is honestly brought with reasonable diligence against the person, or any of the persons, to whom the threats have been made. . . . It is not required that the action should be brought against the aggrieved person." (*z*)

But the action must be an action brought by the person issuing the threats, and such person must be the owner of the patent in support of which the threats are issued. Thus, in *Kensington Electric Lighting Company* v. *Lane Fox*, (*a*) the defendants had issued threats in support of a patent in respect of which they had an agreement with the owner for its assignment to themselves; the assignment, however, had not in fact taken place. It was held that the defendants could not rely by way of defence upon an action for infringement then pending by the owner of the patent against the plaintiffs in the threats action.

It has been held, however, that exclusive licensees with an option to purchase, may, if sued for threats, rely by way of defence upon an action brought by their licensor against an infringer; and that such action, though not brought by themselves, is a good defence. (*b*)

A patentee who has applied for leave to disclaim will be restrained by injunction if, pending disclaimer, he issues circulars threatening persons he alleges to be infringing his patent. (*c*)

Injunction and Damages.—The plaintiff in a threats action will,

(*x*) *Colley* v. *Hart*, 44 C. D. 191 (per North, J.).

(*y*) Ibid. See, also, *English & American Machinery Co.* v. *Gare Co.*, 11 R. P. C. 630 (per Chitty, J.).

(*z*) 36 C. D. pp. 439, 440; 4 R. P. C. 372.

(*a*) [1891] 2 Ch. p. 577.

(*b*) *Incandescent Gas Light Co.* v. *New Incandescent Co.*, 76 L. T. [illegible]

(*c*) *Fusee Vesta Co.* v. *Bryant & May*, 4 R. P. C. 191; 56 L. T. 136.

if successful, be entitled to an injunction, and if he has suffered damages, to damages also.

In addition to the remedy of a perpetual injunction at the trial he may move for an interim injunction till the hearing. (*d*) Such motion should not be made *ex parte*, but on notice. (*e*) The Court will not, however, grant an interim injunction, unless the plaintiff shews a strong *primâ facie* case: such a case as in the absence of a change of evidence will entitle him to a verdict at the trial. For this injunction will not be conceded on a mere balance of convenience, (*f*) nor on the ground that a foreign tribunal may take a different view of the parties' rights. (*g*)

In *Barney* v. *United Telephone Company*, (*h*) Chitty, J., held that the plaintiff in a threats action is not entitled to an interlocutory injunction, unless he satisfies the Court that he has not infringed the defendant's patent. But Kay, J., took a different view in *Walker* v. *Clarke*. (*i*) The Court refused an injunction where the defendant gave an undertaking; (*j*) so, likewise, where an infringement action was pending. (*k*)

The plaintiff may also be entitled to damages. But the Court will not direct an enquiry to be held, unless the damage is substantial. (*l*) If the injury inflicted on the plaintiff's trade has been considerable, heavy damages may be awarded.

In *Ungar* v. *Sugg*, (*m*) the Court of Appeal themselves assessed the damage at £500.

In *Willoughby* v. *Taylor*, (*n*) the damages, being little more than nominal, were assessed by the judge at ten guineas.

The circumstance that the plaintiffs, since the threats were made, have incurred expense in looking into their patents and taking advice, or even that they have in consequence of the threats stopped the progress of new works intended for an extension of their business, is not sufficient to support a claim to damages. Damages so accruing are too remote.

"When the plaintiffs," said Bacon, V.C., in *Driffield* v.

(*d*) *Challender* v. *Royle*, 36 C. D. p. 436.

(*e*) *Wilson* v. *Church Engineering Co.*, 2 R. P. C. 175.

(*f*) *Challender* v. *Royle*, supra; *Société Anonyme* v. *Tilghmann*, 25 C. D. 1; *Howard* v. *Sykes*, L. T. 1897, p. 418. But see *Walker* v. *Clarke*, 4 R. P. C. 115.

(*g*) *Société Anonyme* v. *Tilghmann*, 25 C. D., p. 7.

(*h*) 2 R. P. C. 173; 38 C. D. p. 397; Griff. P. C. 48; 52 L. T. 573.

(*i*) 4 R. P. C. 111; 56 L. J. Ch. 379.

(*j*) *Mackie* v. *Solvo Co.*, 9 R. P. C. 467.

(*k*) *Berliner* v. *Edison*, 16 R. P. C. 338.

(*l*) *Driffield* v. *Waterloo*, 31 C. D. 638; 3 R. P. C. 46; Griff. P. C. 81; *Douglass* v. *Pintsch*, 13 R. P. C. 681.

(*m*) 9 R. P. C. 113. The like sum was recovered for damages in *Appleby's Twin Roller Chain* v. *Eadie*, 16 R. P. C. 330.

(*n*) 11 R. P. C. 45.

Waterloo, (*o*) "received that notice they set themselves to look into their patent—their title-deed—and to look over their machinery all of which they ought to know very well. They ought to know their patent and the terms of it, and they ought to know their machinery, and what it is capable of doing, without requiring the assistance of engineers or solicitors or anybody else to enable them to know whether what they are doing is within their rights or not. I think there is no case whatever for an enquiry as to damages. It has not been alleged in any way that I can notice that any damage has been sustained. The business has not been suspended. Certain works contemplated have not been carried out with the vigour which it was conceived at first would be necessary, but the business has not been stopped; and that is the whole case for damages."

Damages are recoverable in respect of a contract lost by the threats of the defendant. (*p*)

In *Hoffnung & Company* v. *Salsbury*, (*q*) one of the plaintiffs' customers, who had entered into a large contract with the plaintiffs, refused, in consequence of the defendant's threats, to carry it out. The defendant contended that no damage could be recovered by the plaintiffs in respect of loss so accruing, because the plaintiffs ought to have enforced their legal rights under the contract against their customer. Byrne, J., however, held that an enquiry as to damages should go, for the conduct of the defendant having placed the plaintiffs in the position of having to cancel their contract or start litigation against an old customer, was necessarily injurious to the plaintiffs, and there was sufficient evidence of damage to support an enquiry.

Where an enquiry as to damages is directed the costs will generally be reserved. (*r*)

Enforcing the Injunction.—If, after injunction granted, the defendant repeats the threats, the proper remedy is to move to commit the offender. But while the Court will not for a moment tolerate a breach of the injunction, nor allow itself to be trifled with or tricked, it is a serious matter to imprison the defendant, and therefore the Court will not strain the language of the injunction to meet a case which would have been prohibited if foreseen.

In *Ellam* v. *Martyn & Company*, (*s*) the injunction had been

(*o*) Supra.

(*p*) *Skinner* v. *Perry*, 11 R. P. C. 406; [1894] 2 Ch. 581; 64 L. J. Ch. 826.

(*q*) 16 R. P. C. 375.

(*r*) *Johnson* v. *Edge*, 9 R. P. C. 142.

(*s*) 16 R. P. C. 30; 68 L. J. Ch. 123; 79 L. T. 510; 47 W. R. 212.

granted in the following terms: "The Court doth order and adjudge that the defendants, *Martyn & Company*, their servants, and agents, be perpetually restrained from publishing, either verbally or by circular letter, notice, or otherwise howsoever, any statements to the effect that an injunction has been granted against the plaintiffs, restraining them from infringing certain letters patent or any other letters patent, and also from threatening the plaintiffs, or any of the plaintiffs' customers, with any legal proceedings or liability in respect of the manufacture, sale, or purchase of the duplicating machine known or described by the defendants as the "Genuine Edison Mimeograph."

The defendant firm subsequently circulated among customers of the plaintiffs and other persons, a pamphlet headed, "The Genuine Edison Mimeograph," issued by *D. & Co.*, the exclusive makers under Edison's authority. On the front of this pamphlet appeared the name, as special agents for *D. & Co.*, of the defendant firm; on the back a public notice, dated from the office of *D. & Co.*, Chicago, stating *D. & Co.'s* intention to proceed against any other makers of Edison mimeographs, and alleging that the goods of such makers were fraudulent.

On a motion to commit for breach of the above injunction, the Court of Appeal, reversing Romer, J., held that no breach had been committed, the threats being the threats of *D. & Co.*, and not of the defendant, who traded as *Martyn & Company*. "I cannot bring myself," said Lindley, M.R., "to say that the injunction is so clearly worded as to extend to circulating the threats contained in the pamphlet. The *D. Company* are no myths; they are real traders; the defendant is their agent; the threats circulated are their threats, not his. He does not threaten them. They threaten, and make their threats known by him. That he may be restrained from circulating their threats is very likely, and I will assume that he could. I have, moreover, no doubt that those threats which are sent to the plaintiffs' customers are a serious injury to the plaintiffs. But for all that, in my opinion, the injunction as worded does not so plainly prohibit what the defendant has done as to justify me in holding judicially that the defendant has been guilty of a breach of the injunction." (*t*)

(*t*) 16 R. P. C. p. 31.

CHAPTER XXIV.

REMEDIES OF THE PUBLIC.

2. *Revocation of the Patent.*

Prerogative of the Crown to avoid Grants by Letters Patent.—A grant of letters patent from the Crown has always been liable to be avoided on proof that the assumed consideration for the grant did not in fact exist. In such case the grant has been made upon a false suggestion, and the Crown has been misled by the patentee. This high prerogative of the Crown to avoid its own grants has been said to have obtained recognition from the common law as a means of protecting the public interest. Thus, in the report of *Legat's Case*, Sir Ed. Coke says: "It was likewise resolved that there was a difference between the king's case and the case of a subject, for a subject who may mind his own private affairs shall not avoid his grant in these or the like cases being made upon a false insinuation or suggestion; but the king, who takes care of the commonwealth, shall avoid his grant in these cases, *jure regio*, as it is said in 21 Ed. III. 47 A.b. in the Earl of Kent's case, and it is a high and great prerogative which the king has, that when he makes any grant upon such false suggestions as aforesaid, they are void in law; so, when upon false insinuations or pretences he makes any grant, as of any monopoly, etc., which in truth is to the prejudice of the king and commonwealth, the king, *jure regio*, shall avoid such grants, and such letters patent by judgment of law shall be cancelled." (*a*)

Repeal formerly by Writ of Scire Facias.—Formerly such royal grants were repealed by *scire facias*, (*b*) and every ground upon which such grants could formerly have been repealed is now available as a ground of revocation, under the Patents Act, 1883. (*c*)

In his fourth *Institute*, Sir Ed. Coke says that *scire facias*

(*a*) 10 Coke, Rep. 113B. (*b*) *R.* v. *Butler*, 3 Lev. 220. (*c*) See s. 26 (3).

lies to repeal letters patent in three cases. First, when the king by his letters patent doth grant by several letters patent one and the self same thing to several persons, the former patentee shall have a *scire facias* to repeal the second patent. Secondly, 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. Thirdly, when the king doth grant anything which by law he cannot grant, he, *jure regio* (for advancement of justice and right) may have a *scire facias* to repeal his own letters patent." (*d*)

Every applicant for letters patent represents to the Crown that he is the true and first inventor of the invention which he seeks to patent. He also represents that that for which he claims protection is new and useful, and if any of these representations are false his patent cannot stand.

"That a false suggestion of the grantee," said Parke, B., in *Morgan* v. *Seaward*, (*e*) "avoids an ordinary grant of lands or tenements from the Crown, is a maxim of the common law, and such a grant is void, not against the Crown merely, but in a suit against a third person."

Revocation now to be by Petition.—The remedy by an action of *scire facias* which existed down to the passing of the Patents Act, 1883, is now abolished, and petition to the High Court substituted therefor, in England and Ireland. (*f*) In Scotland the remedy remains as formerly, an action of reduction at the instance of the Lord Advocate, or at the instance of a party having interest, (*g*) with the concurrence of the Lord Advocate.

In England a petition for revocation will be dealt with according to the usual practice prevailing on petitions in the High Court of Justice, (*h*) except in so far as the Statute may otherwise provide. (*i*)

Under the former procedure by *scire facias* it was not open to any and every member of the public to take proceedings for the repeal of letters patent. That remedy was an action instituted in the name of the Crown, and therefore the fiat of the Attorney-General had always to be obtained before a writ could be issued. (*j*) The fiat was never granted as a matter of course, but only at the

(*d*) 4 *Inst.* 88. See, also, *R.* v. *Mussery*, 1 W. P. C. 41; Bull, N. P. 76*a*.

(*e*) 1 W. P. C. 196; 2 M. & W. 544.

(*f*) Patents Act, 1883, s. 26 (1) (2).

(*g*) Patents Act, 1883, s. 109 (i). See *Worthington Pumping Engine Co.* v. *Weir*, 11 R. P. C. 657.

(*h*) *Haddan's Patent*, Griff. P. C. 109.

(*i*) See Patents Act, 1883, s. 26 (5) (6) (7).

(*j*) 1 W. P. C. 671, n. As to former practice on Scire Facias, see Hindmarch, p. 376; Agnew, p. 340.

discretion of the Attorney-General. (*k*) And after the proceedings were instituted the Attorney-General still retained a certain control over them, exercised chiefly as to security for costs. (*l*)

Under the Patents Act, 1883, the right of taking proceedings to revoke a patent is still a limited right, confined to certain specified classes of persons, (*m*) but the fiat of the Attorney-General is not now always necessary; though in Scotland the concurrence of the Lord Advocate is in every case required. (*n*)

Who may Petition.—A petition for revocation may be presented by any one of the following persons:—

(1) *The Attorney-General in England or Ireland, or the Lord Advocate in Scotland.* (*o*)

(2) *Any person authorized by the Attorney-General in England or Ireland, or the Lord Advocate in Scotland.* (*p*)

Any person intending to apply to the Attorney-General for his authority must first transmit the following papers to the Patent Clerk at the Royal Courts of Justice, London: (*q*) (1) A memorial to the Attorney-General stating all the circumstances, and asking for his authority; (2) a statutory declaration verifying the statements in the memorial; (3) two copies of the proposed petition, and of the particulars intended to be delivered with it; (4) the certificate of a barrister that the petition is a petition proper to be authorized by the Attorney-General; (5) a certificate by a solicitor that the intending petitioner is a proper person to petition, and that he is competent to answer the costs of all proceedings in connection with the petition if unsuccessful. (*r*)

The Attorney-General will sometimes hear the application for his authority *ex parte*. But if he thinks it undesirable to do so, he will direct notice to be given to the patentee, in order that both parties may appear before him.

The Attorney-General has no power to give costs on these applications. (*s*) But where notice had been sent to the patentee, lengthy declarations filed on both sides, and the application was eventually directed to stand over, on the patentee undertaking to bring an action for infringement against the intending petitioners

(*k*) *Young's Patent, Practical Mechanics' Journal*, 2nd series, vol. vi. 98; Lawson p. 105, n.

(*l*) *Reg.* v. *Newall*, 1 W. P. C. 671, n.

(*m*) *Avery's Patent*, 4 R. P. C. 161 (per Stirling, J.).

(*n*) Patents Act, 1883, s. 109 (1).

(*o*) Patents Act, 1883, s. 26, sub-s. 4 (*a*) (*b*).

(*p*) Ibid.

(*q*) As to this procedure, see Griff. P. C. pp. 319, 320, n.

(*r*) Griff. supra. Forms of Memorial, Declaration, and Certificate will be found in Appendix IV. post.

(*s*) *Welch's Application*, ibid.

within one month, the costs of the application were by consent made costs in the action. (*t*)

In *Ferranti's Application*, (*u*) where no other proceedings were pending between the applicant and the patentees, the authority was given *ex parte*. So likewise in the application of *King's* trustees, where the patentee had commenced an action against *King*, but had abandoned it after the delivery of the defence, and applied at the Patent Office for leave to amend, Webster, A.G., gave his authority *ex parte* for presenting a petition. (*v*)

In the *Haslam Foundry Company's Application*, notice was directed to be given to the owners of the patent (*Messrs. Bell & Coleman*), who had commenced an action of infringement against the applicants in Scotland. On the hearing, *Bell & Coleman* objected that, as they were resident in Scotland, the application should have been made to the Lord Advocate, and James, A.G., refused to give authority pending the result of the Scottish action, but gave leave to renew the application if necessary. (*w*)

In *Bayley's Application*, the circumstances were peculiar. The applicant was one of the defendants in an action for infringement, in which judgment had been given for the patentee; but an appeal was pending. Notice was directed to be sent to the patentee; but the patentee did not appear at the hearing, and Russell, A.G., granted his authority. (*x*)

The fiat of the Attorney-General may even be applied for after the petition has been presented. In *Dege's Patent*, the Court ordered the petition to stand over until the fiat had been obtained. (*y*)

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.*

Fraud here means more than innocent mistake: conduct morally culpable must be proved.

In *Avery's Patent*, (*z*) a petition was presented for the revocation of a patent granted to *Thomas Steven Lindsay*, and alleged to have been obtained by him in fraud of the rights of the petitioner. The facts were shortly as follows: In 1885 *Avery*, a citizen of the United States, authorized one *Weeks*, under a power of attorney, to

(*t*) *Vicker's Application*, Griff. P. C. p. 320.

(*u*) Griff. P. C. 320.

(*v*) Ibid.

(*w*) Ibid.

(*x*) *Vicker's Application*, supra.

(*y*) 12 R. P. C. 448. Forms for Proceedings for Revocation of Letters Patent will be found in Appendix IV. post.

(*z*) 4 R. P. C. 152.

apply for letters patent in England and elsewhere for all his inventions in processes or appliances or apparatus for heating, lighting, and metallurgical purposes. *Lindsay* undertook to test in England the invention it was intended to patent. While so engaged, *Lindsay* met with difficulties which necessitated experiments. Owing to the imminence of the publication of *Avery's* invention in the United States, it became necessary to obtain protection in England before the experiments were completed. To do this, *Lindsay*, who was advised by a patent agent that he was an inventor within the meaning of English patent law, applied (through *Weeks*) for a patent in his own name, and filed a provisional specification. Before it was necessary to file a complete specification the experiments had resulted in the discovery of an improvement upon *Avery's* invention, and this improvement was incorporated in the complete specification. *Weeks* appointed *Lindsay* his substitute as the attorney of *Avery*, under a power for the purpose contained in the original power of attorney, and *Lindsay* made a statutory declaration, stating that he was the true and first inventor, but not disclosing the fact that part of the invention had been communicated from abroad.

On these facts it was contended that the patent had been granted in fraud of the petitioner's rights, and that the statement that *Lindsay* was the inventor was not only untrue, but, having regard to the rules and well-established practice upon applications for a patent, so recklessly untrue as to be evidence of fraud. Further, that it was sufficient under the Act to shew that the petitioner had been defrauded of his rights, and the Crown deceived, without proving actual fraud by the patentee. But Stirling, J., held that fraud, such as would entitle the petitioner to succeed, was not made out.

Discussing the meaning of the word "fraud" in the Act, his lordship said: "Here we have not to deal with a Statute nearly three hundred years old, like the Statute of Monopolies, nor is there any current of decision to fix the sense in which the word therein is used; and in my judgment, it would be wrong to construe the word, occurring as it does in an Act passed little more than three years ago, and in the absence of any context imperatively demanding such a construction otherwise than in accordance with the usual construction of the English language, and, consequently, as envolving a grave moral culpability in the person obtaining the patent." (*a*)

(*a*) 4 R. P. C. p. 165.

On appeal, the judgment below was affirmed. Cotton, L.J., said: "If *Lindsay*, having obtained the patent in his own name, had sought, by means of that, to deprive *Avery* of any rights which he would have had if the patent had been in his own name, then the case would have stood very differently; but, in my opinion, if he made a mistake—I do not say that he did—if he made a mistake honestly, that, in my opinion, although it might make the patent bad, would not enable the petitioner to establish this, that the patent was obtained in fraud of his rights. In my opinion, that means obtained in violation of the rights of *Avery*, who was entitled, I will assume, to have a patent for this as the true inventor, and obtained so as, dir tly or indirectly, to deprive him of his rights, and to gain some advantage to himself. The mere fact that an agent makes an honest mistake, even though that may cause loss to the principal, is not, in my opinion, an act done in fraud of the rights of the principal. It is an act done which injures the rights of the principal, but an act done in fraud of his rights is, to my mind, an entirely different thing. To be in fraud of his rights, it must be either done with the intention of depriving the principal of his rights, or must be insisted upon so as to deprive the principal of his rights. There was an argument addressed to us with great zeal, that anything which deprives a person of his rights, if done by one in a confidential position, such as an agent is, is done in fraud of the rights of the principal. That, in my opinion, is a misuse of the term 'fraud.' It may be a mistake for which the agent must be answerable for not having performed his duty. It may be a mistake for which he may not be answerable, but which still may cause great loss to his principal; but an act to be 'in fraud of his rights,' to my mind, must involve an attempt by the agent to deprive the principal of something, or to gain for himself something at the expense of his principal; and, in my opinion, on the evidence here—I will not go through it in detail—there is nothing which can justify us in coming to any other conclusion than this: that if, in fact, *Lindsay* did act under a mistake, or was wrongly advised, he did so by an innocent mistake, and not as acting in fraud of the rights of his principal. In my opinion, therefore, the case which is raised by the petition fails, and Mr. Justice Stirling was right in dismissing the appeal with costs." (*b*)

In *Gale's Patent*, (*c*) the Court held that the petitioner was entitled to succeed on the ground of fraud. There, however, the respondent,

(*b*) 4 R. P. C. pp. 326, 327.

(*c*) 8 R. P. C. 438.

having agreed to assist the petitioner in patenting his invention in their joint names, and to supply the money to work it, in breach of that agreement took out a patent for the invention in his own name. (*d*)

Where revocation is sought on the ground of fraud, the evidence on the hearing of the petition should be oral evidence, as in such case there is usually a direct conflict of testimony, which it is almost impossible to test satisfactorily on affidavits. (*e*)

Where a patent has been revoked on the ground of fraud the comptroller may, on the application of the true inventor, made in accordance with the provisions of the Patents Act, 1883, grant to him a patent in lieu of, and bearing the same date as the date of revocation of, the patent so revoked. The comptroller has a discretion in the matter, and a patent so granted ceases on the expiration of the term for which the revoked patent was granted. (*f*)

(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.*

In *Walker* v. *The Hydro-carbon Syndicate, Limited*, (*g*) the petitioner, *Walker*, presented a petition alleging that he was the true and first inventor of the inventions comprised in two patents granted to *Haddan* and *Boult* respectively, of which patents the *Hydro-Carbon Syndicate* were the assignees.

In 1875 a patent had been granted to the petitioner for an improved method of applying petroleum and other hydro-carbons in furnaces for generating steam, or in ovens for heating purposes, including the smelting of metals. In 1880 *Haddan* obtained a patent for improvements in apparatus for generating heat, light, and power from hydro-carbon oil, as a communication from abroad. In 1881 a patent was granted to *Boult* for an improved method of burning hydro-carbon oils, together with steam or water, for the purpose of generating heat for calorific and dynamic effect. This patent was also a communication from abroad.

At the hearing of the petition the respondents relied generally upon the state of public knowledge prior to the petitioner's patent, and in particular on the description in the specification of an

(*d*) See, also, *Norwood's Patents*, 12 R. P. C. 214; 15 R. P. C. 98.

(*e*) *Gale's Patent*, supra, per Chitty, J., p. 440.

(*f*) Patents Act, 1883, s. 26 (8). See, also, *Norwood's Patent*, 12 R. P. C. 214.

(*g*) 2 R. P. C. 3; Griff. P. C. 238.

earlier patent granted to one *Wise*. Having heard witnesses on either side, Bacon, V.C., held that the petitioner's patent must be construed as a patent for the particular method therein described only, and that the patents of the respondents were for different methods. He accordingly dismissed the petition with costs.

His Honour said: "There was a common universal knowledge that petroleum, dangerous in itself, inapplicable in itself, could, by means which had been resorted to long ago in *Wise's Patent*, and long before that, namely, by being reduced into the form of spray, be usefully applied for the purposes for which alone petroleum is valuable, and avoiding all the danger which would attend the application of it in any other way. The three patents, the patent of *Walker*, the patent of *Haddan*, and the patent of *Boult*, are not for totally different purposes, but are totally different in their mode of application, and now I am to be told, after a mechanical invention has been produced for a common object, that any person who makes a better combination of machinery (not by the mere introduction of mechanical equivalents, but by the exercise of mechanical genius or talent, or whatever it may be called) could not obtain a patent for it; that he has no right to say to *Walker*: 'Admitting yours was a good patent, and your contrivances are very ingenious and clever, I see a much better way of dealing with the basis of common knowledge, and by retorts and by other means which I describe fully in my specification and drawings, I do it better and differently from the way in which you do it.' That is the whole case."

(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.*

In *Haddan's Patent*, (*h*) the petitioner alleged that the patent had been obtained in fraud of his rights, inasmuch as he was the true inventor and had publicly manufactured and sold within the realm prior to the date of the patent the invention claimed by the patentee. The petition was tried before Kay, J., with *viva voce* evidence. His Lordship found that the patentee had been anticipated, and directed that the patent should be revoked.

Referring to the ground of the petition, the learned judge said: "Now, the justice and common-sense of that is too apparent to need

(*h*) 2 R. P. C. 219.

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*)

In *Edmond's Patent*, (*j*) letters patent had been granted for improvement in tools and tool holders used in machines for making umbrella and parasol ribs and stretchers. The petitioners were the defendants in an action for infringement which had been commenced against them by the patentee and the *English Umbrella Manufacturing Syndicate, Limited*, who claimed to be his assignees. The patentee had formerly been in the service of the petitioners, and they prayed revocation of the grant on the ground that it had been obtained in fraud of their rights, that one of them was the true inventor or joint inventor with *Edwards*, and that they had publicly used the invention prior to the date of the patent. The specification contained seven claims. At the hearing before Pollock, B., the petitioners confined their evidence to the second claim, which was for the application of the machine described for making double-ended solid ribs.

Evidence of prior user by one of the petitioners having been given, it was contended that this was no anticipation, because the user proved extended only to solid and not to "Paragon" ribs.

On this Pollock, B., said: "You take tools which have been used for making solid-ended ribs, and you apply that to the 'Paragon.' That will not do. You might as well say that these things have been made in brass, and you will make them in another metal, and take out a patent for that. It is merely an adaptation and not an invention." (*k*)

Grounds of Revocation.—The petitioner must deliver with his petition particulars of the objections on which he means to rely, and no evidence, except on special leave, will be admitted in proof of any objection of which particulars are not so delivered. (*l*)

Particulars delivered may be from time to time amended by

(*i*) See, also, *Morgan's Patent*, 5 R. P. C. 187.

(*j*) 6 R. P. C. 355.

(*k*) See, also, *Drummond's Patent*, 6 R. P. C. 576; L. R. 43 C. D. 80.

(*l*) *Goulard & Gibbs' Patent*, 5 R. P. C. 532; Patents Act, 1883, s. 26 (5).

leave of the Court or a judge. (*m*) A petitioner who has the required *locus standi*, may impeach the patent for the revocation of which he petitions on any legal grounds which would be open to a defendant resisting an action for infringement or which would formerly have supported proceedings for *scire facias*.

In *Morgan's Patent*, (*n*) the petitioner alleged that he had publicly made and sold carriages according to the alleged invention before the date of the patent.

The particulars of objection raised the following grounds of revocation: That the patentee was not the inventor of the alleged invention, that the alleged invention was not new, that there was a variance betwixt the original and the complete specifications, that the alleged invention was not fit subject-matter for a patent, and that there had been three prior publications of it, as well as instances of prior user besides the user by the petitioner. These objections were held to be open to any petitioner qualified to petition under the Patents Act, 1883.

In *Goulard & Gibbs' Patent*, (*o*) where the petition was presented with the authority of the Attorney-General, the particulars of objections included the following: (1 and 2) that the alleged invention was not novel; (3) that it was a suggestion to use on a large scale a well-known mode of deriving electrical action by induction; (4) that claims 1 and 2 of the specification were for principle only; (5) want of utility; (6) absence of a proper specification; (7) that the specification did not describe or ascertain the nature of the alleged invention, or the manner in which the same was to be performed, and did not distinguish the old from the new, and was vague and calculated to mislead the public; (7*a*) that the complete specification described and claimed an invention different from the provisional; (8) prior publication in a number of earlier specifications; (9) prior user.

Service of the Petition.—There are no special provisions as to service. Where the respondent is resident abroad, personal service will not be required. In such case the Court has directed notice to be given to the respondent by a registered letter containing a copy of the petition and of the particulars of objection. (*p*)

In *Drummond's Patent*, (*q*) a petition was presented by two petitioners, who alleged that they had publicly manufactured and

(*m*) Patents Act, 1883, s. 26 (5).
(*n*) 5 R. P. C. 186.
(*o*) Ibid. 529.
(*p*) *Drummond's Patent*, 6 R. P. C. 576; *Hirschfield's Patent*, 11 R. P. C. 514; *Kay's Patent*, 11 R. P. C. 279; *Cerckel's Patent*, 15 R. P. C. 500; *Goerz & Hoegh's Patent*, 12 R. P. C. 370.
(*q*) Supra.

sold within the realm, and prior to the date of the respondent's patent, articles embodying the respondent's invention. The respondent resided in Scotland, at Dundee, and in reply to a letter from the petitioner's solicitor, stated that he did not intend to appear on the petition, as he was not under the jurisdiction of the English Courts. The respondent had commenced an action for infringement against the petitioners in the Scottish Courts. The petitioners applied to have the petition treated as an action, and placed in the witness list. The respondent did not appear on the hearing of this application, but there was evidence that the particulars of objection and a copy of the petition had been delivered to him personally at Dundee. North, J., made the order, postponing its operation to a specified date, in order that the respondent might have the opportunity of shewing cause against it, if so advised.

Practice on the Hearing.—It would seem that the judge who tries the petition has no power to certify that the objections are proper, for there is no provision in Section 26 of the Patents Act, 1883, similar to that in sub-section 6 of Section 29, dealing with infringement actions. (*r*) But as the judge, where the contrary is not provided, has a complete discretion as to costs, the silence of the section will not affect the right of the petitioner to all such costs as he may be justly entitled to.

Where, on a petition for revocation the petitioner and respondent have been defendant and plaintiff respectively in a prior infringement action in respect of the same patent, no estoppel arises from the judgment in that action to preclude the validity of the patent being fully enquired into on the hearing of the petition. (*s*)

In *Deeley's Patent*, (*t*) the Court, in an infringement action, had found the first claims anticipated, and the patent invalid. Whereupon the defendant presented a petition for revocation, and contended that the respondent was estopped from shewing that the first claim was, in fact, good. On this the Court of Appeal said: "A petition to revoke a patent, by whomsoever presented, is a petition on behalf of the public, and it is not personal to the petitioner, and, in a legal point of view, it is a mere accident that in this case the petitioner was a party to a former litigation. Under the old procedure by *scire facias*, it is plain that there would be no estoppel, and although the procedure is altered, the principle underlying it and the effect of it are the same; and, as

(*r*) See *Goulard & Gibbs' Patent*, 5 R. P. C. 537.

(*s*) *Deeley's Patent*, [1895] 1 Ch. 689; 12 R. P. C. 192; 64 L. J. Ch. 480.

(*t*) Ibid.

in the case of a *scire facias*, so in this petition, there is no estoppel." (*u*)

Again, in the *Shoe Machinery Co.* v. *Cutlan*, Smith, L. J., said: "We held in the case of *Deeley's Patent*, that in a petition for revocation of a patent, there was no estoppel, because the person petitioning and having obtained the fiat of the Attorney-General for revocation of the patent, stands as one of the public and not as an individual." (*v*)

The petition must be presented in the name of the person actually qualified under the Act to present it. An attorney, acting under a power received from a person qualified, cannot petition on behalf of such person. (*w*)

All persons having an interest under the patent of which revocation is sought must be before the Court, and should therefore be made respondents. (*x*)

In *Avery's Patent*, a petition was presented by an attorney named *Kimber*, in his own name, under a power from *Avery*, who was a citizen of the United States of America. Several persons were interested under an agreement in the invention which was the subject of the disputed grant. Objection being taken that these persons had not been made respondents, Stirling, J., held the objection good. The revocation of a patent, his Lordship said, would destroy the rights of all persons beneficially interested, and that he could not do in their absence. The petitioners must amend by making *Avery* sole petitioner, and making all persons interested in the patent parties. And for this purpose the petition was ordered to stand over generally, with liberty to any party to apply. (*y*)

In *Haddan's Patent*, the respondent *Haddan*, after the presentation of the petition for revocation, had assigned his interest in the petition to one *Horlick*. An order was made that *Horlick's* name should be substituted as respondent for that of *Haddan* upon each paying £25 into court as security for costs. (*z*)

Amendment of the Specification pending the Petition.—Section 19 of the Patents Act, 1883, provides that in a proceeding for revocation of a patent the Court or a judge may, at any time, order

(*u*) Per Smith, L.J., 12 R. P. C. p. 199. See, also, *Lewis & Stirckler's Patent*, 14 R. P. C. 35.

(*v*) 12 R. P. C. p. 533; [1896] 1 Ch. 113; 35 L. J. Ch. 44.

(*w*) *Avery's Patent*, 4 R. P. C. 152; 36 C. D. 310, 311; 56 L. J. Ch. 1007; *Haddan's Patent*, 2 R P. C. 218.

(*x*) *Avery's Patent*, supra.

(*y*) 4 R. P. C. p. 159.

(*z*) 2 R. P. C. 218; cf. *Reg.* v. *Betts* (15 Q. B. 540; 19 L. T. Q. B. 531), where it was held that a patentee who had assigned all his interest in the patent ought still to remain as a defendant in an action of *scire facias* for revocation of the patent.

that the patentee shall, subject to such terms as to costs and otherwise as the Court or a judge may impose, be at liberty to apply at the Patent Office for leave to amend his specification by way of disclaimer, and may direct that, in the meantime, the trial or hearing shall be postponed.

Whether on such application being made liberty shall be given is a matter of discretion, and once the judge has exercised his discretion the Court of Appeal will not interfere with his order unless satisfied that it is clearly erroneous. (*a*)

In *Goulard & Gibbs Patent*, (*b*) the respondents applied under this section for liberty to apply at the Patent Office for leave to amend their specification by striking out their third claim, and for a postponement of the hearing of the petition. For the petition it was contended that as the patentee had delayed his motion till a few days before the day on which, in the ordinary course, the petitioner would have been heard, the motion was a mere pretext for delay, and ought to be refused. Kekewich, J., made the order on terms that the patentees should pay all the costs occasioned up to and including the day of petition, and proceed forthwith to apply to the Patent Office, and prosecute the application with diligence: the petitioner, on his part, to have fourteen days after the date of amendment to amend the petition and particulars of objection, or to give notice that the petition was discontinued.

In *Chatwood's Patent*, (*c*) the respondents also moved for liberty to apply for leave to amend after the petition had been presented. The motion was opposed on the ground that the proposed amendments were not disclaimers. Bryne, J., not being satisfied that the amendments amounted to more than disclaimers, gave leave on the following terms: the applicants to pay in any event the costs of the application and of the petition up to and occasioned by the disclaimer, except only so far as the proceedings in the matter might thereafter be utilized for the purpose of the hearing of the petition, should the same be heard; if petitioners elected not to proceed, then the respondents to pay all the costs of the proceedings.

The power to amend given by Section 19 is by way of disclaimer only, and does not include corrections or explanations, except such as may be required to define the disclaimer. (*d*)

In *Deeley* v. *Perkes*, (*e*) the question arose as to whether a

(*a*) *Armstrong's Patent*, 13 R. P. C. 508; 14 R. P. C. 747; 77 L. T. (N. S.), 267.
(*b*) 5 R. P. C. 190.
(*c*) 16 R. P. C. 371.
(*d*) *Owen's Patent*, 15 R. P. C. 755.
(*e*) 13 R. P. C. 581; [1896] A. C. 496.

respondent who appealed against an order revoking his patent could disclaim, pending the hearing in the House of Lords. An adjournment having been granted for that purpose, the comptroller refused to register the disclaimer, on the ground that the patent no longer existed, it being the practice at the Patent Office to remove a patent from the register whenever the result of the petition was recorded.

This having been brought to the notice of the House of Lords, Lord Herschell in delivering the judgment of the House said: "All your Lordships are, I believe, of opinion that it would be very unfortunate if, on a petition for revocation of a patent, the patentee was in this position, that if the judge of first instance on any ground declared the patent invalid, the result should necessarily be an order of revocation, precluding the patentee from disclaiming, however meritorious the invention, and however unimportant the error which rendered it inevitable to hold the patent in its then form to be invalid. The 19th section of the Patents Act, 1883, enables the Court or a judge to order, in a proceeding for revocation, that the patentee may be at liberty to apply for leave to amend, and to direct that, in the meantime, the trial or hearing shall be postponed. This provision is, however, inapplicable when the judge holds, as in the present instance, that the claims made by the patentee are bad; and even when one claim only is held bad, it would be unjust that the patentee should be bound, either to forego his right of appeal, or to lose all opportunity of amending, in case the Court of Appeal should adopt the same view as the Court below. The 26th section of the Act, which relates to the revocation of a patent, contains no provision touching the form of the judgment. It only abolishes the proceeding by *scire facias*, and enables revocation to be obtained 'on petition to the Court,' prescribing certain procedure in relation to such a petition. I do not see any difficulty, therefore, in so framing the order on a petition for revocation as to avoid the possible injustice and hardship to which I have referred. . . . I think that . . . it ought to be ordered that the patent be revoked, unless within three months, or such further time as the Court may allow, the patentee obtain leave to amend his specification by disclaiming the first claim." (*ee*)

A petition for the revocation of a patent is "a cause or matter" within the meaning of Order XXXI. of the Rules of the Supreme Court, and interrogatories may therefore be delivered where the

(*ee*) So ordered in *Haggenmacher's Patent*, 15 R. P. C. 437.

leave of the Court has been obtained. In *Haddan's Patent*, Kay, J., gave leave to the petitioner to interrogate the respondent. (*f*)

Trial.—The Patents Act, 1883, provides that at the hearing the mode of trial shall be the same as that of an infringement action. (*g*) Under the old practice actions of *scire facias* were tried before a judge sitting with a jury. Petitions for revocation are now heard by a judge sitting alone. They are consequently generally heard by a judge of the Chancery Division. But it is not necessary that they should be tried in London, and where the residence of the parties interested made it more convenient that a petition should be heard elsewhere. North, J., on a motion by the petitioners, made an order for the trial of the issues of fact by a judge without a jury at the next Birmingham Assizes. (*h*)

On the hearing the respondent is entitled to begin, and lead evidence in support of the patent, (*i*) and the respondent also has the right of reply if the petitioner gives evidence impeaching the validity of the grant. This is because the *onus* of proof is upon the petitioner, and therefore it is right that the patentee should have the last word. (*j*)

Evidence on the Hearing.—Evidence at the hearing may be given either on affidavit or *viva voce*. (*k*) But where the respondent contests the petition, the hearing will usually be treated as a witness action. "The petition," said North, J., in *Gaulard & Gibbs' Patent*, "involves precisely the same issues as an action to try the validity of the patent, and it is clear that it ought to be tried on evidence taken in court. . . . It is in every sense of the word an action; and I think it ought to be tried in the way in which actions usually are tried, and set down accordingly." (*l*)

Revocation Order.—When an order is made for the revocation of a patent, the person in whose favour it is made shall forthwith leave at the Patent Office an office copy of such order. The Register shall thereupon be rectified, or the purport of such order shall otherwise be duly entered in the Register, as the case may be. (*m*)

Where a patent has been revoked on the ground of fraud, (*n*) the comptroller may, on the application of the true inventor made in accordance with the provisions of the Patents Act, 1883, grant

(*f*) Griff. P. C. 109.
(*g*) Sect. 28 (1).
(*h*) *Edmond's Patent*, 6 R. P. C. 355.
(*i*) Patents Act, 1883, s. 26 (7).
(*j*) Cf. Patent Act, 1852, s. 41.
(*k*) See *Edmond's Patent*, 6 R. P. C. 357; *Walker* v. *Hydro-Carbon Syndicate*, 2 R. P. C. 7; *Vaisey's Patent*, 11 R. P. C. 591 (where the respondent did not appear).
(*l*) L. R. 34 C. D. 396; 5 R. P. C. 525.
(*m*) P. R. rule 74.
(*n*) See ante, p. 580.

to such person a patent in lieu of and bearing the same date as the date of revocation of the patent so revoked, but the patent so granted shall cease on the expiration of the term for which the revoked patent was granted. (*q*)

Staying Revocation Pending Appeal.—Where a patent has been revoked and an appeal is intended, the Court will stay execution as to revocation, for once the patent is revoked difficulties may arise as to its being restored in the event of the appeal succeeding.

In *Armstrong's Patent*, (*r*) Kekewich, J., said that the proper course was to have the order drawn up but not delivered out if notice of appeal was given within a week. In the same case the Court of Appeal also granted a stay pending appeal to the House of Lords. (*s*)

Costs of the Petition.—A successful petitioner is entitled to costs; and this is so even where the respondent has intimated that he will not oppose the petition, for except by petition no means of revoking a patent exists. (*t*) In awarding costs the Court will exercise its discretion, according to the circumstances of the case, as to the particulars of objection in respect of which costs should be allowed. (*u*)

A foreign respondent who contests the petition will not be ordered to give security for costs. In *Miller's Patent*, (*v*) the respondent, a foreigner resident abroad, on being served with notice of the petition, intervened and issued a summons for further particulars of the objections to the patent, whereupon the petitioner applied that he should be required to give security for costs. Kekewich, J., in refusing the application, said: "The principle upon which the Court has acted in ordering security for costs is perfectly clear and perfectly simple. It is this: that no person out of the jurisdiction is allowed under ordinary circumstances to institute proceedings in the High Court here without reasonably satisfying the respondent to his application—be he defendant or be he in any other way respondent—that, supposing the application fails, there will be tangible opportunity of recovering the costs of failure. That is what is laid down by Cotton, L.J., in the case of the *Apollinaris Company* v. *Wilson*, (*w*) and also by the interlocutory observation of Bowen, L.J., in the same case, and it is clearly to

(*q*) Patents Act, 1883, s. 26, sub-s. 8.
(*r*) 13 R. P. C. 508.
(*s*) 14 R. P. C. 756; 11 L. T. (N. S.), 267.
(*t*) *Wallace's Patent*, 12 R. P. C. 444.
(*u*) *Simmon's Patent*, 12 R P. C. 446
(*v*) 11 R. P. C. 55; 63 L. J. Ch. 324.
(*w*) L. R. 31 C. D. 632.

be gathered from the report of what was done by the late Master of the Rolls in *Vavasseur* v. *Krupp.* (*x*) It is said that here the patentee whose patent is attacked comes within that principle. I cannot see it. No doubt it might be possible for the petitioner to proceed without the respondent being here. He is entitled to the opportunity of coming, and he need not come unless he desires to do so, but he is brought here by the petitioner. He is brought here to defend his rights. He makes no application to the Court whatever. He is in no sense an actor within the meaning of that word as used by the Court of Appeal, therefore it does not seem to me that there is any reason why he should give security for costs."

Appeal.—From the decision of the judge at the hearing an appeal lies to the Court of Appeal and to the House of Lords. (*y*)

Fresh evidence will not be admitted on appeal, except with reluctance, and on good cause shewn.

In *Walker* v. the *Hydro-Carbon Syndicate*, (*z*) it was alleged that the introduction of a prior specification at the trial had taken the petitioner by surprise, and leave was sought to admit fresh evidence on appeal. But it being shewn that the petitioner had been cross-examined upon this very specification in a proceeding prior to the trial leave was refused.

Cotton, L.J., said: "We are always very reluctant indeed to allow further parol evidence to be given on an appeal which was not given before the Court below; and here it appears that the plaintiff had this matter of *Wise's Patent* put before him, and said, I suppose, whatever he knew then with reference to *Wise's Patent*. I can see no reason why he should be allowed to give further evidence."

In the same case the petitioner applied for a postponement of the hearing of the appeal, on the ground of his absence in America, and that, being an engineer, it was of importance that he should be present at the hearing to instruct his counsel. The Court refused the application.

Patent assigned to Secretary of State for War.—To the general rule that all letters patent granted by the Crown to inventors are liable to be revoked on due cause shewn, the following exception has recently been created by Statute. Where an invention of an improvement in instruments or munitions of war has been assigned

(*x*) L. R. 9 C. D. 351.

(*y*) *Deeley* v. *Perkes*, 13 R. P. C. 581; *Goulard & Gibbs' Patent*, 5 R. P. C. 525; 6 R. P. C. 215; 7 R. P. C. 367.

(*z*) 3 R. P. C. 254.

to the Secretary of State for the War Department, and such Secretary of State has certified to the comptroller his opinion that in the interest of the public service the particulars of the invention and of the manner in which it is to be performed should be kept secret, no proceeding by petition or otherwise will lie for the revocation of letters patent granted in respect thereof. (*a*)

(*a*) Patents Act, 1883, s. 44 (9).

CHAPTER XXV.

OFFENCES UNDER THE PATENTS ACTS.

Representing as Patented an Article for which no Patent has been Granted.—Section 105 of the Patents Act, 1883, provides as follows:—

"(1) Any person who represents that any article sold by him is a patented article, when no patent has been granted for the same, . . . shall be liable for every offence, on summary conviction, to a fine not exceeding five pounds. (*a*)

"(2) A person shall be deemed, for the purpose of this enactment, to represent that an article is patented . . . if he sells the article with the word 'patent,' 'patented,' or any word or words expressing or implying that a patent . . . has been obtained for the article stamped, engraved, or impressed on, or otherwise applied to, the article."

Seeing that to justify the use of the word "patent" or "patented" a patent must have been granted in respect of the article to which the word is applied, it is an offence to sell an article so marked when provisional protection only has been obtained by the inventor. (*b*)

It would also seem, from the language of the section, that it is an offence to use the word "patent" or "patented" in connection with an article for sale even after the complete specification has been accepted, so long as the patent is still unsealed. But Section 15 of the Patents Act, 1883, gives an applicant whose complete specification has been accepted all the privileges of a patentee, except as to proceedings against infringers; and in view of this section, the magistrate in *Reg.* v. *Townsend* (*c*) refused

(*a*) Section 112 (3) provides as to the Isle of Man: "Any offence under this Act committed in the Isle of Man which would in England be punishable on summary conviction may be prosecuted, and any fine in respect thereof may be recovered at the instance of any person aggrieved in the manner in which offences punishable on summary conviction may for the time being be prosecuted."

(*b*) *Reg.* v. *Wallis*, 3 R. P. C. 1; *Reg.* v. *Crampton*, 3 R. P. C. 367.

(*c*) 13 R. P. C. 265.

to convict an inventor who, after the acceptance of his complete specification, marked with the word "patent" goods made in accordance therewith.

What the position is, under this section, of a patentee whose patent has expired, is not very clear. It would seem that he commits no offence in continuing to use the word "patent;" and if he uses in conjunction with that word the date and number of his letters patent, his action would hardly be likely to deceive the public. (*d*) Under the Merchandise Marks Act, where the words are, "existing patent," it has been held not to be an offence to continue to use the word patent after the expiration of the patent term. (*e*).

In Trade Mark cases the use of the word "registered" when the only registration of the mark was a foreign registration, has been held to be an offence under Section 105 of the Patents Act, 1883, as amounting to a representation that the mark was registered in the United Kingdom. (*f*)

Falsifying the Register of Patents.—By Section 93 of the Patents Act, 1883, it is enacted as follows:—

"If any person makes or causes to be made a false entry in any register kept under this Act, or a writing falsely purporting to be a copy of an entry in any such register, or produces or tenders, or causes to be produced or tendered, in evidence any such writing, knowing the entry or writing to be false, he shall be guilty of a misdemeanour." (*g*)

Assumption and Use of the Royal Arms.—So, likewise, the assumption or use, by any person without authority, in connection with any trade, business, calling, or profession, of the Royal Arms, or Arms so nearly resembling the same as to be calculated to deceive, in such a manner as to be calculated to lead other persons to believe that he is carrying on his trade, business, calling, or profession, by or under the authority of the Queen, or of any of the Royal family, or of any Government Department, is also an offence under the Patents Act, 1883. (*h*)

(*d*) See *Ransome* v. *Graham*, 51 L. J. Ch. p. 903.

(*e*) *Gridley* v. *Swinborne*, 52 J. P. 791; 5 T. L. R. 71. As to the use of the words "Manufactured by Royal Letters Patent" in connection with a product which is not made by any patented process, but in the making of which patented machinery is employed, see *Cochrane* v. *Macnish*, [1896] A. C. 225.

(*f*) *Wright, Crossley & Co.* v. *Dobbin & Co.*, 15 R. P. C. 21; *McSymons* v. *Shuttleworth*, 15 R. P. C. 748.

(*g*) Punishment for a misdemeanour under the Patents Act, 1883, shall in the Isle of Man be imprisonment for any term not exceeding two years, with or without hard labour, and with or without a fine not exceeding £100, at the discretion of the Court. See Sect. 112 (2).

(*h*) Patents Act, 1883, s. 106.

Any person guilty of this offence is liable, on summary conviction, to a fine not exceeding twenty pounds. (*i*)

Unregistered Patent Agents.—The Patents Act, 1888, provides for the registration of patent agents, and under that Act no person is entitled to describe himself as a patent agent, whether by advertisement, by description on his place of business, by any document issued by him, or otherwise, unless he is registered in pursuance of the Act. (*j*).

Any person who knowingly describes himself as a patent agent, without being registered, is liable, on summary conviction, to a fine not exceeding twenty pounds. (*k*)

To convict of this offence it must be shewn that the person charged has expressly described himself as a patent agent. The use of the term "patent expert" by an unregistered person has been held not to amount to this offence. (*l*)

The circumstance that a patent agent has *bonâ fide* practised as such prior to the coming into operation of this section, does not exempt such agent from the necessity of registration. If he continues to describe himself as a patent agent, without having registered, he is guilty of an offence. (*m*)

But an agent practising *bonâ fide* prior to the passing of the Act is entitled to be registered. (*n*)

Under the Patent Agents' Rules, 1889, certain entrance and annual fees are payable by patent agents on registration. (*o*) These rules have statutory force, and any person who has not paid his annual registration fee ceases to be registered, and if he continues practising, is liable to be prosecuted under the above section. (*p*)

In Scotland, offences punishable summarily under the Patents Act, 1883, may be prosecuted in the Sheriff Court. (*q*)

(*i*) Patents Act, 1883, s. 106.

(*j*) Patents Act, 1888, s. 1 (1). The Rules as to Patent Agents will be found in Appendix II. post.

(*k*) Patents Act, 1888, s. 1 (4).

(*l*) *Graham* v. *Eli*, 15 R. P. C. 259.

(*m*) *Starey* v. *Graham*, [1899] 1 Q. B. 406; 68 L. J. Q. B. 257; 80 L. T. 185; 47 W. R. 392.

(*n*) Patents Act, 1888, s. 1 (3).

(*o*) See these Rules, in Appendix II. post.

(*p*) *Institute of Patent Agents* v. *Lockwood*, [1894] A. C. 347; 11 R. P. C. 374; 71 L. T. 205; 63 L. J. P. C. 74.

(*q*) Patents Act, 1883, s. 108.

CHAPTER XXVI.

INTERNATIONAL PROTECTION OF INVENTIONS.

International Convention.—Section 103 of the Patents Act, 1883 (amended by Section 6 of the Patents Act, 1885), empowers her Majesty to enter into arrangements with the governments of foreign states for the mutual protection of inventions. Where this is done any person who has applied for protection in the foreign state obtains, if he applies for a patent in England within seven months from the date of such foreign protection, a priority over other applicants, so that his English patent is ante-dated to the date of the application in the foreign state. A foreign patentee who obtains the advantage of this priority is not, however, permitted to recover damages in respect of any infringement of his patent committed in this country, prior to the actual date of the acceptance of his complete specification.

The provisions of Section 103, however, are only operative in respect of those foreign states to which the Queen by Order in Council makes them applicable, and only so long as such order continues in force.

This section was enacted with the object of enabling the English government to take advantage of the International agreement for the protection of industrial property signed at Paris on the 20th of March, 1883. (*a*)

Her Majesty's Government acceded to this convention on behalf of the United Kingdom on the 17th of March, 1884, (*b*) and such accession was duly accepted on the 2nd of April, 1884.

By Order in Council dated the 7th of July, 1884, the provisions of Section 103 of the Patents Act, 1883, were made applicable to

(*a*) See *Carter Medicine Co.'s Trade Mark*, 9 R. P. C. p. 403. The original parties to this agreement were Belgium, Brazil, Spain, France, Guatemala, Italy, Holland, Portugal, Salvador, Servia, and Switzerland.

(*b*) The right of her Majesty to accede subsequently on notice given, on behalf of the Isle of Man, Channel Islands, and any other of her Majesty's possessions being reserved. See Appendix III. post.

the countries at that time parties to the Industrial Union established by the Convention. (*c*)

Under the Convention the subjects of the respective states which are parties thereto (which states form collectively an International Union for the Protection of Industrial Property) enjoy in each state the same advantages as regards patents for inventions as the subjects of that state themselves enjoy under its laws. (*d*)

Any person who has applied for a patent in any one of the states of the Union becomes entitled to a right of priority in respect of the same invention in the other continental states of the Union during a period of six months and in states of the Union beyond sea during seven months. (*e*)

The protection thus afforded enables the patentee to introduce and work his patented invention in any one of the states of the Union during the prescribed period without depriving himself thereby of the right to subsequently take out a patent in such state for that invention. (*f*) But the foreign inventor who so introduces his invention is bound to work it in accordance with the laws of the country into which it is introduced. (*g*)

The Convention also provides for the temporary protection of patentable inventions shewn at International Exhibitions. (*h*)

In the Convention the word "patents" comprises the various kinds of industrial patents recognized by the legislature of each of the contracting states. (*i*)

Protection of Colonial Inventions.—Letters Patent for the United Kingdom do not give protection beyond the limits of the United Kingdom; her Majesty's Colonial possessions are therefore, so far as regards English patent law, virtually in the position of foreign countries. Hence, provision has been made under the Patents Act, 1883, for the establishment between them and the United Kingdom of the same system of mutual protection in respect of inventions

(*c*) These included Ecuador and Tunis in addition to those above mentioned as original parties. Other Orders in Council have since extended the application of the section to other states. See post, Appendix III.

(*d*) Article II.

(*e*) Article IV.

(*f*) Hence s. 103 of the Patents Act, 1883, provides that the publication or use of the invention in the United Kingdom or the Isle of Man during the seven months of protection allowed by that section shall not invalidate the subsequent letters patent granted thereunder.

(*g*) Article V.

(*h*) Article XI.

(*i*) See Final Protocol, Appendix III. post. The Convention also provides for periodical conferences to revise and perfect the Union system; and for the establishment of an International office and staff in Switzerland.

as may exist under the International Convention between the mother country and foreign states.

By Section 104 it is enacted that where it is made to appear to her Majesty that the legislature of any British possession has made satisfactory provision for the protection of inventions patented in the United Kingdom, it shall be lawful for her Majesty from time to time, by Order in Council, to apply the provisions of Section 103 of the Patents Act, 1883, with such variations or additions as to her Majesty in Council may seem fit, to such British possession. Such order when made takes effect as if it were a part of the Act, but may be revoked by the Queen in Council.

Thus, the procedure described hereafter as applicable to the case of a foreign inventor who is entitled to apply for an English patent under Section 103 applies equally to a Colonial inventor who resides in any British possession to which the Queen by Order in Council has extended the application of that section.

Foreign Applications—How Made.—A foreign inventor who has applied for protection of his invention in one of the states of the International Union created under the Convention, must, if he desires to enjoy in the United Kingdom the special protection and priority afforded by the provisions of Section 103, apply for his English letters patent under that section, otherwise he will lose the benefit of that seven months' protection which the section affords, and will not be entitled to have his grant antedated to the date of his foreign application. (*j*)

Applications under this section are governed by special provisions contained in the Patents Rules, 1890, under the heading, "International and Colonial Arrangements." These, so far as they vary the practice on ordinary applications, (*k*) will now be detailed.

Every application for letters patent under Section 103 must contain a declaration as to the making of the foreign application, and specify the foreign states or British possessions in which foreign applications have been made, and the official date or dates thereof respectively. (*l*)

The application must be made within seven months from the date of the first foreign application, (*m*) and must be signed by

(*j*) See *British Training Co.* v. *Groth*, 8 R. P. C. 122.

(*k*) See ante, p. 280, chap. xiv.

(*l*) P. R. rule 25.

(*m*) Where a foreign applicant had abandoned his original application in the foreign country, and subsequently obtained protection there on a renewed application, Webster, A.G., held that the period of seven months ran from the date of such

the person or persons by whom such foreign application was made. (*n*)

If such person, or any of such persons, be dead, it must be signed by the legal personal representative of such dead person, as well as by the other applicants, if any. (*o*)

A foreign corporation may apply under Section 103. Indeed, if the foreign patent has been taken out by a corporation, such corporation is the only possible applicant, for the application must be made by the foreign patentee, and cannot be made by an agent. (*p*)

The application must be made on Form A^2 in the second schedule to the Patents Rules, 1890. (*q*)

In addition to the specification, provisional or complete, the applicant must also leave at the Patent Office: (1) a copy or copies of the specification and drawings, or documents corresponding thereto, filed or deposited by the applicant in the Patent Office of the foreign state or British possession in respect of the first foreign application, duly certified by the official chief or head of the Patent Office of such foreign state or British possession, or otherwise verified to the satisfaction of the Comptroller; (2) a statutory declaration as to the identity of the invention in respect of which the first foreign application was made, and if the specification or document corresponding thereto be in a foreign language, a translation thereof must be annexed to and verified by such declaration. (*r*)

The comptroller, on receipt of the application and the prescribed documents, is required to make an entry of the applications in both countries, and of their respective official dates. (*s*) Thereafter, all further proceedings in connection with the application must be taken within the times and in the manner prescribed by the Acts or Rules for ordinary applications. (*t*)

The patent is entered in the Register of Patents as dated of the date on which the first foreign application was made, and the payment of renewal fees and the expiration of the patent are reckoned as from the date of the first foreign application. (*u*)

renewed application, on its being shewn that the prior application had been entirely abortive: *Van de Poele's Patent*, 7 R. P. C. 69.

(*n*) Ibid.

(*o*) Ibid.

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

(*q*) P. R. rule 26.

(*r*) P. R. rule 26.

(*s*) P. R. rule 27.

(*t*) P. R. rule 28; Patents Act, 1883, s. 103 (3).

(*u*) P. R. rule 29.

Privileges conferred by Section 103 those of Priority only.—While enabling the Crown to accede to the International Convention, Section 103 of the Patents Act, 1883, gives the foreign inventor a right of priority only in the date of his letters patent: it does not enable a foreigner to patent any invention in the United Kingdom which is not good subject-matter according to English law. (*v*)

Nor does the circumstance that the patent granted to the foreigner under the section has been ante-dated entitle such foreigner to oppose an English applicant on the ground that the invention has been patented by the opponent on an application of prior date, when an ordinary applicant would not have such *locus standi*. For the right to oppose in such case depends on the priority of the application, not of the grant, and the ante-dating of the grant under the section does not also ante-date the application of the foreign patentee.

Thus, in *Everitt's Patent*, (*w*) foreign patentees who applied on the 8th of October, 1886, and obtained a grant ante-dated to the 18th of August, 1886, were held to have no *locus standi* in the case of an application dated the 20th of August, 1886, to oppose on the ground that the invention had been patented on an application of prior date.

The mere circumstance that the state of which the foreign applicant is a citizen only acceded to the Convention at a date later than the date of the applicant's foreign patent, will not deprive such applicant of his right to have his English patent ante-dated, provided an Order in Council has applied Section 103 to that state prior to his application in England. (*x*) This of course, assumes that the English application is made within the prescribed seven months.

No Jurisdiction to Impose Terms.—The Comptroller-General and the Law Officer have no jurisdiction to impose terms upon an applicant under Section 103. Provided he is qualified to apply under the section, he is entitled to have his letters patent ante-dated, no matter how third parties may be affected thereby. (*y*)

As a patent under Section 103 can only be granted to the

(*v*) *Carter Medicine Co.'s Trade Mark*, 9 R. P. C. 401.

(*w*) Griff. A. P. C. 28. See, also, *L'Oiseau & Pierrard's Application*, Griff. A. P. C. 36.

(*x*) *Main's Patent*, 7 R. P. C. 13.

(*y*) *L'Oiseau & Pierrard*, Griff. A. P. C. 36; *Main's Patent*, 7 R. P. C. p. 15 *Quære*, whether terms might be imposed where the foreign applicant had been guilty of bad faith (per Webster, A.G.).

person who has obtained protection abroad, the priority given by this section has no application to an applicant who seeks letters patent for an invention communicated from abroad, the object of the section being to encourage foreign inventors to themselves apply for protection, and work their inventions, in the United Kingdom. (*z*)

(*z*) *Shallenberger's Application*, 6 R. P. C. 550.

APPENDICES.

APPENDIX I.

STATUTES RELATING TO LETTERS PATENT FOR INVENTIONS.

THE STATUTE OF MONOPOLIES, 1623.

(21 Jac. I. c. 3.)

***An Act concerning Monopolies and Dispensations with Penal Laws and the Forfeitures thereof.* (a)**

"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

The king's declaration against monopolies and grants of penalties and dispensations.

(a) The side notes for this Statute are those given in the edition of the Statutes of the Realm, printed by command of George III. in 1819. The spelling in the text has been modernized.

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published as aforesaid." For avoiding whereof, and preventing of the like in time to come, may it please your most excellent Majesty, at the humble suit of the Lords spiritual and temporal, and the Commons, in this present Parliament assembled, that it may be declared and enacted, and be it declared and enacted, by authority of this present Parliament, that all monopolies and all commissions, grants, licenses, 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 license or toleration to do, use, or exercise, any thing against the tenor or purport of any law or Statute, or to give or make any warrant for any such dispensation, license, or toleration to be had or made; or to agree or compound with any others for any penalty or forfeiture limited by any Statute; or of any grant or promise of the benefit, profit, or commodity of any forfeiture, penalty, or sum of money, that is or shall be due by any Statute, before judgment thereupon had; and all proclamations, inhibitions, restraints, warrants of assistance, and all other matters and things whatsoever any way tending to the instituting, erecting, strengthening, furthering, or countenancing of the same, or any of them, are altogether contrary to the laws of this realm, and so are and shall be utterly void and of none effect, and in nowise to be put in use or execution.

All monopolies and grants, etc., thereof, or of dispensations and penalties declared void.

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

Validity of all monopolies and of all such grants, etc., shall be tried by the common law.

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

All persons disabled to use such grants, monopolies, etc.

liberty, power or faculty, grounded or pretended to be grounded upon them or any of them.

Party aggrieved by any monopoly or grant, etc., shall recover treble damages by action in the superior Courts with double costs.

4. And be it further enacted by the authority aforesaid, that if any person or persons, at any time after the end of forty days next after the end of this present session of Parliament, shall be hindered, grieved, disturbed, or disquieted, or his or their goods or chattels any way seized, attached, distrained, taken, carried away, or detained, by occasion or pretext of any monopoly, or of any such commission, grant, license, power, liberty, faculty, letters patent, proclamation, inhibition, restraint, warrant of assistance or other matter or thing tending as aforesaid, and will sue to be relieved in or for any of the premises; that then, and in every such case, the same person and persons shall and may have his and their remedy for the same at the common law, by any action or actions, to be grounded upon this Statute; the same action and actions to be heard and determined in the Courts of King's Bench, Common Pleas, and Exchequer, or in any of them, against him or them, by whom he or they shall be so hindered, grieved, disturbed, or disquieted, or against him or them by whom his or their goods or chattels shall be so seized, attached, distrained, taken, carried away, or detained; wherein all and every such person and persons, which shall be so hindered, grieved, disturbed, or disquieted, or whose goods or chattels shall be so seized, attached, distrained, taken, carried away, or detained, shall recover three times so much as the damages which he or they sustained by means or occasion of being so hindered, grieved, disturbed, or disquieted, or by means of having his or their goods or chattels seized, attached, distrained, taken, carried away, or detained, and double costs; and in such suits, or for the staying or delaying thereof, no essoin, protection, wager of law, aid-prayer, privilege, injunction, or order of restraint, shall be in any wise prayed, granted, admitted, or allowed, nor any more than one imparlance: And if any person or persons shall, after notice given, that the action depending is grounded upon this Statute, cause or procure any action at the common law, grounded upon this Statute, to be stayed or delayed before judgment, by colour or means of any order, warrant, power or authority, save only of the Court wherein such actions as aforesaid shall be brought and depending, or after judgment had upon such action, shall cause or procure the execution of or upon any such judgment to be stayed or delayed by colour or means of any order, warrant, power,

Penalty on unduly delaying any such action, etc., praemunire under St. 16 Ric. II. c. 5.

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or authority, save only by writ of error or attaint; that then the said person and persons so offending shall incur and sustain the pains, penalties, and forfeitures ordained and provided by the Statute of provision and præmunire made in the sixteenth year of the reign of King Richard the Second.

Proviso for existing letters patent for twenty-one years or less for new inventions.

5. *Provided nevertheless, and be it declared and enacted, that any declaration before mentioned shall not extend to any letters patent and grants of privilege for the term of one and twenty years or under, heretofore made, of the sole working or making of any manner of new manufacture within this realm, to the first and true inventor or inventors of such manufactures, which others at the time of the making of such letters patent and grants did not use, so they be not contrary to the law nor mischievous to the State, by raising of the prices of commodities at home, or hurt of trade, or generally inconvenient, but that the same shall be of such force as they were or should be if this Act had not been made, and of none other: and if the same were made for more than one and twenty years, that then the same, for the term of one and twenty years only, to be accounted from the date of the first letters patent and grants thereof made, shall be of such force as they were or should have been if the same had been made but for the term of one and twenty years only, and as if this Act had never been had or made, and of none other.* (*b*)

Proviso for future patents for fourteen years or less, for new inventions.

6. Provided also, and be it declared and enacted, that any declaration before mentioned shall not extend to any letters patent and grants of privilege for the term of fourteen years or under, hereafter to be made, of the sole working or making of any manner of new manufactures within this realm to the true and first inventor and inventors of such manufactures, which others at the time of making such letters patent and grants shall not use, so as also they be not contrary to the law nor mischievous to the State by raising prices of commodities at home, or hurt of trade, or generally inconvenient: The said fourteen years to be accomplished from the date of the first letters patent 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.

Proviso for existing grants by Act of Parliament.

7. Provided also, and it is hereby further intended, declared, and enacted by authority aforesaid, that this Act, or any thing therein contained, shall not in any wise extend or be prejudicial to any grant, or privilege, power, or authority whatsoever,

(*b*) Repealed by S. L. R. Act, 1863 (26 & 27 Vict. c. 125).

heretofore made granted, allowed or confirmed by any Act of Parliament now in force, so long as the same shall so continue in force. Sect. 7.

Proviso for warrants to justices to compound penalties.

8. Provided also, that this Act shall not extend to any warrant or privy seal, made or directed or to be made or directed by his Majesty, his heirs or successors, to the justices of the Courts of the King's Bench or Common Pleas, and barons of the Exchequer, justices of assize, justices of oyer and terminer and gaol-delivery, justices of the peace, and other justices for the time being, having power to hear and determine offences done against any penal statute to compound for the forfeitures of any penal statute depending in suit and question before them, or any of them respectively, after plea pleaded by the party defendant.

Proviso for charters of London and other corporations.

9. Provided also, and it is hereby further intended, declared, and enacted, that this Act, or any thing therein contained, shall not in any wise extend or be prejudicial unto the city of London, or to any city, borough, or town corporate within this realm, for or concerning any grants, charters, or letters patent, to them or any of them, made or granted or for or concerning any custom or customs used by or within them or any of them; or unto any corporation, companies, or fellowships of any art, trade, occupation, or mystery, or to any companies or societies of merchants within this realm, erected for the maintenance, enlargement, or ordering of any trade of merchandise; but that the same charters, customs, corporations, companies, fellowships, and societies, and their liberties, privileges, powers, and immunities, shall be and continue of such force and effect as they were before the making of this Act, and of none other; any thing before in this Act contained to the contrary in any wise notwithstanding.

Proviso for patents concerning printing, saltpetre, gunpowder, ordnance, etc., and grants of offices.

10. *Provided also, and be it enacted, that this Act, or any declaration, provision, disablement, penalty, forfeiture, or other thing before mentioned, shall not extend to any letters patent or grants of privilege heretofore made, or hereafter to be made, of, for or concerning printing, nor to any commission, grant, or letters patent heretofore made or hereafter to be made of, for, or concerning the digging, making, or compounding of saltpetre, or gunpowder, or the casting or making of ordnance, or shot for ordnance, nor to any grant or letters patent heretofore made, or hereafter to be made, of any office or offices heretofore erected, made, or ordained and now in being, and put in execution, other than such offices as have*

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been decried by any his Majesty's proclamation or proclamations: but that all and every the same grants, commissions, and letters patent, and all other matters and things tending to the maintaining, strengthening, and furtherance of the same, or any of them, shall be and remain of the like force and effect, and no other, and as free from the declarations, provisions, penalties, and forfeitures contained in this Act, as if this Act had never been had nor made, and not otherwise. (c)

Proviso for patents, etc., concerning alum-mines.

11. *Provided also, and be it enacted, that this Act, or any declaration, provision, disablement, penalty, forfeiture, or other thing before mentioned, shall not extend to any commission, grant, letters patent, or privilege heretofore made, or hereafter to be made, of, for, or concerning the digging, compounding, or making of alum, or alum-mines: but that all and every the same commissions, grants, letters patents, and privileges, shall be and remain of the like force and effect, and no other, and as free from the declarations, provisions, penalties, and forfeitures contained in this Act, as if the Act had never been had nor made, and not otherwise.* (d)

Proviso for customs, etc., of hoast-men of Newcastle as to coals.

12. *Provided also, and be it enacted, that this Act, or any declaration, provision, penalty, forfeiture, or other thing before mentioned, shall not extend or be prejudicial to any use, custom, prescription, franchise, freedom, jurisdiction, immunity, liberty, or privilege, heretofore claimed, used, or enjoyed by the governors and stewards and brethren of the fellowship of the hoast-men of the town of Newcastle-upon-Tyne, or by the ancient fellowship, guild, or fraternity, commonly called hoast-men, for or concerning the selling, carrying, lading, disposing, shipping, venting, or trading of or for any sea coals, stone coals, or pit coals, forth or out of the haven or river of Tyne, or to any grant made by the said governor and stewards and brethren of the fellowship of the said hoast-men to the late Queen Elizabeth, of any duty or sum of money to be paid for, or in respect of, any such coals as aforesaid: nor to any grants, letters patent, or commission, heretofore granted, or hereafter to be granted, of, for, or concerning the licensing of the keeping of any tavern or taverns; or selling, uttering, or retailing of wines to be drunk or spent in the mansion-house, or houses, or other place in the tenure or occupation of the party or parties so selling or uttering the same; or for or concerning the making of any compositions for such licenses, so as the benefit of such compositions be reserved and applied to and for the use of his Majesty, his heirs or successors, and not to the private use of any person or persons.* (e)

Licenses for taverns, etc.

(c) Repealed Patents Act, 1883 (46 & 47 Vict c. 57), s. 113. (d) Ibid. (e) Ibid.

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13. Provided also, and be it enacted, that this Act, or any declaration, provision, penalty, forfeiture, or other thing, before mentioned, shall not extend or be prejudicial to a grant or privilege for or concerning the making of glass, by his Majesty's letters patent under the Great Seal of England, bearing date the two-and-twentieth day of May, in the one-and-twentieth year of his Majesty's reign of England, made and granted to Sir Robert Mansell, Knight, Vice-Admiral of England: nor to a grant or letters patent, bearing date the twelfth of June, in the thirteenth year of his Majesty's reign of England, made to James Maxewell, Esquire, concerning the transportation of calves' skins: but that the said several letters patent last mentioned, shall be and remain of the like force and effect, and as free from the declarations, provisions, penalties, and forfeitures before mentioned, as if this Act had never been had nor made, and not otherwise.

Proviso for grants for glass making.

Exportation of calves' skins.

14. Provided also, and be it declared and enacted, that this Act, or any declaration, provision, penalty, forfeiture, or other thing before mentioned, shall not extend or be prejudicial to a grant or privilege for or concerning the making of smalt, by his Majesty's letters patent under the Great Seal of England, bearing date the sixteenth day of February, in the sixteenth year of his Majesty's reign of England, made or granted to Abraham Baker; nor to a grant or privilege for or concerning the melting of iron ewer, and of making the same into cast-works or bars with sea coals or pit coals, by his Majesty's letters patent, under the Great Seal of England, bearing date the twentieth day of February, in the nineteenth year of his Majesty's reign of England, made or granted to Edward Lord Dudley; but that the same several letters patent and grants shall be and remain of the like force and effect, and as free from the declarations, provisions, penalties, and forfeitures before mentioned, as if this Act had never been had nor made, and not otherwise.

Proviso for grants for making smalt.

Melting iron ore.

THE PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.

46 AND 47 VICT. c. 57.

An Act to amend and consolidate the Law relating to Patents for Inventions, Registration of Designs and of Trade Marks.

[25th August, 1883.]

BE IT ENACTED, by the Queen's most excellent Majesty, by and with the advice and consent of the Lords spiritual and temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows: (*a*)

PART I.

PRELIMINARY.

Short title.

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

Division of Act into parts.

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

Part I.—PRELIMINARY.
II.—PATENTS.
III.—DESIGNS.
IV.—TRADE MARKS.
V.—GENERAL.

Commencement of Act.

3. This Act, except where it is otherwise expressed, shall commence from and immediately after the thirty-first day of December, one thousand eight hundred and eighty-three.

(*a*) The provisions of the Amending Patents Acts (1885–1888), so far as they relate to letters patent for inventions, are here incorporated with this, the principal Act; and distinguished by the use of heavier type.

PART II.

PATENTS.

Application for and Grant of Patent.

Persons entitled to apply for patent.

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

Power to grant patents to several persons jointly.

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

Whereas doubts have arisen whether under the principal Act a patent may lawfully be granted to several persons jointly, some or one of whom only are or is the true and first inventors or inventor; be it therefore enacted and declared that it has been and is lawful under the principal Act to grant such a patent. (*b*)

Application and specification.

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

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

The declaration may be either a statutory declaration under the Statutory Declarations Act, 1835, or not, as may be from time to time prescribed. (*c*)

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

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

The same drawings may accompany both specifications.

The requirement of this sub-section as to drawings shall not be deemed to be insufficiently complied with by reason only that instead of being accompanied by drawings the complete specification refers to the drawings which accompanied the provisional specification. And no patent heretofore sealed shall be invalid by reason only

(*b*) This further provision was enacted by the Patent Act, 1885, s. 5, which see, post.

(*c*) Added by the Patent Act, 1885, s. 2.

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that the complete specification was not accompanied by drawings, but referred to those which accompanied the provisional specification. (*d*)

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

Reference of application to examiner.

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

Power for comptroller to refuse application or require amendment.

[**7.** (1) *If the examiner reports that the nature of the invention is not fairly described, or that the application, specification, or drawings has not or have not been prepared in the prescribed manner, or that the title does not sufficiently indicate the subject-matter of the invention, the comptroller may require that the application, specification, or drawings be amended before he proceeds with the application.*

(2) *Where the comptroller requires an amendment, the applicant may appeal from his decision to the law officer.*

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

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

(5) *If after an application has been made, but before a patent has been sealed, an application is made accompanied by a specification bearing the same or a similar title, it shall be the duty of the examiner to report to the comptroller whether the specification appears to him to comprise the same invention; and, if he reports in the affirmative, the comptroller shall give notice to the applicants that he has so reported.*

(6) *Where the examiner reports in the affirmative, the comptroller may determine, subject to an appeal to the law officer, whether the invention comprised in both applications is the same, and if so he may refuse to seal a patent on the application of the second applicant.*] (*e*)

Power of comptroller to refuse application or require amendment.

"7. (1) If the examiner reports that the nature of the invention

(*d*) Added by the Patents Act, 1886, s. 6.

(*e*) Repealed Patents Act, 1888, ss. 2, 27.

is not fairly described, or that the application, specification, or drawings has not or have not been prepared in the prescribed manner, or that the title does not sufficiently indicate the subject-matter of the invention, the comptroller may refuse to accept the application, or require that the application, specification, or drawings be amended before he proceeds with the application; and in the latter case the application shall, if the comptroller so directs, bear date as from the time when the requirement is complied with.

Appeal to law officer.

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

Hearing by law officer.

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

Notice of acceptance.

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

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

Time for leaving complete specification.

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

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

Comparison of provisional and complete specification.

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

(2) If the examiner reports that the conditions hereinbefore contained have not been complied with, the comptroller may

(*f*) This section was substituted for the above original section 7, by the Patents Act, 1888, s. 2.

(*g*) This time may be extended by the comptroller for a period not exceeding one month: see Patent Act, 1885, s. 3, and s. 12, infra.

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refuse to accept the complete specification unless and until the same shall have been amended to his satisfaction; but any such refusal shall be subject to appeal to the law officer.

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

(4) Unless a complete specification is accepted within twelve months from the date of application, then (save in the case of an appeal having been lodged against the refusal to accept) the application shall, at the expiration of those twelve months, become void. (*h*)

(5) Reports of examiners shall not in any case be published or be open to public inspection, and shall not be liable to production or inspection in any legal proceeding [*other than an appeal to the law officer under this Act*], unless the Court or officer having powar to order discovery in such legal proceeding shall certify that such production or inspection is desirable in the interests of justice, and ought to be allowed. (*hh*)

Advertisement on acceptance of complete specification.

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

Opposition to grant of patent.

11. (1) Any person may at any time within two months from the date of the advertisement of the acceptance of a complete specification give notice at the Patent Office of opposition to the grant of the patent on the ground of the applicant having obtained the invention from him, or from a person of whom he is the legal representative, or on the ground that the invention has been patented in this country on an application of prior date [*or on the ground of an examiner having reported to the comptroller that the specification appears to him to comprise the same invention as is comprised in a specification bearing the same or a similar title, and accompanying a previous application*], or on the ground that the complete specification describes or claims an invention other than that described in the provisional specification, and that such other invention forms the subject of an application made by the opponent in the interval

(*h*) The time for accepting a complete specification may be extended for a period not exceeding three months: see Patent Act, 1885, ss. 3 and 12.

(*hh*) Words in italics repealed, the Patents Act, 1888, s. 3.

between the leaving of the provisional specification and the leaving of the complete specification, but on no other ground. (*i*)

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

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

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

Sealing of patent.

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

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

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

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

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

Extension of time for leaving and accepting complete specification and sealing.

A complete specification may be left and accepted within such extended times, not exceeding one month and three months respectively after the said nine and twelve months respectively, as the comptroller may on payment of the prescribed fee allow, and where such extension of time has been allowed, a further extension of four months after the said fifteen months shall be allowed for the sealing of the patent;

(*i*) The words in italics were repealed, and the words in the heavier type, enacted in lieu of them, by the Patents Act, 1888, s. 4.

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and the principal Act shall have effect as if any time so allowed were added to the said periods specified in the principal Act. (*j*)

Date of patent.

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

Specifications, etc., not to be published unless application accepted.

Where an application for a patent has been abandoned, or become void, the specification or specifications and drawings (if any) accompanying or left in connection with such application, shall not at any time be open to public inspection or be published by the comptroller. (*k*)

Provisional Protection.

Provisional protection.

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

Protection by Complete Specification.

Effect of acceptance of complete specification.

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

Patent.

Extent of patent.

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

Term of patent.

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

(2) But every patent shall, notwithstanding anything therein

(*j*) Enacted by the Patent Act, 1885, s. 3.

(*k*) Enacted by the Patent Act, 1885, s. 4.

or in this Act, cease if the patentee fails to make the prescribed payments within the prescribed times.

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

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

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

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

Amendment of Specification.

Amendment of specification.

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

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

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

(4) The law officer shall, if required, hear the person making the request and the person so giving notice, and being in the opinion of the law officer entitled to be heard in opposition to the request, and shall determine whether and

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subject to what conditions, if any, the amendment ought to be allowed.

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

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

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

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

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

(10) [*The foregoing provisions of this section do not apply when, and so long as any action for infringement or other legal proceeding in relation to a patent is pending.*]

(10) The foregoing provisions of this section do not apply when, and so long as any action for infringement or proceeding for revocation of a patent is pending. (*l*)

Power to disclaim part of invention, during action, etc.

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

Restriction on recovery of damages.

20. Where an amendment by way of disclaimer, correction, or explanation, has been allowed under this Act, no damages shall be given in any action in respect of the use of the invention before the disclaimer, correction, or explanation, unless the patentee establishes to the satisfaction of the Court that his

(*l*) The words in heavier type were substituted for those in italics, by the Patents Act, 1888, s. 5.

original claim was framed in good faith and with reasonable skill and knowledge. Sect. 20.

Advertisement of amendment.

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

Compulsory Licenses.

Power for Board to order grant of licenses.

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

(*a*) The patent is not being worked in the United Kingdom, or

(*b*) The reasonable requirements of the public with respect to the invention cannot be supplied, or

(*c*) Any person is prevented from working or using to the best advantage an invention of which he is possessed,

the Board may order the patentee to grant licenses on such terms as to the amount of royalties, security for payment or otherwise, as the Board, having regard to the nature of the invention and the circumstances of the case, may deem just, and any such order may be enforced by mandamus.

Register of Patents.

Register of Patents.

23. (1) There shall be kept at the Patent Office a book called the Register of Patents, wherein shall be entered the names and addresses of grantees of patents, notifications of assignments and of transmissions of patents, of licenses under patents, and of amendments, extensions, and revocations of patents, and such other matters affecting the validity or proprietorship of patents as may from time to time be prescribed.

(2) The Register of Patents shall be *primâ facie* evidence of any matters by this Act directed or authorized to be inserted therein.

(3) Copies of deeds, licenses, and any other documents affecting the proprietorship in any letters patent or in any license thereunder, must be supplied to the comptroller in the prescribed manner for filing in the Patent Office.

Fees.

Fees in schedule.

24. (1) There shall be paid in respect of the several instruments described in the Second Schedule to this Act, the fees in that schedule mentioned, and there shall likewise be paid, in

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respect of other matters under this part of the Act, such fees as may be from time to time, with the sanction of the Treasury, prescribed by the Board of Trade; and such fees shall be levied and paid to the account of her Majesty's Exchequer in such manner as the Treasury may from time to time direct.

(2) The Board of Trade may from time to time, if they think fit, with the consent of the Treasury, reduce any of those fees.

Extension of Term of Patent.

Extension of term of patent on petition to Queen in Council.

25. (1) A patentee may, after advertising in manner directed by any rules made under this section his intention to do so, present a petition to her Majesty in Council, praying that his patent may be extended for a further term; but such petition must be presented at least six months before the time limited for the expiration of the patent.

(2) Any person may enter a caveat, addressed to the registrar of the Council at the Council Office, against the extension.

(3) If her Majesty shall be pleased to refer any such petition to the Judicial Committee of the Privy Council, the said Committee shall proceed to consider the same, and the petitioner and any person who has entered a caveat shall be entitled to be heard by himself or by counsel on the petition.

(4) The Judicial Committee shall, in considering their decision, have regard to the nature and merits of the invention in relation to the public, to the profits made by the patentee as such, and to all the circumstances of the case.

(5) If the Judicial Committee report that the patentee has been inadequately remunerated by his patent, it shall be lawful for her Majesty in Council to extend the term of the patent for a further term not exceeding seven, or in exceptional cases fourteen, years; or to order the grant of a new patent for the term therein mentioned, and containing any restrictions, conditions, and provisions that the Judicial Committee may think fit.

(6) It shall be lawful for her Majesty in Council to make, from time to time, rules of procedure and practice for regulating proceedings on such petitions, and subject thereto such proceedings shall be regulated according to the existing procedure and practice in patent matters of the Judicial Committee.

(7) The costs of all parties of and incident to such proceedings shall be in the discretion of the Judicial Committee; and

the orders of the Committee respecting costs shall be enforceable as if they were orders of a division of the High Court of Justice. Sect. 25.

Revocation.

Revocation of patent.

26. (1) The proceeding by scire facias to repeal a patent is hereby abolished.

(2) Revocation of a patent may be obtained on petition to the Court.

(3) 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.

(4) A petition for revocation of a patent may be presented by—

(*a*) The Attorney-General in England or Ireland, or the Lord Advocate in Scotland:

(*b*) Any person authorized by the Attorney-General in England or Ireland, or the Lord Advocate in Scotland:

(*c*) Any person alleging that the patent was obtained in fraud of his rights, or of the rights of any person under or through whom he claims:

(*d*) Any person alleging that he, or any person under or through whom he claims, was the true inventor of any invention included in the claim of the patentee:

(*e*) Any person alleging that he, or any person under or through whom he claims an interest in any trade, business, or manufacture, had publicly manufactured, used, or sold, within this realm, before the date of the patent, anything claimed by the patentee as his invention.

(5) The plaintiff must deliver with his petition particulars of the objections on which he means to rely, and no evidence shall, except by leave of the Court or a judge, be admitted in proof of any objection of which particulars are not so delivered.

(6) Particulars delivered may be from time to time amended by leave of the Court or a judge.

(7) The defendant shall be entitled to begin, and give evidence in support of the patent, and if the plaintiff gives evidence impeaching the validity of the patent the defendant shall be entitled to reply.

(8) Where a patent has been revoked on the ground of fraud,

Sect. 26. the comptroller may, on the application of the true inventor, made in accordance with the provisions of this Act, grant to him a patent in lieu of and bearing the same date as the date of revocation of the patent so revoked, but the patent so granted shall cease on the expiration of the term for which the revoked patent was granted.

Crown.

Patent to bind Crown.

27. (1) A patent shall have to all intents the like effect as against her Majesty the Queen, her heirs and successors, as it has against a subject.

(2) But the officers or authorities administering any department of the service of the Crown may, by themselves, their agents, contractors, or others, at any time after the application, use the invention for the services of the Crown on terms to be before or after the use thereof agreed on, with the approval of the Treasury, between those officers or authorities and the patentee, or, in default of such agreement, on such terms as may be settled by the Treasury after hearing all parties interested.

Legal Proceedings.

Hearing with assessor.

28. (1) In an action or proceeding for infringement or revocation of a patent, the Court may, if it thinks fit, and shall, on the request of either of the parties to the proceeding, call in the aid of an assessor specially qualified, and try and hear the case wholly or partially with his assistance; the action shall be tried without a jury unless the Court shall otherwise direct.

(2) The Court of Appeal or the Judicial Committee of the Privy Council may, if they see fit, in any proceeding before them respectively, call in the aid of an assessor as aforesaid.

(3) The remuneration, if any, to be paid to an assessor under this section shall be determined by the Court or the Court of Appeal or Judicial Committee, as the case may be, and be paid in the same manner as the other expenses of the execution of this Act.

Delivery of particulars.

29. (1) In an action for infringement of a patent the plaintiff must deliver with his statement of claim, or by order of the Court or the judge, at any subsequent time, particulars of the breaches complained of.

(2) The defendant 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. Sect. 29.

(3) If the defendant disputes the validity of the patent, the particulars delivered by him must state on what grounds he disputes it, and if one of those grounds is want of novelty, must state the time and place of the previous publication or user alleged by him.

(4) At the hearing no evidence shall, except by leave of the Court or a judge, be admitted in proof of any alleged infringement or objection of which particulars are not so delivered.

(5) Particulars delivered may be from time to time amended, by leave of the Court or a judge.

(6) On taxation of costs, regard shall be had to the particulars delivered by the plaintiff and by the defendant; and they respectively shall not be allowed any costs in respect of any 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.

Order for inspection, etc., in action.

30. In an action for infringement of a patent, the Court or a judge may on the application of either party make such order for an injunction, inspection, or account, and impose such terms and give such directions respecting the same and the proceedings thereon as the Court or a judge may see fit.

Certificate of validity questioned and costs thereon.

31. 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.

Remedy in case of groundless threats of legal proceedings.

32. Where any person claiming to be the patentee of an invention, by circulars, and 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

Sect. 32. 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.

Miscellaneous.

Patent for one invention only.

33. Every patent may be in the form in the First Schedule to this Act, and shall be granted for one invention only, but may contain more than one claim; but it shall not be competent for any person in an action or other proceeding to take any objection to a patent on the ground that it comprises more than one invention.

Patent on application of representative of deceased inventor.

34. (1) If a person possessed of an invention dies without making application for a patent for the invention, application may be made by, and a patent for the invention granted to, his legal representative.

(2) Every such application must be made within six months of the decease of such person, and must contain a declaration by the legal representative that he believes such person to be the true and first inventor of the invention.

Patent to first inventor not invalidated by application in fraud of him.

35. A patent granted to the true and first inventor shall not be invalidated by an application in fraud of him, or by provisional protection obtained thereon, or by any use or publication of the invention subsequent to that fraudulent application during the period of provisional protection.

Assignment for particular places.

36. A patentee may assign his patent for any place in or part of the United Kingdom, or Isle of Man, as effectually as if the patent were originally granted to extend to that place or part only.

Loss or destruction of patent.

37. If a patent is lost or destroyed, or its non-production is accounted for to the satisfaction of the comptroller, the comptroller may at any time cause a duplicate thereof to be sealed.

Proceedings and costs before law officer.

38. The law officers may examine witnesses on oath and administer oaths for that purpose under this part of this Act, and may from time to time make, alter, and rescind rules regulating references and appeals to the law officers and the practice and procedure before them under this part of this Act; and in any proceeding before either of the law officers under this part of this Act, the law officer may order costs to be

paid by either party, and any such order may be made a rule of the Court. Sect. 38.

Exhibition at industrial or international exhibition not to prejudice patent rights.

38. The exhibition of an invention at an industrial or international exhibition, certified as such by the Board of Trade, or the publication of any description of the invention during the period of the holding of the exhibition, or the use of the invention for the purpose of the exhibition in the place where the exhibition is held, or the use of the invention during the period of the holding of the exhibition by any person elsewhere, without the privity or consent of the inventor, shall not prejudice the right of the inventor or his legal 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; and

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

Protection of patents and designs exhibited at international exhibitions.

It shall be lawful for her Majesty, by Order in Council, from time to time to declare that sections thirty-nine and fifty-seven of the Patents, Designs, and Trade Marks Act, 1883, or either of those sections, shall apply to any exhibition mentioned in the Order in like manner as if it were an industrial or international exhibition certified by the Board of Trade, and to provide that the exhibitor shall be relieved from the conditions, specified in the said sections, of giving notice to the comptroller of his intention to exhibit, and shall be so relieved either absolutely or upon such terms and conditions as to her Majesty in Council may seem fit. (*m*)

Publication of illustrated journal, indexes, etc.

40. (1) The comptroller shall cause to be issued periodically an illustrated journal of patented inventions, as well as reports of patent cases decided by Courts of law, and any other information that the comptroller may deem generally useful or important.

(2) Provision shall be made by the comptroller for keeping on sale copies of such journal, and also of all complete specifications of patents for the time being in force, with their accompanying drawings, if any.

(*m*) The words in heavier type were enacted by the Patents Acts, 1886, s 3, in order to extend this section to industrial and international exhibitions held out of the United Kingdom: see that Act, infra.

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(3) The comptroller shall continue, in such form as he may deem expedient, the indexes and abridgments of specifications hitherto published, and shall from time to time prepare and publish such other indexes, abridgments of specifications, catalogues, and other works relating to inventions, as he may see fit.

Patent museum.

41. The control and management of the existing Patent Museum, and its contents shall, from and after the commencement of this Act, be transferred to and vested in the Department of Science and Art, subject to such directions as her Majesty in council may see fit to give.

Power to require models on payment.

42. The Department of Science and Art may at any time require a patentee to furnish them with a model of his invention on payment to the patentee of the cost of the manufacture of the model; the amount to be settled, in case of dispute, by the Board of Trade.

Foreign vessels in British waters.

43. (1) A patent shall not prevent the use of an invention for the purposes of the navigation of a foreign vessel within the jurisdiction of any of her Majesty's Courts in the United Kingdom, or Isle of Man, or the use of an invention in a foreign vessel within that jurisdiction, 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 Isle of Man.

(2) But this section shall not extend to vessels of any foreign state of which the laws authorize subjects of such foreign state, having patents or like privileges for the exclusive use 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 Courts, 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.

Assignment to Secretary for War of certain inventions.

44. (1) The inventor of any improvement in instruments or munitions of war, his executors, administrators, or assigns (who are in this section comprised in the expression the inventor) may (either for or without valuable consideration) assign to her Majesty's Principal Secretary of State for the War Department (hereinafter referred to as the Secretary of State), on behalf of her Majesty, all the benefit of the invention and of any patent obtained or to be obtained for the same; and the Secretary of State may be a party to the assignment.

Sect. 44.

(2) The assignment shall effectually vest the benefit of the invention and patent in the Secretary of State for the time being on behalf of her Majesty, and all covenants and agreements therein contained for keeping the invention secret and otherwise shall be valid and effectual (notwithstanding any want of valuable consideration), and may be enforced accordingly by the Secretary of State for the time being.

(3) Where any such assignment has been made to the Secretary of State, he may at any time before the application for a patent for the invention, or before publication of the specification or specifications, certify to the comptroller his opinion that, in the interest of the public service, the particulars of the invention and of the manner in which it is to be performed should be kept secret.

(4) If the Secretary of State so certifies, the application and specification or specifications with the drawings (if any), and any amendment of the specification or specifications, and any copies of such documents and drawings, shall, instead of being left in the ordinary manner at the Patent Office, be delivered to the comptroller in a packet sealed by authority of the Secretary of State.

(5) Such packet shall, until the expiration of the term or extended term during which a patent for the invention may be in force, be kept sealed by the comptroller, and shall not be opened save under the authority of an order of the Secretary of State, or of the law officers.

(6) Such sealed packet shall be delivered at any time during the continuance of the patent to any person authorized by writing under the hand of the Secretary of State to receive the same, and shall if returned to the comptroller be again kept sealed by him.

(7) On the expiration of the term or extended term of the patent, such sealed packet shall be delivered to any person authorized by writing under the hand of the Secretary of State to receive it.

(8) Where the Secretary of State certifies as aforesaid, after an application for a patent has been left at the Patent Office, but before the publication of the specification or specifications, the application, specification or specifications, with the drawings (if any), shall be forthwith placed in a packet sealed by authority of the comptroller, and such packet shall be subject to the foregoing provisions respecting a packet sealed by authority of the Secretary of State.

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(9) No proceeding by petition, or otherwise, shall lie for revocation of a patent granted for an invention in relation to which the Secretary of State has certified as aforesaid.

(10) No copy of any specification, or other document or drawing by this section required to be placed in a sealed packet, shall in any manner whatever be published or open to the inspection of the public, but save as in this section otherwise directed, the provisions of this part of this Act shall apply in respect of any such invention and patent as aforesaid.

(11) The Secretary of State may, at any time by writing under his hand, waive the benefit of this section with respect to any particular invention, and the specifications, documents, and drawings shall be thenceforth kept and dealt with in the ordinary way.

(12) The communication of any invention for any improvement in instruments or munitions of war to the Secretary of State, or to any person or persons authorized by him to investigate the same or the merits thereof, shall not, nor shall anything done for the purposes of the investigation, be deemed use or publication of such invention so as to prejudice the grant or validity of any patent for the same.

Existing Patents.

Provisions respecting existing patents.

45. (1) The provisions of this Act relating to applications for patents and proceedings thereon shall have effect in respect only of applications made after the commencement of this Act.

(2) Every patent granted before the commencement of this Act, or on an application then pending, shall remain unaffected by the provisions of this Act relating to patents binding the Crown, and to compulsory licenses.

(3) In all other respects (including the amount and time of payment of fees) this Act shall extend to all patents granted before the commencement of this Act, or on applications then pending, in substitution for such enactments as would have applied thereto if this Act had not been passed.

(4) All instruments relating to patents granted before the commencement of this Act required to be left or filed in the Great Seal Patent Office shall be deemed to be so left or filed if left or filed before or after the commencement of this Act in the Patent Office.

Definitions. Sect. 46.

Definitions of patent, patentee, and invention.

46. In and for the purposes of this Act—

"Patent" means letters patent for an invention:

"Patentee" means the person for the time being entitled to the benefit of a patent:

"Invention" means any manner of new manufacture the subject of letters patent and grant of privilege within section six of the Statute of Monopolies (that is, the Act of the twenty-first year of the reign of King James the First, chapter three, intituled "An Act concerning monopolies and dispensations with penal laws and the forfeiture thereof"), and includes an alleged invention.

In Scotland "injunction" means "interdict."

PART V. (*n*)

GENERAL.

Patent Office and Proceedings thereat.

Patent Office.

82. (1) The Treasury may provide for the purposes of this Act an office with all requisite buildings and conveniences, which shall be called, and is in this Act referred to as, the Patent Office.

(2) Until a new Patent Office is provided, the offices of the Commissioners of Patents for inventions and for the registration of designs and trade marks existing at the commencement of this Act shall be the Patent Office within the meaning of this Act.

(3) The Patent Office shall be under the immediate control of an officer called the comptroller-general of patents, designs, and trade marks, who shall act under the superintendence and direction of the Board of Trade.

(4) Any act or thing directed to be done by or to the comptroller may, in his absence, be done by or to any officer for the time being in that behalf authorized by the Board of Trade.

Officers and Clerks.

83. (1) The Board of Trade may at any time after the

(*n*) Part III. (Secs. 47–61) and Part IV. (Secs. 62–81), which relate respectively to designs and trade marks, are here omitted.

Sect. 83. passing of this Act, and from time to time, subject to the approval of the Treasury, appoint the comptroller-general of patents, designs, and trade marks, and so many examiners and other officers and clerks with such designations and duties as the Board of Trade think fit, and may from time to time remove any of those officers and clerks.

(2) The salaries of those officers and clerks shall be appointed by the Board of Trade, with the concurrence of the Treasury, and the same and the other expenses of the execution of this Act shall be paid out of money provided by Parliament.

Seal of patent office.

84. There shall be a seal for the Patent Office, and impressions thereof shall be judicially noticed and admitted in evidence.

Trust not to be entered in registers.

85. There shall not be entered in any register kept under this Act, or be receivable by the comptroller, any notice of any trust expressed, implied, or constructive.

Refusal to grant patent, etc., in certain cases.

86. The comptroller may refuse to grant a patent for an invention, or to register a design or trade mark, of which the use would, in his opinion, be contrary to law or morality.

Entry of assignments and transmissions in registers.

87. Where a person becomes entitled by assignment, transmission, or other operation of law to a patent, or to the copyright in a registered design, or to a registered trade mark, the comptroller shall on request, and on proof of title to his satisfaction, cause the name of such person to be entered as proprietor of the patent, copyright in the design, or trade mark, in the register of patents, designs, or trade marks, as the case may be. The person for the time being entered in the register of patents, designs, or trade marks, as proprietor of a patent, copyright in a design, or trade mark as the case may be, shall, subject to the provisions of this Act and to (*o*) any rights appearing from such register to be vested in any other person, have power absolutely to assign, grant licenses as to, or otherwise deal with, the same, and to give effectual receipts for any consideration for such assignment, license, or dealing: Provided that any equities in respect of such patent, design, or trade mark may be enforced in like manner as in respect of any other personal property.

Inspection of and extracts from registers.

88. Every register kept under this Act shall at all convenient times be open to the inspection of the public, subject to the provisions of this Act and to (*p*) such regulations as may be prescribed; and certified copies, sealed with the seal of the

(*o*) Added to this section by the Patents Act, 1888, s. 21.

(*p*) Added to this section by the Patents Act, 1888, s. 22.

Patent Office, of any entry in any such register shall be given to any person requiring the same, on payment of the prescribed fee. Sect. 88.

Sealed copies to be received in evidence.

89. Printed or written copies or extracts, purporting to be certified by the comptroller and sealed with the seal of the Patent Office, of or from patents, specifications, disclaimers, and other documents in the Patent Office, and of or from registers and other books kept there, shall be admitted in evidence in all Courts in her Majesty's dominions, and in all proceedings, without further proof or production of the originals.

Rectification of registers by Court.

90. (1) The Court may, on the application of any person aggrieved by the omission without sufficient cause of the name of any person **or of any other particulars** (*q*) from any register kept under this Act, or by any entry made without sufficient cause in any such register, make such order for making, expunging, or varying the entry, as the Court thinks fit; or the Court may refuse the application; and in either case may make such order with respect to the costs of the proceedings as the Court thinks fit.

(2) The Court may in any proceeding under this section decide any question that it may be necessary or expedient to decide for the rectification of a register, and may direct an issue to be tried for the decision of any question of fact, and may award damages to the party aggrieved.

(3) Any order of the Court rectifying a register shall direct that due notice of the rectification be given to the comptroller.

Power for comptroller to correct clerical errors.

91. The comptroller may, on request in writing accompanied by the prescribed fee—

(*a*) Correct any clerical error in or in connexion with an application for a patent, or for registration of a design or trade mark; or,

(*b*) Correct any clerical error in the name, style, or address of the registered proprietor of a patent, design, or trade mark. (*r*)

Falsification of entries in registers.

93. If any person makes or causes to be made a false entry in any register kept under this Act, or a writing falsely purporting to be a copy of an entry in any such register, or produces or tenders or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false, he shall be guilty of a misdemeanour.

(*q*) Added to this section by the Patents Act, 1888, s. 23.

(*r*) Sub-section (*c*) and sub-section (*d*) (added by the Patents Act, 1888, s. 24) and s. 92 are omitted here as only having reference to trade marks and designs.

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Exercise of discretionary power by comptroller.

94. Where any discretionary power is by this Act given to the comptroller, he shall not exercise that power adversely to the applicant for a patent, or for amendment of a specification, or for registration of a trade mark or design, without (if so required within the prescribed time by the applicant) giving the applicant an opportunity of being heard personally or by his agent.

Power of comptroller to take directions of law officers.

95. The comptroller may, in any case of doubt or difficulty arising in the administration of any of the provisions of this Act, apply to either of the law officers for directions in the matter.

Certificate of comptroller to be evidence.

96. A certificate purporting to be under the hand of the comptroller as to any entry, matter, or thing which he is authorized by this Act, or any general rules made thereunder, to make or do, shall be primâ facie evidence of the entry having been made, and of the contents thereof, and of the matter or thing having been done or left undone.

Applications and notices by post.

97. (1) Any application, notice, or other document authorized or required to be left, made, or given at the Patent Office or to the comptroller, or to any other person under this Act, may be sent by a prepaid letter through the post; and if so sent shall be deemed to have been left, made, or given respectively at the time when the letter containing the same would be delivered in the ordinary course of post.

(2) In proving such service or sending, it shall be sufficient to prove that the letter was properly addressed and put into the post.

Provision as to days for leaving documents at office.

98. Whenever the last day fixed by this Act, or by any rule for the time being in force, for leaving any document or paying any fee at the Patent Office shall fall on Christmas Day, Good Friday, or on a Saturday or Sunday, or any day observed as a holiday at the Bank of England, or any day observed as a day of public fast or thanksgiving, herein referred to as excluded days, it shall be lawful to leave such document or to pay such fee on the day next following such excluded day, or days, if two or more of them occur consecutively.

Declaration by infant, lunatic, etc.

99. If any person is, by reason of infancy, lunacy, or other inability, incapable of making any declaration or doing anything required or permitted by this Act or by any rules made under the authority of this Act, then the guardian or committee (if any) of such incapable person, or if there be none, any person appointed by any Court or judge possessing jurisdiction in

respect of the property of incapable persons, upon the petition of any person on behalf of such incapable person, or of any other person interested in making such declaration or doing such thing, may make such declaration or a declaration as nearly corresponding thereto as circumstances permit, and do such thing in the name and on behalf of such incapable person, and all acts done by such substitute shall for the purposes of this Act be as effectual as if done by the person for whom he is substituted. Sect. 99.

Transmission of certified printed copies of specifications, etc.

100. Copies of all specifications, drawings, and amendments left at the Patent Office after the commencement of this Act, printed for and sealed with the seal of the Patent Office, shall be transmitted to the Edinburgh Museum of Science and Art, and to the Enrolments Office of the Chancery Division in Ireland, and to the Rolls Office in the Isle of Man, within twenty-one days after the same shall respectively have been accepted or allowed at the Patent Office; and certified copies of or extracts from any such documents shall be given to any person requiring the same, on payment of the prescribed fee; and any such copy or extract shall be admitted in evidence in all Courts in Scotland and Ireland and in the Isle of Man without further proof or production of the originals.

Power for Board of Trade to make general rules for classifying goods and regulating business of Patent Office.

101. (1) The Board of Trade may from time to time make such general rules and do such things as they think expedient, subject to the provisions of this Act—

(*a*) For regulating the practice of registration under this Act;

(*b*) For classifying goods for the purposes of designs and trade marks;

(*c*) For making or requiring duplicates of specifications, amendments, drawings, and other documents;

(*d*) For securing and regulating the publishing and selling of copies, at such prices and in such manner as the Board of Trade think fit, of specifications, drawings, amendments, and other documents;

(*e*) For securing and regulating the making, printing, publishing, and selling of indexes to, and abridgments of, specifications and other documents in the Patent Office, and providing for the inspection of indexes and abridgments and other documents;

(*f*) For regulating (with the approval of the Treasury) the presentation of copies of Patent Office publications,

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to patentees and to public authorities, bodies, and institutions at home and abroad;

(g) Generally for regulating the business of the Patent Office and all things by this Act placed under the direction or control of the comptroller or of the Board of Trade.

(2) Any of the forms in the first schedule to this Act may be altered or amended by rules made by the Board as aforesaid.

(3) General rules may be made under this section at any time after the passing of this Act, but not so as to take effect before the commencement of this Act, and shall (subject as hereinafter mentioned) be of the same effect as if they were contained in this Act, and shall be judicially noticed.

(4) Any rules made in pursuance of this section shall be laid before both Houses of Parliament, if Parliament be in session at the time of making thereof, or if not, then as soon as practicable after the beginning of the then next session of Parliament, and they shall also be advertised twice in the official journal to be issued by the comptroller.

(5) If either House of Parliament, within the next forty days after any rules have been so laid before such House, resolve that such rules or any of them ought to be annulled, the same shall after the date of such resolution be of no effect, without prejudice to the validity of anything done in the meantime under such rules or rule, or to the making of any new rules or rule.

Annual reports of comptroller.

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

Proceedings of Board of Trade.

102a. (1) All things required or authorized under this Act to be done by, to, or before the Board of Trade, may be done by, to, or before the President or a secretary or an assistant secretary of the Board.

(2) All documents purporting to be orders made by the Board of Trade and to be sealed with the seal of the Board, or to be signed by a secretary or assistant secretary of the Board, or by any person authorized in that behalf by the President of the Board, shall be

received in evidence, and shall be deemed to be such orders without further proof, unless the contrary is shown. Sect. 102.

(3) A certificate, signed by the President of the Board of Trade, that any order made or act done is the order or act of the Board, shall be conclusive evidence of the fact so certified. (*s*)

International and Colonial Arrangements.

International arrangements for protection of inventions, designs, and trade marks.

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

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

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

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

(3) The application for the grant of a patent, or the registration of a design, or the registration of a trade mark under this

(*s*) This section was added to the Act by the Patents Act, 1888, s. 25.

(*t*) These words were substituted in this Act for the words in italics by the Patents Act, 1885, s. 6.

Sect. 103. section, must be made in the same manner as an ordinary application under this Act: Provided that, in the case of trade marks, any trade mark the registration of which has been duly applied for in the country of origin may be registered under this Act.

(4) The provisions of this section shall apply only in the case of those foreign states with respect to which her Majesty shall from time to time by Order in Council declare them to be applicable, and so long only in the case of each state as the Order in Council shall continue in force with respect to that state.

Provision for Colonies and India.

104. (1) Where it is made to appear to her Majesty that the legislature of any British possession has made satisfactory provision for the protection of inventions, designs, and trade marks, patented or registered in this country, it shall be lawful for her Majesty from time to time by Order in Council to apply the provisions of the last preceding section, with such variations or additions, if any, as to her Majesty in Council may seem fit, to such British possession.

(2) An Order in Council under this Act shall, from a date to be mentioned for the purpose in the Order, take effect as if its provisions had been contained in this Act; but it shall be lawful for her Majesty in Council to revoke any Order in Council made under this Act.

Offences.

Penalty on falsely representing articles to be patented.

105. (1) Any person who represents that any article sold by him is a patented article, when no patent has been granted for the same, or describes any design or trade mark applied to any article sold by him as registered which is not so, shall be liable for every offence on summary conviction to a fine not exceeding five pounds.

(2) A person shall be deemed, for the purpose of this enactment, to represent that an article is patented or a design or a trade mark is registered, if he sells the article with the word "patent," "patented," "registered," or any word or words expressing or implying that a patent or registration has been obtained for the article stamped, engraved, or impressed on, or otherwise applied to, the article.

Penalty on unauthorized assumption of Royal arms.

106. Any person who, without the authority of her Majesty, or any of the Royal family, or of any government department, assumes or uses in connexion with any trade, business, calling,

or profession, the Royal arms, or arms so nearly resembling the same as to be calculated to deceive, in such a manner as to be calculated to lead other persons to believe that he is carrying on his trade, business, calling, or profession by or under such authority as aforesaid, shall be liable on summary conviction to a fine not exceeding twenty pounds. Sect. 106.

Scotland, Ireland, etc.

Saving for Courts in Scotland.

107. In any action for infringement of a patent in Scotland the provisions of this Act, with respect to calling in the aid of an assessor, shall apply, and the action shall be tried without a jury, unless the Court shall otherwise direct, but otherwise nothing shall affect the jurisdiction and forms of process of the Courts in Scotland in such an action or in any action or proceeding respecting a patent hitherto competent to those Courts.

For the purposes of this section "Court of Appeal" shall mean any Court to which such action is appealed.

Summary proceedings in Scotland.

108. In Scotland any offence under this Act declared to be punishable on summary conviction may be prosecuted in the Sheriff Court.

Proceedings for revocation of patent in Scotland.

109. (1) Proceedings in Scotland for revocation of a patent shall be in the form of an action of reduction at the instance of the Lord Advocate, or at the instance of a party having interest, with his concurrence, which concurrence may be given on just cause shown only.

(2) Service of all writs and summonses in that action shall be made according to the forms and practice existing at the commencement of this Act.

Reservation of remedies in Ireland.

110. All parties shall, notwithstanding anything in this Act, have in Ireland their remedies under or in respect of a patent as if the same had been granted to extend to Ireland only.

General saving for jurisdiction of Courts.

111. (1) The provisions of this Act conferring a special jurisdiction on the Court as defined by this Act, shall not, except so far as the jurisdiction extends, affect the jurisdiction of any Court in Scotland or Ireland in any proceedings relating to patents, or to designs, or to trade marks; and with reference to any such proceedings in Scotland, the term "the Court" shall mean any Lord Ordinary of the Court of Session, and the term "Court of Appeal" shall mean either division of the said Court; and with reference to any such proceedings in Ireland, the terms "the Court" and the "Court of Appeal" respectively

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mean the High Court of Justice in Ireland and her Majesty's Court of Appeal in Ireland.

(2) If any rectification of a register under this Act is required in pursuance of any proceeding in a Court in Scotland or Ireland, a copy of the order, decree, or other authority for the rectification, shall be served on the comptroller, and he shall rectify the register accordingly.

112. This Act shall extend to the Isle of Man, and—

Isle of Man.

(1) Nothing in this Act shall affect the jurisdiction of the Courts in the Isle of Man, in proceedings for infringement or in any action or proceeding respecting a patent, design, or trade mark competent to those Courts.

(2) The punishment for a misdemeanour under this Act in the Isle of Man shall be imprisonment for any term not exceeding two years, with or without hard labour, and with or without a fine not exceeding one hundred pounds, at the discretion of the Court.

(3) Any offence under this Act committed in the Isle of Man which would in England be punishable on summary conviction may be prosecuted, and any fine in respect thereof recovered at the instance of any person aggrieved, in the manner in which offences punishable on summary conviction may for the time being be prosecuted.

Repeal, Transitional Provisions, Savings.

Repeal and saving for past operation of repealed enactments, etc.

113. The enactments described in the Third Schedule to this Act are hereby repealed. But this repeal of enactments shall not—

(*a*) Affect the past operation of any of those enactments, or any patent or copyright or right to use a trade mark granted or acquired, or application pending, or appointment made, or compensation granted, or order or direction made or given, or right, privilege, obligation, or liability acquired, accrued, or incurred, or anything duly done or suffered under or by any of those enactments before or at the commencement of this Act; or

(*b*) Interfere with the institution or prosecution of any action or proceeding, civil or criminal, in respect thereof, and any such proceeding may be carried on as if this Act had not been passed; or

(c) Take away or abridge any protection or benefit in relation to any such action or proceeding. (u) Sect. 113.

Former registers to be deemed continued.

114. (1) The registers of patents and of proprietors kept under any enactment repealed by this Act shall respectively be deemed parts of the same book as the register of patents kept under this Act.

(2) The registers of designs and of trade marks kept under any enactment repealed by this Act shall respectively be deemed parts of the same book as the register of designs and the register of trade marks kept under this Act.

Saving for existing rules.

115. All general rules made by the Lord Chancellor or by any other authority under any enactment repealed by this Act, and in force at the commencement of this Act, may at any time after the passing of this Act be repealed, altered, or amended by the Board of Trade, as if they had been made by the Board under this Act, but so that no such repeal, alteration, or amendment shall take effect before the commencement of this Act; and, subject as aforesaid, such general rules shall, so far as they are consistent with and are not superseded by this Act, continue in force as if they had been made by the Board of Trade under this Act.

Saving for prerogative.

116. Nothing in this Act shall take away, abridge, or prejudicially affect the prerogative of the Crown in relation to the granting of any letters patent or to the withholding of a grant thereof.

General Definitions.

General definitions.

117. (1) In and for the purposes of this Act, unless the context otherwise requires—

"Person" includes a body corporate:

"The Court" means (subject to the provisions for Scotland, Ireland, and the Isle of Man) her Majesty's High Court of Justice in England:

"Law Officer" means her Majesty's Attorney-General or Solicitor-General for England:

"The Treasury" means the Commissioners of her Majesty's Treasury:

(u) Referring to the present Statute, the Patents Act, 1888 (s. 27), enacts that the principal Act shall, as from the commencement of this Act, take effect subject to the additions, omissions, and substitutions required by this Act; but nothing in this Act shall affect the validity of any act done, right acquired, or liability incurred before the commencement of this Act. The Patents Act, 1888, came into operation on the 1st of January, 1889 (see s. 28).

Sect. 117.

"Comptroller" means the Comptroller-General of Patents, Designs, and Trade Marks:

"Prescribed" means prescribed by any of the Schedules to this Act, or by general rules under or within the meaning of this Act:

"British possession," means any territory or place situate within her Majesty's dominions, and not being or forming part of the United Kingdom, or of the Channel Islands, or of the Isle of Man, and all territories and places under one legislature, as hereinafter defined, are deemed to be one British possession for the purposes of this Act:

"Legislature" includes any person or persons who exercise legislative authority in the British possession; and where there are local legislatures as well as a central legislature, means the central legislature only.

In the application of this Act to Ireland, "summary conviction" means a conviction under the Summary Jurisdiction Acts, that is to say, with reference to the Dublin Metropolitan Police District the Acts regulating the duties of justices of the peace and of the police for such district, and elsewhere in Ireland the Petty Sessions (Ireland) Act, 1851, and any Act amending it.

THE FIRST SCHEDULE.

FORMS OF APPLICATION, ETC.

Form A. (Form of Application for Patent). (*v*)
Form B. (Form of Provisional Specification). (*w*)
Form C. (Form of Complete Specification). (*x*)

FORM D.

Form of Patent.

Victoria, by the grace of God, of the United Kingdom of Great Britain and Ireland, Queen, Defender of the Faith: To all to whom these presents shall come greeting:

(*v*) This form is now replaced by those provided by the Patent Rules, 1890. See post, pp. 655 and 667–672.

(*w*) Ibid. See post, p. 673

(*x*) Ibid. See post, p. 674.

Schedule: Form of Patent.

Whereas *John Smith of* 29 *Perry Street, Birmingham*, in the County of Warwick, *Engineer*, hath [by his solemn declaration] (*y*) represented unto us that he is in possession of an invention for "*Improvements in Sewing Machines*," that he is the true and first inventor thereof, and that the same is not in use by any other person to the best of his knowledge and belief:

And whereas the said inventor hath humbly prayed that we would be graciously pleased to grant unto him (hereinafter together with his executors, administrators, and assigns, or any of them, referred to as the said patentee) our Royal Letters Patent for the sole use and advantage of his said invention:

And whereas the said inventor hath by and in his complete specification particularly described the nature of his invention:

And whereas we, being willing to encourage all inventions which may be for the public good, are graciously pleased to condescend to his request:

Know ye, therefore, that We, of our especial grace, certain knowledge, and mere motion, do by these presents, for us, our heirs and successors, give and grant unto the said patentee our especial license, full power, sole privilege, and authority, that the said patentee by himself, his agents, or licensees, and no others, may at all times hereafter during the term of years herein mentioned make, use, exercise, and vend the said invention within our United Kingdom of Great Britain and Ireland and Isle of Man, in such manner as to him or them may seem meet, and that the said patentee shall have and enjoy the whole profit and advantage from time to time accruing by reason of the said invention during the term of fourteen years from the date hereunder written of these presents: And to the end that the said patentee may have and enjoy the sole use and exercise and the full benefit of the said invention, We do by these presents for us, our heirs and successors, strictly command all our subjects whatsoever within our United Kingdom of Great Britain and Ireland and the Isle of Man that they do not at any time during the continuance of the said term of fourteen years either directly or indirectly make use of or put in practice the said invention, or any part of the same, nor in anywise imitate the same, nor make or cause to be made any addition thereto or subtraction therefrom, whereby to pretend themselves the

(*y*) A simple declaration is all that is now required in practice of an applicant for Letters Patent: see Patents Act, 1885, s. 2, and the Official Forms annexed to the Patent Rules, 1890, Appendix II. pp. 667–672 post.

Schedule: Form of Patent.

inventors thereof, without the consent, license, or agreement of the said patentee in writing under his hand and seal, on pain of incurring such penalties as may be justly inflicted on such offenders for their contempt of this our Royal command, and of being answerable to the patentee according to law for his damages thereby occasioned: Provided that these our letters patent are on this condition, that if at any time during the said term it be made to appear to us, our heirs or successors, or any six or more of our Privy Council, that this our grant is contrary to law, or prejudicial or inconvenient to our subjects in general, or that the said invention is not a new invention as to the public use and exercise thereof within our United Kingdom of Great Britain and Ireland and Isle of Man, or that the said patentee is not the first and true inventor thereof within this realm as aforesaid, these our letters patent shall forthwith determine, and be void to all intents and purposes, notwithstanding anything hereinbefore contained: Provided also that if the said patentee shall not pay all fees by law required to be paid in respect of the grant of these letters patent or in respect of any matter relating thereto at the time or times, and in manner for the time being by law provided; and also if the said patentee shall not supply or cause to be supplied, for our service all such articles of the said invention as may be required by the officers or commissioners administering any department of our service in such manner, at such times, and at and upon such reasonable prices and terms as shall be settled in manner for the time being by law provided, then, and in any of the said cases, these our letters patent, and all privileges and advantages whatever hereby granted, shall determine and become void, notwithstanding anything hereinbefore contained: Provided also that nothing herein contained shall prevent the granting of licenses in such manner and for such considerations as they may by law be granted; and lastly, we do by these presents for us, our heirs and successors, grant unto the said patentee that these our letters patent shall be construed in the most beneficial sense for the advantage of the said patentee. In witness whereof we have caused these our letters to be made patent this one thousand, eight hundred and and to be sealed as of the one thousand eight hundred and

Seal of Patent Office.

THE SECOND SCHEDULE.

Schedule: Repeals.

This schedule contained a scale of patent fees, but is omitted here, as it is now superseded by the schedule annexed to the Patents Rules, 1892. See post, pp. 699, 700.

THE THIRD SCHEDULE.

Enactments Repealed.

21 James I. c. 3 ..... [1623.]	The Statute of Monopolies. In part; namely— Sections 10, 11, & 12.
5 & 6 Will. IV. c. 62... [1835.]	The Statutory Declarations Act, 1835. In part; namely— Section 11.
5 & 6 Will. IV. c. 83... [1835.]	An Act to amend the law touching Letters Patent for Inventions.
2 & 3 Vict. c. 67 ..... [1839.]	An Act to amend an Act of the fifth and sixth years of the reign of King William IV., intituled, "An Act to Amend the Law touching Letters Patent for Inventions."
5 & 6 Vict. c. 100 ..... [1842.]	An Act to consolidate and amend the laws relating to the copyright of designs for ornamenting articles of manufacture.
6 & 7 Vict. c. 65 ..... [1843.]	An Act to amend the laws relating to the copyright of designs.
7 & 8 Vict. c. 69 (*z*) ... [1844.]	An Act for amending an Act passed in the fourth year of the reign of his late Majesty, intituled, "An Act for the Better Administration of Justice in his Majesty's Privy Council, and to extend its Jurisdiction and Powers." In part; namely— Sections 2 to 5, both included.
13 & 14 Vict. c. 104... [1850.]	An Act to extend and amend the Acts relating to the copyright of designs.
15 & 16 Vict. c. 83... [1852.]	The Patent Law Amendment Act, 1852.
16 & 17 Vict. c. 5..... [1853.]	An Act to substitute stamp duties for fees on passing letters patent for inventions and to provide for the purchase for the public use of certain indexes of specifications.
16 & 17 Vict. c. 115... [1853.]	An Act to amend certain provisions of the Patent Law Amendment Act, 1852, in respect of the transmission of certified copies of letters patent and specifications to certain offices in Edinburgh and Dublin, and otherwise to amend the said Act.
21 & 22 Vict. c. 70..... [1858.]	An Act to amend the Act of the fifth and sixth years of her present Majesty, to consolidate and amend the laws relating to the copyright of designs for ornamenting articles of manufacture.
22 Vict. c. 13..... [1859.]	An Act to amend the law concerning patents for inventions with respect to inventions for improvements in instruments and munitions of war.

(*z*) Sections 6 & 7 of this Act are repealed by the S. L. R. No. 2 Act, 1874.

Schedule: Repeals.

24 & 25 Vict. c. 73..... [1861.]	An Act to amend the law relating to the copyright of designs.
28 & 29 Vict. c. 3..... [1865.]	The Industrial Exhibitions Act, 1865.
33 & 34 Vict. c. 27..... [1870.]	The Protection of Inventions Act, 1870.
33 & 34 Vict. c. 97..... [1870.]	The Stamp Act, 1870. In part; namely— Section sixty-five, and in the schedule the words and figures— "Certificate of the registration of a design... £5 0 0 And see sect. 65."
38 & 39 Vict. c. 91..... [1875.]	The Trade Marks Registration Act, 1875.
38 & 39 Vict. c. 93..... [1875.]	The Copyright of Designs Act, 1875.
39 & 40 Vict. c. 33..... [1876.]	The Trade Marks Registration Amendment Act, 1876.
40 & 41 Vict. c. 37..... [1877.]	The Trade Marks Registration Extension Act, 1877.
43 & 44 Vict. c. 10..... [1880.]	The Great Seal Act, 1880. In part; namely— Section five.
45 & 46 Vict. c. 72..... [1882.]	The Revenue, Friendly Societies, and National Debt Act, 1882. In part; namely— Section sixteen.

PATENTS, DESIGNS, AND TRADE MARKS (AMENDMENT) ACT, 1885.

(48 & 49 Vict. c. 63.)

An Act to amend the Patents, Designs, and Trade Marks Act, 1883.

[14th August, 1885.]

Be it enacted by the Queen's most excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows—

Construction and short title.

1. This Act shall be construed as one with the Patents, Designs, and Trade Marks Act, 1883 (in this Act referred to as the principal Act).

This Act may be cited as the Patents, Designs, and Trade Marks (Amendment) Act, 1885, and this Act and the principal Act may be cited together as the Patents, Designs, and Trade Marks Acts, 1883 and 1885.

Amendment of sect. 5 of 46 & 47 Vict. c. 57.

2. Whereas sub-section two of section five of the principal Act requires a declaration to be made by an applicant for a patent to the effect in that sub-section mentioned, and doubts have arisen as to the nature of that declaration, and it is expedient to remove such doubts: Be it therefore enacted that—

The declaration mentioned in sub-section two of section five of the principal Act may be either a statutory declaration under the Statutory Declarations Act, 1835, or not, as may be from time to time prescribed.

5 & 6 Will. IV. c. 62.

Amendment of sects. 8, 9, and 12 of 46 & 47 Vict. c. 57.

3. Whereas under the principal Act, a complete specification is required (by section eight) to be left within nine months, and (by section nine) to be accepted within twelve months, from the date of application, and a patent is required by section twelve to be sealed within fifteen months from the date of application, and it is expedient to empower the comptroller to extend in

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certain cases the said times: Be it therefore enacted as follows:—

A complete specification may be left and accepted within such extended times, not exceeding one month and three months respectively after the said nine and twelve months respectively as the comptroller may on payment of the prescribed fee allow, and where such extension of time has been allowed, a further extension of four months after the said fifteen months shall be allowed for the sealing of the patent; and the principal Act shall have effect as if any time so allowed were added to the said periods specified in the principal Act.

Specifications, etc., not to be published unless application accepted.

4. Where an application for a patent has been abandoned, or become void, the specification or specifications and drawings (if any) accompanying or left in connexion with such application, shall not at any time be open to public inspection or be published by the comptroller.

Power to grant patents to several persons jointly.

5. Whereas doubts have arisen whether under the principal Act a patent may lawfully be granted to several persons jointly, some or one of whom only are or is the true and first inventors or inventor; be it therefore enacted and declared that it has been and is lawful under the principal Act to grant such a patent.

Amendment of sect. 103 of 46 & 47 Vict. c. 57.

6. In sub-section one of section one hundred and three of the principal Act, the words "date of the application" shall be substituted for the words "date of the protection obtained."

PATENTS ACT, 1886.

49 & 50 Vict. c. 37.

An Act to remove certain doubts respecting the construction of the Patents, Designs, and Trade Marks Act, 1883, *so far as respects the drawings by which specifications are required to be accompanied, and as respects exhibitions.*

[25th June, 1886.]

Whereas by section five of the Patents, Designs, and Trade Marks Act, 1883, specifications, whether provisional or complete, must be accompanied by drawings if required, and doubts have arisen as to whether it is sufficient that a complete specification refers to the drawings by which the provisional specification was accompanied, and it is expedient to remove such doubts:

Be it therefore enacted by the Queen's most excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows:—

Short title and construction. 46 & 47 Vict. c. 57. 48 & 49 Vict. c. 63.

1. This Act may be cited as the Patents Act, 1886, and shall be construed as one with the Patents, Designs, and Trade Marks Acts, 1883 and 1885, and, together with those Acts, may be cited as the Patents, Designs, and Trade Marks Acts, 1883 to 1886.

The same drawings may accompany both specifications.

2. The requirement of sub-section four of section five of the Patents, Designs, and Trade Marks Act, 1883, as to drawings shall not be deemed to be insufficiently complied with by reason only that instead of being accompanied by drawings the complete specification refers to the drawings which accompanied the provisional specification. And no patent heretofore sealed shall be invalid by reason only that the complete specification was not accompanied by drawings but referred to those which accompanied the provisional specification.

Protection of patents and designs

3. Whereas by section thirty-nine of the Patents, Designs, and Trade Marks Act, 1883, as respects patents, and by section

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exhibited at international exhibitions.

fifty-seven of the same Act as respects designs, provision is made that the exhibition of an invention or design at an industrial or international exhibition, certified as such by the Board of Trade, shall not prejudice the rights of the inventor or proprietor thereof, subject to the conditions therein mentioned, one of which is that the exhibitor must, before exhibiting the invention, design, or article, or publishing a description of the design, give the comptroller the prescribed notice of his intention to do so:—

And whereas it is expedient to provide for the extension of the said sections to industrial and international exhibitions held out of the United Kingdom, be it therefore enacted as follows:—

It shall be lawful for her Majesty by Order in Council, from time to time to declare that sections thirty-nine and fifty-seven of the Patents, Designs, and Trade Marks, Act, 1883, or either of those sections, shall apply to any exhibition mentioned in the Order in like manner as if it were an industrial or international exhibition, certified by the Board of Trade, and to provide that the exhibitor shall be relieved from the conditions, specified in the said sections, of giving notice to the comptroller of his intention to exhibit, and shall be so relieved either absolutely or upon such terms and conditions as to her Majesty in Council may seem fit.

PATENTS, DESIGNS, AND TRADE MARKS ACT, 1888.

(51 & 52 Vict. c. 50.)

An Act to amend the Patents, Designs, and Trade Marks Act, 1883.

[24th December, 1888.]

Whereas it is expedient to amend the Patents, Designs, and Trade Marks Act, 1883, hereinafter referred to as the principal Act: 46 & 47 Vict. c. 57.

Be it therefore enacted by the Queen's most excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows:

Register of patent agents.

1. (1) After the first day of July, one thousand eight hundred and eighty-nine, a person shall not be entitled to describe himself as a patent agent, whether by advertisement, by description on his place of business, by any document issued by him, or otherwise, unless he is registered as a patent agent in pursuance of this Act.

(2) The Board of Trade shall, as soon as may be after the passing of this Act, and may from time to time, make such general rules as are, in the opinion of the Board, required for giving effect to this section, and the provisions of section one hundred and one of the principal Act shall apply to all rules so made as if they were made in pursuance of that section:

(3) Provided that every person who proves to the satisfaction of the Board of Trade that prior to the passing of this Act he had been bonâ fide practising as a patent agent shall be entitled to be registered as a patent agent in pursuance of this Act.

(4) If any person knowingly describes himself as a patent agent in contravention of this section he shall be liable, on summary conviction, to a fine not exceeding twenty pounds.

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(5) In this section "patent agent" means exclusively an agent for obtaining patents in the United Kingdom.

Amendments of 46 & 47 Vict. c. 57.

2. For section seven of the principal Act the following section shall be substituted, namely:—

Sect. 7, as to applications.

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

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

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

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

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

Sect. 9, as to disclosure of reports of examiners.

3. In sub-section five of section nine of the principal Act the words "other than an appeal to the law officer under this Act" shall be omitted.

Sect. 11, as to opposition to grant of patent.

4. In sub-section one of section eleven of the principal Act the words from "or on the ground of an examiner" to "a previous application," both inclusive, shall be omitted, and there shall be added in lieu thereof the following words, namely, "or on the ground that the complete specification describes or claims an invention other than that described in the provisional specification, and that such other invention forms the subject of an

Sect. 4.

application made by the opponent in the interval between the leaving of the provisional specification and the leaving of the complete specification."

Sect. 18, as to amended specifications.

5. For sub-section ten of section eighteen of the principal Act the following sub-section shall be substituted, namely :—

"(10) The foregoing provisions of this section do not apply when and so long as any action for infringement or proceeding for revocation of a patent is pending." (*a*)

Sect. 87, as to entry of assignments, etc.

21. In section eighty-seven of the principal Act, after the words "subject to," shall be added the words "the provisions of this Act and to."

Sect. 88, as to inspection.

22. In section eighty-eight of the principal Act, after the words "subject to" shall be added the words "the provisions of this Act and to."

Sect. 90, as to rectification of register.

23. In section ninety of the principal Act, after the words "of the name of any person," shall be added the words "or of any other particulars."

Sect. 91, as to correction of errors.

24. To section ninety-one of the principal Act the following sub-section shall be added; namely—

"(*d*) Permit an applicant for registration of a design or trade mark to amend his application by omitting any particular goods or classes of goods in connexion with which he has desired the design or trade mark to be registered."

Proceedings of Board of Trade.

25. After section one hundred and two of the principal Act the following section shall be added and numbered 102A; namely—

"(1) All things required or authorized under this Act to be done by, to, or before the Board of Trade, may be done by, to, or before the President or a secretary or an assistant secretary of the Board.

"(2) All documents purporting to be orders made by the Board of Trade and to be sealed with the seal of the Board, or to be signed by a secretary or assistant secretary of the Board, or by any person authorized in that behalf by the President of the Board, shall be received in evidence, and shall be deemed to be such orders without further proof, unless the contrary is shewn.

"(3) A certificate, signed by the President of the Board of

(*a*) Sections six to twenty inclusive of this Act relate to designs or trade marks only, and are here omitted.

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Trade, that any order made or act done is the order or act of the Board, shall be conclusive evidence of the fact so certified."

Jurisdiction of Lancashire Palatine Court.

26. After section one hundred and twelve of the principal Act the following section shall be added and numbered 112A; namely—

"The Court of Chancery of the County Palatine of Lancaster shall, with respect to any action or other proceeding in relation to trade marks the registration whereof is applied for in the Manchester Office, have the like jurisdiction under this Act as her Majesty's High Court of Justice in England, and the expression 'the Court' in this Act shall be construed and have effect accordingly.

"Provided that every decision of the Court of Chancery of the County Palatine of Lancaster in pursuance of this section shall be subject to the like appeal as decisions of that Court in other cases."

Construction of principal Act.

27. The principal Act shall, as from the commencement of this Act, take effect subject to the additions, omissions, and substitutions required by this Act, but nothing in this Act shall affect the validity of any act done, right acquired, or liability incurred before the commencement of this Act.

Commencement of Act.

28. This Act shall, except so far as is by this Act otherwise specially provided, commence and come into operation on the first day of January, one thousand eight hundred and eighty-nine.

Short title.

29. This Act may be cited as the Patents, Designs, and Trade Marks Act, 1888, and this Act and the Patents, Designs, and Trade Marks Acts, 1883 to 1886, may be cited collectively as the Patents, Designs, and Trade Marks Acts, 1883 to 1888.

APPENDIX II.

RULES RELATING TO LETTERS PATENT FOR INVENTIONS.

PATENTS RULES, 1890.

By virtue of the provisions of the Patents, Designs, and Trade Marks Acts, 1883 to 1888, the Board of Trade do hereby make the following Rules:—

Short Title.

1. These Rules may be cited as the Patents Rules, 1890. Short title.

Commencement.

2. These Rules shall come into operation from and immediately after the 31st day of March, 1890. Commencement.

Interpretation.

3. In the construction of these Rules, any words herein used defined by the said Acts shall have the meanings thereby assigned to them respectively. Interpretation.

Fees.

4. The fees to be paid under the above-mentioned Acts shall be those specified in the list of fees in the First Schedule to these Rules. Fees.

Forms.

5. The Forms A, B, and C in the First Schedule to the Act of 1883 shall be altered or amended by the substitution therefor of the Forms A, A1, A2, B, and C in the Second Schedule to these Rules. Forms. Alterations.

6. (1) An application for a patent containing the declaration mentioned in sub-section two of section five of the Act of 1883 and section two of the Act of 1885 shall be made either in the Form A or the Form A1, or the Form A2, set forth in the Second Schedule to these Rules as the case may be. Application.

(2) The Form B in such Schedule of provisional specification and the Form C of complete specification shall respectively be used. Specification.

(3) The remaining forms other than A, A1, A2, B, and C, set Other forms.

Rule 6.

forth in the Second Schedule to these Rules, may, as far as they are applicable, be used in any proceedings under these Rules.

General.

Hours of business.

7. The Patent Office shall be open to the public every weekday between the hours of ten and four, except on the days and times following :—

Christmas Day.
Good Friday.
The day observed as her Majesty's birthday.
The days observed as days of public fast or thanksgiving, or as holidays at the Bank of England.

Agency.

8. *An application for a patent must be signed by the applicant, but all other communications between the applicant and the comptroller and all attendances by the applicant upon the comptroller may be made by or through an agent duly authorized to the satisfaction of the comptroller, and if he so require, resident in the United Kingdom.* (*a*)

Statement of address.

9. The application shall be accompanied by a statement of an address to which all notices, requisitions, and communications of every kind may be made by the comptroller or by the Board of Trade, and such statement shall thereafter be binding upon the applicant unless and until a substituted statement of address shall be furnished by him to the comptroller. He may in any particular case require that the address mentioned in this rule be in the United Kingdom.

Size, etc., of documents.

10. All documents and copies of documents, except statutory declarations and affidavits, sent to or left at the Patent Office or otherwise furnished to the comptroller or to the Board of Trade shall be written or printed in large and legible characters and, unless otherwise directed, in the English language, upon strong wide ruled paper (on one side only), of a size of 13 inches by 8 inches, leaving a margin of two inches on the left-hand part thereof, and the signature of the applicants or agents thereto must be written in a large and legible hand. Duplicate documents shall at any time be left, if required by the comptroller.

Exercise of discretionary power by comptroller.

Notice of hearing.

11. Before exercising any discretionary power given to the comptroller by the said Acts adversely to the applicant for a patent or for amendment of a specification, the comptroller shall give ten days' notice, or such longer notice as he may think fit, to the applicant of the time when he may be heard personally or by his agent before the comptroller. Statutory declarations and affidavits shall be in the form for the time being in use in the High Court of Justice.

Notice by applicant.

12. Within five days from the date when such notice would be delivered in the ordinary course of post, or such longer time as the comptroller may appoint in such notice, the applicant shall notify in writing to the comptroller whether or not he intends to be heard upon the matter.

Comptroller may require statement, etc.

13. Whether the applicant desires to be heard or not, the comptroller may at any time require him to submit a statement in writing within

(*a*) For this rule is now substituted rule 2 of the Patents Rules, 1898, which see post, p. 701.

a time to be notified by the comptroller, or to attend before him and make oral explanations with respect to such matters as the comptroller may require. **Rule 13.**

Decision to be notified to parties.

14. The decision or determination of the comptroller in the exercise of any such discretionary power as aforesaid shall be notified by him to the applicant, and any other person affected thereby.

Industrial or international exhibitions.

15. Any person desirous of exhibiting an invention at an industrial or international exhibition, or of publishing any description of the invention during the period of the holding of the exhibition, or of using the invention for the purpose of the exhibition in the place where the exhibition is held, shall, after the Board of Trade have issued a certificate that the exhibition is an industrial or international one, give to the comptroller notice, in writing, of his intention to exhibit, publish, or use the invention, as the case may be.

For the purpose of identifying the invention in the event of an application for a patent being subsequently made, the applicant 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.

Power of amendment, etc.

16. Any document for the amending of which no special provision is made by the said Acts may be amended, and any irregularity in procedure which, in the opinion of the comptroller may be obviated without detriment to the interests of any person, may be corrected, if and on such terms as the comptroller may think fit.

16A. Any application, notice, or other document authorized or required to be left, made, or given at the Patent Office, or to the comptroller, or to any other person under these Rules, may be sent by a prepaid letter through the post, and if so sent shall be deemed to have been left, made, or given at the time when the letter containing the same would be delivered in the ordinary course of post. In proving such service or sending, it shall be sufficient to prove that the letter was properly addressed and put into the post.

Manner in which, and persons before whom, declaration is to be taken.

17. The statutory declarations required by the said Acts and these Rules, or used in any proceedings thereunder, shall be made and subscribed as follows:—

(*a*) In the United Kingdom, before any justice of the peace, or any commissioner or other officer authorized by law in any part of the United Kingdom to administer an oath for the purpose of any legal proceeding;

(*b*) In any other part of her Majesty's dominions, before any court, judge, justice of the peace, or any officer authorized by law to administer an oath there for the purpose of a legal proceeding; and

(*c*) If made out of her Majesty's dominions, before a British Minister, or person exercising the functions of a British Minister, or a Consul, Vice-Consul, or other person exercising the functions of a British Consul, or a notary public, or before a judge or magistrate.

17A. Statutory declarations and affidavits shall be headed in the matter or matters to which they relate. They shall be divided into paragraphs consecutively numbered, and each paragraph shall, so far as possible, be confined to one subject.

Rule 18.

Application with Provisional or Complete Specification.

Order of recording applications.

18. Applications for patents sent through the post shall, as far as may be practicable, be opened and numbered in the order in which the letters containing the same have been respectively delivered in the ordinary course of post.

Applications left at the Patent Office otherwise than through the post shall be in like manner numbered in the order of their receipt at the Patent Office.

Application for separate patents by way of amendment.

19. Where a person making application for a patent includes therein by mistake, inadvertence, or otherwise, more than one invention, he may, after the refusal of the comptroller to accept such application, amend the same so as to apply to one invention only, and may make application for separate patents for each such invention accordingly.

Every such application shall, if the applicant notify his desire to that effect to the comptroller, bear the date of the first application, and shall, together therewith, be proceeded with in the manner prescribed by the said Acts and by these Rules, as if every such application had been originally made on that date.

Application by representative of deceased inventor.

20. An application for a patent by the legal representative of a person who has died possessed of an invention shall be accompanied by an official copy of or extract from his will, or the letters of administration granted of his estate and effects, in proof of the applicant's title as such legal representative, and must be supported by such further evidence as the comptroller may require.

Notice and advertisement of acceptance.

21. On the acceptance of a provisional or complete specification the comptroller shall give notice thereof to the applicant, and shall advertise such acceptance in the official journal of the Patent Office.

Inspection on acceptance of complete specification.

22. Upon the publication of such advertisement of acceptance in the case of a complete specification, the application and specification or specifications, with the drawings (if any), may be inspected at the Patent Office upon payment of the prescribed fee.

Application on Communication from Abroad.

Communication from abroad.

23. An application for a patent for an invention communicated from abroad shall be made in the form A1 set forth in the Second Schedule to these Rules.

International and Colonial Arrangements.

24. The term "foreign application" shall mean an application by any person for protection of his invention in a foreign State or British Possession to which by any Order of her Majesty in Council for the time being in force the provisions of section 103 of the Patents, Designs, and Trade Marks Act, 1883, have been declared applicable.

25. An application in the United Kingdom for a patent for any invention in respect of which a foreign application has been made shall contain a declaration that such foreign application has been made and shall specify all the foreign States or British Possessions in which foreign applications have been made, and the official

date or dates thereof respectively. The application must be made, within seven months from the date of the first foreign application, and must be signed by the person or persons by whom such first foreign application was made. If such person, or any of such persons, be dead, the application must be signed by the legal personal representative of such dead person, as well as by the other applicants, if any. Rule 25.

26. The application in the United Kingdom shall be made in the Form A in the Second Schedule to these Rules, and, in addition to the specification, provisional or complete, left with such application must be accompanied by—

(1) A copy or copies of the specification, and drawings or documents corresponding thereto, filed or deposited by the applicant in the Patent Office of the foreign State or British Possession in respect of the first foreign application, duly certified by the official chief or head of the Patent Office of such foreign State or British Possession as aforesaid, or otherwise verified to the satisfaction of the comptroller;

(2) A statutory declaration as to the identity of the invention in respect of which the application is made with the invention in respect of which the first foreign application was made, and if the specification or document corresponding thereto be in a foreign language, a translation thereof shall be annexed to and verified by such statutory declaration.

27. On receipt of such application, together with the prescribed specification and the other document or documents accompanying the same, required by the last preceding rule, and with such other proof (if any) as the comptroller may require of or relating to such foreign application or of the official date thereof, the comptroller shall make an entry of the applications in both countries and of the official dates of such applications respectively.

28. All further proceedings in connexion with such application shall be taken within the times and in the manner prescribed by the Acts or Rules for ordinary applications.

29. The patent shall be entered in the Register of Patents as dated of the date on which the first foreign application was made, and the payment of renewal fees, and the expiration of the patent, shall be reckoned as from the date of the first foreign application.

Sizes and Methods of preparing Drawings accompanying Provisional or Complete Specifications.

30. The provisional or complete specification need not be accompanied by drawings if the specification sufficiently describes the invention without them, but if drawings are furnished, they should accompany the provisional or complete specification to which they refer, except in the case provided for by Rule 33. No drawing or sketch such as requires a special engraving for letterpress should appear in the specification itself. Drawings for specifications.

31. Drawings (if any) must be delivered at the Patent Office either in a flat state or on rollers so as to be free from folds, breaks, or creases.

Rule 31.

Requirements as to paper, etc.

They must be made on pure white, hot-pressed, rolled, or calendered drawing-paper of smooth surface and good quality, and, where possible, without colour or Indian-ink washes.

Size of drawings.

They must be on sheets of one of the following sizes (the smaller being preferable), 13 inches at the sides by 8 inches at the top and bottom, or 13 inches at the sides by 16 inches at the top and bottom, including margin, which must be half an inch wide. If there are more figures than can be shewn on one of the smaller-sized sheets two or more of these sheets should be used in preference to employing the larger size. When an exceptionally large drawing is required, it should be *continued* on subsequent sheets. There is no limit to the number of sheets that may be sent in.

Quality of ink.

To ensure their satisfactory reproduction, the drawings must be executed with *absolutely black Indian ink; the same strength and colour of fine and shade lines to be maintained throughout.* Section lines, and lines for effect, or shading lines, must not be closely drawn. A specimen drawing is inserted in illustration of this requirement. Reference figures and letters must be bold, distinct, and not less than an eighth of an inch in height; and the same letters should be used in different views of the same parts. In cases of complicated drawings, the reference letters must be shewn outside the figure, and connected with the part referred to by a fine line.

Scale of drawings.

The scale adopted should be large enough to shew clearly wherein the invention consists, and only so much of the apparatus, machine, etc., need be shewn as effects this purpose. When the scale is shewn on the drawing it should be denoted, *not* by words, but by a drawn scale, as illustrated in the specimen.

Drawings to bear name of applicant, etc.

Drawings must bear the name of the applicant (and in the case of drawings left with a complete specification after a provisional specification, the number and year of the application) in the *left-hand top corner;* the number of sheets of drawings sent, and the number of each sheet in the *right-hand top corner;* and the signature of the applicant or his agent in the *right-hand bottom corner.*

No written description of the invention should appear on the drawings.

Restrictions as to wood engravings.

Wood engravings, or representations of the invention, other than the drawings prepared as above described, will not be received, unless of such a character as to be suitable for reproduction by the process of photo-lithography.

Copies of drawings.

32. A *facsimile* of the original drawings, but *without* colour or Indian ink washes, and prepared strictly in accordance with the regulations prescribed in Rule 31, must accompany the originals, and be marked "true copy."

Provisional drawings used for complete specification.

33. If an applicant desires to adopt the drawings lodged with his provisional specification as the drawings for his complete specification, he should refer to them as those "left with the provisional specification."

Opposition to Grants of Patents.

Notice of opposition.

34. A notice of opposition to the grant of a patent shall be on Form D, and shall state the ground or grounds on which the person

giving such notice (hereinafter in Rules 37, 38, 41, and 43 called the opponent) intends to oppose the grant, and must be signed by him. Such notice shall state his address for service in the United Kingdom, and shall be accompanied by an unstamped copy. **Rule 34.**

Copy for applicant.

35. On receipt of such notice the copy thereof shall be transmitted by the comptroller to the applicant.

Particulars of prior patent.

36. Where the ground or one of the grounds of opposition is that the invention has been patented in this country on an application of prior date, the number and date of such prior application shall be specified in the notice.

Opponent's evidence.

37. Within 14 days after the expiration of two months from the date of the advertisement of the acceptance of a complete specification, the opponent may leave at the Patent Office statutory declarations in support of his opposition, and on so leaving shall deliver to the applicant a list thereof.

Applicant's evidence.

38. Within 14 days from the delivery of such list the applicant may leave at the Patent Office statutory declarations in answer, and on so leaving shall deliver to the opponent a list thereof, and within 14 days from such delivery the opponent may leave at the Patent Office his statutory declarations in reply, and on so leaving shall deliver to the applicant a list thereof. Such last-mentioned declarations shall be confined to matters strictly in reply.

Evidence in reply.

Copies of the declarations mentioned in this and the last preceding Rule may be obtained either from the Patent Office or from the opposite party.

Closing of evidence.

39. No further evidence shall be left on either side except by leave of the comptroller, upon the written consent of the parties duly notified to him, or by special leave of the comptroller on application in writing made to him for that purpose.

40. Either party making such application shall give notice thereof to the opposite party, who shall be entitled to oppose the application.

Notice of hearing.

41. On completion of the evidence, or at such other time as he may see fit, the comptroller shall appoint a time for the hearing of the case, and shall give the parties 10 days' notice at the least of such appointment. If the applicant or opponent desires to be heard he must forthwith send the comptroller an application on Form E. The comptroller may refuse to hear either party who has not sent such application for hearing. If neither party applies to be heard the comptroller shall decide the case and notify his decision to the parties.

Disallowance of opposition in certain cases.

42. On the hearing of the case no opposition shall be allowed in respect of any ground not stated in the notice of opposition, and where the ground or one of the grounds is that the invention has been patented in this country on an application of prior date, the opposition shall not be allowed upon such ground unless the number and date of such prior application shall have been duly specified in the notice of opposition.

43. Where the ground of an opposition is that the applicant has obtained the invention from the opponent, or from a person of whom such opponent is the legal representative, unless evidence in support

Rule 43. of such allegation be left at the Patent Office within the time prescribed by these Rules, the opposition shall be deemed to be abandoned, and a patent shall be sealed forthwith.

Decision to be notified to parties.

44. The decision of the comptroller, after hearing any party who applies under Rule 41, shall be notified by him to the parties.

Certificates of Payment or Renewal. (b)

Payment of fees of 50*l.* and 100*l.* for continuance of patent.

45. *If a patentee intends at the expiration of the fourth or eighth year from the date of his patent to keep the same in force, he shall, before the expiration of such fourth or eighth year, as the case may be, subject as hereinafter provided, pay the prescribed fee of* 50*l. or* 100*l., as the case may be.*

As to patents granted before commencement of Act.

46. *In the case of patents granted before the commencement of the said Acts, the above Rule shall be read as if the words "seventh year" were therein written instead of the words "eighth year."*

Payment of annual fees in lieu of 50*l.* and 100*l.*

47. *If the patentee intends to pay annual fees in lieu of the above-mentioned fees of* 50*l. and* 100*l., he shall, before the expiration of the fourth and each succeeding year during the term of the patent, until and inclusive of the thirteenth year thereof, pay the prescribed fee.*

The form J in the second schedule, duly stamped, should be used for the purpose of this and the payment referred to in Rule 45.

Certificate of payment.

48. On due compliance with these Rules, and as soon as may be after such respective periods as aforesaid, or any enlargement thereof respectively duly granted, the comptroller shall issue a certificate that the prescribed payment has been duly made.

Enlargement of Time.

Enlargement of time for payments.

49. An application for an enlargement of the time for making a prescribed payment shall state in detail the circumstances in which the patentee by accident, mistake, or inadvertence has failed to make such payment, and the comptroller may require the patentee to substantiate, by such proof as he may think necessary, the allegations contained in the application for enlargement.

Extension of time for leaving and accepting complete specification.

50. An application for enlargement of time for leaving or accepting a complete specification shall state in detail in what circumstances and upon what grounds such extension is applied for, and the comptroller may require the applicant to substantiate such allegations by such proof as the comptroller may think necessary.

In other cases.

51. The time prescribed by these Rules for doing any act, or taking any proceeding thereunder, may be enlarged by the comptroller if he think fit, and upon such notice to other parties, and proceedings thereon, and upon such terms, as he may direct.

Amendment of Specification.

Request for leave to amend.

52. A request for leave to amend a specification must be signed by the applicant or patentee (hereinafter in Rules 54, 55, and 58 called the applicant) and accompanied by a duly certified printed copy of the

(*b*) Rules 45, 46, and 47 of these rules are repealed by rule 3 of the Patents Rules, 1892 (second set).

original specification and drawings, shewing in red ink the proposed amendment, and shall be advertised by publication of the request and the nature of the proposed amendment in the official journal of the Patent Office, and in such other manner (if any) as the comptroller may in each case direct. **Rule 52.** Advertisement.

53. A notice of opposition to the amendment shall state the ground or grounds on which the person giving such notice (hereinafter called the opponent) intends to oppose the amendment, and must be signed by him. Such notice shall state his address for service in the United Kingdom, and shall be accompanied by an unstamped copy. Notice of opposition.

54. On receipt of such notice the copy thereof shall be transmitted by the comptroller to the applicant. Copy for the applicant.

55. Within 14 days after the expiration of one month from the first advertisement of the application for leave to amend, the opponent may leave at the Patent Office statutory declarations in support of his opposition, and on so leaving shall deliver to the applicant a list thereof. Opponent's evidence.

56. Upon such declarations being left, and such list being delivered, the provisions of Rules 38, 39, 40, 41, and 44 shall apply to the case, and the further proceedings therein shall be regulated in accordance with such provisions as if they were here repeated. Further proceedings.

57. Where leave to amend is given the applicant shall, if the comptroller so require, and within a time to be limited by him, leave at the Patent Office a new specification and drawings as amended, to be prepared in accordance with Rules 10, 30, and 31. Requirements thereon.

58. Where a request for leave to amend is made by or in pursuance of an order of the Court or a judge, an official or verified copy of the order shall be left with the request at the Patent Office. Leave by Order of Court.

59. Every amendment of a specification shall be forthwith advertised by the comptroller in the official journal of the Patent Office, and in such other manner (if any) as the comptroller may direct. Advertisement of amendment.

Compulsory Licenses.

60. A petition to the Board of Trade for an order upon a patentee to grant a license shall shew clearly the nature of the petitioner's interest, and the ground or grounds upon which he claims to be entitled to relief, and shall state in detail the circumstances of the case, the terms upon which he asks that an order may be made, and the purport of such order. Petition for compulsory grant of licenses.

61. The petition and an examined copy thereof shall be left at the Patent Office, accompanied by the affidavits or statutory declarations and other documentary evidence (if any) tendered by the petitioner in proof of the alleged default of the patentee. To be left with evidence at Patent Office.

62. Upon perusing the petition and evidence, unless the Board of Trade shall be of opinion that the order should be at once refused, they may require the petitioner to attend before the comptroller, or other person or persons appointed by them, to receive his or their directions as to further proceedings upon the petition. Directions as to further proceedings unless petition refused.

Rule 63.

Procedure.

Petitioner's evidence.

63. If and when a *primâ facie* case for relief has been made out to the satisfaction of the Board of Trade, the petitioner shall, upon their requisition, and on or before a day to be named by them, deliver to the patentee copies of the petition and of the affidavits or statutory declarations and other documentary evidence (if any) tendered in support thereof.

Patentee's evidence.

64. Within 14 days after the day of such delivery the patentee shall leave at the Patent Office his affidavits or statutory declarations in opposition to the petition, and deliver copies thereof to the petitioner.

Evidence in reply.

65. The petitioner within 14 days from such delivery shall leave at the Patent Office his affidavits or statutory declarations in reply, and deliver copies thereof to the patentee; such last-mentioned affidavits or declarations shall be confined to matters strictly in reply.

Further proceedings.

66. Subject to any further directions which the Board of Trade may give, the parties shall then be heard at such time, before such person or persons, in such manner, and in accordance with such procedure as the Board of Trade may, in the circumstances of the case, direct, but so that full opportunity shall be given to the patentee to show cause against the petition.

Register of Patents.

Entry of grant.

67. Upon the sealing of a patent the comptroller shall cause to be entered in the Register of Patents the name, address, and description of the patentee as the grantee thereof, and the title of the invention.

Request for entry of subsequent proprietorship.

68. Where a person becomes entitled to a patent or to any share or interest therein, by assignment, either throughout the United Kingdom and the Isle of Man, or for any place or places therein, or by transmission or other operation of law, a request for the entry of his name in the register as such complete or partial proprietor of the patent, or of such share or interest therein, as the case may be, shall be addressed to the comptroller, and left at the Patent Office.

Signature of request.

69. Such request shall in the case of individuals be made and signed by the person requiring to be registered as proprietor, or by his agent duly authorized to the satisfaction of the comptroller, and in the case of a body corporate by their agent, authorized in like manner.

Particulars to be stated in request.

70. Every such request shall state the name, address, and description of the person claiming to be entitled to the patent, or to any share or interest therein, as the case may be (hereinafter called the claimant), and the particulars of the assignment, transmission, or other operation of law, by virtue of which he requires to be entered in the register as proprietor, so as to shew the manner in which, and the person or persons to whom, the patent, or such share or interest therein as aforesaid, has been assigned or transmitted.

Production of documents of title and other proof.

71. Every assignment and every other document containing, giving effect to, or being evidence of, the transmission of a patent or affecting the proprietorship thereof as claimed by such request, except such documents as are matters of record, shall be produced to the comptroller, together with the request above prescribed, and such other proof of title as he may require for his satisfaction.

As to a document which is a matter of record, an official or certified copy thereof shall in like manner be produced to the comptroller. **Rule 71.**

Copies for Patent Office.

72. There shall also be left with the request an attested copy of the assignment or other document above required to be produced.

As to a document which is a matter of record, an official or certified copy shall be left with the request in lieu of an attested copy.

Body corporate.

73. A body corporate may be registered as proprietor by its corporate name.

Entry of Orders of the Privy Council or of the Court.

74. Where an order has been made by her Majesty in Council for the extension of a patent for a further term or for the grant of a new patent, or where an order has been made by the Court for the revocation of a patent or the rectification of the register under Section 90 of the Act of 1883, or otherwise affecting the validity or proprietorship of the patent, the person in whose favour such order has been made shall forthwith leave at the Patent Office an office copy of such order. The register shall thereupon be rectified, or the purport of such order shall otherwise be duly entered in the register, as the case may be.

Entry of payment of fees on issue of certificate.

75. Upon the issue of a certificate of payment under Rule 48, the comptroller shall cause to be entered in the Register of Patents a record of the amount and date of payment of the fee on such certificate.

Entry of failure to pay fees.

76. If a patentee fails to make any prescribed payment within the prescribed time or any enlargement thereof, duly granted, such failure shall be duly entered in the register.

Entry of licenses.

77. An attested copy of every license granted under a patent shall be left at the Patent Office by the licensee, with a request that a notification thereof may be entered in the register. The licensee shall cause the accuracy of such copy to be certified as the comptroller may direct, and the original license shall at the same time be produced and left at the Patent Office if required for further verification.

Hours of inspection of register.

78. The register of patents shall be open to the inspection of the public on every week day between the hours of ten and four, except on the days and the times following :—

(*a*) Christmas Day, Good Friday, the day observed as her Majesty's birthday, days observed as days of public fast or thanksgiving, and days observed as holidays at the Bank of England ; or

(*b*) Days which may from time to time be notified by a placard posted in a conspicuous place at the Patent Office ;

(*c*) Times when the register is required for any purpose of official use.

Certified copies of documents.

79. Certified copies of any entry in the register, or certified copies of, or extracts from, patents, specifications, disclaimers, affidavits, statutory declarations, and other public documents in the Patent Office, or of or from registers and other books kept there, may be furnished by the comptroller on payment of the prescribed fee.

Power to Dispense with Evidence, etc.

80. Where, under these Rules, any person is required to do any act or thing, or to sign any document, or to make any declaration on behalf of himself or of any body corporate, or any document or evidence

Rule 80. is required to be produced to or left with the comptroller, or at the Patent Office, and it is shewn to the satisfaction of the comptroller that from any reasonable cause such person is unable to do such act or thing, or to sign such document, or make such declaration, or that such document or evidence cannot be produced or left as aforesaid, it shall be lawful for the comptroller, with the sanction of the Board of Trade, and upon the production of such other evidence, and subject to such terms as they may think fit, to dispense with any such act or thing, document, declaration, or evidence.

Repeal.

Repeal. 81. All general rules heretofore made by the Board of Trade under the Patents, Designs, and Trade Marks Acts, 1883 to 1888, and in force on the 31st day of March, 1890, shall be and they are hereby repealed as from that date, without prejudice, nevertheless, to anything done under such rules, or to any application then pending.

Dated 31st day of March, 1890.

M. E. HICKS-BEACH,
President of the Board of Trade.

FIRST SCHEDULE.

List of Patent Fees.

(*Now superseded: see Patent Rules*, 1892 (*second set*), *R.* 5, *post p.* 598.)

SECOND SCHEDULE.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

PATENT.

Form A.

(To be accompanied by two copies of Form B *or of Form* C.*)*

APPLICATION FOR PATENT.

(a)_____

_____

_____

_____

_____do hereby

(a) Here insert name and full address and calling of applicant or applicants.

declare that_____in possession of an invention the title of which is (b)_____

(b) Here insert title of invention.

that (c)_____

_____the true and first inventor_____thereof; and that the same is not in use by any other person or persons to the best of_____knowledge and belief; and_____humbly pray that a Patent may be granted to_____ for the said invention.

(c) In the case of more than one applicant, state whether all, or if not, who is or are the inventor or inventors.

Dated_____day of_____18_____

(d) _____

_____

_____

_____

(d) To be signed by applicant or applicants.
In the case of a Firm, each member of the Firm must sign.

NOTE.—Where application is made through an Agent (Rule 8), the authorization on the back (if used) should be signed by the applicant or applicants.

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

For the convenience of applicants, suggested forms of authorization to an Agent and statement of address respectively are printed below.

(1) *Where application is made through an Agent* (*Rule* 8).

_____ hereby appoint

of _____

to act as _____ Agent in respect of the within application for a Patent, and request that all notices, requisitions and communications relating thereto may be sent to such Agent at the above address.

____ day of _____ 18____

* _____

* To be signed by applicant or applicants.

(2) *Where application is made without an Agent* (*Rule* 9).

_____ hereby request that all notices, requisitions, and communications in respect of the within application may be sent to _____ at _____

_____ day of _____ 18____

† _____

† To be signed by applicant or applicants.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

PATENT.

Form A1.

(To be accompanied by two copies of Form B *or of Form* C.)

APPLICATION FOR PATENT FOR INVENTIONS COMMUNICATED FROM ABROAD.

I (*a*) _____ (*a*) Here insert name and full address and calling of applicant.

of _____ in the

county of _____ do hereby declare that I

am in possession of an invention the title of which is (*b*) (*b*) Here insert title of invention.

_____

_____

_____

which invention has been communicated to me by (*c*) (*c*) Here insert name, address, and calling of communicant.

_____

_____

_____

that I claim to be the true and first inventor thereof; and that the same is not in use within the United Kingdom of Great Britain and Ireland and the Isle of Man by any other person or persons to the best of my knowledge and belief; and I humbly pray that a Patent may be granted to me for the said invention.

Dated _____ day of _____ 18__.

(*d*) _____ (*d*) To be signed by applicant or applicants.

_____

_____

_____

NOTE.—Where application is made through an Agent (Rule 8) the authorization on the back (if used) should be signed by the applicant or applicants.

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

For the convenience of applicants, suggested forms of authorization to an Agent and statement of address respectively are printed below.

(1) *Where application is made through an Agent* (*Rule* 8).

_____hereby appoint_____

of _____

to act as_____Agent in respect of the within application for a Patent, and request that all notices, requisitions, and communications relating thereto may be sent to such Agent at the above address.

_____day of 18

* To be signed by applicant or applicants.

* _____

(2) *Where application is made without an Agent* (*Rule* 9).

_____hereby request that all notices, requisitions, and communications in respect of the within application may be sent to _____

_____at _____

_____ day of_____18___

† To be signed by applicant or applicants.

† _____

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

PATENT.

Form A2.

APPLICATION FOR PATENT UNDER INTERNATIONAL AND COLONIAL ARRANGEMENTS.

(a)

(a) Here insert name and full address and calling of applicant, or of each of the applicants.

do hereby declare that I (or we) have made foreign applications for protection of my (or our) invention of (b)

(b) Here insert title of invention.

in the following foreign States and on the following official dates, viz.: (c)

(c) Here insert the names of each foreign State, followed by the official date of the application in each respectively.

and in the following British Possessions and on the following official dates, viz.: (d)

(d) Here insert the names of each British Possession, followed by the official date of the application in each respectively.

(e) Here insert the official date of the earliest foreign application.

That the said invention was not in use within the United Kingdom of Great Britain and Ireland and the Isle of Man by any other person or persons before the (*e*)

to the best of knowledge, information, and belief, and humbly pray that a Patent may be granted to for the said invention in priority to other applicants, and that such Patent shall have the date (*f*)

(*f*) Here insert the official date of the earliest foreign application.

(*g*) Signature of applicant or of each of applicants.

(*g*) .....

.....

.....

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

To be issued with Form **A**, **A1**, or **A2**.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

Form **B**.

PROVISIONAL SPECIFICATION.

(To be furnished in duplicate.)

(*a*) _____ (a) Here insert title as in declaration.

(*b*) _____ (b) Here insert name and full address and calling of applicant, or applicants, as in declaration.

do hereby declare the nature of this invention to be as follows:—(*c*) (c) Here insert short description of invention.

NOTE.—No stamp is required on this document, which must form the commencement of the Provisional Specification; the continuation to be upon wide-ruled foolscap paper (but on one side only) with a margin of two inches on left hand of paper. The Provisional Specification and the "Duplicate" thereof must be signed by the applicant, or his agent, on the last sheet, the date being first inserted as follows:

"Dated this day of 18 ."

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

Where provisional specification has been left, quote No. and date.
No. _____
Date _____

Form **C.** (*a*)

PATENT.

COMPLETE SPECIFICATION.

(To be furnished in duplicate—one unstamped.)

(*a*) Here insert title as in declaration.

(*a*) _____

(*b*) Here insert name and full address and calling of applicant, or applicants, as in declaration.

(*b*) _____

do hereby declare the nature of this invention and in what manner the same is to be performed, to be particularly described and ascertained in and by the following statement:

(*c*) Here insert full description of invention, *which must end with a distinct statement of claim, or claims, in the following form:*—

"Having now particularly described and ascertained the nature of my said Invention, and in what manner the same is to be performed, I declare that what I claim is

(*c*) _____

Here state distinctly the features of novelty claimed.

1.
2.
3.

NOTE.—This document must form the commencement of the Complete Specification; the continuation to be upon wide-ruled foolscap paper (but on one side only) with a margin of two inches on left hand of paper. The Complete Specification and the "Duplicate" thereof must be signed by the applicant, or his agent, on the last sheet, the date being first inserted as follows:

"Dated this day of 18 ."

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

(*a*) For Form C1, see post, p. 697.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

Form D.

FORM OF OPPOSITION TO GRANT OF PATENT.

PATENT.

(To be accompanied by an unstamped copy.)

* I_____

* Here state name and full address.

hereby give notice of my intention to oppose the grant of Letters Patent upon application No. _____ of _____, applied for by _____

upon the ground †_____

† Here state upon which of the grounds of opposition permitted by section 11 of the Act the grant is opposed.

(Signed) ‡ _____

‡ Here insert signature of opponent.

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

Form **E.**

PATENT.

FORM OF APPLICATION FOR HEARING BY THE COMPTROLLER.

IN CASES OF REFUSAL TO ACCEPT, OPPOSITION, OR APPLICATIONS FOR AMENDMENTS, ETC.

SIR,

of (*a*) _____

(*a*) Here insert address.

hereby apply to be heard in reference to

and request that I may receive due notice of the day fixed for the hearing.

Sir,

Your obedient Servant,

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

Form **F.**

FORM OF APPLICATION FOR AMENDMENT OF SPECIFICATION OR DRAWINGS.

PATENT.

* _____

_____

_____

_____

* Here state name and full address of applicant or patentee.

seek leave to amend the specification of Letters Patent No. _____ of 188 , as shown in red ink in the copy of the original specification hereunto annexed _____

_____

_____

_____

_____

_____

_____

_____

_____

My reasons for making this amendment are as follows † _____

_____

† Here state reasons for seeking amendment; and where the applicant is not the patentee, state what interest he possesses in the letters patent.

(Signed) ‡ _____

‡ To be signed by applicant.

To the Comptroller,

Patent Office, 25, Southampton Buildings,

Chancery Lane, London, W.C.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

Form G.

PATENT.

FORM OF OPPOSITION TO AMENDMENT OF SPECIFICATION OR DRAWINGS.

(To be accompanied by an unstamped copy.)

* Here state name and full address of opponent.

* _____

_____

_____

_____

_____

hereby give notice of objection to the proposed amendment of the specification or drawings of Letters Patent No._____ of 188____ for the following reason : †_____

† Here state reason of opposition.

_____

_____

_____

_____

_____

_____

_____

_____

_____

(Signed)_____

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

Form H.

FORM OF APPLICATION FOR COMPULSORY GRANT OF LICENSE.

PATENT.

(To be accompanied by an unstamped copy.)

* _____

_____

_____

* Here state name and full address of applicant.

hereby request you to bring to the notice of the Board of Trade the accompanying petition for the grant of a license to me by † _____

_____

_____

_____

_____

† Here state name and address of patentee, and number and date of his patent.

(Signed) _____

NOTE.—The petition must clearly set forth the facts of the case and be accompanied by an examined copy thereof. *See* form next page.

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, *1883 TO 1888.*

Form H1.

FORM OF PETITION FOR COMPULSORY GRANT OF LICENSES.

To the LORDS of the COMMITTEE of PRIVY COUNCIL for TRADE.

(*a*) Here insert name, full address, and description.

THE PETITION of (*a*) of in the county of , being a person interested in the matter of this petition as herein-after described :—

(*b*) Here insert title of invention.

(*c*) Here state fully the nature of petitioner's interest.

SHEWETH as follows :—

1. A patent dated No. was duly granted to for an invention of (*b*)

(*d*) Here state in detail the circumstances of the case under section 22 of the said Act, and shew that it arises by reason of the default of the patentee to grant licenses on reasonable terms. The statement of the case should also shew as far as possible that the terms of the proposed order are just and reasonable. The paragraphs should be numbered consecutively.

2. The nature of my interest in the matter of this petition is as follows :—(*c*)

3. (*d*)

(*e*) Here state the ground or grounds on which relief is claimed in the language of section 22 subsections (*a*), (*b*), or (*c*), as the case may be.

Having regard to the circumstances above stated, the petitioner alleges that by reason of the aforesaid default of the patentee to grant licenses on reasonable terms (*e*)

(*f*) Here state the purport and effect of the proposed order and the terms as to the amount of royalties, security for payment, or otherwise, upon which the petitioner claims to be entitled to the relief in question.

Your petitioner therefore prays that an order may be made by the Board of Trade (*f*)

or that the petitioner may have such other relief in the premises as the Board of Trade may deem just.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

Form I.

FORM OF OPPOSITION TO COMPULSORY GRANT OF LICENSE.

PATENT.

* _____ * Here state name and full address.

_____

_____

hereby give notice of objection to the application of _____

_____

_____

_____

for the compulsory grant of a License under Patent No. _____ of 188____

(Signed) _____

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

Form J.

APPLICATION FOR CERTIFICATE OF PAYMENT OR RENEWAL.

_____

_____

_____hereby transmit the fee prescribed for the continuation

* Here insert name of patentee.

in force of * _____, Patent No._____, of 18___

for a further period of _____.

† Here insert name and full address.

Name †_____

Address_____

To the Comptroller,

Patent Office, 25, Southampton Buildings,

Chancery Lane, London, W.C.

(This part of the Form to be filled in at the Patent Office.)

PATENT.

CERTIFICATE OF PAYMENT OR RENEWAL.

Letters Patent No._____of 188___.

_____18___.

This is to certify that_____did this_____

day of_____18___, make the prescribed payment of

£_____in respect of a period of_____from_____

and that by virtue of such payment the rights of the patentee remain

* See section 17 of the Patents, Designs, and Trade Marks Act, 1883.

in force.*

Seal

Patent Office, London.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

Form K.

FORM OF APPLICATION FOR ENLARGEMENT OF TIME FOR PAYMENT OF RENEWAL FEE.

PATENT.

SIR,

I HEREBY apply for an enlargement of time for _____ month in which to make the _____ payment of £_____ upon my Patent, No._____ of 188 .

The circumstances in which the payment was omitted are as follows (*a*):—

(*a*) See rule 49.

I am, Sir,

Your obedient Servant,

(*b*)_____

_____

(*b*) Here insert full address to which receipt is to be sent.

To the Comptroller,

Patent Office, 25, Southampton Buildings,

Chancery Lane, London, W.C.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

Form L.

PATENT.

FORM OF REQUEST TO ENTER NAME UPON THE REGISTER OF PATENTS.

(a) *Or* We.

Here insert name, full address, and description.

I (*a*)_____

(b) My *or* our.

(c) *Or* names.

hereby request that you will enter (*b*)_____name (*c*) in the Register of Patents :—

(d) I or We.

(e) Here insert the nature of the claim.

(*d*)_____ claim to be entitled (*e*)_____

(f) Here give name and address, etc., of patentee or patentees.

of the Patent No._____of 188____, granted to (*f*)_____

(g) Here insert title of the invention.

for (*g*)_____

(h) Here specify the particulars of such document, giving its date, and the parties to the same, and shewing how the claim here made is substantiated.

by virtue of (*h*)_____

(i) Here insert the nature of the document.

And in proof whereof I transmit the accompanying (*i*)_____ with an attested copy thereof (*j*)

(j) Where any document which is a matter of record is required to be left, a certified or official copy in lieu of an attested copy must be left.

I am, Sir,
Your obedient Servant,

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

Form M.

FORM OF REQUEST TO ENTER NOTIFICATION OF LICENSE IN THE REGISTER OF PATENTS.

PATENT.

SIR,

I HEREBY transmit an attested copy of a license granted to me by _____

under Patent No. _____ of 188____, as well as the original license for verification, and I have to request that a notification thereof may be entered in the Register.

I am, Sir,

Your obedient Servant,

(a) _____

(a) Here insert full address.

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

Form **N**.

PATENT.

APPLICATION FOR DUPLICATE OF PATENT.

Date

SIR,

I REGRET to have to inform you that the Letters Patent

* Here insert date, No., name, and full address of patentee.

dated * No.

granted to

† Here insert title of invention.

for an invention of †

‡ Here insert the word "destroyed" or "lost," as the case may be.

have been ‡

I beg therefore to apply for the issue of a duplicate of such

§ Here state interest possessed by applicant in the Letters Patent.

Letters Patent. §

[Signature of Applicant.]

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

Form O.

NOTICE OF INTENDED EXHIBITION OF AN UNPATENTED INVENTION.

PATENT.

* _____ * Here state name and full address of applicant.

_____

_____

hereby give notice of my intention to exhibit a _____

of _____ at the _____

_____

_____

Exhibition, which † _____ of _____ 18 ___, † State "opened" or "is to open."

under the provisions of the Patents, Designs, and Trade Marks Act of 1883.

‡ _____ herewith enclose _____ ‡ Insert brief description of invention, with drawings if necessary.

_____

_____

(Signed) _____

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

Form P.

PATENT.

FORM OF REQUEST FOR CORRECTION OF CLERICAL ERROR.

SIR,

I HEREBY request that the following clerical error (*a*) _____

in the (*b*) _____

No. _____ of 18____, may be corrected in the manner shewn in red ink in the certified copy of the original (*b*) _____ hereunto annexed.

(*a*) *Or* errors.

(*b*) Here state whether in application, specification, or register.

Signature _____

Full Address _____

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

PATENT.

Form **Q.**

CERTIFICATE OF COMPTROLLER-GENERAL.

Patent Office,

London,

18

I, , Comptroller-General of Patents, Designs, and Trade Marks, hereby certify

To *

* Here insert name and full address of person requiring the information.

2 Y

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

Form R.

PATENT.

FORM OF NOTICE FOR ALTERATION OF AN ADDRESS IN REGISTER.

SIR,

(a) Here state name, or names, and full address of applicant, or applicants.

(a) _____

_____

_____

_____

_____

hereby request that _____ address now upon the Register may be altered as follows:—

(b) Here insert full address.

(b) _____

_____

_____

_____

Sir,

Your obedient Servant,

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

Form S.

FORM OF APPLICATION FOR ENTRY OF ORDER OF PRIVY COUNCIL IN REGISTER.

PATENT.

(a) _____ (a) Here state name and full address of applicant.

_____

_____

_____

hereby transmit an office copy of an Order in Council with reference to (b) _____ (b) Here state the purport of the order.

_____

_____

_____

_____

Sir,

Your obedient Servant,

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

Form T.

PATENT.

FORM OF APPEAL TO LAW OFFICER.

I, (a)_____ of (a)_____

(a) Here insert name and full address of appellant.

hereby give notice of my intention to appeal to the Law Officer from (b)_____

(b) Here insert "the decision," or "that part of the decision," as the case may be.

of the Comptroller of the_____ day of_____ 18____, whereby he (c)_____

(c) Here insert "refused [or allowed] application for patent," or "refused [or allowed] application for leave to amend patent," or otherwise, as the case may be.

No. (d)_____ of the year 18____ (d)

(d) Insert number and year.

Signature_____

Date_____

N.B.—This notice has to be sent to the Comptroller-General at the Patent Office, London, W.C., and a copy of the same to the Law Officers' Clerk at Room 549, Royal Courts of Justice, London.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

Form U.

FORM OF APPLICATION FOR EXTENSION OF TIME FOR LEAVING A COMPLETE SPECIFICATION.

PATENT.

SIR,

_____ hereby apply for extension of time for one month in which to leave a Complete Specification upon application.

_____ dated _____.

The circumstances in and grounds upon which this extension is applied for are as follows (*a*): _____ (*a*) See Rule 50.

_____

_____

_____

_____

_____

_____

_____

_____

Sir,

Your obedient servant,

(*b*) _____ (*b*) To be signed by applicant, or applicants, or his or their agent.

_____

_____

To the Comptroller,

Patent Office, 25, Southampton Buildings,

Chancery Lane, London, W.C.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

Form V.

PATENT.

FORM OF APPLICATION FOR EXTENSION OF TIME FOR ACCEPTANCE OF A COMPLETE SPECIFICATION.

SIR,

_____ hereby apply for extension of time for _____ month _____ for the acceptance of the Complete Specification upon application No. _____ dated _____

The circumstances in and grounds upon which this extension is applied for are as follows (*a*): _____

(*a*) See Rule 50.

_____

Sir,

Your obedient Servant,

(*b*) _____

(*b*) To be signed by applicant, or applicants, or his or their agent.

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

M. E. HICKS-BEACH,
President of the Board of Trade.

31st March, 1890.

THE PATENTS RULES, 1892.

By virtue of the Patents, Designs, and Trade Marks Acts, 1883 to 1888, the Board of Trade do hereby make the following Rules :—

1. These Rules may be cited as The Patents Rules, 1892.

2. These Rules shall come into operation from and immediately after the 1st of March, 1892.

Fees.

3. To the Fees specified in the First Schedule to the Patents Rules, 1890, shall be added the Fee specified in the First Schedule hereto.

Forms.

4. To the Forms specified in the Second Schedule to the Patents Rules, 1890, shall be added the Form specified in the Second Schedule hereto.

19th day of February, 1892.

(Signed) M. E. HICKS-BEACH,
President of the Board of Trade.

FIRST SCHEDULE.

Fee.

33*a*. On Postal Request for printed copy Specification ... £0 0 8

(Signed) M. E. HICKS-BEACH,
President of the Board of Trade.

Approved—

(Signed) W. H. WALROND,
HERBERT EUSTACE MAXWELL,
Lords Commissioners of Her Majesty's Treasury.

19th February, 1892.

SECOND SCHEDULE.

Form.

Obverse.

PATENTS FORM C[1].

To the Comptroller-General.

Please send one copy of Specification, No. _____ Year _____

to

(Name in full) _____

(Address) _____

PATENTS, 7½*d.*

Reverse.

½*d.*

The Comptroller-General,

Patent Office,

25, Southampton Buildings,

London, W.C.

(Signed) M. E. HICKS-BEACH,
President of the Board of Trade.

PATENTS RULES, 1892

(SECOND SET).

By virtue of the provisions of the Patents, Designs, and Trade Marks Acts, 1883–88, the Board of Trade do hereby make the following Rules:—

Short Title.

1. These Rules may be cited as the Patents Rules, 1892 (Second Set).

Commencement.

2. These Rules shall come into operation from and immediately after the 30th day of September, 1892.

Certificates of Payment or Renewal.

3. Rules 45, 46, & 47 of the Patents Rules, 1890, are hereby repealed.

Payment of Annual Fees for Continuance of Patent.

4. If a patentee intends at the expiration of the fourth year from the date of his patent to keep the same in force, he shall, before the expiration of the fourth and each succeeding year during the term of the patent, pay the prescribed fee. The patentee may pay the whole or any portion of the aggregate of such prescribed annual fees in advance.

The Form J in the Second Schedule, duly stamped, should be used for the purpose of this payment.

Fees.

5. For the fees specified in the First Schedule to the Patents Rules, 1890, shall be substituted the fees specified in the Schedule hereto.

M. E. HICKS-BEACH,
President of the Board of Trade.

4th July, 1892.

SCHEDULE.

List of Fees Payable on and in Connexion with Letters Patent.
Up to Sealing.

	£	s.	d.	£	s.	d.
1. On application for provisional protection .	1	0	0			
2. On filing complete specification . . .	3	0	0			
				4	0	0
or						
3. On filing complete specification with first application .				4	0	0
4. On appeal from comptroller to law officer. By appellant				3	0	0
5. On notice of opposition to grant of patent. By opponent				0	10	0
6. On hearing by comptroller. By applicant and by opponent respectively				1	0	0
On application to amend specification :—						
7. Up to sealing. By applicant				1	10	0
8. After sealing. By patentee				3	0	0
9. On notice of opposition to amendment. By opponent .				0	10	0
10. On hearing by comptroller. By applicant and by opponent respectively				1	0	0
11. On application to amend specification during action or proceeding. By patentee				3	0	0
12. On application to the Board of Trade for a compulsory license. By person applying				5	0	0
13. On opposition to grant of compulsory license. By patentee				5	0	0
On certificate of renewal :—						
14. Before the expiration of the 4th year from the date of the patent and in respect of the 5th year . . .				5	0	0
15. Before the expiration of the 5th year from the date of the patent and in respect of the 6th year . . .				6	0	0
16. Before the expiration of the 6th year from the date of the patent and in respect of the 7th year . . .				7	0	0
17. Before the expiration of the 7th year from the date of the patent and in respect of the 8th year . . .				8	0	0
18. Before the expiration of the 8th year from the date of the patent and in respect of the 9th year . . .				9	0	0
19. Before the expiration of the 9th year from the date of the patent and in respect of the 10th year . .				10	0	0
20. Before the expiration of the 10th year from the date of the patent and in respect of the 11th year . .				11	0	0

		£	s.	d.
21.	Before the expiration of the 11th year from the date of the patent and in respect of the 12th year . .	12	0	0
22.	Before the expiration of the 12th year from the date of the patent and in respect of the 13th year . .	13	0	0
23.	Before the expiration of the 13th year from the date of the patent and in respect of the 14th year . .	14	0	0
	On enlargement of time for payment of renewal fees :—			
24.	Not exceeding one month	1	0	0
25.	„ two months	3	0	0
26.	„ three months	5	0	0
27.	For every entry of an assignment, transmission, agreement, license, or extension of patent . . .	0	10	0
28.	For duplicate of letters patent . . . . each	2	0	0
29.	On notice to comptroller of intended exhibition of a patent under Section 39	0	10	0
30.	Search or inspection fee . . . . . each	0	1	0
31.	For office copies . . . . . every 100 words (but never less than one shilling)	0	0	4
32.	For office copies of drawings, cost, according to agreement.			
33.	For certifying office copies, MSS. or printed, each . .	0	1	0
34.	On request to comptroller to correct a clerical error up to sealing	0	5	0
	after sealing	1	0	0
35.	For certificate of comptroller under Section 96 . .	0	5	0
36.	For altering address in register	0	5	0
37.	For enlargement of time for filing complete specification, not exceeding one month	2	0	0
38.	For enlargement of time for acceptance of complete specification :—			
	Not exceeding one month	2	0	0
	„ two months	4	0	0
	„ three months	6	0	0

M. E. HICKS-BEACH,
President of the Board of Trade.

4th July, 1892.

Approved;

SIDNEY HERBERT,
HERBERT EUSTACE MAXWELL,
Lord Commissioners of
Her Majesty's Treasury.

PATENTS RULES, 1898.

By virtue of the provisions of the Patents, Designs, and Trade Marks Acts, 1883 to 1888, the Board of Trade do hereby make the following Rules:—

1. These Rules may be cited as the Patents Rules, 1898, and shall come into operation from and immediately after the date hereof.

2. For Rule 8 of the Patents Rules, 1890, shall be substituted the following Rule:—

> An application for a patent must be signed by the applicant, but all other communications between the applicant and the comptroller, and all attendances by the applicant upon the comptroller, may be made by or through an agent duly authorized to the satisfaction of the comptroller, and, if he so require, resident in the United Kingdom, but the comptroller shall not be bound to recognize as such agent, or to receive further communications from, any person whose name, by reason of his having been adjudged guilty of disgraceful professional conduct, has been erased from the Register of Patent Agents kept under the provisions of the Patent, Designs, and Trade Marks Act, 1888, relating to the registration of Patent Agents, and not since restored.

Dated this 15th day of September, 1898.

CHAS. T. RITCHIE,
President of the Board of Trade.

RULES REGULATING THE PRACTICE AND PROCEDURE ON APPEALS TO THE LAW OFFICERS.

I. When any person intends to appeal to the law officer from a decision of the comptroller in any case in which such appeal is given by the Acts, he shall within fourteen days from the date of the decision appealed against file in the Patent Office, a notice of such his intention.

II. Such notice shall state the nature of the decision appealed against, and whether the appeal is from the whole, or part only, and if so, what part of such decision.

III. A copy of such notice of intention to appeal shall be sent by the party so intending to appeal to the law officers' clerk, at room 549, Royal Courts of Justice, London; and when there has been an opposition before the comptroller, to the opponent or opponents; and when the comptroller has refused to seal a patent on the ground that a previous application for a patent for the same invention is pending, to the prior applicant.

IV. Upon notice of appeal being filed, the comptroller shall forthwith transmit to the law officers' clerk all the papers relating to the matter of the application in respect of which such appeal is made.

V. No appeal shall be entertained of which notice is not given within fourteen days from the date of the decision appealed against, or such further time as the comptroller may allow, except by special leave upon application to the law officer.

VI. Seven days' notice, at least, of the time and place appointed for the hearing of any appeal, shall be given by the law officers' clerk, unless special leave be given by the law officer that any shorter notice be given.

VII. Such notice shall in all cases be given to the comptroller and the appellant; and, when there has been an opposition before the comptroller, to the opponent or opponents; and, when the comptroller has refused to seal a patent on the ground that an application for a patent for the same invention is pending, to the prior applicant.

VIII. The evidence used on appeal to the law officer shall be the same as that used at the hearing before the comptroller; and no further evidence shall be given, save as to matters which have occurred or come to the knowledge of either party after the date of the decision appealed against, except with the leave of the law officer upon application for that purpose.

IX. The law officer shall, at the request of either party, order the attendance at the hearing on appeal, for the purpose of being cross-examined, of any person who has made a declaration in the matter to which the appeal relates, unless in the opinion of the law officer there is good ground for not making such order.

X. Any person requiring the attendance of a witness for cross-examination shall tender to the witness whose attendance is required a reasonable sum for conduct money.

XI. Where the law officer orders that costs shall be paid by any party to another, he may fix the amount of such costs, and if he shall not think fit to fix the amount thereof, he shall direct by whom and in what manner the amount of such costs shall be ascertained.

XII. If any costs so ordered to be paid be not paid within fourteen days after the amount thereof has been so fixed or ascertained, or such shorter period as shall be directed by the law officer, the party to whom such costs are to be paid may apply to the law officer for an order for payment, under the provisions of Section 38 of the Act.

XIII. All documentary evidence required, or allowed by the law officer to be filed, shall be subject to the same regulations, in all respects, as apply to the procedure before the comptroller, and shall be filed in the Patent Office, unless the law officer shall order to the contrary.

XIV. Any notice or other document required to be given to the law officers' clerk, under these Rules, may be sent by a prepaid letter through the post.

HENRY JAMES, A.G.
FARRER HERSCHELL, S.G.

RULES OF HER MAJESTY'S PRIVY COUNCIL

With Reference to Applications

For the Extension or Prolongation of Letters Patent made by Order in Council, November, 1897.

ORDER IN COUNCIL.

At the Court at Windsor,

The 26th day of November, 1897.

Present—

The Queen's Most Excellent Majesty,

Lord President,
Lord Privy Seal,
Mr. Ritchie.

Whereas by the 25th section of an Act of Parliament passed in the 46th and 47th years of her Majesty's reign, intituled "The Patents, Designs, and Trade Marks Act, 1883," it is amongst other things enacted that a patentee may, after advertising in manner directed by any rules made under the said section his intention to do so, present a petition to her Majesty in Council, praying that his patent may be extended for a further term, but such petition must be presented at least six months before the time limited for the expiration of the patent; that if her Majesty shall be pleased to refer any such petition to the Judicial Committee of the Privy Council the said Committee shall proceed to consider the same; and that it shall be lawful for her Majesty in Council to make from time to time rules of procedure and practice for regulating the proceedings on such petitions, and, subject thereto, such proceedings shall be regulated according to the existing procedure and practice in patent matters of the Judicial Committee:

And whereas her Majesty in Council has deemed it expedient to make rules for regulating proceedings in such petitions.

Her Majesty is therefore pleased, by and with the advice of her Privy Council, to approve of the several rules and regulations contained in the schedule hereunto annexed, and to order, as it is hereby ordered, that on and after the 1st January, 1898, the same be respectively observed.

Whereof all persons whom it may concern are to take notice and govern themselves accordingly.

C. L. PEEL.

The Schedule above referred to.

RULES to be observed in Proceedings before the Judicial Committee of the Privy Council under the Patents, Designs, and Trade Marks Act, 1883, Section 25. **Rule 1.**

I.

A party intending to apply by petition under Section 25 of the Act shall give public notice by advertising three times in the *London Gazette* and once at least in each of three London newspapers.

If the applicant's principal place of business is situated in the United Kingdom at a distance of fifteen miles or more from Charing Cross, he shall also advertise once at least in some local newspaper published or circulating in the town or district where such place of business is situated. If the applicant has no place of business, then, if he carries on the manufacture of anything made under his specification at a distance of fifteen miles or more from Charing Cross, he shall advertise once at least in some local newspaper published or circulating in the town or district where he carries on such manufacture. If he has no place of business and carries on no such manufacture, then, if he resides at a distance of fifty miles or more from Charing Cross, he shall advertise once at least in some newspaper published or circulating in the town or district where he resides.

The applicant shall in his advertisements state the object of his petition, and shall give notice of the day on which he intends to apply for a time to be fixed for hearing the matter thereof, which day shall not be less than four weeks from the date of the publication of the last of the advertisements to be inserted in the *London Gazette*. He shall also give notice that caveats must be entered at the Council Office on or before such day so named in the said advertisements.

II.

A petition under Section 25 of the Act must be presented within one week from the publication of the last of the advertisements required to be published in the *London Gazette*.

The petition must be accompanied with an affidavit or affidavits of advertisements having been published according to the requirements of the first of these Rules. The statements contained in such affidavit or affidavits may be disputed upon the hearing.

The petitioner shall apply to the Lords of the Committee to fix a time for hearing the petition, and when such time is fixed the petitioner shall forthwith give public notice of the same by advertising once at least in the *London Gazette* and in two London newspapers.

III.

A party presenting a petition under Section 25 of the Act must lodge at the Council Office eight printed copies of the specification: but if the specification has not been printed, and if the expense of making eight copies of any drawing therein contained or referred to would be considerable, the lodging of two copies only shall be deemed sufficient.

Rule 3. The petitioner shall also lo[illegible] t the Council Office eight copies of the balance-sheet of expenditure [illegible] d receipts relating to the patent in question, which accounts are to be proved on oath before the Lords of the Committee at the hearing. He shall also furnish three copies of the said balance-sheet for the use of the solicitor to the Treasury, and shall, upon receiving two days' notice, give the solicitor to the Treasury, or any person deputed by him for the purpose, reasonable facilities for inspecting and taking extracts from the books of account, by reference to which he proposes to verify the said balance-sheet at the hearing, or from which the materials for making up the said balance-sheet have been derived.

All copies mentioned in this Rule must be lodged and furnished not less than fourteen days before the day fixed for hearing.

IV.

A party intending to oppose a petition under Section 25 of the Act must enter a caveat at the Council Office before the day on which the petitioner applies for a time to be fixed for hearing the matter thereof, and having entered such caveat, shall be entitled to have from the petitioner four weeks' notice of the time appointed for the hearing.

The petitioner shall serve copies of his petition on all parties entering caveats in accordance with this Rule, and no application to fix a time for hearing shall be made without affidavit of such service.

All parties intending to oppose a petition shall within three weeks after such copies are served on them respectively, lodge at the Council Office eight printed copies of the grounds of their objections to the granting of the prayer of the petition.

V.

Parties shall be entitled to have copies of all papers lodged in respect of any petition under Section 25 of the Act at their own expense.

All such petitions and all statements of grounds of objection shall be printed in the form prescribed by the Rules which apply to proceedings before the Judicial Committee of the Privy Council. Balance-sheets of expenditure and receipts shall be printed in a form convenient for binding along with such petitions.

VI.

Costs incurred in the matter of any petition under Section 25 of the Act shall be taxed by the Registrar of the Privy Council, or other officer deputed by the Lords of the Judicial Committee of the Privy Council to tax the costs in the matter of any petition, and the Registrar or such other officer shall have authority to allow or disallow in his discretion all payments made to persons of science or skill examined as witnesses.

VII.

The Lords of the Committee may excuse petitioners and opponents from compliance with any of the requirements of these Rules, and may give such directions in matters of procedure and practice under Section 25 of the Act as they shall consider to be just and expedient.

VIII. Rule 8.

The Lords of the Committee will hear the Attorney-General or other counsel on behalf of the Crown on the question of granting the prayer of any petition under Section 25 of the Act. The Attorney-General is not required to give notice of the grounds of any objection he may think fit to take, or of any evidence which he may think fit to place before the Lords of the Committee.

PRIVY COUNCIL FEES.

SCHEDULE OF FEES

Allowed to Solicitors conducting Appeals or other business before the LORDS OF THE JUDICIAL COMMITTEE of the PRIVY COUNCIL under her Majesty's Orders in Council of the 11th August, 1842, and the 13th June, 1853.

		£	s.	d.
Retaining Fee		0	13	4
Perusing official Copy of Proceedings allowed at the rate of, for 25 folios, manuscript		0	6	8
Do. per printed sheet of 8 pages		1	1	0
Attendances at the Council Office, or elsewhere, on ordinary business, such as to enter an Appeal or an Appearance, to make a search, or to lodge a Petition or Affidavit, or to retain Counsel		0	10	0
Attending at Privy Council Office to examine proof of printed copy of Transcript Record with the original	*per diem*	2	2	0
Attending at Council Chamber on a Petition		1	6	8
Attending Council Chamber all day on an Appeal not called on		2	6	8
Attending a Hearing		3	6	8
Attending a Judgment		1	6	8
Attending Council Office on the drawing up of Minutes for Committee Report		1	1	0
Correcting Proofs, per printed sheet of 8 pages		0	10	6
Correcting Foreign or Indian Proofs, per printed sheet		1	1	0
Instructions for Petition of Appeal		0	10	0
Drawing Petition or Case	*per folio*	0	2	0
Copying	*per folio*	0	0	6
Drawing small Petitions for Orders, etc.		0	10	0
Instructions for Case		1	0	0
Attending Consultation		1	0	0
Sessions Fee for the legal year		3	3	0
Attending Taxation		2	2	0

Privy Council Fees.

II.

COUNCIL OFFICE FEES

On Appeals and Petitions to the Queen in Council.

	£	s.	d.
Entering Appearance	0	10	0
Lodging Petition of Appeal	1	1	0
Entering Petition of Appeal	1	1	0
Lodging Case	1	1	0
Setting down Case	0	10	0
Summons	0	10	0
Committee Report	1	10	0
Order of her Majesty in Council under seal	3	2	6
Do. do. plain copy	0	5	0
Committee Order under seal	1	12	6
Do. plain copy	0	5	0
Lodging Affidavit	1	1	0
Do. Petition	1	1	0
Notice to attend	0	10	0
Searching Council Office Books for Information of Parties	0	10	0
Certificate delivered to Parties	0	10	0
Copies of Papers, per side of foolscap	0	5	0
Committee References	2	2	0
Lodging Caveat	1	1	0
Subpœna to Witnesses	0	10	0
Fee for Taxation, Appeals	3	3	0
Do. do. Petitions	1	1	0

REGISTER OF PATENT AGENTS' RULES, 1889.

For the purpose of giving effect to the provisions of the Patents, Designs, and Trade Marks Act, 1888, relating to the registration of patent agents, the Board of Trade, by virtue of the provisions of the said Act, hereby make the following Rules :—

Register to be kept.

1. A Register shall be kept by the Institute of Patent Agents,(*a*) subject to the provisions of these Rules and to the Orders of the Board of Trade, for the registration of patent agents in pursuance of the Act.

2. The Register shall contain in one list all patent agents who are registered under the Act and these Rules.

Contents of Register.

Such list shall be made out alphabetically, according to the surnames of the registered persons, and shall also contain the full name of each registered person, with his address, the date of registration, and a mention of any honours, memberships, or other additions to the name of the registered person which the Council of the Institute may consider worthy of mention in the Register. The Register shall be in the Form 1 in Appendix A., with such variations as may be required.

Printed copies to be published annually, and to be evidence of contents of Register.

3. The Institute shall cause a correct copy of the Register to be, once every year, printed, under their direction, and published and placed on sale. Such correct copy shall, in the year 1889, be printed and published at as early a date as is possible, and in every year subsequent to the year 1889, shall be printed and published on the 31st day of January. A copy of the Register for the time being purporting to be so printed and published shall be admissible as evidence of all matters stated therein, and the absence of the name of any person from the Register shall be evidence, until the contrary is made to appear, that such person is not registered in pursuance of the Act.

Registrar.

4. The Institute shall appoint a Registrar, who shall keep the Register in accordance with the provisions of the Act and these Rules, and, subject thereto, shall act under the directions of the Institute, and the Board of Trade.

Registration of persons who were patent agents prior to the passing of this Act.

5. A person who is desirous of being registered in pursuance of the Act, on the ground that prior to the passing of the Act he had been *bonâ fide* practising as a patent agent, shall produce or transmit to the Board of Trade a statutory declaration in the Form 2 in Appendix A.; provided that the Board of Trade may in any case in which they shall think fit, require further or other proof that the person had prior to

(*a*) See post, Patent Agents Rules, 1891.

Rule 5. the passing of the Act been *bonâ fide* practising as a patent agent. Upon the receipt of such statutory declaration or of such further or other proof to their satisfaction as the case may be, the Board of Trade shall transmit to the Registrar a certificate that the person therein named is entitled to be registered in pursuance of the Act, and the Registrar shall on the receipt of such certificate cause the name of such person to be entered in the Register.

Final qualifying examination for registration.

6. Subject to the provisions of the Act in favour of every person who proves to the satisfaction of the Board of Trade that prior to the passing of the Act he had been *bonâ fide* practising as a patent agent, no person shall be entitled to be registered as a patent agent unless he has passed, and produces or transmits to the Registrar a certificate under the seal of the Institute that he has passed, such final examination as to his knowledge of patent law and practice and of the duties of a patent agent as the Institute shall from time to time prescribe.

Exemption of pupils and assistants from proliminary examination.

7. Any person who has been for at least seven consecutive years continuously engaged as a pupil or assistant to one or more registered patent agents, and any person for the time being entitled to practise as a solicitor of the Supreme Court of Judicature in England or Ireland, or as a law agent before the Court of Session in Scotland, shall be entitled to be registered without passing any examination other than the final examination provided for in the last preceding Rule. The Registrar shall before registering the name of any such person as a patent agent (in addition to the final examination certificate) require proof satisfactory to the Registrar that such person has been for at least seven consecutive years continuously engaged as such pupil or assistant, or is entitled to practice as such solicitor or law agent.

Qualifications of persons generally for registration.

8. Any person who is not qualified under Rule 7 must, in order to be entitled to present himself for the final qualifying examination, be—

A person who has passed one of the preliminary examinations mentioned in Appendix B., or such other examination as the Institute shall, with the approval of the Board of Trade, by regulation prescribe.

Final qualifying examinations to be held by the Institute.

9. The Institute shall hold at least once in the year commencing with the first day of July, 1889, and in every other succeeding year, a final qualifying examination, which shall be the final qualifying examination required under Rules 6 and 7; and the Institute shall, subject to these Rules, have the entire management and control of all such examinations, and may from time to time make regulations with respect to all or any of the following matters, that is to say—

(*a*) The subjects for and the mode of conducting the examination of candidates;

(*b*) The times and places of the examinations, and the notices to be given of examinations;

(*c*) The certificates to be given to persons of their having passed the examinations;

(*d*) The appointment and removal of examiners, and the remuneration, by fees or otherwise, of the examiners so appointed; and

(*e*) Any other matter or thing as to which the Institute may think it necessary to make regulations for the purpose of carrying out this Rule.

Corrections of names and addresses in Register.

10. The Registrar shall from time to time insert in the Register any alteration which may come to his knowledge in the name or address of any person registered.

Erasure of names of deceased persons.

11. The Registrar shall erase from the Register the name of any registered person who is dead.

Erasure of names of persons who have ceased to practice.

12. The Registrar may erase from the Register the name of any registered person who has ceased to practise as a patent agent, but not (save as hereinafter provided) without the consent of that person. For the purposes of this Rule the Register may send by post to a registered person to his registered address a notice enquiring whether or not he has ceased to practise or has changed his residence, and if the Registrar does not within three months after sending the notice receive an answer thereto from the said person, he may, within fourteen days after the expiration of the three months, send him by post to his registered address another notice referring to the first notice, and stating that no answer has been received by the Registrar; and if the Registrar either before the second notice is sent receives the first notice back from the dead letter office of the Postmaster-General, or receives the second notice back from that office, or does not within three months after sending the second notice receive any answer thereto from the said person, that person shall, for the purposes of this Rule, be deemed to have ceased to practice, and his name may be erased accordingly.

Erasure of name for non-payment of fees.

13. If any registered person shall not, within one month from the day on which his annual registration fee becomes payable, pay such fee, the Registrar may send to such registered person to his registered address a notice requiring him, on or before a day to be named in the notice, to pay his annual registration fee; and if such registered patent agent shall not within one month from the day named in such notice pay the registration fee so due from him, the Registrar may erase his name from the Register: Provided that the name of a person erased from the Register under this rule may be restored to the Register by direction of the Institute or the Board of Trade on payment by such person of the fee or fees due from him, together with such further sum of money, not exceeding in amount the annual registration fee, as the Institute or the Board of Trade (as the case may be) may in each particular case direct.

Registrar to act on evidence.

14. In the execution of his duties the Registrar shall, subject to these Rules, in each case act on such evidence as appears to him sufficient.

Erasure of incorrect or fraudulent entries.

15. The Board of Trade may order the Registrar to erase from the Register any entry therein which is proved to their satisfaction to have been incorrectly or fraudulently inserted.

Erasure of names of persons convicted of crimes, and persons found guilty of

16. If any registered person shall be convicted in her Majesty's dominions or elsewhere of an offence which, if committed in England, would be a felony of misdemeanour, or after due enquiry, is proved to the satisfaction of the Board of Trade to have been guilty of disgraceful professional conduct, or having been entitled to practise as a solicitor or law agent shall have ceased to be so entitled, the Board

Rule 16. disgraceful conduct.

of Trade may order the Registrar to erase from the Register the name of such person: Provided that no person shall be adjudged by the Board of Trade to have been guilty of disgraceful professional conduct unless such person has received notice of, and had an opportunity of defending himself from, any charge brought against him.

Restoration of erased name.

17.—(1) Where the Board of Trade direct the erasure from the Register of a name of any person, or of any other entry, the name of the person or the entry shall not be again entered in the Register, except by order of the Board of Trade.

(2) The Board of Trade may in any case in which they may think fit restore to the Register such name or entry erased therefrom either without fee, or on payment of such fee, not exceeding the registration fee, as the Board of Trade may from time to time fix, and the Registrar shall restore the name accordingly.

(3) The name of any person erased from the Register at the request or with the consent of such person shall, unless it might, if not so erased, have been erased by order of the Board of Trade, be restored to the Register by the Registrar on his application and on payment of such fee, not exceeding the registration fee, as the Institute shall from time to time fix.

Inquiry by Board of Trade before erasure of name from Register.

18. For the purpose of exercising in any case the powers of erasing from and of restoring to the Register the name of a person, or an entry, the Board of Trade may appoint a committee consisting of such persons as they shall think fit. Every application to the Board of Trade for the erasure from, or restoration to, the Register of the name of any patent agent shall be referred for hearing and enquiry to the committee, who shall report thereon to the Board of Trade, and a report of the committee shall be conclusive as to the facts for the purpose of the exercise of the said powers by the Board of Trade.

Appeal to Board of Trade.

19. Any person aggrieved by any order, direction, or refusal of the Institute or Registrar may appeal to the Board of Trade.

Notice of appeal.

20. A person who intends to appeal to the Board of Trade under these Rules (in these Rules referred to as the appellant) shall, within fourteen days from the date of the making or giving of the order, direction, or refusal complained of, leave at the office of the Institute a notice in writing signed by him of such his intention.

Case on appeal.

21. The notice of intention to appeal shall be accompanied by a statement in writing of the grounds of the appeal, and of the case of the appellant in support thereof.

Transmission of notice of appeal to Board of Trade.

22. The appellant shall also immediately after leaving his notice of appeal at the Institute send by post a copy thereof with a copy of the appellant's case in support thereof addressed to the Secretary of the Board of Trade, 7, Whitehall Gardens, London.

Directions as to hearing of appeal.

23. The Board of Trade may thereupon give such directions (if any) as they may think fit for the purpose of the hearing of the appeal.

Notice of hearing of appeal.

24. Seven days' notice, or such shorter notice as the Board of Trade may in any particular case direct, of the time and place appointed for the hearing of the appeal shall be given to the appellant and the Institute and the Registrar.

Rule 25.

25. The appeal may be heard by the President, a Secretary, or an Assistant Secretary of the Board of Trade, and the decision and order thereon of the President, Secretary, or Assistant Secretary, as the case may be, shall be the decision of the Board of Trade on such appeal. On the appeal such decision may be given or order made in reference to the subject-matter of the appeal as the case may require.

Hearing and decision of appeal.

26. The fees set forth in Appendix C. to these Rules shall be paid in respect of the several matters, and at the times and in the manner therein mentioned. The Board of Trade may from time to time, by orders signed by the Secretary of the Board of Trade, alter any of, or add to, the fees payable under these Rules.

Fees.

27. Any regulation made by the Institute under these Rules may be altered or revoked by a subsequent regulation. Copies of all regulations made by the Institute under these Rules shall, within twenty-eight days of the date of their being made, be transmitted to the Board of Trade, and if within twenty-eight days after a copy of any regulation has been so transmitted, the Board of Trade by an order signify their disapproval thereof, such regulation shall be of no force or effect; and if, after any regulation under these Rules has come into force, the Board of Trade signify in manner aforesaid their disapproval thereof, such regulation shall immediately cease to be of any force or effect.

Alteration of regulations.

28. The Institute shall once every year in the month of December transmit to the Board of Trade a report stating the number of applications for registration which have been made in the preceding year, the nature and results of the final examinations which have been held, and the amount of fees received by the Institute under these Rules, and such other matters in relation to the provisions of these Rules, as the Board of Trade may from time to time, by notice signed by the Secretary of the Board of Trade and addressed to the Institute, require.

Report to Board of Trade.

29. In these Rules, unless the context otherwise requires—

Definitions.

"The Act" means the Patents, Designs, and Trade Marks Act, 1888.

"The Institute" means the Institute of Patent Agents, acting through the Council for the time being.

"The Registrar" means the Registrar appointed under these Rules.

"Registered patent agent" means any agent for obtaining patents in the United Kingdom whose name is registered under the Act and these Rules.

30. These Rules shall commence and come into operation on the 12th day of June, 1889, but at any time after the making thereof any appointment or regulations may be made and things done for the purpose of bringing these Rules into operation on the said day.

Commencement.

31. These Rules may be cited as the Register of Patent Agents Rules, 1889.

Title.

By the Board of Trade,
COURTENAY BOYLE,
Assistant Secretary, Railway Department.

The 11th day of June, 1889.

Form of Register.

APPENDIX A.

Form 1.

Form of Register.

Name.	Designation.	Address.	Date of Registration

Form 2.

Form of Statutory Declaration.

Register of Patent Agents Rules, 1889.

I, *A.B.* [*insert full name, and in the case of a member of a firm add*, "a member of the firm of "], of , in the county of , Patent Agent, do solemnly and sincerely declare as follows:—

1. That prior to the 24th December, 1888, I had been *bonâ fide* practising in the United Kingdom as a patent agent.

2. That I acted as patent agent in obtaining the following patents:—

[*Give the official numbers and dates of some patents for the United Kingdom in the obtaining of which the declarant acted as patent agent.*]

3. That I desire to be registered as a patent agent in pursuance of the said Act.

And I make this solemn declaration conscientiously believing the same to be true and by virtue of the provisions of the Statutory Declarations Act, 1835.

Declared at

APPENDIX B.

Examination.

PARTICULARS OF PRELIMINARY EXAMINATIONS.

1. The Matriculation Examination at any University in England, Scotland, or Ireland.

2. The Oxford or Cambridge Middle Class Senior Local Examinations.

3. The Examinations of the Civil Service Commissioners for admission to the Civil Service.

APPENDIX C.

FEES.

Nature of Fee.	When to be paid.	To whom to be paid.	Amount.
			£ s. d.
For registration of name of patent agent who had been *bonâ fide* in practice prior to the passing of the Act.	On application and before registration	To the Registrar at the Institute.	5 5 0
For registration of name of any person other than as above.	Do. do.	Do. do.	5 5 0
Annual fee to be paid by every registered patent agent.	On or before November 30 of each year, in respect of the year commencing January 1st following.	Do. do.	3 3 0
On entry of a candidate for the final qualifying examination.	At time of entering name.	Do. do.	2 2 0

REGISTER OF PATENT AGENTS' RULES, 1891.

Whereas by the Register of Patent Agents Rules, 1889, it is provided, amongst other things, that the Register of Patent Agents established by the said Rules shall be kept, and certain duties in reference thereto and to the examination and registration of and otherwise in relation to Patent Agents shall be performed, by the Institute of Patent Agents referred to in the said Rules:

And whereas the said Institute of Patent Agents has been dissolved and ceased to exist, and in place thereof the Chartered Institute of Patent Agents has, by Royal Charter dated the 11th day of August, 1891, been incorporated:

Now, therefore, for the purpose of giving effect to the provisions of the Patents, Designs, and Trade Marks Act, 1888, relating to the registration of Patent Agents, the Board of Trade, by virtue of the provisions of the said Act, hereby make the following Rules:—

Transfer of powers and duties of Institute of Patent Agents to Chartered Institute.

1. From and after the commencement of these Rules all the duties and powers of the Institute of Patent Agents under the Register of Patent Agents Rules, 1889 (hereafter in the present Rules referred to as "the Rules of 1889"), shall be transferred to and vested in the Chartered Institute of Patent Agents, and the Rules of 1889 shall, where applicable, and save so far as they are altered by the present Rules, have effect, with the following modifications:—

(1) For the words "The Institute of Patent Agents" there shall be substituted the words "The Chartered Institute of Patent Agents."

(2) The Registrar shall be the person who, for the purposes of the duties of the Registrar under the Rules of 1889 and the present Rules, shall be continued in office or appointed by the Chartered Institute of Patent Agents.

Saving rights, privileges, acts, appointments, and regulations under Rules of 1889.

2. Nothing contained in the present Rules shall affect any right, privilege, obligation, or liability acquired, accrued, or incurred, any act done, or appointment or regulation made under the Rules of 1889; and any regulation made by the Institute of Patent Agents under the Rules of 1889 prior to the commencement of the present Rules shall be subject to alteration and revocation by subsequent regulations to be made by the Chartered Institute of Patent Agents under Rule 27 of the Rules of 1889, as amended by the present Rules.

Publication of Register.

3. So much of Rule 3 of the Rules of 1889 as provides that the correct copy of the Register therein referred to shall be printed and published in every year subsequent to the year 1889 on the 31st day of January is hereby annulled, and instead thereof the following Rule shall have effect:—

In the month of February in each year, and at such other times as the Chartered Institute of Patent Agents may think desirable, the said Chartered Institute shall cause a correct copy of the Register to be printed under their direction, and placed on sale. **Rule 3.**

4. Instead of Appendix B. to the Rules of 1889 there shall be substituted the Appendix to the present Rules, which may be cited as Appendix B. Alteration of Appendix B.

5. The present Rules shall commence and come into operation on the 19th day of November, 1891, and, together with the Rules of 1889, may be cited as the Register of Patent Agents Rules, 1889 to 1891. Commencement and citation.

By the Board of Trade,
COURTENAY BOYLE,
Assistant Secretary.

Dated the 18th day of November, 1891.

APPENDIX B.

Particulars of Preliminary Examinations.

1. The Matriculation examination at any University in England, Scotland, or Ireland.

2. The Oxford or Cambridge Middle Class Senior Local Examinations.

3. The first public examination before Moderators at Oxford.

4. The previous examination at Cambridge.

5. The examination in Arts for the second year at Durham.

6. The examination for first-class certificate of the College of Preceptors (40 & 41 Vict. c. 25, s. 10).

7. The examination resulting in the obtaining of a Whitworth Scholarship.

APPENDIX III.

INTERNATIONAL CONVENTION FOR THE PROTECTION OF INDUSTRIAL PROPERTY. (*a*)

Signed at Paris, March 20, 1883.

[*Ratifications exchanged at Paris, June* 6, 1884.]

I.

International Convention.

Acceded to by her Majesty's Government, March 17, 1884.

(*Translation.*)

His Majesty the King of the Belgians, his Majesty the Emperor of Brazil, his Majesty the King of Spain, the President of the French Republic, the President of the Republic of Guatémala, his Majesty the King of Italy, his Majesty the King of the Netherlands, his Majesty the King of Portugal and the Algarves, the President of the Republic of Salvador, his Majesty the King of Servia, and the Federal Council of the Swiss Confederation,

Being equally animated with the desire to secure, by mutual agreement, complete and effectual protection for the industry and commerce of their respective subjects and citizens, and to provide a guarantee for the rights of inventors, and for the loyalty of commercial transactions, have resolved to conclude a Convention to that effect, and have named as their Plenipotentiaries, that is to say, &c., &c. :—

Who, having communicated to each other their respective full powers, found in good and due form, have agreed upon the following Articles :—

Article I.

The Governments of Belgium, Brazil, Spain, France, Guatemala, Italy, Holland, Portugal, Salvador, Servia, and Switzerland constitute themselves into a Union for the Protection of Industrial Property.

Les Gouvernements de la Belgique, du Brésil, de l'Espagne, de la France, du Guatemala, de l'Italie, des Pays-Bas, du Portugal, du Salvador, de la Serbie et de la Suisse sont constitués à l'état d'Union pour la Protection de la Propriété Industrielle.

(*a*) The original French is printed in smaller type below each Article.

Article II.

Article 2.

The subjects or citizens or each of the Contracting States shall, in all the other States of the Union, as regards patents, industrial designs or models, trade-marks and trade names, enjoy the advantages that their respective laws now grant, or shall hereafter grant, to their own subjects or citizens.

Consequently, they shall have the same protection as the latter, and the same legal remedy against any infringement of their rights, provided they observe the formalities and conditions imposed on subjects or citizens by the internal legislation of each State.

Les sujets ou citoyens de chacun des États Contractants jouiront, dans tous les autres États de l'Union, en ce qui concerne les brevets d'invention, les dessins ou modèles industriels, les marques de fabrique ou de commerce et le nom commercial, des avantages que les lois respectives accordent actuellement ou accorderont par la suite aux nationaux.

En conséquence, ils auront la même protection que ceux-ci et le même recours légal contre toute atteinte portée à leurs droits, sous réserve de l'accomplissement des formalités et des conditions imposées aux nationaux par la législation intérieure de chaque État.

Article III.

Subjects or citizens of States not forming part of the Union, who are domiciled or have industrial or commercial establishments in the territory of any of the States of the Union, shall be assimilated to the subjects or citizens of the Contracting States.

Sont assimilés aux sujets ou citoyens des États Contractants les sujets ou citoyens des États ne faisant pas partie de l'Union qui sont domiciliés ou ont des établissements industriels ou commerciaux sur le territoire de l'un des États de l'Union.

Article IV.

Any person who has duly applied for a patent, industrial design or model, or trade-mark in one of the Contracting States, shall enjoy, as regards registration in the other States, and reserving the rights of third parties, a right of priority during the periods hereinafter stated.

Consequently, subsequent registration in any of the other States of the Union before expiry of these periods shall not be invalidated through any acts accomplished in the interval, either, for instance, by another registration, by publication of the invention, or by the working of it by a third party, by the sale of copies of the design or model, or by use of the trade-mark.

The above-mentioned terms of priority shall be six months for patents, and three months for industrial designs and models and trade-marks. A month longer is allowed for countries beyond sea.

Celui qui aura régulièrement fait le dépôt d'une demande de brevet d'invention, d'un dessin ou modèle industriel, d'une marque de fabrique ou de commerce, dans l'un des États Contractants, jouira, pour effectuer le dépôt dans les autres États, et sous réserve des droits des tiers, d'un droit de priorité pendant les délais déterminés ci-après.

En conséquence, le dépôt ultérieurement opéré dans l'un des autres États de l'Union avant l'expiration de ces délais ne pourra être invalidé par des faits accomplis dans l'intervalle, soit, notamment, par un autre dépôt, par la publication de l'invention ou son exploitation par un tiers, par la mise en vente d'exemplaires du dessin ou du modèle, par l'emploi de la marque.

Les délais de priorité mentionnés ci-dessus seront de six mois pour les brevets d'invention, et de trois mois pour les dessins ou modèles industriels, ainsi que pour les marques de fabrique ou de commerce. Ils seront augmentés d'un mois pour les pays d'outre-mer.

ARTICLE V.

Article 5. The introduction by the patentee into the country where the patent has been granted of objects manufactured in any of the States of the Union shall not entail forfeiture.

Nevertheless, the patentee shall remain bound to work his patent in conformity with the laws of the country into which he introduces the patented objects.

L'introduction par le breveté, dans le pays où le brevet a été délivré, d'objets fabriqués dans l'un ou l'autre des États de l'Union, n'entraînera pas la déchéance.

Toutefois le breveté restera soumis à l'obligation d'exploiter son brevet conformément aux lois du pays où il introduit les objets brevetés.

ARTICLE VI.

Every trade-mark duly registered in the country of origin shall be admitted for registration, and protected in the form originally registered in all the other countries of the Union.

That country shall be deemed the country of origin where the applicant has his chief seat of business.

If this chief seat of business is not situated in one of the countries of the Union, the country to which the applicant belongs shall be deemed the country of origin.

Registration may be refused if the object for which it is solicited is considered contrary to morality or public order.

Toute marque de fabrique ou de commerce régulièrement déposée dans le pays d'origine sera admise au dépôt et protégée telle quelle dans tous les autres pays de l'Union.

Sera considéré comme pays d'origine le pays où le déposant son principal établissement.

Si ce principal établissement n'est point situé dans un des pays de l'Union, sera considéré comme pays d'origine celui auquel appartient le déposant.

Le dépôt pourra être refusé, si l'objet pour lequel il est demandé est considéré comme contraire à la morale ou à l'ordre public.

ARTICLE VII.

The nature of the goods on which the trade-mark is to be used can, in no case, be an obstacle to the registration of the trade-mark.

La nature du produit sur lequel la marque de fabrique ou de commerce doit être apposée ne peut, dans aucun cas, faire obstacle au dépôt de la marque.

ARTICLE VIII.

A trade name shall be protected in all the countries of the Union, without necessity of registration, whether it form part or not of a trade-mark.

Le nom commercial sera protégé dans tous les pays de l'Union sans obligation de dépôt, qu'il fasse ou non partie d'une marque de fabrique ou de commerce.

ARTICLE IX.

All goods illegally bearing a trade-mark or trade name may be seized on importation into those States of the Union where this mark or name has a right to legal protection.

The seizure shall be effected at the request of either the proper

Public Department or of the interested party, pursuant to the internal legislation of each country. **Article 9.**

Tout produit portant illicitement une marque de fabrique ou de commerce, ou un nom commercial, pourra être saisi à l'importation dans ceux des États de l'Union dans lesquels cette marque ou ce nom commercial ont droit à la protection légale.

La saisie aura lieu à la requête soit du Ministère Public, soit de la partie intéressée, conformément à la législation intérieure de chaque État.

ARTICLE X.

The provisions of the preceding Article shall apply to all goods falsely bearing the name of any locality as indication of the place of origin, when such indication is associated with a trade name of a fictitious character or assumed with a fraudulent intention.

Any manufacturer of, or trader in, such goods, established in the locality falsely designated as the place of origin, shall be deemed an interested party.

Les dispositions de l'Article précédent seront applicables à tout produit portant faussement, comme indication de provenance, le nom d'une localité déterminée, lorsque cette indication sera jointe à un nom commercial fictif ou emprunté dans une intention frauduleuse.

Est réputé partie intéressée tout fabricant ou commerçant engagé dans la fabrication ou le commerce de ce produit, et établi dans la localité faussement indiquée comme provenance.

ARTICLE XI.

The High Contracting Parties agree to grant temporary protection to patentable inventions, to industrial designs or models, and trade-marks, for articles exhibited at official or officially recognized International Exhibitions.

Les Hautes Parties Contractantes s'engagent à accorder une protection temporaire aux inventions brevetables, aux dessins ou modèles industriels, ainsi qu'aux marques de fabrique ou de commerce, pour les produits qui figureront aux Expositions Internationales officielles ou officiellement reconnues.

ARTICLE XII.

Each of the High Contracting Parties agrees to establish a special Government Department for industrial property, and a central office for communication to the public of patents, industrial designs or models, and trade-marks.

Chacune des Hautes Parties Contractantes s'engage à établir un service spécial de la Propriété Industrielle et un dépôt central, pour la communication au public des brevets d'invention, des dessins ou modèles industriels et des marques de fabrique ou de commerce.

ARTICLE XIII.

An international office shall be organized under the name of "Bureau International de l'Union pour la Protection de la Propriété Industrielle" (International Office of the Union for the Protection of Industrial Property).

This office, the expense of which shall be defrayed by the Governments of all the Contracting States, shall be placed under the high authority of the Central Administration of the Swiss

Article 13. Confederation, and shall work under its supervision. Its functions shall be determined by agreement between the States of the Union.

Un office international sera organisé sous le titre de "Bureau International de l'Union pour la Protcotion de la Propriété Industrielle."

Co bureau, dont les frais seront supportés par les Administrations do tous les États Contractants, sera placé sous la haute autorité de l'Administration Supérieure de la Confédération Suisse, et fonctionnera sous sa surveillance. Les attributions en seront déterminées d'un commun accord entre les États de l'Union.

Article XIV.

The present Convention shall be submitted to periodical revisions, with a view to introducing improvements calculated to perfect the system of the Union.

To this end Conferences shall be successively held in one of the Contracting States by Delegates of the said States. The next meeting shall take place in 1885 at Rome.

La présente Convention sera soumise à des révisions périodiques en vue d'y introduire les améliorations de nature à perfectionner le système de l'Union.

A cet effet, des Conférences auront lieu successivement, dans l'un des États Contractants, entre les Délégués des dits États.

La prochaine réunion aura lieu en 1885 à Rome.

Article XV.

It is agreed that the High Contracting Parties respectively reserve to themselves the right to make separately, as between themselves, special arrangements for the protection of Industrial Property, in so far as such arrangements do not contravene the provisions of the present Convention.

Il est entendu que les Hautes Parties Contractantes se réservent respectivement le droit de prendre séparément, entre elles, des arrangements particuliers pour la protection de la Propriété Industrielle, en tant que ces arrangements ne contreviendraient point aux dispositions de la présente Convention.

Article XVI.

States which have not taken part in the present Convention shall be permitted to adhere to it at their request.

Such adhesion shall be notified officially through the diplomatic channel to the Government of the Swiss Confederation, and by the latter to all the others. It shall imply complete accession to all the clauses, and admission to all the advantages stipulated by the present Convention.

Les États qui n'ont point pris pari à la présente Convention seront admis à y adhérer sur leur domande.

Cette adhésion sera notifiée par la voie diplomatique au Gouvernement do la Confédération Suisse, et par celui-ci à tous les autres.

Elle emportera, de plein droit, accession à tout les clauses et admission à tous les avantages stipulés par la présente Convention.

Article XVII.

The execution of the reciprocal engagements contained in the present Convention is subordinated, in so far as necessary, to the observance of the formalities and rules established by the Constitutional laws of those of the High Contracting Parties who are bound to procure

the application of the same, which they engage to do with as little delay as possible. Article 17.

L'exécution des engagements réciproques contenus dans la présente Convention est subordonnée, en tant que de besoin, à l'accomplissement des formalités et règles établies par les lois constitutionnelles de celles des Hautes Parties Contractantes qui sont tenues d'en provoquer l'application, ce qu'elles s'obligent à faire dans le plus bref délai possible.

ARTICLE XVIII.

The present Convention shall come into operation one month after the exchange of ratifications, and shall remain in force for an unlimited time, till the expiry of one year from the date of its denunciation. This denunciation shall be addressed to the Government commissioned to receive adhesions. It shall only effect the denouncing State, the Convention remaining in operation as regards the other Contracting Parties.

La présente Convention sera mise à exécution dans le délai d'un mois à partir de l'échange des ratifications et demeurera en vigueur pendant un temps indéterminé, jusqu'à l'expiration d'une année à partir du jour où la dénonciation en sera faite.

Cette dénonciation sera adressée au Gouvernement chargé de recevoir les adhésions. Elle ne produira son effet qu'à l'égard de l'État qui l'aura faite la Convention restant exécutoire pour les autres Parties Contractantes.

ARTICLE XIX.

The present Convention shall be ratified, and the ratifications exchanged in Paris, within one year of the latest.

La présente Convention sera ratifiée, et les ratifications en seront échangées à Paris dans le délai d'un an au plus tard.

In witness whereof the respective Plenipotentiaries have signed the same, and have affixed thereto their seals.

Done at Paris the 20th March, 1883.

(Signed)

(L.S.) BEYENS.
(L.S.) VILLENEUVE.
(L.S.) DUC DE FERNAN-NUNEZ.
(L.S.) P. CHALLEMEL-LACOUR.
(L.S.) CH. HERISSON.
(L.S.) CH. JAGERSCHMIDT.
(L.S.) CRISANTO-MEDINA.
(L.S.) RESSMAN.
(L.S.) Baron DE ZUYLEN DE NYEVELT.
(L.S.) JOSE DA SILVA MENDES LEAL.
(L.S.) F. D'AZEVEDO.
(L.S.) J.-M. TORRES-CAÏCEDO.
(L.S.) SIMA M. MARINOVITCH.
(L.S.) LARDY.
(L.S.) J. WEIBEL.

Protocol.

II.

Final Protocol.

(*Translation.*)

On proceeding to the signature of the Convention concluded this day between the Governments of Belgium, Brazil, Spain, France, Guatemala, Italy, the Netherlands, Portugal, Salvador, Servia, and Switzerland, for the protection of Industrial Property, the undersigned Plenipotentiaries have agreed as follows :—

1. The words "Industrial Property" are to be understood in their broadest sense ; they are not to apply simply to industrial products, properly so called, but also to agricultural products (wines, corn, fruits, cattle, etc.), and to mineral products employed in commerce (mineral waters, etc.).

2. Under the word "patents" are comprised the various kinds of industrial patents recognized by the legislation of each of the Contracting States, such as importation patents, improvement patents, etc.

3. The last paragraph of Article II. does not affect the legislation of each of the Contracting States as regards the procedure to be followed before the tribunals, and the competence of those tribunals.

4. Paragraph 1 of Article VI. is to be understood as meaning that no trade-mark shall be excluded from protection in any State of the Union, from the fact alone that it does not satisfy, in regard to the signs composing it, the conditions of the legislation of that State; provided that on this point it comply with the legislation of the country of origin, and that it had been properly registered in said country of origin. With this exception, which relates only to the form of the mark, and under reserve of the provisions of the other Articles of the Convention, the internal legislation of each State remains in force.

To avoid misconstruction, it is agreed that the use of public armorial bearings and decorations may be considered as being contrary to public order in the sense of the last paragraph of Article VI.

5. The organization of the special Department for Industrial Property mentioned in Article XII. shall comprise, so far as possible, the publication in each State of a periodical official paper.

6. The common expenses of the International Office, instituted by virtue of Article XII., are in no case to exceed for a single year a total sum representing an average of 2000 fr. for each Contracting State.

To determine the part which each State should contribute to this total of expenses, the Contracting States, and those which may afterwards join the Union, shall be divided into six classes, each contributing in the proportion of a certain number of units, namely :—

1st class . . .	25 units.	4th class . . .	10 units.
2nd class . . .	20 „	5th class . . .	5 „
3rd class . . .	15 „	6th class . . .	3 „

These co-efficients will be multiplied by the number of States in each class, and the sum of the result thus obtained will supply the number of units by which the total expense has to be divided. The quotient will give the amount of the unit of expense.

The Contracting States are classed as follows, with regard to the division of expense :—

1st class . . .	France, Italy.
2nd class . . .	Spain.
3rd class . . .	Belgium, Brazil, Portugal, Switzerland.

4th class	Holland.
5th class	Servia.
6th class	Guatemala, Salvador.

The Swiss Government will superintend the expenses of the International Office, advance the necessary funds, and render an annual account, which will be communicated to all the other Administrations.

The International Office will centralize information of every kind relating to the protection of Industrial Property, and will bring it together in the form of a general statistical statement, which will be distributed to all the Administrations. It will interest itself in all matters of common utility to the Union, and will edit, with the help of the documents supplied to it by the various Administrations, a periodical paper in the French language dealing with questions regarding the object of the Union.

The numbers of this paper, as well as all the documents published by the International Office, will be circulated among the Administrations of the States of the Union in the proportion of the number of contributing units as mentioned above. Such further copies as may be desired, either by the said Administrations or by Societies or private persons, will be paid for separately.

The International Office shall at all times hold itself at the service of members of the Union, in order to supply them with any special information they may need on questions relating to the international system of Industrial Property.

The Administration of the country in which the next conference is to be held will make preparations for the transactions of that conference, with the assistance of the International Office.

The Director of the International Office will be present at the meetings of the conferences, and will take part in the discussions, but without the privilege of voting.

He will furnish an annual Report upon his administration of the office, which shall be communicated to all the members of the Union.

The official language of the International Office will be French.

7. The present Final Protocol, which shall be ratified together with the Convention concluded this day, shall be considered as forming an integral part of, and shall have the same force, validity, and duration as the said Convention.

In witness whereof the undersigned Plenipotentiaries have drawn up the present Protocol.

(Signed) BEYENS.
VILLENEUVE.
DUC DE FERNAN-NUNEZ.
P. CHALLEMEL-LACOUR.
CH. HERISSON.
CH. JAGERSCHMIDT.
CRISANTO-MEDINA.
RESSMAN.
Baron DE ZUYLEN DE NYEVELT.
JOSE DA SILVA MENDES LEAL.
F. D'AZEVEDO.
J.-M. TORRES-CAÏCEDO.
SIMA M. MARINOVITCH.
LARDY.
J. WEIBEL.

Accession to Convention.

III.

ACCESSION OF HER MAJESTY'S GOVERNMENT TO THE CONVENTION SIGNED AT PARIS, *March* 20, 1883.

THE Undersigned, Ambassador Extraordinary and Plenipotentiary of her Majesty the Queen of the United Kingdom of Great Britain and Ireland to the French Republic, declares that her Britannic Majesty, having had the International Convention for the Protection of Industrial Property, concluded at Paris on the 20th March, 1883, and the Protocol relating thereto, signed on the same date, laid before her, and availing herself of the right reserved by Article XVI. of that Convention to States not parties to the original Convention, accedes, on behalf of the United Kingdom of Great Britain and Ireland, to the said International Convention for the Protection of Industrial Property, and to the said Protocol, which are to be considered as inserted word for word in the present Declaration, and formally engages, as far as regards the President of the French Republic and the other High Contracting Parties, to co-operate on her part in the execution of the stipulations contained in the Convention and Protocol aforesaid.

The undersigned makes this Declaration on the part of her Britannic Majesty with the express understanding that power is reserved to her Britannic Majesty to accede to the Convention on behalf of the Isle of Man and the Channel Islands, and any of her Majesty's possessions, on due notice to that effect being given through her Majesty's Government.

In witness whereof the Undersigned, duly authorized, has signed the present Declaration of Accession, and has affixed thereto the seal of his arms.

Done at Paris, on the 17th day of March, 1884.

(L.S.) (Signed) LYONS.

IV.

DECLARATION OF ACCEPTANCE OF ACCESSION.

(*Translation.*)

HER Majesty the Queen of the United Kingdom of Great Britain and Ireland, having acceded to the International Convention relative to the Protection of Industrial Property, concluded at Paris, March 20, 1883, together with a Protocol dated the same day, by the Declaration of Accession delivered by her Ambassador Extraordinary and Plenipotentiary to the Government of the French Republic; the text of which Declaration is word for word as follows:—

[Here is inserted the text of No. III. in English.]

The President of the French Republic has authorized the Undersigned, President of the Council, Minister for Foreign Affairs, to formally accept the said Accession, together with the reserves which are contained in it concerning the Isle of Man, the Channel Islands,

and all other possessions of her Britannic Majesty, engaging as well in his own name as in that of the other High Contracting Parties, to assist in the accomplishment of the obligations stipulated in the Convention and the Protocol thereto annexed, which may concern the United Kingdom of Great Britain and Ireland. **Acceptance of Accession.**

In witness whereof the Undersigned, duly authorized, has drawn up the present Declaration of Acceptance, and has affixed thereto his seal.

Done at Paris, the 2nd April, 1884.

(L.S.) (Signed) JULES FERRY.

ORDER IN COUNCIL

APPLYING SECTION 103 OF THE ACT OF 1883 TO THE SIGNATORIES TO THE INTERNATIONAL CONVENTION (*a*).

At the Court at Windsor, the 26th day of June, 1884: *Present*—
The Queen's most Excellent Majesty in Council.

WHEREAS by the provisions of the Patents, Designs, and Trade Marks Act, 1893, it is among other things provided:—

That if her Majesty is pleased to make any arrangement with the Government or Governments of any foreign State or States for mutual protection of inventions, designs, and trade marks, or any of them, then any person who has applied for protection for any invention, design, or trade mark, in any such State, shall, subject to the conditions further provided and set forth in the said Act, be entitled to a patent for his invention, or to registration of his design or trade mark (as the case may be) under the said Act in priority to other applicants, and such patent or registration shall have the same date as the date of the protection obtained in such foreign State. Recital of Act of 1883, sect. 103.

And whereas it has pleased her Majesty to make an arrangement of the nature contemplated by the said Act, by and in virtue of a declaration signed and sealed by her Majesty's Ambassador at Paris on the 17th March, 1884, duly conveying the accession of Great Britain to the International Convention and Protocol for the Protection of Industrial Property, signed by the representatives of certain Powers on the 20th day of March, 1883, and duly ratified on the 6th day of June, 1884, power being reserved to her Majesty to hereafter accede to the provisions of the said Convention and Protocol on behalf of the Isle of Man, the Channel Islands, and any of her Majesty's possessions, which declaration or accession was duly accepted by the French Government on behalf of the signatory Powers, by and in virtue of a declaration dated the 2nd April, 1884. Recital of accession of Great Britain to International Convention.

Now, therefore, her Majesty, by and with the advice and consent of her Privy Council, and by virtue of the authority committed to her by the said Act, doth declare, and it is hereby declared, that the provisions of the said Act hereinbefore specified shall apply to the following countries, namely:— Sect. 103 applied.

Belgium.	Italy.	Salvador.	Switzerland.
Brazil.	Netherlands.	Servia.	Ecuador.
France.	Portugal.	Spain.	Tunis.
Guatemala.			

(*a*) See the *London Gazette* of July 1, 1884.

Order in Council.

And it is hereby further ordered and declared that this Order shall take effect from the 7th day of July, 1884.

C. L. PEEL.

Order, when Order takes effect.

To the list of States above set forth must now be added the following:—Santo Domingo (by Order dated January 17, 1884), Sweden and Norway (July 9, 1885), Queensland (September 17, 1885), Paraguay, Uruguay (September 24, 1886), United States (July 12, 1887), Netherlands (East India Colonies) (November 17, 1888), Mexico (May 28, 1889), New Zealand (February 8, 1890), Netherlands (Curaçao and Surinam) (May 17, 1890), Dominican Republic (October 21, 1890), Zanzibar (May 16, 1893), Tasmania (April 30, 1894), Denmark (and Faroe Islands) (November 20, 1894), Western Australia (May 11, 1895).

For other States to which these international arrangements have been applied, see post, p. 740.

ORDER IN COUNCIL

With Reference to the Paris Exhibition, 1900.

At the Court at Osborne House, Isle of Wight, the 2nd day of February, 1899.

PRESENT,

The QUEEN'S Most Excellent Majesty in Council.

Whereas "The Patents Designs and Trade Marks Act 1883" amongst other things provides by Section 39 that the exhibition of an invention at an industrial or international exhibition certified as such by the Board of Trade or the publication of any description of the invention during the period of the holding of the exhibition or the use of the invention for the purpose of the exhibition in the place where the exhibition is held or the use of the invention during the period of the holding of the exhibition by any person elsewhere without the privity or consent of the inventor shall not prejudice the right of the inventor or his legal 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; and

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

And whereas the said Act further provides by Section 57 that the exhibition at an industrial or international exhibition certified as such by the Board of Trade or the exhibition elsewhere during the period of the holding of the exhibition without the privity or consent of the proprietor of a design or of any article to which a design is applied or the publication during the holding of any such exhibition of a description of a design shall not prevent the design from being registered or

invalidate the registration thereof, provided that both the following conditions are complied with, namely :—

(*a*) The exhibitor must before exhibiting the design or article or publishing a description of the design give the Comptroller the prescribed notice of his intention to do so ; and

(*b*) The application for registration must be made before or within six months from the date of the opening of the exhibition :

And whereas her Majesty, by virtue of the authority committed to her by the provisions of "The Patents Act, 1886," is empowered by Order in Council from time to time to declare that the provisions of the said Act of 1883, above recited, shall apply to any exhibition mentioned in the Order in like manner as if it were an industrial or international exhibition certified by the Board of Trade, and to provide that the exhibitor shall be relieved from the conditions specified in the said hereinbefore recited sections of the said Act of 1883 :

Now therefore, her Majesty by and with the advice of her Privy Council and by virtue of the authority committed to her by the said Act of 1886, doth declare, and it is hereby declared, that the provisions of the foregoing sections of the said Act of 1883 shall apply to the International Exhibition to be held at Paris in the year 1900, and further, that the exhibitor of an invention a design or any article to which a design is applied shall be relieved from the conditions specified in the said hereinbefore recited sections of the said Act of 1883 of giving notice as therein required of his intention to exhibit such invention, design, or article to which a design is applied.

A. W. FITZROY.

CIRCULAR OF INFORMATION.

Issued by the Patent Office for the Guidance of Inventors applying for Letters Patent.

1. Mode of Proceeding to obtain Patents for Inventions in the United Kingdom.—(i.) All applications and communications must be made in English. No models are required.

(ii.) Any person, whether a British subject or not, may make an application for a patent, either by direct communication with the office or through the intervention of an agent. See p. 738, paragraph 16.

Two or more persons may make a joint application for a patent, and a patent may be granted to them jointly. In every case the true and first inventor (or inventors) must be a party (or parties) to the application.

Applicants must apply in their real names and not under assumed or trade names.

A company (body corporate) may apply for a patent as joint applicant with the inventor, but not as sole applicant, unless the application is made in respect of an invention communicated from abroad (Form A1), or under the International and Colonial arrangements (Form A2). The application should be made under the seal of the company.

A firm as such cannot apply for a patent, but a joint application may be made by all the individual members of the firm.

The declaration on Form A (or A1 or A2) must be signed by the applicant or applicants; but all other communications may be made by or through agents duly authorised to the satisfaction of the comptroller. For applications under the International and Colonial arrangements, see pp. 739, 740, paragraph 22.

(iii.) Applications must be left at the Patent Office by hand, or sent by post, addressed to the Comptroller, Patent Office, 25 Southampton Buildings, Chancery Lane, London, W.C.

(iv.) Every application must be accompanied by a statement of an address to which all communications from the Patent Office may be sent.

(v.) Application for a patent may be made in one of two ways:—(*a*) The applicant may apply in the first instance for provisional protection, [see (vi.), (vii.), (viii.) below], and at any later period within nine months may leave his complete specification, or (*b*) the applicant may leave his complete specification at the time of making his application, [see (ix.), (x.) below], in which case a provisional specification is unnecessary.

Application accompanied by Provisional Specification.

(vi.) An application for Provisional Protection consists of—

(*a*) The Application Form A or (for inventions communicated from abroad) A1, or (for applications under the International and Colonial arrangements) A2, stamped £1, duly filled in as directed by the marginal notes on the form, and signed by the applicant or applicants, and

(*b*) The Provisional Specification, Form B, in duplicate. Form B does not require to be stamped.

(vii.) The provisional specification must fairly describe the nature of the invention and be accompanied by drawings if required. See (xiii.) below for regulations as to drawings. The applicant should in this document give a clear description of the invention, but he need not enter into all the minute details as to the manner in which the invention is to be carried out.

(viii.) Unless a complete specification, stamped £3, is left within nine months from the date of application (or with extension fee (Form U), ten months), the application is deemed to be abandoned. The complete specification should be prepared as stated at (x.) below. It should refer to the number and date of the provisional specification, and should contain a full and detailed description of the invention, independent of the description given in the provisional specification. Drawings which may have been filed with the provisional specification may be used again with the complete specification, if they are considered suitable. Where this is done the drawings should be referred to in the complete specification as those "left with the provisional specification."

Application accompanied by Complete Specification.

(ix.) An application accompanied by complete specification consists of—

(*a*) The Application Form A or (for inventions communicated from abroad) A1, or (for applications under the International and Colonial arrangements) A2, stamped £1, duly filled in, as directed by the marginal notes on the form, and signed by the applicant or applicants, and

(*b*) The complete specification, Form C, stamped £3, and unstamped duplicate.

(x.) The complete specification must be begun upon Form C (bearing a £3 stamp), and continued, if necessary, on foolscap paper. The duplicate must be an exact copy, but unstamped. The specification should contain a full and detailed description of the invention, of such a nature that the invention could be carried into practical effect by a competent workman from the directions of the document alone. See (xiii.) below for regulations as to drawings.

It is necessary to make a distinct and proper statement of claims in the complete specification, and inventors should be careful that their claims include neither more nor less than they desire to protect

Patent Office Circular.

by their patent. In the claims the actual novelty or novelties in the structure, or composition, or processes, or apparatus, should be stated.

Claims are not intended to be made for the efficiency or advantages of the invention.

Titles of Inventions.

(xi.) The title of the invention should appear on the application form and at the commencement of the specification, and the wording of the title in the two documents should be identical.

In the title of the invention the following forms are not allowable—

(*a*) Fancy names or titles, *e.g.*, The Simplex Wheel; The Hercules Braces.

(*b*) The use of the inventor's name, or of the word "Patent."

(*c*) The abbreviation "*etc.*" This should be replaced by words expressing the intended meaning of the term, or by the phrase "and the like."

Specifications and other Documents.

(xii.) The specifications and all other documents must be written or printed in large and legible characters upon strong wide-ruled foolscap paper measuring thirteen by eight inches (on one side only), leaving a margin of two inches on the left-hand; and the signatures of the applicants or agents thereto must be written in a large and legible hand, and the several sheets should be fastened together at the top left-hand corner.

Drawings.

(xiii.) The provisional or complete specification need not (*a*) be accompanied by drawings if the specification sufficiently describes the invention without them, but if furnished, they should accompany the provisional or complete specification to which they refer. No drawing or sketch such as requires a special engraving for letterpress should appear in the specification itself.

Where drawings accompany the specification, they must be delivered at the Patent Office either in a flat state or on rollers, so as to be free from folds, breaks, or creases.

They must be made on pure white, hot-pressed, rolled, or calendered drawing-paper of smooth surface and good quality, and where possible without colour or Indian-ink washes.

They must be on sheets of one of the two following sizes (the smaller being preferable), thirteen inches at the sides by eight inches at the top and bottom, or thirteen inches at the sides by sixteen inches at the top and bottom, including margin, which must be half an inch wide. If there are more figures than can be shewn on one of the smaller-sized sheets, two or more of these sheets should be used in preference to employing the larger size. When an exceptionally large drawing is required, it should be *continued* on subsequent sheets. There is no limit to the number of sheets that may be sent in.

(*a*) The words "need not be accompanied by drawings," apply mainly to inventions for processes and the like. Mechanical inventions capable of illustration by drawings should be described with their aid.

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To ensure their satisfactory reproduction, the drawings must be executed with *absolutely black Indian ink; the same strength and colour of fine and shade lines to be maintained throughout.* Section lines and lines for effect, or shading lines, must not be closely drawn. Reference figures and letters must be bold, distinct, and not less than one-eighth of an inch in height; and the same letters should be used in different views of the same parts. In cases of complicated drawings, the reference letters must be shewn outside the figure, and connected with the part referred to by a fine line.

The scale adopted should be large enough to shew clearly wherein the invention consists, and only so much of the apparatus, machine, etc., need be shewn as effects this purpose. When the scale is shewn on the drawing it should be denoted, *not* by words, but by a drawn scale.

Drawings must bear the name of the applicant (and in the case of drawings left with a complete specification after a provisional specification, the number and year of the application) in the *left hand top corner;* the number of sheets of drawings sent, and the number of each sheet in the *right-hand top corner;* and the signature of the applicant or his agent in the *right-hand bottom corner.*

No written description of the invention should appear on the drawings.

Wood engravings, or representations of the invention, other than the drawings prepared as above described, will not be received, unless of such a character as to be suitable for reproduction by the process of photo-lithography.

A *facsimile* of the original drawings but *without* colour or Indian-ink washes, and prepared strictly (*a*) in accordance with the regulations prescribed above, must accompany the originals, and be marked "true copy."

If an applicant desires to adopt the drawings lodged with his provisional specification as the drawings for his complete specification, he should refer to them as those "left with the provisional specification."

2. Forms of Application and other Patent Forms.—(i.) Forms are not supplied by the Patent Office, but can be purchased on personal application at the Inland Revenue Office, Royal Courts of Justice (Room No. 6), or, at a few days' notice and upon prepayment of the value of the stamp, at any Money Order Office in the United Kingdom.

If it should not be convenient to apply in person in either of the ways specified, the stamped forms can be ordered by post from the Controller of Stamps, Room 7, Inland Revenue Office, Somerset House, London, W.C. In that case a bankers' draft or a money or postal order, payable to the Commissioners of Inland Revenue and crossed Bank of England, for the value of the stamp and for the cost of postage and registration, must be forwarded to Somerset House with the application for the Form.

		£	s.	d.
Form A.	Application for patent	1	0	0
„ A[1].	„ „ for invention communicated from abroad	1	0	0
„ A[2].	Application for patent under International and Colonial arrangements	1	0	0
„ B.	Provisional specification	No fee.		
„ C.	Complete specification	3	0	0

(*a*) It is desirable that the reference letters in the "true copy" be in *faint blue pencil* (*not* aniline pencil).

Patent Office Circular.

		£	s.	d.
Form	C[1]. On postal request for printed copy of specification (*for use in the United Kingdom only*)	0	0	8
„	D. On notice of opposition to grant of patent. By opponent	0	10	0
„	E. On hearing by comptroller. By applicant and by opponent respectively	1	0	0
„	F. On application to amend specification. Up to sealing	1	10	0
	On application to amend specification. After sealing	3	0	0
„	G. On notice of opposition to amendment. By opponent	0	10	0
„	H. On application to the Board of Trade for a compulsory license	5	0	0
„	I. On opposition to grant of compulsory license	5	0	0
„	J. On certificate of payment of renewal fee :—			
	Before the expiration of the 4th year from date of patent, and in respect of the 5th year	5	0	0
„ „	5th „ „ 6th „	6	0	0
„ „	6th „ „ 7th „	7	0	0
„ „	7th „ „ 8th „	8	0	0
„ „	8th „ „ 9th „	9	0	0
„ „	9th „ „ 10th „	10	0	0
„ „	10th „ „ 11th „	11	0	0
„ „	11th „ „ 12th „	12	0	0
„ „	12th „ „ 13th „	13	0	0
„ „	13th „ „ 14th „	14	0	0
„	K. On enlargement of time for payment of renewal fees :—			
	Not exceeding 1 month	1	0	0
„ „	„ „ 2 months	3	0	0
„ „	„ „ 3 „	5	0	0
„	L. For every entry of an assignment, transmission, or agreement	0	10	0
„	M. For every entry of a license	0	10	0
„	N. For duplicate of letters patent	2	0	0
„	O. On notice to comptroller of intended exhibition of unpatented invention	0	10	0
„	P. On request to comptroller to correct a clerical error. Up to sealing	0	5	0
	On request to comptroller to correct a clerical error. After sealing	1	0	0
„	Q. For certificate of comptroller	0	5	0
„	R. For altering address in register	0	5	0
„	S. For every entry of an extension of patent	0	10	0
„	T. On appeal from comptroller to law officer	3	0	0
„	U. On enlargement of time for leaving complete specification :—Not exceeding 1 month	2	0	0
„	V. On enlargement of time for acceptance of complete specification after 12 months :—			
	Not exceeding 1 month	2	0	0
	„ 2 months	4	0	0
	„ 3 „	6	0	0

(ii.) Forms A, B, C, and C[1] are, however, *usually kept on sale* at the undermentioned places:—

The Inland Revenue Office, Royal Courts of Justice (Room No. 6).

The following Post Offices:—

London General Post Office, E.C.
Post Office, 195, Whitechapel Road, E.
" 239, Borough High Street, S.E.
" Charing Cross, W.C.
Post Office, Lombard Street, E.C.
" 28, Eversholt Street, Camden Town, N.W.
" 12, Parliament Street, S.W.,

and at the following Chief Post Offices:—

IN ENGLAND AND WALES.

Accrington.
Altrincham.
Ashton-under-Lyne.
Barnsley.
Barrow-in-Furness.
Bath.
Bedford.
Beverley.
Birkenhead.
Birmingham.
Blackburn.
Bolton.
Bradford.
Brighton.
Bristol.
Bromsgrove.
Burnley.
Burslem.
Burton-on-Trent.
Bury.
Cambridge.
Cardiff.
Carlisle.
Chatham.
Chester.
Clitheroe.
Congleton.
Coventry.
Crewe.
Croydon.
Darlaston.
Derby.
Dewsbury.
Doncaster.
Dorchester.
Driffield.
Droitwich.
Dudley.
Durham.
Exeter.
Gateshead.
Goole.
Greenwich.
Guildford.
Halifax.
Hartlepool.
Huddersfield.
Hull.
Ipswich.
Keighley.
Kendal.
Kidderminster.
Knaresbro'.
Knutsford.
Lancaster.
Leamington.
Leeds.
Leicester.
Lichfield.
Lincoln.
Liverpool.
Macclesfield.
Manchester.
Middlesbrough.
Nantwich.
Newcastle.
Newport (Mon.).
Northallerton.
Northampton.
Nottingham.
Nuneaton.
Oldbury.
Oldham.
Patrington.
Plymouth.
Pontefract.
Portsmouth.
Prescot.
Preston.
Reading.
Redditch.
Richmond (Yorks.).
Ripon.
Rochdale.
Rotherham.
Rugby.
Salford.
St. Helens.
Scarborough.
Sedgeley.
Sheffield.
Southampton.
Stafford.
Stalybridge.
Stockport.
Stoke-on-Trent.
Stourbridge.
Stourport.
Sunderland.
Swansea.
Tamworth.
Truro.
Tunstall.
Wakefield.
Walsall.
Warrington.
Wednesbury.
West Bromwich.
Whitby.
Widnes.
Wigan.
Wolverhampton.
Wolverton.
Woolwich.
Worcester.
York.

IN SCOTLAND.

Aberdeen.
Dumbarton.
Dundee.
Edinburgh.
Glasgow.
Greenock.
Inverness.
Lanark.
Leith.
Paisley.
Perth.
Renfrew.

IN IRELAND.

Belfast.
Cork.
Dublin.
Dundalk.
Galway.
Limerick.
Londonderry.
Waterford.
Wexford.

3. **Opposition to the Grant of a Patent.**—Under Section 11 of the Act of 1883, opposition may be made to the grant of a patent at any time within two months from the date of the advertisement in the Illustrated Official Journal of the acceptance of the complete specification, by any person; on the ground of the applicant having obtained the invention from him, or from a person of whom he is the legal representative; or on the ground that the invention has been patented in this country on an application of prior date; or on the ground that the complete specification describes or claims an invention other than that described in the provisional specification and that such other invention forms the subject of an application made by the opponent in the interval between the leaving of the provisional specification and the leaving of the complete specification; *but on no other ground.* See par. 2, Form D.

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4. Amendment of Specification.—Under Section 18 of the Act, a complete specification may be amended by way of disclaimer, correction, or explanation, but no amendment will be allowed that would make the specification as amended claim an invention substantially larger than or substantially different from the invention claimed by the specification as it stood before amendment. A request for leave to amend must be made, and signed, by the applicant, or the registered proprietor of the patent, and must be accompanied by a certified printed copy of the specification shewing clearly in red ink the proposed amendments. A printed copy of any published specification may be obtained from the Patent Office, 25, Southampton Buildings, W.C., price 8*d.*, including inland postage. See par. 25. The fee for certifying the printed copy is one shilling. Care should be taken to indicate clearly what part of the printed description it is proposed to omit, and at what point interlineations are to be inserted. Additional description which cannot be written upon the printed copy, should be written upon a separate sheet and attached to the print. See par. 2, Forms F and P.

Note.—It should be remembered that the proposed amendments, whether allowable or not, are made public and advertised, and that this publication may be a bar to obtaining a valid patent for matter disallowed by way of amendment. No amendment of a provisional specification is allowed under Section 18; but clerical errors therein may be corrected.

5. Payment of Renewal Fees for Continuance of Patent.—Every patent is granted for the term of fourteen years from the date of application, subject to the payment, before the expiration of the fourth and each succeeding year during the term of the patent, of the prescribed fee. The patentee may pay all or any of such prescribed annual fees in advance.

TABLE SHOWING AMOUNT OF RENEWAL FEES PAYABLE YEAR BY YEAR.

Year in which the patent is dated.	Amount payable in respective years.										
	1899.	1900.	1901.	1902.	1903.	1904.	1905.	1906.	1907.	1908.	1909.
	£	£	£	£	£	£	£	£	£	£	£
1886	14										
1887	13	14									
1888	12	13	14								
1889	11	12	13	14							
1890	10	11	12	13	14						
1891	9	10	11	12	13	14					
1892	8	9	10	11	12	13	14				
1893	7	8		10	11	12	13	14			
1894	6	7	8	9	10	11	12	13	14		
1895	5	6	7	8	9	10	11	12	13	14	
1896		5	6	7	8	9	10	11	12	13	14
1897			5	6	7	8	9	10	11	12	13
1898				5	6	7	8	9	10	11	12
1899					5	6	7	8	9	10	11

Payment must be made by way of Form J duly stamped, which must be sent to the Patent Office for entry of the payment in the Register. The production of letters patent at the Patent Office on payment of these fees is not required. See par. 2, Form J.

As the payment of these renewal fees is regulated by Act of Parliament, a fee cannot be received a *single day* after it is due; but

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if by accident, mistake, or inadvertence the payment has been omitted, application may be made to the comptroller, on Patent Form "K," for an extension of time to make such payment, specifying the reason for such omission, but no extension can be allowed beyond three months. See par. 2, Form K.

6. **Enlargement of Time.**—Applications for enlargement of time must state in what circumstances and upon what grounds the enlargement is applied for. See par. 2, Forms K, U, and V.

7. **Assignments, Licenses, etc.**—Deeds of assignments of patents, and other documents affecting the proprietorship of patents, licenses to manufacture or use patented inventions, are required by Section 23 of the Act to be entered in the Register at the Patent Office. No document can, however, be recorded until the patent affected has been actually sealed. Every assignment sent for registration must be under hand and seal and duly stamped in accordance with the provisions of the Stamp Act, 1891, and must be accompanied by an attested copy written upon foolscap paper (on one side only) and bearing a 1*s.* impressed stamp, and by the stamped Form of Request. See par. 2, Form L and Form M. Names of individual members of firms should be set out on the Form of Request.

8. **Exhibitions of Unpatented Inventions.**—Any person may exhibit an unpatented invention at an exhibition certified by the Board of Trade as industrial or international, without prejudice to his subsequent patent rights, provided (*a*) that he gives the prescribed notice to the comptroller of his intention so to exhibit it, and (*b*) that the application for a patent be made within six months from the date of the opening of the exhibition. See par. 2, Form O. In the case of exhibitions held out of the United Kingdom (Sec. 3 of the Act of 1886) no notice of intention to exhibit is required to be given to the comptroller.

9. **Comptroller's Certificate.**—Any one wishing to be informed as soon as a complete specification is accepted, or an application for amendment is entered, should forward a copy of Form Q with a request for such information. See par. 2, Form Q. An applicant for a patent, however, is duly notified of the acceptance of his complete specification.

10. **Provisional Protection.**—Provisional protection, which is conferred by the acceptance of an application, entitles an applicant to use and publish his invention without thereby prejudicing his patent-rights, but it does not protect him from infringement. The right to sue for infringement does not arise until a patent is sealed, and then only in respect of such infringements as have been committed after the acceptance and publication of the complete specification. The certificate of receipt issued when an application is lodged does not confer provisional protection.

11. **Searches, Office Copies, etc.**—Searches cannot be undertaken by the Patent Office, but must be made by the person requiring information, or by his solicitor or agent. See par. 25.

The following fees are charged :—		£	*s.*	*d.*
For inspection of original documents	each	0	1	0
For office copies . .	every 100 words (but never less than 1*s.*)	0	0	4
For certifying office copies, MS. or printed . . .	each	0	1	0

An additional stamp duty of one shilling is also charged under the Stamp Act upon certified copies of Registers, or of stamped legal documents.

For office copies of drawings, cost according to size and character of drawings.

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12. Information by Post.—Any person wishing to know whether a particular patent is still in force, or any similar details, may obtain an extract from the Register of Patents upon stating the number and year of the patent and forwarding the fee of one shilling by postal order.

13. Date of Printing Specification and Sealing Patent.—Specifications are printed three weeks after the complete specification has been accepted. The patent is usually sealed about ten weeks after the acceptance of the complete specification, *i.e.* about ten days after the expiration of the period allowed for opposition. See par. 3.

14. Documents not Open to Inspection.—The provisional specification (if any) and the complete specification are not open to public inspection, for searches or for copying, until after the acceptance of the complete specification. The specifications of abandoned or void applications are not printed or open to inspection.

15. Use of the word "Patent."—Any person who represents that any article sold by him is a patented article when no patent has been granted for the same is liable for every offence on summary conviction to a fine not exceeding five pounds. In a case decided by a police magistrate, it was held, however, that a person was entitled to mark goods with the word "patent" after the complete specification had been accepted. (See Section 15 of the Act, and Reports of Patent Cases, vol. 13, p. 265.)

16. Advice on Patent Matters, Opinions as to the Merit or Novelty of Inventions, the Infringement or Fraudulent Appropriation of Inventions, etc.—(*a*) The Patent Office does not undertake to give legal advice or opinions on any subject connected with patent law, which, like other laws, is left to the interpretation of professional men; nor does the Patent Office examine specifications or other documents before they are filed.

(*b*) The Patent Laws of this country make no provision for an official search as regards novelty; and consequently British patents are taken out at the risk of applicants, who are expected to cause a search to be made as to the novelty of their inventions either before they make, or before they complete, their applications. Nor does the Patent Office report as to the patentability of an alleged invention unless its use is contrary to law or morality, or it is of a frivolous nature. According to Section 46 of the Patents, etc., Act, 1883, "'Invention' means any manner of new manufacture the subject of letters patent and grant of privilege within section six of the Statute of Monopolies (that is, the Act of the twenty-first year of the reign of King James the First, chapter three, intituled 'An Act concerning Monopolies and Dispensations with Penal Laws and the Forfeiture thereof'), and includes an alleged invention."

(*c*) It is left to every person to protect his rights by opposition or otherwise. See par. 3. A patent is granted upon an application which passes the prescribed stages and is unopposed, whether the invention be novel or not.

(*d*) The Patent Office cannot recommend any particular patent agent for employment by applicants, but a list of registered patent agents may be obtained from Messrs. Eyre and Spottiswoode, East Harding Street, Fleet Street, E.C., and 32, Abingdon Street, Westminster, S.W., or through any bookseller. Price (including postage) 1*s.* 1*d.*

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17. **Application for Assistance, Reduction of Fees, etc.**—It is not within the power of the comptroller to comply with any of the following requests:—

For pecuniary assistance to obtain patents.
" reduction or remission of any of the fees required by the patent law.
" purchase or acquirement of any interest in patented or other inventions.
" recommendation of any invention for purchase or use by a Government Department or by the public.

18. **Mechanical Inventions not Protected by Registration.**—As many inventors imagine that mechanical inventions can be protected by registration as designs, it may be stated that improvements in the construction, arrangement, or application of machinery can only be protected by a patent.

19. **Patent Medicines.**—Communications with respect to the preparation and supply of medicine stamps appropriated to a particular medicine, or as to the liability to Stamp Duty of so-called "Patent Medicines," should be addressed to the Secretary (Stamps and Taxes), Inland Revenue, Somerset House, W.C.

The use of medicine stamps does not have the effect of letters patent.

20. **Full-size Copies of Drawings.**—Full-size copies of drawings printed by photo-lithography may be obtained at the undermentioned rates:—

No. of copies.	Whole sheets imperial (30 × 22).	Half-sheets imperial (15 × 22).	Foolscap size (.3 × 16).	Half foolscap size (13 × 8).
	s. *d.*	*s.* *d.*	*s.* *d.*	*s.* *d.*
Single copies	25 0	15 0	15 0	10 0
Not exceeding 6 copies ...	28 0	18 0	17 0	12 0
" 12 " ...	30 0	20 0	18 6	13 6
" 25 " ...	32 0	22 0	20 0	15 0

If a satisfactory photograph cannot be obtained from the original drawing, an extra charge will be made to cover the expense of taking a tracing.

When the original drawings are coloured there will also be an extra charge for colouring the copies.

21. **Patents, etc., in the British Colonies and Foreign States.**—Applications for Colonial or Foreign Patents, etc., must be made to the Government of the Colony or Foreign State in which protection is desired. A collection of Colonial and Foreign patent, design, and trade mark laws and rules may be seen in the Free Library of the Patent Office.

22. **International and Colonial Arrangements.**—An International Convention for the Protection of Industrial Property exists between the following States:—

Belgium.
Brazil.
Curaçoa and Surinam.
Denmark.
East Indian Colonies of the Netherlands.
France.
Great Britain.
Italy.
Netherlands.
New Zealand.
Norway.
Portugal.
Queensland.
Santo Domingo.
Servia.
Spain.
Sweden.
Switzerland.
Tunis.
United States of America.

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A copy of the text of the Convention, published by Messrs. Eyre and Spottiswoode, may be purchased for 2*d.* through any bookseller.

Under this Convention, an applicant for a patent in any one of the Contracting States may obtain six or seven months' priority in any of the other States.

Similar arrangements, for the mutual protection of inventions, designs, and trade marks, have been made between Great Britain on the one side, and each of the following States and Colonies on the other :—

Ecuador (Designs and Trade Marks only), Greece (Designs and Trade Marks only), Mexico, Paraguay, Roumania (Designs and Trade Marks only), Tasmania, Uruguay, Western Australia.

An application in the United Kingdom for a patent having priority of date under the International and Colonial arrangements must be made within seven months from the date of the *first* foreign application, and must be signed by the person or persons by whom such first foreign application was made. It must be made upon Form A[2] (stamped £1, and obtainable upon prepayment of the value of the stamp, through any Money Order Office), and in addition to the specification, provisional or complete, must be accompanied by—

1. A copy or copies of the specification and drawings as filed in the Patent Office of the foreign State or British Possession in respect of the first foreign application duly certified by the official chief of such Patent Office, or otherwise verified to the satisfaction of the comptroller;
2. A statutory declaration as to the identity of the invention in respect of which the application is made with the invention in respect of which the said first foreign application was made, and if the specification be in a foreign language, a translation thereof shall be annexed to and verified by such statutory declaration.

An International Office, in connection with the Convention, has been established at Berne, Switzerland, which publishes a monthly periodical, entitled "La Propriété Industrielle." The yearly subscription (including postage) for all countries within the Postal Union is 5 francs 60 centimes, and should be forwarded by money order to L'Imprimerie Co-opérative, Berne.

23. Patent Museum, South Kensington.—This Museum was in 1883 placed under the management of the Department of Science and Art. It no longer forms a separate section, but has been incorporated with the general Science Collections of the South Kensington Museum. All communications relating thereto should be addressed to the Secretary, Science and Art Department, South Kensington, London, S.W. The Science Collections are open to the public *free* daily, from 10 a.m. to 10 p.m. on Mondays, Tuesdays, and Saturdays, and from 10 a.m. to 4, 5, or 6 p.m. on other days of the week, according to the season. A number of the models may be seen in motion from 11 a.m. to the hour of closing. Entrance—Exhibition Road.

24. Patent Office Library.—The reading rooms of the Free Public Library, in the Patent Office, are open daily, from 10 a.m. till 10 p.m., except on Sundays, Christmas Day, Good Friday, and Bank Holidays. On the day observed as her Majesty's birthday, Christmas Eve, Easter Eve, and Whitsun Eve, the Library is closed at 4 p.m.

During the re-building of the Patent Office, the Free Library will be transferred to temporary premises in Bishop's Court, Chancery Lane (a few yards west of the Chancery Lane Post-office).

Patent Office Circular.

In addition to the Printed Specifications, Indexes, and other publications of the Patent Office, the Library contains a collection of the leading British and Foreign Scientific Journals, Transactions of Learned Societies, and text-books of Science and Art, and the full or abridged Patent Specifications of the following countries :—Barbados, Belgium, Canada, Cape Colony, Denmark, France, Germany, Italy, Japan, Mauritius, Natal, New South Wales, Norway, Portugal, Queensland, Russia, St. Lucia, St. Vincent, Straits Settlements, Sweden, Switzerland, Trinidad, United States of America, Victoria.

25. **Patent Office Publications.**—These may be consulted daily at the Free Public Library in the Patent Office; at the Science and Art Department, South Kensington; and at the Free Libraries, etc., named on pp., etc. (*a*) They are also on sale at the Patent Office, 25, Southampton Buildings, Chancery Lane, W.C.

Specifications and other publications will be forwarded by post on receipt of the price and of the postage when such is charged. *Sums amounting to* 1*s. or more must be remitted by postal or post-office order payable to the Comptroller-General.* Postage stamps sent in payment of any amount exceeding 11*d.* will be returned. Cheques will not be accepted.

In ordering specifications the name of the patentee, and the No. and year of the patent must be given. These particulars can be obtained by searching the Indexes of Patents and (for recent specifications) the Illustrated Official Journal. Such searches cannot be undertaken by the Patent Office (see par. 11). The Indexes and the Journals can be referred to at the places named in the List "A" following (*b*), and at the Patent Office Library (see par. 24). The price of each specification is 8*d.*, which includes postage in the United Kingdom.

Printed specifications or other publications cannot be returned by the purchasers, unless a wrong No. has been supplied through an error on the part of the Patent Office.

26. **Specifications of Foreign Patents.**—Specifications of foreign patents are not sold by the Patent Office. Applications for these should be made to the Patent Office of the country in which the patent was granted. (*a*)

(*a*) The Lists of places receiving donations of Patent Office Works and the List of Patent Office Publications are here omitted.

(*b*) Ibid.

War Office Memo.

WAR OFFICE MEMORANDUM FOR INVENTORS.

WAR OFFICE,
1*st February*, 1900.

In consequence of the numerous claims for compensation for loss of time, and for expenses incurred by private individuals in working out inventions of various kinds, as well as rewards in consequence of the use of such inventions, the Secretary of State for War considers it necessary to make known the following regulations :—

1. By Section 27 of the "Patents, Designs, and Trade Marks Act, 1883," it is enacted as follows :—

> "A patent shall have to all intents the like effect as against her Majesty the Queen, her heirs and successors, as it has against a subject.
>
> "But the officers or authorities administering any department of the service of the Crown may, by themselves, their agents, contractors, or others, at any time after the application, use the invention for the service of the Crown on terms to be before or after the use thereof agreed on, with the approval of the Treasury, between those officers and authorities and the patentee, or in default of such agreement, on such terms as may be settled by the Treasury, after hearing all parties interested."

2. Persons who desire to submit any invention for consideration should do so by letter addressed to the Under Secretary of State for War. The letter should state the nature of the Invention ; whether patented or not ; if patented, it should quote number and date of patent. It should also state whether the person who offers it for consideration desires to make any claim for remuneration in connection with it. In the absence of such a statement, it will be assumed that no such remuneration is expected.

3. Expenses or loss of time incurred before or after the submission of an invention will give no claim unless authority for such expenses has been previously given by letter signed by one of the Under Secretaries of State or the Director-General of Ordnance, and the liability will be strictly confined to the limits of expenditure authorised in such letter.

4. Should the invention be adopted into the service, the person or persons who submitted the same may be required to furnish two copies of all designs, drawings, or particulars relating to the invention which may be desired by the War Department, as well as any patterns which may be considered necessary; and it is to be understood that all such drawings, designs, and patterns will be absolutely at

the disposal of H.M.'s Government for all purposes whatever. Reasonable prices will be paid by the War Department for the designs, drawings, and patterns supplied. **War Office Memo.**

5. No claim for reward for an invention will be held to be established, unless the invention has been adopted into the service, and all designs, drawings, patterns, and particulars required by the War Department have been supplied, under the conditions mentioned above.

6. All claims for remuneration will be carefully considered; but any award which may be made will only be payable to the claimant when approved by the Treasury, and money is available from funds voted by Parliament for such purposes.

7. The above rules do not apply to inventions patented by such Government employés as are required to obtain official permission before taking out a patent, with regard to whom special regulations are in force.

RALPH H. KNOX.

Admiralty Memo.

LETTER AND MEMORANDUM FOR INVENTORS ISSUED BY THE ADMIRALTY.

ADMIRALTY, S.W.,
189 .

SIR,

In reply to your letter of the , I am commanded by my Lords Commissioners of the Admiralty to acquaint you that if you will comply with the Instructions contained in the accompanying "Memorandum for Inventors," dated 1st July, 1895, and containing Regulations for the reception of Inventions submitted to this Office, your proposal shall be duly considered.

2. In the event of your desiring to submit your proposal in accordance with the Memorandum, it is necessary that sufficient particulars should be given to enable the same to be fully considered, including any evidence you may have of the usefulness of the Invention obtained by actual previous experiment.

3. Should it be considered desirable to try your Invention in a Dockyard or elsewhere, the provision of the article and all expenses connected with carriage, fitting up and removing it will have to be borne by you.

4. I am at the same time to inform you that if any plans, models, or papers, which form an essential part of the description of your Invention, are forwarded to this Office, they will be retained by their Lordships for future reference, and cannot therefore be returned to you.

I am, Sir,
Your obedient Servant,
EVAN MACGREGOR.

MEMORANDUM FOR INVENTORS.

ADMIRALTY,
1st July, 1895.

In consequence of the numerous claims for compensation for loss of time, and for expenses incurred by private individuals in working out inventions of various kinds, as well as for rewards in consequence of the use of such inventions, the Lords Commissioners of the Admiralty consider it necessary to make known the following Regulations:—

Admiralty Memo.

1. By Section 27 of the "Patents, Designs, and Trade Marks Act, 1883," it is enacted as follows:—

"A Patent shall have to all intents the like effect as against her Majesty the Queen, her Heirs, and Successors, as it has against a subject.

"But the Officers or Authorities administering any Department of the service of the Crown, may by themselves, their agents, contractors, or others, at any time after the application, use the invention for the service of the Crown, on terms to be before or after the use thereof agreed on, with the approval of the Treasury, between those Officers or Authorities and the Patentee, or, in default of such agreement, on such terms as may be settled by the Treasury, after hearing all parties interested."

2. Persons who desire to submit any invention for consideration, should do so by letter addressed to the Secretary of the Admiralty. The letter should state the nature of the invention; whether patented or not; if patented, it should quote number and date of patent. It should also state whether the person who offers it for consideration desires to make any claim for remuneration in connection with it. In the absence of such a statement it will be assumed that no such remuneration is expected.

3. Expenses or loss of time incurred before or after the submission of an invention will give no claim, unless authority for such expenses has been previously given by letter signed by the Secretary of the Admiralty; and the liability will be strictly confined to the limits of expenditure authorised in such letter.

4. Should the invention be adopted into the Service, the person or persons who submitted the same may be required to furnish two copies of all designs, drawings, or particulars relating to the invention, which may be desired by the Admiralty, as well as any patterns which may be considered necessary; and it is to be understood that all such drawings, designs, and patterns will be absolutely at the disposal of her Majesty's Government for all purposes whatever. Reasonable prices will be paid by the Admiralty for the designs, drawings, and patterns supplied.

5. No claim for reward for an invention will be held to be established, unless the invention has been adopted into the Service; and all designs, drawings, patterns and particulars required by the Admiralty have been supplied under the conditions mentioned above.

6. All claims for remuneration will be carefully considered; but any award which may be made will only be payable to the claimant when approved by the Treasury, and money is available from funds voted by Parliament for such purposes.

7. The above rules do not apply to inventions patented by such Government employés as are required to obtain official permission before taking out a patent, with regard to whom special regulations are in force.

APPENDIX IV.

Forms.

FORMS AND PRECEDENTS.

A.—PROCEEDINGS FOR REVOCATION OF LETTERS PATENT.

(See ante, p. 358, Chapter XX.)

No. 1.

Petition for Revocation. (*a*)

In the High Court of Justice, 1893, D. No.
Chancery Division.
Mr. Justice ,
In the Matter of the Patents, Designs, and Trade Marks Acts, 1883—1888,
and
In the Matter of Letters Patent granted to J. D., jun., No. of ,
and
Between T. P. . . . Petitioner
and
J. D. the Elder and
W. R. Co., Ltd. . Respondents.

To Her Majesty's High Court of Justice.

The Humble Petition of T. P., of in the County of London, gunmaker.

Sheweth as follows:—

1. Your petitioner is duly authorized by her Majesty's Attorney-General in England to present this petition.

2. Letters Patent dated , of 1884, have been granted to J. D., junior, for an invention entitled, "Improvements in the extracting mechanism of drop-down small arms."

3. The said Letters Patent by assignment dated, ,

(*a*) *Deeley's Patent.*

were absolutely assigned by the said J. D., junior, to the respondent, J. D., senior, who is the owner of the said Letters Patent. The respondents, W. R. & Co., Ltd., are the sole and exclusive licensees of the said Letters Patent.

4. By judgment of this Hon. Court, dated , , in an action in which the respondents were plaintiffs and the petitioner was defendant, the said Letters Patent were adjudged and declared void in law, and of no force and effect. The said judgment was, on the day of , , affirmed by her Majesty's Court of Appeal (England).

5. The said invention was not new at the date of the said Letters Patent for the reasons stated in the Particulars of Objections delivered herewith.

6. The said alleged invention was not any manner of new manufacture, the subject-matter of Letters Patent within Section 6 of the Statute of Monopolies.

Your Petitioner humbly prays that the said Letters Patent may be revoked. And your Petitioner will ever pray.

(Signed) T. P.

It is intended to serve this petition on—

J. D. the elder of, etc.,

And on W. R. & Co., Ltd., of, etc.

Pursuant to Section 26 (4) (*b*) of the Patents, Designs, and Trade Marks Act, 1883, I hereby authorize the presentation of the above written petition to the High Court of Justice.

Dated this day of , .

C. RUSSELL,
Attorney-General.

No. 2.

Another Petition for Revocation. (*a*)

In the High Court of Justice,

Chancery Division.

Mr. Justice ,

In the Matter of G. & G.'s Patent No. , A.D. 1882,

and

In the Matter of the Patents, Designs, and Trade Marks Act, 1883.

To Her Majesty's High Court of Justice.

The Humble Petition of S. Z. F., of , in the City of London.

Sheweth as follows:—

1. Your petitioner is an electrician, and the patentee of many inventions in connection with the production, distribution, and utilization of electric currents, which inventions are now in extensive practical use.

(*a*) *Goulard and Gibbs' Patent.*

Forms.

2. Among other methods of distribution, for some time past your petitioner has especially occupied himself with methods of effecting the same by means of secondary generators, by which electrical action is obtained at different points of an electrical circuit by means of electric induction only, without interrupting such circuit or making any connection conveying the current.

3. In or about the month of , 1885, your petitioner invented an improved form of secondary generator, for the purpose of effecting, economically and conveniently, the above-mentioned object, and on the day of , your petitioner applied for and obtained a Provisional Protection, No. , for such invention, and has since filed a complete specification for the said invention.

4. Since obtaining the said provisional protection, your petitioner has manufactured and used secondary generators constructed according to your petitioner's said invention, and the same have been shewn to possess great advantages over other forms, and to be of great practical utility.

5. The sale and user of the said secondary generators, made according to your petitioner's invention, has recently been interfered with by a limited company named the N. Company. The said company claim to be entitled to restrain any person using any mode of electrical distribution by means of secondary generators of whatever form or construction such generators may be.

6. The said claim of the aforesaid company purports to be based upon Letters Patent granted to L. G. & J. D. G., and numbered A.D. . The invention in respect of which the said Letters Patent were granted was in no wise novel at the date of the same, and the said Letters Patent are, and always have been, of no force and validity by reason thereof, and of the other matters set forth in the Particulars of Objections delivered herewith in pursuance of Section 26 of the above-named Act.

7. The existence of the above-named Letters Patent claiming a wide and general monopoly of the system of distribution by means of secondary generators, which was known to, and the property of the public at the date of the said Letters Patent, has been, and is, the cause of great injury to the public by preventing the sale of machines made according to your petitioner's invention, as well as those made by other inventors, who likewise have made improvements in secondary generators and in the distribution of electricity thereby.

8. That the public are prejudiced by the above-mentioned general claim in the said Letters Patent, because consumers of electricity are not in general acquainted with the science of electricity and the technical application thereof, and are therefore unable to form an opinion as to the invalidity of the said Letters Patent, whereby the sale and use of improved secondary generators are wholly prevented.

9. The office of Mr. , of , in the County of Middlesex, is the place where the petitioner may be served with any petition or summons, or notice of any proceedings or order of this Court relating to the matters herein referred to.

Your petitioner therefore humbly prays for the revocation of Letters Patent, No. , A.D. 1882, or that such order

may be made in the premises as to this Hon. Court may seem meet.

And your Petitioner will ever pray, etc.

(Signed) S. Z. F.

It is intended to serve this petition on L. G., J. D. G., and the N. Company, Limited.

I hereby authorize the presentation to the High Court of Justice of the above written petition.

(Signed) RICHARD E. WEBSTER,
Attorney-General.

Royal Courts of Justice.
(Date.)

No. 3.

Another Petition for Revocation. (*a*)

In the High Court of Justice, 1895, G. No.
Chancery Division.
Mr. Justice
In the Matter of Letters Patent No. of A.D. 1894, granted to C. P. G. and E. H.,
and
In the Matter of the Patents, Designs, and Trade Marks Acts, 1883 to 1888.

To Her Majesty's High Court of Justice.

The Humble Petition of trading as M. & Company of in the County of London, Opticians and Dealers in Photographic Instruments, and of trading as V. & S. of in the Empire of Germany, on the day of preferred unto this Court.

Sheweth as follows:—

Your petitioners, M. & Company, are dealers in photographic apparatus. Your petitioners, V. & S., are manufacturers of optical instruments.

The said Letters Patent, No. of , were granted on an application dated to C. P. G., manufacturer, of , and E. H., optician, of , both near Berlin, in the Empire of Germany, for an alleged invention consisting in "Improvements relating to Double Lenses for photographic purposes."

In the specification describing the said alleged invention the patentees claimed as novel, (1) a photographic double objective, the two separate systems of which are independently corrected for spherical chromatic and astigmatic error, and to this end consist each of three cemented lenses, one of the cemented surfaces of which acts by converging, *i.e.* by collecting the rays of light (to correct the astigmatic error), and the other cemented surface acts by diverging, *i.e.* by

(*a*) *Goerz and Hoegh's Patent.*

Forms.

scattering the rays of light (to correct the spherical error), the two systems being composed, (*a*) of a negative lens of medium refractive index cemented to two positive lenses placed in juxtaposition with each other, one of these latter having a higher and the other a lower refractive index than the negative lens which lies outside, or (*b*) of a positive lens of medium refractive index cemented to two negative lenses placed in juxtaposition with each other, one of which has a higher and the other a lower refractive index than the positive lens which lies outside; and further (2) the employment of a single system of the kind referred to in the first claiming clause as an independent photographic objective.

Your petitioners submit that the said Letters Patent are invalid, and ought to be revoked by reason that your petitioners had publicly used and sold within the realm, before the date of the said Letters Patent, a photographic double objective similar in all respects to that claimed as above mentioned by the respondent as his alleged invention as set forth in the Particulars of Objections.

The respondent was not the true and first inventor of the said alleged invention.

The said photographic double objective was in fact the invention of your petitioners, V. & S., and was communicated by them in confidence, and on conditions of secrecy, to the respondents.

The respondents, C. P. G. and E. H., were the patentees of an invention relating to photographic lenses for which Letters Patent were granted, No. of . The invention claimed in the said Letters Patent was different from the now alleged patent the subject of Letters Patent No. of ; but the respondents have attempted, by mis-description and mis-statement of the nature and scope of the alleged invention in the said Letters Patent, to show that they were the true and first inventors, and that the said invention was the natural outcome and extension of their Letters Patent, No. of .

And your petitioners submit that the said statements are not true and the specification is misleading.

Your petitioners, [trading as] M. & Company, are the sole agents of your petitioners [trading as] V. & S., for the sale in the United Kingdom of lenses and other apparatus manufactured abroad by the said V. & S.

The respondents have attempted, by threats of instituting legal proceedings for infringement of the Letters Patent, to prevent your petitioners from carrying on their lawful trade in the said double objectives.

Your petitioners submit that the said Letters Patent are invalid for the reasons herein, and in the Particulars of Objections stated, and should be revoked, so that the respondent may be debarred from continuing such threats or instituting such legal proceedings, to the injury of your petitioners in their trade and reputation.

Your petitioners therefore humbly pray that the said Letters Patent may be revoked.

And your Petitioners will ever pray, etc.

(Signed)

No. 4. **Forms.**

Particulars of Objections.

Delivered by the Plaintiff with his Petition, pursuant to the Patents Act, 1883, Section 26 (5).

In the High Court of Justice, 1893, D. No.
Chancery Division.
Mr. Justice ,

In the Matter of the Patents, Designs, and Trade Marks Acts, 1883—1888,
and
In the Matter of J... 's Patent granted to J. D. jun., N.. of ,
and
Between T. P. . . . Petitioner
and
J. D. the Elder and
W. R. Co., Ltd. . Respondents.

Particulars of Objections.

1. The inventions claimed by the 1st, 4th, and 5th claims of the specification of J. D. junior, No. of 1884, are anticipated by the specification of T. P., No. of , particularly with reference to the 4th claim in the said specification of T. P., and to the descriptions and illustrations referring to that part of his therein described invention.

2. The invention claimed by the 3rd claim of the specification of J. D. junior, No. of 1884, is anticipated by the specification of T. P., No. of , particularly with reference to the 2nd claim of the said specification of T. P., and to the description and illustrations referring to the said 2nd claim.

3. The invention described in the 3rd, 4th, and 5th claims of the specification of J. D. junior, No. of 1884, was anticipated by one L. E. A., at in the County of London, between October and November , 1882, by making a gun with ejecting mechanism similar in every respect to that described and claimed in the said 3rd, 4th, and 5th claims of the said J. D. junior's specification.

4. None of the claims to the said J. D. junior's specification disclose subject-matter for Letters Patent.

Dated

No. 5.

Another Form of Particulars of Objections.

In the High Court of Justice, 189 , G. No.
Chancery Division.
Mr. Justice ,

Forms.

In the Matter of G. & G.'s Patent, No. A.D. 1882,
and
In the Matter of the Patents, Designs, and Trade Marks Act 1883.

Particulars of Objections.
Delivered by the Petitioner with his Petition for the Revocation of Letters Patent, No. 4362, A.D. 1882.

The petitioner will, at the hearing of this petition, rely on the following objections to the validity of the said Letters Patent:—

1. That L. G. & J. D. G. were not the true and first inventors of the alleged invention comprised in the said Letters Patent.

2. That the alleged invention was not new at the date of the said Letters Patent.

3. That the alleged invention consists solely of a suggestion to use on a large scale the ordinary and well-known mode of deriving electrical action by induction—by means of an induction coil—from a conductor carrying a varying current, both the means employed and the practical use of them for such purpose being well known, and the same is therefore not a fit subject-matter for Letters Patent.

4. That claims 1 and 2 of the specification of the said Letters Patent are for a principle only, and not for any manner of new manufacture, and that the alleged invention is therefore not fit subject-matter for Letters Patent.

5. That the alleged invention, as disclosed by the Queen's printer's copy of the specification filed under the said Letters Patent, did not make any useful addition to the stock of knowledge existing at the date of the said Letters Patent.

6. That the grant of the said Letters Patent to the said L. G. & J. D. G. was subject to the condition that they should within six months from the date of the said Letters Patent duly file a specification, particularly describing and ascertaining the nature of their said alleged invention, and the manner in which the same was to be performed, and they did not do so. (*a*)

7. That the specification purporting to be filed in pursuance of the condition hereinbefore referred to does not describe or ascertain the nature of the said alleged invention, or the manner in which the same was to be performed, and does not distinguish what is old therein from what is new, and is vague and calculated to mislead the public, more especially in the following particulars:—

That the complete specification contains no reference to the primary current being kept constant, and no means of doing this are indicated. Also, that the use of the system for motive power is claimed, but no suitable method of effecting this is described. Also, that the alleged invention is incapable of being exactly defined in the absence of any definition

(*a*) This patent (*Goulard and Gibbs'*) had been granted prior to the coming into operation of the Patents Act, 1883. The specifications are now sent in before the patent is sealed. See ante, pp. 16, 287.

Forms.

of the meaning of the words "currents of high tension." Also, that the words "of which the quality and value depend only on the construction of the secondary coils of the said electrical generators" in the first paragraph of the said specification are calculated to mislead, and are intended to convey and do convey a misleading and erroneous meaning.

7A. That the complete specification of the above mentioned Letters Patent describes and claims an invention different from that described in the provisional specification, because the principle and essence of the alleged invention as described in the provisional specification was the employment of an alternating current in connection with an unlimited number of inductive coils based upon the following statements, namely—that the primary current in passing through these coils suffers no other modification than that due to the resistance of the inductor, and that the currents generated in a hundred induction coils placed on the circuit will only have changed the value of the primary current to the extent of the sum of their resistances, and that under these circumstances the number of induction coils could be indefinitely multiplied, whereas the complete specification omits all refcrence to these wholly erroneous and misleading statements, and claims a system which is wholly devoid of these essential characteristics, being results which are possible, though old, instead of the impossible results which are the whole basis of the alleged invention indicated in the provisional specification.

8. That the alleged invention, in respect of which the said Letters Patent were granted, was published within the realm prior to the date of the same by the following publications :—

The several specifications of inventions in respect of which Letters Patent or provisional protection were respectively granted as follows, namely :—

(*a*) To E. C. S., in respect of a communication from F. N., dated , No. , for certain improvements in electro-magnetic apparatus, suitable for the production of motive power, of heat, and light. The portions relied on are page , line , to page , line ; also, page , line , to page , line ; and the and claims.

(*b*), (*c*), (*d*), etc., etc.

The above are prior publications of the alleged inventions claimed in each of the claims in the Letters Patent granted to the said L. G. & J. D. G.

9. That the alleged inventions, in respect of which the said Letters Patent were granted, were used within this realm prior to the date of the same as follows :—

(1) The alleged inventions claimed in the two claiming clauses of the specification were in ordinary and common use in connection with telegraphy ; the alleged inventions consisting simply in the ordinary device of having several induction coils on one circuit.

(2) The same inventions were used to produce light by J. A. E. G. at , in or about the month of , and

Forms.

subsequently, prior to the date of the said Letters Patent, at his said residence, and at various places in London, of which your petitioner cannot as yet give further particulars.

(3) And also the same were in ordinary and common use for the purposes of producing light (more especially in connection with the use of vacuum tubes) by all electricians, to whom the currents so produced were of a convenient kind, inasmuch as the alleged inventions consist wholly of the use of induction coils on a circuit carrying an alternating current, a device which was well known and commonly used by electricians prior to the date of the said Letters Patent.

No. 6.

Another Form of Particulars of Objections. (*a*)

In the High Court of Justice, 1895, G. No.
Chancery Division,
Mr. Justice ,
In the Matter of Letters Patent, No. of 1894, granted to C. P. G. and E. H.
and
In the Matter of the Patents, Designs, and Trade Marks Acts, 1883—1888.

Particulars of Objections.

The following are the objections to the validity of the said Letters Patent delivered with the Petition as required by section 26, sub-section 5, of the Patents, Designs, and Trade Marks Act, 1883.

1. The respondents were not the true and first inventors of the alleged invention.

2. The petitioners, V. & S., are the true and first inventors of the said invention, and have manufactured and sold photographic double objectives in Germany and elsewhere, since of .

3 The alleged invention is not novel by reason of the following:—

The petitioners, V. & S., sold to your petitioners, M. & Company, within this realm, on the day of , before the date of the said Letters Patent, a photographic double objective, similar in all respects to that claimed by the respondents as their alleged invention in their said Letters Patent.

The petitioners, M. & Company, sold at their shop situate at to on the day of a photographic double objective, similar in all respects to

(*a*) *Goerz and Hoegh's Patent.*

that claimed by the respondents as their invention in their said Letters Patent.

4. Considering the state of public knowledge in the art of the manufacture of lenses at the date of the said Letters Patent, the alleged invention was not good subject-matter for valid Letters Patent.

(Signed)

Delivered, etc.

No. 7.

Another Form of Particulars of Objections. (*a*)

[*Insert Heading in Action.*]

"Take notice, that the petitioner will, upon the hearing of his petition, rely upon the following objections to impeach the patent in the petition mentioned :—

1. That the alleged inventor was not the first and true inventor.

2. That the petitioner was the true inventor.

3. That the petitioner had publicly manufactured within this realm, before the date of the said patent, the whole invention therein claimed, viz., in the year at , and in the years to inclusive, at the works, .

4. That the petitioner publicly used within this realm, before the date of the said patent, the whole invention claimed therein, viz., at the times and places above-mentioned.

5. That the petitioner publicly sold within this realm, before the date of the said patent, the whole invention therein claimed, viz., in the years to , inclusive, at the works, .

6. That the said patent was obtained in fraud of the petitioner's rights, viz., by means of information as to the petitioner's process conveyed by J. H., an employé of the petitioner's, to W. H., by whom the said information was communicated to the patentee."

No. 8.

Interrogatories on Petition for Revocation.

[*Insert Heading as in Form No.* 3, *supra.*]

Interrogatories on behalf of the above-named petitioners for the examination of the above-named respondents.

1. Did you not have an interview with (or receive a communication by letter from) Messrs. V. & S. on the day of at , or at some other, and what time and place, with reference to photographic double objectives made by Messrs. V. ?

2. At such interview (if any), or in such communication (if any),

(*a*) See *Haddan's Patent*, 2 R. P. C. 219.

Forms.

did not Messrs. V. describe and explain the nature and construction of a photographic double objective made by them and sold under the name of the "Colincar"?

3. If you say Yes, was not such description and explanation given as a confidential communication made by Messrs. V. for the express purpose of demonstrating to you the difference between their photographic double objective and that made by you in accordance with your Letters Patent, No. of ?

4. Were you not aware that Messrs. V. were in the habit of exporting to England photographic and other lenses made by them?

5. Is not Messrs. V.'s said photographic double objective substantially the same as the form of lens claimed by you in your Letters Patent, No. of page lines ? If you say No, state in what respects it differs from the said form.

6. When were you first aware of, and when did you first complain to Messrs. V., of the sale by them or their agents, or otherwise, in England, of a lens made by them substantially in accordance with the specification of your Letters Patent, No. of ?

7. Refer to your Letters Patent, No. of on page lines and the words . Do you say that the variation there described is contained or mentioned in your former Letters Patent, No. of ? If Yes, state where in the said Letters Patent the statement of such variation occurs.

8. Refer to your Letters Patent, No. of on page lines and the words . Do you say that the characteristics here mentioned are laid down in the first claiming clause of your said former Letters Patent? If so, state where in the said claiming clause the said characteristics are mentioned. Do you say that other cases or combinations are included or claimed in Claim 1 of the said former Letters Patent in addition to the two particular combinations of lenses claimed in sub-sections (*a*) and (*b*) respectively of Claim 1? If you say Yes, state where such further combinations are included or claimed.

9. Refer to published at on (supplied herewith), and state where you first became aware of such publication. State further whether the description of the photographic double objective of Messrs. V. & S. therein contained does not describe a form of objective substantially the same as that claimed by you in your Letters Patent, No. of . If you say No, state in what respect it differs therefrom.

No. 9.

Order granting Leave to Apply to Amend Specification while a Petition is Pending.

[*Insert Heading as in Form No.* 4.]

Upon motion on the and days of , made unto this Court by counsel for J. D. the elder, and W. R. & Company Limited, the respondents to the petition of T. P., on the day of , ,

preferred unto this Court, and upon hearing counsel for the petitioner, the said T. P., and upon reading an affidavit of E. G. H., filed the day of , , and the exhibits referred to; an affidavit of R. T. W., filed the same day, and the exhibit therein referred to; an affidavit of C. J. B., filed the day of , , and the exhibits therein referred to; a statutory declaration of J. D. the elder, declared on the day of , ; a declaration of T. P., declared on the day of , ; specifications of Letters Patent, numbered respectively of and of . This Court did order that the motion should stand for judgment, and the said motion standing this day in the paper for judgment in the presence of counsel for the respondents and petitioner. This Court doth order that the said respondents be at liberty to proceed with their application to the Comptroller of the Patent Office for leave to amend the specification of the above-mentioned Letters Patent by way of disclaimer. The costs of the said motion are reserved, and the said petition is to stand over until after such proceedings. (*a*)

No. 10.

Another Order Granting Leave to Apply to Amend Specification. (*b*)

In the High Court of Justice,

Chancery Division.

Mr. Justice ,

In the Matter of G. & G.'s Patent, No. of , 188 ,

and

In the Matter of the Patents, Designs, and Trade Marks Act, 1883,

and

In the Matter of the Petition of S. Z. F.

Upon motion this day made unto this Court by counsel for L. G. and J. D. G. and the N. Company, the respondents to the petition preferred by the above-named S. Z. F., and upon hearing counsel for the said petitioner and affidavit of the petitioner, S. Z. F., filed the 17th day of November, 1887, and an affidavit of J. D. G. filed the 19th day of November, 1887, This Court doth order that the applicants be at liberty forthwith to apply to amend their specification filed in pursuance of the above Letters Patent, No. 4862 of 1882, by way of disclaimer, the applicants undertaking to prosecute their proceedings with all diligence. And it is ordered that the petitioner be at liberty within fourteen days after notice of the amendments made in the said specification, either to amend his Petition and the Particulars of Objections delivered by him, or to discontinue all proceedings thereunder. And it is ordered that the respondents, L. G. and J. D. G.,

(*a*) As to this form of order, see, however, *Ludington Cigarette Machine Co.* v. *Baron Cigarette Machine Co.* 17 R. P. C. 214.

(*b*) *Goulard and Gibbs' Patent.*

Forms. and the N. Company, do pay to the petitioner his costs of and consequent upon the prosecution of his petition up to and including his costs of this motion, such costs to be taxed by the Taxing Master.

No. 11. (*a*)

Order on Petition Revoking Letters Patent.

[*Insert Heading as in Form No.* 4.]

Upon the petition of T. P., of , in the County of London, gunmaker, on the day of , preferred unto this Court, and duly authorized by her Majesty's Attorney-General, and upon hearing, on the and days of , counsel for the above-named petitioner and for the respondents, J. D. the elder and W. R. & Company, Limited, and the evidence of the several persons named in the schedule hereto on their examination taken orally before this Court on the days specified in the second column, and on production to them of the exhibits set opposite to their names in the third column of the said schedule, and upon reading the notice dated , , signed by the solicitors for the petitioner, to admit certain documents, and the admission thereof signed by the respondents' solicitors, except documents, numbered to both inclusive; notice dated , , by petitioner's solicitors to admit certain facts; notice dated , , by the respondents' solicitors to admit certain documents, and the admission thereof signed by the petitioner's solicitors; the said Petition and the amended Particulars of Objections; the judgment, dated , , in an action in the Queen's Bench Division of W. R. & Company *v.* P. 189 W. No. , and an order dated the , , of the Court of Appeal in the said *action*,

This Court did order that the said petition should stand for judgment, and the same standing in the paper for judgment this day accordingly, in the presence of counsel for the petitioner and for the respondents,

This Court doth order that the above-mentioned Letters Patent granted to J. D. junior, and being No. of the year 188 be revoked.

And it is ordered that the respondents, J. D. the elder and W. R. & Company, Limited, do pay to the petitioner, T. P., his costs of the said petition, including the costs of the shorthand notes taken by consent of both parties, of the evidence of the witnesses, and of the judgment, such costs to be taxed by the Taxing Master. And the respondents by their counsel asking for stay of execution: It is ordered that in the event of the said respondents serving the petitioner with Notice of Appeal from this Order within one month from the date hereof, this Order is not to be registered at the Patent Office until after the said Appeal shall have been disposed of.

The schedule.

(*a*) *Deeley's Patent.* See ante, p. 746.

No. 12.

Another Order Revoking Letters Patent. (a)

[*Insert Heading as in Form No.* 5.]

Upon the petition of S. Z. F. of on the day of preferred unto this Court and upon hearing counsel for the petitioner and for the respondents, L. G., J. D. G., and the N. Company, Limited, on the day of , and upon reading the petition, the amended Particulars of Objection delivered by the petitioner, the exhibits produced to the witnesses named in the schedule hereto, and set opposite to their names in the third column of such schedule, and upon hearing the evidence of the witnesses named in the first column of such schedule, upon their examination taken orally before this Court on the days mentioned in such schedule, This Court did order that the petition should stand for judgment; and the same standing for judgment this day in the paper in the presence of counsel for the petitioner and the respondents, This Court doth order that the Letters Patent No. A.D. 188 , in the petition mentioned, granted to L. G. and J. D. G. be revoked.

And it is ordered that the respondents, L. G., J. D. G., and the N. Company pay to the petitioner, S. Z. F., his costs of the said petition, to be taxed by the Taxing Master on the higher scale.

Schedule.

No. 13.

Order of the Court of Appeal (a)

Dismissing an Appeal against an Order for Revocation of a Patent.

In the Court of Appeal.

Monday the day of

In the Matter of G. & G.'s Patent, No. of 188 ,

and

In the Matter of the Patents, Designs, and Trade Marks Act, 1883.

Upon motion by way of appeal on the day of made unto this Court by counsel for L. G., J. D. G., and the N. Company from the order dated the day of , and upon hearing counsel for the respondent, S. Z. F., and upon reading the said order,

This Court did order that the said appeal should stand for judgment in the presence of counsel on both sides. This Court doth order that the order dated the 9th July, , be affirmed.

And it is ordered that the said L. G., J. D. G., and N. Company do pay to the said S. Z. F. his costs occasioned by the said appeal, to be taxed by the Taxing Master.

(a) *Goulard and Gibbs' Patent*, see ante, p. 747.

Forms.

No. 14.

Memorial to the Attorney-General

For his Authority to Petition for the Revocation of Letters Patent.

In the Matter of Letters Patent granted to E. V., No. , of A.D. 1893, for an improved medical preparation for the cure of indigestion and like complaints,

and

In the Matter of the Patents, Designs, and Trade Marks Acts, 1883—1888.

To Her Majesty's Attorney-General.

The Memorial of the Pharmaceutical Society of Great Britain, and of M. C. of , in the County of London, pharmaceutical chemist and druggist.

Sheweth as follows :—

1. Your memorialists, the Pharmaceutical Society of Great Britain, are a society formed for objects which include the protection of those who carry on the business of chemists and druggists, and were incorporated by Charter, dated the day of , and confirmed by Statute 31 & 32 Vict. c. 121. By the Statute 15 & 16 Vict. c. 56, in the interests of the public safety, the said society was entrusted with certain powers in relation to sales of "poisons." Your petitioner, M. C., is President of the said society.

2. The invention as set forth in the complete specification of the said Letters Patent relates to an improved medicinal preparation for the cure of indigestion and like complaints, and consists, as is therein stated, "for example, for a two-ounce bottle as follows :—

"Diluted prussic acid	$\frac{1}{2}$ dram.
"Bicarbonate of potash	1 dram.
"Compound tincture of lavender . . .	2 drams.
"Distilled water . . . add to make up	2 ounces."

3. The claim set out in the said specification is as follows: "A medicinal preparation consisting of the above-mentioned ingredients combined in or about the proportion stated."

4. The use of diluted prussic acid and bicarbonate of potash mixed with distilled water has been well known and used for many years as a cure for indigestion. The tincture of lavender is added to the preparation for the purpose of colouring or flavouring such mixture (and is in no way an integral part of the preparation for the purpose of effecting a cure of indigestion). The addition of tinctures or essences for the purpose of colouring and flavouring mixtures of diluted prussic acid and bicarbonate of soda is also well known, and has been in common use amongst chemists and druggists and others for many years, and the said Letters Patent are not proper subject-matter for valid Letters Patent.

5. In the complete specification filed in the Patent Office as a consideration for the grant of Letters Patent the said E. V. purported

Forms.

to declare the nature of her invention and the manner in which the same was to be carried out, and to particularly describe and ascertain the same by the statements contained in the said specification.

6. But the said E. V. has failed in the said specification to declare the nature of her invention, and has not stated sufficiently the proportions of the various ingredients set out in the complete specification which it is necessary to use in order to carry out her alleged invention. It is stated in the said specification that one of the compound parts is diluted prussic acid, but no direction is given as to the strength of the prussic acid which is to be used. In the claim the words "combined in or about the proportion stated" appear. Your memorialists submit that these statements are vague and misleading, and impose upon persons who may desire to use the said invention the necessity of ascertaining by trial and experiment what is the proper strength of prussic acid to be employed, and further to ascertain by trial and experiment what is the exact proportion of the various compounds to be used. For the above, and other reasons, your memorialists submit that the alleged invention claimed is one for which Letters Patent ought not to have been granted.

7. One of the ingredients mentioned in the said specification, to wit prussic acid, is a "poison." Such poison would come and was intended to come within the provisions of the Pharmacy Act (31 & 32 Vict. c. 121), and it would be prejudicial to her Majesty's subjects if, under Letters Patent which are voidable, such poison, to wit prussic acid, should be sold by virtue of its being included in the Letters Patent granted to the said E. V. without being subject to the restrictions as to the sale thereof contained in the said Act, and your memorialists as a matter of duty desire to guard the public against the danger of prussic acid being so sold, by obtaining the revocation of the Letters Patent in question, which they submit are voidable for reasons stated in their Particulars of Objections, and ought not to have been granted.

Your memorialists therefore pray that you will be pleased to grant leave to them to present a petition to Her Majesty's High Court of Justice for the revocation of the above-mentioned Letters Patent granted to the said E. V.

No. 15.

Declaration by the Petitioner

Verifying the Statements in the Petition.

In the Matter of Letters Patent granted to E. V., No. of A.D. 1893, for an, etc.

and

In the Matter of the Patents, Designs, and Trade Marks Acts, 1883—1888,

and

In the Matter of the Memorial of to Her Majesty's Attorney-General of England.

Forms.

I of , the above-named memorialist, do solemnly and sincerely declare that all the statements set forth in the above-mentioned memorial, which memorial is now produced and shewn to me marked , are true in substance and fact. And I make this declaration, conscientiously believing the same to be true, and by virtue of the Statutory Declarations Act, 1835.

Declared, etc.

No. 16.

Certificate by Solicitor
As to Petitioner's Ability to Pay Costs.

[*Heading as in Form No.* 15.]

I of , solicitor for the above-named memorialist, hereby certify that he is a fit and proper person to present a petition for the revocation of the above-named Letters Patent and that he is competent to answer the costs of all proceedings in connection with such petition.

B.—PROCEEDINGS FOR EXTENSION OF LETTERS PATENT.

(See ante, p. 358, Chapter XX.)

No. 17.

Advertisement of Intended Application. (*a*)

In the Matter of Letters Patent granted to S. C. C. C., and to I. A. T. of , both in the County of Middlesex, but now of , for an Invention of "Improvements in the Means of Working and Interlocking Railway Signals," dated the day of , A.D. 1883, No. .

Notice is hereby given, that it is the intention of I. A. T. whose office is at , and who is the proprietor of the said Letters Patent, to present a petition to her Majesty in Council, praying her Majesty to grant new Letters Patent, or a prolongation of the term of the said Letters Patent. And, also, that on the day of now next, or upon such subsequent day as the Judicial Committee of her Majesty's Privy Council shall appoint for that purpose, the petitioners will apply by counsel to the same committee for a time to be fixed for hearing the matter of the said petition, and that on or before the day of now next, any person or persons desirous of being heard in opposition to the prayer of the said

(*a*) *Currie and Timmis' Petition.* See post, p. 765.

petition must give notice of such opposition, and any person or persons intending to oppose the said petition must enter a caveat to that effect at the Privy Council Office on or before the last mentioned date. **Forms.**

Dated the day of .

(Signed)

Agents for .

Solicitors for the Petitioners.

No. 18.

Another Form of Advertisement of Application.

In the Matter of Letters Patent bearing date, the day of , No. , granted to E. C., late of , in the Kingdom of Belgium, Coke Manufacturer, now deceased, for the Invention of "Improvements in the Construction of Coke Furnaces,"

Notice is hereby given, that it is the intention of E. C., the son of the above-mentioned E. C. deceased, and of A. B. G. Le R., S. O. and S. H. S. L., the assignees of three one-sixth parts or shares of and in the said Letters Patent, to present a petition to her Majesty in Council, praying her Majesty to grant a prolongation of the term of the said Letters Patent. And notice is hereby further given, that on the day of next, or on such subsequent day as the Judicial Committee shall appoint for that purpose, application will be made by counsel to the said committee that a time may be fixed for hearing the matter of the said petition, and any person desirous of being heard in opposition to the said petition must enter a caveat to that effect at the Privy Council Office on or before the said day of .

Dated this day of .

(Signed)

Solicitors for the Petitioners.

No. 18*a*.

Affidavit as to Advertisement of Intention to Petition.

In the Privy Council.

In the Matter of Letters Patent granted to A. E. D. of , Massachusetts, in the United States of America, then of , in the City of London, and bearing date the day of , 1882, and numbered .

I, of , in the City of , solicitor, make oath and say as follows :—

1. That on the day of , there appeared in the *London Gazette* an advertisement of which the following is a copy :—

(*Set out Advertisement.*)

Forms.

The said advertisement was repeated in the *London Gazette* on the day of and the day of .

2. On the day of , 1895, a similar advertisement appeared in the *Times* newspaper, a paper published in London.

3. On the day of , 1895, a similar advertisement appeared in the *Daily Telegraph* newspaper, a paper published in London.

4. On the day of , 1895, a similar advertisement appeared in the *Standard* newspaper, a paper published in London.

5. On the day of , 1895, a similar advertisement appeared in the *Liverpool Daily Courier*, a newspaper published in the City of Liverpool, and circulating in Prescot, in the County of Lancaster, and the said advertisement was repeated in the *Liverpool Daily Courier* on the day of and the day of , 1895.

6. On the day of , 1895, a similar advertisement appeared in the *Prescot Weekly Times*, a newspaper published in Prescot, in the County of Lancaster.

Sworn at, etc., this day of

(Signed)

No. 19.

Caveat by Intending Opponent.

To the Registrar
Of Her Majesty's Privy Council.
In the Matter of Letters Patent granted to A. E. D. of , Massachusetts, United States of America, then of , in the City of London, and bearing date the day of , 1882, and numbered , for "Improvements in Electrical Cables."

Take Notice, that we hereby enter a caveat on behalf of the F. W. C. Company, Limited, of , against any Petition which has been or may be presented for the extension of the above Letters Patent.

Dated this day of , 1895.

(Signed)
Solicitors and Agents for the F. W. C. Company, Limited.

No. 20.

Petition for Extension of the Patent Term.

In the Privy Council.
Presented the day of , 1897.

Forms.

To the Queen's Most Excellent Majesty in Council. (*a*)

In the Matter of Letters Patent granted to S. C. C. C. of , gentleman, and I. A. T., formerly of , in the County of Middlesex, for an invention of "Improvements in the Means for working and interlocking Railway Signals by Electricity," dated the day of in the year of our Lord 1883, No.

The Humble Petition of the said I. A. T.

Sheweth as follows :—

1. That your Majesty was graciously pleased by Royal Letters Patent under the Great Seal (*b*) of the United Kingdom of Great Britain and Ireland, bearing date the day of , 1883, and numbered , to grant to your petitioner and to the said S. C. C. C., their executors, administrators, and assigns the sole privilege to make, use, exercise, and vend the said invention within the United Kingdom, the Channel Islands, (*b*) and the Isle of Man for the term of fourteen years from the date of the said Letters Patent.

2. That your petitioner and the said S. C. C. C., in compliance with the proviso in the said Letters Patent contained, (*b*) duly filed in the Great Seal Patent Office, on the of , 1884, a specification particularly describing and ascertaining the nature of the said invention, and the manner in which the same is to be performed. And all other conditions contained in the said Letters Patent, or upon which the said Letters Patent were granted, including those relating to the payment of stamp duties, have been duly performed.

3. That the said invention was at the date of the said Letters Patent a new invention within your Majesty's realm, and your petitioner and the said S. C. C. C. were the true and first inventors thereof.

4. That your petitioner and the said S. C. C. C. obtained Letters Patent in the countries and at the dates following :—

France	No.	of 1884
Belgium	No.	of 1884
Cape of Good Hope . . .	No.	of 1884
Austria	No.	of 1886
Italy	No.	of 1884
New South Wales	No.	of 1884
Queensland	No.	of 1885
Victoria	No.	of 1884
South Australia	No.	of 1884
Tasmania	No.	of 1884
West Australia	No.	of 1884
New Zealand	No.	of 1885
India	No.	of 1885
United States of America . .	No.	of 1885
Canada	No.	of 1884

(*a*) This petition was presented in *Currie & Timmis' Patent*, of which an extension was granted for ten years. See 15 R. P. C. 63.

(*b*) This patent was granted prior to the coming into operation of the Patents Act, 1883.

Forms.

5. That your petitioner also obtained Letters Patent and the like privileges for certain improvements on and details connected with the said invention in the United Kingdom on the dates as set out below :—

In the United Kingdom	.	No.	of 1891
,, ,, ,,	.	No.	of 1892

6. That by an agreement dated , and by two indentures dated respectively and , all made between your petitioner and the said S. C. C. C., both the Letters Patent mentioned in paragraph 4 hereof which were granted in the United States of America and Canada, were contracted to be assigned to the said S. C. C. C., and the whole of the Letters Patent mentioned in the said 4th paragraph which were granted in the other countries therein mentioned, were contracted to be assigned to your petitioner, including the Letters Patent the subject of this petition, and all the said patents were subsequently formally assigned as above mentioned, and since the said dates your petitioner has been the sole owner of the same.

7. The Letters Patent mentioned in paragraph 4 hereof which were granted in France, Belgium, Cape of Good Hope, Austria, Italy, New South Wales, Queensland, Victoria, South Australia, Tasmania, West Australia, New Zealand, and India, were allowed to lapse, no fees having been paid in respect of them for the purpose of upholding them after the year , and no profits were made in respect of them, either by way of assigning them, or working the invention in respect of which they were granted, or otherwise.

8. The invention in respect of which the Letters Patent, the subject of this petition were granted, is to operate the signal arms of railway signals by electrical agency instead of mechanical. To this end an electro-magnet is placed on or near the post on which is the signal arm. Each signal post and arm in a railway station is so fitted, and each is connected by wires, or leads to a source of electricity. This source may be a battery, or a continuous running dynamo.

When the signalman pulls over his lever, and completes the electric circuit to any particular signal, *i.e.* magnet, that magnet is operated, and lowers the signal arm from "danger" to "line clear." This lowering current is what the patent describes as a continuous current, *i.e.* it is always ready to flow along any wire to any signal as soon as the wire or circuit to that signal is completed by—

(*a*) The signalman having operated his lever.

(*b*) By the fact that all conflicting signals or points are at "danger."

As soon as the signal is at "line clear," the armature of the magnet is in touch with the bobbin, and then the current necessary to hold the armature and bobbin together is very small compared with that which was requisite to operate or lower it. And as it is necessary to economize the use of the electric current, it is lessened by any suitable means as described in page 3, lines 2 to 10.

(*a*) A resistance is automatically switched in.

(*b*) Part of the battery is switched out.

Without this reduction of the current, the working of railway signals by electro-magnets would be prohibitive by means of the cost; but it is proved by absolute work that this arrangement, which reduces

the "lowering" to "holding," *i.e.* from 5 amperes to 0·5 (or $\frac{1}{10}$), makes it economical. Then the use of a continuous current is essential and new.

The second claim, by which signals are interlocked with each other and with points electrically, is more safe and more economical than when it is done mechanically. It is clear that the levers necessary to operate signals by means of an electric current need only be very small—seven inches long instead of seven feet—and that they take up very small room; and that by completing all the signal circuits through all the levers when in the "back" position, if any conflicting lever is pulled over, it breaks every circuit which goes to any of its conflicting signals, and then none of them can be lowered. On the other hand, if a signal lever is pulled over, the signal is operated, and the repeater shows the signalman that it is so operated; it is proof positive to him that all the points are in their correct position, and also that all conflicting signals are and must be at "danger."

9. Owing to the exceedingly serious consequences which would probably result from a failure of the signalling apparatus on a railway, and to the fact that your petitioner's above system of working signals electrically was entirely novel and untried, your petitioner, notwithstanding his continuous efforts on that behalf, was unable to induce any railway company to try the system on a large scale until the year 1891, when the L. O. Electric Railway was made. This railway was fitted with an electric signalling system arranged according to the invention described in your petitioner's Letters Patent of 1883, and was fitted with certain of the said improvements in details which are the subject of the two later Letters Patent granted to your petitioner, and referred to in paragraph 5 hereof.

The system has now been continuously in operation on the L. O. Railway for the last four years, and has proved to be reliable, economical, and satisfactory in every respect.

10. Prior to the said installation on the L. O. Railway, your petitioner caused to be erected at G., in the year 1884, a small experimental installation of his system; and, in consequence of this, your petitioner received an order to fit up one signal and two bridge-repeaters on the S. D. Railway which have been working ever since. And in the year 1895–6 he erected an installation at E. C. Junction, on a much larger scale, with the view of bringing the advantages of the said system to the notice of railway engineers.

11. Owing to the causes set out above, and notwithstanding the continuous efforts of your petitioner to bring the said invention into public use, the invention has not at the present time, with the exception of the installations at L. and S., come into commercial use, and your petitioner has not derived any profit from the same, but has, on the contrary, expended large sums of money in his endeavour to introduce the said invention, as shewn by the accounts to be filed by him.

12. Your petitioner believes that the objections to the use of the said system by the railway companies have now been largely or entirely removed by the experience gained on the L. Railway; and that, in the very special circumstances of this case, the exclusive right of using the said invention for a further term of fourteen years, in addition to the term granted by the Letters Patent the subject of

Forms.

this petition, will not be more than sufficient to enable your petitioner to obtain a fair remuneration for his invention and exertions.

13. That your petitioner has given public notice, by advertisements caused to be inserted the requisite number of times in the *London Gazette* and in Metropolitan and County newspapers, pursuant to the Statutes in that case made and provided, that it is his intention to apply to your Majesty in Council for a prolongation of the term of sole using and vending the said invention.

Your petitioner therefore humbly prays that your Majesty will be graciously pleased to take the case of your petitioner into your royal consideration, and to refer the same to the Judicial Committee of your Majesty's Most Honourable Privy Council, and that your petitioner may be heard before such committee by his counsel and witnesses, and that your Majesty will be pleased to grant to your petitioner a prolongation of the term of sole using and vending the said invention for the further and additional term of fourteen years, or for such other term as to your Majesty shall seem fit, and to grant new Letters Patent for the said invention to your petitioner for such term as to your Majesty shall seem fit, after the expiration of the first term originally granted by the existing Letters Patent hereinbefore mentioned, according to the form of the Statutes in such cases made and provided.

And your petitioner will ever pray, (*a*) etc.

Solicitors for Petitioner.

No. 21.

Another Form of Petition. (*b*)

In the Privy Council,

Presented the day of , 1895.

To the Queen's Most Excellent Majesty in Council.

In the Matter of Letters Patent, granted to A. E. D., of , Massachusetts, United States of America, bearing date the day of , 1882, No. , for an invention of "Improvements in Electrical Cables."

The Humble Petition of the said A. E. D. and of the B. I. W. Company, Limited, whose Registered Office is at in the County of , as Assignees of the said Letters Patent.

(*a*) In this case a "supplementary statement" to Paragraph 8 of the Petition was also presented by the petitioner, setting out, with the aid of diagrams, the nature of his invention in detail.

(*b*) This Petition was presented in the case of *Dolbear's Patent*. An extension in this case was refused on the ground that there was no sufficient explanation of delay in bringing the invention into practice; see 13 R. P. C. 203.

Forms.

Sheweth as follows :—

1. That the said A. E. D. obtained the grant of your Majesty's Royal Letters Patent under the Great Seal (*a*) of the United Kingdom of Great Britain and Ireland, bearing date the day of , 1882, for an invention of "Improvements in Electric Cables," whereby your Majesty did give and grant unto the said A. E. D., his executors, administrators, and assigns, the sole privilege to make, use, exercise, and vend the said invention within the United Kingdom of Great Britain and Ireland, the Channel Islands, and the Isle of Man, for the term of fourteen years from the date of the said Letters Patent.

2. That in pursuance of the conditions and provisions in the said Letters Patent contained, the said A. E. D. duly filed in the Great Seal Patent Office, on the day of , 1882, a proper and sufficient specification (*b*) of the said invention, and the manner in which the same was to be performed, and all other conditions contained in the said Letters Patent, or upon which the said Letters Patent were granted, including those relating to the payment of stamp duties, have been duly performed.

3. That the said invention was at the date of the said Letters Patent a new invention within your Majesty's realm, and the said A. E. D. was the true and first inventor thereof.

4. The said invention relates to the insulation of electric conductors. It consists in reducing to the smallest possible extent the contact between the conductor and the surrounding insulating material, so that the conductor is as much as possible insulated by the surrounding air. By this means the rapidity with which electric signals can be transmitted through the cable is largely increased: the reason being that the inductive capacity of air is very low as compared with solid insulators, and, consequently, a much smaller Leyden-jar effect is produced with an air-insulated conductor than with one which is in contact with a solid insulator.

5. Your petitioner, A. E. D., obtained Letters Patent for the same invention, in the United States of America, bearing date the day of , 1887, and numbered .

6. By an assignment dated the day of , 1892, your petitioner, A. E. D., assigned the said Letters Patent for the sum of ten pounds to "P. E., Limited," whose registered office is at , , and by an assignment dated the day of , , the said P. E., Limited, assigned the said Letters Patent for the sum of ten pounds to J. K., and about the same date the said J. K. assigned the said Letters Patent for seven pounds ten shillings to J. B. A. By an agreement dated the day of , , the said J. B. A. agreed to assign the said Letters Patent to your petitioners, the B. I. W. Company, Limited, in consideration of the payment of £1000, of which £500 were paid in cash, and the balance of the £1000 was paid by the issue to him of one hundred fully-paid A shares in your petitioners' company. The formal assignment from J. B. A. to your petitioners was made on the day of , , and your petitioners, the B. I. W. Company, Limited, are now the registered owners of the said Letters Patent.

(*a*) This Petition also concerned a Patent granted prior to the coming into operation of the Patents Act, 1883.

(*b*) Ibid.

Forms.

7. At the date of the said Letters Patent, viz. 1882, there was little or no need for cables made according to the said invention. Such cables are most useful for telephonic cables when laid in the ground; and until a comparatively recent date few, if any, of such cables were in use. Until recently nearly all telephonic conductors were suspended from insulators in the air. Now, however, partly in consequence of the largeness of their number, and the inconvenience and the danger of overhead wires, large numbers of insulated wires for telephonic purposes are laid in the form of cables, in troughs or pipes in the ground, and cables insulated according to the invention the subject of this petition have been found to be of great value for this purpose.

8. Owing to the causes set out above, and notwithstanding the continued efforts of your petitioner, A. E. D., to bring the said invention into public use, the invention did not come into any commercial use until quite recently, and neither your petitioner, the said A. E. D., nor your petitioners, the said B. I. W. Company, Limited, have derived any material profit from the same, as shewn by the accounts to be filed by them respectively.

9. The said invention was new at the date of the Letters Patent the subject of this petition, and neither the utility of the said invention nor the validity of the said Letters Patent have ever been called in question.

10. Your petitioners, the B. I. W. Company, Limited, are now in a more favourable position to obtain some reward in respect of the said invention, and are willing to make such provision for rewarding your petitioner, the said A. E. D., as may seem fit to your Majesty.

11. Your petitioners have caused the necessary and proper advertisements to be inserted the requisite number of times in the *London Gazette* and in London and country newspapers, pursuant to the Statutes in that case made and provided, and the rules made in that behalf, notifying that it is the intention of your petitioners to apply to your Most Excellent Majesty in Council for a prolongation of the said Letters Patent.

Your petitioners therefore humbly pray that your Majesty will be graciously pleased to take the case of your petitioners into your Royal consideration, and to refer the same to the Judicial Committee of your Majesty's Most Honourable Privy Council, and that your petitioners may be heard before such committee by their counsel and witnesses. And that your Majesty will be pleased to grant your petitioners a prolongation of the term of the said Letters Patent for a further term of fourteen years, or for such other term as to your Majesty may seem fit.

And your petitioners will ever pray, etc.

Agents for

(Signed)

Solicitors for the Petitioners.

No. 22. Forms.

Advertisement of Time Fixed for Hearing Petition. (a)

In the Privy Council.

In the Matter of Letters Patent granted to S. C. C. C. of , and I. A. T., formerly of , now of , in the County of Middlesex, for an invention of "Improvements in the Means of Working and Interlocking Railway Signals by Electricity," dated the day of , A.D. 1883, No. .

In the Matter of the Petition of the said I. A. T. for an extension of the term of the said Letters Patent.

Notice is hereby given, that their Lordships the Judicial Committee of the Privy Council have appointed Thursday, the day of , 1897, at half-past ten o'clock in the forenoon, for hearing the matter of the above Petition.

Dated (Signed)

Solicitors for the Petitioner.

No. 23.

Notice to Opponent

Who has entered a Caveat of the Time Fixed for Hearing.

[*Insert Heading.*]

Take notice, that the Judicial Committee of Her Majesty's Privy Council did, on the day of , appoint the day of , now next ensuing, for the hearing of the matter of the above-mentioned petition.

Dated

(Signed) H. K. & Co.

Solicitors for the Petition.

No. 24.

Notice of Grounds of Objection by Opponent.

In the Privy Council.

In the Matter of Letters Patent granted to J. H. (b) of

(a) *Currie and Timmis' Petition*, see ante, p. 765.

(b) This petition (*Hopkinson's*) was refused, on the grounds that adequate remuneration had been received by the inventor, and the merit of the assignees was *insufficient to entitle them to an* extension of the patent monopoly. See 14 R. P. C. 5.

Forms.

, in the County of Middlesex, for an Invention of "Improvements in Distributing and Measuring Electricity, and in Apparatus to be Employed for those Purposes," bearing date the day of , 1882, and numbered ,

and

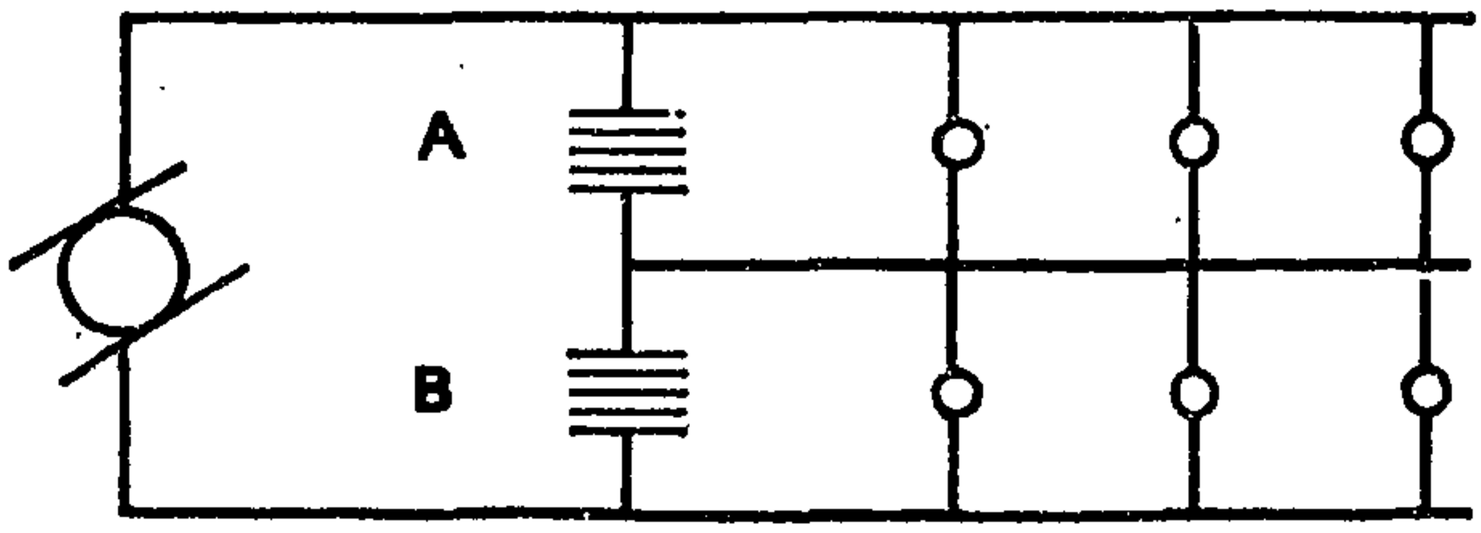
In the Matter of the Petition of the said J. H., and the W. E. Company, Limited, for an Extension of the Term for which the said Letters Patent were granted.

The Grounds of Objection of the several Corporations following, namely: the Corporation of Edinburgh, the Corporation of Aberdeen, and the Corporation of Belfast, to the granting of the Prayer of the above-mentioned Petition, are as follows:—

1. That the said alleged invention, as described and claimed in the specification filed in pursuance of the application for the said Letters Patent, has not been of sufficient public benefit to entitle the petitioners to any further extension of the term for which the said Letters Patent were granted.

2. The invention for which the said Letters Patent were granted is diagrammatically but correctly shown in the petition at the bottom of page 5. And it is claimed in the said specification of the petitioner, J. H., in the following words, "In a system of electrical distribution of supply, the employment of three (or more) conductors in combination with two (or more) dynamo machines, in a series substantially as hereinbefore described with reference to Fig. 5 of the accompanying drawings, whether the middle conductor be continuous or be replaced by an earth-return, as set forth."

3. The system of distribution which is and has been employed by the above-mentioned three corporations is diagrammatically set out in the following drawing, in which A and B represent series of secondary cells, which are or may be charged by a small independent dynamo-machine, if and when required.



4. The above-described method of distribution by means of three wires is not the system of distribution by three wires as described and claimed by the petitioner, J. H., but differs therefrom in several very important and material respects. The system which has been used by the objectors and many others is the system above described, and not the system of the petitioner, J. H.

5. The particular system described and claimed by the said J. H. has not been largely used, and is of very little value as compared with the above-named system as used by the said three corporations.

Forms.

6. The petitioners, the W. Company, Limited, have asserted that the said system as used by the said corporations is an infringement of the system as claimed in the said H.'s specification, and have during the last two or three years endeavoured to compel the said corporations to take a license from them to work according to the said Letters Patent. The said corporations will submit (although denying the said infringements) that if the use by them of the system as used by them, and by many other corporations and companies, is in fact an infringement of the said Letters Patent, the royalties now due in respect of such user, or the damages, as the case may be, which the petitioners will in due time recover down to the date of the expiration of the term for which the said Letters Patent were granted, will amount to a very large sum, and will be such that the petitioners will have been adequately remunerated in respect of their trouble and expenditure. Notwithstanding that the petitioners have for nearly two years past alleged that the system adopted by the said corporations is an infringement of the said Letters Patent, they have intentionally abstained from taking any steps to determine the question or to restrain them from continuing to infringe. The petitioners have been well aware of similar alleged infringements by other corporations and companies for several years past, but have taken no steps as aforesaid to vindicate their rights.

7. Alternatively the said three corporations will contend that, if the said system used by them is not in fact an infringement of the said Letters Patent, in that case the said invention is one of limited merit, and in respect of which adequate remuneration has already been received.

8. That the petitioners, J. H. and the W. Company, Limited, have already received a full and adequate remuneration for the alleged invention as more particularly set forth in section 27 of the petition. The petitioners, the W. Company, Limited, carry on a very extensive business, and own several Letters Patent of great value, and the shares received by the said J. H. were, and now are, of considerable value.

Dated this day of

No. 25.

Another Form of Notice of Grounds of Objection. (*a*)

In the Matter of Letters Patent granted to A. E. D. of Massachusetts, United States of America, bearing date the day of , 1882, and numbered for an invention of "Improvements in Electrical Cables,"

and

In the Matter of the Petition of the said A. E. D., and of the B. I. W. Company, Limited, for an extension of the term of the said Letters Patent.

The Grounds of Objection of the N. T. Company, Limited, whose registered office is at , in the City of London, to the

(*a*) *Dolbear's Petition*, see ante, p. 768.

Forms.

granting of the Prayer of the above-mentioned Petition, are as follows, viz. :—

1. That the alleged invention was not new at the date of the said Letters Patent.

2. That the alleged invention did not disclose any such useful addition to the stock of public knowledge existing at the date of the said Letters Patent as to entitle the said A. E. D. to the grant of valid Letters Patent.

3. That the alleged invention, as described in the specification filed under the said Letters Patent, never has been, and is not likely to be, of sufficient public advantage to entitle the patentee or the owners of the patent to any further extension of the term thereof.

4. That the title of the petitioners to the said Letters Patent is invalid.

5. The alleged invention had been anticipated by the following publications made before the date of the said Letters Patent within the United Kingdom of Great Britain and Ireland :—

By the specification filed under Letters Patent, No. , A.D. , granted to A. W. D., for "Improvements in Submarine Telegraphic Cables."

The whole specification is relied on.

By the American specification of W. E. P., No. , A.D. 1876, for an "Improvement in Insulating Telegraph Wires," published at the Patent Office, Chancery Lane.

The whole specification is relied on.

By the specification filed under Letters Patent, No. , A.D. 1881, granted to W. R. L., for "Improvements in and relating to Electrical Cables or Conductors for Telegraphic and Similar Purposes."

The whole specification is relied on.

6. That the B. I. W. Company and the intermediate assignees of the said Letters Patent respectively have not assisted the said A. E. D. with sufficient funds to enable him to develop the said alleged invention and to bring it into commercial use, nor have they, or either of them, so acted in connection with the introduction of the said alleged invention as to entitle the petitioners to an extension of the term of the said Letters Patent.

7. That the petitioners have already received a full and adequate remuneration for the said alleged invention, or, if not, the want of proper remuneration has been caused by reason of their own conduct in and about the sale and development of the said alleged invention.

8. That the petitioners have permitted infringements of the said Letters Patent, and have not brought actions to restrain such infringements, or warned infringers, or in any way asserted their alleged rights under the said Letters Patent.

9. That the allegations contained in the said petition are incapable of proof.

Dated this day of 1895.

(Signed)

Solicitors for the N. T. Company, Limited.

No. 26. Forms.

Another Form of Notice of Grounds of Objection.

In the Matter of Letters Patent, bearing date , numbered , granted to W. L. of for an invention of "Improvements in the Construction and Arrangement of Apparatus for Purifying, Disinfecting, Drying, and Heating,"

and

In the Matter of the Petition of the said W. L. for an Extension of the Term of the said Letters Patent.

The Grounds of Objection of E. M. & W. W., trading under the style or firm of , engineers and iron-founders at , to the granting of the above-mentioned Petition are as follows :—

1. That the petitioner has received a full and adequate remuneration for the said alleged invention.

2. That the petitioner entered into an agreement with M. A. F. & Company, of , whereby he granted to the said firm the sole right to manufacture and sell his disinfectors. The said firm in the year sold their business to a limited company named M. A. & Company, Limited. By consent of the petitioner, the said limited company exercised and carried on the said exclusive rights. The said firm and the said limited company have received in respect of the said rights £ , and it is submitted that the public have already paid more than an adequate remuneration for the exercise of the monopoly granted by the said Letters Patent.

3. That the plaintiff was not the first and true inventor of the alleged invention comprised in the said Letters Patent.

4. That the alleged invention was not useful.

5. That the said alleged invention was not new at the date of the said Letters Patent.

6. That the said alleged invention was, previously to the date of the said Letters Patent, published within this realm in the following specifications respectively filed in the Patent Office as hereinafter mentioned, that is to say :—

[*These specifications are here omitted.*]

7. That the alleged invention was used before the date of the said Letters Patent by the several persons at or in the several places following, that is to say :—

[*Places of prior user are here omitted.*]

8. The petitioner's invention has been publicly known and used in lace factories in the neighbourhood of N. for a period of thirty years.

(Signed)

Delivered, etc.

No. 27.

Form of Patentees' Accounts.

IN THE PRIVY COUNCIL.

First Year.

C. & T.'s Patent, 1883, December 12: No. 5718—Improvements in Working and Interlocking Railway Signals. (a)

RECEIPTS IN 1883.

1883		£	s.	d.
Jan. 1 to Dec. 31.	Nil			
	£			

EXPENSES IN 1883.

1883		£	s.	d.
Jan. 1 to Dec. 31.	British Patent Fees	25	0	0
	French Patent Fees	9	0	0
	United States Patent Fees	36	0	0
	Belgian Patent Fees	4	8	0
	German Patent Fees	11	5	0
	Austrian Patent Fees	16	16	8
	Indian Patent Fees	25	0	0
	New South Wales Patent Fees	35	0	0
	Victoria Patent Fees	24	0	0
	South Australia Patent Fees	23	0	0
	Italian Patent Fees	15	0	0
	Queensland Patent Fees	35	0	0
	Tasmania Patent Fees	25	0	0
	West Australia Patent Fees	39	0	0
	Cape of Good Hope Patent Fees	27	0	0
	New Zealand Patent Fees	25	0	0
	Experimental work—Elliott Bros., £61 19*s.* 6*d.*; wages, £12 5*s.*; material, £4 11*s.* 4*d.* . . .	78	15	10
	Pamphlets, lithographs, etc.	0	14	6
	Travelling—Manchester and back	3	0	0
		£458	6	0

REMARKS FOR 1883.

In 1883 M. C. & J., who had arranged in 1882 to work out a scheme of electrically-worked railway signals, employed Elliott Bros. to make experimental magnets, and took out patents for the magnets first. At the end of 1883 we took out the British Signal Patent, which I now petition to be extended.

(a) See the petition in this case, Form No. 20, *supra*. This patent monopoly was prolonged for ten years: *Currie & Timmis' Patent*, 15 R. P. C. 63.

Second Year.

Receipts in 1884.

1884		£	s.	d.
Jan. 1 to Dec. 31.	Magnet supplied to London, Brighton, & South Coast Railway Company	6	0	0
	Magnets supplied to Captain McEvoy for marine engineering	31	10	0
	Magnets supplied to E. C. & Co., Italy	6	19	8
	Work done for the Swansea Harbour Trust	75	18	0
		£120	7	8

Remarks for 1884.

In 1884 we took out other patents for the signal working, printed pamphlets, made experimental gearing, and then fitted a complete installation at Gloucester, where the Great Western Railway and the Midland Railway have sidings into the Gloucester Railway Carriage Company's yard. This installation was inspected by Major Marindin, R.E., of the Board of Trade. I found Mr. C. all the money for his time and trouble.

Expenses in 1884.

1884		£	s.	d.
Jan. 1 to Dec. 31.	British Patent Fees	26	0	0
	French Patent Fees	13	0	0
	United States Patent Fees	12	11	0
	Belgian Patent Fees	5	18	0
	Cape of Good Hope Patent Fees	27	0	0
	German Patent Fees	14	15	11
	Austrian Patent Fees	17	0	0
	Indian Patent Fees	38	0	0
	Canada Patent Fees	47	12	6
	Italy Patent Fees	15	10	0
	New South Wales Patent Fees	35	0	0
	Queensland Patent Fees	35	0	0
	Victoria Patent Fees	24	0	0
	New Zealand Patent Fees	25	0	0
	Tasmania Patent Fees	25	0	0
	South Australia Patent Fees	23	0	0
	West Australia Patent Fees	39	0	0
	Travelling expenses—Scotland, £5; Paris, £3; Paris, £3; Manchester, £1 10*s.*; Notts and Derby, £4 10*s.*; Notts and Derby, £1 10*s.*; Paris, £10; Newcastle, £2 10*s.*	31	0	0
	Dinners	1	18	6
	Pamphlets, lithographs, etc.	67	9	9
	Sundry office expenses	7	8	0
	Experimental work, £17 9*s.* 1*d.*; material, £2 10*s.* 4*d.*; carriage, 19*s.* 6*d.*; paid C., £150; wages, £4; C. M., £1 4*s.*	176	2	11
	Ditto at Swansea, £14 9*s.* 6*d.*; travelling, £12 10*s.*; wages, £8 18*s.* 2*d.*; batteries, £60	95	17	8
	Ditto at Gloucester, £72 5*s.* 4*d.*; travelling, £12 10*s.*; material, £21 2*s.*; wages, £156 14*s.* 11*d.*; A. & P., £9 13*s.*; Gloucester Waggon Company, £209 18*s.* 3*d.*; L. C., £61 10*s.* 6*d.*; office, £20 5*s.*; E. Brothers, £9 13*s.*; C. A., £166	739	12	0
		£1543	13	0

No. 27.—*Continued.* (*a*)

Third Year.

Receipts in 1885.

1885.		£	s.	d.
Jan. 1 to Dec. 31.	Magnets supplied to E. Zeller	6	6	0
		£6	6	0

Remarks for 1885.

In 1885 I paid for more patents and renewal fees on the Continent. I also obtained a small order at Swansea from the Gloucester work, and fitted one signal and several bridge repeaters to control the Great Western Railway running through the docks. This small installation has worked with perfect regularity since, and was one of the main reasons for my getting the order for the work on the L. O. Railway some years later. I also fitted an installation of signals and points at the Inventions Exhibition in London, and many railway engineers came to see it, amongst others, Mr. , the chief engineer of the Great Northern Railway.

Expenses in 1885.

1885.		£	s.	d.
Jan. 1 to Dec. 31.	Austrian Patent Fees	6	10	0
	German Patent Fees	25	14	0
	United States Patent Fees	22	15	0
	Canada Patent Fees	1	15	0
	French Patent Fees	4	10	0
	Belgian Patent Fees	1	8	0
	Italian Patent Fees	2	5	0
	Indian Patent Fees	1	10	0
	Sundry Patent Fees	8	9	0
	Models	17	16	0
	Dinners	1	19	6
	Preparing contracts	5	0	0
	Pamphlets, lithographs, etc.	26	8	0
	Sundry office expenses	8	3	0
	Travelling expenses—Scotland, £3; Liverpool and Crewe, £2 15*s.*; Glasgow, £2; Glasgow, £2 2*s.*; sundry, £10	19	17	0
	Experimental work at Swansea	19	2	6
	Ditto at Gloucester—coils, £180; H. & A., £2 10*s.*; forgings, £8; wages, £4 2*s.*; insurance of cabin, £2 2*s.*	196	14	0
	Ditto at office—coils, £15 11*s.* 6*d.*; instruments, £2 10*s.*; instruments, etc., £3; instruments, £1 10*s.*; motor, £11 7*s.* 6*d.*; carriage, £1 15*s.*; wages, £10 17*s.*; L. O., £1 15*s.*;	48	6	0
	Ditto at workshop at Clapham—wages . . .	3	11	7
	Ditto at Inventions Exhibition—wages, £115 1*s.* 6*d.*; house, £15; E. P. S., £12 6*s.* 10*d.*; L. O., £37 10*s.* 3*d.*; magnet, £3 18*s.*; salary, £40; salary, £5 5*s.*; point gearing, £9 19*s.* 9*d.*; anemometre, £2 8*s.*; notice boards, £5 18*s.* 4*d.*; photos, £1 1*s.*	248	8	8
		£670	2	3

(*a*) The accounts for the later years, which were similar in form to the above, are not reproduced here.

No. 27.—*Continued.*

General Balance Sheet.

Summary.	£	s.	d.
Receipts in 1883—nil	0	0	0
„ 1884	120	7	8
„ 1885	6	6	0
„ 1886	30	19	3
„ 1887	2	10	0
„ 1888	402	13	0
„ 1889	25	0	0
„ 1890	51	9	8
„ 1891—nil	0	0	0
„ 1892	664	9	6
„ 1893	883	9	0
„ 1894	350	0	0
„ 1895	109	10	0
„ 1896	22	0	0
„ 1897	13	8	9
Amounts still due—nil	0	0	0
	£2682	2	10

Summary.	£	s.	d.
Expenses in 1883	458	6	0
„ 1884	1543	13	0
„ 1885	670	2	3
„ 1886	547	18	8
„ 1887	535	7	0
„ 1888	856	16	2
„ 1889	1202	7	7
„ 1890	278	10	3
„ 1891	222	2	9
„ 1892	346	4	8
„ 1893	1960	14	2
„ 1894	836	12	10
„ 1895	369	1	2
„ 1896	1524	9	7
„ 1897	575	5	11
Amounts still due	31	3	2
	£11,958	15	2
Expenses	£11,958	15	2
Receipts	2692	2	10
Total loss	£9276	12	4

Or, say, nine thousand two hundred and seventy-six pounds twelve shillings and fourpence total loss.

No. 28.

Another Form of Patent Accounts.

IN THE PRIVY COUNCIL.

John Hopkinson's Patent (27th July, 1882) No. 3576. Improvements in Distributing and Measuring Electricity, and in Apparatus to be used for those purposes. (*a*)

PETITION FOR PROLONGATION.

FIRST PART.

The Account of the Petitioner, John Hopkinson.

Dr. EXPENDITURE.

		£	s.	d.
1882	Fees and charges on taking out English patent . .	50	0	0
	NOTE.—The petitioner incurred other expenses, of which he kept no account, and no claim is made in respect thereof.			
1883—nil 1884—nil 1885—nil 1886—nil 1887—nil 1888—nil 1889—nil 1890—nil 1891—nil 1892—nil 1893—nil	The note to the first year applies to all these years.			

RECEIPTS. Cr.

		£	s.	d.	£	s.	d.
First year 1882—nil Second year 1883—nil Third year 1884—nil Fourth year 1885—nil Fifth year 1886—nil Sixth year 1887—nil	NOTE.—Immediately after the grant of the patent to the petitioner, Dr. J. H., he used every endeavour to procure the adoption of his invention, but the electric lighting industry was at that time so much in its infancy, and central lighting electric installations (where long main conductors are required, and to which the invention is chiefly applicable) were so hampered by the provisions of the legislature that for the first eight years of the life of the patent there was practically no opportunity for the application of the petitioner's invention.						
Seventh year 1888	Royalties from Messrs. C. & H. for use of 3-wire system in L. . . .				100	0	0

					£	s.	d.
							£50 0 0
	Eighth year						
1889	Royalties from C.'s B. T. & W. Co., Ltd., in respect of sole license to use 3-wire system for one year .				200	0	0
Mar. 16	Payment from the W. Co. in respect of option of purchase, proportion appertaining to English patent. (For explanation see Appendix C.) .				171	16	4
Apl. 6	Payment from the W. Co. on agreement to purchase, proportion appertaining to English patent. (For explanation see Appendix C.)				2148	7	9
	Ninth year						2529 4 1
1890							
Mar. 16	Payment from the W. Co. of instalment of purchase-money, proportion appertaining to English patent. (See Appendix C.)						2148 7 9
	Tenth year						
1891							
Mar. 16	Ditto						2148 7 9
	Eleventh year						
1892							
Mar. 16	Ditto						2148 7 9
	Twelfth year						
1893							
Mar. 16	Ditto				2148	7	9
Aug. 10	Amount of commutation of remaining purchase instalments from W. Co., proportion appertaining to English patent. (See Appendix C.) . .				5757	4	11
							7905 12 8
							£16,971 0 0

NOTE.—If the value to be placed upon the English patent, in accordance with the note to Appendix C., is, as the petitioners submit, the sum of £9700, and not the sum of £16,671, as estimated in Appendix C., the total profits of Dr. H. will be reduced to £9950.

(a) In this case extension of the patent monopoly was refused, on the grounds that the petitioning patentee had been adequately remunerated, and the petitioning company were in the position of commercial speculators, and had not the kind of merit required to justify extension to assignees.

No. 28.

Second Part.

The Account of the Petitioners, The W. Electric Company, Limited.

A very detailed note setting out at the head of this account the circumstances attending the formation of the English company, and showing how the American company was merely in effect a trustee for the English company, is here omitted.

Dr.	Expenditure.	£	s.	d.	£	s.	d.
1889							
Mar. 16	Paid to Dr. H. in respect of option of purchase, proportion appertaining to English patent. (See Appendix C.)	171	16	4			
Apl. 6	Paid to Dr. H. on agreement to purchase, proportion appertaining to English patent. (For explanation see Appendix C.)	2148	7	9			
June 10	Patent fees for renewal of English patent	10	0	0			
June 29	Retaining Profs. F. & K. and consultation fees	117	17	0			
	Office expenses for half year. (For explanation see Appendix C.)	515	0	0			
					2963	1	1
1890							
Mar. 16	Paid to Dr. H. in respect of first instalment of purchase-money, proportion appertaining to English patent. (See Appendix C.)	2148	7	9			
June 27	Patent fees for renewal of English patent	15	0	0			
Sept. 22	Messrs. N. & Co.'s charges, *re* license to St. P. Vestry	32	9	0			
Nov. 19	Messrs. A. & I., *re* declaration of trust	3	3	0			
	Office expenses for one year. (See Appendix C.)	1030	0	0			
					3228	19	9

Receipts.	Cr. £	s.	d.
Eighth year 1889—nil			
Ninth year 1890—nil			

Note.—During the years 1889 and 1890 the petitioning company were using every endeavour to introduce the invention, but central station lighting was just being introduced, and was in the hands of wealthy companies, who repudiated the patent rights of the petitioning company, and it was not until the following year that the petitioning company were able to procure the adoption of their patented invention.

1891							
Feb. 28 / May 5	Paid to Messrs. A & I., *re* declaration of trust		45	4	7		
Mar. 16	Paid to Dr. H. in respect of second instalment of purchase-money, proportion appertaining to English patent. (See Appendix C.)		2148	7	9		
July 22	Patent fees for renewal of English patent		15	0	0		
Sept. 22	Messrs. N. & Co.'s bill of costs to date, *re* 3-wire patent		90	4	4		
Dec. 31	Messrs. F. & O.'s costs, *re* patent action against P. M. Co.		101	4	9		
	Office expenses for one year. (See Appendix B.)		1030	0	0		
						3430	1 5
		Carried forward				£9622	2 3

Tenth year					
1891	Royalties received. (See Appendix A.)			880	0 0
		Carried forward		£880	0 0

Accounts similar to the above were also presented for the later years of the Letters Patent, shewing a loss of nearly £6000 to the petitioning company.

The following Appendices were annexed to the accounts in this case: Appendix A. "Details of Royalties received by the Petitioning Company;" Appendix B. dealing with office expenses chargeable against English patent; and Appendix C. shewing separate values of the English and German patents. Tabulated statements shewing the receipts from the German and American patents were also annexed; also summaries shewing (1) profits of the patentee from the English patent; (2) Joint profits of the patentee and the petitioning company from the English patent; (3) Joint profits of the patentee and the company from the English, German, and American patents.

Forms.

C.—ACTION FOR INFRINGEMENT.

No. 29.

Indorsement on Writ.

In the High Court of Justice, 1892, W. No.
Chancery Division.
Mr. Justice .
Between W. R. & Company, Limited,
and J. D. . . . . Plaintiffs
and
T. P. . . . . Defendant.

The plaintiffs' claim is for:—

1. An injunction to restrain the defendant, his servants and agents, from infringing the Letters Patent, No. of 18 , granted to J. D. the younger, for "Improvements in the Extracting Mechanism of Drop-down Small Arms," which patent, by an assignment dated the day of and duly registered, is now vested in the plaintiff, J. D.

2. An account of profits, or, at the option of the plaintiffs, an enquiry as to damages.

3. Delivery up by the defendant of all guns or portions of guns made in infringement of the plaintiffs' rights.

4. Costs. (*a*)

No. 30.

Indorsement on Writ.

In the High Court of Justice, 1891, L. No.
Chancery Division.
Mr. Justice .
Between W. L. . . . Plaintiff
and
F. G. E. M. and
W. W. . . . Defendants.

The plaintiff's claim is:—

1. For an injunction to restrain the defendants, their servants and agents, from infringing the plaintiff's Letters Patent, numbered , of the year 1880.

(*a*) *Westley Richards & Co. v. Perkes.*

2. For damages for such infringement, or, at the option of the plaintiff, an account of all profits derived by the defendants from such infringement.

3. For the delivery up to the plaintiff or the destruction of all articles in the possession of the defendants made in such infringement.

4. For costs. (*a*)

No. 31.

Indorsement on Writ.

In the High Court of Justice, 1894, T. No.
Queen's Bench Division.
Between J. A. T. and
H. L. T. . . . Plaintiffs.
and
A. R. . . . Defendant.

The plaintiffs' claim is for an injunction restraining the defendant, his servants or agents, from infringing the Letters Patent granted to , and now vested in the plaintiffs, dated 1891, and numbered , and for damages, or, alternatively, an account, and costs. (*b*)

No. 32.

Indorsement on Writ.

In the High Court of Justice,
Chancery Division.
Mr. Justice .
Between the P. T. Company, Limited, and
the D. P. T. Company, Limited . Plaintiffs
and
the T. P. T. and C. H., Limited,
J. B. D. H. H., Junr.,
and C. H. & Company, Limited . Defendants.

The plaintiffs' claim is for:—

1. An injunction to restrain the defendants and their respective servants and agents from infringing the Letters Patent owned by the plaintiff companies.

2. Damages, or, at the option of the plaintiffs, an account of profits.

(*a*) *Lyon* v. *Goddard*. (*b*) *Thierry* v. *Rielmann*.

Forms.

3. Delivery up by the defendants of all tyres and parts of tyres made in infringement of the said Letters Patent or either of them.

4. Costs as between solicitor and client. (*a*)

No. 33.

Statement of Claim.

[*Insert Heading as in Form No.* 29.]

Statement of Claim.

1. The plaintiff, J. D., by virtue of an assignment dated the day of and duly registered, is the owner of certain Letters Patent, No. of 18 , granted to J. D. the younger for "Improvements in the Extracting Mechanism of Drop-down Small Arms," of which the said J. D. the younger is the first and true inventor. The plaintiffs, W. R. & Company, Limited, are the sole licensees under the said Letters Patent.

2. The defendant is a gun manufacturer, carrying on business at , in the County of Middlesex.

3. The said Letters Patent are valid, and of full force and effect.

4. The defendant has for some time past manufactured and sold both guns and gun actions fitted with ejecting mechanism made in infringement of the plaintiffs' Letters Patent.

The plaintiffs claim:—

1. An injunction to restrain the defendant, his servants and agents, from making, using, and vending guns containing an ejector mechanism, or portions thereof, made in infringement of the plaintiffs' Letters Patent, or made so as to be a colourable imitation of the invention therein contained.
2. An account of profits, or, at the option of the plaintiffs, an enquiry as to damages.
3. Destruction of, or delivery up, by the defendant to the plaintiffs of all guns or portions of guns made in infringement of the plaintiffs' rights.
4. Costs.

(Signed)

Delivered, etc.

No. 34.

Another Form of Claim.

[*Insert Heading as in Form No.* 30.]

Statement of Claim.

The defendants have infringed the plaintiff's Patent, No. , A.D. 1880, granted for the term of fourteen years from the day of

(*a*) *Pneumatic Tyre Co.* v. *Tubeless Pneumatic Tyre and Others.*

, 1880, for "Certain Improvements in the Construction and Arrangement of Apparatus for Purifying, Disinfecting, Drying, and Heating," whereof the plaintiff was the first inventor. Forms.

The plaintiff claims—

1. An injunction to restrain the defendants from further infringement.
2. An enquiry as to the damages sustained by the plaintiff by reason of the infringement, or, at plaintiff's option, an account of profits made by the defendants.
3. That the defendants may be ordered to pay the plaintiff the amount so found to be due.
4. That the defendants may be ordered forthwith to deliver up to the plaintiff, to be destroyed, all machines or apparatus made in infringement of the plaintiff's patent.
5. Costs.

(Signed)

Particulars of breaches are delivered herewith and annexed hereto.

Delivered, etc.

No. 35.

Another Form of Claim.

[*Insert Heading as in Form No.* 31.]

Statement of Claim.

1. The plaintiffs, J. A. T. and A. L. T., carry on business at No. , Street, London, as boot manufacturers, and are the owners of Letters Patent, No. , of A.D. 1891, granted to them for an "Improvement in Eyelets," and of which they are the original and true inventors.

2. The defendant carries on business at 59 Street, London, E.C., as agent for the F. C. E. Company, of S., Massachusetts, United States of America.

3. The said Letters Patent are valid and of full force and effect.

4. The defendant has infringed the plaintiffs' Letters Patent, No. , of A.D. 1891, as set forth in Particulars of Breaches delivered herewith.

The plaintiffs claim—

1. An injunction restraining the defendant, his servants and agents, from selling eyelets manufactured in infringement of the Letters Patent granted to, and now vested in, the plaintiffs, dated 1891, and numbered .
2. An account of all profits derived by the defendant from such infringement, or, at the plaintiffs' option, an enquiry as to damages sustained by such infringement.

Forms.

3. Delivery up to the plaintiffs or destruction of all eyelets made in infringement of plaintiffs' Letters Patent, No. , of A.D. 1891.

4. Costs.

(Signed)

Delivered, etc.

No. 36.

Another Form of Claim.

[*Insert Heading as in Form No.* 32.]

Statement of Claim.

1. The plaintiffs are the proprietors of the following Letters Patent, that is to say, No. , of 1888, granted to J. B. D. for "An Improvement in Tyres of Wheels for Bicycles, Tricycles, or other Road Cars;" No. , of 1890, granted to W. E. B. for "Improvements in Tyres or Rims for Cycles and other Vehicles," and No. , of 1890, granted to W. G. for "Improvements in Rubber Tyres and Rims, or Felloes for Wheels of Velocipedes and other Light Carriages."

2. All the aforesaid Letters Patent are good and valid, and the respective persons therein stated to be the true and first inventors thereof respectively were the true and first inventors.

3. The said Letters Patent, No. , of 1890, granted to W. E. B., were certified to be valid by Mr. Justice Romer on the day of , 1894.

4. The defendants have infringed all the said Letters Patent in the manner appearing in the Particulars of Breaches delivered herewith, and threaten to continue to infringe the same by the manufacture and sale of tyres made according to the inventions in respect of which the said Letters Patent were granted.

The plaintiffs' claim—

An injunction restraining the defendants, their servants, agents, or workmen, from infringing the said Letters Patent, No. , of 1888, No. , of 1890, and No. , of 1890.

That an enquiry may be made as to the damage sustained by the plaintiffs by the wrongful acts of the defendants as aforesaid, and that the defendants may be ordered to pay the amount thereof to the plaintiffs, or, at the option of the plaintiffs, that an account may be taken of all profits made by the defendants by such wrongful acts as aforesaid, and that the defendants may be ordered to pay the amount so ascertained to the plaintiffs.

That the defendants may be ordered to deliver up to the plaintiffs all tyres made according to the said inventions which may be in the possession, or under the control of any or either of them.

That the defendants may be ordered to pay the costs of this

action, and that the costs may be as between solicitor and client, in respect of the Letters Patent, No. , of 1890.

(Signed)

Delivered, etc.

No. 37.

Statement of Defence.

[*Insert Heading as in Form No.* 29.]

Defence.

Delivered, etc.

1. The said defendant denies that he has infringed the said Letters Patent as alleged, or at all.

2. The said J. D. the younger was not the first and true inventor of the invention described in the specification to the said Letters Patent.

3. The said Letters Patent are void, by reason that the invention was not new at the date of the said Letters Patent. Particulars of prior user and prior publication are delivered herewith.

4. The specification to the said Letters Patent does not sufficiently describe and ascertain the nature of the said invention, and the manner in which the same is to be performed in the following respects. Referring to page 4, lines 44 to 53, and to the illustrations, figures 1, 2, 10, and 11, the arrangements of the sliding rod "G" with the rocking arm "l" and the spring "m" is unworkable and incapable of being put in practice, and there is no alternative method shewn or described by which the sliding rod "G" could be actuated in the desired manner. The alternative arrangement described in page 5, lines 49 to 54, and claimed in the last claim, is unworkable, and could not be put in practice.

5. The said specification does not distinguish what is old from what is new in the following respects :—

The combination set forth in the first, second, and third claims were old at the date of the said Letters Patent for the reasons set forth in the Particulars of Objection.

(Signed)

No. 38.

Another Form of Defence.

[*Insert Heading as in Form No.* 30.]

Statement of Defence.

1. The defendants deny that they have infringed the plaintiff's Letters Patent in the manner set forth in the Particulars of Breaches, or at all.

Forms.

2. The defendants deny that the plaintiff was the first and true inventor of the improvements referred to in the first paragraph of the Statement of Claim.

3. The said Letters Patent are invalid for the reasons given in the Particulars of Objections which are delivered herewith.

(Signed)

Delivered, etc.

No. 39.

Another Form of Defence.

[*Insert Heading as in Form No.* 31.]

Defence.

Delivered, etc.

1. The defendant denies that he has infringed the Letters Patent in the Statement of Claim mentioned, and he further denies that the plaintiffs were the true and first inventors of the invention for which the said Letters Patent were granted.

2. The said Letters Patent are not now, nor were they ever, valid, or of any effect.

3. Particulars of Objections on which the defendant means to rely are delivered herewith.

(Signed)

No. 40.

Another Form of Defence.

[*Insert Heading as in Form No.* 32.]

Statement of Defence.

Delivered, etc.

1. The defendants do not admit that the plaintiff companies, or either of them, are the proprietors of the Letters Patent, No. , of 1888, No. , of 1890, and No. , of 1890, in the Amended Statement of Claim mentioned, or any of them.

2. All the said Letters Patent are invalid for the reasons stated in the Particulars of Objections delivered herewith, and the persons therein respectively stated to be the true and first inventors thereof were not the true and first inventors.

3. The defendants have not, nor has any of them, infringed the said Letters Patent, or any of them, in the manner alleged in the Particulars of Breaches, or at all, and the defendants do not, nor does any of them, threaten or intend to infringe the said patents, or any of them, as alleged in paragraph 4 of the Amended Statement of Claim, or at all.

4. The defendants deny that the plaintiff companies, or either of them, have sustained any damage, or are entitled to payment of any profits by reason of any of the alleged acts by the defendants, or any of them, of which the plaintiffs complain.

Particulars of Objections are delivered herewith.

(Signed)

No. 41.

Reply.

[*Insert Heading as in Form No.* 29.]

Reply.

As to the statement of defence the plaintiffs say that they join issue save in so far as the allegations made in the Statement of Claim and Particulars of Breaches are admitted.

(Signed)

Delivered, etc.

No. 42.

Another Form of Reply.

[*Insert Heading as in Form No.* 30.]

The plaintiff joins issue on the defence herein as contained in the Defence and Particulars of Objections delivered therewith.

Delivered, etc.

(Signed)

No. 43.

Another Form of Reply.

[*Insert Heading as in Form No.* 32.]

Delivered the day of , by of , the plaintiffs' solicitor.

The plaintiffs join issue except in so far as the same contains admissions with the defendants on the defences raised by them in their Defence and Particulars of Objections and amended and re-amended Particulars of Objections.

The plaintiffs will also contend, as to paragraphs B 4 and C 5 of the Objections, that the grant of Letters Patent to B. therein referred to was a grant in respect of an invention which is in no wise the same as the inventions for which the Letters Patent, , of 1890, and , of 1890 (patents sued on in this action) were granted.

(Signed)

Forms.

No. 44.

Particulars of Breaches.

[*Insert Heading as in Form No.* 29.]

Particulars of Breaches

Delivered by the plaintiffs with the Statement of Claim, the day of ,

The following are the Particulars of the Breaches complained of by the plaintiffs in this action, that is to say :—

1. That the defendant has at divers times previously to the commencement of this action, infringed the plaintiffs' Letters Patent, No. , A.D. 18 , by making, using, and applying in or to the extracting mechanism of drop-down small arms certain mechanism, being the same as the mechanism described in the Queen's printers' copy of the specification filed under the said Letters Patent, and claimed in claiming clauses 1 and 2 thereof, and by manufacturing and selling for his own profit, guns and gun actions having therein the mechanism aforesaid.

2. The plaintiffs complain in particular of the sale of a side-lever, hammerless ejector gun, No. , by the defendant to one, S. W. C., of , in the County of Middlesex, on the day of ,

3. The precise number, dates, and amounts of the defendant's infringements are not at present known, but the plaintiffs will claim to recover from the defendant full compensation in respect of all such infringements.

Delivered, etc.

No. 45.

Another Form of Particulars of Breaches.

[*Insert Heading as in Form No.* 30.]

Particulars of Breaches.

The following are the Particulars of the Breaches complained of in this action :—

That the defendants have at divers times since the day of December, 1886, and prior to the commencement of this action, infringed the plaintiff's Letters Patent and the claim thereof in manner following, that is to say—

That the defendants have, subsequently to the date of the plaintiff's patent, manufactured, in accordance with the provisions of certain alleged Letters Patent, No. , of A.D. 1886, certain apparatus for disinfecting by steam articles of all descriptions that are infected by germs of disease, and have sold the said apparatus, in which said apparatus there are arranged and combined together inner and outer chambers substantially in the improved manner described and claimed

in the Queen's printers' copy of the complete specification filed prior to the grant of the said Letters Patent as therein recited.

The defendants sold disinfecting apparatus infringing the plaintiff's Letters Patent—

To the Corporation of L., in the county of S., about November, 1887.

To the Borough Fever Hospital, L., in the county of L., during 1887.

To the Corporation of L., in the county of Y., on or about the day of June, 1890.

To the Corporation of B., in the county of C., about the month of October, 1890, and .

To the Corporation of D., about the month of April, 1891.

The exact number and dates of the defendants' infringements, save as hereinbefore mentioned, are not at present known to the plaintiff, but the plaintiff will claim to recover from the defendants full compensation in respect of all such infringements.

(Signed)

Delivered, etc.

No. 46.

Another Form of Particulars of Breaches.

[*Insert Heading as in Form No.* 31.]

The following are the Particulars of Breaches complained of by the plaintiffs in this action, that is to say—

1. The defendant has at various times, previous to and since the commencement of this action, infringed plaintiffs' Letters Patent, No. , of A D. 1891, by making, using, and selling, or offering for sale at 59, Street, London, E.C., and elsewhere, eyelets made in the manner described in the Queen's printers' copies of the specification of the said Letters Patent, without the leave or license of the plaintiffs.

2. By the admission of the defendant that he is making and selling eyelets made in the manner described in the Queen's printers' copies of the specification filed under the plaintiffs' Letters Patent, contained in a letter written by the defendant on , 1894, and sent to the plaintiffs.

3. The precise dates and amounts of the defendant's infringements are not at present known to the plaintiffs, but the plaintiffs will claim to recover from the defendant full compensation in respect of all infringements.

Delivered, etc.

Forms.

No. 47.

Another Form of Particulars of Breaches.

[*Insert Heading as in Form No.* 32.]

Particulars of Breaches

Delivered with the Statement of Claim in this Action by, etc.

The defendants have infringed all the Letters Patent in the Statement of Claim mentioned, by the manufacture and sale of tyres made according to the inventions in respect of which the said Letters Patent were granted.

The plaintiffs complain in particular of the manufacture and sale by the defendants of certain tyres now in the plaintiffs' possession, marked A, B, C, D, E, F, and G respectively, which tyres can be seen by the defendants at the offices of John B. Purchase, 11, Queen Victoria Street.

The plaintiffs cannot give further particulars of the infringements of the defendants until after discovery, but will claim to recover in respect of all infringements by the defendants, or any of them.

No. 48.

Particulars of Objections.

[*Insert Heading as in Form No.* 29.]

Particulars of Objections

Delivered the day of , 1892, by Messrs. , of , the above-named defendant's solicitors.

1. The inventions claimed by the first, fourth, and fifth claims of the specification of J. D., junior, [No.] of 18 , are anticipated by the specification of the defendant's patent [No.] of 18 , particularly with reference to the fourth claim and to the description and illustrations referring to that part of the defendant's therein-described invention.

2. The invention described in the second, fourth, and fifth claims was anticipated by one, L. E. H., at , in the County of London, between October and November , , by making a gun with ejecting mechanism similar in every respect to that described and claimed in the said second, fourth, and fifth claims to the said J. D.'s specification.

(Signed)

[*Insert Heading as in Form No.* 29.]

Further Particulars of Objections

Delivered pursuant to Order dated , 1892, by Messrs. of , defendant's solicitors.

1. The meaning of paragraph 4 of the Statement of Defence is that the ejecting mechanism when made in accordance with D.'s specification is unworkable, and not that D.'s specification does not sufficiently describe the invention to allow the same to be put in practice by a skilled workman.

2. The reference "to the fourth claim, and to the description and illustrations referring to that part of the defendant's therein-described invention" in paragraph 1 of the Particulars of Objections, means the fourth claim in the specification of the defendant, No. of 18 , and the whole of the fourth claim is relied upon.

3. The fifth paragraph of the Defence refers to both paragraphs of the Particulars of Objections, that is to say, with reference to the first claim to the matters alleged in the first paragraph only, with reference to the second claim to the matters alleged in the second paragraph only, and with reference to the fourth claim to the matters alleged in both paragraphs of the said Objections.

No. 49.

Another Form of Particulars of Objections.

[*Insert Heading as in Form No.* 30.]

Amended Particulars of Objections

Delivered pursuant to Order, dated the day of , 1892.

The defendants, besides denying that they have infringed the Letters Patent in the Statement of Claim mentioned, rely, in support of their defence to this action, on the following objections to the validity of the said Letters Patent :—

1. That the plaintiff was not the first and true inventor of the alleged invention comprised in the said Letters Patent.

2. That the alleged invention was not useful.

3. That the said alleged invention was not new at the date of the said Letters Patent.

4. That the said alleged invention was, previously to the date of the said Letters Patent, published within this realm in the following specifications respectively filed in the Patent Office as hereinafter mentioned, that is to say :—

(*a*) The specification of F.'s Patent, No. , of 1876. The whole final specification is relied on.

(*b*) The specification of F. & A.'s Patent, No. , of 1877, the complete specification, page , and lines to page and the drawings, are relied on.

(*c*) The whole provisional specification of W. L., dated the day of , 1879, and numbered .

5. That the alleged invention was used before the date of the said Letters Patent by the several persons at or in the several places following, that is to say :—

Forms.

(*a*) Messrs. S. & Sons at R., Nottingham, in the year 1872.

(*b*) The defendants, at their works at Nottingham, from the year 1872 down to the present time.

(*c*) Messrs. H., at their works at Nottingham, during the year 1870, and for some months prior and subsequent thereto.

(*d*) Messrs. S., at their works at Nottingham, in the year 1872, and for some months prior and subsequent thereto.

(*e*) The A. Laundry, at their works at Aberdeen, early in 1879.

(*f*) Messrs. J. P. & Co., at their works at York, during the year 1872, and subsequently thereto, till the date of the plaintiff's Letters Patent.

6. That the plaintiff, in his specification, pointed out and claimed no sufficient improvement on the then state of public knowledge to make his alleged invention good subject-matter for valid Letters Patent.

7. The plaintiff's invention has been publicly known and used in lace factories in the neighbourhood of Nottingham for a period of thirty years.

No. 50.

Another Form of Particulars of Objections.

[*Insert Heading as in Form No.* 31.]

Particulars of Objections

Delivered with the Statement of Defence in this action by Messrs. of , the defendant's solicitors.

The following are the Particulars of Objections upon which the Defendant will rely at the trial of this action with respect to the Letters Patent in the Statement of Claim mentioned.

1. That the specification filed in pursuance of the application for the said Letters Patent does not sufficiently describe or ascertain the nature of the said alleged invention or the manner in which the same is to be performed.

2. That the said alleged invention, as claimed in the said specification, was not new at the date of the said Letters Patent, but had been published within the realm before the said date in and by the publication following:—

(*a*) The specification of an invention for which Letters Patent No. , of 1889, were granted to W. H. S. The whole is relied on.

(*b*) The specification of an invention for which Letters Patent, No. , of 1890, were granted to W. H. S. The whole is relied on.

(*c*) The specification of an invention for which Letters Patent, No. , of 1882, were granted to J. L. J. in the United States of America. The whole is relied on.

(*d*) The specification of an invention for which Letters Patent, No. , of 1889, were granted to W. H. S. in the United States of America. The whole is relied on. **Forms.**

No. 51.

Another Form of Particulars of Objections.

[*Insert Heading as in Form No. 32.*]

Particulars of Objections

Delivered by the defendants the day of , 1897, by Messrs. of , London, agents for of , solicitors for the defendants.

The defendants, besides denying that they have infringed any of the Letters Patent in the Amended Statement of Claim mentioned, rely in support of their defence to this action on the following objections to the validity of the said Letters Patent respectively :—

A. As to D.'s Patent No. , of 1888.

1. The said J. B. D. was not the true and first inventor of the alleged invention comprised in the said Letters Patent and claimed by the complete specification thereof as amended.

2. The said alleged invention so claimed was not new at the date of the said Letters Patent, but previously thereto was published within the realm ; (*a*) in the specification of Letters Patent, No. , of 1845, granted to R. W. T., upon the whole of which specification and the drawings thereto the defendants rely ; (*b*) in a description of a carriage fitted with tyres made according to an improved form of T.'s invention, published in Vol. (1851) of the *Mechanics' Magazine* at page . The description relied on commences with the words—

3. The said alleged invention claimed by H.'s amended complete specification is not proper subject-matter for Letters Patent.

4. The said alleged invention claimed as aforesaid is not useful.

5. The alleged invention claimed as aforesaid is not the same as the invention (if any) described in the provisional specification filed on the application for the said Letters Patent, and is, moreover, a different invention from the invention claimed by the said complete specification before amendment.

6. The provisional specification does not describe the nature of the alleged invention, or of any invention.

7. The said complete specification as amended does not sufficiently describe and ascertain the nature of the alleged invention, or in what manner the same is to be performed.

B. As to B.'s Letters Patent, No. , of 1890, the defendants say that if the invention comprised therein be held, upon the true construction of the complete specification of the said patent, to include the tyres alleged to

Forms.

be infringements thereof in this action, the said patent is invalid for the following reasons, viz.:—

1. The said W. E. B. was not the true and first inventor of the alleged invention comprised in the said Letters Patent.

2. The said alleged invention was not new at the date of the said Letters Patent, but previously thereto was published within this realm in the following publications:—

The specifications of the following Letters Patent.

[*The List of Anticipating Patents is here omitted.*]

3. The said alleged invention is not proper subject-matter for valid Letters Patent.

4. The said Letters Patent are invalid by reason of the prior grant of the patent of B., No. , of 1890, above mentioned.

5. The complete specification claims an invention different from, and larger than, the invention described in the provisional specification, if, on the true construction thereof, the thickening of the edges of the cover, or the holding of the cover to the rim by any dovetailing or hooking action, are part of the invention claimed, inasmuch as the provisional specification in no way describes such thickening or any such action.

C. As to G.'s Patent, No. , of 1890.

1. The said W. G. was not the true and first inventor of the alleged invention comprised in the said Letters Patent.

2. The said alleged invention was not new at the date of the said Letters Patent, but previously thereto was published within this realm (*a*) in the publications hereinbefore stated, as anticipating B.'s Patent; and (*b*) by the manufacture, or sale, or exhibition, or user, by the said W. E. B., and by the N. B. R. Company, of tyres made according to B.'s specification, No. , of 1890, in the months of , 1890, and by the publication by the said B. and the said company in the same months of circulars describing tyres according to the said specification; and (*c*) by an article on page in the issue of , 1890, of "B. News," beginning with the words down to , and by the three diagrams at the top of the sheet facing page in the same issue. By an article in the "S. C.," dated , 1890, beginning with the words on page down to on page . By an article on page of the "C. T. C. M. G." of , 1890, beginning with the words down to , and by three diagrams on the top of page . These defendants rely on the said publications and prior users as anticipating claiming clauses 1 to 7 inclusive, of G.'s complete specification.

3. The said alleged invention is not useful.

4. The said alleged invention is not proper subject-matter for Letters Patent.

5. The said Letters Patent are invalid by reason of the prior grants of the patents of B. No. , of 1890, and No. , of 1890, above mentioned.

6. If according to the true construction of G.'s complete specification

Forms.

the same in any way describes or claims the fastening of the metal rim by means of lugs, projections, or thickened edges of a tyre, such as the tyres of which the plaintiffs are complaining as infringements in this action, or of a tyre consisting of an inner tube with a detachable cover, the invention described and claimed in G.'s complete specification is not the same as the invention described in his provisional specification, but differs therefrom in that such provisional specification in no way describes or indicates tyres of either of the forms above referred to.

7. If on the true construction of G.'s complete specification and Fig. 3 thereof, the same be held to include tyres consisting of an inner air tube and detachable cover held in a flanged or grooved rim, his patent is invalid by reason of the Crown having, prior to the date of his complete specification, validly granted to one N. by Letters Patent, dated and numbered , the sole right of manufacturing, using, and selling tyres so constructed and operating, the same not being included in G.'s provisional specification.

No. 52.

Interrogatories in an Action for Infringement. (*a*)

[*Insert Heading in Action.*]

Interrogatories

On behalf of the above-named Plaintiff for the examination of the above-named Defendant.

1. Have the defendants or any and which of them at any time or times since the day of , and when, caused to be manufactured and whether or not sold and whether or not delivered to the purchasers thereof in this country and whether or not exported for sale fasteners or clips for the purpose of securing card clothing to the flats of carding engines and whether or not were such fasteners or clips constructed of strips or bands of sheet metal bent near to and along both edges and whether or not applied for securing clothing to the flat bars of carding engines in such manner that one bent portion of the strip or band tightly held the foundation fabric of the clothing while the other bent portion of the strip or band gripped along the back of the bar and whether or not were the edges or selvages of the foundation fabric secured to the bars by such fasteners and whether or not enclosed by such fasteners and whether or not encased by such fasteners and whether or not were the edges of the bars enclosed by such fasteners and whether or not encased by such fasteners, whereby the necessity for perforating or nicking the bars or using rivets, pins, prongs of the fasteners and the like was avoided and whether or not were such fasteners or clips constructed and applied substantially according to the invention described and claimed in the specification of the patent of the day of , No. in the Statement of Claim mentioned, and in what respect or particulars did such fasteners or clips differ therefrom?

(*a*) *Tweedale* v. *Ashworth.*

Forms.

2. Have the defendants or any and which of them at any time or times since the day of , and when, manufactured or used or sold or applied fasteners or clips for the purpose of attaching clothing to carding engine flats constructed and applied substantially as described in the specification of a patent dated the day of , No. , and granted to the defendants in this action? Let the defendants set forth by reference to the said specification which of the several figures in sheets 1 and 2 of the drawings accompanying the said specifications, such fasteners or clips so made or used or sold or applied as aforesaid substantially resembled in their construction and in the manner in which they were applied for attaching the clothing of carding engines to the flats thereof.

3. Have the defendants or any and which of them at any time or times since the day of , and when, manufactured or sold or offered for sale or used or applied or caused to be manufactured or used or sold or offered for sale or applied fasteners or clips for the purpose of attaching clothing to carding engine flats constructed and applied substantially as described in the specification of a patent dated , No. , and granted to the defendants in this action? Let the defendants set forth by reference to the said specification which of the several figures in the drawings accompanying the said specification such fasteners or clips as aforesaid substantially resembled in their construction and mode of application.

4. Did not the defendants construct and manufacture and whether or not sell and whether or not deliver any and what number of flat carding engines or parts of carding engines wherein the carding clothing was fastened to the flats by means of fasteners or clips such as are mentioned in these interrogatories or the answers thereto to Messrs. F. of or to some and what other person as the purchaser thereof, and when and where did the defendants so deliver the same?

5. Have the defendants or any and which of them now in his or their possession, power, and control any and what number of fasteners or clips such as are mentioned in these interrogatories or the answers thereto, and when were the same made and where are the same or any, and which of them, now deposited and to be seen?

6. Let the defendants set forth fully and particularly the names and addresses of the persons respectively to whom the defendants have, since the day of , sold and delivered such fasteners or clips as aforesaid, and the respective dates at which such fasteners or clips were respectively so sold and delivered, and have the defendants granted any license or licenses under the said patents, No. of , and No. of , or either of them, to any and what person or persons, and when have the same been granted?

7. Let the defendants set out by reference to the specification of the plaintiff's patent, No. of , in what respects or particulars the said specification does not sufficiently describe or ascertain the nature of the plaintiff's said invention, or the manner in which the same is to be performed, as alleged by the defendants in paragraph of their Particulars of Objections delivered in this action.

8. Specify the inventions which you allege in paragraph of your Particulars of Objections to be not comprised in plaintiff's provisional specification, but to be described and claimed in his complete

specification, and point out by reference to the said specification the parts thereof on which you rely in support of such allegation. Forms.

9. Specify the inventions claimed in plaintiff's complete specification which you allege in paragraph of your Particulars of Objections to be not comprised in the title of plaintiff's said patent, and point out by reference to the said specification the parts on which you rely in support of such allegation.

Each of the defendants is required to answer all the foregoing interrogatories.

Delivered, etc.

No. 53.

Defendants' Answers to Interrogatories. (*a*)

[*Insert Heading in Action.*]

The Answer of the above-named Defendants to the Interrogatories for their Examination by the above-named Plaintiff.

In answer to the said interrogatories, we and , the above-named defendants, make oath and say as follows:—

1. Both the defendants have, since the day of , upon divers dates manufactured or caused to be manufactured, and have sold and delivered to the purchasers thereof in this country, but have not exported for sale fasteners clamps or clips for the purpose of securing card clothing to the flats of carding engines. Such fasteners clamps or clips were constructed of strips or bands of sheet metal bent to nearly right angles near to and along both edges; such fasteners clamps or clips were applied for securing clothing to the flat bars of carding engines in such manner that one limb of the clamp pressed the foundation fabric upon the face of the bar, whilst the other limb of the clamp bore and abutted upon the back of the bar. The margins of the strips of card clothing were secured or clamped to the bars by such fasteners, but such strips of card clothing or foundation fabric were without selvages. All such fasteners clamps or clips made by the defendants as aforesaid were in all respects the same as those mentioned in the Particulars of Breaches as having been supplied to Messrs. F., and by the use of such fasteners clips or clamps as aforesaid the necessity for perforating or nicking the bars or using rivets pins and prongs of the fasteners and the like was avoided. Such fasteners or clips or clamps as aforesaid were not constructed and applied substantially according to the invention described in the specification of the patent, dated , No. , in the Statement of Claim mentioned, but were all of them constructed as above mentioned.

2. In answer to the second interrogatory the defendants say that they have both of them, since the day of , manufactured or used or sold or applied, or caused to be manufactured or used or sold or applied, fasteners or clips or clamps for the purpose of attaching

(*a*) *Tweedale* v. *Ashworth*.

Forms.

clothing to carding engine flats constructed and applied substantially as illustrated by the several figures and of the sheets of drawings accompanying the specification of Letters Patent, dated , No. , granted to the defendants in this action.

3. In answer to interrogatory 3, the defendants have not manufactured or sold or offered for sale or applied fasteners or clips for any purpose constructed according to the specification mentioned in this interrogatory.

4. In answer to the fourth interrogatory, the defendants have constructed, manufactured and sold and delivered, eighteen carding engines or thereabouts having revolving flats wherein the card clothing was fastened to the flat by means of fasteners or clips resembling such as are mentioned in the answer to the first and second interrogatories as having been applied by the defendants hereto to machines for Messrs. F. of .

5. In answer to the fifth interrogatory, the defendants have in their possession, power and control fasteners, clips and lamps similar to those mentioned in the answer to the first and second interrogatories as having been made and sold by the defendants all of which have been made since the day of , and some of which were made prior to the issue of the writ in this action. The same are now deposited in our works at .

6. In answer to the sixth interrogatory, the defendants decline at the present stage of the proceedings to give the names and addresses of their customers. With reference to the second paragraph the defendants say that it is wholly immaterial to the present issue to state whether the defendants have or have not granted any license or licenses to work the patents referred to in this interrogatory.

7. In answer to the seventh interrogatory, the defendants say that if the invention described in the specification therein mentioned be so ascertained that the specification contains a claim to such fasteners as those made by them as above mentioned it would claim an invention which is not described, and the defendants say that the mechanism described in the plaintiff's specification at line to line , both inclusive, on page , and illustrated by the second and third sheets of drawings to the said specification do not sufficiently describe or ascertain the manner in which the plaintiff's invention is to be performed.

8. In answer to the eighth interrogatory the defendants say that if the complete specification be construed to contain a claim to such fasteners as those made by them above mentioned, an invention will be claimed in the complete specification which is in no way referred to in the provisional specification.

9. In answer to the ninth interrogatory the defendants will not contend that the plaintiff's specification claims certain alleged inventions which are not comprised in the title.

10. The defendants decline to answer any of the above interrogatories further, on the ground that they are immaterial at this stage of the action and irrelevant and relate to matters of argument and construction.

Sworn, etc.

No. 54.

Order Permitting Amendment of Particulars of Objections.

[*Insert Heading in Action.*]

Upon hearing the solicitors on both sides, it is ordered that the defendant be at liberty within seven days to amend his Particulars of Objections delivered 27th December, 1894, and to deliver to the plaintiffs further Particulars of Objections with respect to the Letters Patent mentioned in the Statement of Claim herein mentioned, in seven days, and that the plaintiffs have fourteen days after delivery thereof to elect if they will continue or discontinue this action. If the plaintiffs discontinue, it is ordered that the defendant pay to the plaintiffs their taxed costs of action since the 27th December, 1894, and that the plaintiffs do pay to the defendant his taxed costs up to that date; the Taxing Master to certify the amount due from and to be paid to either party in respect of such taxation. If the plaintiffs elect to continue the action it is ordered that their costs of this application and of and occasioned by amendment be their costs in any event. And it is ordered that the plaintiffs have three weeks after delivery of amended Particulars to deliver their reply. (*a*)

Dated, etc.

No. 55.

Order Permitting Amendment of Particulars of Objections.

[*Insert Heading in Action.*]

Upon hearing, etc., it is ordered that the defendants be at liberty to amend their Particulars of Objections as advised within seven days, the costs of and occasioned by such amendment to be the plaintiffs' in any event. The plaintiffs to be entitled to elect to discontinue the action within six weeks from the date of this order on giving notice to the defendants, in which event the defendants are to be at liberty to tax their costs up to and including the day of (*b*), and the plaintiffs are to be at liberty to tax their costs of this action subsequently to that date, and the Master is to set off the plaintiffs' costs against the defendants' and certify the balance payable by either party. (*c*)

No. 56.

Notice of Motion for an Interlocutory Injunction.

[*Insert Heading in Action.*]

Take notice that this Hon. Court will be moved on the day of at 10.30 o'clock in the forenoon, or so soon thereafter as

(*a*) *Thierry* v. *Rickmann.*

(*b*) Date at which the original Particulars of Objections were delivered.

(*c*) See *Wilson* v. *Wilson*, 16 R. P. C. 315.

Forms.

counsel can be heard, by counsel on behalf of the above-named plaintiff, that the defendant, his servants, agents, and workmen may be restrained by the order and injunction of this Hon. Court until judgment in this action or further order from infringing the plaintiff's Letters Patent, No. of , by manufacturing *lamps* according to the method described in the complete specification of the plaintiff's said Letters Patent, or in any manner only colourably differing therefrom, and from selling, offering for sale, supplying, or using any *lamps* so made as aforesaid in infringement of the plaintiff's said Letters Patent, or that such other order may be made in the premises as to the Court may seem meet.

No. 57.

Another Form of Notice of Motion.

[*Insert Heading in Action.*]

Take notice that this Court will be moved before his Lordship Mr. Justice on the day of at o'clock, or so soon thereafter as counsel can be heard, by Mr. , as counsel for the above-named plaintiffs, that the defendant his and each of his servants, workmen, and agents may be restrained by the order and injunction of this Hon. Court from making and selling or offering for sale *pneumatic tyres* made in infringement of the plaintiffs' Letters Patent No. of A.D. , or from making, selling, or using any *pneumatic tyres* made in colourable imitation of the invention described and claimed in the specification filed under the said Letters Patent until the trial of this action, or until further order.

No. 58.

Order for an Interlocutory Injunction.

[*Insert Heading in Action.*]

Upon Motion this day made unto this Court by counsel for the plaintiffs, and upon hearing counsel for the defendants, and upon reading the writ of summons issued on the day of , an affidavit of C. K. W., an affidavit of H. C., an affidavit of J. B. P., and an affidavit of E. H., all filed the day of , 1896, and an affidavit of R. E., filed the day of , 1896, and the exhibits therein respectively referred to, and the affidavit of A. C., filed the day of , 1896, and the plaintiffs by their counsel undertaking to abide by any order the Court may make as to damages in case the Court shall hereafter be of opinion that the defendants shall have sustained any by reason of this order which the plaintiffs ought to pay:

This Court doth order that R. E. and J. T. S., trading as the L. P. T. & A. V. Company, their servants and agents, be restrained until judgment in this action or further order, from infringing the Letters Patent, No. of A.D. , granted to C. K. W., of which

the plaintiffs are owners, by manufacturing and selling pneumatic tyres of the same construction as those described in the specification of the said Letters Patent or only colourably differing therefrom. (*a*)

No. 59.

Order Refusing an Interlocutory Injunction,

Defendant Keeping an Account.

[*Insert Heading in Action.*]

Upon Motion this day made unto this Court by counsel on behalf of the above-named plaintiff that the above-named defendants might be restrained, etc., etc., and upon hearing counsel for the defendants, and upon reading the plaintiff's Statement of Claim and Particulars of Breaches and the affidavit of etc., etc.: And the defendants undertaking by their counsel until the trial of this action or the further order of this Court to keep an account of all the etc. alleged to be an infringement of the plaintiff's aforesaid Letters Patent made or sold by them, this Court doth not think fit to make any order on the said motion other than that the costs of the said motion be costs in the action.

No. 60.

Order for Discovery of the Names and Addresses of Defendant's Customers

In aid of Enquiry as to Damages.

[*Insert Heading in Action.*]

Upon Motion, etc., it is ordered that the defendants do within four days after service of this order make and file an affidavit or affidavits, stating the number of brick-cutting machines made or caused to be made by them since , the date of the plaintiff's Letters Patent mentioned, etc., and the names and addresses of the persons to whom the same respectively have been sold or for whom the same have been purchased, and the number of machines now in course of construction, and of the licenses granted by the said defendants, or either of them, to any persons to make or use the said machines, with the names and addresses of the said persons to whom such licenses have been granted, and the number of licenses granted by the defendants, or either of them, to any persons to use the said machines, together with their names and addresses, and the places where the said machines are respectively licensed to be used, and the amount of royalties to be received by or for the use of the said defendants, or either of them, for the granting of such licenses in respect thereof. (*b*)

(*a*) *Pneumatic Tyre Co.* v. *Leicester.* on Decrees, 567.
(*b*) *Murray* v. *Clayton.* See Seton

Forms.

No. 61.

Order on Application of Defendants for Inspection of Plaintiffs' Process by Experts.

[*Insert Heading in Action.*]

Upon Motion, etc., it is ordered that J. I. and one other indifferent person appointed by him, and A. C., one of the defendant's solicitors, be at liberty at all such times and as often as in the opinion of the said J. I. be requisite, on giving three days' notice to the plaintiffs, to enter into some business premises to be selected by the plaintiffs where the process or mode of working referred to in the specification mentioned in the Statement of Claim can be seen at work, and to inspect and examine there the whole of the machinery fitted in such mill, and to take such samples of the finished and unfinished products of the working of such machinery as in the opinion of the said J. I. may be necessary for the purposes of this action. And it is ordered that such machinery be put to regular work upon such inspection. The costs of this application are to be costs in the action. (*a*)

No. 62.

Notice of Motion for Judgment.

In the High Court of Justice, 189 etc.
Chancery Division.
Mr. Justice .
Between A. B. . . . . Plaintiff,
and
C. D. . . . . Defendant.

Take Notice, that this Hon. Court will be moved before his Lordship Mr. Justice on the day of or so soon thereafter as counsel can be heard, by counsel on behalf of the above-named plaintiff for judgment, in the terms set forth in the schedule hereto.

Schedule.

No. 63.

Judgment After Trial of Action.

Final Judgment Dismissing Action.—C. D.

[*Insert Heading in Action.*]

This action, coming on the day of and this day for trial before this Court, in the presence of counsel for the plaintiffs and defendants, and upon hearing the writ issued and the pleadings in this action, and the evidence of the several persons named in the

(*a*) *Germ Milling Co.* v. *Robinson*, 3 R. P. C. p. 14.

schedule hereto on their examinations taken orally before this Court upon the several days set opposite their names in the second column of the said schedule, and the several documents and other exhibits produced to such persons on their said examinations set forth in the third column of the said schedule opposite to the names of such persons respectively, and what was alleged by counsel on both sides:

This Court doth order that this action do stand dismissed out of this Court, with costs to be taxed by the Taxing Master. And it is ordered that the plaintiffs, the P. T. Company, etc., do pay to the defendants, the T. P. Company, etc., the amount of their said costs when taxed, Mr. , of the firm of , the solicitor for the defendants, personally undertaking, in the event of this order being reversed on appeal, to abide by any order which this Court may make as to their refunding to the plaintiffs the costs of this order directed to be paid to them by the plaintiffs, and this Court certifies, pursuant to Section 29 of the Patents, etc., Act, 1883, that the Particulars of Objections of the defendants to D. & G.'s Patents are reasonable and proper. (*a*)

Schedule.

No. 64.

Judgment for Plaintiffs Directing an Enquiry as to Damages.

[*Insert Heading in Action.*]

Dated the day of , 1895.

This action having, on the and days of , 1895, been tried before the Honourable Mr. Justice without a jury, in the County of Middlesex, and the said Mr. Justice , on the day of , 1895, having ordered that judgment be entered for the plaintiffs with costs, and granted an injunction restraining the defendant, his servants, or agents, from infringing the Letters Patent granted to and now vested in the plaintiffs, numbered , of 1891, and granted his certificate that the validity of the said Letters Patent came in question, and also directed that an enquiry be had before one of the referees as to what sum of money is fit to be awarded to the plaintiffs in respect of the losses and injury sustained by them by reason of the infringements of the defendant: And that the defendant pay to the plaintiffs such sum of money as shall be certified as fit to be awarded to the plaintiffs, within twenty-one days after the filing of the certificate or report in answer to such enquiry, and further directed that the defendant deliver up to the plaintiffs, within one month, any eyelets in his possession made in infringement of the said Letters Patent, and that the injunction and enquiry and order for delivery up be stayed for three weeks, and if an appeal be entered by the defendant within that time, be further stayed until such appeal is decided, the defendant undertaking to keep an account of the sale of any eyelets in the meantime; the costs then taxed to be paid to the

(*a*) *Pneumatic Tyre Co.* v. *Tubeless Tyre, etc., Ltd.*

Forms.

plaintiffs' solicitors upon their giving the usual undertaking to return them if so ordered. It is this day ordered and adjudged that the defendant, his servants, or agents, be, and they are, hereby restrained from infringing the Letters Patent granted to, and now vested in, the plaintiffs, dated 1891, and numbered : And it is further adjudged that an enquiry be had before one of the official referees as to what sum of money is fit to be awarded to the plaintiffs in respect of the loss or injury sustained by them by reason of the infringements of the defendant: And that the defendant, A. R., do pay to the plaintiffs such sum of money as shall be certified as fit to be awarded to the plaintiffs within twenty-one days after the filing of the certificate or report in answer to such enquiry. And it is also ordered and adjudged that the defendant deliver up to the plaintiffs, within one month, any eyelets in his possession made in infringement of the said Letters Patent: And it is ordered that the injunction and enquiry and order for delivery up of eyelets be stayed for three weeks, and if an appeal be entered by the defendant within that time, be further stayed until such appeal is decided, the defendant undertaking to keep an account of the sale of any eyelets in the meantime.

And it is ordered that the defendant pay the costs of the plaintiffs of this action, to be taxed, the plaintiffs solicitor giving the usual undertaking to return them if so ordered. (*a*)

No. 65.

Judgment for Plaintiffs Ordering an Account.—Q.B.D.

[*Insert Heading in Action.*]

Dated and entered the day of .

This action having on the days of been tried before the Hon. Mr. Justice without a jury, in the County of Middlesex, and the said judge on the day of having ordered that judgment be ordered for the plaintiff, and that the defendants, their servants and agents, be restrained during the continuance of the Letters Patent, No. , of 18 , from manufacturing, selling, letting on hire, supplying, or using any machine or apparatus for disinfection manufactured according to or in the manner described in the specification filed in pursuance of such Letters Patent, or in any manner only colourably differing from the same: And the judge having further directed that an account should be taken before one of the official referees of all machines or apparatus for disinfection made in infringement of the said Letters Patent which have been manufactured, or sold, or let for hire by or by the order, or for the use or profit of the defendants, and also of the gains and profits made by the defendants by reason of such manufacture, sale, or letting for hire: and that the defendants do within seven days after the service upon them of the Official Referee's report of the result of such account, pay to the plaintiff the amount of such gains and profits, the defendants by their counsel undertaking to bring into the said account

(*a*) *Thierry* v. *Riekmann.*

all such machines or apparatus for disinfection as aforesaid as are now in their possession, custody, or power, whether completed or in process of manufacture, and to give notice of appeal, and enter the same within three days from the service of this judgment upon them.

The judge further directed that the injunction, so far as relates to the machines or apparatus comprised in the said undertaking, be suspended until the said appeal has been heard and determined, and the judge further directed that the defendants do pay to the plaintiff the costs of this action, such costs to be taxed.

It is therefore adjudged that the defendants, their servants and agents, be restrained during the continuance of the Letters Patent, No. of 18 , from manufacturing, selling, letting on hire, supplying, or using any machine or apparatus for disinfection manufactured according to or in the manner described in the specification filed in pursuance of such Letters Patent, or in any manner only colourably differing from the same.

And it is ordered and adjudged that an account be taken before one of the official referees of all machines or apparatus for disinfection made in infringement of the said Letters Patent which have been manufactured, or sold, or let for hire, by or by the order or for the use or profit of the defendants, and also of the gains and profits made by the defendants by reason of such manufacture, sale, or letting for hire: And that the defendants do within seven days after the service upon them of the Official Referee's report of the result of such account, pay to the plaintiff the amount of such gains and profits: And the defendants, by their counsel, undertaking to bring into the said account all such machines or apparatus for disinfection as aforesaid as are now in their possession, custody, or power, whether completed or in process of manufacture, and to give notice of appeal and enter the same within three days from the service of this judgment upon them:

It is ordered that the Injunction, so far as relates to the machines or apparatus comprised in the said undertaking, be suspended until the said appeal has been heard and determined.

And it is also further adjudged that the defendants do pay to the plaintiff the costs of this action, such costs to be taxed. (*a*)

No. 66.

Order for an Inquiry as to Infringing Articles and their Destruction.

[*Insert Heading in Action.*]

Upon moving, etc., etc., Let an inquiry be made whether the defendants, or any of them, have in their possession or power any, and what articles manufactured in violation of the plaintiff's patent, and let all articles which shall be certified to have been so manufactured, and to be in the possession of the defendants, or any of them, be destroyed in the presence of C., the plaintiff's manager, and K., the

(*a*) *Lyon* v. *Goddard.*

Forms. defendants' manager, and the respective solicitors of the plaintiffs and defendants. (*a*)

No. 67.

Certificate that the Validity of Letters Patent has been in Issue.

[*Insert Heading in Action.*]

I hereby certify, pursuant to Section 31 of the Patents, Designs, and Trade Marks Act, 1883 (46 & 47 Vict. c. 57), that the validity of Letters Patent, No. of , in the plaintiff's Statement of Claim mentioned, came in question upon the trial of this action.

Dated day of

(Signed)

No. 68.

Certificate as to Particulars.

It is certified that the plaintiff [or defendant] has proved to the satisfaction of the Court the breaches [or objections] mentioned in the Particulars of Breaches [or Objections] delivered by him, and numbered respectively , and that the Particulars numbered were, under the circumstances of the case, reasonable and proper.

D.—APPEAL TO THE COURT OF APPEAL.

No. 69.

Notice of Appeal

By Plaintiffs from Order dismissing Action.—C.D.

In Her Majesty's Court of Appeal. 1896 P. No.

On Appeal from the Chancery Division of the High Court of Justice.

Between The P. T. Company, Limited, and the D. P. Company, Limited, ... Plaintiffs. (*b*)

and

The T. P. T. & C. H. Limited, J. D. B., H. H., jun., & C. H. & Company, Limited. . . Defendants. (*c*)

(*a*) *Betts* v. *De Vitre*: see Seton, 566.

(*b*) Or Appellants.

(*c*) Or Respondents.

Notice of Appeal. Forms.

Take Notice, that this Hon. Court will be moved by counsel for the above named plaintiffs on the day of , or so soon thereafter as counsel can be heard, for an order setting aside or reversing the judgment of Mr. Justice , delivered in this action on the of , whereby he directed that this action should be dismissed with costs:

And for an order to restrain the defendants from infringing the plaintiffs' Letters Patent of 1890, and giving such other relief as is prayed for in respect of the said Letters Patent in the Statement of Claim:

Or that such other order may be made as this Hon. Court shall deem fit.

Dated, etc.

(Signed)
Solicitors for the Plaintiffs, the Appellants.

No. 70.

Notice of Appeal.

By the Defendant.—Q.B.D.

[*Insert Heading.*]

Take Notice, that this Hon. Court will be moved by counsel on behalf of the defendant, on the day of , at 10.30 of the clock, or so soon thereafter as counsel can be heard, that the judgment of Mr. Justice , dated the day of , may be reversed, and that judgment may be entered for the defendant with costs, together with the defendant's costs of this appeal, or that such other order may be made as to the Court of Appeal shall seem just.

Dated this day of

(Signed)

No. 71.

Another Form of Notice of Appeal.

[*Insert Heading.*]

Take Notice, that this Hon. Court will be moved, on Monday, the day of , or so soon thereafter as counsel can be heard, on the part of the appellants, that the whole of the judgment delivered in this action on the day of , by Mr. Justice , may be reversed, and it may be ordered that judgment be entered for the appellants, that the said action be

Forms.

dismissed with costs, and that such other relief may be granted as to this Hon. Court may seem fit.

Dated the day of

(Signed)

Appellant's Solicitors.

To the Respondent and , his Solicitors.

No. 72.

Order of the Court of Appeal

Affirming Judgment below.

[*Insert Heading.*]

Upon Motion by way of Appeal this day made into this Court by counsel for the above-named plaintiffs from the judgment of Mr. Justice , dated the day of , and for an Order to restrain the defendants from infringing the plaintiffs' Letters Patent of A.D. , and giving such other relief as is prayed for in respect of the said Letters Patent in the Statement of Claim, and upon hearing counsel for the defendants, and upon reading the said judgment, dated :

This Court doth order that the said judgment, dated , be affirmed.

And it is ordered that the plaintiffs, the P. T., etc., etc., do pay to the defendants, the T. P., etc., etc., their costs occasioned by this Appeal, such costs to be taxed by the Taxing-Master, Mr. of the firm of , the solicitors for the defendants, personally undertaking, in the event of this Order being revised on Appeal, to abide by any Order which the House of Lords may make as to the defendants refunding to the plaintiffs the costs by this Order directed to be paid to them by the plaintiffs, and having signed the registrar's book accordingly. (*a*)

No. 73.

Order of the Court of Appeal.

Another Form.

[*Insert Heading.*]

Upon hearing Mr. , Q.C., of counsel for the defendant, and Mr. , Q.C., of counsel for the plaintiffs, on the defendants' Notice of Appeal, dated the day of , from the judgment of the Hon. Mr. Justice , dated the day of :

(*a*) *Pneumatic Tyre Co.* v. *Tubeless Tyre, Ltd.*

It is ordered that the defendant's appeal herein be dismissed with costs to be taxed and paid by the said defendant to the said plaintiffs or their solicitors. (*a*)

Forms.

No. 74.

Order of the Court of Appeal

Granting a Stay of the Injunction Pending Further Appeal.

[*Insert Heading.*]

Upon hearing Mr. , Q.C., of counsel for the defendants, and Mr. , Q.C., of counsel for the plaintiffs, upon the defendants' notice of Appeal, dated , from the judgment of the Hon. Mr. Justice , dated , at the trial without a jury at :

It is ordered that the Appeal of the defendants herein be dismissed with costs to be taxed and paid by the said defendants to the said plaintiffs or their solicitors.

And it is further ordered that upon the defendants paying to the plaintiffs' solicitors the taxed costs herein, upon such solicitors undertaking to return the same should an Appeal be successful, and also by their counsel undertaking to keep an account (from the date of the judgment herein) of all gains and profits made by the defendants by the manufacture, sale, and supply or advertising of the machinery and apparatus the subject of this action by the defendants or by any person or persons by the order or for the use of such defendants, and to pay the amount of such gains and profits to the said plaintiff as damages, the injunction granted to the plaintiffs to be stayed for three weeks, and if within that time an appeal be brought to the House of Lords, then such injunction be stayed until the hearing of such appeal. (*b*)

E.—APPEAL TO THE HOUSE OF LORDS.

No. 75.

Notice of Appeal. (*c*)

In the House of Lords.

From her Majesty's Court of Appeal (England).

Between A. R. . . . . Appellant,

and

J. A. T. and A. L. T. . . . Respondents.

We hereby give you notice that on the day of , or so soon after as conveniently may be, the Petition of Appeal by the above

(*a*) *Thierry* v. *Riekmann.*
(*b*) *Morris* v. *Young.*
(*c*) *Thierry* v. *Riekmann.*

Forms.

named appellant A. R., a correct copy whereof is served herewith (being a Petition of Appeal against the Order dated of the Court of Appeal (England) made in an action wherein the respondents J. A. T. and A. L. T. were plaintiffs and the appellant A. R. was defendant), will be presented to the House of Lords on behalf of the appellant

To the respondents and and their solicitors.

Dated

(Signed)
Appellant's Solicitor.

No. 76.

Petition of Appeal. (*a*)

In the House of Lords.

On Appeal

From her Majesty's Court of Appeal (England).

To the Right Honourable the House of Lords.

The humble Petition and Appeal of A. R. of in the City of London.

Your petitioner humbly prays that the matter of the Order set forth in the schedule hereto may be reviewed before her Majesty the Queen in her Court of Parliament, and that the said Order may be revised, varied, or altered: Or that the petitioner may have such other relief in the premises as to her Majesty the Queen in her Court of Parliament may seem meet, and that J. A. T. and A. L. T. mentioned in the schedule to the Appeal may be ordered to lodge such printed case as they may be advised and the circumstances of the case may require in answer to this Appeal: And that service of such Order on the solicitors in the cause of the said respondents may be deemed good service.

(Signed).

Schedule referred to in the Foregoing Petition.

From her Majesty's Court of Appeal (England).

In a cause wherein J. A. T. and A. L. T. were plaintiffs and A. R. was defendant.

The Order of the Court of Appeal (England), dated the day of appealed from is in the words following, that is to say:—

In the Court of Appeal,
On Appeal.
From the High Court of Justice,
Queen's Bench Division.

Stamp £1.

(*a*) *Thierry* v. *Rielmann.*

Monday the 9th day of December, 1895.

1894 *T. No.*

J. A. T. and A. L. T. . . . . *Plaintiffs,*

v.

A. R. . . . . . *Defendant.*

Upon hearing Mr. , *Q.C., of counsel for the defendant, and Mr.* , *Q.C., of counsel for the plaintiffs, on the defendant's notice of Appeal dated the day of July*, 1895, *from the judgment of the Hon. Mr. Justice Charles, dated the day of July*, 1895:

It is ordered that the defendant's Appeal herein be dismissed, with costs to be taxed and paid by the said defendant to the said plaintiffs or their solicitors.

By the Court.

We humbly conceive this to be a proper case to be heard before your Lordships by way of Appeal.

(Signed).

F.—ACTION AGAINST A PATENTEE FOR THREATS.

No. 77.

Statement of Claim.

In the High Court of Justice, 1894, M. No.

Chancery Division.

Mr. Justice

Between M. A. & Company, Limited . . Plaintiffs,

and

The H. R. F. Company, Limited . Defendants.

Statement of Claim.

1. The plaintiff company carry on business as mechanical engineers at works , in the county of Nottingham. Since the year they have erected furnaces for burning the refuse of towns under Letters Patent No. of , granted to A. F., of which the plaintiff company are owners.

2. The defendants are mechanical engineers carrying on business as a limited company at , in the city of , in the county of Yorkshire.

3. The said defendants have, in the month of , and subsequently to the issue of the writ in this action, written threatening letters both to the plaintiffs and their customers, threatening them with legal proceedings for an alleged infringement of certain Letters Patent, No. of , granted to W. H.

Forms.

4. The said defendants, although making such threats, have not commenced an action for infringement of their above-mentioned Letters Patent.

5. The invention claimed in the said Letters Patent, No. of , is not good subject-matter for valid Letters Patent, and was not at the date of the said Letters Patent a novel invention.

6. The Plaintiff Company have not infringed the said Letters Patent, No. of .

7. The plaintiffs have suffered loss in their business by reason of the said threatening letters.

The plaintiffs claim :—

1. An injunction restraining the defendants, their officers, servants, and agents, from threatening the plaintiffs and their customers with legal proceedings for the alleged infringement by them of the defendants' Letters Patent, No. , of , granted to W. H. for "a new and improved construction of furnace for burning towns' and other refuse," and from, by letters, advertisements, or any other means whatever, circulating statements to the effect that "Destructor" or other furnaces erected by the plaintiffs, are constructed in infringement of the defendants' said Letters Patent.

2. Damages.

3. Costs.

(Signed)

Delivered, etc.

No. 78.

Another Form of Statement of Claim

In an Action for Threats.

In the High Court of Justice, 1886 to No.
Chancery Division.
Mr. Justice .
Writ issued the day of
Between T. F. W. and L. J. M.
(trading as J. W. W.) . . . Plaintiffs,
and
S. C. . . . . Defendant.

Statement of Claim.

Delivered, etc.

1. The plaintiffs and the defendant are respectively manufacturers of and dealers in lamps and similar articles, and there has existed, and still exists, a competition in trade between them.

2. The defendant claims to be the patentee of a certain alleged invention of improvements in candle-lamps and chandeliers, for which he has obtained Letters Patent, dated the day of , 1885,

and numbered . The said alleged invention was, and is in fact not an invention at all, and comprises no manner of manufacture which was new at the date of such Letters Patent. The said Letters Patent are in fact, and to the knowledge of the defendant, void for want of novelty and otherwise, and the same were applied for and obtained by the defendant, not for the protection of any invention, but for the purpose of enabling him by such threats as hereafter mentioned, to injure the trade of the plaintiffs and other competing manufacturers of, and dealers in such articles as aforesaid, for the defendant's own advantage.

3. The plaintiffs, before and at the time of the acts of the defendant herein complained of, had at considerable trouble and expense established a trade in a description of candle-lamps known as "Glow-worm" lamps, and known by that time to be of the plaintiffs' manufacture. The said lamps had become known in the trade, and had acquired a good reputation, and the said trade was of value to the plaintiffs. The said Glow-worm lamps did not involve any manner of manufacture which was in any respect an infringement of any legal rights of the defendant, or of the said Letters Patent, as described in the specification thereof.

4. In the course of their said business the plaintiffs have supplied their Glow-worm lamps to H. G. S., who carries on business in M. as a glass and earthenware dealer. On or about the , 1886, the defendant wrote and sent to the said H. G. S. a letter, which so far as material is in the words and figures following:—

"Mr. S. 1886,

"Dear Sir,

"Caution.—Walsh's Glow-worm lamps are an infringement
"of my patent, and agents are now going through the
"country to get all the evidence they can to take
"legal proceedings against the vendors, that being the
"course decided upon by my solicitors, Messrs. .

"Yours truly,
"S. C."

5. The defendant by circulars, advertisements, or otherwise, has threatened, and intends unless restrained by the Order of the Court, to continue to threaten, the plaintiffs and their customers with legal proceedings or liability in respect of the alleged infringement of his patent rights by the said Glow-worm lamps, manufactured and sold by the plaintiffs. The plaintiffs have requested the defendant to commence proceedings against them for the alleged infringement, but he has not done so, and refuses or neglects so to do.

6. The said threats of the defendant to the said H. G. S. and otherwise, have caused considerable damage to the plaintiffs in their said business, and the continuance of such threats will, unless restrained by the Order of the Court, cause the plaintiffs very great and irreparable loss and damage in their said business.

The plaintiffs' claim:—

1. An injunction to restrain the defendant, his servants and agents, from threatening any person or persons, by circulars, advertisements, or otherwise, with legal proceedings or liability in respect of

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manufacture, sale, use, or purchase of the lamps made or sold by the plaintiffs, and known as Glow-worm lamps, on the allegation that such manufacture, use, sale, or purchase is an infringement of any Letters Patent belonging to the defendant.

2. Damages.

(Signed)

G.—ASSIGNMENTS AND LICENSES.

No. 79.

Form of Assignment of Letters Patent.

This Indenture, made the day of , 1898, **Between** of of the one part, and Company of the other part, **Whereas** by an agreement made day of expressed to be made between the said of the one part, and the said Company of the other part, it was agreed that the said should sell to the Company, and the Company agree to purchase the Letters Patent hereinafter mentioned in the schedule hereto, and the rights and privileges thereby granted, and the invention which is the subject of the said Letters Patent, for the sum of £ , to be satisfied by the issue to the said of shares in the said Company of £ each: And the Company agreed that they would, on the assignment of the said Letters Patent, or within days thereafter, allot to the said , or his nominees, shares of £ each in the said Company, which shares should be deemed for all purposes to be fully paid up, and the said agreement now in recital has been filed with the Registrar of Joint Stock Companies: **And Whereas** the said shares have been duly issued and allotted to the said as fully paid shares, and the same are declared by the parties hereto to be of par value: **Now this Indenture Witnesseth** that in consideration of the issue and allotment of the said shares to the said , he, the said , **Doth hereby Assign** unto the said Company, and their successors and assigns, all the Letters Patent mentioned in the schedule hereunder written, and the invention which is the subject thereof, and all the exclusive rights and privileges thereby granted and secured or expressed, or intended so to be, and the full benefit thereof, and all profits, emoluments, and advantages which can be in any wise had, made, gotten, or received from, or in respect of, the same, or from, or in respect of, the making, using, exercising, and vending under the said Letters Patent of the invention which is the subject thereof, including the right of obtaining whatever prolongation or extension can or may be obtained of the term of the said Letters Patent: **To have, hold, use, exercise, and enjoy** the said Letters Patent, and all and singular other the premises hereinbefore assigned or expressed, or intended so to be, unto the said Company, their successors and

assigns, henceforth absolutely: **And** the said **Doth hereby,** for himself, his heirs, executors, and administrators, **covenant** with the said Company, their successors and assigns, in manner following, that is to say—

That notwithstanding anything by the said , made, done, executed, or omitted, or knowingly suffered since obtaining the grant of the said Letters Patent, the said now has power to assign the premises hereby expressed to be assigned unto the said Company, their successors and assigns, in manner aforesaid: **And that** the said premises shall henceforth be held, used, exercised, and enjoyed by the said Company, their successors and assigns, without any interruption or disturbance by the said , or any person or persons *lawfully or equitably claiming* through or in trust for him: **And that** he, the said , and every person now or hereafter lawfully claiming by, from, or under him, any right, title, or interest to, or in the said Letters Patent, will and shall at all times hereafter, at the request and cost of the said Company, their successors or assigns, make, do, execute, concur in, and give effect to all such further and other acts, deeds, assurances, matters, and things whatsoever as may be requisite or expedient for the more effectually or satisfactorily assigning, assuring, confirming, and securing the said Letters Patent, invention, privileges, and premises expressed to be hereby assigned, and the full, sole, and exclusive benefit and enjoyment thereof unto the said Company, their successors and assigns, as by the said Company, their successors or assigns, shall be reasonably required.

In witness, etc.

The Schedule *to which the foregoing Indenture refers.*

Letters Patent for the United Kingdom of Great Britain and Ireland and Isle of Man, bearing date , and numbered , granting unto the said , his executors, administrators, and assigns, the exclusive privilege of making, using, exercising, and vending his invention of "Improvements in, etc.," within the said United Kingdom and the Isle of Man, during the term of fourteen years from the day of the date of the said Letters Patent.

No. 80.

Form of License

By a Limited Company to use two Patented Inventions.

This Indenture, made the day of , **Between The P. T. Company** and **B. C. Agency, Limited,** whose registered office is at in the City of (hereinafter called the Licensors), of the one part, and **G. H. S. R. E. & E. E.,** trading as **R. E. & Company,** of (hereinafter called the licensees), of the other part.

Whereas the licensors are the owners of the invention and British Letters Patent No. of and No. of granted to J. B. D. for improvements in tyres of wheels for bicycles, tricycles, and other light vehicles, **And Whereas** the licensors have agreed to grant the

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licensees a license to make, use, exercise, and vend tyres in accordance with the said Letters Patent respectively, upon the terms hereinafter appearing, **Now this Indenture Witnesseth** that in pursuance of the said agreement, and in consideration of the Royalties hereinafter reserved, and the covenants on the part of the licensees hereinafter contained, the licensors **Do hereby** grant unto the licensees full liberty, license, power, and authority under the above recited Letters Patent, or either of them, to make, use, exercise, and vend tyres for the wheels of cycles and other vehicles made in accordance with the specification of the said Letters Patent, or either of them; **to have**, hold, exercise, and enjoy the said license unto and by the licensees in the United Kingdom for and during all the residues now to come and unexpired of the terms for which the said Letters Patent were granted respectively, and during any further term for which the said Letters Patent were granted respectively, and during any further term for which the said Letters Patent, or either of them, may be prolonged, yielding and paying unto the licensors quarterly, on every day of January, day of April, day of July, and of October for every tyre sold by the licensees hereunder in the quarter then ending respectively, the Royalty of the first of such payments to be made on the day of January next:

And also that they will during the said term keep at their place of business all proper books of account, and make true and complete entries therein at the earliest opportunities, of all particulars necessary or convenient for the purpose hereof, of all transactions relating to the sale of tyres manufactured by them hereunder, and will, at their own expense, obtain and give to them all such information as to any item or matter contained, or which ought to be contained therein, as shall be reasonably required, and also that they will at the end of each quarter aforesaid deliver or send to the licensors or their assigns a statement in writing of the sale in such quarter of the said tyres and the amount of royalties payable in respect thereof as aforesaid, and will, if required by the licensors, verify the same by a statutory declaration of a chartered accountant: **And also** that they will not during the continuance of this license dispute or object to the validity of the said Letters Patent, or either of them, or the novelty or utility of the inventions.

In Witness whereof the licensors have caused their common seal to be hereto affixed, and the licensees have hereto set their hands and seals the day and year first above written.

No. 81.

Another Form of License.

This Indenture, made the day of Between & Company, Limited (hereinafter referred to as the Company), of the one part, and & (hereinafter referred to as the licensees) of the other part, **Witnesseth** that in consideration of the payments, covenants, and agreements by and on the part of the licensees hereinafter contained and reserved, they, the Company, **do hereby grant** unto the licensees

license to make, use, and exercise: First, an invention for improvements in breech-loading small arms dated and numbered ; secondly, an invention for improvements in breech-loading small arms dated and numbered ; thirdly, an invention for improvements in the extracting or ejector mechanism of drop-down small arms dated and numbered (but to the extent only and in manner hereinafter set forth), and to sell and dispose of sporting guns, rifles, and breech actions containing the said inventions, **to hold** the same, with all benefits and advantages from the exercise thereof unto the licensee henceforth for the respective residues now unexpired of the term of years granted by the Letters Patent for the said inventions, if the licensees or the survivor shall so long live, subject, nevertheless, to the covenants, stipulations, restrictions, and conditions hereinafter contained, and on the part of the licensees to be observed and performed: **And it is hereby mutually covenanted and agreed** between and by the Company and the licensees as follows:—

1. The Company shall make for the licensees all the ejector mechanism in connection with the said respective Letters Patent and which is used in the fore ends of guns, in such quantities and at such times as the licensees shall require, and the licensees shall and will pay to the Company, their successors or assigns, for each and every ejector mechanism so made by them as aforesaid the sum of £ , which sum shall include all royalty to be paid by the licensees under this license or in respect thereof. Such sums shall be paid on in every year during the continuance of this license, the first payment to be made on the day of next.

2. The licensees shall and will at all times during the continuance of this license keep or cause to be kept at his or their principal place of business accurate and regular accounts of all sporting guns, rifles, or breech actions containing the said inventions and of the sales thereof, such accounts to be made up on March 31st, June 30th, September 30th, and December 31st in every year, the first of such accounts being made up on the day of next, and such accounts shall be rendered to the Company, their successors or assigns, by the licensee within seven days after each successive respective days, and if necessary shall be verified by a statutory declaration to be made by the licensee (or one of them) at his (or their) own expense.

3. When the breach actions the subject of the said inventions shall have been completely fitted to the barrels of the guns or rifles they shall be sent by the licensee to the Company, their successors or assigns, at their principal place of business for the time being, for the purpose of being viewed and marked by the Company, their successors and assigns, in such manner and form as they may desire, the Company, their successors and assigns, hereby reserving to themselves the right of condemning any breech actions that may appear to them to be unsatisfactory.

4. The licensees shall not use or exercise the said invention otherwise than in accordance with this license.

5. The licensees shall not sell or allow to be sold any sporting gun, rifle, or breech action containing the said inventions without the same being previously marked by the Company, their successors or assigns, upon the body of the breech action.

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6. The licensees shall not assign or transfer this license or grant any sub-license to any person or persons, company or companies whomsoever, but this license shall immediately upon the death of the survivors of the then licensee become and be absolutely void unless previously determined by effluxion of time or under the powers hereinafter contained, but without prejudice to any right of action or remedy of the Company, their successors or assigns, for the recovery of any moneys then due to them hereunder, or in respect of any antecedent breach of any of the covenants or agreements of the licensees hereinbefore contained.

7. In any case if the sums hereby made payable, or any part thereof, shall at any time be in arrear and unpaid for fourteen days after the same shall have become due (whether any legal or formal demand for the same shall have been made or not), or if the licensees, or either of them, shall become bankrupt, or enter into any arrangement or composition with his or their creditors, or shall commit any offence falling within Section 4 of the Bankruptcy Act, 1883, or any statutory modification or re-enactment thereof, or shall make default in performing or observing any of the covenants, agreements, or conditions hereinbefore contained, and on his or their part to be performed or observed, then, and in any such cases, it shall be lawful for the Company, their successors or assigns, by notice in writing given to the licensees, or one of them, or left for them or him at their or his usual or last known place of abode or business, to revoke this license, which shall thereupon become void, but without prejudice to any right of action or remedy of the Company, their successors or assigns, for the recovery of any moneys due to them hereunder, or in respect of any antecedent breach of any of the covenants or agreements of the licensees hereinbefore contained.

In Witness whereof the Company have to one part hereof affixed their common seal, and the licensees have to another part hereof set their hands and seals the year and day first above written.

Signed, sealed, and delivered, etc.

No. 82.

Another Form of License.

This **Indenture**, made the day of , **Between** of (hereinafter called the patentee), of the one part, and the Company, Limited, whose registered office is at (hereinafter called the Company), of the other part: **Whereas** the patentee is the grantee named in the Letters Patent for the United Kingdom, dated , numbered , for "Improvements in, etc.": **And whereas**, in consideration of the covenants and arrangements made and entered into between the parties hereto by an Indenture bearing even date herewith, the patentee has agreed to grant to the Company the sole and exclusive license to use the invention the subject of the said Letters Patent for all the residue of the term thereby granted, or any extension thereof, but subject as hereinafter mentioned: **Now this Indenture witnesseth** that in pursuance of the said

agreement, and in consideration of the covenants and agreements on the part of the Company contained in the said Indenture of even date herewith, the patentee **doth hereby grant** unto the Company, their successors and permitted assigns, the full, sole, and exclusive liberty, right, license, power, and authority to make, use, and exercise the invention the subject of the said Letters Patent, and to sell and dispose of all manufactured under, or in accordance with, the said invention within the United Kingdom of Great Britain and Ireland and the Isle of Man: **To have, hold,** exercise, and enjoy the said premises unto and by the Company, their successors and permitted assigns, for and during the residue now to come and unexpired of the term of fourteen years granted by the said Letters Patent, or any renewal or extension thereof, but subject to the covenants, conditions, and agreements contained in the said Indenture of even date herewith: **And the Patentee hereby covenants** with the Company that notwithstanding anything by the patentee done, omitted, or knowingly suffered, the patentee now has power to grant a license to use the said Letters Patent in manner aforesaid, and that the same shall be held, used, and enjoyed by the Company, without any interruption or disturbance, free from incumbrances: And that the patentee and every person claiming under, or in trust for him, will at all times, at the cost of the Company, execute and do all such assurances and acts for confirming the license hereby granted as by the Company may be reasonably required: **And the Company hereby covenants** with the Patentee that the Company and its successors will not assign or otherwise part with the benefit of the license hereby granted, without the covenant in writing of the patentee first had and obtained, but such consent shall not be withheld in the case of a responsible and respectable assignee.

In Witness whereof said hath hereunto set his hand and seal, and the Company has caused its common seal to be hereunto affixed the day and year first above written.

No. 83.

Agreement of Terms

To which the Preceding License refers.

This **Indenture,** made the day of , **Between** of (hereinafter called the patentee) of the one part, and the Company, Limited (hereinafter called the Company), of the other part: **Whereas** the patentee is the grantee named in the Letters Patent for the United Kingdom and the Isle of Man, dated , numbered , for "Improvements in, etc.": **And whereas** by an Indenture bearing even date with these presents, and made between the same parties, the patentee has granted to the Company the full, sole, and exclusive license to make, use, and exercise the invention the subject of the said Letters Patent, and to sell and dispose of all manufactured under or in accordance with the said invention within the United Kingdom of Great Britain and Ireland and the Isle of Man, but subject to the covenants, conditions, and agreements

Forms.

contained in an Indenture of even date herewith, meaning these presents: **Now this Indenture witnesseth** that it is hereby covenanted and agreed by the parties hereto as follows:—

Royalties.

1. The Company shall pay to the patentee, his executors, administrators, and assigns, during the residue now to come and unexpired of the term of fourteen years by the said Letters Patent granted, and during the continuance of any renewal or extension of such term, a royalty equal to per cent. of the gross proceeds of sale received by the Company for or in respect of each and every manufactured by the Company under or in accordance with the said Letters Patent.

2. The Company hereby covenants and guarantees that the net amount payable to the patentee, his executors, administrators, or assigns, for royalties hereunder shall be not less than £ for the period ending on the 30th day of September, 1900, which sum shall be payable on the execution of these presents; £ for the second year, payable on the 30th day of September, 1901; £ for the third year, payable on the 30th day of September, 1902; £ for the fourth year, payable on the 30th day of September, 1903, and £ for the fifth and each and every subsequent year, payable on the 30th day of September, 1904; and on the same day in each and every subsequent year of the term of fourteen years granted by the said Letters Patent, and any extension or renewal of such term.

3. The Company shall keep full, true, and accurate accounts, shewing the number of manufactured or sold by it, together with the capacity of each such , and the names and addresses of the persons to whom all such shall be sold, which accounts shall, at all reasonable times, be open to the inspection of the patentee, or any person authorized by him. The Company shall, on or before the expiration of one month from the 31st day of March and the 30th day of September in each year, furnish to the patentee a statement shewing the total number of manufactured or sold by the Company during the half year ending on the said dates respectively in each year, and the total invoice prices thereof, and the gross proceeds of sale received by the Company, and shall with each such account remit to the patentee the amount of royalty thereby shewn to be due to him. The Company shall, if so requested by the patentee, verify the accuracy of each such statement by a statutory declaration, to be made by the chairman and secretary, for the time being, of the Company.

4. If in any year the amount of royalty paid under the last preceding clause hereof shall not amount to the said minimum royalty, such deficiency shall be paid to the patentee yearly, within one month after the 30th day of September in each year, the first payment under this clause to be made within one month after the 30th day of September, 1901.

5. If at any time during the continuance of the said licence the said Letters Patent shall be declared to be invalid by a Court of competent jurisdiction, all royalties hereunder shall cease to be payable: Provided always, that if such decision shall be reversed on

appeal, or if the said Letters Patent shall be rendered valid by a sufficient amendment or disclaimer, all royalties hereunder shall forthwith again become payable, and the Company shall also forthwith pay to the patentee all sums due for royalties hereunder, as if this clause had not been inserted in these presents.

Patent Fees.

6. The Company shall pay all future patent fees, and do and perform all such other acts, deeds, matters, and things as may be necessary for keeping the said Letters Patent on foot and in full force and effect, and shall be at liberty to deduct such fees from the amount of royalty payable to the patentee hereunder; and if at any time the said Letters Patent shall be openly infringed by any other person or persons whomsoever, the Company may take all such steps as may be necessary or convenient to fully and effectually restrain such infringement: And the patentee shall, at the request of the Company, and upon receiving a full and sufficient guarantee and indemnity to his satisfaction, authorize such proceedings to be brought in his name, but the conduct thereof shall remain in the hands of, and under the sole control of, the Company.

Trade Regulations and Prices.

7. The Company shall use its best endeavours, and take all such steps as may be necessary to extend and push the sale of manufactured under, or in accordance with, the said Letters Patent, and shall in all things obtain the best prices payable for all so sold by it.

8. The Company shall not let at a rental any manufactured under or in accordance with the said Letters Patent, or deal with or dispose of the same in any manner which may lessen the amount of royalty due to the patentee, as provided by these presents, or which may prejudicially affect his rights and interests hereunder, without the consent of the patentee,

9. The Company shall not, save as hereinafter provided by Clauses 11 and 12 hereof, during the term of fourteen years granted by the said Letters Patent, manufacture, sell, license, or otherwise deal or be interested in any other kind of which may be similar to made under or in accordance with the said Letters Patent, but shall in all things protect the rights and interests of the patentee hereunder in all respects.

10. The Company shall not sell, or supply, or license any made under or in accordance with the said Letters Patent for use outside the United Kingdom of Great Britain and Ireland and the Isle of Man and the British Colonies, nor shall the Company knowingly sell, supply, or license any such to any person, firm, or company within the limits aforesaid for export therefrom, and the Company shall take all reasonable steps and use its best endeavours to prevent the export of any manufactured by it to any foreign country or state.

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11. If at any time or times hereafter during the continuance of the license granted by the hereinbefore-mentioned Indenture of even date herewith, the patentee shall invent, discover, or make any improvement or improvements in the said invention or the mode of working or using the same, or which may be applied to the said manufacture, or should become the owner of any such improvement or improvements (whether patented or not), then and in every such case he shall forthwith communicate such improvement or improvements to the Company, and give it full and sufficient information, instruction, and assistance respectively in the mode of working and using the same, and, so far as practicable, render the same available, at the expense of the Company, for its benefit, within the limits aforesaid, and the Company shall be entitled to use and exercise the same without paying any further or other royalty, premium, or compensation to the patentee in respect thereof.

12. If at any time or times hereafter during the continuance of the license granted by the hereinbefore-mentioned Indenture of even date herewith, the Company or its successors or assigns, or any person or persons in its employ, on its behalf shall invent, discover, or make any improvement or improvements (whether patented or not), then, and in every such case, the Company, its successors or assigns, shall, so far as it lawfully may, forthwith communicate or cause to be communicated to the patentee such improvement or improvements and give to him full and sufficient information, instruction, and assistance respecting the mode of working and using the same, and, so far as practicable, render the same available at the expense of the patentee for his benefit within all parts and places outside the United Kingdom of Great Britain and Ireland, and the patentee shall be entitled to use and exercise the same without paying any royalty, premium, or compensation to the Company, its successors or assigns, or such person or persons as aforesaid in respect thereof.

Termination of License.

13. If at the expiration of any year it shall appear that the royalty calculated upon the machines sold during such year shall not equal the minimum royalty hereby reserved, either party hereto shall be at liberty to give to the other three months' notice in writing to terminate the said license of even date herewith upon sending the same to the other party by post addressed, in the case of the patentee to his usual place of residence, and in the case of the Company to its registered office in the United Kingdom, and at the expiration of the said period of three calendar months from the giving of such notice the said license shall be deemed to be cancelled.

In witness whereof the said hath hereunto set his hand and seal and the Company has caused its common seal to be hereunto affixed the day and year first above written.

H.—COMPULSORY LICENSES.

No. 84.

Petition for Compulsory License. (*a*)

To the Lords of the Committee of Privy Council for Trade.

The Petition of L. Limited of in the County of , Chemical Manufacturers, and of J. L., Managing Director of the said Company, being persons interested in the subject-matter of this Petition.

Sheweth as follows:—

A patent, dated the day of , 1889, and numbered , was granted to O. I. of London, Patent Agent, for an invention communicated to him by M. L. & B. of , in the German Empire, relating to the Production of Oxysulphonic Acids of Naphthalin. The said patent was by deed, dated the day of , 1892, duly assigned by the said O. I. to M. L. & B., hereinafter called the patentees. The assignment so made was duly registered at the Patent Office on the day of , 1892, and the patentees have been, from the date of the said registration, and still are, the duly registered patentees under the said grant. Another patent, dated the day of , 1889, and numbered , was also granted to the said O. I. for an invention in like manner communicated to him by the patentees, relating to Improvements in the Production of Amidonaphtholmonosulphonic Acids and the Manufacture of their Diazo Compounds and Azo Colouring Matters therefrom, which said patent was by deed, dated the day of , 1892, duly assigned by the said O. I. to the patentees. The assignment so made was duly registered at the Patent Office on the day of , 1892, and the patentees have been, from the date of the said registration, and still are, the duly registered patentees under the said grant. Both the said patents are now in force, having been duly maintained by due payment of all renewal fees accrued due in respect of the same.

2. The privileges granted to the said patentees by the said patents include, *inter alia*, the exclusive right to use within this realm the following processes of manufacture, that is to say:—

(*a*) The production of oxynaphthalin-sulphoric acids by heating the naphtholdi- and tri-sulphuric acids with caustic alkalies.

(*b*) The production of amidonaphthol-sulphonates by heating betanaphthylamine disulphonic acids with caustic alkalies, under or without pressure, to 200–280° C.

3. The patentees are manufacturing chemists, who carry on their manufacture at , in the German Empire aforesaid, and they there manufacture dye-stuffs by the processes above mentioned; but the patentees and the said O. I. have wholly failed to introduce the use of the said processes, or any of them, within the realm, and have not at any time attempted so to do. It is, on the contrary, the settled

(*a*) This is *Levinstein's Petition.* See Gordon's Compulsory Licenses, p. 352.

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commercial policy of the patentees to prevent the introduction and use of their patented processes within this realm. They import and sell the products of these manufactures at prices greatly in excess of the prices at which they sell the same products to their customers in other countries, and they make use of their privileges under the said patent grants for no other purpose than to exclude other manufacturers, and to raise the prices of the said commodities in the British market. Dye-stuffs manufactured in accordance with the said processes are in large demand within this realm for the treatment of Manchester and other goods, some of which are intended for export to markets in which foreign manufacturers compete with British manufacturers; and the preference granted by the patentees to their foreign customers is a great hindrance to British trade in such foreign markets. Thus, by reason of the default of the patentees, the grants of privilege so as aforesaid made to them, are mischievous and cause hurt of trade, and are prejudicial and inconvenient to her Majesty's subjects in general.

4. Your petitioners are manufacturing chemists, carrying on their manufacture upon a large scale at , Works, Manchester, in the County of Lancaster, and they have great facilities for the carrying on of the said patented processes, and for the production of dye-stuffs thereby. They have, by themselves, and by the predecessors of the petitioning company in business, been a long time engaged in the production of colouring matters, and have conducted numerous and costly experiments, as the result of which they have introduced from time to time many improvements in the manufacture of such dye-stuffs, in connection with which they carry on an extensive manufacture and trade. They have recently discovered a process by which valuable new dye-stuffs can be manufactured, which dye-stuffs are an improvement upon the dye-stuffs so as aforesaid manufactured by the patentees in Germany, and by them imported and sold within this realm. Other similar improved dye-stuffs have similarly been discovered by your petitioners, and they are still conducting experiments, from which they hope that further discoveries of the same kind will result. But the valuable new dye-stuffs referred to can only be manufactured by employing the patented processes above mentioned, and your petitioners, L. Limited, did, therefore, apply to the patentees for a license to manufacture under their said patents. The patentees have refused to entertain the said application for a license, and still refuse to grant such license as is necessary to enable your petitioners to introduce the patented manufactures into use within this realm, and to work and use to the best advantage the said inventions of which your petitioners are possessed.

5. Your petitioners are well able to introduce and carry on the said manufacture if duly licensed so to do, and they will undertake to introduce and carry on the same according to their ability, provided that a proper license is accorded to them. The terms upon which it is submitted that the patentees may justly be ordered to grant such license as is desired by your petitioners, L. Limited, and their successors and assigns, are set out in the schedule appended hereto.

Your Petitioners therefore pray that an order may be made by the Board of Trade under Section 22 of the Patents, Designs, and Trade Marks Acts of 1883, that the patentees shall grant to your petitioners, L. Limited, a license under the two patents

hereinbefore mentioned, upon the terms set out in the schedule, or upon such other terms as may be just, and

That the Petitioners may have such other relief in the premises as the Board of Trade may deem just.

(Signed) J. J.

(Sealed) L. Limited.

The Schedule

containing the heads of proposed agreement is here omitted.

No. 85.

Order of the Board of Trade

For a Compulsory License. (*a*)

In the Matter of the Patents, Designs, and Trade Marks Acts, 1883 to 1888; and

In the Matter of Letters Patent No. , of 1889, and of Letters Patent No. , of 1889; and

In the Matter of a Petition of L. Limited, of , Manchester, in the County of Lancaster, Chemical Manufacturers, and of J. L., Managing Director of the said Company (hereinafter called the Petitioners), to the Board of Trade for an Order for a Compulsory License under the said patents.

Whereas, by Section 22 of the Patents, Designs, and Trade Marks Act, 1883, it is enacted, "If on the petition of any person interested it is proved to the Board of Trade that by reason of the default of a patentee to grant licenses on reasonable terms—

"(*a*) The patent is not being worked in the United Kingdom; or

"(*b*) The reasonable requirements of the public with respect to the invention cannot be supplied; or

"(*c*) Any person is prevented from working or using to the best advantage an invention of which he is possessed,

"the Board may order the patentee to grant licenses on such terms as to the amount of royalties, security for payment, or otherwise, as the Board, having regard to the nature of the invention and the circumstances of the case, may deem just, and any such order may be enforced by mandamus."

And whereas, on the day of , 1889, a patent, numbered , was granted to O. I. of , London, Patent Agent, for an invention communicated to him by M. L. & B. of , in the German Empire (hereinafter called the patentees), relating to the Production of Oxysulphonic Acids of Naphthalin; And whereas, on the day of , 1892, the said patent was duly assigned by the said O. I. to the patentees, which said assignment was, on the day of , 1892, duly registered at the Patent Office; And whereas, on the day of , 1889, another patent, numbered , was also granted to the said O. I. for an invention, in like manner communicated to him by

(*a*) Made in *Levinstein's Petition*, see Gordon, p. 361.

Forms.

the patentees, relating to Improvements in the Production of Amido-napthol-monosulphonic Acids, and the Manufacture of their Diazo Compounds and Azo Colouring Matters therefrom; And whereas, on the day of , 1892, the said patent was duly assigned by the said O. I. to the patentees, which said assignment was, on the day of , 1892, duly registered at the Patent Office; And whereas, the petitioners presented a petition to the Board of Trade, under the said section, for an order that the patentees under the said Letters Patent, No. , of the day of , 1889, and No. , of the day of , 1889, should grant to the petitioners a license under or in respect of the inventions described and claimed in and by the specifications of the said respective Letters Patent; And whereas, on consideration of the said petition, and of the matters therein mentioned, it has been proved to the Board of Trade that the said petitioners are persons interested in the matter of the said petition, and that by reason of the default of the patentees to grant licenses on reasonable terms the said patents are not being worked in the United Kingdom, and that by reason of the default aforesaid the said petitioners are prevented from working and using to the best advantage certain inventions of which they are possessed: Now, therefore, the Board of Trade, in exercise of the power conferred upon them by Section 22 of the Patents, Designs, and Trade Marks Act, 1883, and of all other powers enabling them in this behalf, do hereby order as follows:—(1) That a license, to take effect from the date of this order, and in the form set forth in the schedule hereto, be forthwith granted by the patentees to the petitioners to make, use, exercise and vend within the United Kingdom the inventions described and claimed in and by the specifications of the said Letters Patent, Nos. and , of 1889, for the unexpired residues of the respective terms of the said Letters Patent, at a royalty of one halfpenny for each pound weight avoirdupois of products made by the licensees under the said Letters Patent or either of them, but so that in each year a minimum royalty of £250 per annum shall be paid by the licensees, and the patentees shall forthwith deposit such license, duly executed by them, with the Board of Trade. (2) The said petitioners, before the day of , 1898, shall execute and deposit with the Board of Trade a counterpart license in the form aforesaid, and in default of their doing so this order shall be of no effect.

Dated this 6th day of July, 1898.

(Signed) COURTENAY BOYLE,
Secretary, Board of Trade.

No. 86.

Compulsory License.

(Referred to in the above Order.) (*a*)

This Indenture, made the day of , between the and of in of (hereinafter called the patentees), of the one part, and of , in the County of (hereinafter called the licensees), of the other part; Whereas, by an Order of the Board

(*a*) See Gordon, p. 363.

of Trade, dated the 6th day of July, 1898, and made under Section 22 of the Patents, Designs, and Trade Marks Act, 1883, it was ordered that a license, to take effect from the date of the said Order, should be granted by the patentees to the licensees to make, use, exercise, and vend the inventions described in the Letters Patent hereinafter mentioned (to the benefit of which the patentees are entitled), in the form set out in the schedule to the said Order, being the form of these presents: Now, this Indenture witnesseth that, in pursuance of the said Order, the patentees do hereby grant to the licensees license within the United Kingdom to make, use, exercise, and vend the inventions described and claimed in and by the specifications of the Letters Patent Nos. and , of 1889, mentioned in the said Order, to hold, exercise, and enjoy the said license for and during all the residues now to come and unexpired of the respective terms of the said Letters Patent, and during any further term for which the said Letters Patent, or either of them, may be extended; and the licensees hereby covenant with the patentees that the licensees will, during the continuance of this license, pay to the patentees, half-yearly, on every 6th day of January and 6th day of July, royalties at the rate of a halfpenny for each pound weight avoirdupois of product made by the licensees under the said Letters Patent, or either of them, in the half-years then ending respectively; Provided always that if the royalties payable in any year ending on the 6th day of July shall not have amounted to the sum of £250, the licensees shall on such 6th day of July, pay to the patentees such further sum as with the said royalties shall amount to the said sum of £250, hereinafter called the yearly rent. The licensees do hereby also covenant with the patentees that the licensees will, during the continuance of the license, keep proper accounts in separate books containing full particulars of all products made by them under this license, and of all other things which may be material for the purpose of shewing the amounts payable to the patentees by way of royalty, and will at any time produce the same for the inspection of the patentees or any person appointed by them, who shall be at liberty to make copies from or extracts from any of the accounts or matters therein contained, and that the licensees will within ten days after each of the half-yearly days aforesaid deliver to the patentees an account in writing, shewing all the particulars and matters aforesaid with respect to the products made during the preceding half-year; And it is hereby agreed and declared that the patentees shall be at liberty at any time during the continuance of this license to enter upon any factory or place of business of the licensees in which the manufacture of the said products shall be carried on at any reasonable hour, with a view of obtaining all such information as may be material for the purpose of ascertaining the amount of royalty payable to them under this license; And it is hereby also agreed and declared, that if any payment of royalties or yearly rent under this license shall be in arrear for one month after the same shall have become due (whether payment thereof shall have been demanded by the patentees or not), or if the licensees shall make default in the performance of any obligation on their part herein contained, and shall not have made good the same within fourteen days after the patentees shall have by notice in writing required them to do so, then the patentees may, with the consent of the Board of Trade, by notice in writing to the licensees, revoke this license as from the date of such notice, without prejudice

Forms.

to the right of the patentees to recover any monies then due hereunder ; And it is hereby also agreed and declared that if the said Letters Patent, or either of them, shall become void, or shall be declared by a Court of Law to be void, the licensees may, with the consent of the Board of Trade, by notice in writing to the patentees revoke this license.

As witness, etc.

I.—SPECIFICATIONS OF INVENTIONS.

No. 87.

Provisional Specification

Of Mechanical Invention.

PROVISIONAL SPECIFICATION.

Improvements in Rubber Tyres and Metal Rims or Felloes of Wheels for Cycles and other Light Vehicles. (*a*)

I CHARLES KINGSTON WELCH of Fairmead Philip Lane Tottenham in the County of Middlesex Engineer, do hereby declare the nature of this invention to be as follows:—

My invention relates to improvements in the construction of rubber tyres and metal rims or felloes, and methods of securing the same one to the other for the wheels of cycles and other light vehicles.

The chief objects of my invention are easy running, reduction of vibration and security of the rubbers to the metal rims or felloes.

Hitherto the majority of rubber tyres used on cycle wheels have been round in section and of small diameter fitted in grooved rims or felloes which has not only rendered half of the rubber tyre of little or no use for reducing vibration but has also cut on the sharp edges of the rims or felloes thus destroying the tyre.

According to this invention the rubber tyres are soft and of larger form and are constructed to fit either wholly or partly outside the metal rims or felloes which may in some cases be of special shape as hereinafter described.

In constructing a light wheel for a cycle I may form the rim of a length of round or D-shaped weldless steel or other tube (say about $\frac{5}{8}$ inch diameter) or I may form a hollow rim or felloe having shoulders of more or less extent at the sides, or I may form rims of the ordinary crescent-shaped steel turned the reverse way or any other suitable form having a more or less rounding surface outwardly (in section) for the rubber tyre, into any of these the spokes may be suitably secured.

(*a*) The specifications of the Welch Tyre Patent are given here as examples of specifications of a mechanical invention, as they have been closely scrutinized in all the Courts, and, although drawn by the inventor himself, without the assistance of a patent agent, finally upheld by the House of Lords.

Forms.

The rubber tyres to fit the above described rims or felloes may be moulded (in section) saddle or arch shaped thickened in the crown thus forming a groove inside, into which is fitted the metal rim or felloe of the wheel. In order to secure the rubber tyre to the metal rim I may have two small holes through the rubber one on each side of the rim through each of which a suitable wire may be put and the ends may be connected with a nipple having a right and left hand thread, or I may put a thread on one end of the wires and a head on the other and connect it with a similar device, or I may use the well-known spring wire, the nipples may be of hexagon form or may be enlarged in any part in the form of a hexagon collar which may be turned by means of a suitable thin wrench pushed between the ends of the rubber or if the tyre is moulded in a complete ring, small apertures may be made for the purpose, thus the above described rubber tyres may be placed on either of the described metal rims or felloes one wire of which may be connected beforehand the ends of the other wire may then be connected after the tyre is in place and each drawn together with the wrench thus the rubber tyre would tighten on the rim or felloe and the sides would be slightly drawn in towards the centre of the wheel.

I may mould rubber tyres as above described in quite a different form (in section) from what they appear when on the rim or felloe, for instance the sides of the rubbers may nearly touch having in section somewhat the form of a closed horseshoe. In fitting a tyre thus moulded on to the metal rim it is obviously necessary to open the rubber which would not only hug the rim but also cause the outer surface of the rubber tyre which is subject to the most wear to be compressed laterally rendering it softer and more indestructible.

I may also make the rubber tyres larger in circumference and draw them into the rims or felloes by the wires, this would cause the surface of the rubber to be compressed generally making it still more indestructible and easy running. I may also line the inner and under portions of these rubbers with canvas or similar material either to give support to the wires or to prevent undue wear on the part or parts in contact with metal.

The outward form of these rubber tyres (in section) may be rounding or may be more or less flat as found in practice to be most advantageous in reducing vibration.

The inner surfaces or those in contact with the metal rim or felloe may be grooved or embossed for the purpose of either lightening the rubber, reducing vibration or for cementing to the rims, felloes or the like.

The above described improved rubber tyres are also applicable to cycle and other wheels in present use or made in the ordinary way in which case they may be fitted over the existing rubbers without necessarily making any alteration or I may substitute in place of the ordinary rubbers a lighter or cheaper material such as cork.

I may also fit this class of tyre to the ordinary rims by modifying the form of the inner surface of the rubbers in which case a hole through the centre may be an advantage for lightening the same.

In all cases these tyres may be cemented in addition to the wires described for either preventing the collection of dirt or dust or to help in keeping them in position.

Another method of securing the rubber tyres to the rims is to have thin pieces of metal such as brass stamped to fit the metal rims or

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felloes and vulcanized on the inner surfaces of the rubbers these can either be fastened to the metal rims or felloes by small screws or soft soldered to the same.

The above described rubber tyres being outside the metal rims or felloes are free to expand laterally thus giving a more elastic contact with the ground and therefore reducing vibration more effectually.

In applying these improvements to wheels other than cycles it may in some instances be necessary to vary the details of construction.

Dated this 15th day of September, 1890.

CHARLES KINGSTON WELCH.

No. 88.

Complete Specification

Of Mechanical Invention.

COMPLETE SPECIFICATION.

Improvements in Rubber Tyres and Metal Rims or Felloes of Wheels for Cycles and other Light Vehicles.

I CHARLES KINGSTON WELCH of Fairmead Philip Lane Tottenham in the County of Middlesex, Engineer, do hereby declare the nature of this invention and in what manner the same is to be performed, to be particularly described and ascertained in and by the following statement :—

My invention relates to improvements in the construction of rubber tyres and metal rims or felloes and methods of securing the same one to the other, for the wheels of cycles and other light vehicles.

The chief objects of my invention are to produce rubber tyres that will be easy running, reduce vibration and also be securely fastened to the metal rims or felloes.

The rubber or elastic tyres hereinafter described are in most cases saddle or arched (when on the rims) in section and are made to fit either wholly or partly outside the metal rims or felloes which may in some cases be of special form as hereinafter described, I also construct this form of tyre to fit over other elastic tyres or wheels at present in vogue or made in the ordinary way, either for protecting securing, or reducing vibration. In all cases the method of securing renders the rubber tyre easily attachable or detachable for repairs etc.

Referring to the accompanying sheet of drawings throughout the several figures similar parts are marked with like letters of reference. Fig. 1 is a transverse section of a saddle or arched shape rubber or elastic tyre as fitted to a round weldless steel tubular rim. Fig. 2. is a transverse section and part side elevation of a similar tyre as fitted to a D-shaped tubular rim in which the spokes may be suitably secured. Referring to both figures *a*. is the rim. *c*. the saddle or arched shape elastic tyre through which two longitudinal holes are formed one on each side of the rim, these are lined with a strong canvas or insertion and vulcanized within the rubber *c*. as shown at *d*. these linings may be separate one from the other as in Fig. 1 or I may fold a piece of

canvas on each side and either stitch or otherwise fasten it together and vulcanize the same within the rubber tyre as shown at *d.* in Fig. 2. **Forms.**

In order to secure the rubber or elastic tyres to the rims I insert two wires or cores *e. e.* (which may be of steel brass, bronze or other sufficiently inelastic material to answer the purpose) one on each side of the rim, the ends of the wires may be connected with a nipple *f.* having a right and left hand thread screwed thereon, or I may put a thread on one end of the wires a head on the other and connect it with a similar device as shown with reference to Fig. 21 or in any other suitable way. The nipples may be of hexagon form or may be enlarged at any part in the form of a hexagon collar as shown at *f.* Fig. 2 which may be turned by a thin wrench as shown in Fig. 3 pushed between the ends of the rubber when the tyre is made of a straight length or if moulded in a complete ring small apertures may be made for the purpose as shown at *g.* Fig. 2. Thus the above described rubber tyres may be placed on either of the described metal rims or felloes one wire of which may be connected beforehand the ends of the other wire may then be connected after the tyre is in place and each drawn together with a wrench, thus the rubber tyre would tighten on the rim or felloe and the sides would be drawn in towards the centre of the wheel securing the same thereto, the under or inner portion of the tyre Fig. 1. is shown lined with canvas to strengthen the same, cement may be used in addition to the wires for either preventing the collection of dirt or dust or to help in keeping them in position, when the tyres may be grooved, serrated or embossed as shown in Fig. 2.

Fig. 4 shows in section a tyre of similar construction to that described with reference to Fig. 2, but is round in outward form and is fitted to a different section of rim, the inner surface of the rubber is shown at *h.* deeply grooved for either lightening the same or for reducing vibration.

Fig. 5 shows in transverse section a saddle or arched shaped rubber as fitted to an inverted crescent steel rim or felloe. *a.* is the rim. *c.* is the rubber tyre. *d.* is the canvas for supporting the wires and is shown double or formed of a flattened canvas tube. *e. e.* are the wires or cores for securing the same which may be applied in the same manner as described with reference to Figs. 1 and 2.

Figs. 6 and 7 are transverse sections Fig. 8 a longitudinal section of saddle or arched shaped rubber tyres of different outward form, fitted to hollow rims formed with an outward rounding surface having shoulders formed thereon of more or less extent at the sides.

The under or inner surfaces of these tyres are deeply embossed for the purpose of reducing vibration or for lightening the rubber. Referring to the above three figures *a.* shows the form of the rims. *c.* the construction of the rubber tyres. *a.* the manner of inserting the canvas or insertion within the tyres. *e. e.* are the wires or cores for securing the same. In connecting or disconnecting the wires on this form of rim the tyres may be lifted and held from the rim by any convenient tool such as a screwdriver. By making this form of rim very shallow I may connect both the wires beforehand and force the rubber into its place on the rim.

The above described improved rubber tyres are also applicable to other elastic tyres or wheels at present in vogue either in their construction or for protecting, securing, or reducing vibration. Figs. 9 and 10 show saddle or arched shaped tyres constructed and secured in

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the same manner as those described with reference to Figs. 1, 2, 4 and 5 but fitted over ordinary round rubbers. *a.* Fig. 9 shows an ordinary $\frac{5}{8}$ in. hollow rim, *b.* an ordinary round rubber tyre. *c.* is the saddle or arched shaped elastic tyre. *d.* the canvas for supporting the wires *e. e.*, the under or inner surface of the tyre is grooved or serrated that it may the better grip the under rubber, or for the use of cement. Fig. 10 shows a rubber tyre having an embossed under surface similar and for the same purpose as those described with reference to Figs. 6, 7 and 8 fitted over an ordinary $\frac{3}{4}$ in. rubber tyre cemented in an ordinary rim as in Fig. 9.

I may mould tyres herein described in quite a different form in section from what they appear when on the rims, felloes or tyres for instance the sides of the rubbers may nearly touch, having in section somewhat the form of a closed horse-shoe as shown in Figs. 11 and 12. In fitting a tyre thus moulded and vulcanized on to the metal rims or tyres, it is obviously necessary to open the rubber which not only hugs the rim, tyre or felloe but also causes the outer surface of the rubber tyre which is subject to the most wear to be compressed laterally thus rendering it the more indestructible. I may also make the rubber tyres slightly larger in circumference and draw them on to the rims, tyres or felloes by the wires or cores thus causing the surface of the rubber tyres to be compressed generally making it still less liable to cut. In all cases I prefer to line these tyres with canvas or other suitable material.

Fig. 14 shows an ordinary cushion tyre protected and secured by my improved form of tyre or outer covering. *a.* is the rim. *b.* is an ordinary cushion tyre. *c.* is a saddle or arched shaped tyre made much thinner in the crown than those before described. *d.* is the canvas lining. *e.e.* are the securing wires, the method of applying is similar as in the designs hereinbefore described.

Fig. 15 shows a transverse section of a saddle or arched shape rubber or elastic tyre constructed according to my invention for covering, protecting and securing tyres of wheels which are inflated with air as described in Thomsons Patent No. 10990—1845, and are now in present use. *a.* is a wide metal rim constructed with a rounding surface outwardly in the form of a shallow concave groove on each side of which the shoulders *k. k.* are formed the spokes may be secured in the rim in the ordinary way, this rim may also be made in a tubular form. *b.* is an ordinary inflatible tyre similar to that described in Thomson Patent hereinbefore mentioned and also in present use. *c.* is a saddle or arched shaped tyre similar to those before described but made larger as shown in the drawings, *d. d.* is a strong canvas lining made from a width of canvas or other suitable material folded over and sewn or otherwise secured as before described so as to form a strong support for the wires or cores, in some cases it may be desirable to double the canvas throughout, *e. e.* are the securing wires or cores which are inserted into the sides of the tyre or covering as in other cases hereinbefore described, the ends of the wires may be fastened by nipples similar to those before described or I may render the wires endless in this case by bevelling the ends of the wires for about 2 in. and braze them together, the tyre may then be made up on the wires or cores and vulcanized with the same. *l.* is a piece of canvas placed over the spoke heads to protect the inflatible tyre from undue wear. Fig. 16 shows a saddle or arched tyre of this class moulded or vulcanized

Forms.

in a closed form in a similar manner and for the same purpose as those described with reference to Figs. 11 and 12, whereby the outer surface is rendered more indestructible. Fig. 17 shows another method of moulding or vulcanizing the same tyre, whereby the condition and shape of the rubber when on the ground may be the same or nearly the same as that when moulded or vulcanized thus rendering it less liable to cuts or punctures.

Fig. 18 is a transverse section of the complete tyre and rim as described with reference to Figs. 15, 16 and 17, showing the manner in which the tyre is attached or detached from the metal rim. *a.* is the metal rim. *b.* is an ordinary inflatible tyre or tube shown doubled up or in a collapsed form inside the closed tyre *c.* (see also Fig. 16). *c. e.* shows the wires or cores which are made smaller in circumference than the flanges of the rim. *m.* shows the ordinary tube for inflating in which is generally fitted a valve this projects through a hole in the rim *a.* through which the inner tyre is inflated in the ordinary way. To secure the whole on the rim the inflatible tyre is first placed within the outer or protecting tyre *c.* the wires or cores *e. e.* are then closed together allowing the tube *m.* to project between, this is then pushed through the hole in the rim *a.* and the two wires or cores are placed into the bottom of the concave groove for about two-thirds of the whole rim the remainder of the wires or cores with the tyre can then be lifted or sprung over the edge of the rim opposite the tube *m.* as shown in the drawing the inner tube or tyre *b.* may now be inflated with a small pump in the usual manner, this causes the wires or cores *e. e.* to part until finally they are pushed into place over the shoulders *k. k.* thus the wires being smaller in circumference than the edges of the rim, the inner tube or tyre may be pumped tight against the inner surface of the protecting tyre thus the whole is rendered secure on the rim as shown in Fig. 15, and also in dotted lines in Fig. 18. To detach the rubber tyre or outer covering from the rim the air must first be allowed to escape when the wires or cores may be pinched or closed together round the rim by the thumbs and fingers until the wires can be lifted over the edge of the rim; the whole can then be removed as shown in Fig. 18.

Fig. 19 shows a complete tyre constructed to fit the ordinary large sized rims. *a.* is the rim in which is fitted the rubber tyre *c.* constructed with a hole through the same for either lightening or reducing vibration. *d.* is the canvas for supporting the wires *e. e.* which are passed through the holes and drawn together in a similar manner to those described with reference to Figs. 1 and 2.

Fig. 20 shows a similar tyre constructed with a much larger hole through the centre this hole or space may be inflated through a suitable tube fitted with a valve in the ordinary manner. *a.* shows an ordinary hollow metal rim made with rounded edges. *c.* is a saddle or arched shaped tyre connected at the bottom by a web or band of rubber thus making a complete tube; *d.* is the canvas insertion which is vulcanized within the rubber in the form of a tube for strengthening the same and also to give support to the securing wires or cores *e. e.* which may be connected by the described nipples or the wires may be rendered endless by brazing the ends together as before described in which case they must be inserted before vulcanizing. *m.* is the valve-tube through which the tyre may be inflated in the usual manner. In order to secure the tyre in its place on the rim the tube *m.* is first pushed

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through the hole in the rim *a*. the rubber tyre is then pulled open as shown in dotted lines which allows it to be forced or pushed into its place, the tyre is then inflated which causes the web or band of rubber to be pressed down tightly into the concave grooved rim and thus preventing any displacement laterally, the tyre being held on each side by the wires or cores is therefore firmly secured to the rim.

To remove the tyre from the rim all that is necessary is to allow the air or gas to escape, the tyre can then be easily pulled laterally over the edge of the rim without disconnecting the securing wires or cores. In most cases these tyres may be cemented in addition to the described wires or cores for either preventing the collection of dirt or dust or to help in keeping them in position on the rims.

The above described rubber tyres being either wholly or partly outside the metal rims or felloes are free to expand laterally thus giving a more elastic contact with the ground and therefore reducing vibration more effectually.

It is obvious that I may fit these improvements to various other wheels and also vary the details of construction without however departing from my invention.

I would have it distinctly understood that I am aware that arched tyres have been used before also that wires and other cores have been applied in a variety of ways.

I am also aware that a tyre similar in form and fitted on to a similar rim to that described by me with reference to Fig. 1, is shown in Salamons Patent 17093[81] but is secured to the rim by cement only, or by shrinking.

Having now particularly described and ascertained the nature of my said invention and in what manner the same is to be performed I declare that what I claim is :—

1. A rubber or elastic tyre having the form of a saddle or arch in section in combination with two wires inserted through the sides of the same for securing it to the metal rims or felloes substantially as herein described.

2. The application of a rubber or elastic tyre to a metal rim or felloe in such a manner that the wires or cores inserted within the said rubber for securing the same are outside the rim or felloe substantially as herein described.

3. A rubber or elastic tyre having the form of a saddle or arch in section fitted with two wires or cores so arranged that the same may be easily attached or detached by a wrench from outside the rim, felloe or tyre substantially as herein described.

4. A rubber or elastic tyre having the form of a saddle or arch in section lined with canvas in combination with two wires or sufficiently inelastic cores for securing the same to the rims or tyres substantially as herein described.

5. The application of endless wires or cores to each side of a rubber or elastic tyre having a saddle or arched form in section in combination with a canvas insertion or insertions for supporting the same substantially as herein described.

6. The methods of securing the elastic tyres in combination with the form of rims substantially as herein described and shown in the drawings with reference to Figs. 6, 7 and 8.

7. Grooving or embossing a rubber or elastic tyre for the purpose of reducing vibration or for lightening the same in combination with the wires or cores for securing to the rim felloe or tyre substantially as described with reference to Figs. 4, 6, 7, 8 and 10 of the drawings.

8. The application of my improved rubber or elastic tyres to an ordinary rubber and rim substantially as herein described with reference to Figs. 9, 10 and 14 of the drawings.

9. A rubber or elastic tyre having the form of a saddle or arch in section provided with endless wires or cores fitted or vulcanized within each side for the purpose of securing the same to the rims in combination with an inflatible inner tyre or tube substantially as described and shown with reference to Figs. 15 and 18 of the drawings.

10. A rubber or elastic tyre having the form of a saddle or arch in section, lined with canvas and provided with endless wires or cores for covering, protecting and securing an inflatible inner tube or tyre, substantially as herein described.

11. Forming the inner surface or groove of a metal rim with shoulders in combination with the construction of tyre substantially as described and shown in the drawings with reference to Figs. 15 and 18.

12. Making the endless wires or cores for securing the covering or protecting tyre of smaller circumference than the edges of the rim or felloe in combination with an inner inflatible tyre whereby the wires or cores are placed and held in position by the pressure of air substantially as described with reference to Figs. 15, 16 and 17 of the drawings.

13. The method of placing the securing wires or cores with the tyres on the metal rim namely—by holding the two wires or cores together and placing them round the bottom of the concave groove until the remainder can be forced over the edge in combination with an inner inflatible tyre whereby the outer covering or protecting tyre is held or forced into its place on the rim substantially as herein described with reference to Figs. 15 and 18 of the drawings.

14. The methods of attaching or detaching the rubber or elastic tyres on or from the rims substantially as herein described and shown in the drawings with reference to Figs. 15, 16, 18 and 20.

15. The methods of moulding or vulcanizing rubber or elastic tyres substantially as described with reference to Figs. 11, 12, 16 and 17 of the drawings whereby the outer surfaces are rendered more indestructible.

16. A rubber or elastic tyre of a saddle or arch form in section but having a connecting web or band of rubber at the bottom or base in combination with two wires or cores for securing the same to the rim substantially as herein described with reference to Figs. 19 and 20.

17. An inflatible rubber or elastic tyre secured to a concave grooved rim by two endless wires or cores one on each side of the tyre in combination with a flexible band or web of rubber connecting the base and so constructed that the pressure on the inside when the tyre is inflated causes the said band to press tightly in the groove whereby it is firmly secured laterally substantially as herein described with reference to Fig. 20 of the drawings.

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18. The various methods of constructing rubber or elastic tyres in combination with the various metal rims, felloes or tyres and the manner of securing the same substantially as herein described with reference to the drawings.

Dated this 16th day of June, 1891.

C. KINGSTON WELCH.

No. 89.

Provisional Specification

Of Chemical Invention.

PROVISIONAL SPECIFICATION.

Improvements in the Manufacture of Explosive Compounds.

I, HIRAM STEVENS MAXIM, of Crayford Works, Crayford, in the County of Kent, Mechanical Engineer, do hereby declare the nature of this invention to be as follows :—

My invention relates to the manufacture of explosive compounds, and comprises improvements whereby I am enabled to so modify the explosive properties of such compounds that the said compounds will burn slowly and will act very efficiently in rifles or other fire-arms, that is to say, will impart a very high muzzle velocity to the projectile without at any time subjecting the gun-barrel to excessive pressure.

In the manufacture of explosive compounds according to my present invention, I mix dissolved gun-cotton or pyroxyline with nitro-glycerine, nitro-gelatine or similar material and with oil, preferably castor-oil.

I have discovered that the addition of oil to compounds of dissolved gun-cotton and nitro-glycerine, nitro-gelatine or the like, increases the toughness of the product and modifies the explosion thereof, whilst greatly diminishing its liability to deterioration by exposure to the atmosphere.

Various kinds of oil are useful for the purpose of my invention ; I prefer, however, to employ castor-oil because it is soluble by means of the solvents which are employed for dissolving the gun-cotton and nitro-glycerine or nitro-gelatine ; it combines with either of these substances, forming a compound which is unlike either of the said substances alone ; and, as it contains oxygen, it requires a smaller supply of oxygen from other sources to consume it and also has less tendency to produce smoke than other oils, while like them it modifies the explosion. Castor-oil, moreover, makes the explosive compound very tough, and of such nature that it may be easily cut and easily pressed, and prevents it from deteriorating under atmospheric influences.

I find that an explosive compound which is advantageous for various purposes is produced by mixing gun-cotton, nitro-glycerine and castor-oil in, or about in the following proportions, viz. :—from two to five per cent. of castor-oil, from ten to sixteen per cent. of nitro-glycerine, and the remainder of gun-cotton. I can thus make an explosive compound which, when cut into small pieces, answers very well as a smokeless powder for rifles, the oil effectually preventing detonation

and regulating or modifying as may be required the rapidity with which the said compound will burn.

My improved explosive compound is advantageously manufactured by first dissolving the gun-cotton in acetone or a similar solvent either in a liquid state or in the form of vapour, then adding the nitro-glycerine and after that the castor-oil, and thoroughly incorporating these substances. Or the castor-oil may be dissolved in a portion of the acetone or other solvent before the said solvent is added to the gun-cotton.

According to another method of manufacture, I take thoroughly dried gun-cotton, and place it in a rotary cylinder wherein it is tumbled with the nitro-glycerine and the oil, the oil and nitro-glycerine being first mixed with acetone or other solvent in such quantity that it will not dissolve the gun-cotton; the said cylinder is rotated until the fibres of the gun-cotton are uniformly wetted with the said mixture; in this condition the gun-cotton is not explosive. The gun-cotton thus mixed with the nitro-glycerine and oil is then placed in a closed cylinder or press, the air is exhausted from the said cylinder or press, and its place supplied by the vapour of acetone, ethylic acetate or other solvent. The product is then subjected to pressure in the said cylinder or press and thus forced out through small holes in the form of threads or thin strips, which may be cut into small pieces.

Instead of proceeding as above described, I sometimes dissolve the gun-cotton or tri-nitro-cellulose in acetone or ethylic acetate until it is brought to a sufficiently thin consistency, and then add the nitro-glycerine and oil.

I wish it understood, however, that I do not confine myself to any special method or process for the production of my improved compound of gun-cotton, nitro-glycerine or similar material and oil, as I may manufacture the said compound in various ways.

Dated this 14th day of March, 1889.

HASELTINE, LAKE & Co.,
45, Southampton Buildings, London,
Agents for the Applicant.

No. 90.

Complete Specification
Of Chemical Invention.

COMPLETE SPECIFICATION.

Improvements in the Manufacture of Explosive Compounds.

I, HIRAM STEVENS MAXIM, of Crayford Works, Crayford, in the County of Kent, Mechanical Engineer, do hereby declare the nature of this invention and in what manner the same is to be performed, to be particularly described and ascertained in and by the following statement:—

My invention relates to the manufacture of explosive compounds, and comprises improvements whereby I am enabled to so modify the

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explosive properties of such compounds that the said compounds will burn slowly and will act very efficiently in rifles and other fire-arms, that is to say, they will impart a very high muzzle velocity to the projectile without at any time subjecting the gun-barrel to excessive pressure.

In the manufacture of explosive compounds according to my present invention, I mix dissolved gun-cotton or pyroxyline with nitro-glycerine, nitro-gelatine or similar material and with oil, preferably castor-oil.

I have discovered that the addition of castor-oil or other suitable oil to compounds of dissolved gun-cotton and nitro-glycerine, nitro-gelatine or the like, increases the toughness of the product and modifies the explosive properties thereof, whilst greatly diminishing its liability to deterioration by exposure to the atmosphere.

I prefer to employ castor-oil because it is soluble by means of the solvents which are employed for dissolving the gun-cotton and nitro-glycerine or nitro-gelatine; it combines with either of these substances, forming a compound which is unlike either of the said substances alone; and, as it contains oxygen, it requires a smaller supply of oxygen from other sources to consume it, and also has less tendency to produce smoke than other oils, while like them it modifies the explosion. Castor-oil, moreover, makes the explosive compound very tough, and of such nature that it can be easily cut and easily pressed, and effectually prevents its deterioration under atmospheric influences.

I produce an explosive compound which is advantageous for various purposes, by mixing the gun-cotton, the nitro-glycerine, nitro-gelatine or similar substance and the castor-oil in, or about in the following proportions, viz.:—from two to five per cent. of the castor-oil, from ten to sixteen per cent. of the nitro-glycerine or the like, and the remainder of gun-cotton. I can thus make an explosive compound which, when cut into small pieces, answers very well as a smokeless powder for rifles, the oil effectually preventing detonation and regulating or modifying as may be required the rapidity with which the said compound will burn.

My improved explosive compound is advantageously manufactured as follows, that is to say:—I first dissolve gun-cotton or tri-nitro-cellulose in acetone, ethylic acetate or a similar solvent, either in a liquid state or in the form of vapour, until the said gun-cotton is brought to a sufficiently thin consistency; and I then add to the dissolved gun-cotton, the nitro-glycerine or nitro-gelatine, and after that the castor-oil, and thoroughly incorporate these substances. Or the castor-oil may be dissolved in a portion of the acetone or other solvent before the said solvent is added to the gun-cotton.

According to another method of manufacture, I take thoroughly dried gun-cotton, and place it in a rotary cylinder wherein it is tumbled with the nitro-glycerine or nitro-gelatine and the oil, the said nitro-glycerine or nitro-gelatine and oil being first mixed with a quantity of acetone or other solvent insufficient to dissolve the gun-cotton; the said cylinder is rotated until the fibres of the gun-cotton are uniformly wetted with the said mixture; in this condition, the gun-cotton is not explosive. The gun-cotton thus mixed with the nitro-glycerine or nitro-gelatine and oil is then placed in a closed cylinder or press, the air is exhausted from the said cylinder or press, and its place supplied by the vapour of acetone, ethylic acetate or other solvent. When the mixture is sufficiently dissolved, it is

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subjected to pressure in the said cylinder or press and thus forced out through small holes in the form of threads or thin strips, which may be cut into small pieces as described in the specification of former Letters Patent granted to me and dated 8th November A.D. 1888, No. 16,213, or in any other convenient manner.

I wish it understood, however, that I do not confine myself to any special method or process for the production of my improved compound of gun-cotton, nitro-glycerine or similar material and oil, as I may manufacture the said compound in various ways.

I sometimes treat the explosive compound in the manner described in the specification of Letters Patent granted to me and dated 20th December A.D. 1888, No. 18,663 for the recovery of the solvents used in the manufacture of the said compound.

Having now particularly described and ascertained the nature of my said invention and in what manner the same is to be performed, I wish it understood that I claim :—

First. An explosive compound consisting essentially of gun-cotton or pyroxyline mixed with nitro-glycerine, nitro-gelatine or similar material and with castor-oil or other suitable oil, for the purpose above specified.

Second. The manufacture of an explosive compound by first dissolving gun-cotton by means of acetone or other solvent and then incorporating with the dissolved gun-cotton, nitro-glycerine, nitro-gelatine or similar material and castor-oil or other suitable oil, substantially as hereinbefore described.

Third. The manufacture of an explosive compound by dissolving first castor-oil or other suitable oil and then gun-cotton by means of acetone or other solvent, and incorporating therewith nitro-glycerine, nitro-gelatine or similar material substantially as hereinbefore described.

Fourth. The manufacture of an explosive compound by first mixing nitro-glycerine, nitro-gelatine or similar material and castor-oil or other suitable oil with a small quantity of acetone or similar solvent, treating dried gun-cotton with this mixture in a rotary cylinder or chamber, and then subjecting the product, in a cylinder or chamber from which air is exhausted, to the action of vaporized acetone or other solvent and then to pressure, substantially as hereinbefore described.

Dated this 16th day of December, 1889.

HASELTINE, LAKE & CO.,
45, Southampton Buildings, London,
Agents for the Applicant.

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