1544 CUNYNGHAME (H.) ENGLISH PATENT PRACTICE.
Clowes, London. 1894.
Brown half morocco, gilt top. 8vo. 1 vol.
Presentation copy.
(35.B.3.)

ENGLISH PATENT PRACTICE.

WITH

ACTS, RULES, FORMS, AND PRECEDENTS.

BY

HENRY CUNYNGHAME, M.A.,

OF THE INNER TEMPLE, BARRISTER-AT-LAW; M.I.E.E.; LATE ROYAL ENGINEERS.

Author of "A Treatise on the Law of Electric Lighting."

ILLUSTRATED.

LONDON:

WILLIAM CLOWES AND SONS, LIMITED,

27, FLEET STREET.

1894.

Closed
T
C9195
1894

LONDON:
PRINTED BY WILLIAM CLOWES AND SONS, LIMITED,
STAMFORD STREET AND CHARING CROSS.

PREFACE.

THE Law of Patents depends upon the prerogative of the Crown as protector of trade to grant monopolies for the use of new inventions, but has been modified and restricted by statute. From this two main principles follow, from which have been derived most of the rules of Patent Law. In the first place the Crown acts for the encouragement, not of science or of meritorious discoverers, but of trade; and hence the novelty and utility demanded of a patent must be trade novelty and trade utility, and not merely scientific excellence or importance. It is for this reason that the commercial success or failure of an invention plays so important a part in determining the validity of a patent for it, and a short chapter has been devoted to this subject.

In the next place, since a patent exists only by virtue of a royal grant, it must be interpreted according to the rules which govern the interpretation of grants by the Crown, which stand on a very different footing from grants between subjects. It is for this reason that failure in any part of a patent avoids the whole, and that, although in the construction of a patent the natural meaning of words is adopted, yet the grant is construed more strictly against the grantee than in cases of ordinary grants.

In order to compress the subject into the compass of a moderate-sized book, and yet to insert all the useful cases, it has been necessary to condense the style, to avoid repetition, and to make a liberal use of cross-references.

For convenience of reference, the various rules of law have been arranged so far as is practicable in a series of propositions or sectional headings distinguished by thicker type. In the table of cases the dates are given, and also the subject-matter of the patent. The new circular of information issued by the Board of Trade has also been inserted. The index, it is believed, will be found sufficiently exhaustive.

This book is mainly intended for professional men. Those unaccustomed to drawing patents will, if their inventions are of any real value, find it greatly to their interest to have their patents well drawn from the beginning by some competent adviser. It is quite as difficult, and even much more difficult, to draw a good specification, as it is to draw a will or conveyance of property, and bad drafting inevitably leads to expense, if not to a total loss of the patent. On the other hand, an inventor, even when he has secured competent professional assistance, should not neglect to peruse carefully the whole draft, so as to see that his ideas have been well interpreted, and nothing omitted.

There is a tendency on the part of inventors to make application before their inventions are really ripe. This arises from the very natural fear of anticipation, or of their secrets being discovered by others. There is some foun ation for this fear, for an examination of the patents taken out in various years will shew the extraordinary tendency of the human mind to run in grooves. One year will abound in inventions for electric lamps, the next will perhaps be notable for refrigerating apparatus; then will come a tide of new proposals for pencils and pens, and in the next few years a remarkable crop of patents for paraffin lamps.

Most extraordinary instances have come within the author's knowledge of inventions which were certainly made independently, and yet which corresponded even in minute details.

Therefore, when an inventor is working on a subject that happens to be in fashion, he should be rapid. Where, however, he is at work on some new or neglected branch of invention, he can afford to be slow, and in this latter case the advantage to his patent will be very great.

Before developing his idea, it is in general better not to consult what has been previously done, for this often tends to divert the mind and to destroy originality; but once the idea is well developed and clear, the inventor should make himself master of the principal prior patents connected with it. He is certain in this way to find something to avoid, and almost as certain to find something which he may carefully adopt in combination with parts of his own proposals.

In almost every case it is wise to have working-models made, for small unexpected defects often delay and even defeat the most ingenious inventions.

Before having these models made he should carefully plan them out in detail. The author has seen very large sums of money wasted which might have been saved if more care had been devoted, before the models were made, to the development and perfection of details. Machinery design almost always proceeds from the complex to the simple; one can hardly take up a patent without seeing a lever which might have been suppressed, or a part which might have been simplified with advantage. Care should be taken to see not merely that the design is theoretically correct, but that it is one that can be carried out cheaply and successfully. It is a great mistake in general to order finished models at once; the first working models should be utterly devoid of ornamentation, or of any finish whatever, except in the working parts, for only in the very simplest cases is it possible to avoid the necessity of more than one model. On the other hand, when preparing a model to exhibit to commercial men, it is well to have it properly

finished and good-looking, for it takes a good mechanician to recognise the value of a model in the rough.

It is above all needful before starting to work out an invention to see that sufficient funds are available to complete it. In all the stages of application for a patent those who can afford it will do well to consult a patent agent. The services these gentlemen can render are usually worth to the inventor far more than the cost of obtaining them. Unfortunately, owing to the present state of the law, a body of ignorant pretenders has sprung up, who pass themselves off as patent agents without having been regularly placed on the roll, and are therefore not under any control nor have passed any examinations. They thus possess no credentials of character or competency. Inventors are recommended to see that the patent agents they employ are duly on the roll of patent agents, a printed list of whom can be obtained at the Patent Office.

Lastly, inventors may be reminded that it is not enough to make a clever invention; when the invention has been perfected, the hardest part of all comes, namely, to cause it to be adopted and worked to the advantage of the inventor. The words of Sir Hugh Platt in 1589 are as true now as they were when he wrote them: "I have always found it in mine own experience an easier matter to devise manie and profitable inventions, than to dispose of one of them to the good of the author."

I have to thank Mr. Lloyd Wise, President of the Chartered Institute of Patent Agents, for many valuable suggestions, too numerous to specify in detail.

H. CUNYNGHAME.

2 Patent Buildings, Temple,
April, 1894.

TABLE OF CONTENTS.

INTRODUCTION.

	PAGE
1. Nature of inventions; no property in them at common law	1
2. The origin of the law of patents	3
3. General view of the present law	20

CHAPTER I.

THE SUBJECT-MATTER OF LETTERS PATENT.

1. No patent can derogate from a former grant	37
2. A patent must be for some kind of manufacture	38
3. A patent cannot be granted for a bare principle	45
4. A patent may be granted for a process which simply omits a step in an already known process	52
5. Patents for combinations and improvements	53
6. It is no derogation from a patent to grant another for an improvement upon it, although the patent for the improvement cannot be used without the consent of the prior patentee	59
7. A patent may cover not only machines as they exist, but also the same machines as subsequently improved	60
8. If any substantial or essential part of an invention fails, the whole patent is void, for the grant is indivisible, and goes to the whole consideration	60
9. The subject-matter must not be contrary to public policy	63

CHAPTER II.

UTILITY.

1. An invention must possess utility at the time it is patented	65
2. It is the invention that must be useful, not merely the result of the invention	65
3. The degree of utility may be slight	70
4. Effect of failure of utility in a material part of the patent	70

CHAPTER III.

NOVELTY AND THE AMOUNT OF INVENTION OR INGENUITY NECESSARY TO CONSTITUTE IT.

	Page
1. General remarks, ambiguous use of the term "novelty"	74
2. Ingenuity is to be judged in the light of the state of public knowledge at the time of the invention	77
3. The use of an old machine or thing for a merely analogous purpose is not the subject of a patent	87
4. The substitution of what is afterwards discovered to be a mere analogue, or mechanical equivalent, will not avoid a patent, if, in the state of knowledge at the time of the patent, it was not known to be an analogue	94
5. If there be invention, the degree of it may be slight	94
6. Examples of cases in which the invention was held to be sufficient	97
7. Examples of patents held bad, for want of ingenuity	118
8. Want of ingenuity in part of the subject-matter of a patent will render it void	133

CHAPTER IV.

THE EFFECT OF COMMERCIAL SUCCESS ON THE VALIDITY OF A PATENT.

1. General remarks	124
2. The effect of commercial success as evidence of utility	134
3. Commercial success as evidence of novelty	136
4. Commercial success as evidence of ingenuity	136

CHAPTER V.

ANTICIPATION.

1. A patent will be bad if prior public knowledge of it can be shown	138
2. Effect of prior user of a public character	140
3. Effect of prior user of a private or experimental character	142
4. Prior user of such a character that the results of the invention are published, but not the means whereby those results were obtained	145
5. Prior user by sale or offering for sale	148
6. The prior user must be in the United Kingdom	148
7. Prior user at public exhibitions, under the Act of 1883	149
8. Prior user which has been abandoned	149
9. Prior publication by documents in general, and sufficiency of description in the anticipating documents	151

PAGE

10. Prior publication in a provisional specification 155
11. Prior publication by a complete specification 156
12. Prior publication in a book 157
13. A book in a foreign language 157
14. Prior publication by drawings without description . . . 158
15. Prior publication by models 158
16. The prior publication must have been accessible to the public . 158
17. Want of novelty in a part of an invention will invalidate the whole patent 160

CHAPTER VI.

THE SPECIFICATIONS AND TITLE OF THE PATENT.

1. General principles regulating the choice of a title . . . 162

CHAPTER VII.

THE PROVISIONAL SPECIFICATION.

1. General remarks 163
2. The object of a provisional specification is not to describe how the invention is to be performed 169
3. The complete specification will not be allowed to travel outside the limits of the provisional—Disconformity 170
4. A provisional specification may be consulted to explain the complete specification, but not to cure defects in it . . . 176
5. If needful the provisional specification must have drawings attached 177
6. Abandonment of a provisional specification 177
7. The effect of provisional protection is to prevent public user between the date of application and the sealing of the patent . 177

CHAPTER VIII.

THE COMPLETE SPECIFICATION.

1. General remarks 178
2. The specification should point out whether the invention be a thing, a process, a combination, or an improvement 178
3. Patent for a new machine 179
4. Claim for an improvement 179
5. Claim for a combination 180
6. A complete specification must particularly describe and ascertain (1) The nature of the invention, (2) In what manner it is to be performed, and (3) Must be accompanied by drawings if required 181

PAGE

7. The subject-matter must be proper 135
8. The complete specification must conform to the provisional . . 185
9. If the specification fail in a material point the whole patent fails . 185
10. The specification must be clear and unambiguous . . . 185
11. The specification must clearly distinguish what is new from what is old 190
12. And what is useful from what is useless 186
13. In claiming an improvement it is not *necessary* to explain why it is an improvement 187
14. Not needful to describe any obvious or well-known step . . 187
15. Not necessary formally to disclaim what is obviously old . . 187
16. Not vitiated by the claim of some non-material part, which turns out not to be useful (in the absence of fraud) 187
17. Not necessary to describe every known method 188
18. Not necessary to describe the best method, but necessary to describe the best method known to the patentee 188
19. The specification must be intelligible to an ordinary workman . 188
20. Without further experiment 190
21. The inventor must reveal the best method with which he is acquainted 191
22. The specification must not contain any misleading or false statements or suggestions 192
23. An *obvious* error will not vitiate a patent 193

CHAPTER IX.

THE CLAIMS.

1. The nature, functions, and objects of claims 195
2. Everything not claimed is treated as disclaimed 196
3. Claims must be unambiguous and clear 196
4. The claim must be considered with reference to the specification . 196
5. A claim of "every method by which a thing can be done" is bad . 197
6. A patentee is strictly held to his claims 197
7. Where a claim may be read as merely ancillary, this will be done to save the patent 198

CHAPTER X.

THE DRAWINGS.

1. Drawings are to be attached to specifications if required . . 201
2. Drawings are to be taken as part of the specification . . . 201
3. But it is not sufficient to shew an improvement by a drawing, if it is not claimed 202

PAGE
4. Drawings, if intelligible, need not be well executed . . . 202
5. Anticipation by drawings 203
6. If the provisional specification has a drawing, reference to it may be made in the complete specification 202

CHAPTER XI.

CONSTRUCTION OF SPECIFICATIONS.

1. The beneficial construction 203
2. The title-specification and claims may all be looked at to explain one another 209
3. A patent is to be construed with reference to public knowledge at the time 210
4. A patent which has stood the test of time should be favourably construed 211
5. Effect of the use in specifications of foreign words; "manufacture"; "as above described"; "other substances"; "mechanical equivalents"; "analogous"; "more or less"; "effect"; "a"; "and"; "etc."; "or"; "s" 211

CHAPTER XII.

AMENDMENT OF THE SPECIFICATION.

1. Practice prior to the Patents Act, 1883 215
2. Amendment under the Patents Act, 1883 215
3. Procedure when no action is pending 216
4. Procedure when an action is pending 216
5. Opposition to the amendment 218
6. Hearing of the application, and conditions imposed . . . 219
7. Nature of amendments allowed 221
8. Amendment dates back to date of patent 224
9. Title, provisional, complete, and drawings, all may be amended . 224
10. Effect of an amendment widening scope of the patent would be to invalidate it 225
11. No damages for infringements prior to amendment except by leave 225
12. Amendments made out of caution 225
13. Amendment of clerical errors 226
14. Costs 226

CHAPTER XIII.

PATENTEES.

PAGE

1. Who may be 228
2. Patents granted to infants, lunatics, married women, and aliens . 228
3. Legal representatives 229
4. International grants for foreign inventions 229
5. First and true inventor 229
6. Assistance of servants and workmen 230
7. Communications from abroad 232
8. Meaning of the word patentee 231

CHAPTER XIV.

PATENT AGENTS.

1. Patent agents, under the Act of 1883 235

CHAPTER XV.

PROCEDURE TO OBTAIN A PATENT.

1. Whether to send in a provisional or a complete specification in the first instance 237
2. Procedure in sending in an application 239
3. Patents contrary to law or morality refused 241
4. Report of the examiner 241
5. Acceptance of the application 241
6. Sending in the complete specification 242
7. Acceptance of the complete specification 244
8. Sending in the complete specification with the application . . 244
9. Rival applications, interference 244
10. Powers of the comptroller 245
11. Appeals 245
12. Amendment of the specifications 245
13. Constitution of the Patent Office, and powers of the comptroller . 245

CHAPTER XVI.

OPPOSITION TO THE GRANT.

1. Practice before Patents Act, 1883 246
2. Procedure under Patents Act, 1883 246
3. Grounds of opposition 247
4. Opposition on ground that the invention was got from the opponent 247

PAGE

5. Opposition on ground of prior grant on prior application . . 249
6. Opposition on ground that patentee is seeking to put into his patent his opponent's interim invention 253
7. Hearing before the comptroller 254
8. Appeals to the law officer 255
9. Opposition on ground of fraud 256

CHAPTER XVII.

GRANT OF THE PATENT.

1. Form of the grant 258
2. Note (*a*). No estoppels against the Crown 261
3. „ (*b*). Meaning of the word patentee 263
4. „ (*c*). Great Britain and Isle of Man 263
5. „ (*d*). Powers of search obsolete 263
6. „ (*e*). Revocation clause 263
7. „ (*f*). Beneficial construction clause 265
8. Duration of the grant 265
9. Lost patents 266
10. Sealing of a patent notwithstanding prior seal 266

CHAPTER XVIII.

REGISTER OF PATENTS.

1. The keeping of the register, and what will be entered thereon . 267

CHAPTER XIX.

FEES.

1. Fees under the new rules, 1892 270
2. Enlargement of time for paying fees 270
3. Stamps 271
4. Privy Council fees. 271

CHAPTER XX.

CROWN RIGHTS.

1. Crown now cannot use patent without compensation to patentee . 272

CHAPTER XXI.

FOREIGN GOVERNMENTS.

1. Cannot be made amenable to English law 273

CHAPTER XXII.

ASSIGNMENT, DIVISION, MORTGAGE AND DEVOLUTION OF PATENTS BY DEATH OR BANKRUPTCY, CO-OWNERSHIP AND PARTNERSHIP IN PATENTS.

	PAGE
1. Assignments	274
2. Division of a patent	275
3. Agreements to assign	277
4. Warranties and estoppels in assignments	278
5. Assignment with notice of prior covenants	280
6. Mortgage	280
7. Death and devolution to personal representatives	281
8. Bankruptcy	281
9. Co-ownership and partnership in patents	282
10. Assignments to Secretary of State for War	283

CHAPTER XXIII.

LICENSES.

1. License (what amounts to a)	284
2. Estoppel by a license, by deed, by conduct or by record	288
3. Compulsory licenses	290

CHAPTER XXIV.

INFRINGEMENT.

1. Infringment in general	291
2. The essence of the invention must be infringed in order to constitute an infringement	292
3. The ambit of an invention	299
4. Infringement by the substitution of equivalents or analogues	302
5. Infringement of a combination	305
6. A patent is not infringed by the use of the same means for a different purpose	313
7. It is no answer to say that the means used in the infringement are an improvement on the original patent	314
8. Co-extension of anticipations and infringements	314
9. Time when an infringement may be committed	315
10. The intention to infringe is not material	316
11. In order to constitute an infringement the act complained of must be one calculated to injure the trade profits of the patentee	316
12. Infringement by manufacture	317
13. Mere experimental user is no infringement	318

PAGE

11. Infringement by user 318
15. After a patent has been granted, a man who has used the invention secretly may not now do it publicly 319
16. Infringement by sale 320
17. The sale in Great Britain of an article made abroad is an infringement 321
18. It is no infringement to sell materials for infringing . . . 321
19. Repairs to a patented article 322
20. Use on board ships 322
21. Manufacture, use and sale by agents 323
22. Question of infringement is one of fact 324
23. Opinions of experts 325

CHAPTER XXV.

EXTENSION OF LETTERS PATENT.

1. Old practice 326
2. Practice under the present law 326
3. Persons who may petition 327
4. Procedure 329
5. Inspection of accounts 330
6. Advertisements 330
7. The petition 330
8. Time for presenting the petition 331
9. Caveats and caveators 332
10. Notice of objections to the extension 332
11. Lodging documents at the Privy Council 332
12. The hearing 332
13. Grounds on which a petition is granted 333
14. Accounts 338
15. The period of extension 344
16. No second extension allowed 345
17. Conditions of extension 345
18. Costs 346
19. The extension and new grant 347
20. Petition to revoke an order for extension which had not been acted upon 348

CHAPTER XXVI.

CONFIRMATION OF LETTERS PATENT.

1. Confirmation of letters patent 349

CHAPTER XXVII.

INTERIM INJUNCTIONS.

PAGE

1. General principles 351
2. Effect of long and uninterrupted user 351
3. Prior judicial establishment of the patent 353
4. The inability of the defendant, if defeated in the action, to compensate the plaintiff, or to pay costs, is also considered . . 353
5. Delay greatly prejudices an application for an interim injunction . 353
6. In rare cases interim injunctions are granted *ex parte* . . . 354
7. The infringement must be plain and clear 354
8. Affidavits in support of the application 354
9. In granting interim injunctions the Court endeavours to avoid a premature expression of opinion upon the merits of the case . 355
10. The injunction is most often refused, defendant agreeing to keep an account 355
11. Sometimes the application is ordered to stand over till the hearing, without an undertaking to keep an account 355
12. Terms upon which interlocutory injunctions are granted . . 355
13. By consent the hearing of the interim injunction is sometimes treated as the final hearing 356
14. An interim injunction when granted may be dissolved . . 356
15. Breach of the interim injunction, and committal . . . 356

CHAPTER XXVIII.

ACTION OF INFRINGEMENT.

1. Courts in which actions can be brought 357
2. Parties—plaintiffs 357
3. Parties—defendants 360
4. Time when the action can be brought 361
5. Writ in a patent action 361
6. Consolidation of actions 361
7. Statement of claim 362
8. Particulars of breaches 362
   (a) The plaintiff must specifically point out what part of his invention has been infringed 362
   (b) The plaintiff must point out what portions or characteristics of the articles complained of infringe his patent . . 363

PAGE

(c) The plaintiff must give such instances of infringement as he knows of 364
(d) The plaintiff is not permitted to group together generally infringements which differ in type 364
9. Amendment of particulars of breaches 365
10. The defence 365
11. Particulars of objections, old practice 365
12. Practice as to particulars of objections under the Patents Act, 1883, sect. 29 367
(a) Denial of plaintiff's title 368
(b) Denial of infringement 368
(c) Plaintiff not true and first inventor 368
(d) Invention not proper subject of a patent 368
(e) The patent a derogation from a former grant . . . 369
(f) Want of utility 369
(g) Want of novelty 370
(1) By reason of public common knowledge . . . 370
(2) Prior publication 371
(α) By a prior specification 371
(β) By a book or other publication . . . 372
(γ) By prior user 372
(h) Specification imperfect 373
(1) Disconformity 373
(2) Disconformity produced by amendment . . . 373
(3) New not distinguished from old 373
(4) Ambiguity 374
(5) False suggestions 374
(6) Insufficient description to enable a workman to make it 374
(7) Concealment of the most beneficial method . . 374
13. Amendment of defence and particulars 374
14. Amendment of particulars of defence before hearing . . . 375
15. Amendments at the hearing 376
16. Amendment of particulars of objections on appeal . . . 377
17. Inspection—old practice 378
18. Inspection under Patents Act, 1883, sect. 30 379
19. Discovery and production of documents 382
20. Interrogatories 382
21. Mode of trial (assessors) 385
22. Change of venue 387
23. The hearing; evidence 387
24. Questions of law and fact 394
25. Construction of documents is for the Court 395
26. Determination of the quantum of invention 395

PAGE
27. Questions of anticipation 395
28. Questions of utility 395
29. Questions of intelligibility 396
30. Judgment 397
31. Judgment for an account 398
32. Damages 400
33. Perpetual injunction 401
34. Disobedience to an injunction 402
35. Delivery up of the infringing articles 404
36. Discovery in aid of execution 404
37. Stay of execution 405
38. Certificate of validity 406
39. Costs 408
40. Costs of separate issues 409
41. Certificate of particulars 409
42. Apportionment of costs 411
43. Costs on the higher scale 413

CHAPTER XXIX.

ACTIONS FOR THREATS.

1. Old practice 415
2. Modern practice 415
3. What constitutes a threat 416
4. What issues may be raised in an action for threats . . . 417
5. Interim injunction to restrain threats 417
6. Damages for threats 419
7. Issuing warning circulars 419

CHAPTER XXX.

PROCEDURE FOR REVOCATION OF THE PATENT.

1. Old method 421
2. New procedure 422
3. Attorney-General's fiat 422
4. Locus of petitioner. 423
5. A petitioner who has a locus may impeach the patent on any ground 424
6. A petition for revocation analogous to an action 424
7. Particulars of objections 425

PAGE

8. In a petition for revocation the defendant begins and supports the patent 425
9. Copy of order for revocation to be left at the Patent Office . . 425
10. Revocation on ground of fraud—Grant to true inventor . . 425

CHAPTER XXXI.

APPEALS.

1. Appeals are now by re-hearing 426
2. Court of Appeal may hear fresh evidence 426
3. Judge's notes 428
4. Costs on appeal 428

CHAPTER XXXII.

OFFENCES.

1. Selling unpatented articles as patented 430
2. Falsification of registers 431
3. Assuming the Royal Arms 431

CHAPTER XXXIII.

INTERNATIONAL ARRANGEMENTS 432

APPENDIX.

Statutes :—
Statute of Monopolies, 21 Jac. I. c. 3 435
Patents Act, 1883–1888, 46 & 47 Vict. c. 57 440
Patents Act, 1885, 48 & 49 Vict. c. 63 475
Patents Act, 1886, 49 & 50 Vict. c. 37 477
Patents Act, 1888, 51 & 52 Vict. c. 50 479

PAGE

Patent Rules, 1890 483
Short title, sect. 1 483
Commencement, sect. 2 483
Interpretation, sect. 3 483
Fees, sect. 4 483
Forms, sects. 5, 6 483
General, sects. 7–17a 484
Application with provisional or complete specification, sects. 18–22 487
Application on communication from abroad, sect. 23 . . 488
International and colonial arrangements, sects. 24–29 . . 488
Sizes and methods of preparing drawing, sects. 30–33 . . 489
Opposition to grants of patents, sects. 34–44 . . . 491
Certificates of payment or renewal, sects. 45–48 . . . 493
Enlargement of time, sects. 49–51 493
Amendment of specification, sects. 52–59 494
Compulsory licenses, 60–66 495
Register of patents, 67–79 496
Power to dispense with evidence, 80 499
Repeal of previous rules, 81 499
Law officers' Appeal Rules 500
Patent Rules, 1892 (first set) 503
Patent Rules, 1892 (second set, table of fees) 504
Patent Official Forms—
A. Form of application for patent 508
A.[1] „ „ „ communicated from abroad. 510
A.[2] „ „ „ (international) . . . 512
B. Provisional specification 513
C. Complete „ 515
D. Opposition to grant of patent 516
E. Application for hearing by comptroller 517
F. „ to amend specification or drawings . . 518
G. Opposition to amendment of specification or drawings . 519
H. Application for compulsory grant of license . . . 520
H.[1] Petition for compulsory grant of licenses . . . 521
I. Opposition to compulsory grant of licenses . . . 522
J. Application for certificate of payment or renewal . . 523
K. „ for enlargement of time to pay renewal fees . 524
L. Request to enter name on register of patents . . . 524
M. Request to enter notification of license upon register . 525
N. Application for duplicate of letters patent . . . 526
O. Notice of intended exhibition of unpatented invention . 527
P. Request for correction of clerical error 528
Q. Certificate of comptroller 528

PAGE

Patent Official Forms—*continued.*
R. Notice for alteration of an address in register . . . 529
S. Application for entry of order of P. C. in register . . 530
T. Appeal to law officer 530
U. Application for extension of time for leaving a complete specification 531
V. Application for extension of time for acceptance of complete specification 532
Register of Patent Agents Rules, 1889 533
Circular of Information of the Patent Office, 1892 . . . 541
International Convention for the Protection of Industrial Property. 558
Privy Council Rules 567
Privy Council Fees 568
Forms—
Opposition to grant of patent 569
Indorsement on writ 569
Motion for interlocutory injunction 569
Order for interlocutory injunction 570
Undertaking to keep an account 570
Statement of claim 571
Particulars of breaches 573
Application for further and better particulars of breaches . 574
Order for further and better particulars of breaches . . 575
Statement of defence 576
Particulars of objections 576
1. Plaintiff not first and true inventor 577
2. Patent bad, as being 578
(*a*) For a bare principle 578
(*b*) Contra bonos mores 578
3. Patent bad for want of utility 578
4. Patent bad on the ground of public general knowledge 578
5. Patent anticipated by prior publications . . . 579
6. Patent anticipated by prior user 581
7. Specification bad on the grounds following . . . 581
(*a*) Disconformity 582
(*b*) New not sufficiently distinguished from old . 582
(*c*) Ambiguity 583
(*d*) Misleading 583
(*e*) Contains false suggestions 583
(*f*) Insufficient directions 584
(*g*) Non-disclosure of best method known to inventor 584
Summons for further and better particulars . . . 584
Order thereon 584
Interrogatories 586

PAGE

Forms—*continued.*

Application and order for leave to amend pending action . 587
Notice of opposition to amendment 587
Order for inspection of plaintiff's premises 589
Order for inspection of defendant's premises . . . 589
Order for experiments by an expert 590
Order directing trial of issue of infringement, before other issues 591
Forms of final judgment 591
Form of special case 591
Order for inquiry as to damages 591
Report thereon 591
Order for discovery in aid of execution 591
Motion for a new trial 592
Indorsement on writ in action for threats 592
Statement of claim in an action for threats 593
Interim injunction to restrain threats 593
Petition for revocation 593
Order for revocation 596
Petition for extension 597
Accounts sent in with petition 607
Register of Patent Agents Rules, 1891 613

ABBREVIATIONS.

A. & E.	Adolphus and Ellis' Reports.
B. & Ad.	Barnewall and Adolphus' Reports.
B. & A.	Barnewall and Alderson's Reports.
B. & C.	Barnewall and Cresswell's Reports.
Beav.	Beavan's Reports.
B. & S.	Best and Smith's Reports.
Bing. N. C.	Bingham's New Cases.
B. & P. N. R.	Bosanquet and Puller's New Reports.
Brod. & Bing.	Broderip and Bingham's Reports.
Bull. N. P.	Buller's Nisi Prius.
C. P. C.	Carpmael's Patent Cases.
Camp.	Campbell's Reports.
Co. Rep.	Coke's Reports.
C. B.	Common Bench Reports.
C. B. N. S.	Common Bench Reports, New Series.
Car. & K.	Carrington and Kirwan's Reports.
Car. & P.	Carrington and Payne's Reports.
C. L. R.	Common Law Reports.
Cl. & F.	Clark and Finnelly's Reports.
Coop.	Cooper's Chancery Cases.
Cr. M. & R.	Crompton, Meeson, and Roscoe's Reports.
Ct. Sess.	Court of Session Reports. (Scotland).
D. P. C.	Davies' Patent Cases.
De G. F. & J.	De Gex, Fisher, and Jones' Reports.
De G. & J.	De Gex and Jones' Reports.
De G. M. & G.	De Gex, Macnaghten, and Gordon's Reports.
De G. J. & S.	De Gex, Jones, and Smith's Reports.
Dowl. & Ry.	Dowling and Ryland's Reports.
Dr. & S.	Drewry and Smale's Reports.

E. & B.	Ellis and Blackburn's Reports.
E. B. & E.	Ellis, Blackburn, and Ellis' Reports.
E. & E.	Ellis and Ellis' Reports.
Eq. Rep.	Equity Reports.
Ex.	Exchequer Reports.
F. & F.	Foster and Finlason's Reports.
Giff.	Giffard's Reports.
Good. P. C.	Goodeve's Practice Cases, 1853.
Griff. P. C.	Griffin's Patent Cases.
Griff. App.	Griffin's Appendix of Cases.
G. P. C.	Goodeve's Patent Cases.
H. Bl.	H. Blackstone's Reports.
H. & M.	Hemming and Miller's Reports.
H. L. Cas.	House of Lords Cases.
Holt N. P.	Holt's Nisi Prius Cases.
H. & N.	Hurlstone and Norman's Exchequer Reports.
Ir. Ch. Rep.	Irish Chancery Reports.
John.	Johnson's Reports.
J. & H.	Johnson and Hemming's Reports.
Jur. N. S.	Jurist, New Series.
Jur.	Jurist, Old Series, vols. 1–18, 1837–1854.
K. & J.	Kay and Johnson's Reports.
L. J.	Law Journal Reports, New Series.
L. R. App. Cas.	Law Reports, Appeal Cases.
L. R. Ch.	" Chancery Appeals.
L. R. Ch. D.	" Chancery Division.
L. R. C. P.	" Common Pleas Cases.
L. R. E. & I. App.	" English and Irish Appeal Cases.
L. R. Eq.	" Equity Cases.
L. R. Ex.	" Exchequer Cases.
L. R. H. L.	" House of Lords.
L. R. P. C.	" Privy Council Cases.
L. R. Q. B. D.	" Queen's Bench Division.
L. T.	Law Times, Old Series, vols. 1–34, 1831–1858.
L. T. N. S.	Law Times, New Series.
Lond. Jour.	London Journal of Patents.
Lawson.	Lawson's Patents Acts, 1883.

M. & G.	Manning and Granger's Reports.
M. & W.	Meeson and Welsby's Reports.
Mac. & G.	Macnaghten and Gordon's Reports.
M. P. C.	Macrory's Patent Cases.
Marsh.	Marshall's Reports.
Mer.	Merivale's Reports.
Moo. P. C. N. S.	Moore's Reports of Cases in the Privy Council, New Series.
Moo. P. C.	Moore's Reports of Cases in the Privy Council, Old Series.
My. & Cr.	Mylne and Craig's Reports.
N. R.	The New Reports from 1863, onwards.
Newt. L. J. C. S.	Newton's London Journal of Arts and Sciences, Conjointed Series.
Newt. L. J. N. S.	Newton's London Journal of Arts and Sciences, New Series.
Parl. Rep.	Parliamentary Reports.
Q. B.	Queen's Bench Reports.
R. P. C.	Reports of Patent Cases (official).
Russ.	Russell's Reports.
Russ. & M.	Russell and Mylne's Reports.
Ry. & M.	Ryan and Moody's Reports.
Scott N. R.	Scott's New Reports.
Scot. L. R.	Scottish Law Reporter.
Stark. R.	Starkie's Reports.
Taunt.	Taunton's Reports.
T. R.	Term Reports.
Times R.	Times Reports.
Tyr.	Tyrwhitt's Reports.
Ves.	Vesey's Reports.
W. N.	Weekly Notes.
W. P. C.	Webster's Patent Cases.
W. R.	The Weekly Reporter.
Y. & C.	Younge and Collyer's Reports.

TABLE OF CASES.

		PAGE
1684. **A. G. *v.* Vernon** . .	Vernon, fo. 279	70
1837. **Abbot *v.* Williams** .	2 C. P. C. 383; 9 Rep. Arts. 103 (*Manufacture of Felt*).	322, 338
1881. **Adair's Patent** . .	L. R. 6 App. Cas. 176; 29 W. R. 746 (*Pumps*).	331, 342
1879. **Adair *v.* Young** . .	L. R. 11 Ch. D. 136; 12 Ch. D. 13; 40 L. T., N.S., 596; 41 L. T., N.S., 361; 28 W. R. 85; W. N. 1979, 8 (*Pumps*).	318, 322, 354, 404
1873. **Adams *v.* N. B. Rail. Co.**	29 L. T., N.S. 367	359
1853. **Adam's Patent** . .	21 L. T. 38; 1 W. R. 259 .	226
1856. **Adamson's Patent** .	6 De G. M. & G. 420; 25 L. J. Ch. 456; 4 W. R. 473 (*Pier Building Machinery*).	141, 144
1866. **Ainsworth's Patent** .	Griff. 269	255
1888. **Aire & Calder Works and Walker's Application.**	5 R. P. C. 345 (*Screw Stoppers*).	251, 256
1888. **Airey's Application** .	5 R. P. C. 348 (*Height-Measuring Machine*).	252, 254
1887. **Albocarbon Light Co. *v.* Kidd.**	4 R. P. C. 535 (*Gaslights*) .	124
1829. **Alcock *v.* Cooke** . .	5 Bing. 340	14
1867. **Allan's Patent** . . .	L. R. 1 P. C. 507; 4 Moo. P. C. C., N.S., 443 (*Electric Conductors*).	336
1887. **Allen's Patent** . . .	Griff. App. 3 (*Water-Closets*).	220, 223
1887. **Allen *v.* Doulton** . .	3 T. L. R. 655; 4 R. P. C. 377 (*Drain-Pipes*).	217, 218, 587
1845. **Allen *v.* Rawson** . .	1 C. B. 551 (*Felt-Making*) .	99, 231
1600. **Alton Wood's Case** .	Coke's Rep., pt. i. 40 *b*. . .	261
1891. **Alliance Pure Lead Co. *v.* McIvor.**	8 R. P. C. 321 (*White Lead*) .	373, 383, 397
1887. **American Braided Wire Co. *v.* Thomson.**	4 R. P. C. 316; 5 R. P. C. 113, 375, 606; 7 R. P. C. 47, 152; 38 W. R. 329. (In the H. L.) 6 R. P. C. 518 (*Bundles*).	96, 114, 134, 401, 405, 413, 414, 427, 576, 591, 592

			PAGE
1852.	Amies v. Kolsey . .	22 L. J. Q. B. 84; 16 Jur. 1047; 20 L. T. 115; 1 W. R. 54 (*Braid*).	378
1890.	Anderson's Application.	7 R. P. C. 323 (*Explosives*) .	253, 257, 569
1887.	Anderson v. Mackinnell's Application.	Griff. App. 23 (*Air Currents*).	252
1886.	Anderson v. Pat. Oxonite Co.	3 R. P. C. 279 (*Blasting*) . .	358
1886.	Anderton's Application.	Griff. App. 25 (*Spinning-Frames*).	255, 256
1892.	Andrew v. Crossleys .	9 R. P. C. 165 (*Gas-Motors*) .	224
1886.	Anglo-American Brush Co. v. Crompton.	4 R. P. C. 27; 34 Ch. D. 152; 56 L. J. Ch. 167; 55 L. T. 722 (*Dynamos*).	373
1785.	Arkwright v. Nightingale.	D. P. C. 37; 1 W. P. C. 60 (*Spinning*).	157, 188
1871.	Arnold v. Bradbury .	L. R. 6 Ch. 706; 24 L. T., N.S., 613; 19 W. R. 817 (*Frills and Ruffles*), *Wright v. Hitchcock*.	53, 197
1887.	Arnold's Patent . .	Griff. App. 5 (*Steam Boilers*).	219
1886.	Ashworth's Patent .	Griff. App. 6 (*Cards*) . . .	220, 224
1890.	Ashworth v. Law . .	7 R. P. C. 86, 231; 9 R. P. C. 194 (*Carding*).	280, 289, 410, 581
1890.	Ashworth v. Roberts.	9 R. P. C. 62; W. N. 1890, 154 (*Wire-Tempering*).	211
1889.	Atherton's Application.	6 R. P. C. 547 (*Felt Hats*) .	251
1892.	Automatic Weighing Machine Co. v. N. Exhibitions Association.	8 R. P. C. 345; 9 R. P. C. 41 (*Weighing Machines*).	292, 296
1889.	Automatic Weighing Machine Co. v. Combined Weighing Machine Co.	6 R. P. C. 120, 367 (*Weighing Machines*).	296, 394, 397, 410, 413
1889.	Automatic Weighing Machine Co. v. International Hygienic Society.	6 R. P. C. 475 (*Weighing Machines*).	296, 407
1889.	Automatic Weighing Machine Co. v. Knight.	6 R. P. C. 113, 297; W. N. 1888, 250; 5 T. R. 359 (*Weighing Machines*).	50, 208, 296, 370, 406, 579
1880.	Aveling v. Maclaren .	17 Ch. D. 139 (n.)	375
1887.	Avery's Patent . .	36 Ch. D. 307; 4 R. P. C. 152, 322; 56 L. J. Ch. 526, 1007; 35 W. R. 541; 36 W. R. 249 (*Generating Gas*).	233, 425

		PAGE
1874. **Axman** *v.* **Lund** . .	18 Eq. 330; 43 L. J. Ch. 655; 22 W. R. 789; 31 L. T., N.S., 119 (*Brooches*).	288, 415
1839. **Bacon** *v.* **Jones**. . .	4 My. & Cr. 433 (*Gas Lamps*).	353
1839. **Bacon** *v.* **Spottiswoode**	1 Beav. 382 (*Gas-Burners*) .	399
1868. **Badham** *v.* **Bird** . .	5 R. P. C. 238 (*Sewer Manholes*).	141, 387, 413
1889. **Badische Anilin Fab.** *v.* **Dawson.**	6 R. P. C. 387 (*Aniline Dyes*)	114
1883. **Badische Anilin Fab.** *v.* **Levinstein.**	24 Ch. D. 156; 29 Ch. D. 366; 52 L. J. Ch. 704; 48 L. T., N.S., 522; 31 W. R. 913; 2 R. P. C. 73, 143. (In H. L.) 12 App. C. 710; 2 R. P. C. 91: 4 R. P. C. 449 (*Aniline Dyes*).	46, 52, 67, 136, 153, 187, 190, 211, 389, 412, 590
1886. **Bailey's Patent** . .	1 R. P. C. 1 (*Registering Figures*).	240
1886. **Bailey's Patent** . .	Griff. 269 (*Locks*)	250
1887. *Re* **Bailey**	Good. Prac. Cas. 57 . . .	251
1878. **Bailey** *v.* **Roberton** .	L. R. 3 App. Cas. 1055; 38 L. T., N.S., 854; 27 W. R. 17 (*Preserving Meat*).	87, 147, 170, 184, 301
1886. **Baillie** *v.* **Goodwin** .	3 R. P. C. 283 (*Corrugated Plates*).	331
1810. **Bainbridge** *v.* **Wigley**	Parl. Rep., 1829, 197; 10 Rep. Arts. 127; 1 C. P. C. 270 (*Flutes*).	163, 214
1876. **Baird** *v.* **Moule**. . .	17 Ch. D. 132 (n.) (*Earth Closets*).	360, 375
1888. **Bairstow's Application.**	5 R. P. C. 286 (*Velvet*) . .	247, 250
1892. **Baker** *v.* **Kinnell** . .	9 R. P. C. 441 (*Hot-Water Coils*).	133
1893. **Baker** *v.* **Kinnell** . .	10 R. P. C. 441	576, 578, 582
1862. **Bakewell's Patent** .	15 Moo. P. C. C. 385 (*Electric Telegraphy*).	337
1879. **Ball's Patent** . . .	L. R. 4 App. Cas. 171; 48 L. J. P. C. 24 (*Sheep Shears*).	332
1881. **Ball** *v.* **Lelm** . . .	Times, April 14, 1881 (*Copying Machine*).	407
1875. **Bamlett** *v.* **Plokaloy** .	Griff. 49 (*Mowing Machines; Making Iron Tubes by Squeezing like Macaroni*).	57, 94, 103

		PAGE
1823. Barber *v.* Walduck .	1 C. P. C. 438; 1 W. P. C. 126 (*Hats*).	220
1847. Barber *v.* Graco . .	1 Ex. 330; 17 L. J. Ex. 122 (*Hot-Pressing Cloth*).	212
1823. Barker *v.* Shaw . .	1 C. P. C. 438; 1 W. P. C. 126 (*Hats*).	231
1881. Barnett *v.* Barrett's Screw-stopper Co.	1 R. P. C. 9 (*Bottle Stoppers*).	419, 593
1884. Barney *v.* U. Telephone Co.	28 Ch. D. 394; 2 R. P. C. 173; 33 W. R. 576 (*Telephones*).	418
1876. Barrett *v.* Vernon .	25 W. R. 343; 35 L. T., N.S., 755 (*Bottle Stoppers*).	301
1836. Bate's Patent . . .	1 W. P. C. 739 (n.) (*Hydrometers*).	341
1856. Bateman *v.* Gray . .	22 L. J. Ex. 290; M. P. C. 93; 1 C. L. Rep. 512 (*Valves*).	303
1854. Bateman's Patent .	M. P. C. 116 (*Water Valves*) .	222
1869. Bates *v.* Redgate . .	L. R. 4 Ch. 577; 38 L. J. Ch. 501; 21 L. T., N.S., 410.	253
1871. Batley *v.* Kynoch . .	L. R. 19 Eq. 229; 20 Eq. 632; 44 L. J. Ch. 89; 31 L. T., N.S., 573 (*Cartridges*).	363, 364, 389, 403
1849. Baxter's Patent . .	13 Jur. 593 (*Colour-Printing*).	346
1850. Baxter *v.* Coombe . .	1 Ir. Ch. R. 284; 3 Ir. Ch. R. 245 (*Dressing Flax*).	353
1887. Beanland's Patent .	4 R. P. C. 489; 4 T. R. 30 (*Window Fasteners*).	334, 336, 343
1846. Beard *v.* Egerton . .	3 C. B. 97; 8 C. B. 165; 15 L. J. C. P. 270; 10 Jur. 643; 19 L. J. C. P. 36; 13 Jur. 1004 (*Photography*).	165, 189, 192, 194, 232
1815. Beaumont *v.* George .	1 C. P. C. 294; 27 Rep. Arts, 2nd Series, 252 (*Refining Sugar*).	359
1886. Beck & Justice's Patent.	Griff. App. 10 (*Steam Nozzles*)	224
1820. Beeston *v.* Ford . .	2 Corp. Ch. C. 58	352
1887. Bell's Patent . . .	Griff. App. 10 (*Matches*). . .	219, 227
1840. Bell's Patent (*In re*) .	10 Jur. 363; 2 W. P. C. 100 (*Lucifer Matches*).	332
1886. Bell & Colman's Patent.	Griff. 320	423
1892. Benno Jaffé *v.* Richardson & Co.	10 R. P. C. 136 (*Making Fat*)	385, 586
1814. Bentley *v.* Fleming .	1 C. & R. 587; 1 C. B. 479 (*Cards*).	143

		PAGE
1844. Bentley v. Keighley .	13 L. J. C. P. 167; 7 M. & G. 953; 8 Scott N. R. 372 (*Cards*).	366
1875. Berdan's Patent . .	L. R. 20 Eq. 346; 44 L. J. Ch. 544.	226
1881. Bergman v. Macmillan.	17 Ch. D. 423; 20 W. R. 690 (*Buttons and Umbrellas*).	358, 399
1804. Bernard c. Levinstein	10 L. T., N.S., 177 (*Purple Dye*).	352
1850. Berry's Patent. . .	7 Moo. P. C. C. 187 (*Cleansing Wheat*).	329
1872. Betts v. Cleaver . .	L. R. 7 Ch. 513; 41 L. J. Ch. 653.	403
1860. Betts v. Clifford . .	1 J. & H. 74	406
1862. Bett's Patent . . .	1 Moo. P. C. C., N.S., 49; 9 Jur., N.S., 137; 11 W. R. 221; 7 L. T., N.S., 677 (*Lead Capsules for Wine Bottles*).	101, 322, 335, 340, 341, 343, 348
1864. Betts v. De Vitre . .	34 L. J. Ch. 289; 11 L. T., N.S., 445, 533; 5 N. R. 165. (*Lead Capsules for Wine Bottles*).	154, 155
1868. „ „ . .	L. R. 3 Ch. 429; 37 L. J. Ch. 325.	324, 360
1873. „ „ . .	L. R. 6 H. L. 319; 21 W. R. 705.	398, 429
1857. Betts v. Menzies . .	3 Jur., N.S., 357	352
1859. „ „ . .	8 E. & B. 937; 1 Ell. & Ell. 980; 28 L. J. Q. B. 361.	143
1862. „ „ . .	10 H. L. C. 117; 31 L. J. Q. B. 233; 7 L. T., N.S., 110.	140, 154, 156, 396
1865. Betts v. Neilson . .	3 De G. J. & S. 22; 34 L. J. Ch. 537; 13 W. R. 804; 6 N. R. 221; 11 Jur., N.S., 679; 81 L. T., N.S., 710.	154, 324
1868. „ „ . .	L.R. 3 Ch. 429; 37 L. J. Ch. 321; 18 L. T., N.S., 159.	157, 318, 400
1871. „ „ . .	L. R. 5 H. L. 1; 40 L. J. Ch. 317.	152, 198, 211, 379, 398
1850. Betts v. Walker . .	14 Q. B. 363	366
1870. Betts v. Wilmot . .	18 W. R. 946; L. R. 6 Ch. 239	408
1871. „ „ . .	L. R. 6 Ch. 239; 25 L. T., N.S., 188; 19 W. R. 369.	321, 389
1856. Bewley v. Hancock .	6 De G. M. & G. 391; 2 Jur., N.S., 289 (*Gutta Percha*).	100
1838. Bickford v. Skewes .	1 W. P. C. 211; 1 Q. B. 938; 10 L. J. Q. B. 302; 1 W. P. C. 214 (*Safety Fuses*).	168, 169, 204, 212, 352, 396
1891. Billington v. Hill .	8 R. P. C. 332 (*Bottle Cleaning*).	411

		PAGE
1875. **Binney** *v.* **Foldtman** .	Griff. 49 (*Stuffing Boxes*).	213
1883. **Birch** *v.* **Mathar** . .	L. R. 22; Ch. D. 629; 52 L. J. Ch. 202.	306, 383
1568. **Bircot's Case** . . .	1 W. P. C. 31; Year Book, 15 Eliz. 4, Easter Term.	17, 50
1884. **Bischof's Patent** . .	1 R. P. C. 162 (*Purification of Water*).	342
1889. **Blakey** *v.* **Latham** . .	6 R. P. C. 29, 184; W. N. 1888, 126 (*Iron Plates for Boats*).	128, 370, 413, 427, 580
1850. **Blamoud's Patent** .	3 L. T., N.S., 809	226
1868. **Blank** *v.* **Footman** .	5 R. P. C. 661 (*Trimming for Corsets*).	413
1833. **Blofield** *v.* **Payne** . .	4 B. & Ad. 410.	430
1825. **Bloxam** *v.* **Elsee** . .	1 C. & P. 558; 1 C. P. C. 434 (*Paper Making*).	186, 201, 212, 231
1827. ,, ,, . .	6 B. & C. 169; 1 W. P. C. 132 (n.); 1 C. P. C. 440; 9 D. & R. 215 (*Paper Making*).	164, 198, 213, 228, 252, 353, 396
1849. **Bodmer's Patent** . .	6 Moo. P. C. C. 468 (*Metal Tools*).	327, 328, 345, 347
1856. **Booth** *v.* **Kennard** . .	1 H. & N. 527; 2 H. & N. 84; 26 L. J. Ex. 23, 305; 28 L. T. 160; 5 W. R. 85, 607 (*Making Gas from Seeds*).	53, 197
1880. **Boult's Patent** . .	10 R. P. C. 275 (*Cellulose*) .	251
1795. **Boulton** *v.* **Bull** . .	2 H. B. 463; D. P. C. 102; 1 C. P. C. 117 (*Fuel*).	9, 20, 41, 42, 52, 57, 58, 68, 187, 358
1865. **Bovill** *v.* **Crate** . .	L. R. 1 Eq. 388; Griff. App. 46 (*Flour Grinding*).	310, 353
1865. **Bovill** *v.* **Goodier** . .	L. R. 1 Eq. 35; 2 Eq. 195; 35 Beav. 264, 427; 35 L. J. Ch. 174, 432; 36 L. J. Ch. 360 (*Flour Grinding*).	150, 355, 363, 365, 377
1857. **Bovill** *v.* **Hoyworth** .	7 Ell. & Bl. 725; 5 W. R. 686; 29 L. T. 194; 3 Jur., N.S., 817 (*Flour Grinding*).	58, 101, 310
1845. **Bovill** *v.* **Moore** . .	2 Cop. 56 (n.); D. P. C. 361 (*Flour Grinding*).	66, 101, 202, 373
1856. **Bovill** *v.* **Pimm** . .	11 Ex. 718 (*Flour Grinding*)	300
1866. **Bovill** *v.* **Smith** . .	L. R. 2 Eq. 459; Griff. App. 40 (*Flour Grinding*).	310, 356, 366
1863. **Bovill's Patent** . .	1 Moo. P. C. C., N.S., 348 (*Flour Grinding*).	329
1853. **Bower** *v.* **Hodges** . .	13 C. B. 765; 22 L. J. C. P. 194; 1 C. L. R. 807 (*Iron Pipes*).	258

		PAGE
1831. **Bowman** *v.* **Taylor** .	2 A. & E. 278 (*Looms*) . .	279, 289
1889. **Bown** *v.* **Humber Co.** .	6 R. P. C. 9 (*Bicycles*). . .	286
1888. **Bown** *v.* **Sanson** . .	5 R. P. C. 510 (*Bicycles*) . .	382
1887. **Boyd** *v.* **Farrar** . .	5 R. P. C. 33; 57 L. T. 866 (*Winding Yarn*).	371, 372, 581, 585
1886. **Boyd** *v.* **Horrocks** . .	3 R. P. C. 285; 5 R. P. C. 557; 6 R. P. C. 152, 528; 9 R. P. C. 77 (*Winding Yarn*).	59, 311, 370, 371, 373, 390, 410, 579, 580, 584,
1890. **Bracher** *v.* **Bracher** .	7 R. P. C. 422 (*Hat Linings*).	351
1789. **Bramah** *v.* **Hardcastle**	1 C. P. C. 168; 1 W. P. C. 44 (*n.*) (*Water Closets*).	230
1884. **Brandon's Patent** . .	1 R. P. C. 154; 9 App. Cas. 589; 53 L. J. P. C. 84 (*Oils for Lighting*).	327, 349
1885. **Brauer** *v.* **Sharp** . .	*See* Sharp *v.* Brauer.	
1867. **Bray** *v.* **Gardner** . .	34 Ch. D. 668; 4 R. P. C. 40, 400; 5 R. P. C. 151; 56 L. J. Ch. 497; 35 W. R. 341 (*Boot Laces*).	152, 184, 198, 212, 217, 587,
1861. **Bronnaud's Patent** .	3 De G. F. & J. 695; 7 Jur., N.S., 690 (*Ornamental Lappets*).	246
1884. **Brereton** *v.* **Richardson**	1 R. P. C. 165 (*Tricycles*). .	141
1849. **Bridson** *v.* **Benecke** .	12 Beav. 1 (*Stretching Woven Fabrics*).	353
1845. **Bridson** *v.* **M'Alpine** .	8 Beav. 229.	351
1852. **Bridson's Patent** . .	7 Moo. P. C. C. 469 (*Stretching Woven Fabrics*).	330, 347
1884. **Briggs** *v.* **Lardeur** .	1 R. P. C. 126, 192; 2 R. P. C. 13 (*Printing Fabrics*).	352, 355, 360
1888. **Britain** *v.* **Hirsch** . .	5 R. P. C. 74, 226 (*Dancing Dolls*).	127, 198, 200, 367, 376, 428
1879. **British Dynamite Co.** *v.* **Krebs.**	1 Good. P. C. 88 (*Dynamite*) .	190, 199
1889. **British Tanning Co.** *v.* **Groth.**	7 R. P. C. 1; 8 R. P. C. 113 (*Electric Tanning*).	352, 355, 433
1857. **Brook** *v.* **Aston.** . .	8 El. & B. 478; 27 L. J. Q. B. 145; 23 L. J. Q. B. 175; 6 W. R. 42 (*Finishing Yarn*).	119
1849. **Brown** *v.* **Annandale** .	1 W. P. C. 433; 8 Cl. & F. 437	148
1816. **Brown** *v.* **Moore** . .	3 Swan. 264	373
1887. **Brown's Patent** . .	Griff. App. 1; 3 R. P. C. 212 (*Corks*).	167, 213
1889. **Brownhill's Application.**	6 R. P. C. 135 (*Gas-Meters*) .	255
1821. **Brunton** *v.* **Hawkes** .	1 C. P. C. 405; 4 B. & Ald. 541 (*Anchors*).	12, 59, 61, 75, 118, 178, 165, 201

		PAGE
1837. Bulnois *v.* Mackenzie	4 Bing. N. C. 127; 1 W. P. C. 260; 5 Scott, 419 (*Cabriolets*).	305
1858. Burgess *v.* Hately .	26 Beav. 249 (*Trade-Mark Case*).	409
1882. Burnett *v.* Tak . .	45 L. T., N.S., 743 (*Cube Sugar*).	415
1887. Burt *v.* Morgan . .	4 R. P. C. 278; 3 T. R. 660 (*Carriage-Springs*).	410
1854. Bush *v.* Fox . . .	M. P. C. 152, 166, 178; 23 L. J. Ex. 257; 5 H. L. C. 707; 25 L. J. Ex. 251 (*Caissons for Piers*).	41, 45, 88, 118, 212, 395
1661. Butler, Sir Oliver's Case.	3 Lev. 220	37
1890. C.'s Application . .	7 R. P. C. 250	241
1851. Caldwell *v.* Vanvlissengen.	21 L. J. Ch. 97; 9 Hare, 415; 16 Jur. 115 (*Screw-Propellers*).	315, 319, 323, 352
Calvert *v.* Ashburn .	John. 34; 7 Prac. Mech. Journal, 2nd Series, 97 (*March*).	120
1821. Campion *v.* Bonyon .	3 B. & B. 5; 6 B. Moo. 71 (*Making Canvas*).	163, 165
1871. Cannington *v.* Nuttall	L. R. 5 H. L. 205; 40 L. J. Ch. 739 (*Glass Furnaces*).	46, 52, 222, 313
1818. Card's Patent . . .	6 Moo. P. C. C. 207; 2 W. P. C. 161 (*Candle Wicks*).	350
1836. Cardwell's Patent .	10 Moo. P. C. C. 488 (*Cotton Presses*).	333
1889. Caroz's Application .	6 R. P. C. 552	433
1841. Carpenter *v.* Smith .	1 W. P. C. 530, 540; 9 M. & W. 300; 11 L. J. Ex. 213 (*Locks*).	59, 141, 148, 179, 292
Carpenter *v.* Walker	1 W. P. C. 268 (n.) (*Locks*) .	365
1854. Carpenter's Patent .	2 Moo. P. C. C., N.S., 191 (n.) (*Steering Vessels*).	346
1873. Carr's Patent . . .	L. R. 4 P. C. 539; 9 Moo. P. C. C., N.S., 370 (*Manure*).	340
1884. Cartsburn Co. *v.* Sharp.	1 R. P. C. 181 (*Sugar-Making*)	180, 321, 388
1799. Cartwright *v.* Amatt	2 B. & P. 43; D. P. C. 240 .	277
1860. Cartwright *v.* Eamer	14 Veesy, 131, 136 . . .	12, 178.
1891. Cassella *v.* Levinstein	8 R. P. C. 473 (*Azo-Dyes*) .	190, 212, 364, 574
1887. Challender *v.* Royle .	4 R. P. C. 363; 36 Ch. D. 425; 56 L. J. Ch. 965; 57 L. T., N.S., 734; 36 W. R. 357 (*Top-Unions*).	416, 417, 418, 593

		PAGE
1864. Chambers *v.* Crichley	33 Beav. 374	279
1887. Chandler's Patent .	Griff. 270 (*Gas-Burners*) . .	255
1844. Chanter *v.* Dewhurst	12 M. & W. 823; 13 L. J. Ex. 198 (*Furnace*).	285
1845. Chanter *v.* Johnson .	14 L. J. Ex. 289; 14 M. & W. 408 (*Furnace*).	286
1838. Chanter *v.* Leese . .	4 M. & W. 295; 5 M. & W. 698; 9 L. J. Ex. 327; 1 H. & H. 224 (*Furnace*).	286
1893. Chartered Institute of Patent Agents *v.* Lockwood.	10 R. P. C. 167	236
1873. Chatwood's Patent .	L. R. 5 P. C. 88 (n.) . . .	340
1877. Cheavin *v.* Walker .	L. R. 5 Ch. D. 850; 46 L. J. Ch. 265 (*Fillers*).	228
1864. Cheeseborough's Patent.	Grill. 303 (*Electric Lamps*) .	220, 221
1888. Cheetham *v.* Oldham	5 R. P. C. 617, 624; 7 R. P. C. 116; 8 R. P. C. 168 (*Felt Hats*).	142, 147, 363, 380, 574
1874. Chevasse *v.* Stevens .	W. N. 1874, 193 (*Ice Safes*) .	277
1883. Child's Patent . . .	John. 214 (*Bread*) . . .	342
1857. Chollet *v.* Hoffman .	7 Ell. & Bl. 686; 26 L. J. Q. B. 249; 5 W. R. 573; 29 L. T. 158 (*Preserved Vegetables*).	268, 359, 366
1886. Church's Patent . .	3 R. P. C. 95 (*Steam-Engines*)	323, 332, 335, 345, 348
1886. Church's Engineering Co. *v.* Wilson.	3 R. P. C. 123 (*Steam-Engines*)	363, 365, 575
1851. Claridge's Patent . .	7 Moo. P. C. C. 394 (*Asphalte*).	329
1873. Clark *v.* Adie . . .	21 W. R. 256, 704; 24 W. R. 1007; 26 W. R. 45; L. R. 3 Ch. D. 134, 141; 10 Ch. App. 667; 2 App. Cas. 315, 423; 45 L. J. Ch. 228; 46 L. J. Ch. 585; 33 L. T., N.S., 295, 923; 35 L. T., N.S., 349; 37 L. T., N.S., 1 (*Horse Clippers*).	99, 182, 198, 200, 202, 206, 211, 287, 289, 305, 310, 395
1870. Clark's Patent. . .	L. R. 3 P. C. 421; 7 Moo. P. C. C., N.S., 255 (*Floating Docks*).	338
1881. Clark *v.* Bradlaugh .	L. R. 8 Q. B. D. 63 . . .	38
1615. Clothworkers of Ipswich Case.	Godbolt, 252	19
1830. Cochrane *v.* Braithwaite.	1 C. P. C. 493; 3 Lond. Jour. 42 (*Steam-Boilers*)	293

		PAGE
1816. Cochrane v. Smethurst.	1 Stark. 205; D. P. C. 354 (*Lighting Cities*).	163
1885. Cocking's Patent . .	2 R. P. C. 151 (*Making Splints*).	335, 343
1884. Codd v. Brathy . .	1 R. P. C. 209	218
1884. Codd's Patent . . .	Griff. 305	218
1843. Colbourn v. Sims .	2 Hare, 543.	409
1888. Colo v. Saqui . . .	5 R. P. C. 489; 6 R. P. C. 41; 40 Ch. D. 132; 58 L. J. Ch. 237; 59 L. T. 877; 37 W. R. 109 (*Dancing Dolls*).	127, 135, 321, 372, 400, 410
1839. Collard v. Allison .	4 My. & C. 487	352
1888. Colley v. Hart . . .	6 R. P. C. 17; 7 R. P. C. 101; 44 Ch. D. 179; 59 L. J. Ch. 308 (*Toilet Paper*).	416, 418, 593
1834. Collings v. Bowman	1 W. P. C. 294 (*Looms*) . .	289
1851. Cook & Wheatstone's Patent.	38 Lond. Jur. 223 . .	327
1843. Cook v. Pearce . .	12 L. J. Q. B. 187; 13 L. J. Q. B. 189; 8 Q. B. 1044; 7 Jur. 764 (*Carriages*).	163, 165
1886. Cooper & Ford's Patent.	Griff. 275 (*Knitting-Machines*)	255
1880. Cooper v. Whittingham.	L. R. 15 Ch. D. 501 (*Copyright Case*).	409
1862. Copeland v. Webb .	11 W. R. 134; 1 N. R. 110 (*Blasting Cartridges*).	355
1835. Cornish v. Keene . .	1 W. P. C. 501; 2 C. P. C. 314; 6 L. J. C. P. 225 (*Weaving Elastic Goods*).	69, 139, 147, 292, 396
1837. Cornish v. Keene . .	3 Bing. N. C. 588; 6 L. J. C. P. 225; 1 W. P. C. 501; 2 C. P. C. 371 2 Hodg. 294 (*Wearing Elastic Goods*).	98, 212, 230, 319, 389, 395
1870. Cornish v. Stubbs . .	L. R. 5 C. P. 334	287
1884. Couchman v. Greener	1 R. P. C. 197 (*Breach-Loading Guns*).	211, 299
1888. Crampton v. Patent Investments Co.	5 R. P. C. 382; 6 R. P. C. 287 (*Electric Bells*).	171, 414, 416
1886. Crampton v. Swete.	56 L. T. 516	416
1842. Crane v. Price . . .	1 W. P. C. 393; 4 M. & G. 580; 12 L. J. C. P. 81; 2 C. P. C. 669 (*Hot Blast*).	41, 57, 59, 96, 99
1850. Croll v. Edge . . .	9 C. B. 479; 19 L. J. C. P. 261 (*Gas-Meters*).	165
1828. Crompton v. Ibbotson	1 W. P. C. 83; C. P. C. 460 (*Paper*).	103
1887. Crompton v. Anglo-American British Co.	4 R. P. C. 197; 56 L. J. Ch. 862; 35 Ch. D. 283 (*Dynamos*).	374, 584, 586

		PAGE
1884. Cropper v. Smith . .	24 Ch. D. 305; 26 Ch. D. 700; 28 Ch. D. 148; 10 App. Cas. 249; 1 R. P. C. 81, 254; 2 R. P. C. 17, 61; 53 L. J. Ch. 591; 54 L. J. Ch. 287; 55 L. J. Ch. 12; 33 W. R. 60, 753; 51 L. T., N.S., 729 (*Twist-Lace Machines*).	198, 200, 207, 217, 278, 280, 282, 290, 366, 397, 587
1829. Crossley v. Beverley	3 C. & P. 513; 1 W. P. C. 106, 112, 119; 9 B. & C. 63; 1 R. & M. 166 (*Gas*).	60, 62, 78, 94, 164, 187, 191, 211, 212, 401
1834. Crossley v. Derby Gas Co.	1 W. P. C. 119; 4 L. J. Ch. 25; 3 My. & Cr. 428 (*Gas-Meters*).	399, 400, 401
1863. Crossley v. Dixon . .	10 H. L. Cas. 293; 32 L. J. Ch. 617; 11 W. R. 716; 8 L. T., N.S., 260 (*Carpet Looms*).	285, 287, 289
1853. Crossley v. Potter .	M. P. C. 240 (*Carpet Looms*)	40, 68, 162,
1876. Crossley v. Tomey .	L. R. 2 Ch. D. 533 (*Water-Gauges*).	384
1889. Crossthwaite v. Steel	5 R. P. C. 220; 6 R. P. C. 190 (*Fire-Grates*).	286, 289
1884. Croysdale v. Fisher .	1 R. P. C. 17 (*Manure*) . .	90, 122, 141
1884. Cumming's Patent .	Griff. 277 (*Bracelet-Fastenings*).	252
1839. Curtis v. Cutts. . .	8 L. J. Ch. 184; 2 Coop. C. C. 60 (n.) (*Cards*).	352
1892. Curtis & André . .	9 R. P. C. 495	252
1863. Curtis v. Platt . . .	3 Ch. D. 136 (n.); L. R. 1 H. L. 337; 8 L. T., N.S. 657; 33 L. J. C. P. 2[illegible]5; 35 L. J. Ch. 852; 10 L. T., N.S. 383; 11 L. T., N.S., 245 (*Spinning-Mules.*)	213, 299, 316, 325, 363, 366, 377
1848. Cutler v. Bower . .	11 Q. B. 973; 17 L. J. Q. B. 217; 12 Jur. 721 (*Boiler-Flues*).	288
1850. Daglelish v. Jarvis .	2 Mac. & G. 231 (*Copyright*)	355
1872. Dalziel v. Railway Carriage and Steamboat Co.	L. R. 13 Eq. 358	415
1865. Dangerfield v. Jones .	13 L. T., N.S., 142 (*Making Walking-Stick Handles*).	102, 283
1885. Daniel's Application.	5 R. P. C. 413 (*Kettles*) . .	251

			PAGE
1891.	Darby's Patent . .	8 R. P. C. 380	339
1602.	Darcy v. Allin . . .	Noy. 173; 1 W. P. C. 1; 11 Co. Rep. 84 (*Playing Cards*)	17, 68
1869.	Darrah v. Purser . .	6 R. P. C. 365 (*Hose Connections*).	376
	Dart's Patent . . .	Griff. 307 (*Dynamos*) . . .	221, 243
1862.	Davenport v. Jopson .	1 N. R. 173, 307 (*Chenille*) .	353, 379
1865.	Davenport v. Goldberg.	3 N. R. 484; 2 Hem. & M. 283 (*Chenille*).	352
1860.	Davenport v. Richards	3 L. T., N.S., 503 (*Chenille*) .	352, 358
1865.	Davenport v. Rylands	L. R. 1 Eq. 302; 35 L. J. Ch. 204; 14 L. T., N.S., 63; 14 W. R. 243 (*Chenille*).	316, 320, 406
1886.	David's v. Woodley's Application.	Griff. App. 26 (*Sewing Machines*).	231, 248
1884.	Davis v. Foldtman .	1 R. P. C. 13, 193 (*Umbrellas*).	314
1887.	Davis v. Davis . . .	56 L. J. Ch. 481	414
1863.	Daw v. Eley . . .	L. R. 1 Eq. 38; 3 Eq. 496; 13 L. T., N.S., 399; 14 W. R. 48, 126; 36 L. J. Ch. 482 (*Cartridges*).	201, 315, 366, 370 401
1880.	Day v. Foster . . .	43 Ch. D. 435; 7 R. P. C. 54 (*Bottles*).	416, 418
1873.	De Vitre v. Betts . .	*See* Betts v. De Vitre.	
1887.	Deacon's Patent . .	4 R. P. C. 119; 3 T. R. 349 (*Water-Meters*).	327, 328, 339, 342
1857.	De la Rue v. Dickinson.	7 E. & B. 738; 5 W. R. 704; 29 L. T. 104; 3 K. & J. 286 (*Envelopes*).	310, 324, 364
1891.	Delta Metal Co. v. Maxim-Nordenfelt.	8 R. P. C. 169, 215 (*Alloys*) .	383, 384, 407, 579, 582
1851.	Denley v. Blore . .	35 Lond. Jour. 224 . . .	323, 360
1880.	Dering's Patent . .	L. R. 13 Ch. D. 393 (*Iron and Steel*).	253
1835.	Deroene v. Fairie . .	1 W. P. C. 154, 158; 1 Mo. & Rob. 457; 5 Tyr. 353; M. & R. 476 (*Sugar-Refining*).	164, 187, 193, 214, 359, 368
1844.	Deroene's Patent . .	4 Moo. P. C. C. 416; 2 W. P. C. 1 (*Sugar-Refining*).	328, 330, 334, 342
1890.	Deutsche Nähmaschinen Fabrik v. Pfaff.	7 R. P. C. 16, 251 (*Sewing Machines*).	135, 579
1880.	Dicks v. Brooks . .	L. R. 15 Ch. D. 39 (*Copyright*).	400
		8 R. P. C. 196	402
1891.	Dick v. Haslam . .	6 R. P. C. 297 (*Harps*) . .	255
1880.	Diehl's Patent . . .	L. R. 10 Q. B. 130; 1 Q. B. D. 384; 1 App. Cas. 662; 44 L. J. Q. B. 65, 617; 31 L. T., N.S., 138, 559; 24 W. R. 706, 142 (*Gun-Barrels*).	272, 323
1875.	Dixon v. London Small Arms Co.		

		PAGE
1849. Dobbs *v.* Fenn . . .	3 Ex. 427 (*Blind-Pulleys*).	118, 157
1758. Dollond *v.* Champness.	2 H. Bl. 469; 1 W. P. C. 43; D. P. C. 170; 1 C. P. C. 28 (*Achromatic Lenses*).	143, 230
1890. Dowling *v.* Billington	7 R. P. C. 191 (*Wearing Wire*).	114, 402
1885. Downes *v.* Falcon Engine & Car Works.	2 R. P. C. 197; 3 R. P. C. 70 (*Steam Engines*).	314
1839. Downton's Patent .	1 W. P. C. 555 (*Water-Closets*)	327, 336, 340, 346
1885. Drake *v.* Munts Metal Co.	3 R. P. C. 43 (*Making Tubes*)	380
1880. Driffield Linseed Cake Co. *v.* Waterloo.	3 R. P. C. 46; 31 Ch. D. 638; 55 L. J. Ch. 351; 54 L. T., N.S., 210 (*Feeding Cake*).	416, 419
1889. Drummond's Patent .	L. R. 43 Ch. D. 80; 59 L. J. Ch. 102; 6 R. P. C. 570.	425
1877. Dudgeon *v.* Thomson	L. R. 3 App. Cas. 34; 30 L. T., N.S., 244; 22 W. R. 464 (*Boiler Tubes*).	206, 222, 225, 262, 352, 373
1884. Duncan & Wilson's Patent.	1 R. P. C. 257; 1 T. R. 69 (*Folding Paper*).	341
1885. Dundon's Patent . .	Griff. 278	252
1859. Dunnicliffe *v.* Mallot	7 C. B., N.S., 209; 1 L. T., N.S., 514; 29 L. J. C. P. 70; 8 W. R. 260 (*Lace-Weaving*).	275, 358
1830. Duvergier *v.* Fellowes.	10 B. & C. 826; 1 C. & P. 39	263, 274
1812. Dyer, *Ex parte* . . .	Holroyd, 59; Parl. Rep. Pat. 1820.	253
1881. Eadon *v.* Starbruck Waggon Co.	W. N. (1881), 160 (*Tramcars*)	122
1885. Eadie's Patent . . .	Griff. 279 (*Wearing Travellers*).	249
1885. Easterbrook *v.* Great West. Railway Co.	2 R. P. C. 201; 3 R. P. C. 94 (*Railway Signals*).	48, 67, 71, 180, 196, 212, 414
1853. Eastern Archipelago Co. *v.* Reg.	2 E. & B. 892	10
1890. Edge's Patent . . .	W. N. (1890), 147 (*Wrapping up Blue*).	424
1891. Edge *v.* Harrison . .	8 R. P. C. 74 (*Wrapping up Blue*).	386, 424
1892. Edge *v.* Johnson . .	9 R. P. C. 142 (*Wrapping up Blue*)	405
1791. Edgebury *v.* Stevens .	1 W. P. C. 35	232
1887. Edison Electric Co. *v.* Shippey.	4 R. P. C. 471 (*Electric Lamps*).	377

		PAGE
1888. Edison *v.* Holland .	3 R. P. C. 395; 5 R. P. C. 459; 6 R. P. C. 243; 33 Ch. D. 497; 55 L. J. Ch. 943 (*Electric Glow-Lamps*).	65, 106, 125, 137, 140, 185, 190, 204, 205, 290, 313, 360, 383, 394, 396, 397, 400, 407, 413
1886. Edison *v.* Woodhouse	32 Ch. D. 520; 3 R. P. C. 167; 55 L. J. Ch. 943; 55 L. T. 263; 3 R. P. C. 183; 4 R. P. C. 70, 99 (*Electric Glow-Lamps*)	51, 105, 107, 190, 191, 194, 209, 412,
1881. Edison Telephone Co. *v.* India-Rubber Co.	17 Ch. D. 137; 20 W. R. 406 (*Telephones*).	366, 375
1887. Edison's Patent . .	Lawson, 64	220
1893. Edlin *v.* Pneumatic Tyre Agency.	10 R. P. C. 311, 317 . . .	403, 418
1889. Edmond's Patent . .	6 R. P. C. 355	387, 424
1886. Edmund's Patent . .	Griff. 281 (*Telephones*) . .	247, 248, 257
1887. Ehrlich *v.* Ihlee . .	4 R. P. C. 115; 5 R. P. C. 37, 198, 437; 7 R. P. C. 202; 56 L. T. 819 (*Hand-Organs*).	65, 73, 112, 135, 136, 154, 208, 363, 375, 390, 574, 580, 586
. Electric Telegraphic Co.'s Patent.	1 Moo. P. C. C., N.S., 346 .	328
1851. Electric Telegraph Co. *v.* Brett.	10 C. B. 838; 20 L. J. C. P. 123; 15 Jur. 579 (*Telegraphy*).	52, 60, 106, 358
1847. Electric Telegraph Co. *v.* Nott.	11 Jur. 273, 590; 4 C. B. 464; 16 L. J. C. P. 174; 2 Cop. 41 (*Telegraphy*).	352, 354, 363
1839. Elgie *v.* Webster . .	5 M. & W. 518 (*Trochometers*)	283
1849. Elias *v.* Gravesend Tin Plate Co.	7 R. P. C. 455	130, 141
1884. Elsan *v.* Williams . .	1 Times R. 144 (*Buttons*). .	402
1888. Ellington *v.* Clarke .	5 R. P. C. 135, 319; 58 L. T., N.S., 918 (*Hydraulic Lift*).	186, 211, 311, 413, 428
1810. Elliot *v.* Aston . . .	1 W. P. C. 222 (*Buttons*) . .	189, 395
1845. Elliot *v.* Turner . .	2 C. B. 446; 15 L. J. C. P. 49 (*Buttons*).	201, 213 396
1864. Ellwood *v.* Christy .	34 L. J. C. P. 130; 17 C. B., N.S., 754; 18 C. B., N.S., 494; 13 W. R. 54, 498; 11 L. T., N.S., 312; 10 Jur. N.S., 1079; 5 N. R. 12, 312 (*Hats*).	281

		PAGE
1869. Elmslie *v.* Boursier .	L. R. 9 Eq. 217; 39 L. J. Ch. 328; 18 W. R. 665 (*Tin-Foil*).	321
1891. Embossed Metal Co. *v.* Saupe.	8 R. P. C. 355 (*Embossing Metal*).	132
1835. Erard's Patent. . .	1 W. P. C. 557; 5 Rep. Arts., N.S., 56 (*Pianofortes*).	332, 334, 336, 337
1885. Evans & Otway's Patent.	Griff. 279 (*Steam-Engines*) .	225, 249
1883. Everitt's Application	Griff. App. 27, 28 (*Automatic Liquid Delivery for Coin Apparatus*).	243, 250, 432
1885. Fairburn *v.* Household.	1 R. P. C. 109; 2 R. P. C. 140, 195; 3 R. P. C. 128, 263 (*Tramcar-Engines*).	193, 202, 212, 397, 574
1891. Fairfax *v.* Lyons . .	8 R. P. C. 401 (*Mechanical Targets*).	132, 580
1891. Farben fabrik *v.* Bowker.	8 R. P. C. 136, 389; 10 R. P. C. 215 (*Dyes*)	117, 216, 225, 373, 374, 387, 389, 414
1891. Farben fabrik *v.* Dawson.	8 R. P. C. 397	353
1889. Fawcett's Patent . .	Goodeve's Patent Practice (1893), 10.	254
1865. Feather *v.* Reg. . .	6 B. & S. 257; 35 L. J. Q. B. 200; 12 L. T., N.S., 114 (*Ships*).	12, 178, 272
1829. Felton *v.* Greaves. .	3 C. & P. 611 (*Sharpening Knives*).	71, 164
1893. Fenner *v.* Wilson . .	10 R. P. C. 287 (*Shuttles*). .	355, 420, 5[illegible]
1889. Flechter's Application.	Griff. 284 (*Dust-Collecting*) .	257
1857. Finlay *v.* Allan . .	19 Dec. Ct. Sess., 2nd Ser., 1087 (*Fire-Grates*).	310
1874. Finnegan *v.* James .	L. R. 19 Eq. 72; 44 L. J. Ch. 185.	366
1838. Fisher *v.* Dewick . .	4 Bing. N. C. 706; 1 W. P. C. 264, 551 (n.); 7 L. J. C. P. 279; 6 Dow. 730; 6 Scott, 587 (*Lace*).	165, 365, 373, 374
1889. Fletcher's Application.	Griff. App. 30 (*Drying Paper*)	252
1887. Fletcher *v.* Arden . .	5 R. P. C. 46 (*Gas Cooking-Stoves*).	126
1893. Fletcher's Patent . .	10 R. P. C. 252	
1857. Fletcher *v.* Glasgow Gas Commissioners.	4 R. P. C. 356 (*Gas Cooking-Stoves*).	313, 409

		PAGE
1876. Flower *v.* Lloyd . .	6 Ch. D. 297; 10 Ch. D. 327 W. N. (1876) 71, 132; (1877) 71; 45 L. J. Ch. 746; 35 L. T., N.S., 454; 36 L. T., N.S., 444; 25 W. R., 17, 793 (*Printing Tin Plates*).	309, 311, 366, 379, 381
1855. Foardo's Patent . .	9 Moo. P. C. C. 376 (*Smoke-Prevention*).	334
1819. Forsyth's *v.* Riviere .	1 W. P. C. 97; 1 C. P. C. 401 (*Detonators*).	319
1892. Fountain Livet's Case.	9 R. P. C. 327 (*Steam-Boilers*)	331, 332, 338, 342 606
1886. Fowler *v.* Gaul . .	3 R. P. C. 247 (*Oil-Vessels*) .	371
1812. Fox, *Ex parte* . . .	1 W. P. C. 431; 1 V. & B. 67 (*Steam-Engines*).	201
1866. Fox *v.* Dollestable .	15 W. R. 194 (*Umbrella Ribs*).	60
1861. Foxwell *v.* Bostock .	4 De G. J. & S. 77, 298; 12 W. R. 94, 723; 9 L. T., N.S., 362, 528; 10 L. T., N.S., 144; 3 N. R. 103, 546 (*Sewing-Machines*).	50, 181, 189, 201, 222, 225
1863. Foxwell *v.* Webster .	4 De G. J. & S. 77 (*Sewing-Machines*).	362
1828. Fradelle *v.* Weller .	2 Russ. & M. 247 (*Copyright Case*).	400
1878. Frearson *v.* Loe . .	L. R. 9 Ch. D. 48; 26 W. R. 138; 27 W. R. 183 (*Screws*).	63, 104, 199, 318, 354, 381, 402
1887. Fraser *v.* Brescia Tram Co.	56 L. T., N.S., 771; 3 Times R. 587.	414
1885. Furness' Patent . .	2 R. P. C. 175 (*Lubricating Valves*).	340, 343
1887. Fusee Vesta Co. *v.* Bryant & May.	4 R. P. C. 71, 191; 34 Ch. D. 458; 37 Ch. D. 120; 56 L. J. Ch. 187; 56 L. T. 110, 136; 35 W. R. 267 (*Matches*).	218, 225, 227, 410
1892. Gadd *v.* Mayor of Manchester.	9 R. P. C. 249 (*Gas-Holders*) .	176, 579
1891. Gale's Patent . . .	8 R. P. C. 438 (*Tube-Joints*) .	424
1839. Galloway *v.* Bleadon .	1 W. P. C. 521, 538 (n.) (*Propelling-Vessels*).	150, 158, 185, 188, 365, 388

		PAGE
1843. **Galloway's Patent** .	1 W. P. C. 724; 7 Jur. 453; (*Steam-Engines*).	328, 336, 340, 341,
1846. **Gamble** *v.* **Kurtz** . .	3 C. B. 425 (*Sulphate of Soda, etc.*).	293
1885. **Gandy** *v.* **Reddaway** .	2 R. P. C. 49 (*Machine Belting*).	190, 194,
1856. **Gardner** *v.* **Broadbent**	4 W. R. 764; 2 Jur. N.S., 1041 (*Saddle-Covers*).	354, 355
1884. **Garo's Patent** . . .	L. R. 26 Ch. D. 105 . . .	226
1889. **Garrard** *v.* **Edge** . .	6 R. P. C. 372, 563; 44 Ch. D. 224; 58 L. J. Ch. 397; 59 L. J. Ch. 379; 60 L. T., N.S., 557; 62 L. T., N.S., 510; 37 W. R. 501; 38 W. R. 455 (*Tile-Making*).	311, 381
1886. **Garthwaite's Patent** .	Griff. 284 (*Dog-Feed*) . . .	249
1846. **Geary** *v.* **Norton** . .	1 De G. & S. 9 (*Registered Design*).	316
1884. **Germ Milling Co.** *v.* **Robinson.**	1 R. P. C. 217; 8 R. P. C. 11, 254, 309; 55 L. J. Ch. 287; 53 L. T., N.S., 696; 34 W. R. 194 (*Meal-Flour*).	145, 363, 380, 381, 576, 589
1841. **Gibson** *v.* **Brand** . .	1 W. P. C. 627; 11 L. J. C. P. 177; 4 M. & G. 179 (*Spinning Silk Waste*).	12, 41, 45, 53, 140, 178, 186, 198, 320, 323
1839. **Gillett** *v.* **Wilby** . .	9 C. & P. 334; 1 W. P. C. 270 (*Carriages*).	292, 365
1884. **Glossop's Patent** . .	Griff. 285 (*Steam-Hammers*) .	219, 250
1888. **Gosnell** *v.* **Bishop** .	5 R. P. C. 41, 151; 4 T. R. 397 (*Trouser-Stretchers*).	35, 137, 300
1865. **Goucher** *v.* **Clayton** .	34 L. J. Ch. 239; 13 L. T., N.S., 115; 11 Jur., N.S., 462 (*Threshing-Machines*).	322
1865. **Goucher's Patent** . .	2 Moo. P. C. C., N.S., 532 (*Threshing Corn*).	345
1887. **Goulard & Gibbs' Patent.**	5 R. P. C. 189, 525; 6 R. P. C. 215; 7 R. P. C. 367; 34 Ch. D. 396; 56 L. J. Ch. 606; 57 L. J. Ch. 209; Griff. 320 (*Electric Transformers*).	127, 135, 172, 217, 218, 225, 423, 425, 576, 579, 582, 583
1887. **Goulard & Gibbs** *v.* **Lindsay.**	4 R. P. C. 189; 5 R. P. C. 192; 38 Ch. D. 38; 56 L. T. 506; 57 L. J. Ch. 687 (*Electric Transformers*).	217, 419
1888. **Gosney's Application**	5 R. P. C. 597 (*Weight and Height Machine*).	252
1881. **Grafton** *v.* **Watson** .	51 L. T., N.S., 141 (*Trade-Mark*).	414
1892. **Graham** *v.* **Fanta** . .	9 R. P. C. 164	255

		PAGE
1812. Granger, *Ex parte* . .	Godson P. 2nd Ed. 225 . .	282
1857. Groon's Patent . .	24 Beav. 145 (*Casks*) . . .	268
1886. „ „ . .	Griff. 286 (*Fuel*)	250, 254,
1885. Greer *v.* Bristol Tanning Co.	2 R. P. C. 268 (*Tanning*) .	353
1890. Granfell & McEvoy's Patent.	7 R. P. C. 131 (*Fire-Arms*) .	243
1888. Griffin's Application .	6 R. P. C. 296 (*India-Rubber*).	248
1889. Griffin *v.* Feaver . .	6 R. P. C. 396	128
1862. Grover & Baker Sewing Machine Co *v.* Millard.	8 Jur., N.S., 713 (*Sewing-Machines*).	269
1870. Grover *v.* Wilson , .	W. N. (1870) 78 (*Sewing-Machines*).	366
1888. Guest & Barrow's Patent.	5 R. P. C. 312 (*Velocipedes*). .	252
1886. Guilbert Martin *v.* Kerr.	4 R. P. C. 18; 3 T. R. 87 (*Steam Gauge-Glasses*).	144, 412
1885. Haddan's Patent . .	Griff. App. 12; 54 L. J. Ch. 126; 2 R. P. C. 218 (*Baby's Food*).	220, 227, 424, 425, 578
1822. Hall *v.* Boot & Jarvis.	1 W. P. C. 100; 1 C. P. C. 423 (*Singeing Lace*).	75, 97
1857. Hall *v.* Conder . .	2 C. B., N.S., 22, 53; 26 L. J. C. P. 138, 288; 5 W. R. 491; 3 Jur., N.S., 360, 963 (*Boilers*).	278
1888. Hall, *In re*	21 Q. B. D.; 5 R. P. C. 307; 57 L. J. Q. B. 494; 59 L. T. 37; 36 W. R. 892 (*Refrigerators*).	216, 218
1888. Hall & Hall's Patent.	5 R. P. C. 283 (*Leather*) . .	252
1885. Hall *v.* Trueman . .	L. R. 29 Ch. D. 307 . . .	383
1881. Halsey *v.* Brotherhood.	19 Ch. D. 386; 51 L. J. Ch. 233; 45 L. T. 640 (*Engines*).	415
1887. Hampton & Facer's Patent.	Griff. App. 13 (*Casting Steel Ingots*).	219, 255
1852. Hancock *v.* Moulton .	Johnson's Pat. Manual, 3rd Ed. 208; Monthly Digest, 506 (*Caoutchouc*).	304, 352
1851. Hancock *v.* Somervell	39 Newton's Lond. Jour. 158.	142, 148

		PAGE
1843. **Hardy's Patent** . .	6 Moo. P. C. C. 441; 13 Jur. 177 (*Axle-Trees*).	342, 346
1803. **Hare** *v.* **Taylor**. . .	1 W. P. C. 252 (*Brewing*) .	280
1809. **Harmar** *v.* **Playne**. .	11 East. 101; D. P. C. 311 (*Raising a Shag on Woollen Cloths*).	60, 179, 188
1807. **Harmer** *v.* **Plane** . .	14 Vesey, 130 (*Woollen Cloths*)	39, 351, 352
1886. **Harris** *v.* **Rothwell** .	3 R. P. C. 243, 383; 4 R. P. C. 225; 35 Ch. D. 426; 3 T. R. 553; Griff. 109; 56 L. J. Ch. 459; 56 L. T. 5, 52; 35 W. R. 581 (*Knitting-Machines*).	157, 158, 159, 371, 372, 591
1853. **Harrison's Patent** .	M. P. C. 31 (*Railway Turning-Table*).	220
1853. **Harrison** *v.* **Spiro** . .	22 L. T. 92	378
1876. **Harrison** *v.* **Anderston Foundry Co.**	2 Sc. L. R. 4th Ser., 857; L. R. 1 App. Cas. 574 (*Loom-Weaving*).	181, 196, 205, 307
1777. **Hartley's Case**. . .	2 H. Bl. 493; 1 W. P. C. 55 (*Fire-Proof Buildings*).	44, 333
1860. **Harwood** *v.* **Great North. Rail Co.**	11 H. L. C. 654; 29 L. J. Q. B. 193; 31 L. J. Q. B. 198; 35 L. J. Q. B. 27; 6 L. T., N.S., 90; 12 L. T., N.S., 771; 10 W. R. 422; 14 W. R. 1 (*Joints for Rails*).	119
1867. **Haslam** *v.* **Hall** . .	4 R. P. C. 203; 5 R. P. C. 1, 144; 20 Q. B. D. 491; 57 L. J. Q. B. 352; 59 L. T. 102; 36 W. R. 407 (*Refrigerators*).	112, 152, 217, 363, 364, 382, 403, 405, 574
1887. **Haslam** *v.* **Goodfellow**	5 R. P. C. 28; 57 L. J. Ch. 245; 57 L. T. 788; 37 Ch. D. 118 (*Refrigerators*).	218, 587, 589
1891. **Heslett** *v.* **Hutchinson**	8 R. P. C. 457 (*Electric Motors*).	237
1870. **Hassall** *v.* **Wright** .	L. R. 10 Eq. 500; 40 L. J. Ch. 145; 18 W. R. 621	268, 350
1853. **Hastings** *v.* **Brown** .	22 L. J. Q. B. 161; 1 E. & B. 450; 17 Jur. 647 (*Windlass*).	186, 201, 213
1885. **Hatfield's Patent** . .	Griff. 288	254
1834. **Haworth** *v.* **Hardcastle**.	1 W. P. C. 480; 3 L. J. C. P. 311; 1 Bing. N. C. 182; 4 M. & Sc. 720 (*Drying Calicos*).	72, 187, 204
1886. **Haydock** *v.* **Bradbury**	4 R. P. C. 74 (*Springs for Shuttle Pegs*).	407
1789. **Hayne** *v.* **Maltby** . .	3 Ter. R. 438; D. P. C. 156 (*Point Net*).	280

		PAGE
1890. Haythornethwaite's Patent.	7 R. P. C. 70 (*Automatic Sprinklers*).	250
1881. Hayward v. Hamilton	Griff. 121 (*Pavement Lights*) .	96, 104
1884. Hayward v. Pavement Light Co.	1 R. P. C. 207 (*Pavement Lights*).	298, 353
1872. Healey's Application	John. 165	232
1891. Heald's Patent . .	8 R. P. C. 429 (*Gas Lamps*) .	231
1889. Heap v. Hartley . .	5 R. P. C. 603; 6 R. P. C. 495; 42 Ch. D. 461; 58 L. J. Ch. 790; 41 L. T. 536; 38 W. R. 136; 5 T. R. 710 (*Gig Mills*).	260, 270, 284, 321, 350
1886. Hearnor's Patent . .	Griff. 266 (*Water Heating*) .	219, 241
1884. „ „ . .	1 R. P. C. 213; Griff. 309 (*Pen-Holders*).	218, 220, 568
1886. Heath & Frost's Patent.	Griff. 311 (*Blasting*) . . .	219, 223, 250
1853. Heath's Patent . .	2 W. P. C. 247.	327, 335, 337, 339, 340
1854. Heath v. Smith . .	3 Ell. & Bl. 256; 2 C. L. R. 1584; 1 W. P. C. 551; 2 W. P. C. 268; L. J. Q. B. 166; 18 Jur. 601 (*Making Steel*).	145, 253, 335
1842 Heath v. Unwin . . (a) 1852.	10 M. & W. 684; 13 M. & W. 583; 1 W. P. C. 551; 2 W. P. C. 216, 236; 2 D., N.S., 482; 12 L. J. Ex. 46; 14 L. J. Ex. 153; 16 L. J. Ch. 283; 22 L. J. C. P. 7; 12 C. B. 522. (In H. of Lords) 5 H. L. Cas. 505; 16 C. B. 713; 25 L. J. C. P. 8.	141, 187, 192, 196, 198, 211, 301, 316, 366
1883. Henderson v. Clippon's Oil Co.	8 App. Cas. 873; 20 Scot. L. Rep. 423.	311
1872. Henry, *Ex parte*.	L. R. 8 Ch. 167; 42 L. J. Ch. 363 (*Breech Loaders*).	253
1867. Herbert's Patent . .	L.R. 1 P.C. 309; 4 Moo. P.C.C., N.S., 300 (*Mooring Buoys*).	337, 345
1889. Herrburger v. Squire .	5 R. P. C. 581; 6 R. P. C. 194 (*Pianofortes*).	129, 158, 418, 419
1803. Hesse v. Stevenson .	3 B. & P. 565; D. P. C. 244 (*Straw Paper*).	281, 282
1889. Hetherington, re . .	7 R. P. C. 419 (*Grinding Carding Engine Flats*).	257
1877. Hough v. Chamberlain.	25 W. R. 742 (*Frilling Machines*).	288
1877. Hough v. Magill . .	W. N. (1877) 62	353
1836. Hourteloup's Patent .	1 W. P. C. 553 (*Fire-Arms*).	158, 350

		PAGE
1891. Hoyes v. Hallmark .	9 R.P.C. 27 (*Window Weights*).	132, 410
1858. Higgs v. Goodwin .	Ell. Bl. & Ell. 529; 27 L. J. Q. B. 421; 5 Jur., N.S., 97 (*Sewage Utilisation*).	318
1892. Higgins' Patent . .	9 R. P. C. 74 (*Type Setting*) .	247
1888. Hill's Application .	5 R. P. C. 599 (*Wire Ropes*) .	250, 251, 255, 569
1863. Hill's Patent . . .	1 Moo. P. C. C., N.S., 258; 9 L. T., N.S., 101; 12 W. R. 25; 9 Jur., N.S., 1200.	340, 341, 347
1893. Hill v. Adams . . .	10 R. P. C. 102 (*Skylights*) .	367, 369
1817. Hill v. Thompson . .	1 W. P. C. 229, 235; 1 C. P. C. 377; 3 Mer. 622; 8 Taunt. 375; 2 B. Moo. 424 (*Iron Smelting*).	10, 12, 57, 59, 61, 62, 147, 157, 179, 198, 293, 300, 352, 354, 396
1891. Hill v. Tombs . . .	John. 82; Lawson 490 (*Frilling Machine*).	381
1862. Hills v. Evans . . .	4 De G. F. & J. 288; 31 L. J. Ch. 457; 8 Jur., N.S., 525; 6 L. T., N.S., 90 (*Gas Purification*).	101, 140, 151, 396
1853. Hills v. Laming . .	9 Ex. 256; 23 L. J. Ex. 60 (*Gas Purification*).	288
1862. Hills v. Liverpool Gas Co.	32 L. J. Ch. 28; 9 Jur., N.S., 140; 7 L.T., N.S., 537 (*Gas Purification*).	304
1857. Hills v. London Gaslight Co.	27 L. J. Ex. 401 20 L. J. Ex. 409; 5 H. & N. 312 (*Gas Purification*).	10, 52, 101, 146, 166, 1[illegible] 213
1885. Hindo v. Osborn . .	1 R. P. C. 221; 2 R. P. C. 45, 64 (*Hair Curling*).	377, 427
1876. Hinks v. Safety Lighting Co.	L. R. 4 Ch. D. 607; 46 L. J. Ch. 185; 36 L. T., N.S., 391 (*Lamps*).	95, 96, 103, 190, 196, 205
1887. Hocking v. Hocking .	3 R. P. C. 291; 4 R. P. C. 255, 434; 6 R. P. C. 69 (*Steam Condensers*).	210, 279, 300, 367, 375, 581
1885. Hocking v. Fraser .	3 R. P. C. 3 (*Heating Water*).	405, 412, 573
1869. Hoffman v. Postill .	L. R. 4 Ch. 673; 19 L. T., N.S., 276; 20 L. T., N.S., 893; 17 W. R. 901 (*Brick Kilns*).	384
1890. Hoffman's Application.	7 R. P. C. 92 (*Automatic Weighing Machines*).	232
1853. Holland v. Fox . .	1 C. L. R. 440; 2 C. L. R. 1576; 1 W. R. 448; 3 Ell. & Bl. 977; 23 L. J. Q. B. 357; 1 Jur., N.S., 13 (*Umbrellas*).	366

		PAGE
1889. Holliday *v.* Hoppenstall.	41 Ch. D. 109; 6 R. P. C. 320; 58 L. J. Ch. 820; 61 L. T., N.S., 313; 37 W. R. 662 (*Dyeing*).	370, 371, 570
1888. Hollins *v.* Capper .	5 R. P. C. 289	144
1852. Holmes *v.* London & North-West. Rail Co.	M. P. C. 13; 12 C. B. 831; 22 L. J. C. P. 57 (*Turning Tables*).	180, 184, 321
1876. Holste *v.* Robertson .	L. R. 4 Ch. D. 9; 46 L. J. Ch. 1; 35 L. T., N.S., 457; 25 W. R. 35 (*Glass Furnaces*).	375
1888. Homan's Application	6 R. P. C. 104 (*Fire-Proof Floors*).	231, 248
1854. Honiball *v.* Bloomer .	10 Ex. 538; 2 W. P. C. 100; 24 L. J. Ex. 11; 3 C. L. R. 167; 3 W. R. 71 (*Lubricating Apparatus*).	144, 148
1855. Honiball's Patent .	9 Moo. P. C. C. 378; 2 W. P. C. 201; 3 Eq. 225 (*Anchors*)	347, 350
1886. Hookham's Application.	Griff. App. 32 (*Velocipedes*) .	249, 252
1892. Hopkinson *v.* St. James Electric Light Co.	10 R. P. C. 46 (*Electric Wires*)	91, 194, 225
1799. Hornblower *v.* Boulton.	D. P. C. 221; 1 C. P. C. 156; 8 Ter. R. 95 (*Fuel Consumption*).	46, 52, 57, 163, 188, 210
1886. Horrocks *v.* Stubbs .	3 R. P. C. 221 (*Twisting Threads*).	171
1884. Horsey's Patent . .	1 R. P. C. 225 (*Brooms*) . .	331
1869. Horsley & Knighton's Patent.	L. R. 8 Eq. 475; 4 Ch. 784; 39 L. J. Ch. 357; 17 W. R. 1000, 1054; 21 L. T., N.S., 345.	208
1862. Horton *v.* Mabon . .	12 C. B., N.S., 437; 31 L. J. C. P. 255; 10 W. R. 582; 6 L. T., N.S., 289; 16 C. B., N.S., 141; 12 W. R. 491; 9 L. T., N.S., 815 (*Gas Holders*).	120
1884. Hoskins' Patent . .	Griff. 291 (*Folding Cots*) . .	248
1871. Houghton's Patent .	L. R. 3 P. C. 461; 7 Moo. P. C. C., N.S., 309 (*Paper*) .	338
1843. Household Co. *v.* Neilson.	1 W. P. C. 676; 9 C. & F. 788 (*Furnaces*).	46, 49, 52, 150, 165, 189, 204, 210, 368, 390
1884. Household *v.* Fairburn.	1 R. P. C. 109; 2 R. P. C. 140 (*Water Elevators*).	420
1862. Howe *v.* McKernan .	30 Beav. 547	384

		PAGE
1803. **Huddart v. Grimshaw**	D. P. C. 265; 1 W. P. C. 85; 1 C. P. C. 200 (*Cables*).	59, 68, 97, 192, 388
1879. **Hughes' Patent . .**	L. R. 4 App. Cas. 174; 48 L. J. P. C. 20; 27 W. R. 403 (*Armour Plates*).	336
1856. **Hull v. Bollard . .**	1 H. & N. 134; 25 L. J. Ex. 304 (*Grinding Corn*).	366, 377
1831. **Hullett v. Hague . .**	2 B. & Ad. 370 (*Sugar Refining*).	52, 98, 204
1887. **Humpherson v. Syer .**	4 R. P. C. 184, 407 (*Water-Waste Preventer*).	124, 138, 144, 158, 405
1861. **Hutchinson's Patent .**	14 Moo. P. C. C. 304 (*Paste-Board*).	331, 332, 339
1888. **Hutchison v Pattullo**	4 R. P. C. 329; 5 R. P. C. 351 (*Oils and Fats*).	173
1884. **Huth's Patent . . .**	Griff. 202 (*India-Rubber*) . .	252
1863. **Hyde v. Palmer . .**	3 B. & S. 657; 32 L. J. Q. B. 120; 7 L. T., N.S., 823; 11 W. R. 433 (*Separating Cocoa Fibre*).	391
. **Hyde v. Trent . . .**	John. 79; 45 Newton's Lond. Journal, 135 (*Separating Cocoa Fibre*).	120
1891. **Jablochkoff's Patent .**	8 R. P. C. 281 (*Electric Lighting*).	349
1884. **Jackson v. Needle. .**	1 R. P. C. 174; 2 R. P. C. 191 (*Parcel-Post Boxes*).	123, 351, 355
1884. **Jackson v. Wolstenholmes.**	1 R. P. C. 105 (*Toothed Wheels*)	196
1892. **Jahncke v. Bell . .**	9 R. P. C. 100 (*Metallic Boxes*)	300
1885. **Jenson v. Smith . .**	2 R. P. C. 249 (*Lubrication*) .	122, 148
1892. **Johnson v. Edge . .**	9 R. P. C. 144 (*Wrapping up Blue*).	416
1871. **Johnson's Patent . .**	L. R. 4 P. C. 75; 8 Moo. P. C. C., N.S., 282 (*Sewing Machines*).	331, 341, 342, 347
1877. **Johnson's Patent . .**	L. R. 5 Ch. D. 503; 46 L. J. Ch. 555; 13 Ch. D. 398.	226
1873. **Johnson & Atkinson's Patent.**	L. R. 5 P. C. 87	340
1873. **Johnson v. Rylands .**	Griff. 138 (*Wire Testing*) . .	304
1843. **Jones v. Berger . .**	5 M. & G. 208; 1 W. P. C. 544; 12 L. J. C. P. 179; 6 Scott. N. R. 208; 7 Jur. 883 (*Starch*).	366, 371, 374
. **Jones v. Heaton . .**	1 W. P. C. 401 (n.) . . .	191

		PAGE.
1856. Jones v. Lees . . .	25 L. J. Ex. 241; 1 H. & N. 189; 26 L. J. Ex. 9; 2 Jur., N.S., 645 (*Rubbing Fibrous Substances*).	364, 378
1852. Jones v. Pearce . .	1 W. P. C. 122; 1 C. P. C. 524; 1 Lond. Jour. C. S. 213 (*Carriage Wheels*).	150, 317
1851. Jones v. Pratt . . .	6 H. & N. 697; 30 L. J. Ex. 365; 9 W. R. 696; 4 L. T., N.S., 411 (*Preparation of Cotton, etc.*).	383
1840. Jones' Patent . . .	1 W. P. C. 577 (*Carriage Wheels*).	334, 337
1854. Jones, *In re*.	9 Moo. P. C. C. 41 (*Starch*) .	347
. Jones' Patent . .	Griff. 313	215
. Jones' Application .	Griff. 265	240
1853. Jones' Application .	Griff. App. 33 (*Writing Slates*)	252, 254
1866. Jordan v. Moore . .	L. R. 1 C. P. 624; 35 L. J. C. P. 268; 14 W. R. 769; 12 Jur., N.S., 766 (*Ship Building*).	121, 198
1866. Jourdan v. Palmer .	L. R. 1 Ex. 102	385
1843. Joy's Patent . . .	10 R. P. C. 89 (*Steam Engines*)	343
1837. Jupe v. Pratt . . .	1 W. P. C. 145 (*Expanding Table*).	48, 203
1887. Kaye v. Chubb . .	4 R. P. C. 23, 289; 5 R. P. C. 641 (*Locks*).	110, 151, 152, 157, 184, 208, 304, 405, 413, 414, 428
1836. Kay v. Marshall . .	1 My. & Cr. 373; 1 Keen, 150; 5 Bing. N. C. 492; 7 Scott, 548; 8 L. J. C. P. 261; 2 W. P. C. 71; 8 Cl. & F. 245; 6 Jur. 1028; 2 W. P. C. 79 (*Spinning Flax*)	90, 118, 195, 196
1839. Kay's Patent . . .	1 W. P. C. 568; 3 Moo. P. C. C. 24 (*Spinning Flax*).	335, 340, 341
1893. Kelly v. Batchelar .	10 R. P. C. 289 (*Ladies*). .	324
1890. Kelly v. Heathman .	7 R. P. C. 343; 45 Ch. D. 256; W. N., 1890, 134 (*Telescope Ladder*).	223
1878. Kenny's Patent Button-Holeing Co. v. Somerville.	38 L. T., N.S., 878; 26 W. R. 786 (*Button-Holes*).	283
1891. Kensington Co. v. Lane Fox Co.	8 R. P. C. 277 (*Electrical Distribution: see* Lane, Fox v. Kensington Co.).	353, 356, 416, 417

		PAGE
1861. **Kornot** *v.* **Potter** . .	30 Beav. 343; 3 De G. F. & J. 447; (*Turnpin*).	256
1891. **Kilner's Patent** . .	8 R. P. C. 35 (*Bottle-making Tools*).	252
1884. **King** *v.* **Oliver** . . .	1 R. P. C. 23, 42 (*Colliery Winding Machinery*).	278, 282
1889. **King, Brown & Co.** *v.* **Anglo-American Brush Co.**	6 R. P. C. 414; 7 R. P. C. 436; 9 R. P. C. 313 (*Dynamos*).	70, 150, 173, 211
1887. **Knight's Application**	Griff. App. 35	255
1888. **Knott** *v.* **Morgan** . .	2 Keen, 213 (*Trade-Mark Case*).	430
1839. **Kollman's Patent** . .	1 W. P. C. 564 (*Pianofortes*).	337
1886. **Kurtz** *v.* **Spence** . .	3 R. P. C. 368; 4 R. P. C. 427; 5 R. P. C. 161; 33 Ch. D. 579; 36 Ch. D. 770; 55 L. J. Ch. 919; 57 L. J. Ch. 238; 55 L. T., N.S., 317; 58 L. T., N.S., 439; 35 W. R. 26; 36 W. R. 438 (*Chemicals*).	67, 231, 414, 416, 417, 419, 503
1892. **Laino** *v.* **Herold** . .	9 R. P. C. 447 (*Blackkettle Poison*).	298
1887. **Lake's Application** .	Griff. App. 35	254
1888. „ „ .	5 R. P. C. 415 (*Locomotives*) .	247
1889. „ „ .	6 R. P. C. 548 (*Naphthol*). .	251
1887. **Lake's Patent** . . .	Griff. App. 16 (*Colours*) . .	224, 225, 227
1891 „ „ . . .	8 R. P. C. 228 (*Joints for Rails*).	338
1874. **Lamb** *v.* **Nottingham Manufacturing Co.**	Seton's Decrees, 4th Ed. 349 .	393
1850. **Lamenaudo's Patent** .	2 W. P. C. 161 (*Glass Letters*)	350
1864. **Lancaster's Patent** .	2 Mac. P. C. C., N.S., 169 (*Fire-Arms*).	316
1884. „ „ .	Griff. 293 (*Pistons*) . . .	250, 256,
1892. **Lane Fox** *v.* **Kensington Co.**	8 R. P. C. 277; 9 R. P. C. 221, 413 (*Electrical Distribution*).	50, 173
1892. **Lane Fox's Patent** .	9 R. P. C. 411 (*Electrical Distribution*)	325, 329
1862. **Lang** *v.* **Gisborne** . .	31 Beav. 133; 31 L. J. Ch. 769; 6 L. T., N.S., 771 (*Targets*).	188
1889. **Lang** *v.* **Whitecross Co.**	6 R. P. C. 570; 6 Times R. 57 (*Wire Ropes*).	217
1890. **Lang**, *Re*	7 R. P. C. 169 (*Wire Ropes*) .	217, 394

		PAGE
1890. Law v. Ashworth . .	7 R. P. C. 86, 231; 9 R. P. C. 194 (*Wire Curls*: see Ashworth v. Law).	372, 417, 580
1856. Lawes v. Purser . .	6 E. & B. 930; 26 L. J. Q. B. 25; 28 L. T. 84; 5 W. R. 43; 3 Jur., N.S., 182 (*Manure*).	289
1892. Lawrence's Patent .	9 R. P. C. 85 (*Refrigerators*) .	330
1885. Lawrence v. Perry .	2 R. P. C. 179 (*Crayon-Holders*).	123, 212, 217, 311, 412
1885. Lawrie v. Baker . .	2 R. P. C. 213 (*Bird-Cages*) .	412
1873. Lea v. Saxby . . .	32 L. T., N.S., 731 (*Gates*) .	384
1880. Leadbeater v. Kitchin	7 R. P. C. 235 (*Machinery Fingers*).	131, 209
1812. Leadstains v. E. of Sandwich.	4 M. & Sr. 1028	10
1845. Leaf v. Topham . .	14 M. & W. 146; 14 L. J. Ex. 231 (*Weaving Elastic Fabrics*).	366
1886. Ledgard v. Bull . .	L. R. 11 App. Cas. 648 (*Brick-Making*).	399
1847. Ledsam v. Russell .	See Russell v. Ledsam.	
1872. Lee v. Walker . . .	L. R. 7 C. P. 121; 41 L. J. C. P. 91; 26 L. T., N.S., 70 (*Coal-Boxes*).	235
1836. Lee's Patent . . .	10 Mod. P. C. C. 226 (*Brakes*).	347
1828. Lewis v. Davis. . .	3 C. & P. 502; 1 W. P. C. 488; 1 C. P. C. 471 (*Shearing Cloth*).	60, 97, 368
1829. Lewis v. Marling . .	4 C. & P. 52; 1 W. P. C. 490; 1 C. P. C. 475; 10 B. & C. 22; 5 M. & R. 66 (*Shearing Cloth*)	72, 79, 94, 150, 167, 211, 250
1883. Liardet v. Hammond Electric Light Co.	W. N. (1883) 96; 31 W. R. 710 (*Accumulators*).	278
1777. Liardet's Patent . .	1 W. P. C. 52	333
1778. Liardet v. Johnson .	Bull. N. P. 76; 1 W. P. C. 53; 1 C. P. C. 35 (*Trusses*).	42, 96, 102
1891. Lifeboat Co. v. Chamborn.	8 R. P. C. 418 (*Lifeboats*) .	141 144, 158
1618. Lightfoot v. Lenot .	2 Cro. 421	9
1856. Lister v. Eastwood .	3 C. L. R. 1249; 26 L. T. 4 (*Wool-Combing*).	352, 353
1864. ,, ,, .	9 L. T., N.S., 766 (*Wool-Combing*).	310, 313
1857. Lister v. Leather . .	3 Jur., N.S., 423; 8 E. & B. 1004; 27 L. J. Q. B. 205; 3 Jur., N.S., 811; 4 Jur., N.S., 947; 29 L. T. 112; 4 K. & J. 425 (*Treating Fibre*).	59, 181, 305

		PAGE
1884. Lister v. Norton . .	1 R. P. C. 114; 2 R. P. C. 68, 135; 3 R. P. C. 190 (*Imitation Fur*).	142, 156, 167, 177, 208, 351, 353, 355, 382, 384, 388
1857. L'Oiseau & Pierraud's Application.	Griff. App. 36 (*Medical Electricity*).	250, 433
. Lombe's Act . . .	1 W. P. C. 38 (*Silk-Spinning Machinery*).	232
1886. London & Leicester Hosiery Co. v. Griswold.	3 R. P. C. 251; 2 T. R. 676 (*Knitting Machinery*).	278
1883. London & Leicester Hosiery Co. v. Higham.	Lawson's Patents, 2nd Ed., 142, 498, 505.	371
1888. Longbottom v. Shaw .	5 R. P. C. 497; 6 R. P. C. 143, 510; 8 R. P. C. 333; 43 Ch. D. 46; 58 L. J. Ch. 734; 61 L. T., N.S., 325; 37 W. R. 792 (*Pile-Fabric Weaving*).	126, 410
1612. Lord Chancellor's Case	No. 273; Hob. 214 . . .	11
1888. Lorrain's Patent . .	5 R. P. C. 142 (*Electric Clocks*)	251
1838. Losh v. Hague . . .	1 W. P. C. 202; 2 Coop. 59 (n.); 7 D. P. C. 495; 5 M. & W. 387; 8 L. J. Ex. 251 (*Wheels*).	87, 354, 365
1835. Lovell v. Hicks . .	2 Y. & C. 46, 481; 5 L. J. Ex. 101; 6 L. J Ex. 85.	277, 280
1846. Lowe's Patent . . .	10 Jur. 363 (*Gas Manufacture*).	339
1852. „ „ . . .	8 Moo. P. C. C. 1 (*Propelling Vessels*).	3[illegible]
1885. Lucas v. Miller . .	2 R. P. C. 155 (*Bicycle Lamp*)	171, 196
1854. Lucas's Patent. . .	M. P. C. 235 (*Chains*) . .	220
1886. Luke's Patent . . .	Griff. 294 (*Roving Fibrous Materials*).	248, 254, 255
1888. Lynde's Patent . .	5 R. P. C. 663 (*Weighing-Machines*).	252
1893. Lyon v. Goddard . .	10 R. P. C. 121 (*Disinfecting Clothes*).	68, 151
1861. M'Cormick v. Gray .	7 H. & N. 25; 31 L. J. Ex. 42; 4 L. T., N.S., 832 (*Reaping Machine*).	316, 322
1867. McDougal's Patent .	L. R. 2 P. C. 1; 37 L. J. P. C. 17; 5 Moo. P. C. C., N.S., 1 (*Disinfecting Sewage*)	333

		PAGE
1880. McDougal v. Parting-ton.	7 R. P. C. 216 (*Paper Fabrics*)	375
1888. MacEvoy's Patent .	5 R. P. C. 235 (*Portland Cement*).	250
1816. Macfarlane v. Price .	1 Stark. 199; 1 W. P. C. 74 (n.) (*Umbrellas*).	186
1883. Macfarlane's Applica-tion.	John. 168	253
1891. McHardy's Patent .	8 R. P. C. 432 (*Velocipedes*) .	251
1868. McInnes' Patent . .	L. R. 2 P. C. 54; 37 L. J. P. C. 23; 5 Mon. P. C. C., N.S., 72 (*Metallic Soap*).	336
. Macintosh v. Evering-ton.	6 Rep. Arts., N.S., 317, 365 (*Waterproof Cloth*).	102
1836. Macintosh's Patent .	1 W. P. C. 739 (*War Materials*).	331, 337
1862. Mackolean v. Rennie .	13 C. B., N.S., 52 (*Floating Docks*).	120, 176, 210
1882. Mackie v. Solvo Laundry Co.	9 R. P. C. 465 (*Washing Clothes*).	418
1842. Macnamara v. Hulse	Car. & M. 471; 2 W. P. C. 128 (n.) (*Paving*).	70, 188, 190, 324, 366, 396
1889. Main's Application .	7 R. P. C. 13 (*Dynamos*) . .	433
1866. Mallet's Patent . .	L. R. 1 P. C. 305; 4 Mon. P. C. C., N.S., 175 (*Fire-proof Buildings*).	316
1870. Mancoaux, *Ex parte* .	L. R. 6 Ch. 272; 18 W. R. 1181 (*Breech-Loaders*).	249
1893. Mandelberg v. Morley	10 R. P. C. 256	364
1821. Mansell's Patent . .	1 W. P. C. 13	147
1815. Manton v. Manton .	D. P. C. 333; 1 C. P. C. 278 (*Gun-Locks*).	68, 186, 185
1814. Manton v. Parker . .	D. P. C. 327; 1 W. P. C. 192 (n.) (*Gun-Locks*).	68
1850. Markwick's Patent .	13 Moo. P. C. C. 310; 8 W. R. 313 (*Spongiopiline*).	339, 345
1878. Marsden v. Saville Street Foundry Co.	L. R. 3 Ex. D. 203; 39 L. T., N.S., 97; 26 W. R. 784.	229
1888. Marshall's Applica-tion.	5 R. P. C. 661 (*Button-Hole Machine*).	247
. Martin's Patent . .	(Griff. 32)	423
1838. Mason v. Goodwin .	6 R. P. C. 235 (*Stone-Break-ing*).	311
1875. Mathers v. Green . .	L. R. 1 Ch. 29; 34 L. J. Ch. 296; 35 L. J. Ch. 1; 34 Beav. 170; 5 N. R. 358; 12 L. T., N.S., 66; 13 L. T., N.S., 420; 13 W. R. 421; 14 W. R. 17; 11 Jur., N.S., 845 (*Mowing-Machine*).	282

		PAGE
1860. **Mayer** *v.* **Spence** . .	1 J. & H. 87	354
1860. **Meadows** *v.* **Kirkman**	29 L. J. Ex. 205 (*Veneering*)	378
1874. **Mellor** *v.* **Watkins** .	L. R. 9 Q. B. 400.	287
1890. **Meyer** *v.* **Sherwood** .	7 R. P. C. 283 (*Gas Shade-Holders*).	218
1892. **Miller** *v.* **Clyde Bridge Steel Co.**	9 R. P. C. 470 (*Rolling Metals*)	300
1856. **Milligan** *v.* **Marsh** . .	2 Jur., N.S., 1083 (*Pianofortes*)	233
1854. **Milner's Patent** . .	9 Moo. P. C. C. 39 . . .	347
1893. **Miller** *v.* **Searle, Barber & Co.**	10 R. P. C. 106 (*Lamps for Velocipedes*).	117, 194, 201, 574
1892. **Mills** *v.* **Carson** . .	9 R. P. C. 338; 10 R. P. C. 9 (*Safety Burners*).	267
1835. **Minter** *v.* **Mower** . .	6 A. & E. 735; 1 W. P. C. 138; 6 L. J. K. B. 183; 2 N. & P. 565 (*Chairs*).	52, 150, 198, 204
1834. **Minter** *v.* **Wells** . .	1 W. P. C. 127; 1 C. P. C. 622; 4 L. J. Ex. 2; 1 C. M. & R. 505; 5 Tyr. 163 (*Chairs*).	52, 68, 231, 293
1835. **Minter** *v.* **Williams** .	4 Ad. & Ell. 251; 5 Nev. & M. 647; 1 H. & W. 585; 5 L. J. K. B. 60; 1 W. P. C. 135 (*Chairs*).	320
1884. **Moore** *v.* **Bennett** . .	1 R. P. C. 129	182, 380, 397, 428
1870. **Moore** *v.* **Craven** . .	L. R. 7 Ch. 94 (n.) . . .	385
1855. **Morewood** *v.* **Tupper** .	3 C. L. R. 718 (*Zinc-coating Metal*).	313
1858. **Morey's Patent** . .	25 Beav. 581; 6 W. R. 612 (*Sewing Machines*).	268
1843. **Morgan's Patent** . .	1 W. P. C. 737 (*Tinned Plates*).	327, 328 333
1876. „ „ . .	24 W. R. 245; W. N. (1876) 27.	268
1888. „ „ . .	Griff. App. 17 (*Watch-Keys*) .	224, 227
1888. „ „ . .	5 R. P. C. 180; 58 L. T., N.S., 713; W. N. (1888) 34 (*Carriages*).	424
1866. **Morgan** *v.* **Fuller** . .	L. R. 2 Eq. 296; 14 L. T., N.S., 353; 14 W. R. 497 (*Carriages*).	366
1835. **Morgan** *v.* **Seaward** .	1 W. P. C. 167, 187; 2 C. P. C. 37, 96, 101; 2 M. & W. 544; 6 L. J. Ex. 153 (*Propelling Vessels*).	41, 62, 66, 68, 72, 143, 145, 160, 184, 185, 187, 191, 201, 203, 378, 379
1886. **Morgan Brown's Patent.**	3 R. P. C. 212 (*Horseshoe Nails*).	317

		PAGE
1887. Morgan v. Windover .	4 R. P. C. 417; 5 R. P. C. 295; 7 R. P. C. 131; 3 Times L. Rep. 748; 4 Times L. Rep. 425 (*Carriage Springs*).	116, 129, 150, 172, 567, 580
1776. Morris v. Branson .	Bull. N. P. 76; 1 W. P. C. 51 (*Stocking Frames*).	57, 59
1891. Morris v. Coventry Co.	8 R. P. C. 353 (*Bicycles*) . .	376
1863. Morton v. Middleton .	1 Cr. Scss. 3 Ser. 718 (*Gate Posts*).	59, 185, 201, 202
1892. Moser v. Marsden . .	9 R. P. C. 214; 10 R. P. C. 215 (*Gin-Mills*).	225, 233, 360, 582
1886. Moseley v. Victoria Rubber Co.	3 R. P. C. 351; 4 R. P. C. 241; 55 L. T., N.S., 482; Griff. 163 (*Waterproof Cloth*).	109, 155, 170, 171, 175, 235, 363, 384, 414
1886. Moss v. Malins . .	3 R. P. C. 373; 33 Ch. D. 603; 56 L. J. Ch. 126; 2 T. R. 837; 35 W. R. 165 (*Tennis Ball Handles*: not followed, see Slazinger v. Feltham).	123, 376, 383, 579
1852. Mullins v. Hart . .	3 C. & K. 297 (*Penholders*). .	144, 148
1843. Muntz v. Foster . .	2 W. P. C. 93 (*Alloy*). . .	58, 90, 190, 297, 318, 320, 352, 387, 395, 396
1842. Muntz v. Grenfell . .	2 W. P. C. 88; 7 Jur. 121; 2 Cop. 61 (n.) (*Alloy*).	350
1840. Muntz v. Vivian . .	2 W. P. C. 87 (*Alloy*).	
1846. Muntz's Patent . .	2 W. P. C. 113 (*Alloy*) . .	58, 341, 343, 347
1872. Murray v. Clayton .	L. R. 7 Ch. 570; 15 Eq. 115; 10 Ch. 675 (n.); 42 L. J. Ch. 191; 27 L. T., N.S., 110, 644; 20 W. R. 649; 21 W. R. 118, 498 (*Brick-Making*).	58, 99, 102, 150, 315, 405
1882. Myer's Patent . . .	W.N., 1882, 53, 56. . . .	208
1891. Nairn's Patent . .	8 R. P. C. 444 (*Floor-Cloth Printing*).	222
1861. Napier's Patent . .	13 Moo. P. C. C. 543; 9 W. R. 396 (*Copper Ore Smelting*).	337, 345,
1861. Napier's Patent . .	L. R. 6 App. Cas. 174; 50 L. J. P. C. 40; 29 W. R. 745 (*Blankets*).	346, 347
1884. Needham v. Johnson .	1 R. P. C. 49 (*Filters*). . .	208, 314, 411

		PAGE
1863. **Needham** *v.* **Oxley** .	8 L. T., N.S., 532, 604; 11 W. R. 745, 852; 2 N. R. 232, 267, 388 (*Squeezing out Moisture*).	363
1615. **Needler** *v.* **Bishop of Winchester** . .	Hob. 221	15
. **Neilson** *v.* **Betts** . .	See Betts *v.* Neilson.	
1841. **Neilson's Patent** . .	1 W. P. C. 290 (*Hot Blast*). .	288
1841. **Neilson** *v.* **Fothergill** .	1 W. P. C. 287 (*Hot Blast*). .	288
1841. **Neilson** *v.* **Harford** .	1 W. P. C. 295, 324 (n.); 1 W. P. C. 331, 373; 10 L. J. Ex. 493; 11 L. J. Ex. 20; 2 Coo. C. C. 61 (n.); 8 M. & W. 806 (*Hot Blast*).	47, 48, 51, 52, 165, 188, 190, 191, 197, 204, 213, 314, 366, 377, 395
1841. **Neilson** *v.* **Thompson**	1 W. P. C. 278; 2 Coop. 61 (n.) (*Hot Blast*).	184, 187, 351, 354
1891. **Nottlefolds** *v.* **Reynolds**	8 R. P. C. 410; 9 R. P. C. 270 (*Screws*).	300, 371, 579, 580, 583, 584
1863. **Nowall** *v.* **Elliot** . .	1 H. & C. 797; 32 L. J. Ex. 120; 11 W. R. 438; 13 W. R. 11; 7 L. T., N.S., 753; 10 L. T., N.S., 792; 9 Jur., N.S., 359; 10 Jur., N.S., 954 (*Submarine Cables*).	44, 166, 170, 181 280, 316, 322
1856. **Nowall** *v.* **Elliot**, *In re*	4 C. B., N.S., 260; 27 L. J. C. P. 337; 4 Jur., N.S., 562 (*Submarine Cables*).	143
1851. **Nowall** *v.* **Wilkins** .	17 L. T. 20.	407
1852. **Nowall** *v.* **Wilson** . .	2 De G. M. & G. 282; 19 L. T. 161 (*Wire Ropes*).	[illegible]
1817. **Newbury** *v.* **James** .	2 Mer. 446; 1 C. P. C. 367 (*Gout Pills*).	184
1861. **Nowby** *v.* **Harrison** .	1 J. & H. 393	284
1887. **Newman's Patent**. .	5 R. P. C. 271; Griff. App. 40 (*Doors and Windows*).	248, 251
1890. **Newsum** *v.* **Mann** . .	7 R. P. C. 307 (*Letterpress Printing*).	131
1846. **Newton** *v.* **Grand Junction Rail. Co.**	5 Ex. 331; 20 L. J. Ex. 427 (n.) (*Axle Boxes*).	99, 204, 315, 324
1872. **Newton** *v.* **Halbard** .	John. 152	205
1851. **Newton** *v.* **Vaucher** .	6 Ex. 859; 21 L. J. Ex. 305 (*Hydraulic Packing*).	52, 99, 166, 210
1861. **Newton's Patent** . .	14 Moo. P. C. C. 156; 15 Moo. P. C. C. 176; 10 W. R. 731; 9 Jur., N.S., 109 (*Printing Machines*).	327, 340,

		PAGE
1884. **Newton's Patent** . .	L. R. 9 App. Cas. 592; 1 R. P. C. 177 (*Grinding Stone*).	330
1844. **Nickels** *v.* **Haslam** .	8 Scott N. R. 97; 7 M. & G. 378; 13 L. J. C. P. 146; 8 Jur. 474 (*United Fabrics*).	165, 214
1849. **Nickels** *v.* **Ross** . .	8 C. B. 679 (*Braid*) . . .	232
1893. **Nicoll** *v.* **Swears** . .	10 R. P. C. 240 (*Riding Habits*).	133
1880. **Nobel's Explosive Co.** *v.* **Jones.**	L. R. 17 Ch. D. 721; 8 App. Cas. 5; 50 L. J. Ch. 582; 52 L. J. Ch. 339; 48 L. T. 490; 30 W. R. 294; 31 W. R. 388 (*Nitro Glycerine*).	316, 319, 324
1850. **Noble's Patent** . . .	7 Moo. P. C. C. 191 (*Carding Wool*).	328, 330
1887. **Nordenfelt's Patent** .	Griff. App. 18 (*Alloy of Aluminium and Iron*).	223
1884. **Nordenfelt** *v.* **Gardner**	1 R. P. C. 10, 61 (*Battery Gun*).	307, 405, 411, 427
1870. **Normand's Patent** .	L. R. 3 P. C. 193; 6 Moo. P. C. C., N.S., 477 (*Steam*).	328
1855. **Normanby's Patent** .	9 Moo. P. C. C. 452 (*Soap*). .	345
1863. **Norton's Patent** . .	1 Moo. P. C. C., N.S., 339; 11 W. R. 720; 9 Jur., N.S., 419 (*Figured Fabrics*).	328, 336
1861. **Noton** *v.* **Brooks** . .	7 H. & N. 499; 8 Jur., N.S., 155; 10 W. R. 111 (*Looms*).	289
1865. **Nunn** *v.* **D'Albuquerque.**	34 Beav. 595 (*Lamps*). . .	208
1889. **Nussey & Louchman's Patent.**	7 R. P. C. 22 (*Pressing Fabrics*).	331, 343
1891. **Nuttall** *v.* **Hargreaves**	8 R. P. C. 273, 450 (*Beer Taps*)	131, 173, 552
1888. **Oddy** *v.* **Smith** . . .	5 R. P. C. 503 (*Covering Rollers*).	120, 578
1789. **Oldham** *v.* **Langmead**	3 Term R. 439, 441. . . .	279, 288
1862. **Orunson** *v.* **Clarke** . .	13 C. B., N.S., 337; 14 C. B., N.S., 475; 32 L. J. C. P. 8, 291; 7 L. T., N.S., 301; 11 W. R. 118, 787; 9 Jur., N.S., 740; 10 Jur., N.S., 128; 1 N. R. 61; 2 N. R. 192 (*Casting Boilers*).	120
1856. **Osborne** *v.* **Jullion** .	26 L. J. Ch. 6; 4 W. R. 767 (*Chemicals*).	253

		PAGE
1885. **Osmond** *v.* **Hirst** . .	2 R. P. C. 205 (*Lawn Tennis Ground Markers*).	354
1881. **Otto** *v.* **Linford** . .	46 L. T., N.S., 35 (*Gas Engines*).	46, 107, 135, 136, 137, 155, 157, 188, 202, 206, 305
1889. **Otto** *v.* **Singer** . . .	7 R. P. C. 7 (*Bicycle Tyres*) .	280
1886. **Otto** *v.* **Steel** and **Otto** *v.* **Sterne.**	2 R. P. C. 139; 3 R. P. C. 109; L. R. 31 Ch. D. 241; 55 L. J. Ch. 196; 54 L. T. 157; 34 W. R. 289 (*Gas Engines*).	107, 158 150, 375, 405, 406, 407, 414
1860. **Oxley** *v.* **Holden** . .	8 C. B., N.S., 666; 30 L. J. C. P. 68; 2 L. T., N.S., 464; 8 W. R. 626 (*Carriage Doors*).	148, 155, 166, 177, 199, 210, 213, 320
1853. **Palmer** *v.* **Cooper** . .	9 Ex. 231; 2 C. L. R. 430; 23 L. J. Ex. 82 (*Candles*).	366
1853. **Palmer** *v.* **Wagstaffe** .	8 Ex. 840; 9 Ex. 494; 22 L. J. Ex. 205; 23 L. J. Ex. 217; 1 C. L. R. 448; 2 C. L. R. 1052 (*Candles*).	204, 366, 373, 383, 388
1888. **Parker** *v.* **Maignen Filtre Rapide Co.**	5 R. P. C. 207 (*Filters*). . .	376
1860. **Parkes** *v.* **Stevens** . .	L. R. 8 Eq. 358; 5 Ch. 36; 22 L. T., N.S., 635; 18 W. R. 253 (*Lamp Doors*).	121, 179, 182, 309, 356
1888. **Parnell's Patent** . .	5 R. P. C. 126; 4 T. R. 197 .	268
1890. **Pascall** *v.* **Toope** . .	7 R. P. C. 125; 8 R. P. C. 1 (*Propagating Pans*).	377, 385, 586
1858. **Patent Bottle Envelope Co.** *v.* **Soymer.**	5 C. B., N.S., 164; 28 L. J. C. P. 22; 5 Jur., N.S., 174 (*Bottles*).	110, 166, 310
1850. **Patent Type-founding Co.** *v.* **Richards.**	1 John. 381; 6 Jur., N.S., 39; 2 L. T., N.S., 359 (*Printers' Type*).	188, 196, 365
1860. **Patent Type-founding Co.** *v.* **Walter & Lloyd.**	6 H. & N. 132; 29 L. J. Ex. 207; 1 L. T., N.S., 382; 6 Jur., N.S., 103; John. 727; 8 W. R. 353 (*Printers' Type*).	378, 381
1886. **Paterson's Patent** . .	Grif. 295 (*Casks*)	248

		PAGE
1876. Patterson v. Gaslight & Coke Co.	L. R. 2 Ch. D. 812, 827; 3 App. Cas. 230; 45 L. J. Ch. 843; 47 L. J. Ch. 402; 35 L. T., N.S., 11; 38 L. T., N.S., 303; 26 W. R. 482 (*Gas Purification*).	89, 138, 228
1849. Patterson's Patent .	6 Mac. P. C. C. 469; 13 Jur. 593 (*Colour Printing*).	337
1845. Pattison v. Holland .	Hindmarch, Pat. 293 . . .	387
1846. Payne v. Banner . .	15 L. J. Ch. 227 (*Preserving Vegetables*).	277
1851. Payne's Patent. . .	Carpmael, 220 (*Preserved Meat*).	337
1894. Peckover v. Rowland & Co.	10 R. P. C. 118, 234 (*Softening Water*).	179, 305, 311, 367
1866. Penn v. Bibby. Jack & Fernie	L. R. 1 Eq. 548; 2 Eq. 314; 3 Eq. 308; 5 Eq. 81; 2 Ch. 127; 36 L. J. Ch. 277, 455; 37 L. J. Ch. 136; 14 L. T., N.S., 405; 15 L. T., N.S., 385, 393; 17 L. T., N.S., 407; 14 W. R. 760; 16 W. R. 243 (*Screw-Shaft Bearings*).	91, 102, 170, 171, 366, 391, 398
1881. Pennycook's Patent Glazing Co. v. Mackenzie.	19 Scottish Law Reporter (*Glazing Windows*).	298
1845. Perkins' Patent . .	2 W. P. C. 6 (*Hot Air*).	332, 336, 340
1884. Peroni v. Hudson . .	1 R. P. C. 261 (*Thermometer Tubes*).	407
1840. Perry v. Mitchell . .	1 W. P. C. 269 (*Pens*). . .	363
1893. Pether v. Shaw . .	10 R. P. C. 293	160, 260
. Pettit Smith's Patent	See Smith's Patent.	
1880. Philips v. Ivel Cycle Co.	7 R. P. C. 77; 62 L. T. 392 (*Bicycles*).	370, 372
1855. Philpot v. Hanbury .	2 R. P. C. 33, 153 (*Dress Pattern Draughting*).	70, 122, 152, 155, 185, 208
1890. Pickard v. Prescott .	7 R. P. C. 361; 9 R. P. C. 195 (*Eye Glasses*).	159
1881. Pietschmann's Patent	Griff. 314 (*Barrel Organs*). .	219, 220, 226
1865. Piggott v. Anglo-American Telegraph Co.	13 L. T., N.S., 46 (*Electric Telegraphy*).	379
1845. Pinkus' Patent . .	12 Jur. 233 (*Motors*) . . .	335, 336
1892. Pirrie v. York Street Flax Co.	10 R. P. C. 34 (*Flax Spinning*).	117
1871. Pitman's Patent . .	L. R. 1 P. C. 81; 8 Moo. P. C. C., N.S., 293 (*Candles*).	328, 329, 330, 331, 345

		PAGE
1888. **Pitt's Patent . . .**	5 R. P. C. 343 (*Naphthol*)	251, 569
1883. **Plating Co. v. Farquharson.**	Griff. 187; 17 Ch. D. 49 (*Electro-Plating*).	212, 213, 225, 379, 381, 403, 580
1875. **Plimpton v. Malcolmson.**	L. R. 20 Eq. 37; 3 Ch. D. 531; 44 L. J. Ch. 257; 45 L. J. Ch. 505; 34 L. T., N.S., 340 (*Roller-skates*).	130, 154, 157, 159, 190, 192, 294, 352, 355
1876. **Plimpton v. Spiller . .**	L. R. 4 Ch. D. 286; 6 Ch. D. 412, 425; 35 L. T., N.S., 636; 37 L. T., N.S., 56; 25 W. R. 152; 47 L. J. Ch. 211; 25 W. R. 152; 26 W. R. 285; L. R. 5 H. L. 433 (*Roller Skates*).	63, 157, 159, 195, 198, 206, 209, 216, 294, 351, 353, 355, 402, 403
1888. **Podmore v. Wright . .**	5 R. P. C. 380 (*Umbrellas*) .	141
1867. **Poole's Patent . . .**	L. R. 1 P. C. 514; 4 Moo. P. C. C., N.S., 452; 36 L. J. P. C. 76 (*Surface Condensers*).	341, 342
1885. **Pooley v. Pointon . .**	2 R. P. C. 167 (*Bread*) . .	192, 412
1889. **Postcard Automatic Co. v. Samuel.**	6 R. P. C. 560 (*Automatic Postcard Boxes*).	286
1860. **Potter v. Parr . . .**	2 B. & S. 216 (n.) (*Spinning Machinery.*)	180
1869. **Poupard v. Fardell . .**	21 L. T., N.S., 696; 18 W. R. 50, 127 (*Wheel Skids*).	94, 144, 286
1845. **Pow v. Taunton . .**	9 Jur. 1056 (*Nipping Lever*) .	50
1879. **Powell v. Head . .**	L. R. 12 Ch. D. 686 (*Copyright*).	283
1875. **Printing & Numerical Registering Co. v. Sampson.**	L. R. 19 Eq. 462; 44 L. J. Ch. 705; 32 L. T., N.S., 851; L. R. 42 Ch. D. 390 (*Printing*).	277
1889. **Proctor v. Bailey . .**	6 R. P. C. 106, 538; 59 L. J. Ch. 12; 38 W. R. 10 (*Fuel-Feeding*).	319, 354
1887. **Proctor v. Bennis . .**	4 R. P. C. 333; L. R. 36 Ch. D. 740; 57 L. J. Ch. 11; 57 L. T., N.S., 622; 36 W. R. 458 (*Fuel-Feeding*).	183, 299 309
1887. **Proctor v. Sutton Lodge Chemical Co.**	5 R. P. C. 184 (*Fuel-Feeding*)	357, 410
1840. **Quarrill's Patent . .**	1 W. P. C. 740 (*Lamps*) . .	338
1888. **Railway & Electrical Appliance Co., *In re*.**	L. R. 38 Ch. D. 597; 59 L. T., N.S., 22; 36 W. R. 730 (*Waggon-cover Fastenings*).	279, 287

		PAGE
1850. Ralston v. Smith . .	9 C. B., N.S., 117; 11 C. B., N.S., 471; 30 C. B., N.S., 28; 11 H. L. C. 223; 31 L. J. C. P. 102; 33 L. J. C. P. 49 (*Embossing Cloth*).	88, 119, 212, 217, 222, 225
1831. Ransome v. Bentall .	3 L. J. Ch. 161.	430
1830. Rawes v. Chance . .	7 R. P. C. 276 (*Sulphur*) . .	382
1799. Rebeckah, The. . .	1 Rob. 227	13
1802. Rodges v. Mulliner .	10 R. P. C. 21 (*Carriages*) .	287
1785. Rex v. Arkwright. .	D. P. C. 61; 1 W. P. C. 61; 1 C. P. C. 53 (*Preparing Cotton, etc.*).	57, 59, 68, 188, 191, 192, 231
1891. Reg. v. County Court of Halifax.	8 R. P. C. 318 (*Beer Jugs*) .	357, 410
1886. Reg. v. Crampton . .	3 R. P. C. 367 (*Electric Bells*)	430
1817. Rex v. Cutler . . .	1 Stark. 351; 1 W. P. C. 76; 1 C. P. C. 351; M. P. C. 124; 14 Q. B. 372 (n.) (*Tubular Boilers*).	88, 118, 188
1785. Rex v. Elwo	Bull. N. P. 76; 1 W. P. C. 76; D. P. C. 144 (*Thread*).	198
1826. Rex v. Linter . . .	W. P. C. 80 (*Steam Hot Rollers*).	301
1817. Rex v. Metcalf . .	2 Stark. 240; 1 W. P. C. 141 (n.) (*Tapering Brush*).	163, 184
1850. Reg. v. Mill . . .	10 C. B. 379; 20 L. J. C. P. 16; 15 Jur. 50; 14 Beav. 312 (*Ink-stands*).	222, 366
1782. Reg. v. Mussary . .	Bull. N. P. 76A; 1 W. P. C. 41 (*Not known*).	37, 203
1856. Reg. v. Wallis . . .	3 R. P. C. 1 (*Lamps*) . . .	430
1862. Reg. v. Walton. . .	2 Q. B. 969; 1 W. P. C. 626 (*Carding Wool*)	366
1819. Rex v. Wheeler . .	2 B. & Ald. 345; 1 C. P. C. 334 (*Drying Malt*).	40, 46, 163, 180
1884. Renard v. Levinstein .	3 N. R. 655; 5 N. R. 301; 10 L. T., N.S., 94, 177; 11 L. T., N.S., 365, 766; 13 W. R. 229, 382; 2 H. & M. 528 (*Dyes*)	284, 356, 376, 384
1856. Reynolds v. Amos. .	3 R. P. C. 215 (*Fumigation*) . .	100, 121
1857. Richardson v. Castrey	4 R. P. C. 263 (*Wine-glasses*).	387
1834. Ridgway v. Philip .	1 C. M. & R. 415; 5 Tyr. 131 (*Gas-engine*).	288
1879. Roberts v. Heywood .	27 W. R. 451 (*Painting Machine*).	62
1868. Roberts' Patent . .	1 W. P. C. 573 (*Spinning-jennies*).	337, 340
1845. Robinson's Patent .	5 Mod. P. C. C. 65; 2 W. P. C. 5 (*Production of Electricity for Telegraphy*) called Bain's Patent.	350

		PAGE
1774. **Roebuck** *v.* **Sterling** .	1 W. P. C. 54, 451 (n.) (*Oil of Vitriol*)	90, 148
1872. **Rollins** *v.* **Hinks** . .	L. R. 13 Eq. 355; 41 L. J. Ch. 358; 26 L. T., N.S., 56 (*Duplex Lamp*).	415
1878. **Rolls** *v.* **Isaacs** . . .	L. R. 19 Ch. D. 268; 51 L. J. Ch. 170; 45 L. T., N.S., 701; 30 W. R. 243; W. N. 1878, 37 (*Paint for Ships*).	148, 384
1887. **Roper's Patent** . .	4 R. P. C. 201 (*Safety Rafts*)	337
1891. **Ross,** *In re.*	8 R. P. C. 477 (*Breech-loaders*)	251
1886. **Rothwell** *v.* **King** . .	3 R. P. C. 370; 4 R. P. C. 70, 397 (*Weaving Fabrics*).	352, 410, 423
1891. **Rothwell's Patent** .	Griff. 320 (*Weaving Fabrics*).	423
1887. **Rowcliffe** *v.* **Longford Wire Co.**	4 R. P. C. 251 (*Mattresses*) .	124
1885. **Rowcliffe** *v.* **Morris** .	3 R. P. C. 17, 145 (*Mattresses*).	124, 183 411
1870. **Rushton** *v.* **Crawley** .	L. R. 10 Eq. 522 (*Artificial Hair*).	121
1834. **Russell** *v.* **Barnsley** .	1 W. P. C. 472 (*Tubes*).	
1832. **Russell** *v.* **Cowley** . .	1 W. P. C. 457; 1 C. P. C. 532; 2 Coop. C. C. 59 (n.); 1 C. M. & R. 864 (*Iron Tubes*).	53, 98, 204, 378
1837. **Russell** *v.* **Crichton** .	1 W. P. C. 677 (n.); 15 D. Cr. Sess. 1270 (*Gun Tubes*).	368, 378, 388
1885. **Russell** *v.* **Hatfield** .	2 R. P. C. 144 (*Portable Ramps*).	364
1843. **Russell** *v.* **Ledsam** .	11 M. & W. 647; 14 M. & W. 574; 16 M. & W. 633; 7 Jur. 585; 9 Jur. 557; 12 L. J. Ex. 439; 14 L. J. Ex. 353; 16 L. J. Ex. 145; 1 H. L. C. 687 (*Gun Tubes*).	265, 314, 316, 327, 345, 366, 368, 374
1857. **Russell's Patent** . .	2 De G. & J. 130; 30 L. T. 178; 6 W. R. 95; 2 Mac. P. C. C. 496 (*Metal Tubes*).	232, 246
1855. **Ryder's Patent** . .	John. 213	340
1888. **Ryland's Patent** . .	5 R. P. C. 665 (*Packing Cases*)	223
1890. **Ryland** *v.* **Ashley's Patent Bottle Co.**	7 R. P. C. 175 (*Bottle-making*).	380, 381 580
1893. **Salvo Laundry Co.** *v.* **Mackie**	10 R. P. C. 68	670
1873. **Sampson,** *In re.* . .	21 L. T. 81 (*Veneer*) . . .	253
1887. **Sanitas Co.** *v.* **Condy** .	4 R. P. C. 330 (*Trade-mark Case*).	309

		PAGE
1832. Saunders *v.* Aston .	3 B. & Ad. 881; 1 L. J. K. B. 265; 1 C. P. C. 319.	57
1823. Savory *v.* Price . .	1 Ry. & Mo. 1; 1 W. P. C. 63 (*Seidlitz Powders*).	102
1874. Saxby *v.* Clunes . .	43 L. J. Ex. 225 (*Railway Points*).	303, 311
1872. Saxby *v.* Easterbrook	L. R. 7 Ex. 207; 41 L. J. Ex. 113; 20 W. R. 751; 26 L. T., N.S., 429.	405
1880. Saxby *v.* Gloucester Waggon Co.	L. R. 7 Q. B. D. 305; 50 L. J. Q. B. 577; Griff. App. 51; W. N. (1880) 28, (1882) 102; Griff. P. C. 417 (*Railway Signals*).	121, 144, 231
1870. Saxby's Patent . .	L. R. 3 P. C. 202; 7 Moo. P. C. C., N.S., 82; 19 W. R. 513 (*Railway Signals*).	335, 338, 341
1853. Schlumberger's Patent.	9 Moo. P. C. C. 1; 2 Eq. Rep. 1	348
1871. Scott & Young, *Ex parte*.	L. R. 6 Ch. 274; 19 W. R. 425 (*Water Meters*).	249, 256
1856. Seed *v.* Higgins . .	8 E. & B. 755, 771; 8 H. L. C. 550; 27 L. J. Q. B. 148, 411; 30 L. J. Q. B. 314; 3 L. T., N.S., 101; 4 Jur., N.S., 258; 5 Jur., N.S., 540; 6 Jur., N.S., 1264 (*Boring Villa*).	222, 300, 324, 325, 389, 395
1850. Sellers *v.* Dickinson .	5 Ex. 312; 20 L. J. Ex. 417 (*Looms*).	59, 201, 300, 324
1867. Seguelin *v.* Terrell .	16 L. T., N.S., 537 (*Purifying Oil*).	270
1868. Sorrell's Patent . .	6 R. P. C. 101 (*Electrical Contacts*).	223
1883. Shallenberger's Application.	6 R. P. C. 550	433
1883. Sharp *v.* Brauer . .	3 R. P. C. 193 (*Window Winds*).	123, 415, 418
1873. Shaw *v.* Bank of England.	22 L. J. Ex. 26, 210 (*Paging Books*).	378
1883. Shaw *v.* Jones . . .	6 R. P. C. 328 (*Printing*). .	116, 140, 213, 300
1880. Sheehan *v.* Great East. Rail. Co.	L. R. 16 Ch. D. 59; 50 L. J. Ch. 68; 43 L. T. 432; 29 W. R. 69 (*Stiffening Iron*).	358
1872. Sheffield, *Ex parte* . .	L. R. 8 Ch. 257; 42 L. J. Ch. 356; 21 W. R. 293 (*Melting Glass*).	246
1883. Shorter's Patent . .	9 R. P. C. 435 (*Sewing*). .	333
1883. Shillito *v.* Learmonth .	2 R. P. C. 1 (*Window Blinds*). .	332, 355

		PAGE
1887. Siddell v. Vickers .	5 R. P. C. 81, 416; 7 R. P. C. 292; 6 R. P. C. 464; 9 R. P. C. 152; 39 Ch. D. 92; 61 L. T., N.S., 233 (*Forging-Tongs*).	94, 111, 136, 170, 172, 195, 196, 231, 368, 396, 398, 400, 578, 592
. Siddell's Patent . .	Griff. 320 (*Forging-Tongs*) .	423
1891. Sidebottom v. Fielden	8 R. P. C. 266 (*Spinning Cotton*).	371, 372, 381, 579, 581
1888. Siclaff's Application .	5 R. P. C. 484 (*Automatic Selling Apparatus*).	252, 256
1891. Siemens v. Karo . .	8 R. P. C. 370 (*Gas Lamps*) .	370, 371, 372, 579
1892. Siemens v. Taylor. .	9 R. P. C. 401 (*Iron Ores*) .	414
1881. Simmonds v. Hitchman.	L. R. 20 Ch. D. 417 (n.) . .	411
1882. Sillar's Patent . . .	1 Good. P. C. C. 581 (*Manure*)	333
1842. Simister's Patent . .	1 W. P. C. 721; 4 Moo. P. C. C. 161 (*Stays*).	330, 338
1888. Simon, *Ex parte* . .	(Van Gelder's Patent) 6 R. P. C. 22; 4 Times R. 754 (*Dust Separators*).	219
1864. Simpson v. Holliday .	20 New Lond. Journal, N.S., 105; 13 W. R. 577; 12 L. T., N.S., 90; 5 N. R. 340; L. R. 1 H. L. 315; 35 L. J. Ch. 811 (*Dyes*).	136, 193, 205, 213, 288
1884. Singer v. Stassen . .	1 R. P. C. 121	217, 218, 587
1865. Singer Machine Co. v. Wilson.	5 N. R. 505; 11 L. T., N.S., 670; 12 L. T., N.S., 140; 13 W. R. 560 (*Sewing Machines*).	379
1892. Skinner v. Porry . .	9 R. P. C. 406; 10 R. P. C. 1 (*Photographic Cameras*).	417
1889. Slazenger v. Feltham	6 R. P. C. 130, 232; 5 T. R. 354 (*Tennis-Bat Handles*).	123, 394, 397
1606. Smalt Patents, The .	1 W. P. C. 9	147
1852. Smith v. Buchanan .	25 S. J. 347	331
1870. Smith v. Buckingham	21 L. T., N.S., 819; 18 W. R. 314 (*Waterproof Fabrics*).	278
1875. Smith v. Buller . .	L. R. 19 Eq. 473 (*Watch-Chain Swivels*).	405
1857. Smith v. Davidson .	19 Court of Session 631 (*Ruling Ornamental Figures*).	319
1804. Smith v. Dickinson .	3 B. & P. 630 (*Saddles*) . .	274
1854. Smith v. Great West. Railway Co.	M. P. C. 221; 3 W. R. 69 (*Wheels*).	382
1890. Smith v. Lang . . .	7 R. P. C. 148 (*Wire Ropes*)	373, 381, 581

		Page
1853. Smith v. London & North West. Railway Co.	2 E. & B. 69; M. P. C. 188; 17 Jur. 1071 (*Wheels*).	281, 310, 401
1871. Smith v. London & South West. Railway Co.	23 L. J. Ch. 552; 2 Eq. Rep. 428, Kay, 408; 2 W. R. 310 (*Wheels*).	353
1867. Smith v. Noale . . .	2 C. B., N.S., 67; 26 L. J. C. P. 143; 28 L. T. 67; 29 L. T. 93; 3 Jur., N.S., 516 (*Toys*).	277, 278
1850. Smith v. Scott . . .	6 C. B., N.S., 771; 28 L. J. C. P. 325; 5 Jur., N.S., 1356 (*Wire Ropes*).	268
1813. Smith v. Upton . .	6 M. & S. 251	357
1850. Smith's Patent . .	(Pettit Smith's Patent) 7 Moo. P. C. C. 133 (*Screw-Propeller*).	332, 337, 346
1835. ,, ,, . .	M. P. C. 232 (*Wheels*) . .	220
1852. ,, ,, . .	2 R. P. C. 14 (*Anchors*) . .	348
1854. Smith's Application .	Griff. 265	135, 243
1853. Soame's Patent . .	1 W. P. C. 725 (*Combustible Oils*).	329, 333, 334, 336
1883. Société Anonyme des Manufactures de Glaces v. Tilghman's Patent Sand Blast Co.	L. R. 25 Ch. D. 1; 53 L. J. Ch. 1; 49 L. T. 451; 32 W. R. 71 (*Lamp Globes*).	321, 415
1893. Solvo Laundry Co. v. Mackie.	10 R. P. C. 68 (*Washing Pulleys*).	370, 579
1891. Southby's Patent . .	8 R. P. C. 433 (*Refrigerators*)	337
1857. Southworth's Patent .	1 W. P. C. 480 (*Drying Cylinders*).	337
1884. Speckart v. Campbell	W. N. (1884) 24 (*Watch Cases*).	301
1850. Spence's Patent . .	3 Re G. & J. 523; 7 W. R. 137 (*Tinned Plates*).	240
1862. Spencer v. Jack . .	3 De G. J. & S. 346; 1 N. R. 114; 11 L. T., N.S., 242 (*Steam Engines*).	101, 335
1885. Spencer v. Ancoat's Vale Rubber Co.	6 R. P. C. 46; 4 Times R. 681 (*India-Rubber Springs*).	324, 356, 426, 531
1885. Spiel's Patent . . .	3 R. P. C. 281 (*Engines*) . .	247
1853. Stafford's Patent . .	1 W. P. C. 263 (*Carriages*) .	337
1891. Stavart v. Pausburg Grain Syndicate.	8 R. P. C. 406 (*Drying Grain*)	278
1845. Stead v. Anderson .	4 C. B. 478; 2 W. P. C. 147; 16 L. J. C. P. 250 (*Pavements*).	141, 298, 316, 395
1847. Stead v. Carey . . .	1 C. B. 496; 14 L. J. C. P. 177; 9 Jur. 511 (*Wood Pavement*)	350

		Page
1844. Stead v. Williams . .	2 W. P. C. 126, 137; 7 M. & G. 818; 8 Scott. N. R. 443; 13 L. J. C. P. 218; 8 Jur. 930 (*Wood Pavement*).	141, 153, 159, 295
1846. Stead's Patent . . .	2 W. P. C. 143 (*Wood Pavement*).	350
1872. Steele v. Hutchinson .	W. N., 1879, 18	402
1892. Steers v. Rogers . .	9 R. P. C. 186; L. R. 2 Ch. (1892) 13; L. R. App. Cas. (1893) 232; 10 R. P. C. 245 (*Gas Manufacture*).	282
1871. Steiner v. Heald . .	6 Ex. 607; 20 L. J. Ex. 410; 17 Jur. 875 (*Dyes*).	335
1891. Stell's Patent . . .	8 R. P. C. 215 (*Twisting Wool*)	252
1847. Stevens v. Keating .	2 W. P. C. 175; 2 Ex. 772; 19 L. J. Ex. 57 (*Artificial Stone*).	41, 45, 180, 194, 201, 210, 303, 324, 352, 356
1885. Stewart's Patent . .	3 R. P. C. 7 (*Sugar Mills*) .	332, 335, 337, 347
1883. Stewart v. Briggs . .	11 Ch. Sess. Cas. 4th Ser. 236 (*Metal Pipes*).	302
1891. Stewart v. Casey . .	8 R. P. C. 259 (*Storing Inflammable Liquids*).	267, 275, 350
1817. Stocker v. Rodgers .	1 Car. & Kir. 99 (*Straps for Wearing Apparel*).	407
1846. Stocker v. Waller . .	1 C. B. 148; 14 L. J. C. P. 90; 9 Jur. 130 (*Pumps*).	225
1851. Stoll's Patent . . .	21 L. T. 223; 1 W. R. 472 (*Shoes*).	249
1875. Stoner v. Todd . . .	L. R. 4 Ch. D. 58; 46 L. J. Ch. 32; 35 L. T., N.S., 601; 25 W. R. 38 (*Shutters*).	170, 171
1885. Stoney's Patent . .	5 R. P. C. 518 (*Sluices*) . .	326, 327, 345, 348
1893. Stuart's Application .	9 R. P. C. 452 (*Fishing Nets*).	248
1851. Stubb's Patent . . .	Griff. 208 (*Floating Carpets*) .	252, 255
1828. Sturts v. De la Rue .	6 Russ. 322; 1 W. P. C. 83 (*Copper-plate Printing*).	154, 188, 193
1884. Sugg v. Bray . . .	1 R. P. C. 45; 2 R. P. C. 223; 54 L. J. Ch. 132 (*Gas Burners*).	208, 412, 415
1877. Sugg v. Silber . . .	L. R. 2 Q. B. D. 493; 45 L. J. Q. B. 460 (*Gas Burners*).	346, 377
1857. Swaine's Patent . .	1 W. P. C. 520 (*Mineral Waters*)	330
1796. Swan v. Fonnereau .	3 Ves. 41	12
1853. Swinborne v. Nelson .	16 Beav. 416; 22 L. J. Ch. 961 (*Artificial*).	265

		PAGE
1879. Sykes v. Howarth .	L. R. 12 Ch. D. 826; 48 L. J. Ch. 769; 41 L. T., N.S., 70; 28 W. R. 215 (*Carding Wire*).	101, 322, 324
1821. Sykes v. Sykes . . .	3 B. & C. 541 (*Trade-mark Case*).	130
1854. Talbot v. La Roche .	15 C. B. 310; 2 C. L. R. 856 (*Photography*).	364
1860. Tatham v. Dunn . .	Griff. 213 (*Dressing Textile Materials*).	77, 310
1862. Tatterwall's Patent .	9 R. P. C. 150 (*Air Blower*) .	251
1865. Taylor v. Haro. . .	1 H. & P. N. R. 260 (*Preserving Oil of Hops.*)	289
1856. Teague's Patent . .	Griff. 204 (*Rock-drill*) . . .	252
1818. Templeton v. Macfarlane.	1 H. L. C. 595	160
1862. Tennant's Case . .	D. P. C. 420; 1 W. P. C. 125; 1 C. P. C. 177 (*Bleaching*).	147, 230
1852. Tetley v. Easton . .	M. P. C. 48, 82; 2 Ell. & B. 956; 18 C. B. 643; 2 C. B., N.S., 706; 23 L. J. Q. B. 77; 25 L. J. C. P. 253; 26 L. J. C. P. 250; 18 Jur. 350 (*Raising Water*).	70, 85, 158, 187, 192, 196, 197, 201, 225, 385, 395
1858. Thomas v. Foxwell .	5 Jur., N.S., 37; 6 Jur., N.S., 271 (*Sewing Machines*).	310, 395
1861. Thomas v. Hunt . .	17 C. B., N.S., 183 (*Soap*). .	321
1892. Thomas's Patent . .	9 R. P. C. 367 (*Making Steel*)	338, 339, 343
1866. Thomar v. Tillie . .	17 Ir. C. L. R. 783 (*Sewing Machines*).	355
1846. Thomas v. Welch . .	L. R. 1 C. P. 192; 35 L. J. C. P. 200; 12 Jur., N.S., 316 (*Sewing Machines*).	171, 184, 217
1863. Thompson v. James .	32 Bear. 370 (*Steel Grinding Rings*).	120
. Thomson v. American Braided Wire Co.	*See* American Braided Wire Co. (*Bustles*).	
1885. Thomson v. Batty .	6 R. P. C. 81; 4 T. R. 36 (*Perforated*).	113, 188, 365, 372
1886. Thomson v. Hughes .	7 R. P. C. 71, 187; W. N., 1889, 212 (*Perforated*).	351, 352, 361
1850. Thomson v. Macdonald.	8 R. P. C. 5 (*Steam Boilers*) .	135, 365, 373
1886. Thomson v. Moore .	6 R. P. C. 126; 7 R. P. C. 326 (*Perforated Sheets*).	32, 113, 350, 360, 362, 363, 365

		PAGE
1876. Thorn *v.* Worthing Skating Rink Co.	L. R. 6 Ch. D. 415 (n.) (*Roller Skates*).	294, 303, 335
1892. Thwaite, *Re* . . .	9 R. P. C. 515 (*Boilers*).	301
1888. Tickelponny *v.* Army & Navy Society.	5 R. P. C. 405 (*Fireproof Buildings*).	126
1884. Tilghman's Sand Blast Co. *v.* Wright.	1 R. P. C. 103 (*Grinding Stone and roughening Glass*).	364, 375
1878. Tildely *v.* Harpor . .	L. R. 10 Ch. D. 393 . . .	375
1892. Todd, *Re*	9 R. P. C. 486 (*Bottle-stoppers*)	251
1856. Tolson's Patent . .	6 De G. M. & G. 422; 4 W. R. 518 (*Giving Metallic Lustre to Fabrics.*)	249
1875. Townsend *v.* Haworth	L. R. 12 Ch. D. 831 (n.): Higgin's Digest, p. 168 (*Preserving Cloth*).	322, 324
1873. Tranter's Patent . .	Johnson's Pat. Manual, 6th Ed., 131 (*Pistols*).	220
1683. Travell *v.* Carteret .	3 Lev. 131	14
1861. Trotman *v.* Wood . .	16 C. B., N.S., 479 (*Anchors*) .	289
1856. Trotman's Patent. .	L. R. 1 P. C. 118; 3 Moo. P. C. C., N.S. 488 (*Anchors*).	338
1891. Tucker *v.* Kaye . .	8 R. P. C. 61, 230 (*Locks*). .	131, 580
1787. Turner *v.* Winter . .	D. P. C. 145; 1 W. P. C. 77; 1 Term. R. 602 (*Painter's Colours*).	68, 185, 192, 358
1892. Twoodale *v.* Ashworth	9 R. P. C. 121	312
1889. Ungar *v.* Sugg . . .	6 R. P. C. 337; 9 R. P. C. 115; 5 T. R. 372 (*Gas Lamps*).	390, 417, 419
1888. Union Electrical Power Co. *v.* Electrical Storage Co.	5 R. P. C. 329; 38 Ch. D. 325 (*Electrical Storage*).	417
1888. United Horseshoe & Nail Co. *v.* Stewart.	2 R. P. C. 122; 3 R. P. C. 130; 4 R. P. C. 130; 5 R. P. C. 260; 13 App. Cas. 401 (*Nails*).	73, 399, 400, 401
1888. United Horseshoe & Nail Co. *v.* Swedish Horseshoe & Nail Co.	6 R. P. C. 1 (*Nails*). . . .	71, 73, 125
1883. United Telephone Co. *v.* Harrand.	2 R. P. C. 70; 3 R. P. C. 295; 2 T. R. 450, 840; 31 Ch. D. 630 (*Telephones*).	32, 135, 212, 375, 420
1884. United Telephone Co. *v.* Dale.	25 Ch. D. 778; 53 L. J. Ch. 295 (*Telephones*).	322, 330, 402
1886. United Telephone Co. *v.* Donohoe.	31 Ch. D. 399; 3 R. P. C. 45; 2 T. R. 301 (*Telephones*).	101
1885. United Telephone Co. *v.* Equitable Telephone Co.	3 R. P. C. 201 (*Telephones*) .	334

		PAGE
1882. United Telephone Co. v. Harrison.	21 Ch. D. 720; 51 L. J. Ch. 705; 46 L. T., N.S., 620 (*Telephones*).	85, 94, 158, 159, 171, 184, 411
1881. United Telephone Co. v. Henry.	2 R. P. C. 11 (*Telephones*). .	329
1881. United Telephone Co. v. London & Globe Telephone Co.	L. R. 26 Ch. D. 766; 1 R. P. C. 117; 32 W. R. 870 (*Telephones*).	221, 319, 354
1882. United Telephone Co. v. MacLean.	"Engineering" Newspaper.	83, 135
1880. United Telephone Co. v. Mitchell.	38 W. R. 70 (*Telephones*). .	363
1886. United Telephone Co. v. Mottishead.	3 R. P. C. 213 (*Telephones*) .	387, 591
1887. United Telephone Co. v. Nelson.	W. N., 1887, 193 (*Telephones*)	311, 322
1889. United Telephone Co. v. Patterson.	6 R. P. C. 140	406
1886. United Telephone Co. v. St. George.	3 R. P. C. 33. 321 (*Telephones*)	32, 298
1885. United Telephone Co. v. Sharples.	2 R. P. C. 28; 29 Ch. D. 164; 54 L. J. Ch. 633; 52 L. T. 384; 1 T. R. 259 (*Telephones*).	317, 318, 320, 400
1880. United Telephone Co. v. Smith.	38 W. R. 76 (*Telephones*) . .	363
1888. United Telephone Co. v. Tasker.	5 R. P. C. 628; 6 R. P. C. 38 (*Telephones*).	356, 362
1883. United Telephone Co. v. Townshend & Mercer.	3 R. P. C. 10 (*Telephones*) .	356
1886. United Telephone Co. v. Walker.	4 R. P. C. 63; 56 L. T. 508 (*Telephones*).	400
. Unwin v. Heath . .	*See* Heath v. Unwin.	
1871. Upmann v. Elkan . .	L. R. 12 Eq. 146; 7 Ch. App. 130 (*Trade-mark Case*).	408
1883. Upmann v. Forester .	L. R. 24 Ch. D. 231 (*Trade-mark Case*).	409
1885. Useful Patents Co. v. Rylands.	2 R. P. C. 255 (*Bottle-making*)	143, 572
1880. Van de Poele's Application.	7 R. P. C. 69	433
1888. Van Golder's Patent .	5 R. P. C. 22 (*Dust Separators*)	222, 224, 256
1892. „ „ „ .	9 R. P. C. 325 (*Dust Separators*).	252
1890. Van Golder Apsimon Co. v. Sowerby Bridge Flour Society.	7 R. P. C. 41, 208; 59 L. J. Ch. 202 (*Dust Separators*).	251, 359

		PAGE
1878. Vavasseur v. Krupp .	L. R. 9 Ch. D. 351; 39 L. T., N.S., 437; 27 W. R. 170 (*Projectiles*).	273, 404
1887. Von Buch's Application.	Griff. App. 40 (*Gas-Burners*).	250
1880. Von Heydon v. Neustadt.	L. R. 14 Ch. D. 230; 50 L. J. Ch. 126 (*Salicylic Acid*).	155, 321
1890. Vorwerk v. Evans .	7 R. P. C. 107, 205 (*Waistbands*).	205
1887. Walker v. Clarke . .	4 R. P. C. 111; 56 L. J. Ch. 239; 56 L. T., N.S., 111; 3 T. R. 207; 35 W. R. 245 (*Night Lights*).	410, 418
1881. Walker v. Hydro-Carbon Syndicate.	2 R. P. C. 3; 3 R. P. C. 253 (*Hydro-Carbon Oils*).	424, 427
. Walker's Patent . .	Griff. App. 22 (*Cotton Spinning*).	223
1880. Wallace's Application	6 R. P. C. 134 (*Coin Receiving Apparatus*).	252
1852. Wallington v. Dale .	7 Ex. 858; 23 L. J. Ex. 49 (*Making Gelatine*).	53, 306
1888. Wallis & Ratcliffe's Application.	5 R. P. C. 347 (*Gas Improvement*).	251
1842. Walton v. Bateman .	1 W. P. C. 613 (*Carding Wool*)	192, 232, 291, 366, 396
1860. Walton v. Lavater .	8 C. B., N.S., 162; 29 L. J. C. P. 276; 3 L. T., N.S., 272; 6 Jur., N.S., 1251; 1 W. P. C. 48n. (*Carding Wool*).	276, 279, 316, 321
1841. Walton v. Potter . .	1 W. P. C. 585; 11 L. J. C. P. 135; 4 Scott N. R. 91; 3 M. & G. 411 (*Carding Wool*)	192, 232, 178, 294, 324
1897. Ward v. Livesy . .	5 R. P. C. 102 (*Loom Dobbies*)	287
1850. Warwick v. Hooper .	3 Mac. & G. 60 (*Knitting Machines*).	287
1886. Warman's Application.	Griff. App. 43	255
1880. Washburn & Moen Manufacturing Co. v. Cunard Steamship Co.	6 R. P. C. 398 (*Barbed Fence Wire*).	360, 361
1884. Washburn & Moen Manufacturing Co. v. Patterson.	1 R. P. C. 167, 191; 2 R. P. C. 27 (*Barbed Fence Wire*).	397, 404, 420
1860. Watling v. Stevens .	3 R. P. C. 37, 147 (*Vans*). .	168, 171, 179, 183, 187, 414, 427

		PAGE
1882. Watson v. Holliday .	L. R. 20 Ch. D. 780; 48 L. T., N.S., 545; 30 W. R. 747; 31 W. R. 536; 52 L. J. Ch. 513 (*Steam Steering*).	399
1888. Webster's Application.	6 R. P. C. 165 (*Wire Ropes*) .	250, 251
1878. Wegmann v. Corcoran	L. R. 13 Ch. D. 65; 39 L. T., N.S., 505; 27 W. R. 357 (*Meal Grinding*).	186, 192, 411
1885. Welch's Patent . .	Griff. 300 (*Brick Making*) .	252
1891. Welch's Patent . .	8 R. P. C. 442 (*Velocipedes*) .	252
1887. Wenham Co. v. May .	4 R. P. C. 303 (*Gas Lamps*) .	309, 414
1887. Wenham Co. v. Carpenter.	5 R. P. C. 68 (*Gas Lamps*) .	225, 591
1891. Wenham Co. v. Champion Gas Co.	8 R. P. C. 22, 313; 9 R. P. C. 49 (*Gas Lamps*)	116, 364, 384, 414
1881. Werdermann v. Société Générale d'Electricité.	L. R. 19 Ch. D. 246 (*Electric Lighting*).	280
1845. Westhead v. Keene .	1 Beav. 287; 8 L. J. Ch. 89; 2 W. P. C. 36 (n.) (*Cutting India Rubber*).	353
1881. Westinghouse v. Lancashire Rail. Co.	1 R. P. C. 98, 229 (*Brakes*) .	211, 212, 386, 397, 404, 412, 414, 591
1883. Westinghouse v. Midland Rail. Co.	48 L. T., N.S., 98, 462 (*Brakes*).	382
1878. Westinghouse's Patent.	Griff. 315 (*Brakes*) . . .	220
1893. Westley Richards v. Perkes.	10 R. P. C. 193 (*Breech-Loaders*).	141
1886. Westrupp & Gibbins' Patent.	1 W. P. C. 554 (*Purifying Water*).	346, 350
1861. Wheatstone v. Wild .	Griff. 247 (*Telegraphs*) . .	235
1867. White v. Fenn . . .	15 L. T., N.S., 505; 15 W. R. 316 (*Oil Cans*).	310
1867. White v. Toms . . .	37 L. J. Ch. 204; 17 L. T., N.S., 348 (*Ladies' Hat Falls*).	121
1838. Whitehouse's Patent.	1 W. P. C. 473; 2 Moo. P. C. C. 406 (*Iron Tubes*).	327, 345
1859. Whitton v. Jennings .	1 Dr. & S. 110	354
1871. Wield's Patent . .	L. R. 4 P. C. 59; 8 Moo. P. C. C., N.S., 30 (*Winding Yarn*).	338, 342, 347
1888. Willacy's Patent . .	5 R. P. C. 630 (*Spreading Manure*).	327, 336, 348
1858. Williams v. Nash . .	28 L. J. Ch. 856; 28 Beav. 93	268, 270
1890. Williams v. Nye . .	7 R. P. C. 62 (*Mincing Machines*).	129

		PAGE
1863. **Willis *v.* Davison** . .	1 N. R. 234 (*Organ Bellows*).	120
1888. **Wilson *v.* Barbour** .	5 R. P. C. 245, 675 (*Spinning Rope Yarn*).	283
1885. **Wilson *v.* Church Engineering Co.**	2 R. P. C. 175 (*Cylinders and Valves of Steam Engines*).	418
1875. **Wilson *v.* Gann** . .	23 W. R. 646	366, 376
1892. **Wilson *v.* Union Oil Mills.**	9 R. P. C. 66 (*Refining Oil*) .	65, 132, 286, 289
1862. **Wilts Peerage Case** .	L. R. 4 H. L. 126	10
1889. **Winby *v.* Manchester Steam Tramways Co.**	6 R. P. C. 359; 7 R. P. C. 30; 8 R. P .C. 68 (*Tramway Crossings*).	131, 154, 158, 301
1884. **Winter *v.* Baybut** . .	1 R. P. C. 70 (*Cotton Cloths*).	218
1879. **Wirth's Patent** . .	L. R. 12 Ch. D. 303, 28 W. R. 329 (*Colours*).	233
1884. **Wittman *v.* Oppenheim.**	L. R. 27 Ch. D. 260 (*Copyright Case*).	316
1845. **Wood *v.* Ledbitter** .	13 M. & W. 838; 14 L. J. Ex. 161.	236
1845. **Wood *v.* Zimmer** . .	1 W. P. C. 82; 1 C. P. C. 290 (*Zinc Paint*).	145, 191
1841. **Woodcroft's Patent** .	1 W. P. C. 740; 3 Moo. P. C. C. 171 (*Printed Fabrics*).	333
1846. „ „ *In re.*	2 W. P. C. 18 (*Boat Paddles*)	154, 157, 336
1887. **Woodhead's Application.**	Griff. App. 44 (*Fire Stoves*) .	255
1887. **Woodward *v.* Sansum**	3 R. P. C. 357; 4 R. P. C. 166; 56 L. T., N.S., 347 (*Pencil Cases*).	170, 171, 405
1869. **Wren *v.* Weild** . . .	L. R. 4 Q. B. 213, 730; 38 L. J. Q. B. 88, 327; 20 L. T., N.S., 277, 1007 (*Sewing Machines*).	363, 364, 415
1870. **Wright *v.* Hitchcock** .	L. R. 5 Ex. 37; 39 L. J. Ex. 97 (*Frills or Ruffles: see* Arnold *v.* Bradbury).	166, 316, 320
1837. **Wright's Patent** . .	1 W. P. C. 561 (*Needles*) . .	327
1839. „ „ . .	1 W. P. C. 575 (*Washing Linen*).	337
1843. „ „ . .	1 W. P. C. 736 (*Tiles*) . .	325
. **Wyath *v.* Stone** . .	*See* Arnold *v.* Bradbury . .	197
1868. **Yates, *Ex parte*.** . .	L. R. 5 Ch. 1; 21 L. T., N.S., 663; 18 W. R. 1, 153 (*Furnaces*).	249
1887. **Yates & Kellett's Patent.**	1 R. P. C. 130; L. R. 12 App. Cas. 147 (*Wire Cords*).	339, 340
1883. **York *v.* Stowers** . .	W. N. (1883) 171	398

		PAGE
1861. Young *v.* Fernie . .	1 De G. J. & S. 353; 4 Giff. 577; L. R. 1 H. L. 63; 33 L. J. Ch. 192; 35 L. J. Ch. 523; 2 L. T., N.S., 510; 10 L. T., N.S., 861; 11 L. T., N.S., 637 (*Bituminous Substances*).	101, 389
1891. Young *v.* Hermand & Co.	8 R. P. C. 263; 9 R. P. C. 373 (*Mineral Oil and Ammonia*).	290
1881. Young *v.* Rosenthal .	1 R. P. C. 29 (*Vessels*) . .	46, 69, 314, 316, 380, 411

ENGLISH PATENT PRACTICE.

INTRODUCTION.

PRINCIPLES, ORIGIN, AND GENERAL FEATURES OF THE LAW OF LETTERS PATENT.

INTRODUCTION. SECT. 1.

The nature of an invention. There is no property in inventions at Common Law

1. The nature of an invention. There is no property in inventions at common law.—There can be no doubt that the development of civilisation in all ages has been chiefly due to the progress of the arts, and the increase of wealth in Great Britain during the present century has mainly depended upon the ingenuity of British inventors.

But the history of industry in England proves that it is almost impossible for a patentee to reap the reward of his labour, without financial help and legal assistance.

The poor inventor, pressed by lack of means, with an ill-drawn patent and a want of business capacity, too often sees his invention pirated, and even his claim to the credit of it disputed, until, like Cort, the founder of the iron industry in England, he is reduced to a pauper's grave.

By an invention, in ordinary language, we mean the result of the exercise of the imaginative or constructive faculty. Thus, we speak of the "inventions" of a poet,

Inventor.

The meaning of an invention.

a painter, a chemist, or an engineer. As used in patent law, the word "invention" has a slightly different meaning; it is somewhat wider in one direction, and somewhat narrower in another. For in patent law the word inventor also includes the "importer" of an invention, and on the other hand, since the granting of patents is restricted to inventions of new manufactures, authors, poets, and painters must look elsewhere than to patent law for protection for creations of their genius.

An invention is sometimes spoken of as the property of the inventor, as though he had a right to that which he has created; this, however, is an error. It is true that the author of a book is considered in law as having a property in the copyright of it, by reason of his labour in producing it. This is sometimes treated as a sort of title by occupancy, and has been regulated, and in some respects curtailed, by statute. But though an analogous property might logically be deemed to exist in an invention, yet such property has never been recognised by our law, and the only way in which an inventor can obtain any special benefit from his invention, is by virtue of the Royal prerogative exercised in his favour for the advantage of trade.

The granting of a patent is not a matter of right, but is at the pleasure of the Crown. It is in the highest degree unlikely that the Crown would refuse a patent or would restrict the number of years for which it was granted, but it is necessary to remember that no Act of Parliament compels the Sovereign to grant patents, and it would be quite possible for the King, with the advice of the Ministry of the day, supported by public opinion, to withhold any patent, or impose new conditions on the

patentee, providing always that the provisions of the Patent Acts were not violated.

Introduction. sect. 1.

Thus, for instance, the Crown might refuse to grant a patent altogether, but if it were granted, no higher fee could be taken than that specified in the Acts of Parliament. Therefore, a patentee's claim is not like a man's property in a copyright, it is a matter of grace and favour, only extended to him on account of the public advantage which will be derived from his invention. This right to withhold a patent has been especially saved by sect. 116 of the Patent Act of 1883.

The nature of an invention. There is no property in inventions at Common Law.

2. The origin of the law of patents.—Before commencing a detailed exposition of the patent law as it at present exists, it may be useful first to examine its origin, and then to summarise briefly its salient features, so as to give a bird's-eye view of the subject as a whole, and render more easy the consideration of the various parts, and their co-relation to one another.

In the first place it is necessary to observe that, according to the Law of England, the King has been invested from time immemorial with certain peculiar powers, called his prerogatives. Thus, for example, he is the fountain of honours; he alone has the right of making peace and declaring war, and of sending embassies to foreign states. All judicial acts are in theory done in his name, and he is also the guardian of trade and commerce (see Amos' Notes to Fortescue; Stanford on the Prerogative; Allen's 'Rise and Growth of the Prerogative in England').

Origin of the power of the Crown to grant monopolies.

But it is not to be understood that the King can exercise his prerogative in the above matters simply at his own pleasure, and in an unlimited way. In a monarchy such as that of Great Britain, the King can

Introductory. sect. 2.

The origin of the law of patents.

only use his powers according to precedent, that is to say, in the way and to the extent to which they have been anciently exercised (Blackstone's Commentaries, vol. i. p. 238). It is the express duty of the Courts of Justice to moderate and regulate the prerogative so that it shall be used in a manner conformable to the law of the land. Again, this prerogative is not entrusted to the King merely as a source of revenue or profit. It is a trust, to be exercised only for the good of the Commonwealth (*per* Lord Kenyon, 4 T. R. 410; see also 3 Atk. 171).

There is yet another safeguard which has gradually grown up against the abuse of the Royal prerogative. For whereas in theory the King can do no wrong, and in theory he may, within its due limit, use his prerogative as he pleases, yet in practice he cannot do so except by means of his principal ministers, who are responsible to Parliament and to the courts of law for the advice which they give to him.

The prerogative of the Crown is of course liable to be curtailed, or extended, or regulated by an Act of Parliament, which is the highest expression of sovereign power that the State possesses.

It is, however, a principle of the interpretation of statutes, that the prerogative cannot be curtailed by implication, but only by express enactment. For no Act of Parliament binds the Crown, unless it is either expressly provided that the Crown shall be bound, or unless it appears from the statute that the curtailment of the prerogative was clearly intended.

One of the prerogatives of the King, which appears to be very ancient, is the privilege of protecting and regulating both external and internal commerce.

The origin of the law of patents.

In these days no interference with industry takes place except by virtue of the advice of both Houses of Parliament, expressed in a statute. But in earlier times it was by no means unusual for the King to exercise his prerogative for what was considered the benefit of trade, even in cases where no Act of Parliament had dealt with the subject. Thus, for instance, the King always claimed the right to grant and regulate markets and fairs, and to select the most convenient places and times for the holding of them. Again, the King has always possessed the prerogative of fixing the amount and character of the coinage, and probably originally also of weights and measures.

But it is to be remarked that in all these cases, as stated above, the acts of the King must be done according to ancient custom: they must be for the benefit of trade, and they are always liable to be controlled by parliamentary enactment.

Among the methods by which the King has been accustomed to use his prerogative for the protection of trade, is the formulation of regulations as to the persons who may carry it on, and the places where they may exercise their craft. In our time the tendency has hitherto been in favour of complete freedom, so that we find it difficult to realise the condition of mind which desired and courted protection. And yet to our ancestors nothing seemed more proper than that particular industries should be restricted to particular persons or guilds, whose members had served their apprenticeship, and that foreigners should be admitted only with caution. Nay, more, even the garments which the various classes of the community should wear, the prices that should be paid for their make, and the materials of

Interference of the Crown.

The origin of the law of patents.

which they should be composed, were all considered reasonable objects of State interference. Thus, in the reign of Charles I., proclamations were issued that no more than 2s. a head should be paid for an ordinary dinner; bakers were prohibited from making into more than thirteen loaves the flour which, under the assize of bread, ought to serve for twelve; tavern keepers were forbidden to sell cooked meat, or to charge more than 2d. for the bait of a horse (A.D. 1634). Similar intervention on the part of the State may be found in the history of Venice and the other States of Italy; in France; in Spain; in the German Empire; and in fact all over Europe.

This power to regulate trade was not admitted as boundless. It was used more or less in accordance with ancient precedent, according as the power of the reigning King was weak or strong. But in theory at least, it has been always held in our law, whenever the voice of the judges was not silenced by tyranny or by corruption, that the right of regulating manufactures must be exercised primarily for the good of trade and the advantage of the subject.

The manner in which the Crown has generally used its right of controlling industry, is by the granting of monopolies for the practice of certain trades. But though the power of the King to regulate trade is unquestioned, yet the regulation of trade by means of monopolies has always been looked upon with suspicion by the Courts. Monopolies are very repugnant to the spirit of our constitution. For instance, that sort of monopoly which is produced by forestalling and regrating has ever been held to be against the law. Combinations of workmen or of employers whose object

was by means of monopoly to raise prices have been always regarded with disfavour. Nay more, so decidedly does the law lean against any restrictions on the right of every one to pursue his industry freely, that it is *ultra vires* for a man to contract not to exercise his trade, except for a limited time and within a limited area.

Increase of power. Origin of the law of patents.

But within limits the power of the Crown to grant trade monopolies was recognised long before the days of Elizabeth.

When by virtue of the Royal prerogative a privilege is granted to a subject, and thus, as it were, a portion of that prerogative is delegated to him, he is said to be possessed of a franchise. Hence all monopolies created by virtue of the prerogative are franchises.

We shall enter more fully hereafter into the nature of the industrial monopolies which the King can grant. It is sufficient here to say that, in spite of the extravagant claims of the Tudor kings, the law has only recognised monopolies, limited as to time, and granted only for new manufactures, which are useful to the public, in that they introduce into practice arts or crafts unknown before.

The mode in which a franchise can be created is also limited and restricted. For by virtue of his prerogative, the King in making grants does so in ways and with formalities peculiar to himself. He is more capable than a subject in some things, for instance he can assign a chose in action at common law where a subject could not, and debts to him are preferred to the debts due to other creditors. But he is less capable than the subject in other matters. Thus, for instance, he cannot grant a franchise except by record.

The principal mode in which the King makes a grant

Introductory. PART. 2.

The origin of the law of patents.

by record is either by Royal Charter or also by the issue of what are termed "Letters Patent" or "open letters" sealed with the great seal, of which the Lord Chancellor is the nominal custodian, which operate so to record the grant that it is at once supposed to be matter of public notoriety, and every one is presumed to be aware of it. This is the origin of the word "patent."

Inasmuch as the foundation of all rights conferred by Letters Patent is always to be sought in the words of the grant, it becomes necessary to give a sketch of the principal characteristics of Royal Letters Patent, and of the rules recognised for their interpretation.

(1.) In the first place it is essential to the validity of a Royal grant that it should be within the law, for the King is not above the law, but subject to the law (Blackstone's Commentaries, vol. i. p. 234). Hence no Letters Patent can be valid which are repugnant either to the Common Law or to a statute. (Examples of this rule may be found in Viner's Abridgment, tit. 'Prerogative,' Y. 6, vol. xvii, fo. 192, p. 124, if any authority be needed for so obvious a proposition.)

(2.) Closely allied to the principle that the King cannot make a grant contrary to law, is the rule that he cannot make any grant to the prejudice of vested rights.

From this it follows that if he has made by patent a valid grant to one person, he cannot derogate from it by a subsequent grant of the same thing to another. In the older books many instances are to be found in which such subsequent grants have been repealed.

But the case of *Sir Oliver Butler* (1661, 3 Lev. 220), goes even further, and shews that a second grant which even interferes unfairly with the first will not be good.

Introduction
Sect. 2.
The principles of the law of patents.

From this it follows that the King when once he has granted a patent to one person or persons, cannot make a valid grant of the same subject-matter to others. In the case of Letters Patent for inventions there will in general be other reasons also why the second grant will be bad, for the publication of the invention granted by the first patent will destroy the novelty of the second. But where the patents closely follow on one another, so that the second is granted before the first is published, it may become necessary to apply the principle stated above, which cases will be more fully discussed hereafter.

(3.) In the next place no grant from the Crown is good unless it is certain, that is to say, unless it is so expressed, that the subjects of the King may know what it is he has granted.

This doctrine will be found laid down as to patents in general in *Lightfoot* v. *Lenet*, 1618, 2 Croke, 421, and in several cases quoted in Comyn's Digest; tit. 'Grant,' (i. 6: and in Viner's Abridgment, tit. 'Prerogative,' F. c., fo. 196, vol. xvii., p. 140; and its application to the law of patents for inventions has been approved by Heath (J.), in *Boulton* v. *Bull*, 1795, 2 H. B., p. 484.

(4.) Again, any grant which contains an expression of the King's intention in making the grant will be void, if the grant obviously contradicts the intention (1 Co. R. 46 a). From this principle it would follow, that, if the King expressed the patent to be made for the encouragement of all inventions which may be for the public good, and the grant was of a monopoly for some invention which was clearly not for the public good, on this ground alone it would be void.

(5.) The next principle is, that if a patent purport to be made upon a mistaken consideration or suggestion

Introduction. sect. 2.

The origin of the law of patents.

which is in fact false, even though not made with any intention to deceive, the grant is void for deceit. This is a very old and well-known principle (see 5 Co. 94 a., and a large collection of cases in Viner's Abridgment, 'Prerogative,' M. C. fol. 100, vol. xvii., p. 151). Thus, in the case of the *Eastern Archipelago Co.* v. *Reg.*, 1853, 2 E. & B. 802, Baron Parke said:—"If the King has been deceived by a false suggestion as to what he grants, on the consideration for his grant, if he appears to have been ignorant or misinformed as to his interest in the subject-matter of his grant, if the language of his grant be so general that you cannot in reason apply it to all that might literally fall under it, or if it be couched in terms so uncertain that you cannot tell how to apply it with that precision which grants from one so specially representing the public interest ought to have, or if the grant reasonably construed would be injurious to the vested interests of the subject, or would work a wrong, or something contrary to law; in these, and such like cases, the grant would be wholly void, or restrained according to circumstances, and equally so whether the technical words, '*ex certa scienta et mero motu*' be used or not. To hold grants valid and unrestrained in such cases would be *deceptione domini regis*, and not *secundum intentionem*" (see also *Leadstains* v. *Earl of Sandwich*, 1842, 4 M. & G. 1028; *Wilts' Peerage* case, 1862, L. R. 4 H. L. 126). This principle has been repeatedly applied to grants for inventions. In fact it is one of the principal pillars of patent law, and causes all patent grants whenever obtained by erroneous representations on the part of the patentee to be void: *e.g. Hills* v. *London Gaslight Co.*, 5 H. & N. 340; *Hills* v. *Thompson*, 1817, 8 Taunt. R. 375. This will be further considered hereafter.

Interpretation of grants.

The recitals of the letters patents.

(6.) Another rule is, that whereas recitals in a deed are put in for the express purpose of binding both grantor and grantee, so as to avoid future disputes, yet recitals in a Crown grant only bind the grantee, and the King is always at liberty to shew that any one of them is untrue. For in a Crown grant, the recitals, instead of being treated as binding the King not to dispute them, are treated either as the representations made to him, or motives of his grant, and if any one of them is false the whole grant fails. For example, it has been held that if a patent recites that a benefice is in value under £20 a year, and the value is really greater, the whole patent fails, but the grant would have been good had there been no recital at all. (*Lord Chancellor's* case, 1612, No. 273, Hob. 214.) A distinction was once made as to cases in which the recital was on suggestion of the party and others in which the recital was on suggestion of the King: 1 W. P. C. 41. The distinction was never very sharply drawn between them, but those recitals which were clearly on the suggestion of the grantee were treated most severely. In all letters patent for inventions, there is a recital that the patentee "has represented that he is in possession of an invention, that he is the true and first inventor, and that the same is not in use by any other person." And therefore since in the recital the grant is expressly declared to be made on the suggestion of the grantee, the strictest truth is required in all these representations.

(7.) Another rule is that a royal grant made upon a series of suggestions or considerations, is void if one of them fails. It is doubtful whether in a patent for an invention the part performed by the patentee can really be called the consideration. It is rather a series of

suggestions or conditions, upon the making and performing of which the patent is granted. In the case of *Feather* v. *The Queen*, 1865, 6 B. & S. 285, the question arose whether the Crown, having granted a patent for an invention, was prevented from using it, and it was sought in argument to treat the grant as a contract. But the Court negatived this view. The language therefore of *Brunton* v. *Hawkes*, 1821, 4 B. & Ald. 551; *Walton* v. *Potter*, 1841, 1 W. P. C. 585; *Cartwright* v. *Amyot*, 1800, cited 14 Ves. 136; *Gibson* v. *Brand*, 1841, 1 W. P. C. 329, in which the filing of a final specification is spoken of as the "consideration" or "price paid" for the grant, can hardly be considered verbally accurate. In any case, however, whether we treat the acts of the patentee as suggestions or considerations, it is certain that, if any one of them fails the whole patent is void. This is different from the case of grants between subjects, in which, if only a part fail, the grant will be supported, provided that the failure does not go to the whole root of the contract (see Bacon's Abridgment, 'Prerogative,' F., and Chitty on Contracts, chap. i. sec. 1). The principle was first applied to patent law in the cases of *Hill* v. *Thompson*, 1818, 8 Taunt. 401; and *Brunton* v. *Hawkes*, 1821, 4 B. & Ald. 541, as to which, see further, Chap. I. sec. 8.

(8.) Another principle applies to the mode of construing Crown grants. For whereas between subjects the rule is, that the grant shall be construed most favourably for the grantee, and against the grantor (Bacon's Abr. 'Grant,' L. 1; *Seton* v. *Pommeran*, 3 Ves. 41); yet where the King is the grantor, a contrary rule of construction applies, and the grant is construed most favourably for the Crown; see *Feather* v. *The Queen*, 1865, 6 B. & S. 295,

and the judgment of Lord Stowell in *The Rebekah*, 1799, 1 Rob. 227, 230; see also Plowden's Comm. 333. Comyn's Digest, 'Grant' G. 12; Viner's Abridg. 'Prerogative,' O. c., folio 200, vol. xvii, p. 153.

The origin of the law of patents.

Thus, if a private person were to make a grant of the "mines" under certain lands, this would carry mines of all sorts, but if the King made a grant of all the mines under certain of his lands, royal mines (*e.g.* gold and silver) would be presumed to be excepted. In the one case the word "mines" would be most favourably construed for the grantee, in the other it would be construed most unfavourably for the grantee.

It is, however, to be observed that where a good and valuable consideration accrues to the King for his grant, or where there is some public advantage from the grant, the strict rule of construction is greatly relaxed, "for the honour," as it is termed, "of the King." It is also possible by the insertion of suitable words, somewhat to mitigate the severity of this rule of construction. Accordingly, grants of patents for inventions, contain a clause that the grant "shall be construed in the most beneficial sense for the advantage of the patentee." These words give the Courts power to employ the beneficial construction, as will be explained further on, so that in so far as the interpretation of words and phrases is concerned, patents for inventions are now fairly construed, and with no strained meaning in favour of the Crown.

(9.) The last rule applicable to patents is that if for any reason a royal grant is void, it can be declared void, not only in proceedings instituted by way of *scire facias* for revocation of it (or in the case of letters patent for inventions, by a petition for revocation), but also in any suit against a third person brought by

Introduction. SECT. 2.

The origin of the law of patents.

a grantee to enforce his patent rights. This will appear from *Trarell* v. *Carteret*, 1683, 3 Levinz. 134; and *Alcock* v. *Cooke*, 1820, 5 Bing. 340. In the latter of these cases the plaintiff, under colour of a grant from the King, brought an action of trespass for taking wreck. It appeared that the grant was void, owing to a prior lease to a third person which was not recited in the grant. The defendant was allowed to take advantage of this defect, and the plaintiff's action was defeated. It thus appears that when the grantee of letters patent for an invention brings an action on his patent, the defendant is at liberty to shew in any way that he can that the patent is invalid.

Attempts have been made to mitigate the rigour of the above rules applicable to royal grants by reciting that the King made his grant *ex mero motu*, *speciali gratia et certa scientia*. These words are still contained in letters patent for inventions, but a critical examination of them will shew that they are not of much advantage to the patentee.

The words *ex speciali gratia* have the effect of reciting that the grantee has no common law right to his patent, but only receives it as a matter of grace.

The words *ex mero motu*, if they had any effect, would mean that no consideration was given for the grant, and that it was made on the motion of the King. If this could be upheld, then any want of consideration or misrecital, or error of suggestion, might of course become less fatal.

But such an interpretation of the grant is not admissible, because it would contradict the recitals. For the recital expressly says that "the inventor hath humbly prayed" for the grant. Whence it follows that the

The origin of the law of patents.

grant is not made *ex mero motu*, but on the suggestion and prayer of the grantee. Therefore, in accordance with the decision in *Needler* v. *The Bishop of Winchester*, 1615, Hob. 221, the words *ex mero motu* will be treated as *clausula clericorum*, a mere clerical flourish, and have but little weight.

The words *ex certa scientia* are intended to relieve the grantee from the consequences of a false recital. For it was thought at one time, the recital that the King knew of certain knowledge that a man was possessed of an invention, might save the patent even if that knowledge was false in fact. But there is no force in this contention; no estoppels bind the King; and whether a recital is put in stating that "a thing is so," or "that the King knows it to be so," any person is equally at liberty either to show that the recital is false in fact, or else that the recital "that he knows it" is untrue, For the King cannot be presumed to know an untruth. In cases of mere mistake in some unimportant part, the words still have an effect, and hence are useful as may be seen by consulting the old cases in Viner's Abridgment, 'Prerogative,' E. c. 3, fo. 196, vol. xvii, p. 196.

We thus see, (1) that an inventor has at common law no property in his invention, and can only obtain a monopoly for the use of it by virtue of a grant of letters patent by the Crown; (2) that this grant is a voluntary exercise of the royal prerogative; (3) that it can only be made for the encouragement of trade, and the good of commerce; (4) that the power of granting letters patent at common law was always restricted to new and useful manufactures, and limited in point of time (see Coke's Institutes, 84), and (5) that the letters patent when granted are subjected to special principles and rules of construction

INTRODUCTION. SECT. 2.

The origin of the law of patents.

very favourable to the Crown, and unfavourable to the grantee; rules quite different from those which are usually applied to the interpretation of contracts between subject and subject.

Although our ancient law undoubtedly contains indications that the power of the King to grant monopolies by letters patent was limited, yet such limitation was for many centuries very ill-defined, and, as may be supposed, gave rise to constant struggles between the people and the Crown. And many Acts of Parliament were passed in consequence: *e.g.* Mag. c. c. 9 Ed. III. st. 1, c. 1; Stat. of Cloths, 25 Ed. III. c. 2; Statatum de Stapulis, 27 Ed. III. stat. 2; 28 Ed. III. c. 13, s. 3; 31 Ed. III. c. 10; 2 Rich. II. st. 1, c. 1; 7 Hen. VII. c. 9; 12 Hen. VII. c. 6; 2 W. & M. st. 2, c. 9.

Grants of patents in the reign of Q. Elizabeth.

For the Tudor sovereigns, and notably Queen Elizabeth, had made claims to regulate trade and grant monopolies far in excess of what the Commons were disposed to allow. Accordingly, in our law books we find very divergent opinions upon the subject, ranging from the extravagant claims of some of the Crown lawyers to the moderate views of Sir Edward Coke, whose career afterwards suffered from the freedom with which his views were expressed and supported. It would be beyond the range of our present object to investigate this matter further, but those who desire to trace the history of the claims and power of the Crown to grant monopolies may consult Chitty's Prerogative of the Crown, chap. x.; 3 Coke's Institutes, chap. lxxxv., and Bacon and Petersdorf's and Viner's Abridgments, tits. 'Prerogative' and 'Monopoly.'

From these and other authorities, the truth seems to be that the Crown had in the days of Queen Elizabeth a

limited and modified right to grant monopolies, but not in restraint of already existing trades, nor unless it could be shewn or inferred that such monopoly was for the public advantage.

INTRODUCTION. SECT. 2.

The origin of the law of patents.

In Noy's Report of *Darcy* v. *Allin*, p. 182, it is stated that in the year 1567 there was a patent granted to Mr. Hastings of the Court, that in consideration that he brought in the skill of making of frisadoes, as they were made in Harlem and Amsterdam beyond the seas, being not used in England; that, therefore, he should have the sole trade of the making and selling thereof for divers years; charging all other subjects not to make any frisadoes in England during that time, under a penalty of £100. The patentee having filed a bill in the Exchequer against certain clothiers of Coxall, for making frisadoes contrary to the intent of the patent, it appeared, upon the examination of the cause, that the same clothiers did make baies very like to Mr. Hastings' frisadoes, and that they used them before Mr. Hastings' patent, for which cause they were neither punished nor restrained from making their baies like to his frisadoes. And from *Bircot's* Case (A.D. 1568), it would seem that the manufacture in respect of which the patent was granted must have been a new one: 1 W. P. C. 31, and Year Book, 15 El. 4, Easter Term; see also 3 Shepherd's Abridgment, 'Prerogative,' p. 57.

In the year 1602 the Case of *Darcy* v. *Allin*, reported in Coke's Reports, Part xi., fo. 84, gave rise to an investigation of the Crown power of granting monopolies. Queen Elizabeth had granted to Edward Darcy, a groom of the Privy Chamber, the sole license to make playing-cards for twelve years after 1600, at a yearly rent of 100 marks. Darcy brought an action against T. Allin, a

INTRODUCTION. SECT. 2.

The origin of the law of patents.

haberdasher, for infringing his patent. In the argument it was admitted by the plaintiff that the Crown could not restrain the practice of a trade or manufacture of useful things, but contended that in matters of recreation it had this power. The Court in their judgment were against the Patent, and in the course of it the following dictum was delivered, which has usually been regarded as an accurate exposition of the law upon the subject. The passage is not to be found in Coke's Report, but is given in Noy's Report of the same trial: "Now therefore, I will shew you how the judges have heretofore allowed of monopoly patents, which is, that where a man by his own charge or industry, or of his own wit or invention, doth bring any new trade into the realm, that in such cases the King might grant him a monopoly patent for some reasonable time until the subjects may learn the same in consideration of the good that he doth by his invention to the commonwealth, otherwise not": Noy, 1; 781 W. P. C. 6. Similar words were used by Sir F. Bacon in his speech on Monopolies: 1 Parl. Hist. 926. In Webster's Patent Cases a number of examples of early patents are given, and of the arbitrary way in which they were frequently revoked.

Although Sir E. Coke argued the case of *Darcy* v. *Allin* for the plaintiff, yet in his report (published long afterwards) he calls it an "odious monopoly." And in 1604 he became chairman of a committee of grievances of the House of Commons for suppressing illegal monopolies.

In 1610, King James I. published a book, entitled "A Declaration of His Majesty's Pleasure," wherein he expressly declared that grants of monopolies of existing industries were illegal, and that he would grant no more.

For a time this promise was kept, and those which

were granted, *e.g.* one for the importation of whalebone (see Proclamations of James I., Sept. 11, 1614) were expressed to be for new industries.

INTRODUCTION. SECT. 2.

The origin of the law of patents.

In the *Clothworkers of Ipswich* Case, 1615, it is said: "If a man hath brought in a new invention, and a new trade within the kingdom in peril of his life, and consumption of his estate, or stock, &c., or if a man hath made a new discovery of any thing: in such cases the King, of his grace and favour, in recompense of his costs and travail, may grant by charter unto him, that he only shall use such a trade or trafique for a certain time, because at first the people of the kingdom are ignorant, and have not the knowledge or skill to use it: but when that patent is expired, the King cannot make a new grant thereof. For when the trade is become common, and others have been bound apprentices in the same trade, there is no reason that such should be forbidden to use it": Godbolt, 252.

But gradually the old abuses revived, and patents were granted for all kinds of old manufactures, until the case of Sir Giles Mompesson, which resulted in the Statute of Monopolies, 21 James I. c. 3 (A.D. 1624).

The Statute of Monopolies, 1624.

By the Statute of Monopolies it was provided, in the year 1624, that in future the grant of monopolies should be restricted to "the term of fourteen years . . . of the sole working or making of any manner of new manufactures within the realm, to the true and first inventor and inventors of such manufactures which others at the time of making such letters patent and grant 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": 21 Jac. I. c. 3, s. 6, (46 & 47 Vict. c. 57, s. 46.)

post, p. 438.

INTRODUCTION. SECT. 2.

The origin of the law of patents.

It follows, from the above remarks, that the power of granting patents is not derived from statute, but is by the common law. "This Act," says Lord Coke (3 Inst., 184), "maketh patents no better than they should have been if the Act had not been passed."

Patents to be interpreted according to the principles regulating Crown grants.

Hence, then, all the principles as to the interpretation of royal grants, will still govern the interpretation of patents.

It is necessary to bear this in mind, because it explains how it is that the recitals in a patent do not bind the King, and how, in case any one of them is false, instead of the grantor being bound, as would be the case in an ordinary grant, the whole patent becomes void. Between private persons, even if the recital of a past consideration in a deed were false, the deed would stand (in the absence of fraud). But, as has been already explained, in the case of the King this is not so; therefore, if an invention be old or not useful, the patent for it will fail as against the King and the public, and yet a deed of sale or license of that very patent to another person for a sum of money would be good.

A curious question might perhaps be raised where the monopoly is granted not by a patent, but by an Act of Parliament, for it might be argued that in that case, the King having the advice of Parliament in the making of the grant, the grant must be construed in the ordinary way. The point was raised but not determined in *Boulton* v. *Bull*, 1795, 2 H. Bl., p. 500, and is not likely to arise again.

(3.) General view of the present law.—The law which governs the nature of the invention for which a patent may be granted is still the 6th section of the Statute of James I. c. 3, which limits the power of the

post, p. 435.

General view of the present law.

Crown to the granting of monopolies for the sole working or making of any manner of new manufacture to the first and true inventors, provided that they be not contrary to law or mischievous to the State by raising prices of commodities at home, or to the hurt of trade, or generally inconvenient. The period was to be for fourteen years only from the date of the grant, and the patents were to have only such force as they would have had if the Act had not been made.

It is to be observed that the publication of the invention by the patentee, was not originally insisted on, nor was it any part of the terms or conditions upon which the grant of letters patent was founded. The object of the framers of the Statute of Monopolies seems rather to have been the introduction of new mysteries or manufactures into England, than the publication of the methods of working them, for no provision for publication is contained in that statute. It is true that a few years before the Act was passed, namely, in 1611, a very curious patent for working metals granted to Sturtenant, expresses the grant to be made upon condition that the patentee should publish his invention. He complied with this by printing a work called 'Metallica,' which is the first specimen extant of anything in the nature of a specification, and is a curious jumble of poetry, philosophy and Scripture quotations, but contains very little to disclose the nature of the art which it professes to describe. This example was not imitated, and although in a few cases conditions were made for the inspection of the machines, or for the deposit of models of them in the Tower, yet it was not till the reign of Queen Anne that the law officers of that day made a regular practice of inserting into the grant a condition

INTRODUCTION. SECT. 3.

General view of the present law.

that the patentee should describe how to perform his invention. It is, therefore, quite an error to suppose that originally the making public the means of performing an invention was any part of the consideration for the grant of it. The true consideration upon which it was founded was the creation, or planting on English soil, of some trade which was previously not in use within the realm, and the greatest publicity expected, was that which would arise from the training of a number of apprentices and artificers in the practice of it.

For many years the Statute of Monopolies continued to regulate the granting of patents, but it was amended in 1835 (5 & 9 Will. IV. c. 83); 1839: (2 & 3 Vict. c. 67.); and again remodelled in 1852: (15 & 16 Vict. c. 83). Finally, in 1883, the whole question was taken up anew and a fresh Act passed which, with some successive amending Acts, is still in force. The policy of this last statute was chiefly directed to the lowering of the fees, an advantage which was counter-balanced by the prohibition to put more than one invention into a patent. All these Acts, however, like the Statute of Monopolies did, no more than regulate and limit the exercise of the royal prerogative, which is still the source from which the power of the Crown to grant letters patent is derived. It is probable that in using the word manufacture in the Statute of Monopolies, the framers of that Act intended some complete trade or branch of trade. But as inventions multiplied, it became so impossible to distinguish an improvement in an old trade, from a substantially new trade, that ultimately all improvements and new processes were treated as new manufactures. It is clear that in order to make an invention capable of being the subject of a valid patent, the invention must be for a

manufacture, not merely for a principle, nor an abstract method. It must in some way result or aid in the production of an article capable of being dealt with in the way of trade. Inventions are generally classified under the heads of new machines, processes of manufacture, and articles, and there is a further and co-ordinate division of them into new products, improvements and combinations. These all shade into one another so that it is often difficult to say to what class an invention belongs. It is sometimes important to determine this, especially in the case of "combinations," and the subject will be more fully dealt with hereafter. Patents can only be granted for "inventions," that is to say, for some advance on what was previously known, and not merely a change so obvious that any one could have made it. It will not therefore be sufficient for an inventor to suggest a mere substitute for some part of a well known machine and call it an invention. But the amount of the invention may be slight. Thus suppose some one suggested the mere substitution of a pivot (which is well-known) for a hinge in a door. This would be no invention, it would be the substitution of an obvious mechanical equivalent. But great stress must be laid on the word obvious, for suppose the substitution of the pivot had some advantage which it required invention and ingenuity to find out, then, if it were new, it is quite possible that a patent for it might be sustained. Each case must stand on its own merits, and often each case depends on the frame of mind of the Judge or arbitrator who decides it. What one man will think most ingenious another will consider obvious. And there is as great danger of under-valuing the ingenuity as of over-appreciating it.

INTRODUCTION SECT. 3.

General view of the present law.

Again the invention must be useful, that is to say, disclose a new and good way of doing a thing. It need not perhaps be absolutely better than anything that has gone before, but its utility must be such that there is a reasonable prospect of its being useful to somebody or in some circumstances. Thus if a man invented a new way for making sulphuric acid, he is not bound to shew that it is actually cheaper, quicker or more effectual than every method now in use; what he has to shew is, that it is a successful new method. It may not be very likely to be used, still it is an addition to the common stock of public knowledge, and in this sense is useful. But if a man were to expend great ingenuity in inventing some alteration which was no improvement at all, his invention would fail to afford good subject-matter for a patent, because of want of utility. For instance, it would be possible like the tailor in Gulliver's voyage to Laputa, to invent a method of taking the height of a man with a sextant, and to desig a special machine for the purpose, but it would be of no use when made, it would be far worse than an ordinary tape measure, and unless it possessed some peculiar advantage of its own, or capability of being turned to a useful purpose, would fail to support a patent. It must however be remarked that it is not a very easy thing to upset a patent on the ground of want of utility, especially now that each patent is granted only for one invention, for the fact that the defendant has infringed it, is some evidence that it was of use to somebody.

The power of the Crown to grant monopolies is for the encouragement of *trade*, not of the polite arts and sciences. From which it follows, that though no doubt the theoretical beauty of some scientific instrument may excite

our admiration and it may be the herald of a new path in discovery, no argument is so forcible in support of a patent as to shew that commercially the article made under it has been, or is sure to be largely bought by the public, or that the trade had been desiring to discover it, but failed until the inventor shewed them how it could be done.

No one can have been present at many patent trials, without observing the vital importance of enlisting the sympathy of the Tribunal. If the Court can be made to believe that the patent was taken out by an honest and meritorious inventor, who had expended great labour, overcome great obstacles, and at length really benefited the public by a good discovery, every effort will generally be made to support the patent. Nor is such sympathy wrongly enlisted; it is the object of all good law that a truly meritorious and candid inventor should not be deprived of his invention by a mere slip or by some immaterial or technical error.

In addition to being useful and ingenious, the patent must also be new, that is to say, it must not have been anticipated. By this it is not meant that a patent will always hold unless the invention has been identically produced before. It is enough to invalidate a patent if the substance of the invention has been previously known. Any sort of prior knowledge or prior publication in Great Britain, and accessible to the public, will be sufficient. Thus if it has been published in England in any magazine, or newspaper, or book, or used in any public place, or used in an open manner in any private place so that everyone could see it, or again if it has been printed in a foreign book placed in a library accessible to the public, and in a language which is reasonably likely

INTRODUCTION. SECT. 3.

to be understood by cultivated persons; such as German, Italian, French, or Spanish, this will be an anticipation.

General view of the present law.

But all prior publications do not stand quite upon the same level. It is far stronger evidence of anticipation to produce a description intended for those engaged in industry, and so written that they can understand it, than it is to produce a learned book, in which the invention is described from a theoretical point of view. And the reason is plain. In one case the trade were, or ought to have been, in the possession of the secret, in the other, it was only known to scientists, and required some adaptation or interpretation, though perhaps only a slight one, to render it available for the trade.

Prior public user by others than the patentee may also be an anticipation, even though it hardly amounted to a regular publication. For the words of the statute are "which others at the time of making such letters patent shall not use." There is, therefore, some distinction between anticipation by a prior publication and anticipation by prior user which should be borne in mind.

Prior user which has been abandoned may also be an anticipation if clear and certain, but the fact of abandonment is itself strong evidence that the invention was not complete, or else was only in that theoretical stage which can hardly be considered useful to trade. And therefore an inventor who takes up an abandoned invention, and for the first time makes it a success, generally occupies a very favourable position in a court of law, even though an expert may think that what he has done is not very much more than to succeed where the other happened to fail.

Assuming that an intending patentee is possessed of (1) a new manufacture, (2) of which he is the first in-

ventor, that is to say, which he has either invented or imported, (3) which has ingenuity, (4) utility, (5) has not been anticipated either by prior publication or public user, (6) and a patent for which, if granted, would not be in derogation of a former grant, or as it is commonly expressed, if his subject-matter is good, it is next to be considered how he must proceed to obtain his patent.

In former times he petitioned the Crown. To save the formalities of a petition it is now sufficient to make an application in proper form, accompanied at his option either by a provisional specification describing the invention or else by a complete specification, not only describing the invention, but pointing out how it is to be performed. The considerations which should guide his choice are discussed hereafter. If he only send in a provisional specification he is bound to follow it up within nine months with a complete specification, after which he receives a patent dated as of the day of the reception of his application. Till then he cannot proceed against anyone for infringement, nor in any case recover damages for infringements prior to the date of his complete specification. The procedure is described in detail hereafter, and is very simple. But great care and art are required in the choice of his title, and in the preparation of his provisional and complete specifications. These matters are discussed farther on, but it is essentially necessary for the comprehension of the subject, that some general indication should be given of the rules of law which apply to these instruments, and the reasons upon which these general rules depend.

We have seen that it is by his prerogative that the King grants letters patent, and that this prerogative, limited as it is by the Common Law is still further

INTRODUCTION. SECT. 3.

General view of the present law.

limited and regulated by statute. But although the King may grant a patent he is not compelled to do so, hence then, conditions may be imposed by the Crown quite apart from those required by the Common or Statute Law.

The form of the grant is set out in the Patents Act of 1883, but the Board of Trade has power to alter or amend it. The present form of grant recites that the inventor has represented that he is in possession of an invention for some specified object, that he is the first and true inventor, that it is not in use by any other person to the best of his knowledge, that he has prayed for the grant, and that he has particularly described the invention in his complete specification. It then recites the intent of the Queen to encourage inventions which are for the public good. Then follows the grant, to the patentee, his agents, and licenses to make, use, exercise, and vend the invention. Then follows a prohibition to others to make use of or put in practice the invention, and conditions that if it is made to appear to "us," or the Privy Council, that the provisions of the Statute of Monopolies had not been complied with, or he does not pay the fees, or does not supply the public service with articles made according to the invention in manner provided, that the grant shall be void.

The whole of the law upon which the subject-matter depends, and all the principles necessary to the drawing of specifications may be derived from the rules of Common and Statute Law, and the rules of construction which have been already described. Thus, for instance, the fact that the grant purports to be made on the prayer of the petitioner, causes the recital to be treated as his suggestions, hence then, if one of them is false,

General view of the present law.

the patent fails. The recitals that the patentee is the first and true inventor, and that others do not use the invention do little more than repeat the conditions of the Statute of Monopolies. The recital that the inventor has filed a complete specification particularly describing the nature of his invention puts upon him the necessity of having complied with this provision by a correct specification, according to the provisions of the Patent Acts. From which it follows :—

(*a*) That the invention must be correctly described in the title and specifications, for otherwise not only would the patent when granted be void for uncertainty in what had been granted, but the Queen would not have been correctly informed what the invention was. Thus, if in any material part the specifications do not agree with one another and with the title in describing the invention, if they are ambiguous, or if they do not clearly distinguish what it is that has been invented from what has gone before the whole patent will be invalid, even though the subject-matter be perfectly good.

(*b*) The complete specification must not only describe the invention correctly, but must also explain the best method with which the inventor is acquainted for putting it into practice, in a manner sufficient to be clearly intelligible, to a fairly skilful workman, acquainted with the manufactures to which the invention relates, and without the necessity of further experiments, except such as are necessarily incident to a fair trial of it.

The necessity for the observance of this condition does not directly arise by reason of the Common Law or the Statute of Monopolies, but upon the suggestion made in the grant that the patentee has, "by, and in his complete specification particularly described his invention."

INTRODUCTION. SECT. 3.

General view of the present law.

It may be observed that the old form of patent added the words "and in what manner the same is to be performed." But though these words are not in the modern form of grant they are clearly implied. For the Patents Act of 1883, s. 5, sub.-s. 4, distinctly requires that this shall be done in a complete specification, and it is clear that it is an absolute necessity in order to make the grant of the patent beneficial to the public. The kindred provisions that the specification shall commence with the title, and end with the claims (sub-sect. 5) has been held to be only directory, consequently its non-observance would not render a patent void, though it might be prejudiced.

It has also been pointed out that in Crown grants the failure of a part of the suggestions or considerations causes the whole grant to be void, and therefore a want of proper subject matter in a part of an invention, or a failure of essentials of description as to a part of it, in the title or specifications will be fatal to its validity.

Formerly a patent which was imperfect as to part of the invention, might be amended by disclaimer. Now it may be amended generally, but not so as to widen its scope or enlarge the grant.

As soon as the specifications are sent in they are submitted to an examiner, who sees that the form is technically correct and reports upon any obvious errors which the comptroller may require the patentee to amend. But such examination gives no validity to the patent.

When the complete specification has been accepted, it is published, and then during a period of two months any interested person who thinks that the patent contains an invention which is subject of a previous

patent, or who alleges that the invention has been stolen from him, or that the complete invention contains matter not in the provisional, and for which a patent has in the interim been applied for by him, may oppose the grant. A certain definite procedure is laid down for this opposition. But the right of opposing is limited to certain persons and for certain definite causes. If no opposition is offered, or if any opposition offered is unsuccessful, the patent is then sealed, but so as to date back to the date of the application. It follows that if a man after sending in his provisional specification discovers some legitimate development of it, he will be the first and true inventor of that development, even though someone else may have independently made it after the application and before the sending in of the complete specification.

The grant of a patent entitles the patentee and his executors and assigns to prevent the unauthorised or unlicensed use of his inventions and is valid until shewn to be bad; but such grant does not in any way cure an inherent defect in the subject-matter of the invention, or in the title or specifications, all of which may be afterwards impeached.

The patent is for fourteen years, but in cases in which the patentee can shew that his invention has been inadequately rewarded, the Privy Council can grant him a new patent for a term not exceeding fourteen years more. This is called extending the patent.

Having thus sketched very briefly the salient characteristics of an invention, it only remains to shew how it can be infringed. It is obvious that it is not needful that the infringing article should be an exact reproduction of the thing described in the patent. Any

INTRODUCTION. SECT. 3.

General view of the present law.

manufacture which substantially uses the invention patented, infringes it. It is not possible to lay down any rule which will decide when the exercise of the invention has been infringed; each case will stand upon its own merits. An example may serve to illustrate this. The invention of the Carbon Microphone depends on the fact that when an electric constant current is passed through two pieces of semi-conducting substance in contact, any vibrations of these substances induced by the air waves produced by the human voice, will cause variations in the current strength, very suitable for actuating a telephone, which consists of a coil of wire wrapped round the end of a magnet in close proximity to an iron diaphragm. Edison patented this in 1877, and contrived one of his instruments as shown in Fig. 1., where A is a metal resonating diaphragm put in connection with the circuit from which the current passes to a block of carbon B, and thence to a second block of carbon C, pressed against the first by a metal spring D, by means of which the current is carried away to the line. Two infringements of this took place, one by St. George and another by Bassano: *United Telephone Co.* v. *Bassano*, 1886, 2 R. P. C. 70, 3 R. P. C. 295. St. George's was like Fig. 2: *United Telephone Co.* v. *St. George*, 1886, 3 R. P. C. 33, 321. In this the whole diaphragm was made of carbon, and the carbon block held by the spring was replaced by a ball C, suspended by a fine metal conducting spring so as to press lightly against the carbon

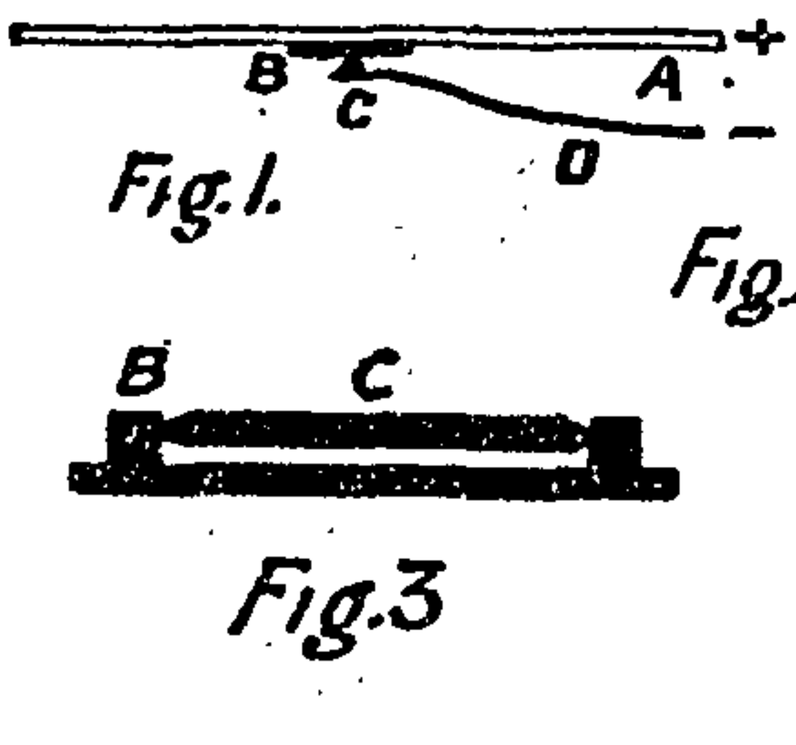


Fig. 1.

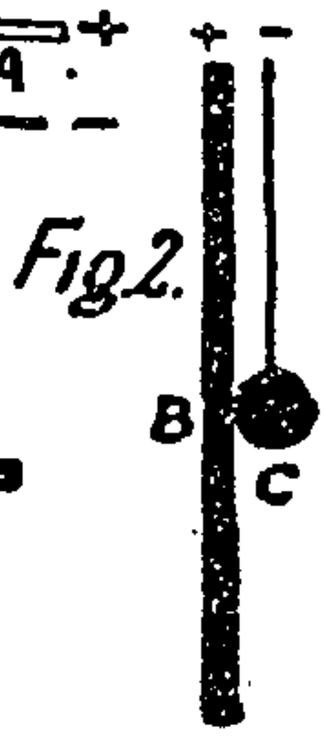


Fig. 2.

Fig. 3

diaphragm. This was considered as infringing the substance of Edison's inventions.

Bassano's infringement consisted of a wooden chamber which played the part of the resonating diaphragm and contained two pencils of carbon loosely fitted into holes in other pieces against which the pencils rested by virtue of their own weight. From a scientific point of view the action of this was similar to the others. Fig. 3 represents one of these pencils, and it was held an infringement.

It follows from what has been said that if the differences between the article complained of, and that described in the invention, only consist of immaterial changes, or of mere additions, an infringement will have been committed. To determine what is an immaterial change, one must be acquainted, not only with the description of the invention given in the specification, but with the state of the arts and manufactures at the time. For instance, a machine that in the infancy of the arts was a totally new departure, might, in a more advanced age, be considered as merely an obvious adaptation. Moreover, the very same difference which would be considered a colourable variation in one case might be held to constitute a different invention in another. Let us consider an example, in order to make this proposition clear.

Suppose, for instance, a man had invented a machine for stretching trousers (Fig. 1), as shewn in the drawing, consisting of two clamps, A and B, fitted to the top and bottom of the trousers and pushed apart by the screw C working in a loose collar D, and actuated by a handle. And suppose another made a trousers-stretcher as shewn in Fig. 2, so arranged that the trousers doubled over at the knee, and the top and bottom were secured to the

INTRODUCTION. SECT. 3.

General view of the present law.

same clamp, and the trousers were stretched by using a similar handle and screw to press against a piece of wood placed in the fold at the knee. Would this last be an infringement of the first? At first sight one would certainly be inclined to say that it was. The mere alterations of position of the clamps still left the general features of the invention untouched. But a more intimate knowledge of what had been done in the matter of trousers-stretchers might greatly alter that view. Suppose it were shewn that Figs. 3 and 4 had previously been invented. It would then be clear that



Fig. 1.

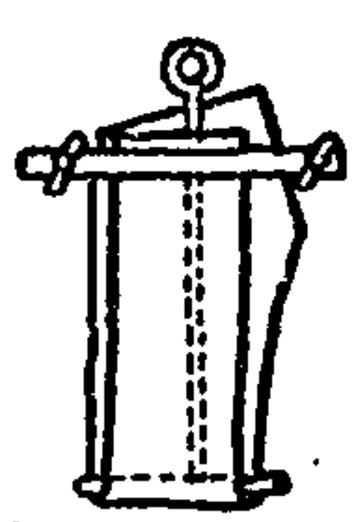
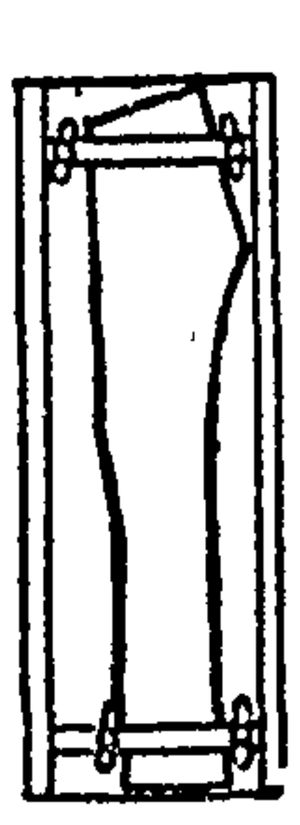

Fig. 2.



Fig. 3.


Fig 4.

the only way in which the invention shewn in Fig. 1 could be good, would be by considering it simply as a mere patent for a series of details. To read it as claiming generally the method of stretching trousers by clamps would make it clearly bad as being anticipated by the stretchers shewn in Figs. 3 and 4. Suppose that, after looking at its terms, the Court thought that the stretcher in Fig. 1 could be read as only claiming the peculiar details. Then it is clear that the stretcher shewn in Fig. 2 would not be an infringement. For if the gist of the invention were only a special and particular mode of stretching trousers, then that mode

had not been infringed. The defence of the defendant would clearly be, first, that the plaintiff's patent was anticipated by Guy's and by Dredge's (Figs. 3 and 4); but, second, that if it were read in so narrow a manner as to be considered merely a special mode of stretching the trousers, then the defendants did not infringe it: *Gosnell* v. *Bishop*, 1888, 5 R. P. C. 151. Here, then, the "Ambit" of the plaintiff's invention was controlled by the previous inventions of Dredge and Guy.

A plaintiff whose patent has been infringed may, after commencing an action, obtain an injunction, and also damages, or an account of profits made by the infringer. The various steps in this action are pointed out further on.

Any one who has been threatened with proceedings under the patent law may bring an action for damages and to restrain the threats, unless the person making the threats will follow them up by bringing an action of infringement. In an action for threats, the plaintiff, that is to say the person who has been threatened, may deny the validity of the patent of the defendant who has made the threats, and the issues will then be much the same as in an action for infringement.

According to old law a proceeding lay for the revocation of an invalid Crown grant, called a *scire facias*. This has now been replaced by a petition for revocation.

The various proceedings in an action or proceedings for revocation can only be taken by the parties themselves, or by duly qualified solicitors.

The functions of patent agents are to advise the parties as to their rights, and assist them in drawing their specifications, and arguing for them before the Comptroller or on appeals before the Law Officer. The

INTRODUCTION. SECT. 3.

General view of the present law.

duties of patent agents demand a good acquaintance with patent law, and considerable mechanical skill and knowledge. They have to pass examinations, and are put on a roll by the Board of Trade. The provisions of the Patent Acts are entirely insufficient to protect the public from unqualified practitioners who have given no security for their conduct or knowledge. For though it is penal to assume the title of a patent agent, yet it is permissible for anyone without knowledge, training, or character to use every other sort of title, however calculated to deceive an inventor into the belief that he is consulting a patent agent. And although patent agents are subject to regulations quite as stringent as those applicable to solicitors, and like solicitors are liable for negligence, they have no solicitors' lien, no professional privilege as to the secrets of their clients, nor any similar exclusive rights. It is high time in the interest of the public that these glaring injustices should be removed, and that within their sphere of action patent agents should have proper protection, so as to encourage all who wish to act as advisers to patentees to become regular qualified practitioners, and put a stop to the many frauds that are now being perpetrated upon ignorant inventors.

CHAPTER I.

THE SUBJECT-MATTER OF LETTERS PATENT.

WHAT has preceded has prepared us to see that a grant of Letters Patent (1) must not derogate from a prior grant; must be (2) for some manner of new manufacture; (3) that it must be useful; (4) that it must be ingenious, and (5) that it must not have been anticipated by prior publication or by prior public user by persons other than the patentee. We shall proceed to consider these questions in order.

1. No patent can be good which derogates from a former grant of Letters Patent.—It is a general rule of law that the King cannot make a grant to the prejudice of the vested rights of others. Hence, when he has granted a patent for an invention to one person, he cannot on a subsequent occasion make the same grant to another. No case appears to have arisen in which this has been expressly laid down with regard to patents for invention, but the same point has been decided with reference to a market, in *Sir Oliver Butler's* Case, 1661, 3 Levinz, 220, and further examples are to be found in Viner's Abridgment, tit. 'Prerogative,' M., b. 5, fo. 188, vol. xvii. p. 92; see also *R.* v. *Mussary*, 1738, 1 W. P. C. 41. The point is not likely to arise, except in cases where the second patent is granted before the complete

CHAP. I. SECT. 1.

No patent can be good which derogates from a former grant of letters patent.

specification of the first is sent in, and in which such specification contains some development of the invention not in the provisional. For otherwise the second patent would be bad on the ground of prior publication. When two patents are granted on the same day a curious question may arise as to which has priority. For judicial acts are assumed to take place at the earliest period of the day on which they occur, and fractions of a day are not noticed. It is otherwise with an act of the party, such as the issue of a writ: *Clarke* v. *Bradlaugh*, 1881, 8 Q. B. D. 63. It might be argued that a patent (being granted like a writ, on the motion of the party) is really an act of the party, but there is this difference, that a writ is a matter of right, a patent is a matter of grace. Moreover, it would be rather hard that the relative precedence of patentees should be determined by the order in which a patent-office official might happen to open his letters in the morning, for there is no possibility of shewing which is first of two letters that have come in by the same post.

A patent for the use of an improvement on a prior patent, is of course no derogation from the prior grant (see sect. 6).

post, p. 59.

The manner in which a plea of derogation may be raised is perhaps difficult to determine, for if a defendant may plead that the plaintiff's patent derogates from a grant to a third person, then surely the defendant may plead that that patent is bad and give particulars of objections, and try the whole question out in the absence, of the third person, which might be inconvenient and possibly unfair.

2. A patent must be for some kind of manufacture.—The power of the Crown to grant patents for inven-

A patent must be for some kind of manufacture.

tions is limited by the Statute of Monopolies, s. 6, to the "true and first inventor of any manner of new manufactures." For the power of the Crown is not exercised merely as a reward of ingenuity or scientific genius, but only for the furtherance of industry, and in its capacity as protector of trade: *Harmer* v. *Plane*, 1807, 14 Ves. 130, 136. It therefore becomes material to enquire what the word "manufactures" means. In the first place it is clear that the patent is not granted for the thing manufactured, nor the process of manufacturing, nor the machinery used therein. What the patent is granted for is the invention. It is, therefore, the *art* that is the subject of the patent.

For instance, if a patent were taken out for a new inkstand, it is not the inkstand which is the subject matter of letters patent, but the art by which the pieces of material comprising it are put together so as to form it. Or if a patent be taken out for a new medicine composed of old materials, the patent is in reality for the art of mixing them together so as to form the new compound.

Again, a patent for a process of manufacture is in reality only a patent for the art or craft by the aid of which that process is carried on. Except for an art, no patent can be granted. Thus, if a man discovers a totally new metal, he may have a patent for the art of making it, but not for the metal itself. When Crookes discovered Thallium, he could no doubt have taken out a patent for the art of producing it, but he could not have obtained an exclusive right to sell Thallium however made, even though it was a new product which he was the first to introduce to the world. On the other hand, when Sprengel invented his air-pump which

CHAP. I. SECT. 2.

A patent must be for some kind of manufacture.

operated by means of the fall of mercury from a height of more than thirty inches, he could probably have had a patent protecting the general idea of his machine, however carried out. But that is because the disposition of the glass, mercury, india-rubber, and wood that he employed was dictated by the new craft which he had invented.

In the case of Crookes the only industrial art given to the work by his new discovery of Thallium was the mode of making it.

Decisions have been given which would seem to imply, sometimes that the term "manufacture" means a process of making, sometimes a result obtained or an article made by that process. This proceeds from the ambiguity of the word "manufacture." Just as by the words "painting," or "drawing," or "sculpture," we may mean either the practice of the art, or the objects made by means of it, so also to the word manufacture we may give either an abstract or concrete meaning. There are some similarly formed words which admit of no such ambiguity. Thus we speak of the art of gardening, but the result of that art is a garden.

This ambiguity in the word manufacture has occasionally caused language to be used by the judges expressive of a doubt whether any patent could be granted for a process, and whether the only subject of a patent was not a manufacture in its concrete sense; that is to say a manufactured article. Thus, in *Rex* v. *Wheeler*, Abbott, C.J., thought that the word manufacture might "perhaps" extend to a new process: 1819, 2 B. & Ald. 349, and even in 1853, in *Crossley* v. *Potter*, M. P. C. 240, Pollock, B., says:—"It is in reality for the article that the patent is taken out, when it is said to be a process,

A patent must be for some kind of manufacture.

that only means a process resulting in an article." This mode of expression is clearly erroneous, but in *Boulton* v. *Bull*, 1795, 2 H. Bl. 493, Eyre, C.J., said:—"When the effect produced is no substance or composition of things, the patent can only be for the mechanism, if new mechanism is used; for the process, if it be a new method of operating, with or without old mechanism by which the effect is produced."

In *Morgan* v. *Seaward*, 1837, 2 M. & N. 558, 1 W. P. C. 193, Parke, B., said:—"The word manufacture may mean the machine when completed, or the process of constructing the machine."

And in *Crane* v. *Price*, 1842, 1 W. P. C. 393, the validity of a patent for a process was clearly assumed. See also *Stevens* v. *Keating*, 1847, 2 W. P. C. 182; *Bush* v. *Fox*, 1854; M. P. C. 176; *Gibson* v. *Brand*, 1841, 1 W. P. C. 630.

It therefore admits of no doubt that both a new article or tool, or machine, and also a new process of manufacture may become the subject of letters patent; only it is to be remembered that in strictness the monopoly is granted, not for the article or process, but for the art of constructing or carrying it on. So that when we speak of "a patent for a new pen," we really mean a grant by letters patent of the monopoly of exercising the craft of making that pen. Or, again, when we speak of a patent for making anilin, we really mean a grant of the monopoly of exercising the craft of some particular mode or modes of making anilin. In fact, unless there is some art to be protected, a monopoly cannot be granted at all. Thus, if a new drug were discovered in a foreign land, no patent could be granted to the discoverer of a right to import and sell it; all

CHAP. I. SECT. 2.

A patent must be for some kind of manufacture.

that could be granted would be a patent for preparing or using it in some particular way; or if a chemist discovered a new substance, he could only have a patent for some mode or modes of making or using it, but not for the thing itself.

But not every art is capable of being patented. It must be an art connected with trade, that is to say, an industrial art. The word "craft" is often used to signify an industrial art. It will therefore follow that no monopoly can be granted of a right to do things which are not done by the exercise of some craft. For instance, in *Boulton* v. *Bull*, 1795, Dav. P. C. 199, Mr. Justice Buller, said:—"Suppose the world were better informed than it is, how to prepare James' Fever Powder, and an ingenious physician should find out that it was a cure for consumption, if given in particular quantities, I think it must be conceded that such a patent would be void; and yet the use of the patent invention would be new, and the effect of it as materially different from what it is now, as life is from death. So, in the case of a late discovery, which, as far as experience has hitherto gone, is said to be efficacious—that of the medical properties of arsenic in curing agues—could a patent be supported for the sole use of arsenic in aguish complaints?" (The judge in speaking of the preparation of James' Powder, evidently refers to the fact that Lord Mansfield in the case of *Liardet* v. *Johnson*, 1778, cited James' invention as defective, because in the specification (dated 1747, No. 626) he mentioned the ingredients, but omitted the quantities: see 1 W. P. C. 55).

This example shews that a new use of an old material cannot be patented, unless such new use itself constitutes a manufacture. The art of curing an illness cannot be

A patent must be for some kind of manufacture.

said to be an art of manufacture, and it follows therefore that all old things may be used in new ways by private persons, provided always that in so using them they are not manufacturing anything. If a doctor discovered a medicine consisting of various ingredients, he might have a patent for it (of which a large number have been granted), and then no private person could make it up and use it (except simply as an experiment); but if the new medicine only consisted of one ingredient, or were only a new application of an old medicine, no patent for it could be obtained. In the first case, the patient would have to manufacture the dose before he took it, whereas, in the second case, no manufacturing process was needful, except the mere use of an already known article. Again, if any one discovered that some well-known drug was useful for any new domestic purpose, he could not prevent others from purchasing that drug, and using it, provided always that they did not do so in such a way as to amount to a manufacture.

post, p. 318.

And in like manner an invention for some mathematical process which, however useful, was not a manufacture, could not be patented. Thus a new method of computing logarithms, or a new cypher, or a new method of book-keeping, would not be good subjects of patents. It follows again, that the author of a book cannot be said to "manufacture" it, nor likewise can the writer of a song, or the painter of a picture, or the inventor of a design, take out a patent for them. The art of a painter really consists of two parts, the craft by knowledge of which the colours are mixed and applied to the canvas, and the art of composition by which the design is worked out. For an improvement in the craft, as for a new colour, or a new mode of applying it, no doubt a

CHAP. I. SECT. 2.

A patent must be for some kind of manufacture.

patent could be obtained; but the art of composing a picture could not be called an art of manufacture. A man who endeavoured to patent a picture would be either attempting to patent some particular principles of composition which he had discovered, or else some special arrangements of figures or light and shade, or some special subject or design. But neither of these can be said to be a "manufacture." In one sense the author of a book produces a physical article consisting of paper, ink, and cardboard, arranged in a way such as to be novel, useful, and to require invention to produce it. But the reason why this is not patentable is, because if he tried to patent it, the author would not be patenting a new craft, but only the product of a single exercise of an art, and could in no sense term himself a manufacturer.

In *Newall* v. *Elliot*, 1864, 10 Jur. (N.S.) 954, 10 L. T. (N.S.) 792, the question was raised whether a new process of doing a thing could be patentable when the result was, not the production of an article, but a new disposition of a quantity of machinery. The patent was for a new method of coiling submarine cables in ships for the purpose of laying the cables. "The point pressed by Mr. Cleasby, I confess I have some difficulty in understanding, that this is not the subject of a patent, because the thing is not vendible, because . . . instead of being ready-made and afterwards fitted up in the ship, it is fitted into the ship by the owner or user of the ship when he uses it. I confess I am unable to understand that" (*per* Bramwell, B.).

A method of disposing plates of iron on buildings, to make them fire-proof, was held good subject matter: *Hartley's Case*, 1795 (quoted, 2 H. B. 493). The same principle that a method, or process, is patentable, as well as

A patent must be for some kind of manufacture.

an article or result, was also affirmed in *Stevens* v. *Keating*, 1847, 2 W. P. C. 182; *Bush* v. *Fox*, 1854, M. P. C. 176; *Gibson* v. *Brand*, 1841, 1 W. P. C. 630. But it is clear that the process so patented must be part, at least, of some process of manufacture.

3. A patent cannot be granted for a bare principle unconnected with a method of practically carrying it into effect—We have seen, then, that it is only for an art that a patent can be granted, and that the art must be of an industrial character, or, in other words, a "craft." It remains to consider what the nature of that craft or art must be, in order to be patentable. In one sense a craft may be said to include all the principles upon which it is based. Thus, the art of soldering metals together is based upon the principle that metallic alloys have a lower melting point than the metals of which they are composed. But this principle is not an art. It is the scientific basis of an art.

Philosophers from the time of Aristotle have defined an art as "a body of facts arranged with a view to practice," and a science as "a body of facts arranged with a view to knowledge." A somewhat similar distinction is made in patent law. It is only an art, or, perhaps, more strictly speaking, a craft that can be a manufacture, so as to be the subject of letters patent.

In accordance with this view, the Courts have decided that a mere principle cannot be patented unless it be coupled with some practical way of carrying it into effect. For it is only in this last case that it could be considered as a manufacture. "Suppose," said Grove, J., "that a person had discovered that three angles of a triangle are together equal to two right

CHAP. I. SECT. 3.

A patent cannot be granted for a bare principle unconnected with a method of practically carrying it into effect.

angles, that would be an abstract principle and not the subject of a patent, it must be for a manufacture": *Young* v. *Rosenthal*, 1884, 1 R. P. C. 31.

"It would be difficult to form a specification of a philosophical principle; it would be something like an idea without a substratum" (*per* Ld. Kenyon): *Hornblower* v. *Boulton*, 1799, 8 T. R. 99. "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 submitted to his art and skill, or at least some new mode of employing that art and skill, is requisite to satisfy this word" (*per* Abbot, C.J.): *Rex* v. *Wheeler*, 1819, 2 B. & Ald. 349. "Here the refrigerating effect of the air on the sides of the vessel was not a thing for which a patent could be obtained, but an apparatus so constructed as to bring into operation that particular property of the external atmospheric air constitutes an invention" . . . (*per* Westbury, C.): *Cannington* v. *Nuttall*, 1871, L. R., 5 H. L. 225. "A patent will be good though the subject of the patent consist 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. . . . It is then no longer an abstract principle; it is clothed with the language of practical application" (*per* Hope, L.J.C.): *Househill Co.* v. *Neilson*, 1843, 1 W. P. C. 673. "If you have a 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" (*per* Jessel, M.R.): *Otto* v. *Linford*, 1881, 46 L. T. 39; *Badische Anilin Fabrik* v. *Levinstein*, 1885, 2 R. P. C. 91.

A patent cannot be granted for a bare principle unconnected with a method of practically carrying it into effect.

It is sometimes very difficult to distinguish between the enunciation of a principle and a general description of a new procedure. In the case of *Neilson* v. *Harford*, 1841, 1 W. P. C. 331, the patentee thus described his invention: "A blast or current of air must be produced by bellows or other blowing apparatus in the ordinary way to which mode of producing the blast or current of air, this patent is not intended to extend. The blast or current of air so produced, is to be passed from the bellows or blowing apparatus into an air vessel or receptacle made sufficiently strong to endure the blast, and through, or from that vessel or receptacle by means of a tube-pipe or aperture into the fire, forge or furnace. The air vessel or receptacle must be air-tight, or nearly so, except the apertures for the admission or emission of the air, and at the commencement, and during the continuance of the blast, it must be kept artificially heated to a considerable temperature" (1 W. P. C. 273). Commenting upon this description, Park, B., said:—"It is very difficult to distinguish it from the specification of a patent for a principle, and this at first created in the minds of the Court much difficulty; but, after full consideration, we think that the plaintiff does not merely claim a principle, but a machine embodying a principle, and a very valuable one.

"We think the case must be considered as if the principle, being well known, the plaintiff had first invented a mode of applying it by a mechanical apparatus to furnaces: and his invention then consists in this—by interposing a receptacle for heated air between the blowing apparatus and the furnace. In this receptacle he directs the air to be heated by the application of heat externally to the receptacle, and thus

CHAP. I. SECT. 3.

he accomplishes the object of applying the blast which was before of cold air in a heated state to the furnace." (p. 370).

A patent cannot be granted for a bare principle unconnected with a method of practically carrying it into effect.

In the same case, Baron Alderson said:—

"If you claim a specific shape, and go to the jury and say, that which the other people have adopted is a colourable imitation, then I can understand it. If you claim every shape you claim a principle. There is no difference between a principle to be carried into effect any way you will, and claiming the principle itself; you must detail some specific mode of doing it" (*per* Alderson, B.): *Neilson* v. *Harford*, 1841, 1 W. P. C. 355. It is obviously not meant here that if you invent a principle, and specify and claim a vast number, or indeed every possible way of doing it, that the patent would be bad. What is condemned is a vague claim of all ways of doing the thing. The proper method is to clothe the principle with one or more ways of carrying it out, and then rely on other methods being treated as merely colourable imitations. "If you start with some mode of carrying the principle into effect, you are entitled to protect yourself from all other modes of carrying the same principle into effect, that being treated by the jury as a piracy of your original invention" (*per* Alderson, B.): *Jupe* v. *Pratt*, 1837, 1 W. P. C. 146; *Easterbrook* v. *G. W. Rail. Co.*, 1885, 2 R. P. C. 207; see Chap. IX., sec. 5.

A claim of every method by which a thing could be done would be a claim for a principle.

post, pp. 197, 292.

The same opinions were further amplified by Lord Justice Clerk Hope, in another action on Neilsons' patent. "The defenders say:—'You announce a principle, that hot air will produce heat in the furnace; you direct us to take the blast without interrupting, or rather without stopping it, to take the current in blast

A patent cannot be granted for a bare principle unconnected with a method of practically carrying it into effect.

to heat it after it leaves the blast, and to throw it hot into the furnace. But you tell us no more, you do not tell us how we are to heat it; you say, you may heat it in any way, in any sort of form of vessel; you say, I leave you to do it how best you can. But my application of the discovered principle, is, that if you heat the air, and heat it after it leaves the blowing engine (for it is plain you cannot do it before), you attain the result. I state, that is the purpose to which I apply the principle. The benefit will be greater or less. I only say, benefit you will get, I have disclosed the principle. I so apply it to a specific purpose by a mechanical contrivance, viz., by getting the heat when in blast, after it leaves the furnace; but the mode and manner and extent of heating, I leave to you, and the degree of benefit, I do not state. The defenders say the patent on this account is bad in law. I must tell you that taking the patent to be of this general character, it is good in law; I state to you the law to be that you may obtain a patent for a mode of carrying a principle into effect; and if you suggest and discover, not only the principle, but suggest and invent how it may be applied to a practical result by mechanical contrivance and apparatus, and shew you are aware that no particular sort of modification or form of the apparatus is essential in order to obtain a benefit from the principle, then you may take your patent for the mode of carrying it into effect, and are not under the necessity of describing and confining yourself to one form of apparatus.'" *Household Co.* v. *Neilson*, 1843, 1 W. P. C. 685.

Lane Fox discovered the necessity of keeping up a constant pressure in electric mains, and he patented his *post*, p. 173.

CHAP. I. SECT. 3.

A patent cannot be granted for a bare principle unconnected with a method of practically carrying it into effect.

discovery, but he did not explain how it was to be done in a manner sufficiently explicit to shew how the principle was to be applied. In the Court of Appeal, his patent was held bad. Cotton, L.J., said:—"An invention is not the same as a discovery. When Volta discovered the effect of an electric current from a 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. 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. . . . The plaintiff was a pioneer, he shewed others the road to be followed, but he did not give the traveller the information necessary to enable him to travel on it: *Lane Fox* v. *Kensington Co.*, 1892, 9 R. P. C. 419; *Automatic Weighing Machine Co.* v. *Knight*, 1889, 6 R. P. C. 297: In this case, the plaintiffs in their specification described a weighing machine consisting of a platform which sunk with the weight of the person to be weighed, and as it sunk, raised up a pivoted lever with a counter-weight attached to it. The amount by which the lever was rotated thus was a measure of the weight. This lever was concealed from view. In order to reveal the result on payment of a penny, the weight of that coin when dropped through a slot into a little box, caused another indicating hand to rotate till it came in contact with the concealed lever. The first claim was, "The manufacture and use of a new kind of weighing machine such as is herein described, in

A patent cannot be granted for a bare principle unconnected with a method of practically carrying it into effect.

which, on a coin or the like being placed in the apparatus the weight of a person or body being weighed will be indicated on a dial or the like substantially as hereinbefore described." The Court held that this was clearly not a patent for a principle.

But it must not be concluded, because a principle is not patentable, that therefore only specific modes of performing the inventions can be claimed. In one sense, every patent which has an inventive merit about it, is for a principle, and could be carried out in various ways, and with various differences. Thus, for instance, the patent above quoted in *Neilson* v. *Harford* was for the use of the hot blast for smelting iron. It was quite independent of the shape or size or modes of construction of the parts; its essence was in passing the air into a hot chamber before it impinged on the fire in the furnace. In one sense this was a principle of construction, but in reality it was a principle clothed with an actual means of carrying it into effect, for any one could understand and apply it. Take again Edison's patent for the use of a carbon filament of high resistance in a vacuum composed wholly of glass, into which the conducting wires were sealed. This, in one sense, was a principle of lamp construction, and a very valuable one; but in the true sense it was only a description of the leading features of a lamp which might be carried out in an infinite number of ways. What is condemned as not being a "manufacture," is an abstract principle not applied specifically to any given class of objects: *Edison* v. *Woodhouse*, 1886, 32 Ch. D. 520; 4 R P. C. 79; on the other hand, Lane Fox failed because he merely pointed out that accumulators were useful in keeping up a constant pressure in electric mains, but omitted

CHAP. I. SECT. 4.

to give objective validity to his discovery of this principle by reducing it to practice.

A patent cannot be granted for a bare principle unconnected with a method of practically carrying it into effect.

See also *Minter* v. *Wells*, 1834, 1 W. P. C. 134. (Chair Seat), but same patent held to have been anticipated: *Minter* v. *Mower*, 1837, 6 A. & E. 735, 1 W. P. C. 142; *Neilson* v. *Harford* (Hot Blast), 1841, 8 M. & W. 806, 11 L. J. Ex. 20, 1 W. P. C. 331; *Household Co.* v. *Neilson*, 1843, 9 Cl. & F. 788, 1 W. P. C. 673; *Electric Telegraph Co.* v. *Brett*, 1851, 10 C. B. 838, 20 L. J. C. P. 123 (Electric Telegraphs); *Cannington* v. *Nuttall*, 1871, L. R. 5 H. L. 205, 40 L. J. Ch. 739 (Glass Furnaces); *Hills* v. *London Gas Co.*, 1860, 5 H. & N. 312, 29 L. J. Ex. 409 (Gas Purification); *Boulton* v. *Bull*, 1795, 2 H. B. 500, n.; *Hornblower* v. *Boulton*, 1799, 8 T. R. 95, D. P. C. 221 (Lessening Coal Consumption in Engines); *Badische Anilin Fabrik* v. *Levinstein*, 1887, 24 Ch. D. 156, 12 App. Cas. 710 (Dye); *Thomson* v. *Moore*, 1889, 6 R. P. C. 450, 7 R. P. C. 325 (Compass Cards); *Newton* v. *Vaucher*, 1851, 6 Ex. 865, 21 L. J. Ex. 305 (Lining Metal); *Hullet* v. *Hague*, 1831 2 B. & Ad. 378 (Evaporation of Liquids).

Cases in which patents were upheld, as being for a principle with a means of practically carrying it out.

4. A patent may be granted for a process which simply omits a step in an already known process.—There is no doubt of the truth of this proposition, but it is somewhat hard to find a case that exactly establishes it, and in which the only change from what has gone before is the omission of a part of the machine, or of a step in the process.

In *Minter* v. *Mower*, 1835, 1 W. P. C. 142, the plaintiff had claimed generally every application of self-adjusting leverage, whereby the seat of a chair was so connected with the back that the weight of the body on the chair balanced the back of it. It was proved that Brown had

A patent may be granted for a process which simply omits a step in an already known process.

constructed a chair with this feature, but much encumbered with a pad, spring, and rack. This was held to be an anticipation, but the Court intimated an opinion that if Minter had confined his claim simply to the particular chair, then he might very probably have established his title by shewing that a part of Brown's chair could have effected that for which the whole chair was designed.

The following cases may be consulted, but none of them expressly decide the proposition.

Where it had been usual to make seeds into oil, and oil into gas, a good patent could be had for making seeds directly into gas: *Booth* v. *Kennard*, 1856, 1 H. & N. 527, 26 L. J. Ex. 23 (the patent was invalidated for want of novelty), 2 H. & N. 84, 1857, 26 L. J. Ex. 305. Gelatine was made from hides cut into large pieces and treated with caustic alkali or else reduced to pulp. Held, a good patent to omit the caustic alkali and cut the hide into shavings instead: *Wallington* v. *Dale*, 1852, 7 Ex. 888, 23 L. J. Ex. 49. Tubes used to be made according to an old patent by bending iron plates into cylinders and drawing them on a mandril between welding rollers; a patent for omitting the mandril held good: *Russell* v. *Cowley*, 1832, 1 W. P. C. 457; see also *Arnold* v. *Bradbury*, 1871, 6 Ch. App. 714. The doctrine seems once to have been doubted: *Gibson* v. *Brand*, 1842, 1 W. P. C. 639.

5. Patents for combinations and improvements.—Where an invention does not consist of a new article or a new sort of machine, or a new process, it will generally come under the head of an improvement or a new combination. It is often very difficult to say

CHAP I. SECT. 5.

Patents for combinations and improvements.

whether an invention is for a new machine, an improvement on an old machine, or a new combination of old parts of machinery. But as will be seen hereafter when it becomes necessary to deal with "infringement," it is often necessary to distinguish between a new machine, an improvement, and a combination. A new machine is one which presents some features of novelty so fundamental or essential, that it may be regarded as different in its nature from those which had preceded it. Thus for instance, the ring armature to the dynamo, invented by Pacinotti, and first made practicable by Gramme, may distinctly claim, not to be a mere improvement on what had gone before, but substantially a new machine for producing electricity. Again the induction machine for producing electricity of high tension was essentially and distinctly a different machine from the old plate friction machines, although in shape and appearance it somewhat resembled them. Again the horse clipper (*Clark* v. *Adie*) might fairly be considered a new machine, when compared with the old scissors, and the rotary hair-brush might claim to be a new machine as compared with the old hand-brush. An improvement is produced when some new part is added to an old machine, or some novelty introduced into an old process whereby they are more useful. Thus for instance, the ring armature of the Gramme dynamo was improved by the introduction of air spaces between the coils, to cause the circulation of air amidst the wires and iron, and thus to cool them, but the form of the armature remained much the same as before. The principles on which it acted were identical. Hence then, this new and valuable suggestion was only an improvement. It follows that in an improvement, that which is added should be new, or substantially new in its

Patents for combinations and improvements.

nature, and yet not so important as to transmute the old machine or process into a substantially new one.

But a new combination consists essentially of a new arrangement of old parts, or else of an associating together of old parts which previously were never united. If the invention consist of a readjustment of old things, or an association together of old things not previously united, it is a combination, whereas if it consist of the addition of a new thing to an old one, or to an old combination, it would be more properly described as an improvement. It is, therefore, often very difficult to say whether an invention is an improvement or a combination.

Thus, for instance, aneroid barometers are old, so also are recording drums, but the first person who combined together an aneroid barometer with a recording drum, would, if he had made a valid invention (and this would much depend on the condition of knowledge at the time) have made a combination. But it would also be hardly wrong to describe it as an improvement.

Although there is in strictness a difference between the words "combination" and "improvement," which an endeavour has been made to explain, yet in practice the word improvement is used to cover combination, and the title of a patent "an improved machine" for doing a thing, would cover more than would be strictly understood by a mere improvement. Very commonly an invention is described as "a new and improved machine," so that the title may cover either clear novelty in the machine, novelty in an improvement in it, or a new combination.

In an improvement, however, or in a combination, it is necessary that there should be utility, invention, and

CHAP. I. SECT. 5.

Patents for combinations and improvements.

novelty. These will be treated in more detail in subsequent chapters; meanwhile, it is sufficient to say, that it is not enough simply to make a union of two things which have never been united before and call it an invention. Thus, one could not patent the fixing of clocks in railway carriages. It is probably new, it might be useful, but no invention would be required to carry it out. The essence of a combination is, not that the parts of it should be new, but the essence is in the novelty, ingenuity and utility of their union. It will follow as we shall see hereafter that the only mode of infringing a combination is therefore to infringe the union of the parts, not to use any one of them disunited. If any one of the associated parts is new, then it becomes doubtful whether the invention is in reality a combination or an improvement. For though the distinction between a new machine, an improvement, and a new combination is easy to formulate in theory, nothing is harder than to apply the distinction to the various inventions which are made every day. But while it is frequently essential in deciding a patent case to determine whether the invention is an improvement or a combination, yet in the drafting of patents, this delicate distinction is of less importance. For if a patentee has made a real invention, correctly described it, and correctly stated his claims; then, whether it be a new machine or process, an improvement or a combination, it will be supported, even though the Court might not agree with the exact classification adopted by the inventor.

It appears that in *Bircot's* Case, 1568, Year Book 15, Elizabeth, Easter Term 4, the Court of Exchequer had decided that no patent could be granted for an improve-

ment, saying that it was "much easier to add than to invent." This dictum may have been due to the fact that the Court thought that merely to improve a method was not such an introduction of a new manufacture as was contemplated in the statute, taking the older view that it was not so much a particular invention, as the right to practise a "mystery" that was the subject of the monopoly. This case was, however, definitely overruled in 1776, in the case of *Morris* v. *Bransom*, Bull. N. P. 76, c., which affirmed a patent for a new mode of weaving lace which laid the foundation of a great improvement in the lace trade at Nottingham. See also, *Boulton* v. *Bull*, 1795, D. P. C. 201, 205; *R.* v. *Arkwright*, 1785, D. P. C. 61; *Hornblower* v. *Bull*, 1799; 8 T. R. 98; *Hill* v. *Thompson*, 1817, 8 Taunt. 375.

A patent may clearly be granted for an improvement, and owing to the progress of invention it has become so hard to hit upon a new leading idea, that by far the greater number of modern inventions are only improvements on what has gone before.

A patent may be granted for a new combination of old materials or of things partly new and partly old. But it is not sufficient merely to put two things together and call them a combination, "as to put a lock on a window which had previously been put on a door, and call it a combination" (*per* Grove, J.): *Bamlett* v. *Picksley*, 1875, Griff. 44; *Saunders* v. *Aston*, 1832, 3 B. & Ad. 881.

post, pp. 180, 302.

Prior to 1836, anthracite coal had been used for smelting iron, so also had the hot blast, but the two had never been combined. A patent for their combination was held good: *Crane* v. *Price;* 1842, 4 M. & G. 580. This decision has been questioned, and indeed appears

CHAP. I. SECT. 5.

Patents for combinations and improvements.

post, p. 13.

very doubtful. "I," says James, L.J., "have never been satisfied with the decision. That, however, is simply because I could not see how the word 'combination' could be properly applied to the introduction of a particular kind of fuel into a machine which had been patented for the use of every kind of fuel in the making of iron; but neither I, nor, so far as I am aware, any other judge, has ever questioned the principles upon which the case was decided, and which are thus laid down in the judgment of the Court delivered by Tindal, C.J.: 'We are of opinion that if the result produced by such a combination (*i.e.* a combination of two old things) is either a new article, a better article, or a cheaper article to the public than that produced by the old method, such a combination is an invention or manufacture intended by the statute, and may well become the subject of a patent'" (*per* James, L.J.): *Murray* v. *Clayton*, 1872, L. R. 7 Ch. 570. "It is no objection to a patent for a mechanical or chemical discovery that the articles of which it is composed were known and were in use before, provided that the compound article which is the object of the invention is new" (*per* Buller, J.): *Boulton* v. *Bull*, 1795, 2 H. B. 487. A blast had been used to remove dusty air from flour mills, and an exhaust had also been used: a combination of them was supported: *Bovill* v. *Keyworth*, 1857, 7 E. & B. 725. An alloy possessiug special advantages, consisting of a particular combiuation of copper and zinc, is patentable, though the mixing of copper and zinc, to make brass was well known, and had been used in all sorts of proportions: *Muntz* v. *Foster*, 1843, 2 W. P. C. 93. The inventor made £55,000 by this patent: *Muntz's Patent*, 1846, 2 W. P. C. 113. The principle that combination patents are good if the combination is new

The subject of a combination patent is not the parts or things combined, but the combination of them.

post, p. 103.

and useful is laid down in the following cases:— *Morris* v. *Branson*, 1776, Bull. N. P. 76, 1 W. P. C. 51; *R.* v. *Arkwright*, 1785, 1 W. P. C. 71; *Huddart* v. *Grimshaw*, 1803, 1 W. P. C. 92, 1 C. P. C. 267; *Hill* v. *Thompson*, 1817, 1 W. P. C. 237; *Brunton* v. *Hawkes*, 1821, 2 B. & Ald. 550; *Carpenter* v. *Smith*, 1841, 1 W. P. C. 538; *Pow* v. *Taunton*, 1845, 9 Jur. 1056; *Sellers* v. *Dickinson*, 1850, 5 Ex. 312; *Lister* v. *Leather*, 1858, 8 E. & B. 1004, 1031, 27 L. J. Q. B. 295; *Morton* v. *Middleton*, 1863, 1 Ct. Sess. 3rd ser. 721; *Foxwell* v. *Bostock*, 1864, 12 W. R. 725; *Boyd* v. *Horrocks*, 1889, 6 R. P. C. 162.

6. It is no derogation from a patent to grant another for an improvement upon it, although the patent for the improvement cannot be used without the consent of the prior patentee.—At one time it was ingeniously argued that when the Crown had granted one patent, it could not grant a patent which in any way involved the use of the first, as, for instance, an improvement on the first. For it was contended that by so doing the Crown would derogate from its former grant. But this view was obviously incorrect, for the second patent was granted, not for the old process plus the improvement, but for the improvement only. "It was argued that in point of law no patent can be taken out which includes the subject matter of a patent still running and in force. No authority was cited to support this proposition" (*per* Tindal, C.J.): *Crane* v. *Price*, 1842, 4 M. & G. 580. "The assertion that all patents for improvements on existing patents must be void is obviously untenable" (*per* Campbell, C.J.): *Lister* v. *Leather*, 1858, 8 E. & B. 1004. "No doubt a man may

post, p. 313

CHAP. I. SECT. 6.

It is no derogation from a patent to grant another for an improvement upon it, although the patent for the improvement cannot be used without the consent of the prior patentee.

make an invention which is partly covered by an existing patent, but he cannot use it without the license of the patentee" (*per* Malins, V.C.): *Fox* v. *Dellestable*, 1866, 15 W. R. 194; see also *Harmar* v. *Playne*, 1809, 11 East, 107, D. P. C. 318; *Lewis* v. *Davis*, 1829, 3 C. & P. 504, 1 W. P. C. 489.

7. A patent for an improvement may cover not only machines as they exist at its date, but also the same machines as subsequently improved.—*Electric Telegraph Company* v. *Brett*, 1851, 10 C. B. 881. This was a patent for telegraphic instruments for use with metallic circuits. At the date of the patent, earth returns for telegraphic wires were unknown, and the infringement complained of was an adaptation of the invention the subject of the patent, to instruments with earth returns. It was argued that no patent could be granted so as to cover future improvements, or so as to include a machine in a state unknown to the inventor, and that improvement-patents must be limited to machines substantially as known and used at the date of the patent. The Court, however, negatived that view. "A patent for improvements in the mode of doing something by a known process is sufficient to entitle the claimant to a patent for his improvements when applied either to the process as known at the time of the claim, or to the same process altered and improved by discoveries not known at the time of the claim" (*per* Cresswell, J.). See also *Crossley* v. *Beverley*, 1829, 1 W. P. C., p. 108, *note*.

8. If any substantial or essential part of an invention fails, the whole patent is void, for the grant is indivisible, and goes to the whole consideration.—

If any substantial or essential part of an invention fails, the whole patent is void, for the grant is indivisible, and goes to the whole consideration.

It might at first sight appear that if the King grant several things, and as to one of them it turns out that it is not the proper subject of a grant, the grantee may retain the others, though as to one of them the patent is void. But this is not so. For, in the first place, there is a recital in every patent that the inventor has made a certain specified invention, and that he has sent in a true description of it in his specifications. If these recitals are false in any part the whole grant fails. And, moreover, these suggestions or considerations go to the whole of the grant, and are the inducement of each part of it, and it is a principle of interpretation of Crown grants, that if part of the considerations or suggestions on which it is made fails, the whole grant is void (see Bacon's Abridgement, Prerogative, F.).

ante, p. 11.

It is different in the case of a private grant, where a partial failure of consideration will not annul a contract, provided there is sufficient left to support it (see Chitty on Contracts, chap. i., sect. 1). The first cases in which this theory was laid down with regard to the law of patents for invention were: *Hill* v. *Thompson*, 1818, 8 Taunt. 401, and *Brunton* v. *Hawkes*, 1821, 4 B. & Ald. 541. Hill had patented "Improvements in the smelting and working of iron." One of these improvements was for the use of lime to prevent the iron from being "cold short," but this had been anticipated by the publication of a book, 'Rinman's Dictionary,' and it was held that, inasmuch as a material part of the invention had failed, the whole patent was altogether void. The case of Brunton and Hawkes was of a patent for "Improvements in the construction of, making, or manufacturing of ships' anchors and windlasses and chain cables or moorings." This was a description of three distinct

CHAP. I. SECT. 8.

If any substantial or essential part of an invention fails, the whole patent is void, for the grant is indivisible, and goes to the whole consideration.

inventions. One of them, viz., that relating to anchors (which was held to be old), described the putting of the shank into the arm joining the flukes without welding, in a manner similar to the way in which a pickaxe is fastened to its handle by a conical hole in the arms fitted upon a cylindrical end of the shaft, which is then hammered up to make it tight. Abbott, C.J., said:—"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 new invention in one article, grant a patent for that article and another. . . . It appears to me that the case of *Hill* v. *Thompson* is decisive upon that question." In the next year the same point was argued by Mr. Brougham in *Crossley* v. *Beverley*, 1 W. P. C. 109, but so hard did the rule which he had supported appear to him, that in 1835 he procured the passing of an Act which permitted the patentee to disclaim any part of his title or specification, or to enter a memorandum of alteration therein, which disclaimer or alteration were thenceforth to be taken to be part of the letters patent.

The principle, however, still holds that if any part of the subject-matter of any invention fails the whole is void: *Morgan* v. *Seaward*, 1836, 1 W. P. C. 173. In the case of *Roberts* v. *Heywood*, 1879, 27 W. R. 454, a tray for catching paint drippings was among other things specifically claimed. It was held to be bad and to avoid the whole patent.

It follows from the power of disclaimer given above, and the power of amendment which has now been substituted for it, that a patent which is void may, by

relating back, be rendered good again. It is hence not absolutely worthless, but only void until amended.

If any substantial or essential part of an invention fails, the whole patent is void, for the grant is indivisible, and goes to the whole consideration.

It may also be observed that this rule that the invalidity of part of the subject-matter invalidates the whole is less strictly applied when the invalidity is due to want of utility. The reasons for this will be stated further on (*post*, p. 71).

It will at once strike everyone, that if the doctrine that part failure of a patent avoids the whole were pushed too far, few patents could stand; accordingly, the Courts are chary of applying the principle so as to destroy a meritorious invention except where some distinct claim on the part of the inventor leaves them no choice. Where in good faith a claim of an old thing is made, the Court will often endeavour to read it, not as an isolated claim, but as a claim for a thing to be used in conjunction with the main part of the invention.

post, p. 198.

Thus, in a patent for screws, Jessell, M.R., says: "It does not follow that because an inventor thinks he has invented more than he has in fact, and describes the advantages of his invention, and some of these advantages arise from an old portion of his invention, it may not still be a good patent, provided the invention as claimed is so limited as to fail to cover the actual thing in use while it covers some of the advantages mentioned: *Frearson* v. *Loe*, 1878, 9 Ch. D. 58; *Plimpton* v. *Spiller*, 1877, 6 Ch. D. 412, L. R. 5 H. L. 433; see further as to failure of utility in a part of a patent, Utility, Chap. II., sect. 4.

post, p. 70.

9. The subject-matter must not be against public policy.—Thus, patents for housebreaking tools would not

CHAP. I. SECT. 9.

The subject matter must not be against public policy.

post, p. 241.

be granted: (Hindmarch, p. 142); P. Act, 1883, sect. 86; Griff. P. C. 20.

In Sir E. Coke's time it seems to have been considered that patents for inventions which substituted machine labour for hand labour might be bad on the ground that they discouraged industry. But this view was never formally adopted by the Courts of Justice.

CHAPTER II.

UTILITY.

1. An invention must possess utility in order to be the subject of Letters Patent.—As has been previously explained the power of the King to use his prerogative to create a monopoly depends upon that monopoly being for the public advantage (Bacon's Abridgment, tit. 'Prerogative'). And grants can only ensue according to the King's intent. Therefore, as they profess to be made "for the public good," it follows that no patent can be valid unless the invention is useful. It is, however, not needful that the invention should be commercially useful in the sense of being a better method for a manufacturer to employ, it is enough if it be a new, sound, practical method, even though it may not be so economical. In *Edison* v. *Holland*, 1889, Cotton, L.J., observed :—"I am afraid I cannot consider commercial utility. It is a new term in patent law": 6 R. P. C. 257. In *Ehrlich* v. *Ihlee*, 1888, 5 R. P. C. 437, Cotton, L.J., said: "In my opinion it is not necessary, in order to support a patent, to shew that all that is claimed is a commercial success, if it can be practically used, a very little utility is sufficient." Again, in *Wilson* v. *Union Oil Mills Co.*, 1892, 9 R. P. C. 70, Charles, J., remarked: "Commercially, this process

ante, p. 18.
ante, p. 9.

CHAP. II. SECT. 1.

An invention must possess *utility* in order to be the subject of letters patent.

appears to be enormously expensive. That appears to be the result of the evidence which the defendants have given me upon this occasion, but that is not the test, and it is not pretended it is the test. A patent may be a patent for a useful article—it may satisfy the conditions of utility, although it may be so commercially expensive as to be commercially useless. That is not the Act at all. The question is, does it really do, when put in practice by a competent man, what it assumes to do?" : see also *Morgan* v. *Seaward*, 1836, 1 W. P. C. 185.

It is, however, necessary in considering the utility of a patent, to determine, not only what utility an invention or part of an invention really has, but also the utility which the inventor ascribes to it in his specification. For if an inventor describes a process, or a part of a process, or a machine, or other thing, as capable of producing a certain result, and it fails to accomplish that result, then, quite apart from the question whether the invention may or may not be useful in other ways, or on the whole, yet by that misrepresentation as to the effect of the operation the Crown will have been deceived and the patent will be invalid.

Thus, for example, it is clearly not necessary to the validity of a patent, that the invention should necessarily describe a cheaper way of doing a thing than before; but if the inventor represents it as a cheaper way, and it be not cheaper, his patent will fail. Lord Halsbury remarked in the case of *The Badische Anilin and Soda Fabrik* v. *Levinstein*, 1887: "The element of commercial pecuniary success has, 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

post, p. 136.

An invention must possess utility in order to be the subject of letters patent.

essence of the patent itself, and the thing claimed has really not been invented unless the condition is fulfilled": 4 R. P. C. 462; see also p. 466; *Kurtz* v. *Spence*, 1888, 5 R. P. C. 182.

Thus the question of utility has to be considered, not merely with regard to the Common Law, but with regard to the representations made by the patentee in his specification.

An illustration of the necessity that every part of the invention represented by the patentee to be useful should in fact be useful, is afforded by the case of *Easterbrook* v. *Great Western Railway Co.*, 1885, 2 R. P. C. 210; 3 R. P. C. 94. In his complete specification for a system of signalling, the inventor had represented that, by his arrangements, "it will be impossible to give a wrong signal or point antagonistic to each other." But at the trial, a model of his machine was exhibited, by which it was demonstrated that by moving the handles in a peculiar way in four different cases wrong signals could be given, and in one of these that four trains could be signalled to run into one another. This was held fatal to the patent, though evidence was given that in some cases the invention worked well.

It is not needful that practical utility should have existed at the date of the patent. It is enough that the invention should be mechanically effective and sound, and that there should be at least a reasonable prospect of utility. Thus it is explained in Chap. IV., sect. 2, that though an invention may not be a commercial or practical success at the time it was made, yet if it afterwards becomes useful, or can be shewn to have a reasonable prospect of becoming so, the patent will be supported. *post*, p. 136.

The necessity for utility in the subject matter of a

CHAP. II. SECT. 1.

An invention must possess utility in order to be the subject of letters patent.

An invention must possess utility at the time it is patented.

patent was repeatedly affirmed in early cases: *Darcy* v. *Allin*, 1602, 1 W. P. C. 6; *R.* v. *Arkwright*, 1785, D. P. C. 138, 1 W. P. C. 72; *Huddart* v. *Grimshaw*, 1803, 1 W. P. C. 86, D. P. C. 278; *Manton* v. *Parker*, 1814, D. P. C. 327; *Manton* v. *Manton*, 1815, D. P. C. 348. Manton's patent was for a touch-hole for guns, designed to let the air out while the charge was being rammed home, and yet prevent the powder also passing out through the hole. Evidence was given that the powder did come out; the invention was held not useful: see also *Bovill* v. *Moore*, 1816, D. P. C. 399; *Minter* v. *Wells*, 1834, 1 W. P. C. 129. "The effect of the evidence is, that without additional facts which are not described, the machines would certainly not be capable of making velvet goods" (*per* Pollock, C.B.): *Crossley* v. *Potter*, 1853, M. P. C. 245. See also *Boulton* v. *Bull*, 1795, 2 H. B. 463, D. P. C. 162; *Turner* v. *Winter*, 1787, 1 T. R. 602, 1 W. P. C. 80; *Morgan* v. *Seaward*, 1837, 2 M. & W. 562, 1 W. P. C. 197.

In patent actions, the plaintiff should always make a strong point of the utility of his patent. For if a patent is once shewn to be useful, the Courts will always be inclined in its favour, and its utility will also afford a presumption in its favour that it is new and ingenious. In *Lyon* v. *Goddard*, 1893, 10 R. P. C. 121, the plaintiff had invented a machine for disinfecting clothes, by putting them in a chamber filled with steam under pressure surrounded by a second chamber also filled with steam. At first sight the invention did not look very novel. But when it was shewn in evidence that all other ways of using steam had failed by reason of condensed water spoiling the fabrics, and when it was also shewn that hot steam possessed a peculiar property of pene-

trating into the very centre of woollen stuffs such as hot air did not possess, the opinions expressed by the Judge at the commencement of the trial changed, and the patent was upheld as for a valuable invention.

An invention must possess utility in order to be the subject of letters patent.

The utility must be in the invention, not merely in some result of it.

2. It is the invention that must be useful, not merely the result of the invention.—For a merely useless change in the shape or mode of making a useful article would confer no benefit upon the public. Thus, in an action on a patent for stays, Grove, J., told the jury: "The question is not whether stays were in existence before and were useful, but . . . whether there is anything in the plaintiff's invention which is more useful than the stays people had before; is there any new point of utility? If there is any new point of utility in the plaintiff's invention which was not in any previous known thing, then you may say it is useful. But if you think it is not as good as those existing before, or no better than those existing before in any particular point, then you would say it was not useful": *Young* v. *Rosenthal*, 1884; 1 R. P. C. 41. The utility must exist, not merely in some one application of the invention, but in the very invention itself. Thus, in a patent for elastic fabrics, it was shewn that this material was useful for surgical bandages (which were not specially mentioned in the patent). Tindal, C.J., said: "It would not be sufficient to maintain the patent, on the ground of its being an improvement, to shew that it was an improvement of surgical bandages only, because the patent is not confined to that, but they must prove also that it is generally an improvement with respect to the general uses of that fabric or manufacture which was intended": *Cornish* v. *Keene*, 1835, 1 W. P. C. 506.

CHAP. II. SECT. 3.

The degree of utility may be slight if once utility is established.

3. The Degree of Utility may be slight if once utility is established.—"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 enough to sustain a patent" (*per* Grove, J.): *Philpot* v. *Hanbury*, 1885, 2 R. P. C. 37. "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" (*per* Pollock, C.B.): *Tetley* v. *Easton*, 1852, M. P. C. 63. This rule depends on the general principle, that when once a substantial consideration exists, the amount or value of it is not material. This principle holds in contracts between subjects: see Chitty on Contracts, 5th Ed. p. 20. And there seems no doubt that the same rule applies to the Crown: Chitty's Prerogative, p. 400; *A. G.* v. *Vernon*, 1684, Vernon, fo. 279; Viner's Abridgment, Prerogative, vol. xvii., p. 151.

It is not necessary, in order to prove utility, to shew that the invention has been actually used: *Macnamara* v. *Hulse*, 1842, Car. & M. 471; but such user would, of course, be very good evidence of utility; see further, Commercial Success, Chap. IV., sect. 1 (*post*, p. 134).

4. Effect of failure of utility in a material part of the patent.—It was said in Chap. I., sect. 8, that if a substantial part of an invention proves to be useless, the whole invention fails. But, as was pointed out above, those cases in which the patentee has distinctly affirmed the utility of any part of his invention should be distinguished from cases in which he has made no such representation. Where he has made a distinct representation of the usefulness of anything, he will be held to it, and, if his representation is false, his patent will be

ante, p. 60.

Effect of failure of utility in a material part of the patent.

void. But where he has made no such representation, then, if his invention be valuable upon the whole, the conditions of the Statute of Monopolies will have been fulfilled, and a want of utility in some merely subordinate part will not avoid the patent. Thus a patent was taken out for several things, among which was an improved method of making horseshoe nails from a rolled ribbed plate. Two actions were brought in respect of the patent. In the second of these it was held that this was put forward as a substantive invention, that it was useless, and that the whole patent was consequently void. "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 he is to get his patent right, and so long as that stands, I am unable to resist the effect of the decisions" (*per* Lord Kinnear): *United Horse-shoe Co.* v. *Swedish Horse Nail Co.*, 1889, 6 R. P. C. 1. It was held, that where an invention for railway signalling was useful for part of the work, but very dangerous in some places, and where the inventor had not limited his invention to the safe part of it, that the whole patent was bad: *Easterbrook* v. *G. W. Railway Co.*, 1885, 2 R. P. C. 210, 3 R. P. C. 94.

Felton v. *Greaves*, 1829, 3 C. & P. 611. A patent had been obtained for a machine for sharpening knives and scissors consisting of a row of small discs with roughened edges arranged on parallel axes, Fig. 1, so that the knife could be drawn between them.

Fig. 1



In order to fit this for sharpening scissors, which are only sharpened on one side, it would be needful to leave one set of discs smooth, but the patentee had not described this. His invention

CHAP. II. SECT. 4.

Effect of failure of utility in a material part of the patent.

was therefore useless for scissors, and his patent was invalidated. This case was decided before the days of disclaimers and hence the patentee had no means of curing the defect in his title and specification. But where no separate and distinct claim is made to a certain part of the invention, or where a claim can be read as merely subsidiary, failure of utility in that part will not always avoid the patent, provided it is not one of the main features of the invention.

A patent had been taken out for drying calico and other stuffs. The jury found that the invention was useful upon the whole, but "not useful in some cases for taking up goods." On motion the Court considered that the jury had held that the invention was useful in the general, and that as they had not specified in how many cases it failed, that failure must be taken to be in an immaterial portion: *Haworth* v. *Hardcastle*, 1834, 1 W. P. C. 483, 4 M. & S. 732. *Lewis* v. *Marling*, 1829, decided, that where part of a process was useless, but the uselessness was subsequently discovered, and the inventor did not know it when he took out his patent, the patent was not void, it being on the whole a useful patent: 1 W. P. C. 496. In *Morgan* v. *Seaward*, 1837, the Court, whilst holding that non-utility of part of the invention made it void, said: "We do not mean to intimate any doubt as to the validity of a patent for an entire machine or subject, which, taken altogether, is useful, though a part or parts may be useless, always supposing there be no false suggestion": 1836, 1 W. P. C. 187, and Lord Kinnear, while holding a patent for making nails bad, because the sixth claim was not useful, says: "It is a perfectly sound proposition that . . . an invention shall not be invalidated because the specification includes some

The necessity of utility in every part of a patent is not to be too stringently required, provided that there is substantial utility in the invention as a whole.

Effect of failure of utility in a material part of the patent.

minor claim, which turns out not to be useful, provided there is no concealment": *United Horseshoe Co.* v. *Swedish Horse Nail Co.*, 1888, 6 R. P. C. 1; see also *Ehrlich* v. *Ihlee*, 1888, 5 R. P. C. 450.

The effect of commercial success as evidence of the utility of a patent is dealt with in Chap. IV. The fact that defendant infringed is some evidence of utility: *United Horseshoe and Nail Co.* v. *Stewart*, 1888, 13 App. Cas. 407.

post, p. 134.

CHAPTER III.

NOVELTY, AND THE AMOUNT OF INGENUITY NECESSARY TO CONSTITUTE IT.

CHAP. III. SECT. 1.

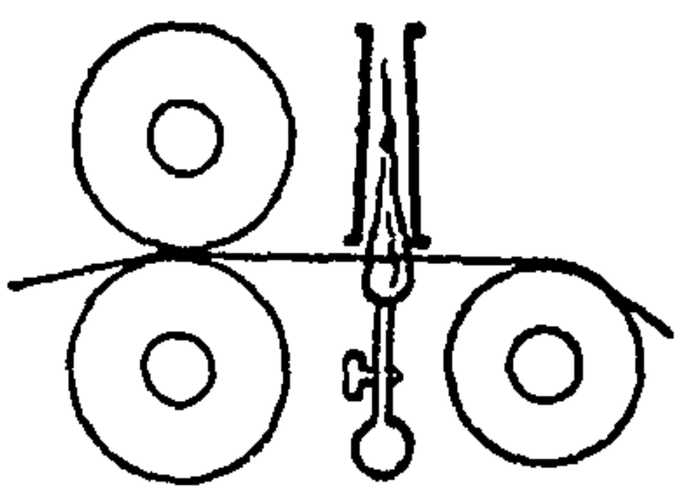
1. General remarks.—The only monopolies allowed by the Statute were for new manufactures. The question must early have arisen, whether a thing can be called new, which only differs from what has been done before by some merely immaterial alteration. And it must have been early seen that in order truly to determine the newness of a manufacture, the essence of the invention must be regarded, and not in its mere form.

Traces of this view are to be found in the case of *Roebuck* v. *Sterling*, 1774, 1 W. P. C. 45, in which it was submitted that the mere substitution of lead vessels for glass in the manufacture of sulphuric acid was no new discovery, but the decision did not turn upon this point. The reported cases which follow from that time to the year 1822, are chiefly noticeable for the destruction of a number of patents for valuable inventions through errors in the drawing of the specifications. But in the cases *Brunton* v. *Hawkes*, 1821, and *Hall* v. *Jervis*, 1822, the question of the *quantum* of ingenuity necessary to support an invention was definitely raised.

It will be interesting to give a short account of these patents, in order that the principles upon which the decisions proceeded may be made clear. Brunton's

patent was for a new method of making anchors, by forging the flukes in one piece, with a coned hole through the centre. Into this the shaft was inserted and bulged up to fit, just as the wooden handle of a pick-axe is fastened to the pick. A similar method had been used for mushroom anchors, and the patent was invalidated: 1821, 4 B. & Ald. 541.

Hall v. Jervis and Boot, 1822, 1 W. P. C. 100. The patent was for removing the small fibres that remain on cotton-lace goods after they are made, by singeing them with a gas flame. It was stated that the result of this invention was a very great improvement in lace, and that all manufactured lace was subjected to the process. The defendant excited no sympathy, for he was proved to have used the invention clandestinely. Prior to this invention many modes of singeing woven goods had been employed. The fibres had been removed from silk, cotton or lace sleeves by putting them on a leg or sleeve board, and submitting them to the flame of charcoal, waste paper, wood shavings, or pit coal. Bellows too had been employed to force the flame into the interstices, and hot rollers had also been used. The plaintiff's invention was to submit the horizontally stretched portion to the flame of gas. But this alone would not do. For as Sir H. Davy has pointed out, flame will not go through a narrow set of interstices such as exist in wire gauze unless the gauze is forced against it, or unless the flame is sucked through it. Therefore, to effect this Hall placed chimneys over the lace, by the draft of which the flame was drawn right through the lace, so as to act on



CHAP. III. SECT. 1.

General remarks.

both sides of it, the lace being drawn through the flame sufficiently rapidly to prevent its being burned and yet slowly enough to singe off the wool on both sides, a result which would not be attained by merely blowing the flame by means of bellows into the interstices of lace stretched on a board. The jury were strongly impressed by the proof offered of the great improvement which the invention had effected in the lace trade and the evidence given that various experiments made by men of science for doing the same thing had failed. They found for the plaintiff. The Court afterwards refused to disturb the verdict.

This case is an instructive one. A man of science might have ridiculed the mere invention of a gas flame drawn upward by a draught of air, for singeing lace. But commercially, as it was shewn, the invention was a valuable one, and others had failed where the plaintiff had succeeded. This led to the conclusion that the method was really novel and not merely an old process in disguise.

The obvious justice of requiring that an invention shall not be a mere adaptation of some previously well-known method, naturally leads to the conclusion that in supporting a patent on the score of novelty it is needful to shew that it is to some extent a new departure, or, in other words, that some ingenuity must have been displayed in making it. Therefore when the novelty of a patent is impugned, the parties may find themselves engaged either upon a dispute whether as a fact some prior alleged invention was known to the public, or else that fact being conceded, whether it was really substantially the same as the patentee's invention. For convenience, these two very different questions may be

General remarks.

separated, and the investigation of that part of the law of patents which deals with "novelty" may be divided into an enquiry as to what constitutes prior publication, or knowledge, what is a sufficient publication, and where and how that publication must have been made, and a separate enquiry, what amount of difference between one invention and another will be considered by the Courts as necessary to make the last of them novel. This has been recognized in the Courts. Thus Willes, J. said:—"I apprehend that if a patentee would succeed, he must shew not merely newness in the sense of doing a thing which has not been done before, but newness in the shape of novelty by producing a thing which requires some exertion of mind that could properly be called invention." *Tatham* v. *Dania*, 1869, Griff. 213. The distinction may be formulated by asking: (1.) Is the invention ingenious? (2) Has it been anticipated?

It is proposed in this chapter to consider the question of "*ingenuity*," and in the next to deal with "*anticipation*," always remembering that in law both these branches are embraced in the use of the word "*novelty*," and that the separation here proposed is merely adopted for the sake of clearness and convenience.

2. The ingenuity of every invention is to be judged in the light of the state of public knowledge at the time it was made.—The first reflection that must strike anyone in considering what is meant by saying that an invention is ingenious, is, that ingenuity is really a relative term depending on the state of the arts and sciences. That which in barbaric times would be a great effort of genius, might, in a more advanced

CHAP. III. SECT. 2.

The ingenuity of every invention is to be judged in the light of the state of public knowledge at the time it was made.

age, be justly regarded as a very obvious application of well-known principles.

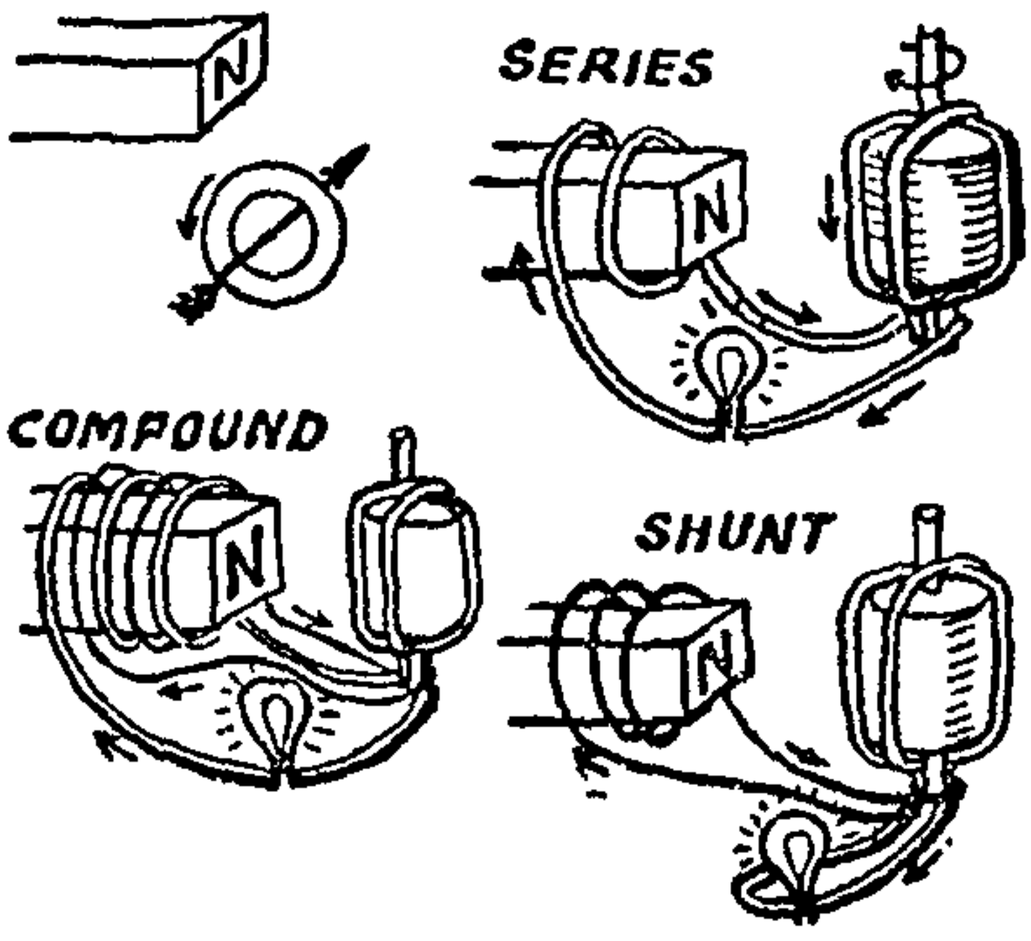
By lighting a pipe with a florence flask full of water held in the rays of the sun, a man might astonish a group of savages; in England, it would be regarded as the effort of an ingenious child. Every invention must be judged according to the standard of knowledge at the time it was made. This principle is most important in its applications. We are too apt on a trial relating to a telephone or an electric lamp which takes place some ten years after these instruments have been made for the first time, to consider the invention, not in the light in which it appeared to the world at the date when it was made, but in the light of the advanced state of knowledge at the date of the trial. It is surprising what a difference is made in the value of an invention, by a change in the point of view from which it is regarded. Thus, for example, the 'Principia' of Sir Isaac Newton were read for years by men of science, who, however, never obtained from that work any idea of the principle of the conservation of energy which has been one of the great discoveries of our own age. And yet it is now the general opinion that the Principia of Newton, read in the light of modern knowledge, clearly shew that he not only understood, but had anticipated that discovery. In the same way Huygens and Hook anticipated the undulatory theory of light, and anyone who will read Faraday's researches in the light of modern knowledge, will be surprised to find what a number of subsequent discoveries are shadowed forth in those volumes.

This principle was clearly assumed in *Crossley* v. *Beverley*, 1829, 1 W. P. C. 107, and again in *Lewis* v.

The ingenuity of every invention is to be judged in the state of public knowledge at the time it was made.

Marling, 1829, 1 W. P. C. 496; and will be further considered in the chapter devoted to the "Construction of Specifications."

In its application to the question of the novelty of an invention, we may take as an example *King Brown* v. *The Anglo-American Brush Corporation*, 1889, 6 R. P. C. 414, 7 R. P. C. 436, 9 R. P. C. 313; this was a petition for revocation of the Brush Patent of 1878, for what is known as the Compound winding of Dynamos. In order to make the case understood, it is necessary briefly to describe a dynamo, and the "shunt," "series," and "compound" methods of winding it. The invention of dynamos is derived originally from two discoveries made by Oerstead and Faraday about the year 1820, and developed by Paccinotti and Gramme.



The first of these is, that if a current of electricity be made to flow in a wire round a piece of soft iron, it becomes a magnet, more or less strong in proportion to the strength of the current and the number of turns of the wire. The next, that every magnet attracts along "lines of force," or "lines of magnetic influence," which radiate out from it in all directions; and if a closed metallic circuit, such as a coil of wire, is moved across any of these lines, resistance to the motion is experienced, and force is necessary to overcome that resistance, which force manifests itself in the generation of a current of

CHAP. III. SECT. 2.

The ingenuity of every invention is to be judged in the light of the state of public knowledge at the time it was made.

electricity in the coil, more or less strong, according to the strength of the magnet, the distance of the coil, and the speed with which it is moved. The direction in which this current flows is always invariable, depending upon the polarity of the magnet, and the direction of motion of the coil. The causes of these phenomena are not at present known, but their practical utility is evident. Thus if a coil of wire is moved across the path of the magnetism radiating from the magnet N., a current will be generated in the direction of the small arrow. From whence it follows that if a cylinder of iron called an armature, with wire wound round it, is rotated close to a magnet N., electricity will flow in the wires, and may be drawn off by brushes to an electric lamp. But further, since electro-magnets are stronger than permanent steel ones, the current may be carried round the magnet by virtue of whose force it has been produced, and thus reinforce the magnet, so that the magnet and coil shall interact on each other. This is called the "series winding." It has a cumulative effect. The more electricity is produced, the more tends to be produced, and the electricity goes on increasing till the resistance of the armature to the engine that is turning it, and the electrical resistance of the wires becomes so great, that things come to equilibrium. Everything depends on the external circuit being *complete*, so that if the consumer turns out his lamp the circuit is broken, the magnet almost demagnetised, and the current stops. The action of this series machine, therefore depends on plenty of lamps being alight, so as to have a good external circuit.

But if, instead of leading the main current th. igh the circuit, we were to lead only a branch or "sh t" of

CHAP. III. SECT. 2.

The ingenuity of every invention is to be judged in the light of the state of public knowledge at the time it was made.

the current through the circuit, then the strength of the magnetism would be independent of the external circuit, and the machine would work though no lamps or very few lamps were alight, and in fact the fewer lamps there are alight, the better it will light them. Here then we have two machines, one which works best when many lamps are alight, one which works best when few lamps are alight. The idea at once arises, why not unite them? and take one wire round in "series," and then lead the other round in "shunt," so that whether there are many lamps or few alight, one at least of the windings will benefit by what renders the other less efficacious. This was done by Brush in 1878 with excellent results, and is known as "the compound winding." But unfortunately for his patent, a patent had been taken out by Varley in 1876, in the specification of which he used the following words: "Part of the electricity developed by the machine is diverted to maintain the magnetism of the soft iron magnets, and the remaining portion is used to produce the electric light. There are several well-known ways of doing this, but the method I prefer is to wrap the soft iron magnets with two wires, one having a larger resistance than the other. The circuit of larger resistance is always closed, and the circuit of less resistance is used for the electric light. . . . When the electric light circuit is opened from any cause, the electricity developed passes through the circuit of greater resistance only, and maintains the magnetism of the magnets."

It was pressed upon the Court that the full *compensating* effect of the compound winding was not present to Varley's mind, and that to read it as an anticipation was really "a gloss put upon the passage by subsequent knowledge." The House of Lords held

CHAP. III. SECT. 2.

The ingenuity of every invention is to be judged in the light of state of *public knowledge* at the time it was made.

Varley's description as a true anticipation, but all the judgments delivered are expressly founded, not on the state of knowledge at the time of the trial, but on the state of knowledge at the time of Brush's patent.

Another interesting example of the application of this principle is found in the two cases by which the validity of the Bell and Edison telephone patents was established; the first of these was the case of the *United Telephone Co.* v. *McLean*, tried in Scotland; the other was an action brought by the same Company against *Harrison, Cox, Walker & Co.*, tried in London.

Before dealing with these cases it will be convenient briefly to explain the nature of Edison's transmitter and Bell's receiver which formed the subject of their respective patents.

When a piece of carbon is placed loosely in contact with a piece of metal, and both are caused to shake or vibrate by sounds such as the human voice, the contact between them becomes more or less imperfect, and if a current of electricity is passing through them, that current will be caused to vary in strength in proportion as the undulations of the voice vary; the result is that a battery connected through such a machine is caused to emit an electric current of a tremulous character, the undulations of the strength of which resemble the vibrations caused by the voice. Thus if a person speak through the trumpet-shaped orifice A to the diaphragm behind it, to which is fixed a cork, fastened to a piece of platinum, which rests in contact with a piece of carbon, then the current from a battery P passed through the instrument will acquire the tremulous character above described. Metal in contact with metal would effect the result, but nothing

See next page.

CHAP. III. SECT. 2.

The ingenuity of every invention is to be judged in the light of the state of public knowledge at the time it was made.

seems to be nearly so effective as carbon. This is the Edison transmitter. The current is now sent along the line to the receiver, which consists of a magnet F (preferably long and thin, as being more sensitive to delicate influences) on one end of which is placed a bobbin G, wound with thin wire in continuation of the line wire, and the current is then carried back to the battery either by a wire or an "earth return." By this arrangement the strength of the magnet is caused tremulously to vary in accordance with the voice vibrations, and if a diaphragm H of iron is placed near it, with the rim tightly secured, it will be made to vibrate like a drum, and the energy of the electric vibrations will then be re-transmuted into audible air-waves. This is the Bell "receiver." The diaphragms of both the receiver and the transmitter should be stiff, metal or mica answer well, membranes or paper are apt to set up independent vibrations and confuse the result. If the diaphragms are not fixed, or held pretty firmly by some means, they will not vibrate properly so as to receive or transmit speech.

In the case of the *United Telephone Co.* v. *McLean*, 1882, not reported except in *Engineering*, the principal attack was made upon the Morgan-Browne patent (a communication from Bell), and the circumstances were very singular. It appeared that in July, 1876, Sir W. Thomson (the present Lord Kelvin) met Mr. Bell at the Philadelphia Exhibition, and Mr. Bell, having shewn various inventions to Sir W. Thomson, finally told him that he had a machine which would transmit human speech, by means of electricity. He tried it, and distinguished the words, "To be or not to be." Bell gave Sir W. Thomson a membrane transmitter and a receiver.

CHAP. III. SECT. 2.

The ingenuity of every invention is to be judged in the light of the state of public knowledge at the time it was made.

These instruments Sir W. Thomson brought to England, and exhibited at a scientific meeting in Glasgow before the date of the Morgan-Browne patent. His words will be found reported in *Engineering*, Sept. 15th, 1876, p. 241: "All this my own ears heard spoken to me with unmistakable distinctness by the thin circular disc-armature of just such another little electro-magnet as this which I hold in my hand. The words were shouted with a clear and loud voice by my colleague judge Professor Watson, at the far end of the line, holding his mouth close to a stretched membrane, such as you see

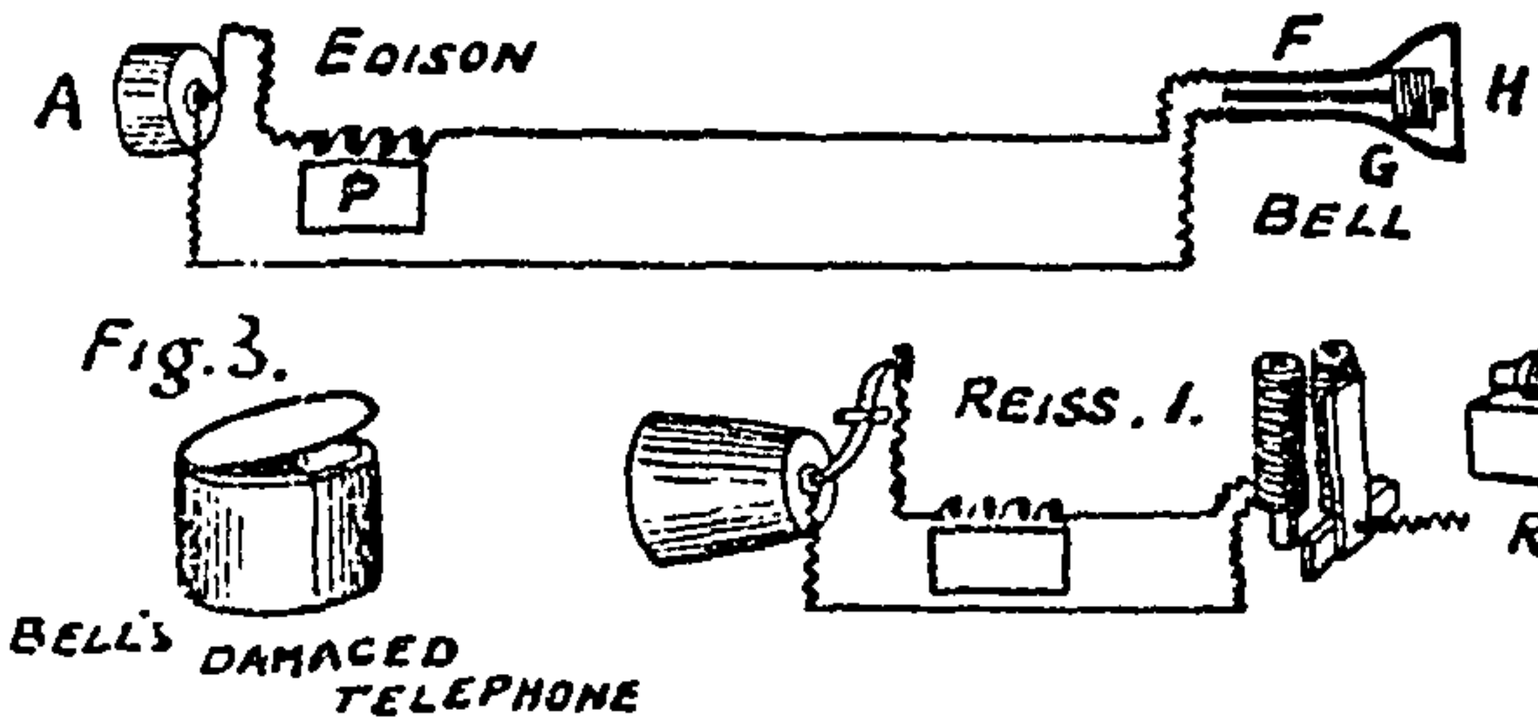


Fig. 3.

before you here, carrying a little piece of soft iron which was thus made to perform in the neighbourhood of an electro-magnet in circuit with the line, motions proportional to the sonorific motions of the air." He exhibited the instruments, but fortunately for the patentee, the iron plate of the receiver had become damaged and was only attached to the box containing the electro-magnet by one point, as the lid of a box is attached by the hinge so that it would not transmit speech (Fig. 3). There can be no reasonable doubt that Sir W. Thomson, one of the greatest living electricians, and himself a most ingenious mechanician, perfectly understood the invention, but the question at the trial

The ingenuity of every invention is to be judged in the light of the state of public knowledge at the time it was made.

was whether at that meeting he had published it to the world in such a way that an ordinary workman could have successfully performed it. Considering that with all his knowledge he did not succeed in making it work, the only reasonable conclusion is that at which Lord McLaren arrived, namely, that the machine had not been published in a practicable form.

In this action the validity of Edison's patent was not seriously disputed, the chief defence was a denial of infringement.

Having successfully passed this ordeal, the Bell patent was destined to undergo another. In the trial in London of the *United Telephone Co.* v. *Harrison, Cox, Walker & Co.*, 1882, 21 Ch. D. 720, the principal attack on the validity of the Bell patent was derived from the publication in England of a paper in the German language, by Legat on the telephone of Reis, and from the making of a machine according to that invention by Ladd, an optical instrument maker in London. The machine of Reis is shewn under those of Bell and Edison. In the transmitter there is no carbon, but only a metallic contact. In the receiver there is no disc, but only a pivoted armature, held in its place by a spring in one form, No. 1, or else a simple electro-magnet without a disc in the other, No. 2. There is not the slightest doubt that the machine of Reis was intended to, was capable of, transmitting and did transmit speech, and that Edison knew of the paper in July, 1875. Machines were exhibited at the trial shewing that Reis' machine would transmit speech. But Fry, J., held that the Bell receiver with its diaphragm was a distinctly different machine from Reis' receiver, and on reflection few people will be disposed to disagree with that opinion. It is quite one

CHAP. III. SECT. 2.

The ingenuity of every invention is to be judged in the light of the state of public knowledge at the time it was made.

thing to read the description of Reis' machine in the light of existing knowledge, and another to read it as it must have appeared to those who read it before it was shewn to be capable of being practically worked.

As to the receiver of Edison, with its carbon "tension regulator," it was not practically affected by Reis' transmitter. But the patent was declared invalid on the ground that it not only contained the transmitter, but that the complete specification also contained the phonograph, which had not been described in the provisional, and thus the patent was void for disconformity. It is not often that two patents come into Court containing three such splendid inventions as the disc telephone, the carbon transmitter, and the phonograph. Ultimately Edison had to disclaim the phonograph, after which almost all the actions brought by the United Telephone Company against infringers were successful.

But Reis must be regarded as the true inventor of the telephone. He lived to see his invention ridiculed and his papers refused in the local scientific papers of his day. Shortly before his death he closed his journals thus: "As I look back upon my life I can say indeed with the Holy Scriptures that it has been labour and sorrow." He died a poor schoolmaster at the age of 43.

The interest of the two cases above cited is to shew that anticipations must be read in the light of the knowledge at the time, not of that subsequently acquired, and that the Court is always reasonably careful to endeavour to support an invention which, though it may have been foreshadowed, has yet by the patentee been for the first time rendered a practical success.

3. The use of an old machine or thing for a merely analogous purpose or in an analogous way is not the subject to a Patent.—This follows from what has been already said as to the ingenuity required, in order that an invention may be the proper subject of letters patent. For by an analogue in patent law we mean something so similar as to be a merely obvious adaptation. A few examples may serve to illustrate this. A patent was granted for wheels for railroad carriages, made by introducing a rim of some elastic substance between the felloe and the tyre. It was shewn that the wheels had been used before for ordinary carriages: "Plaintiff says that the wheels made by the alleged anticipations were never applied to railways at all. This opens the question whether a man who finds a wheel ready made to his hand, and applies that to a railway, shall get a patent. . . . 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. . . . You cannot have a patent for applying a well-known thing. . . . to an operation which is exactly analogous to what was done before. . . . It is like sweeping a new carpet with an old broom" (*per* Abinger, C.J.): *Losh* v. *Hague*, 1838, 1 W. P. C. 207; see also *Bailey* v. *Roberton*, 1878, L. R. 3 App. Cas. 1079.

See sections 5–8, pp. 94–133, for examples of decisions upon the necessary quantum of ingenuity.

Patent for preserving meat.

It must be remembered, that the question whether a new use is merely analogous to old ones, or whether it required invention to discover, is one of fact, depending not upon abstract considerations, but upon the state of the arts and the nature of the case.

It is sometimes said that no patent can be granted

CHAP. III. SECT. 3.

The use of an old machine or thing for a merely analogous purpose or in an analogous way is not the subject to a patent.

The use of an old material for a merely analogous purpose is not patentable.

for the new use of an old material. Thus, Wightman, J., is reported to have said: "I entertain a strong opinion on this question as to whether a mere application can be made the subject of a patent, for when once you have got a material you may apply it as you think fit: *R.* v. *Cutler*, 1847, M. P. C. 124, 14 Q. B. 372, n. From the case, however, it is quite clear that the judge was speaking of applications to analogous purposes only, and a similar remark applies to the judgment of Maule, J., in *Bush* v. *Fox*, 1854, M. P. C. 166; *Tetley* v. *Easton*, 1852, 2 C. B. (N.S.) 706, 26 L. J. C. P. 269. The case of *Ralston* v. *Smith*, 1865, 11 H. L. Cas. 223, 20 C. B. (N.S.) 28, is usually cited in support of the proposition, that when a material is common property it may be used for any purpose. This was an invention for improvements in embossing and finishing woven fabrics, and in the machinery employed therein. The specification as amended claimed the employment of rollers driven at a greater speed than the "bowl." "Although the patentee may have discovered how to use the machine more beneficially than the owner knew, he has no right to take a grant which virtually prohibits the owner from an existing right over his own property" (*per* Erle, C.J.) 9 C. B. (N.S.) 117. This view was confirmed in the House of Lords by Lord Cranworth: "It is not every useful discovery that can be made the subject of a patent, but you must shew that the discovery can be brought within a fair extension of the words, a 'new manufacture.' Now, how is it possible that this can be a 'new manufacture'? I, as a manufacturer, have my roller, which I am in the habit of rolling upon my bowl (if that is the proper expression), the fabric passing between the two at equal velocities. Then I can impress any

Ralston v. Smith.

pattern upon it. I have my roller without any pattern engraved upon it; I can impress that at an unequal velocity and it will calender. But I do not do these both at the same time, because I suppose that in doing so I shall tear my fabric, and I rightly suppose so till the plaintiff makes the discovery that there is one particular sort of pattern which may be produced without tearing the fabric. Now, that is a very useful discovery, but it would be a strange thing to say that this is a new manufacture, and that therefore I am to be deprived of the most useful way of using my roller." If this decision meant no more than that there can be no patent for the use of an old machine in a manner analogous to that in which it had been used in the past, the decision would accord with all the other cases, but it seems very doubtful whether the new use here proposed was a mere analogue; and it is to be noticed that Lord Westbury, who gave judgment in the case at the same time, based his reasoning upon very different grounds: "I should have thought that the patentee might have maintained a patent for a new combination, if he had put his invention upon this ground, that he was the first person who discovered that the circular grooved roller would answer by one process the double operation of calendering and imprinting the fabric," and he based his decision on the insufficiency of the specification.

The use of an old machine or thing for a merely analogous purpose or in an analogous way is not the subject to a patent.

Care to be used in interpreting this judgment.

Lord Westbury's view.

In *Patterson* v. *Gas Light & Coke Co.*, 1875, L. R. 2 Ch. D. 812, 834, the patent was in substance for a method of using successive lime purifiers for gas. The old method was to pass the gas through lime to remove the carbonic acid and sulphur, and then through oxide of iron. The patentee did not alter the apparatus, but only advocated the use of it so as not to allow any

Compare with Dowling v. *Billington*, *post*, p. 114.

CHAP. III. SECT. 3.

The use of an old machine or thing for a merely analogous purpose or in an analogous way is not the subject to a patent.

The more efficient use of old methods will not support a patent.

carbonic acid to enter the last lime purifier, as by doing so it liberated sulphur from the lime and sent it into the gas again as fast as the lime took it out of the gas. The method of doing this simply amounted to keeping the purifiers more clean, and emptying their contents more often. James, L.J., said: "No one has a right to prevent a workman from using care to keep his tools in the most efficient state; no one has a right to prevent a manufacturer from cleansing his vessels and throwing away their useless contents whenever he likes, or to ask him his motives and intentions for doing so. . . . It really only amounts to a direction to be sufficiently liberal in the use of the caustic lime in the first stage." The decision was affirmed in the House of Lords, on the ground that a man is not entitled to a patent for discovering the reason of a process which was empirically used before. In *Kay* v. *Marshall*, 1841, 2 W. P. C. 82, Lord Cottenham says: "If the patentee has discovered any means of using the machine which the world had not known before the benefit of, that he has a right to secure to himself by means of a patent, but if this mode . . . was known before, the plaintiff cannot deprive them of having the benefit of that which they enjoyed before." These cases must, however, not be interpreted as meaning that a really new step in an old process, or a really new mode of using an old machine or article, is not patentable. The fair test is whether the patent is for "the use of a well-known machine to a merely cognate purpose": *Croysdale* v. *Fisher*, 1884, 1 R. P. C. 19. In *Muntz* v. *Foster*, 1843, 2 W. P. C. 92, the patent was for a special alloy of 80 parts of copper and 100 of zinc, which afterwards became known as Muntz's metal. It had the peculiar property of bearing rolling at a low red

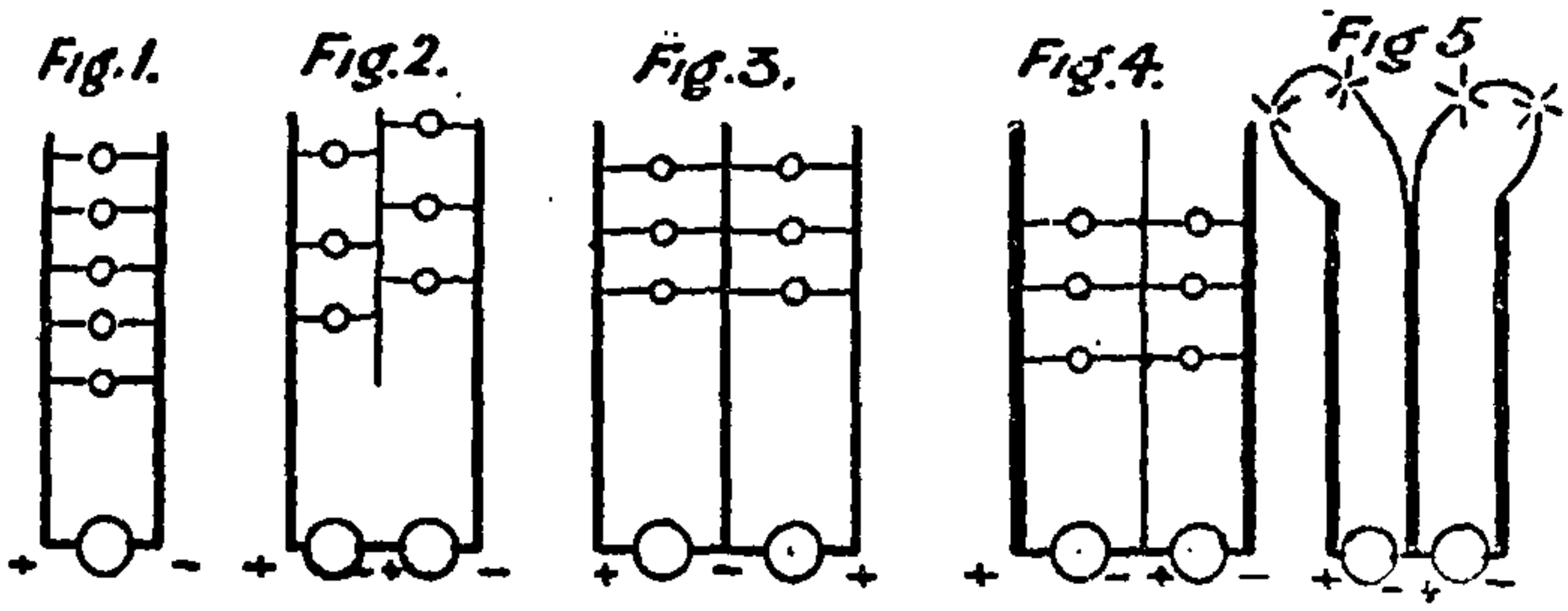
Compare with Badishe Anilin Fabrik v. *Dawson*, 1889, *post*, p. 114.

post, p. 118.

The use of an old machine or thing for a merely analogous purpose or in an analogous way is not the subject to a patent.

heat. Zinc and copper, when alloyed, make brass, and it was argued that this was only a sort of brass, but Lyndhurst, C., said: "I do not think that the circumstances of shewing that . . . . infinitely varying combinations must have been made . . . . or the proportions combined for another and different purpose . . . . destroys the patent."

The case of *Penn* v. *Bibby*, 1866, L. R. 2 Ch. App. 136, will illustrate this. Wooden bearings for grindstones and mill wheels were of course old. The plaintiff proposed a bearing for a screw propeller. The bearing was larger than the shaft, and contained ribs of wood fastened round the inside, so that the shaft turned in them, and was lubricated by the water that entered by the interstices between them. The patent was held valid.



This important principle is also well illustrated by *Hopkinson* v. *St. James' and Pall Mall Electric Light Co.*, 1893, 10 R. P. C. 46. The plaintiff's patent was for a pressure regulator, and also for what is known as the "Three wire system" of laying electric mains. The interest of the case was entirely confined to this latter which we shall now proceed to describe. No electric machine generates electricity, properly speaking: it only causes electricity to "move on" as water is pumped by a pump. The work-doing or lighting power of an electric

CHAP. III. SECT. 3.

The use of an old machine or thing for a merely analogous purpose or in an analogous way is not the subject to a patent.

current, like the work-doing power of a current of water depends on its quantity, but also on its pressure, and by using high pressures, whether with water or electricity, we can drive machinery by means of much smaller and more economical wires or pipes, than we should have to use if the pressure were smaller. Hence high pressures admit of the use of small wires to convey the same amount of working power as large wires with low pressures.

Prior to the plaintiff's patent, incandescent lamps, which, unlike arc lamps, require to be fed at a constant pressure, had been fed with electricity by three different systems of "parallel lighting." First, there was the simple parallel system (*Fig. 1.*), where the lamps were simply shunted across the conducting cables. And as these lamps usually work at about 70-100 "volts," this was the pressure usually employed, and was sometimes simply duplicated (Fig. 3). The object of this was to enable the two sides or wings to be worked independently, so that one could be out and its dynamos stopped, while the other was alight. The mains were all equally thick. Of course a considerable fall in pressure took place at a distance from the dynamo, just as happens in gas or water mains.

In order to be able to use more economical mains and a more uniformly distributed pressure, the first improvement suggested was to arrange the lamps in pairs, in series, so as to be able to double the pressure (Fig. 2). This effected some saving, for the size of the mains could be reduced to one half; it was called the compound parallel system. But it was subject to the defect that the current had to flow through the lamps on the left side to reach the lamps on the right side, and consequently, if many were turned out on the left side, the electricity in

The use of an old machine or thing for a merely analogous purpose or in an analogous way is not the subject to a patent.

its struggle to get through, overworked the remainder, while, as a less total got through, all the lamps on the right hand were under-worked. To cure this difficulty, the plaintiff ingeniously suggested the arrangement in Fig. 4; and, to use the words of Romer, J., "the thing was done." It was really only Fig. 3, but with one of the dynamos reversed the other way. The effect was, that if some of the lamps on the left-hand side were turned out, and the current needful to supply the right-hand side was diminished, it was made up by the flow of the necessary extra quantity along the middle wire, and as this merely differential quantity was small, it needed but a thin wire.

Of course, if the central wire were thick, the system could also be worked in wings, like Fig. 3, but then the great saving produced by a thin central wire, would be lost. It was objected that the plaintiff had not confined his patent to parallel lighting, but this was decided in his favour. So far the plaintiff's patent was clearly valid. But several anticipations of the exact arrangement were produced. First, one at Sauchie Hall, which would have been a clear anticipation, but that the proof broke down that the middle wire was conducted back to join the middle point between the dynamos. In default of which the arrangement was no more than Fig. 2. Two others were produced, relating to arc lamps in series as in Fig. 5, with the middle wire properly brought back and with the dynamos properly placed. Here was apparently a clear anticipation, but it was held not to be one, because the persons who had thus used it, had done so, not with the intention of regulating the light and using small mains, but with the intention only of working the lamps in "wings," either one or the other as they pleased, *and they manifested this by using a thick centre return cable.* This

CHAP. III. SECT. 3.

The use of an old machine or thing for a merely analogous purpose or in an analogous way is not the subject to a patent.

post, p. 103.

post, p. 111.

shewed they had not understood the plaintiff's plan, nor anticipated it, and because they had only unwittingly obtained a result of the value and very nature of which they were ignorant, their operations were held to be no anticipation. A point also arose on the construction of the specification as to whether the plaintiff had really confined it to "parallel" lighting, which was decided in his favour. See also *Bamlet* v. *Picksley*, 1875, Griff. 40; *Poupard* v. *Fardell*, 1869, 18 W. R. 59, 127; *Siddell* v. *Vickers*, 1888, 5 R. P. C. 81, 416; 7 R. P. C. 292.

4. The substitution in a machine or process of something which is afterwards discovered to be a mere analogue or mechanical equivalent may form the subject of a good patent, if in the state of knowledge at the time of the patent, the thing substituted was not known to be an analogue.—In some future time discoveries will be so co-related that every scientific fact will perhaps seem to be a mere outcome of some other. Meantime we must judge of inventions by the light approved by the science of the day; and, if this be admitted, the proposition stated above will follow. For every patent must be judged by the state of knowledge at the time it was taken out: *United Telephone Co.* v. *Harrison*, 1882, 21 Ch. D. 720; *Crossley* v. *Beverley*, 1819, 1 W. P. C. 107; *Lewis* v. *Marling*, 1829, 4 C. & P. 57, 10 B. & C. 27: see also "Construction of the Specification," Chap. XI., sect. 3.

post, p. 210.

5. If there be invention the degree of it may be slight.—It has been explained that, provided the Crown be not deceived, the amount of the consideration on which the patent is expressed to be granted, may be slight. Hence, if an invention possesses even a slight

ante, p. 70

amount of ingenuity the patent for it will be supported, for the Court will not weigh the value of the invention. Its only duty is to see not whether a patent is valuable, but whether it is valid. The most clear expression of this principle is found in *Hinks* v. *Safety Lighting Co.*, 1876, L. R. 4 Ch. D. 615, though an examination of the invention itself leads to the conclusion that it was more valuable than seemed to be supposed by the Master of the Rolls.

If there be invention the degree of it may be slight.

post, p. 103.

It was for two sorts of paraffin lamps, viz., that now known as the duplex lamp, and a sort of paraffin argand

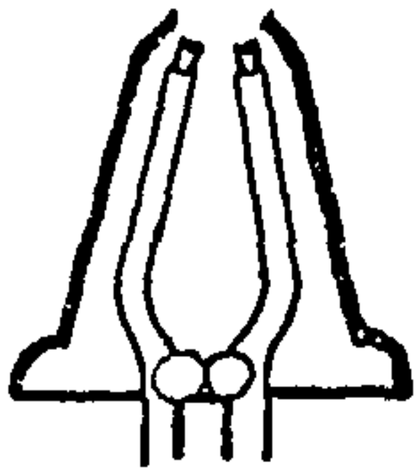


Fig. 1.



Fig. 2.



Fig. 3

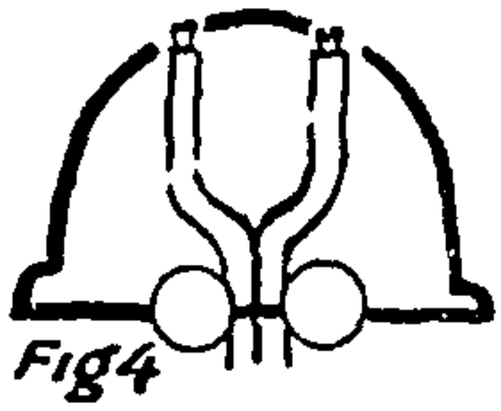


Fig 4

burner, with a horizontal disc of metal in the centre of the flame. The reasons of the utility of the duplex burner are as follows. In order to secure good combustion, it is necessary to bring the air well into contact with every part of the flame. This necessitates the use of thin flat wicks. In order to get light enough, without making the wick too wide, and thus rendering the chimneys too flat, two wicks are placed side by side, and in order to secure good combustion, they are separated by a ridge of metal, which directs the rising current of heated air well into the flame (Fig. 4). Or, again, in order to get the necessary width of wick it may be curled round into a circle as in the argand lamp, in which case in order to direct the air on the flame, a

CHAP. III. SECT. 5.

If there be invention the degree of it may be slight.

horizontal disc of metal is placed above the wick in the centre of the flame (Fig. 3).

In 1871, Messrs. Hinks having threatened to stop the sale by Rollins of paraffin lamps having two wicks with the flames projecting through one hole, Rollins obtained an injunction restraining these threats: L. R. 13 Eq. 355. In 1876, Hinks brought an action against the Safety Lighting Company for infringement of his patent. The anticipations set up by the defendants were Halvorsen's American patent for a double wick, and Little's English patent for five round wicks with the flame coming up through one hole (Figs. 3 & 4). In this action it became necessary for Hinks to change his ground and no longer assert that his patent was for a two-wicked paraffin lamp, but for a paraffin lamp with two wicks and two flame holes. Jessel, M.R., after commenting on the position previously taken up by the plaintiff, decided that this was the true interpretation, and found that part of the patent valid. As to the argand burner with the disc (Fig. 2) he treated it as "a trumpery matter," and inasmuch as no utility was proved, and the specification and drawing did not shew the holes through which the air entered to feed the lamp, he declared the whole patent invalid. In the course of his judgment he laid down the law that a slight amount of ingenuity will support a patent: L. R. 4 C. D. 615. *The American Braided Wire Company* v. *Thomson*, 1889, 7 R. P. C. 47, is another instance of a very slight amount of invention being held sufficient.

post, p. 114

"It may be the result of a lucky discovery": *Crane* v. *Price*, 1842, 1 W. P. C. 411; *Liardet* v. *Johnson*, 1778, 1 W. P. C. 54; *Haslam* v. *Hall*, 1886, 5 R. P. C. 1; *Hayward* v. *Hamilton*, 1879, Griff. 115.

post, p. 112

Cases of sufficient ingenuity to support the patent.

6. Examples of Cases in which the Invention was held sufficient.—*Huddart* v. *Grimshaw*, 1803, 1 W. P. C. 92.—A patent for rope-twisting held valid as a new way of doing an old thing.

Hall v. *Jarvis*, 1822, 1 W. P. C. 100.—Silk, cotton, and woollen articles and stockings had previously been freed from projecting fibres by passing them through hot rollers, or else by singeing them (when placed on a board or a wooden leg) with flames of wood, charcoal, or coal. Bellows had been used to force the flame into the interstices. Plaintiff's patent was for the use of a flame of gas with a chimney to draw it through the interstices of cotton-lace goods. Strong evidence of utility was given and the patent supported.

ante, p. 75.

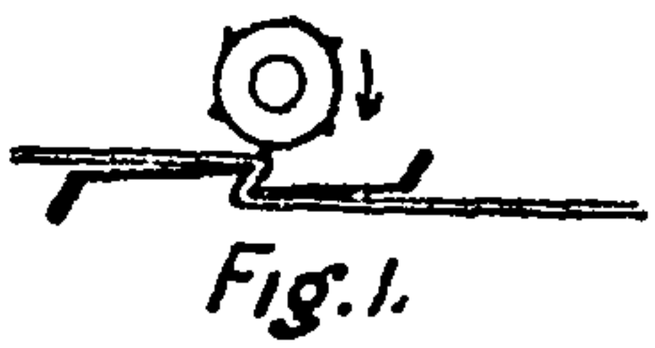


Fig. 1.

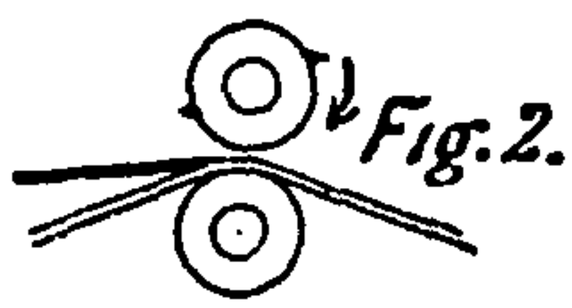


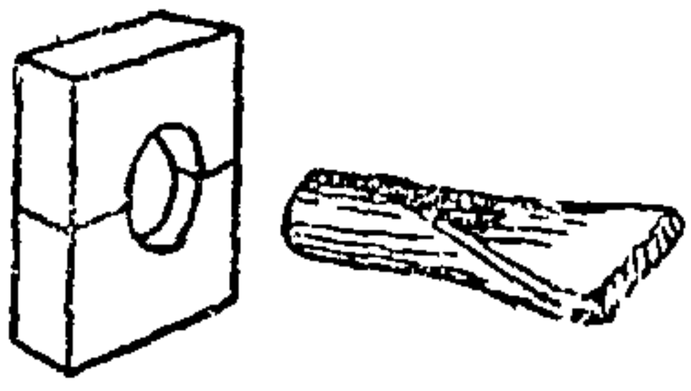
Fig. 2.

Lewis v. *Davis*, 1829, 1 W. P. C. 488.—This was a patent for shearing cloth from list to list. Fig. 1 shews the plaintiff's method. The cutter consisted of a roller with a number of triangular steel wires wound spirally on it. The cloth was passed between two springs, which brought it close up to the cutters. Fig. 2 represents the infringement of the defendant. It was proved that the shearing of cloth from list to list was old, also that cloth had been previously sheared from end to end by means of circular cutters. The defendant had previously been in partnership with the plaintiff, the utility of whose invention was endorsed by the fact that he had made a large fortune by means of it. The jury found for the plaintiff, and the verdict was supported.

CHAP. III. SECT. 6.

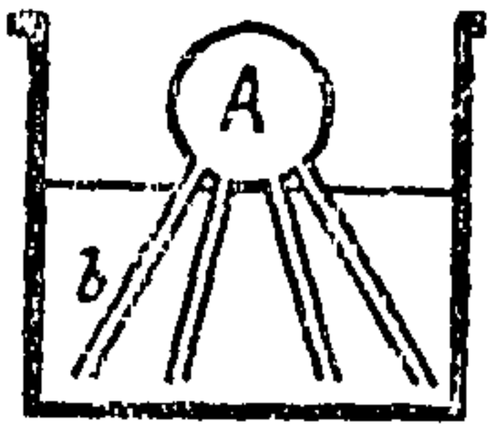
Cases of sufficient ingenuity to support the patent.

Russell v. *Cowley*, 1832, 1 W. P. C. 457.—The plaintiff's patent was for a method of making gas piping or other iron tubes by taking a strip of metal heated in a furnace, and bending one end into a tube. It was then drawn through a pair of dies and thus welded into a tube. In anticipation, it was proved that a



method had been proposed for welding gun-barrels by putting them on a mandril, and then passing them between grooved rollers. This, as might be expected, was held to be no anticipation.

Hullet v. *Hague*, 1831, 2 B. & Ad. 370.—A prior patent, to which no drawing was attached, had described a method of evaporating sugar, by causing hot air to bubble through it by means of pipes pierced with orifices, put at the bottom of the pans. The plaintiff's patent was for a special arrangement for carrying this out, as shewn in the figure where A is the air pipe, and *b b* are



jets, or tubes leading from it. The patent was supported.

Cornish v. *Keene*, 1837, 3 Bing. (N.C.) 570, 6 L. J. C. P. 225.—This was an action on a patent granted to Sevier in 1833. By a prior patent in 1831 Sevier had disclosed the curious property of india-rubber, that if stretched while heated, and allowed to cool, it remained stretched, but that if it were again heated it shrank back and recovered its elasticity. The patent sued on was for weaving threads of such stretched india-rubber in its quiescent state among the warp or woof of woven fabrics, and then heating it so as to shrink the india-rubber and contract the fabric, which thus became elastic to an

Cases of sufficient ingenuity to support the patent.

extent limited by the original size of the threads in the warp or woof, and which prevented the india-rubber being broken by undue stretching. It was shewn that india-rubber threads, both covered and uncovered, had been woven before, but never combined with threads so as to limit the elasticity. The patent was held valid.

Crane v. *Price*, 1842, 4 M. & G. 580, 1 W. P. C. 393. —The use of hot blast for smelting iron was old, also the use of anthracite coal. A combination patent for using them together was held good; see, however, remarks on this case in *Murray* v. *Clayton*, 1872, L. R. 7 Ch. 584, and *Clark* v. *Adie*, 1877, 2 App. Cas. 335. *ante*, p. 57.

Allen v. *Rawson*, 1845, 1 C. B. 551.—Patent for felt-making claiming (*inter alia*) the use with rollers, of soap and water; soap and water had been used before, and rollers with acidulated water had been used before. Held, a good patent.

Newton v. *Vaucher*, 1852, 21 L. J. Ex. 305.—Defendant had patented the use of soft metal, preferably made of zinc, tin, and antimony, in order to make bearings, pistons, and other moving parts of pumps, hydraulic machines, and steam engines, water-tight, or steam-tight. Plaintiff afterwards found that linings of britannia metal, pewter, or any alloy of which block-tin was the basis, would diminish the friction of bearing surfaces, the linings being held in place by rims, or fillets, or other suitable means. His patent was held good in *Newton* v. *Grand J. Canal Co.*, 1846, 20 L. J. Ex. 427. In 1852 he brought an action against the defendant. Held, that his invention was sufficiently distinct from that of the defendant, though the same sorts of metal were used for different purposes.

Walton v. *Potter* and *Walton* v. *Bateman*, 1841, 1

YALE LAW LIBRARY

CHAP. III. SECT. 6.

Cases of sufficient ingenuity to support the patent.

W. P. C. 585.—Cards are a sort of brush with metal bristles fixed into what is termed the fillet, and which corresponds to the back of a hair-brush, for scratching up wool, cotton, and other substances. It is needful, however, to fix the bristles not rigidly, but to some slightly flexible fillet, and leather had been generally used up to the time of the Walton's patent, by which, in 1834, he proposed to use a simple slice of native india-rubber backed with brown holland for the fillet, for the purpose of giving it greater elasticity. An action was brought on this patent in 1841 against Potter, and in 1842 against Bateman.

In 1825, Hancock had patented the use of india-rubber dissolved in naphtha and turpentine, mixed with cotton and other substances, to make a flexible substitute for leather. There was some evidence that he had used it for cards, but probably in a merely experimental way. The juries found for the plaintiff in both actions, and the Courts supported their finding on the ground that the essence of the plaintiff's invention was the application of the elastic property of india-rubber, whereas Hancock's mixture, even if it could have been shewn to have been used for cards, had merely secured flexibility, and even destroyed the elasticity, and that the plaintiff's invention was, therefore, for an ingenious application of an old substance to a new purpose. The patent was tried again in 1842 on a *scire facias*, in which, in addition to the previous evidence, it was also shewn that Hancock had disclosed the use of his invention for making cards, at a public scientific meeting in 1826. The jury found this time against the patent. A rule for a new trial was applied for, but the proceedings were ultimately compromised (see *Barley v. Hancock*, 1856, 6 De G. M. & G. 420).

Cases of sufficient ingenuity to support the patent.

Bovill v. *Keyworth*, 1857, 7 E. & B. 725, 3 Jur. (N.S.) 817, —A blast had been used to convey the matter from between mill-stones, and an exhaust had also been used. A combination of a blast with an exhaust was held good; see the criticisms on this case in Wynne's Bovil Patents, Lond. 1873, p. 47.

Hills v. *London Gas-light Co.*, 1860, 5 H. & N. 312, 29 L. J. Ex. 409; *Hills* v. *Evans*, 1862, 31 L. J. Ch. 457, 8 Jur. (N.S.) 525.—The property of hydrated oxide of iron in absorbing sulphuretted hydrogen was known, and also that the sulphuret of iron so formed would be re-oxidised if exposed to the air. Held, that a patent might be taken out for the *application of these principles* to gas manufacture.

Betts' Patent, 1 Moore's P. C., 1862, at p. 60.—"This is a good illustration of the distinction . . . between the merit of ingenuity and the merit of utility. Dobbs' specification may have given the petitioner the idea of the possibility of uniting the two metals tin and lead, and may thus have deprived him of the merit of originality, but in Dobbs' hands the discovery was barren, the petitioner, who . . . gave it a practical application, is the real benefactor to the public" (*per* Lord Chelmsford): see *Betts* v. *Menzies* cited, Chap. V., sect. 9. *post*, p. 154.

Spencer v. *Jack*, 1864, 11 L. T. (N.S.) 242.—Patent for surface condensers for engines. "A new and useful combination of things previously well known, may be the subject of a patent" (*per* Westbury, L.C.).

Young v. *Fernie*, 1864, 4 Giff. 577, 12 W. R. 901.—Patent for distilling paraffin oil from cannel coal and getting solid paraffin from it. Held good, for previous experiments upon shale coal, and even on cannel coal, had been used to make small quantities of

CHAP. III. SECT. 6.

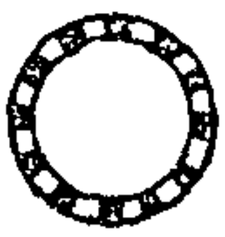
Cases of sufficient ingenuity to support the patent.

paraffin wax, and were little more than "ornaments of a museum."

Macintosh v. *Everington*, 6 Rep. Arts. (N.S.) 317, 365.—Patent for putting india-rubber solution as a cement between two fabrics held good, notwithstanding that the use of india-rubber in other states, and other substances, for the same purpose, was well known.

Dangerfield v. *Jones*, 1865, 13 L. T. (N.S.) 142.—Patent for a method of bending walking-stick handles. After being softened in moist sand they were bent over a hollow mandril heated from the inside with a gas-jet and clamped down. It was proved that a band of steel had been used to bend sticks made out of sawn timber, the band being placed externally over the bend, and the stick and band being then heated externally. A *solid* mandril had also been employed for bending natural twigs after they had been taken out of moist sand. Defendants had taken out a license to use plaintiff's machines. Held, that this was evidence that defendants thought it a new invention. Patent supported.

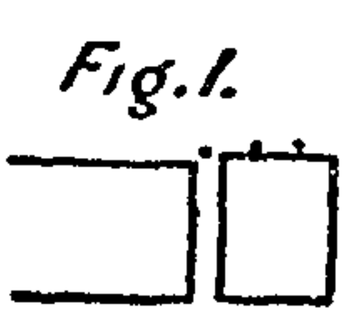
Penn v. *Bibby*, 1866, L. R. 2 Ch. App. 127.—Grind-stones and water-wheels had been made with shafts working on wooden bearings. Plaintiff patented an

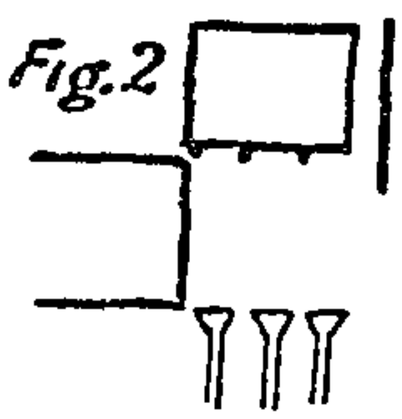


invention (see the Fig.) for diminishing the friction of screw-propeller shafts by introducing strips of wood into the bearings of the shafts of screw and submerged propellers, so that the water constantly wetted the wood, and lubricated the bearing. It was shewn to be useful, and supported as displaying invention.

Murray v. *Clayton*, 1872, 7 Ch. 570, 10 Ch. 675, n., 15 Eq. 115.—The patent was for a method of making bricks. A tape of moist clay being squeezed forward from a

kneading machine, a piece was cut off it, sufficient to make a number of bricks, by a wire moved transversely, and the part so cut off rested on a table. It was then pushed transversely off this table on to a movable board by a row of pistons. On its passage it encountered a series of equidistant vertical wires, which cut it into bricks, which were then removed, board and all (Fig. 2). An anticipation was proved which was very similar (Fig. 1), only instead of the cut-off mass being pushed off the table on which it rested, the whole table was slid transversely encountering a row of vertical wires which cut the bricks up, which had to be removed from the table by hand. The table was then slid back to its place. The patent was considered to have a very narrow ambit, but to be valid for the exact combination described, and useful as avoiding the removal of the bricks by hand, which was necessary in the case of the anticipation.





Bamlett v. *Picksley*, 1875, Griff. P. C. 40.—Where it was known that macaroni could be pressed through dies into pipes, *semble*, a good invention to do the same with red-hot iron.

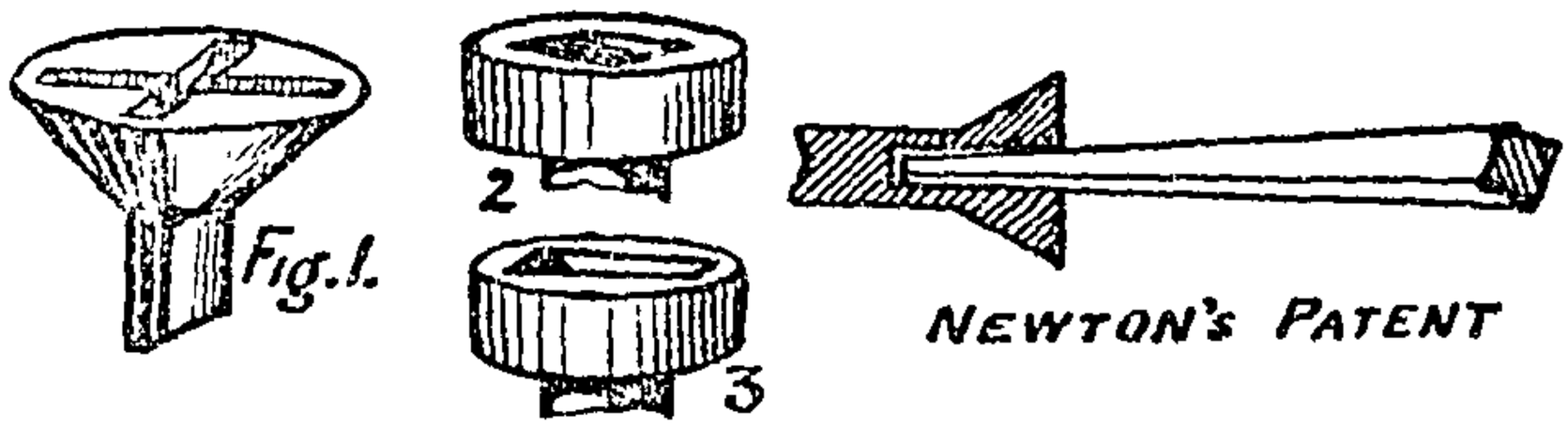
Hinks v. *Safety Lighting Co.*, 1876, L. R. 4 Ch. D. 615. *ante*, p. 95. —An inventor had patented the combination of two wick cases with a double-slotted cone, which was new, though contrivances very closely resembling it had been used before. Jessel, M.R., said: "When a slight alteration in a combination turns that which was practically useless before into that which is very useful and very important, judges have considered, that though the invention was

CHAP. III. SECT. 6.

Cases of sufficient ingenuity to support the patent.

small, yet the result was so great as fairly to be the subject of a patent, and so far as a rough test goes, I know no better." The patent was, however, adjudged bad because it was not properly described in the specification.

Frearson v. *Loe*, 1878, L. R. 9 Ch. D. 48.—This was a patent for a new form of head for carpenters' screws, consisting of one or more grooves milled out with a circular cutter, so as to be of the shape that would be produced by pressing the edge of a coin into soft wax, but not so as to extend beyond the head of the screw. Sometimes two such nicks were cut at right angles to

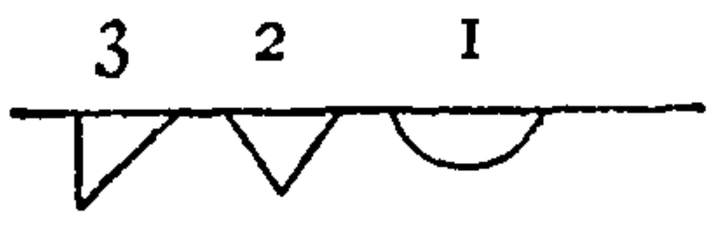


one another (Fig. 1). The screw-driver of course had a rounded point. It was claimed that by this arrangement the head of the screw was stronger. Anticipations, as shewn in Figs. 2 and 3, were proved, and also a patent by Newton, for a circular hole in the screw-head, actuated by a square tapered screw-driver. The Master of the Rolls declared the patent valid.

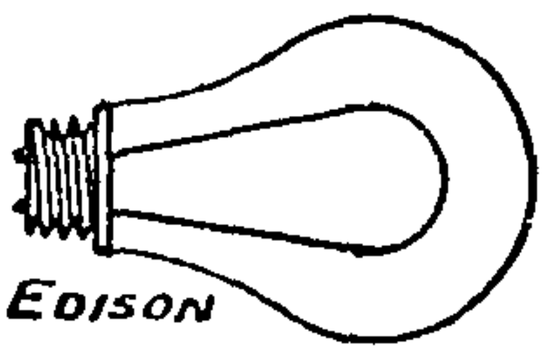
Sykes v. *Howarth*, 1879, L. R. 12 Ch. D. 826, 48 L. J. Ch. 769.—The introduction of wide spaces between the cards on a roller so as to produce an exhaust current of air, supported.

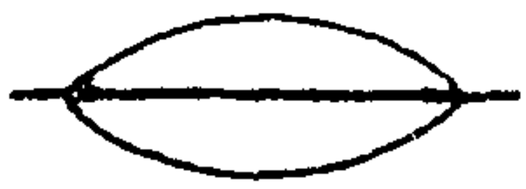
Hayward v. *Hamilton*, 1879, Griff. P. C. 115.—Prisms for deflecting light were old; so also were glass pavement-lights of rectangular shape, and bull's-eyes (Fig. 1); and in ships prismatic deck-lights of glass had been used (Fig. 2), but not for giving definite direction

to the reflected light. Plaintiff took out a patent for pavement-lights with prisms of peculiar shape for deflecting the light nearly horizontally (Fig. 3). Held in the C. A. to display sufficient invention. "It is very strange if it is no invention, that it has never been done before" (*per* Bramwell, L.J.).



Edison v. *Woodhouse*, 1886, 3 R. P. C. 165, 4 R. P. C. 79.—By this action the validity of the Edison patent of 1879, for the electric incandescent or glow-lamp was established. When electricity is passed through any conductor it always does work in that conductor proportioned to the resistance experienced in its flow. The work usually is developed in the form of heat. The greater the resistance in proportion to the electric energy passing through it the more violent the action and the hotter the conductor becomes.


EDISON


SWAN.

With a certain quantity of electricity the conductor becomes red hot, then white hot, radiating out both light and heat, and the greater the temperature, the greater is the amount of light given as compared with the heat. So that if one desired an economical form of lighting apparatus, the resistance should be great, and the temperature as high as possible. At this high temperature all metals fuze, and most metallic earths, such as clay. A few oxides, such as that of zirconium, will resist, but one of the very best substances, which is also a conductor of electricity, is carbon, on account of its extraordinary infusibility. Unfortunately it oxydises very easily, so that in order that it may be used it has

CHAP. III. SECT. 6.

Cases of sufficient ingenuity to support the patent.

to be enclosed in a very perfect vacuum, or else it would burn away in an instant.

Up to the year 1879 no good incandescent lamp was practically known, but incandescent wires of platinum and rods and spirals of carbon had been used in glass vessels from which the air was exhausted. It was known that high resistances were necessary. Moreover, Swan, in 1878, had exhibited a slender rod of carbon, one-twenty-fifth of an inch in diameter, in incandescence, hermetically sealed into an exhausted globe. Edison's patent was for a "filament" of carbon of high resistance sealed into a glass globe from which the air was exhausted. It was urged that this was no invention when once it was known that high resistance was required, that carbon was suitable, and a vacuum necessary; but Butt, J., decided for the plaintiffs. This was confirmed on appeal. on the ground that what Edison had discovered was the necessity for the use of *threads* of carbon, one way of making which he described, and the value of the invention was shewn by the success which attended it, and the failure of all previous experiments.

Next year, however, the question was tried over again: *Edison and Swan Electric Light Co.* v. *Holland*, 1888, 5 R. P. C. 459. At this trial fresh evidence was produced, which had been mainly obtained by forcing the plaintiffs to disclose information which had been prepared by Swan, to enable him to contest an action against him by Edison before they united. Kay, J., thought that inasmuch as the necessity of high resistance was known, and carbon was known, no one could have a patent for uniting them. He also found that there was insufficient description, and that the claim was too wide. On appeal, however, this judgment was reversed, on the

Cases of sufficient ingenuity to support the patent.

ground that though Swan's lamp might, and probably would, have been an anticipation if it had been a commercial success, yet that it had been a mere abandoned experiment: 6 R. P. C. 243.

Closely connected with this patent is one also owned by the Edison and Swan Company. It was found that when filaments were made by carbonizing threads or strips of fibre in closed retorts, that the carbonized fibres were uneven, and were burned up at the weak places. To secure uniformity, a very ingenious process was patented called "flashing." The filaments were placed in a gas or liquid rich in carbon, such as coal gas or petroleum, and then heated by a current of electricity. This caused the carbon to be deposited from the gas or liquid on to the filament. But as the electricity heated the fibres most, just at their weakest points, a greater deposition of carbon from the gas or liquid was caused to take place on their weaker parts than elsewhere, and so the filament was rendered uniform. It was endeavoured to shew that Sidot and Depretz and others had previously known that hydro-carbons could thus be deposited, but inasmuch as it could not be shewn that this fact had ever been utilized for any process akin to "flashing," the patent was supported: *Edison* v. *Woodhouse*, 1886, 3 R. P. C. 183, 4 R. P. C. 99.

Otto v. *Linford*, 1881, 46 L. T. (N.S.) 35; *Otto* v. *Steel*, 1886, 3 R. P. C. 109.—The part of the patent which really came in question was for an old form of gas-engine. The gas-engines of Lenoir and others worked very like a steam-engine, simply sucking in the mixture of gas and air during the commencement of the piston's motion, then, when this had been done, igniting it, whereby the piston was driven forward during the

CHAP. III. SECT. 6.

Cases of sufficient ingenuity to support the patent.

remainder of its stroke. On its return the piston expelled the foul exploded air from the cylinder, which was then ready for a fresh charge. The improvement of Otto in this patent consisted of letting some pure air in first, then behind it some mixed air and gas, and as these were all sent in from behind he concluded that the state of the cylinder just before ignition was a residuum of burned gas and air next to the piston, then air, and behind all the explosive mixture. The light being applied from behind he argued that the explosion would be gradual through these three layers. Experiments seemed to justify this view, and the practical result of improved working was certain. The scientific accuracy of this explanation of the matter is perhaps open to question, for the kinetic theory of gases shews that layers will mix with a rapidity so great that it is doubtful whether these layers would have remained, even if they ever existed, for more than a very short time. On the evidence, however, coupled with the fact that whatever the theory was, there was a great increase of efficiency; the patent was supported. Most gas-engines now work by igniting gases in a compressed state, which was the subject of Otto's second claim, but was not disputed, after De Rocha's alleged anticipation had been held not to have been published in England.

Watling v. *Stevens*, 1886, 3 R. P. C. 37, 147.—The plaintiff patented a tip-waggon, in which the body of the waggon ran on small wheels on a frame attached to the axles. When pushed backwards, a pin on the body caught in a notch at the back of the frame, and the body of the waggon tipped over, and was prevented falling by a retaining rod (not shewn in the figure). Previously to this another inventor had patented Fig. 2,

Cases of sufficient ingenuity to support the patent.

the action of which sufficiently appears from the drawing. The Court held this no anticipation, for the body was

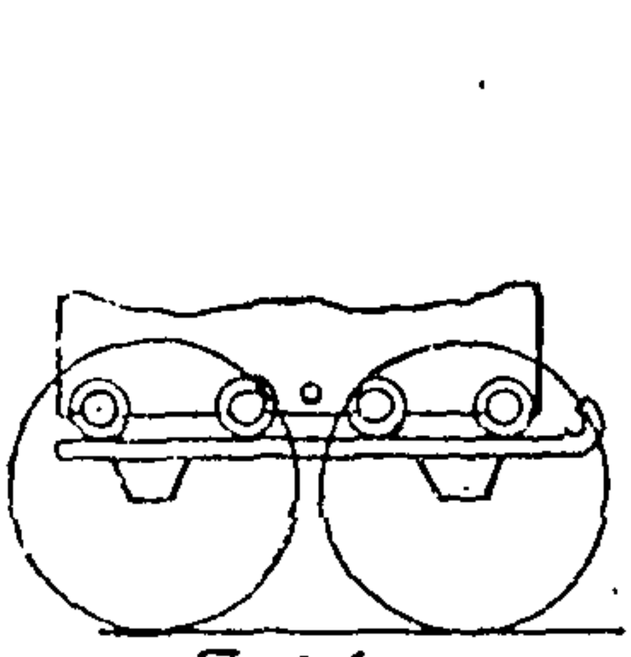


Fig. 1.

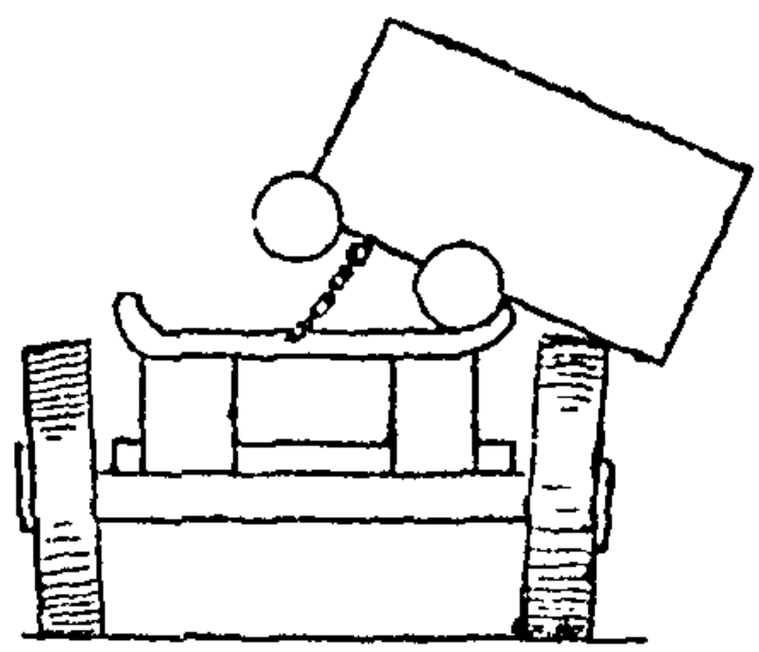
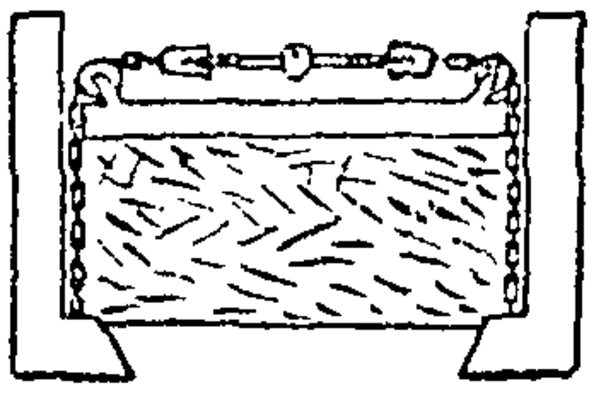


Fig. 2.

not properly supported by its wheels, and would break, and was considered different in construction from the plaintiff's, though the leading idea on which it was constructed was the same.

Reynolds v. *Amos*, 1886, 3 R. P. C. 215.—Plaintiff patented an invention for compressing ensilage, consisting of chains fastened to the bottom of the pit or passing under the ensilage, and fastened with pegs after being strained tight by a jack or lever. Before this dead weights had been used to compress the ensilage, and the ensilage had been compressed by screw-jacks. Held (by Bacon, V.C.), to display invention.

See remarks in Sharp v. *Brauer*, 1886, *post*, p. 123.



Moseley v. *Victoria Rubber Co.*, 1887, 4 R. P. C. 241; 55 L. T. (N.S.) 482. The cold process for vulcanising india-rubber, or india-rubber coated fabrics, had been invented by Parkes in 1846. Instead of heating the india-rubber with sulphur, the sheets of india-rubber are immersed in a solution of chloride of sulphur in disulphide of carbon, or other solvent, or else merely exposed to the vapour of that solution. It had been previously known

CHAP. III. SECT. 6.

Cases of sufficient ingenuity to support the patent.

also, that if before being heated with the vapour, the fabrics were covered with farina, a silky bloom was imparted to them. The plaintiff further discovered that in the state when covered with farina, the cloth was peculiarly susceptible to being printed with colours in patterns. This was due to the very absorbtive nature of the coating of farina. He patented the invention. It was objected that the invention was only the application of ordinary colour printing rollers to farina-coated india-rubber goods. But Chitty, J., held that, inasmuch as such printing only succeeded on farnia covered goods, it was not a mere adaptation of an old process, but one which was a new invention.

Kaye v. *Chubb*, 1887, 4 R. P. C. 23, 289; 5 R. P. C. 641.—This was an invention for a door-latch, in which the bolt was drawn back to open the door, simply by pulling the handle from the inside, or pushing it from the outside. The spindle had a collar *a*, acting on a lever *b*, which

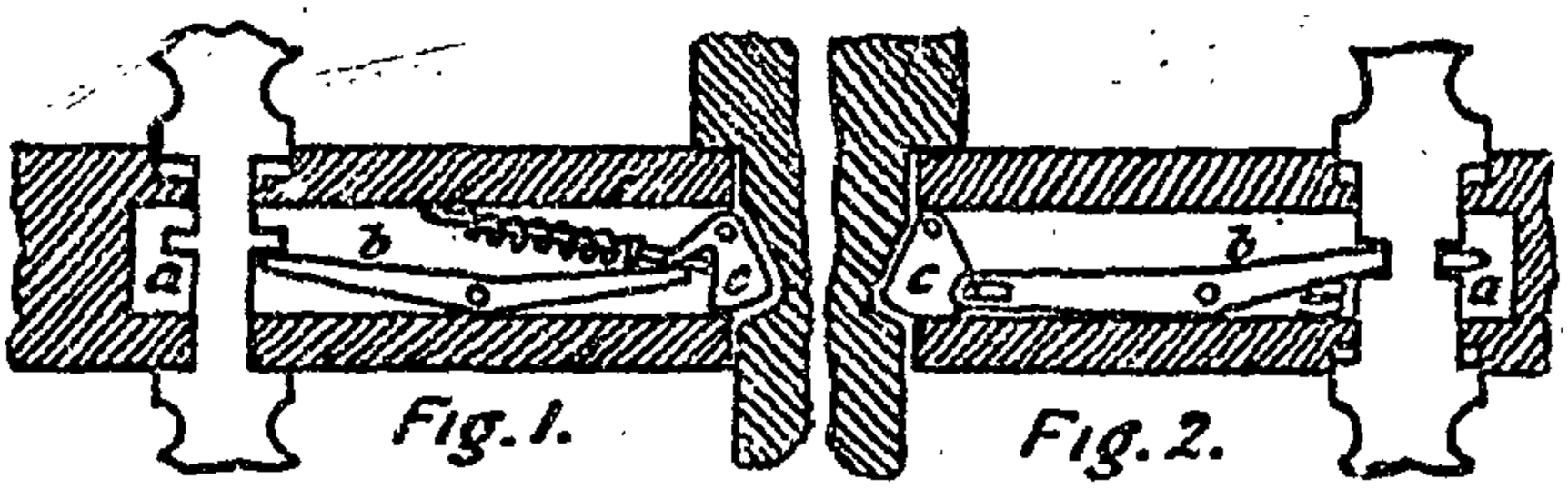


Fig. 1. Fig. 2.

actuated the bolt *c*, and a spring kept the bolt in place (Fig. 1).—In anticipation, a patent was produced of Imray (Fig. 2). The only difference was that a notch *a* was substituted for the collar, and the position of the spring was different. It was argued for the plaintiff that there was no anticipation, because the notch in Imray's lock was not equivalent to the collar in Kaye's lock, and for this reason, that if you tried to shut the door

Cases of sufficient ingenuity to support the patent.

with Kaye's bolt, the collar receded and left the bolt free to slam into the catch plate. But if you tried to shut the door with Imray's latch, the act of pressing the handle from the inside, or pulling from the outside, only jammed the bolt fast, and prevented it from shutting properly. This could be cured either by making the groove *a* very much wider, or else substituting a collar. In his specification, Imray had used the words, "With a groove in it, or with a projection or collar on it, which engages with a lever connected with the spring bolt." At the trial, Matthew, J., considered that what was here meant was only a collar *equivalent* to the groove, *i.e.* a collar on both sides of which the lever should engage. The Court of Appeal thought he meant to point out the mechanical alternative, and that he had contemplated the plan of the plaintiff. But, on appeal to the House of Lords, they thought that, in using the alternative words "projection or collar," the same sort of engagement must have been meant, as was meant when a lever or groove were used, viz., a double engagement, and hence that the plaintiff's invention was an advance on Imray's, and the subject of a patent. Inasmuch as the defendant's lock was just like that of the plaintiff, except only that he pressed the bolt *a* with a V-spring, instead of a spiral spring, the Court held the infringement proved, and gave judgment for the plaintiff.

Siddel v. *Vickers*, 1888, 5 R. P. C. 81, 416, 7 R. P. C. 292.—Endless chains worked by cog-wheels, or winches, or by hooks, to turn forgings about, were known, but were not portable, and had never been much used. Plaintiff patented an endless chain, worked by a portable cog-wheel and hand-ratchet, for the same object. Held, that this machine was a new combination. Patent supported.

CHAP III. SECT. 6.

Cases of sufficient ingenuity to support the patent.

Ehrlich v. *Ihlee*, 1888, 5 R. P. C. 437, 7 R. P. C. 292.—Plaintiff's patent was for a circular disc of card with holes in it, by means of which levers were actuated, which played a small organette. Prior to this, bands of cards had been used for the same object, very like the arrangements in a Jacquard loom. Circular cards had been suggested for the Jacquard loom. Circular cards with holes in them had been used in organettes, not to actuate levers, but to be blown through, *i.e.*, to open and stop pipes. Circular cards had also been proposed by Peabody with "dents" in them to actuate levers for an organ, but the specification was not in England at time of plaintiff's patent, and besides, was so badly drawn as to be unintelligible. The plaintiff's machine was admitted to be a great commercial success. Held a good patent.

Haslam v. *Hall*, 1888, 5 R. P. C. 1.—The principle of the machine of the plaintiffs depended on the fact that if air is compressed, it becomes heated. Suppose that while still compressed, it is allowed to cool, and thus to dissipate the heat. Then let the pressure be removed. If the air were inelastic, it would remain compressed, but being elastic it again expands. In expanding it must become cooler by the amount of the heat it lost during the time it was allowed to cool. In this cool state, it is ready to absorb from surrounding bodies heat sufficient to restore it to the same temperature as at first, before the pressure was applied. Thus then we can construct a "heat dissipating and absorbing machine," and by putting substances near it, we can heat some of them, and cool others. This is the principle of mechanical refrigerators largely used for preserving meat during its voyage from the colonies. But if meat is shut up in refrigerators, it

Cases of sufficient ingenuity to support the patent.

gives up moisture, and if air which is being cooled contains moisture, that moisture is deposited as ice, hoar-frost, or snow, which is apt to clog the pipes and machinery. This difficulty the plaintiff by his patent sought to remove. He passed the air over the meat, and then over pipes which cooled it, and then arranged his pipes in which the cooling took place at such inclinations and with such cocks, that the moisture which had come from the meat could be drawn off as soon as it had got into the liquid form of water, and before it reached the solid stage of ice or snow. It was like wiping the meat with a cold towel, and then drying the towel again. Evidence was given of prior machines by Windhaussen and Nerlich, which also had cocks, but it was not satisfactorily shewn that these cocks were more than experiments, or that they were deliberately made and used for the same purpose as the cocks of the plaintiff. It was objected that if once it were known that condensed moisture was likely to freeze and block the machine, it was no invention simply to incline the pipes to let the condensed moisture drain away, and to put a cock to draw it off. But it being proved that the plaintiff's use of cocks had resulted in a great commercial success by the obviation of a previously felt difficulty, it was held that, though a simple invention, it had merit, and could sustain a patent. "The effect of a great deal of the examination appears to us to be this: that the inventor of the (plaintiff's) machine did make a step forward in the process of invention, of the highest practical importance, although previous inventions had led up to it in such a manner, that now that the thing is done, it seems as if any one might have done it, by the use of a little power of invention. This, however, is, I believe, practically speaking, the history of a very large number,

Cases of sufficient ingenuity to support the patent.

perhaps of the great majority, of useful discoveries" (per Stephen, C.J.). Judgment was given against the plaintiff, however, as one of his claims was old. This was afterwards cured by disclaimer.

Dowling v. *Billington*, 1889 (Ireland), 7 R. P. C. 191.—A patent for a new method of weaving wire mattresses. It was shewn that they could be woven on well-known machines, but the patent described a new and improved arrangement of the warp and weft. It was argued that, as the machines were old, those who possessed them could weave what they liked upon them; but patent supported, as a new way of using an old machine.

Badische Anilin Fabrik v. *Dawson*, 1889, 6 R. P. C. 387.—Plaintiffs' patent was for a new chemical substance produced by the use of an additional quantity of sulphuric acid in one of the stages of manufacture of an old substance, *viz.*, dinitro-naphthol. Such additional use produced a totally new substance. Held good.

American Braided Wire Co. v. *Thomson*, 1889, 4 R. P. C. 316; 5 R. P. C. 113, 375, 696; 6 R. P. C. 518; 7 R. P. C. 47, 152.—This patent (1885) was for making ladies' bustles out of braided wire. The wire was first woven into long cylinders. Several lengths being taken, their ends were squeezed together, and then clamped without solder by inserting them into a V-shaped piece of metal, squeezing it tight, and doubling it over (Fig. 1). The V-shaped pieces of metal were then fastened to a waistband. In 1880 Jenkins had taken out a patent for braided wire, in which he proposed its application to all sorts of uses,

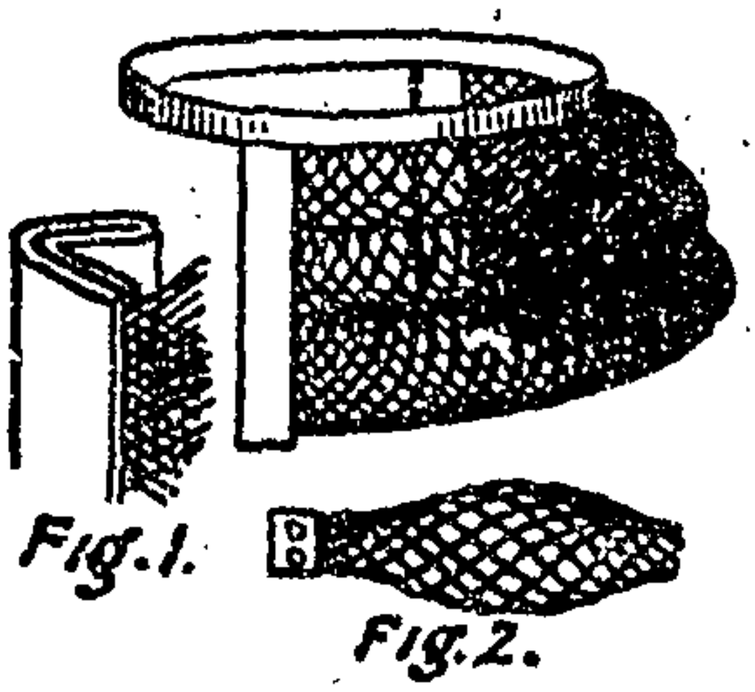


Fig. 1.

Fig. 2.

Cases of sufficient ingenuity to support the patent.

such as bell ropes, bird-cage perches, arms and legs of chairs, walking sticks, and also for stiffeners, for use in corsets, skirts or other articles of dress. He clamped the ends by means of V-shaped pieces of metal put on with rivets or solder (Fig. 2). The use of braided wire for cushions had also been patented in 1884. Kekewich, J., thought that the plaintiff's patent had been anticipated, but was reversed on appeal, and finally also in the House of Lords, Lords Watson, Herschell and McNaughten thought that the patent was valid for the particular combination described: Lords Halsbury and Fitzgerald dissented.

Lord Herschell said: "If I thought that the patentee had claimed the mere use of tubular sections of braided wire as a bustle, however fastened or secured, I should arrive at the conclusion that the defendants' contention was well founded. . . . In my opinion it is the combination alone for which protection is sought, and the method of fastening the ends by clamping-plates is an essential part of that which is claimed." This case was, however, considered on the margin, as appears from the remarks of Lord Watson in *Morgan* v. *Windover*, 1890, 7 R. P. C. 136 (*post*, p. 417).

Thomson v. *Batty*, 1889, 6 R. P. C. 84; *Thomson* v. *Moore*, 1889, 6 R. P. C. 426.—Sir W. Thomson, having applied himself to the study of the mariner's compass, arrived at the conclusion that what was required was an exceedingly light card to diminish friction, the weight disposed chiefly round the rim, to give a large moment of inertia, and very small magnets, so as to be less sensitive to local disturbances. He carried out these ideas by attaching the card rim by threads to the magnets, which were made very small. The result was a great practical

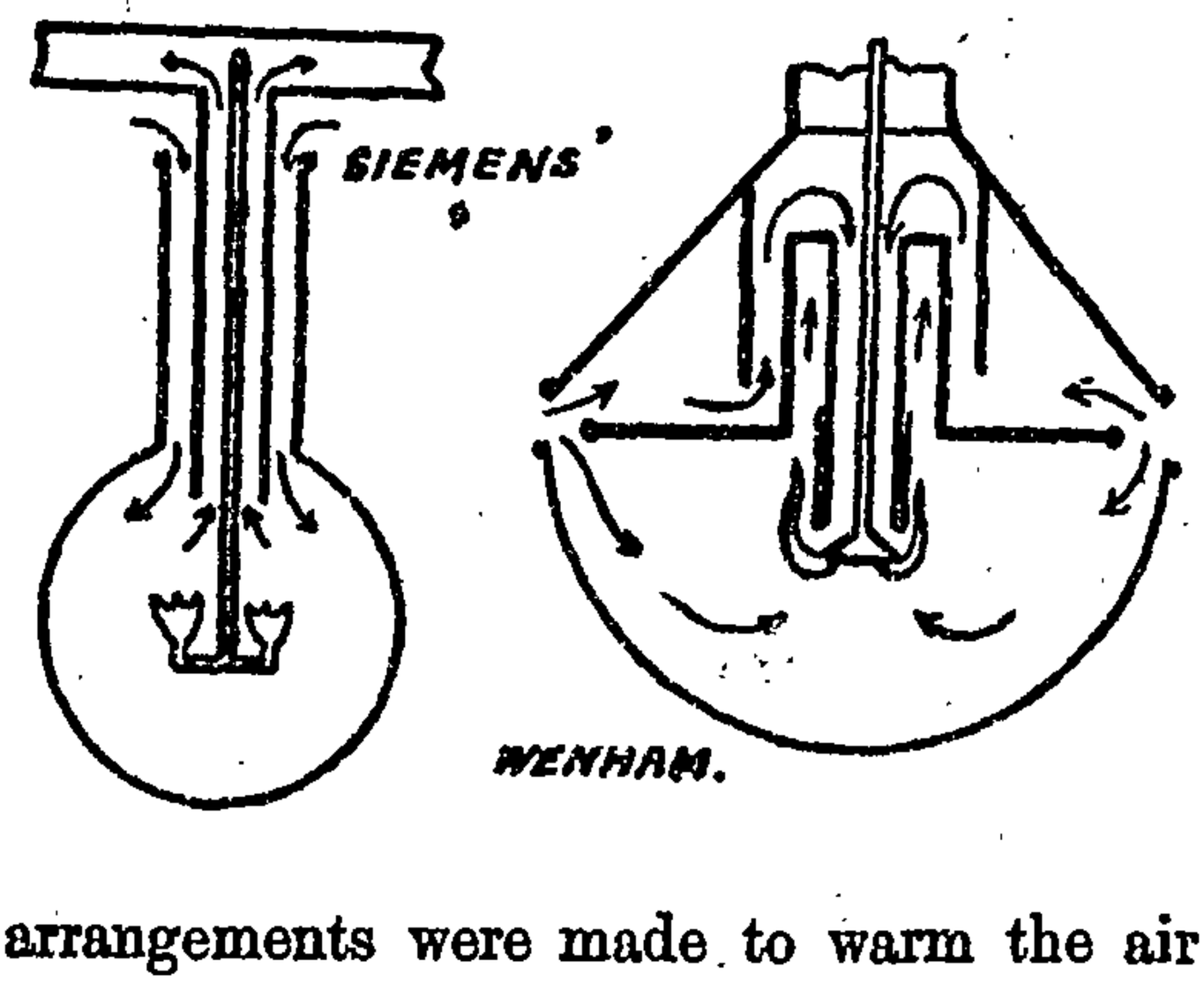
CHAP. III. SECT. 6.

Cases of sufficient ingenuity to support the patent.

success. Held, that though all the parts were old, yet the combination was clearly subject-matter for a patent.

Shaw v. *Jones*, 1889, 6 R. P. C. 328.—The plaintiff's specification contained no drawings, but stated the invention to be for "blocks of various sizes and geometrical squares, angles, curves, etc. So that by this means a compositor may construct a block poster, etc., in the same way as he would proceed to set up a combination border." The alleged anticipation was in a patent for somewhat the same thing, but with drawings shewing how blocks of a few different shapes could be used to build up various designs. The defendants complained of the vagueness of the plaintiff's specification, but proof being given that the plaintiff's patent was useful and that blocks could be made from the descriptions in it, the patent was supported.

Wenham Gas Co. v. *Champion Gas Co.*, 1891, 8 R. P. C. 313, 9 R. P. C. 49.—Siemens had invented a lamp in



which arrangements were made to warm the air before it was applied to the flame. The arrangement is shewn in the Figure. The hot air ascending warmed the gas-pipe. Wenham invented a form of lamp shewn in the

Cases of sufficient ingenuity to support the patent.

second figure. It was held that this was an advance on Siemens', and was consequently good subject-matter for a patent. In the Wenham lamp the entering current of air is divided into two portions, one of which circulates round the outer globe, the other is heated, and feeds the flame.

Farben Fabrik v. *Bowker*, 1891, 8 R. P. C. 389.—A new dye, obtained by putting in practice known chemical facts, held good.

Pirrie v. *York Street Flax Co.*, 1892, 10 R. P. C. 34.—Dry paper tubes had been used for winding cotton yarn upon, for spinning. A patent for similar tubes for use with wet flax yarn held good, on special advantages being shewn by their use for that purpose.

Miller v. *Scarle*, 1893, 10 R. P. C. 106.—This was an action brought upon two patents, one for a clip for securing lamps to velocipedes, the other for a more elaborate mode of attachment with the same object. The alleged anticipation of the first patent is so vague as to be hardly comprehensible. The second patent (Fig. 2), and its alleged anticipation (Fig. 1), are as follows: In Fig. 1 the lamp is suspended on four arms, giving a parallel motion, which is controlled by a spiral spring diagonally arranged. In Fig. 2 the arrangement is similar, except that the arms are braced together by cross pieces, and that linings of india-rubber are inserted into all the joints and axes to minimise vibration. The patent (Fig. 2), was found to display invention enough to support a patent.

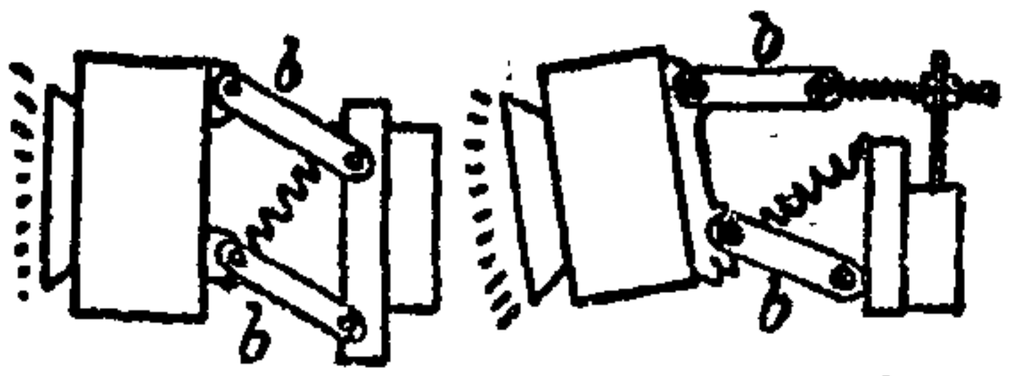


Fig. 1.

Fig. 2.

CHAP. III. SECT. 7.

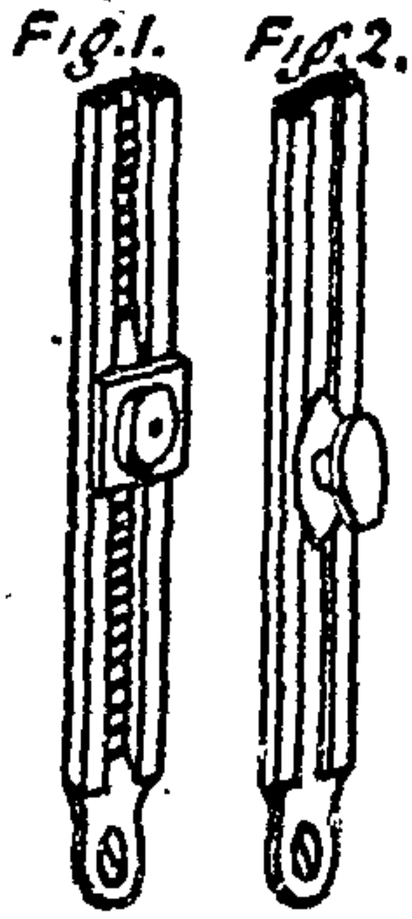
Cases of insufficient ingenuity to support the patent.

7. Examples of patents held bad for want of ingenuity.—*Brunton* v. *Hawkes*, 1821, 4 B. & Ald. 541, 1 C. P. C. 405.—Patent for making anchor flukes in one piece with shank rivetted on, instead of in two pieces welded on to shank, held bad, because mushroom anchors and kege anchors had been similarly made.

Cook v. *Hague*, 1838, *ante*, p. 26.

Kay v. *Marshall*, 1841, 2 W. P. C. 34.—Plaintiff had patented (*inter alia*) the placing of rollers for spinning flax, hemp, and other fibrous substances, "nearer together than they had previously been placed, say within 2½ inches of each other." This was to prevent the fibres from breaking after they had been macerated in water (which process was not new). Previously, flax rollers had been put 15–20 inches apart, cotton rollers 1⅛ inch apart, and, in fact, the distance had been regulated to suit its fibre. Patent held bad.

R. v. *Cutler*, 1847, M. P. C. 124.—The mere application of a known article to an analogous use is not patentable. Iron tubes for boilers were old; brass-coated iron tubes were old; a patent for using brass-coated iron tubes for boilers held bad.



Dobbs v. *Penn*, 1849, 3 Ex. 427.—Patent for a pulley for window blinds (Fig. 2), which differed only from a previous invention (Fig. 1) by the omission of an ornamental escutcheon, and the use of a screw instead of a rack.

Bush v. *Fox*, 1852, M. P. C. 166, 178, 23 L. J. Ex. 257, 25 L. J. Ex. 251, 5 H. L. C. 707.—Caissons for excavating earth under water. The caisson was shaped like a diving-bell, so as to keep out the water, and sank into the earth as the excavation

proceeded. Exactly similar means had been used for excavating in mines on land, the caissons also serving in this case to keep the water from coming in. "If a man were to take out a patent for a telescope to be used for making observations on land, I do not think anyone could say, 'I will take out another patent for that telescope, to be used for making observations on the sea'" (*per* Pollock, C.B.). Patent held bad.

Brook v. *Aston*, 1857, 8 E. & B. 478, 27 L. J. Q. B. 145, 28 L. J. Q. B. 175.—A patent had been granted for strengthening and polishing linen and cotton yarns by means of friction brushes. Another patent could not be obtained for applying the same process to yarns of wool or hair, or to fabrics made of cotton, linen, silk, wool, or hair.

Patent Bottle Envelope Co. v. *Seymer*, 1858, 5 C. B. (N.S.) 164, 28 L. J. C. P. 22.—Plaintiffs patented and claimed a peculiar method of making bottle envelopes upon a bottle-shaped mould. Defendants used a different method of making envelopes upon a bottle-shaped mould. Held (1), that there was no infringement, and (2) that the mere use of a bottle-shaped mould could be no invention, for moulds were well known for giving shape to pliable materials.

Ralston v. *Smith*, 1860. (See this case at Chap. III., sect. 3.) Compare with *Dowling* v. *Billington*.

ante, p. 88.

ante, p. 114.

Harwood v. *G. N. Rail. Co.*, 1860, 2 B. & S. 194, 222, 11 H. L. C. 654, 29 L. J. Q. B. 193, 31 L. J. Q. B. 198, 35 L. J Q. B. 27.—Fishplates of iron, grooved so that a square-headed bolt, put through a hole in them, would not turn round, so that the nut on the bolt could be



CHAP. III. SECT. 7.

Cases of insufficient ingenuity to support the patent.

screwed up tight, had been used in timber construction. Held, no invention to apply them for uniting railway rails. "You cannot have a patent for a well-known mechanical contrivance, merely because it is applied in a manner, or to a purpose, which is analogous to the manner, or to the purpose, in or to which it has been hitherto notoriously used."

Hyde v. *Trent*, 45 Newton's Lond. Journal, 135.—Where crushing-rollers had been used for hemp fibre, no patent could be had for using them for cocoanut fibre.

Calvert v. *Ashburn*, 7 Prac. Mech. Journal, 2nd Series, p. 97.—Caustic alkali had been used to dissolve gluten to make starch. Held, no patent to use the same means to make size.

Compare Ormson v. *Clarke, infra.*

Horton v. *Mabon*, 1862, 16 C. B. (N.S.) 141, 31 L. J. C. P. 255.—Troughs round the joints of telescopic gas-holders had previously been made of two pieces of iron, L-shaped in section, riveted together. A patent for making the troughs of one piece of U-shaped iron (U-shaped iron being known before) held bad for want of invention.

Mackelcan v. *Rennie*, 1862, 13 C. B. (N.S.) 52.—It was queried whether the use of a new material, such as iron, in floating docks, where wood had been used before, was patentable, but not decided.

Thompson v. *James*, 1863, 32 Beav. 570.—The substitution of steel for whalebone in petticoat hoops held insufficient.

Willis v. *Davison*, 1863, 1 N. R. 234.—The application of an old compensating valve to an old pneumatic lever for organs held bad for want of invention.

See Newsum v. *Mann, post*, p. 47, *and Horton* v. *Mabon, supra.*

Ormson v. *Clarke*, 1862, 32 L. J. C. P. 8, 291, 13 C. B. (N.S.) 337, 14 C. B. (N.S.) 475.—It had been usual to cast hot-water tubes for conservatories in separate

Cases of insufficient ingenuity to support the patent.

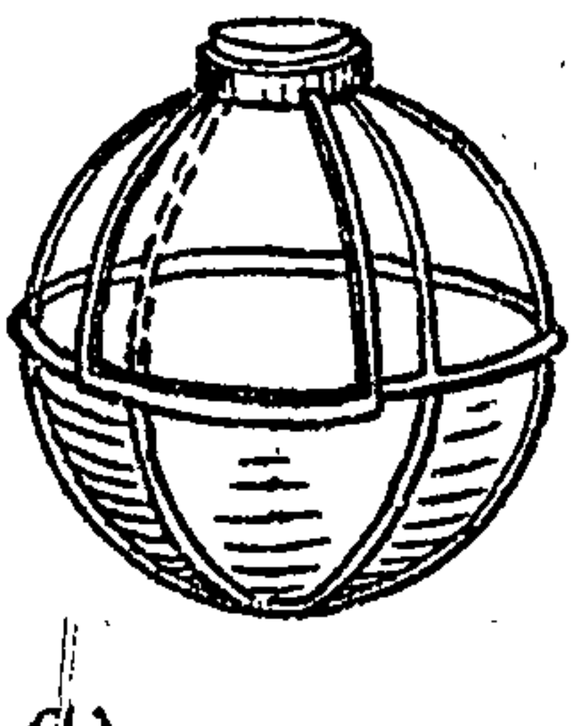
lengths, and then to place them parallel in groups with their ends cemented into rings made with sockets to receive them, so as to unite them all together. A patent for casting them, rings and all, in one piece, described how to do it, and then claimed, not any special mode of casting, but the doing it in one piece. Held bad for want of invention.

Jordan v. *Moore*, 1866, L. R. 1 C. P. 624, 35 L. J. C. P. 268.—Iron plates on iron frames for ships were old; so also was wood planking on wooden frames. Held, no invention to use wooden planking on an iron frame (*Harwood* v. *G. N. R. C.* followed).

Compare with Crane v. *Price*, *ante*, p. 57.

White v. *Toms*, 1867, 37 L. J. Ch. 204, 17 L. T. (N.S.) 348.—There is no invention in covering the falls of mourning hats or bonnets on the inside with similar pleats to those which before were used on the outside, so that when turned back the appearance of the fall is improved.

Parkes v. *Stevens*, 1869, L. R. 5 Ch. 3, 6.—Sliding doors had been used for cylindrical lamps. Held, no novelty to apply them to spherical lamps.



Rushton v. *Crawley*, 1870, L. R. 10 Eq. 532.—Wool had been used for making chignons. Plaintiff claimed wool, particularly Russian wool, for that purpose. Held, an absurd claim. *Crane* v. *Price* doubted (*per* Malins, V.-C.).

Saxby v. *Gloucester Waggon Co.*, 1881, L. R. 7 Q. B. D. 305, 50 L. J. Q. B. 577.—A patentee had, by two patents of 1870 and 1871, made improvements in interlocking railway signals. In 1874 he patented a combination of the parts contained in the other two patents,

CHAP. III. SECT. 7.

Cases of insufficient ingenuity to support the patent.

which, however, effected no results which were new. After an examination of the invention, the Court held that the combination patent of 1874 was such as "any person of ordinary knowledge would be able to effect, without further experiment, by placing the inventions of 1870 and 1871 side by side." Patent held bad.

Eades v. *Starbruck Waggon Co.*, 1881, W. N. 160.—A tramcar pivotted on its frame was old. Plaintiff's patent was for the same thing, with the difference, that the car was longer, and that the frame had two segmental arcs for better support. Held bad.

Croysdale v. *Fisher*, 1884, 1 R. P. C. 17.—A machine had been invented by Forest for treating nitrogenous refuse with sulphuric acid heated by gas, air, or by a furnace, to produce a manure. Plaintiff's patent was for a similar machine to do this by means of steam, so as to produce the manure in a dry powder, according to a method described by him. Manure made into powder from the manure made according to the first patent was known. Held, that the mere substitution of steam heating for other modes of heating would not support a patent, though had the result, *viz.*, manure *in powder*, been new; the patent might have been good.

Jensen v. *Smith*, 1885, 2 R. P. C. 249.—The substitution of a screwed cap working in a thread cut in the inner or outer surface of an oil box (Fig. 1), and substituted for a previously-known piston in the box driven forwards by a screw working in a collar (Fig. 2), held not sufficient for a patent.

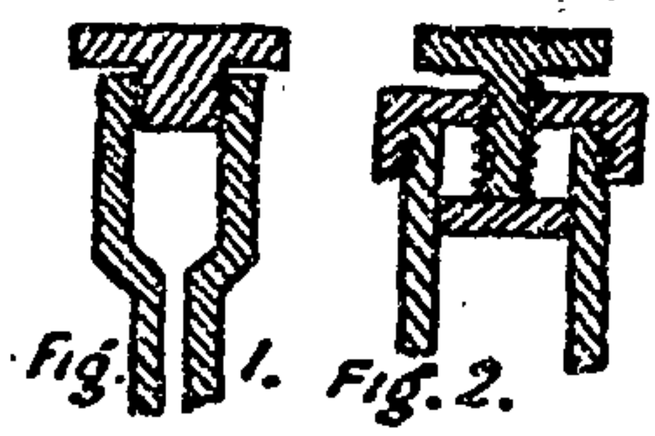


Fig. 1. Fig. 2.

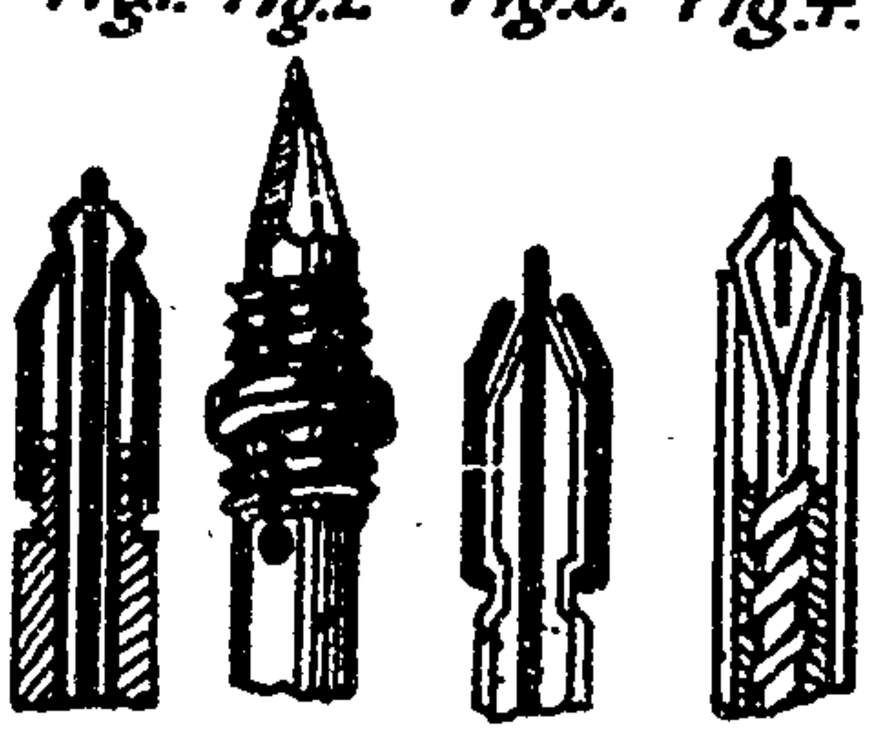
Philpot v. *Hanbury*, 1885, 2 R. P. C. 33.—A patent for a dressmaker's measuring machine held anticipated.

Cases of insufficient ingenuity to support the patent.

(The construction of the various instruments is somewhat complicated.)

Jackson v. *Needle*, 1885, 2 R. P. C. 192.—Two boxes, one inside the other, with packing between them, for sending by parcels post, held no invention.

Lawrence v. *Perry*, 1885, 2 R. P. C. 183.—This patent was for a pencil, in which the lead was secured as shewn in Fig. 1. by unscrewing the cap, so that it squeezed together the claws. As anticipations, Fig. 2 was put forward, being an invention of J. D. Harding, the well-known artist. And also Fig. 3, which attained the same result, by simply pushing back a cap. Fig. 4, for an adapting key for watches was also adduced as an anticipation. Indeed the general features of the plan are very old, having been used for jewellers' vices, and by optical instrument makers for years. The patent was held to have been anticipated.



Moss v. *Malings*, 1886, 3 R. P. C. 378.—The alteration in the shape of a tennis-bat handle with a groove on each side and a lump at the end, so as to resemble a shin-bone, was considered good, "though somewhat slight matter for a patent." But in a second action brought by the patentee, the Court of Appeal pronounced the patent bad: *Slazenger* v. *Feltham*, 1889, 6 R. P. C. 232.

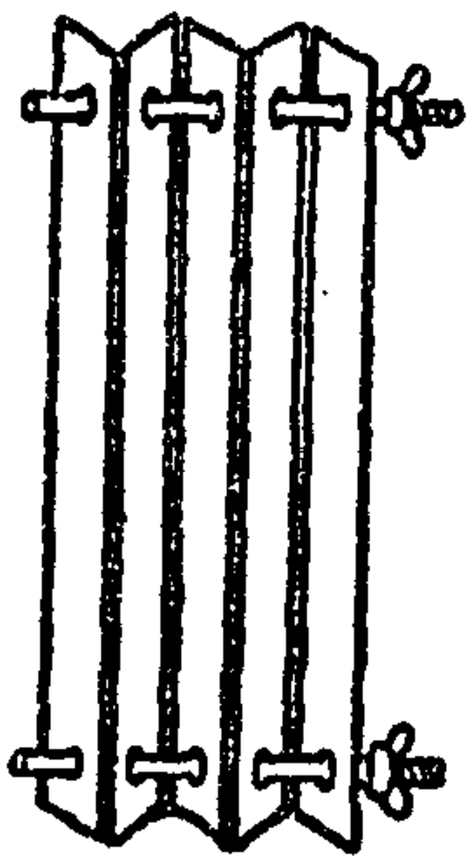
Sharp v. *Brauer*, 1886, 3 R. P. C. 196.—Plaintiff took out a patent for strips of paper or metal joined at the edges so as to make folding screens for windows. Such screens had been previously used for fireplaces. "A luminous idea occurred to him that this old-fashioned

CHAP. III. SECT. 7.

Cases of insufficient ingenuity to support the patent.

ante, p. 109.

thing, which everybody might have used whenever he liked, and wherever he liked, would be very handy for a window. . . . It is the very essence of a patent that it must contain an invention. That has been carried very far in the ensilage case (*Reynolds* v. *Amos*, 1886, 3 R. P. C. 215). The ground upon which I decided that case was that there was a clear invention . . . . Here nothing is invented" *per* Bacon, V.-C.).



Albo-Carbon Light Co. v. *Kidd*, 1887, 4 R. P. C. 535.—Liquid naphthaline had been used for enriching gas by supplying it with carbon in a state of vapour. Held, that a patent for using solid naphthaline (a well-known form of naphthaline) for the same purpose was bad for want of invention.

Rowcliffe v. *Morris*, 1886, 3 R. P. C. 17; *Rowcliffe* v. *Longford Wire Co.*, 1887, 4 R. P. C. 281.—In old four-post bedsteads it was usual to attach one end of the sacking on which the mattress rested to one end of the bed-frame; the other end of the sacking was fastened to a cross-piece of wood, the ends of which slid in grooves on the inner faces of the bed-frame. This piece of wood was then drawn towards the other end of the bed-frame by screws and nuts, so as to stretch the sacking tight. After the invention of wire-wove mattresses or webs the plaintiff patented a similar method of attaching them to frames without legs, with this difference, that his cross-pieces slid on the surface of the frame instead of in grooves in it; this enabled the web to be wider than before. Held to display no invention.

Humpherson v. *Syer*, 1887, 4 R. P. C. 184, 407.—In

1881, Winn invented a form of waste preventer for W.C.'s shewn in Fig. 1. When the cap, A, is raised by the lever, B, the water enters the syphon and flushes down the pipe, P. But when the cistern re-fills, the pressure of air in the cap, A, prevents the water entering the mouth of the syphon till the cover, A, is raised again. In January, 1885, Syer invented a modification of this by substituting for Winn's cap and syphon, a double cap (Fig. 2). The action is scientifically exactly the same, only the syphon is formed by the cap itself. Fearing that this similarity would invalidate his patent, he con-

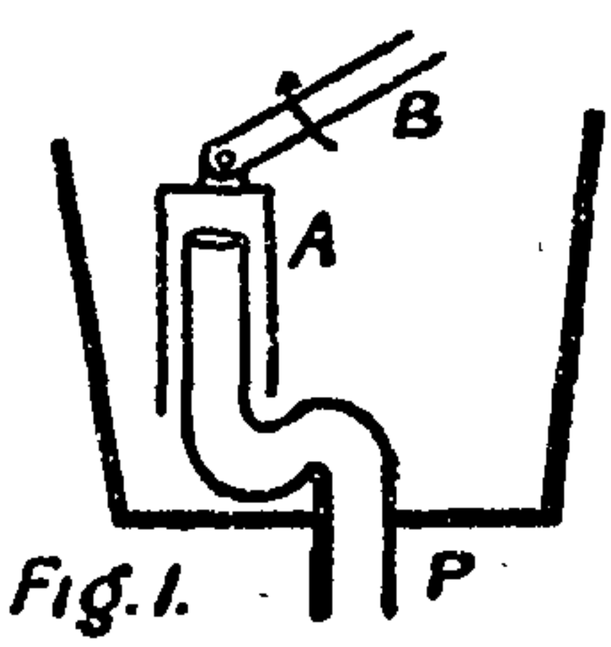


Fig. 1.

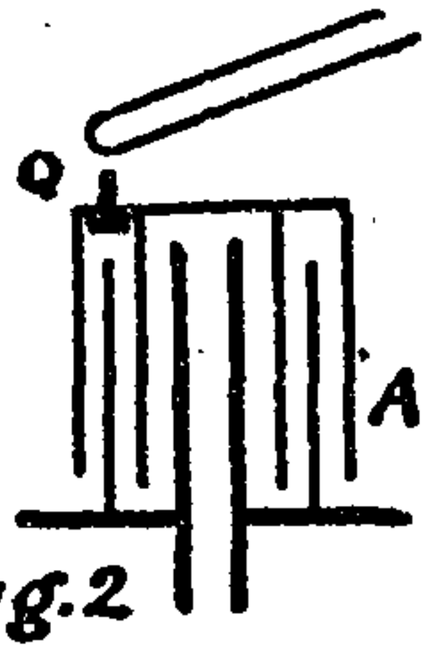


Fig. 2

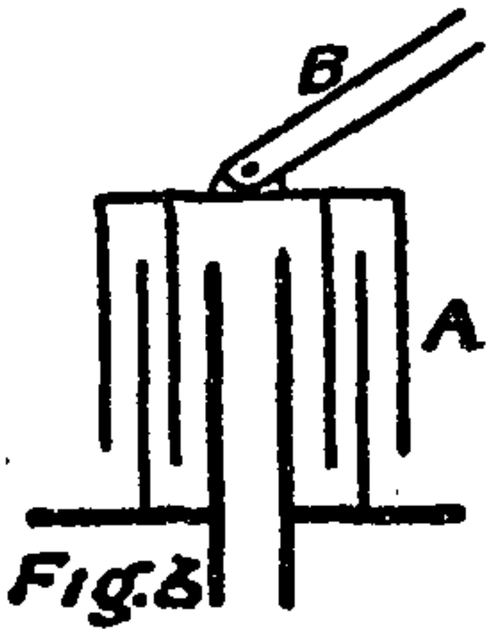


Fig. 3

trived another mode of working his machine, by placing in it an air valve, Q, actuated by a lever, or else by a simple button, to let out the compressed air which the rise of the water in filling the cistern had forced into the cap. This had just the same effect as raising the cap. He also caused a workman to make a preventer on his system adapted to work by raising the cap. In February, 1885, Humpherson patented Fig. 3, which really was the same as Syers', only that the cap was raised by a lever instead of an air valve being actuated by the lever. He thus did exactly what Syer had been afraid to do. Syer then made a waste preventer resembling Humpherson's, who brought an action. Held, that Winn's was not an anticipation of Humpherson's; that on the true in-

CHAP. III. SECT. 7.

Cases of insufficient ingenuity to support the patent.

terpretation of Syer's patent he only claimed a stationary cap and air valve, and hence these two were not an anticipation of Humpherson, who obtained a judgment, which was reversed on appeal, on the ground that the model made by Syer had been published, and that, taking Winn's and Syer's patents together, the plaintiffs presented no sufficient feature of novelty: for it was only to apply Winn's method of lifting to Syer's cap.

Oddy v. *Smith*, 1888, 5 R. P. C. 503.—Patent for holding down leather (on to places to which it was to be cemented) by spiked bars while the cement was drying. Held, no subject-matter.

Longbottom v. *Shaw*, 1888, 5 R. P. C. 497, 6 R. P. C. 143, 8 R. P. C. 333.—Separate hooks fastened to frames or reels had been used for holding fabrics. A patent for making rows of hooks by stamping or casting them in one piece, and then fastening it on, held bad for want of invention.

Tickelpenny v. *Army and Navy Society*, 1888, 5 R. P. C. 405.—Hollow columns were old, and when filled with water had, at least partially, supported a floor on which tanks rested. Held, no invention simply to apply them in the support of fire-proof floors, for the former user would be an infringement of the patent.

Fletcher v. *Arden*, 1888, 5 R. P. C. 46.—A patent was taken out for a contrivance for grilling and boiling over gas flames. The grill was hinged or pivotted so that it could be pushed out of the way when not wanted. The specification had originally claimed a sliding grill, but this was disclaimed. A previous invention had caused the grill to *slide* out of the way. Held, that the idea of hinging or pivotting the grill instead of making it slide

Cases of insufficient ingenuity to support the patent.

was not the subject-matter of a patent, as it was the mere substitution of a known mechanical equivalent.

Cole v. *Saqui*, 1888, 5 R. P. C. 489; 6 R. P. C. 41.—An upright with a flexible arm was fitted to a stand, and from it was hung a figure whose toes touched a top spinning on a china plate fixed to the stand. When the top was spun the figure was made to dance. It was proved that one Dean had registered a similar machine, in which the top was not freely spun in a plate, but rotated in a fixed bearing. Patent held bad.



Britain v. *Hirsch*, 1888, 5 R. P. C. 74, 226.—A top dressed like a dancing doll contained a gyroscope (Fig. 1), which was caused to spin by means of a coiled spring in a separate stand released by a detent (Fig. 2). A coiled spring with a detent in a box had been previously used for spinning tops. Held, no invention to apply it to that particular sort of top.

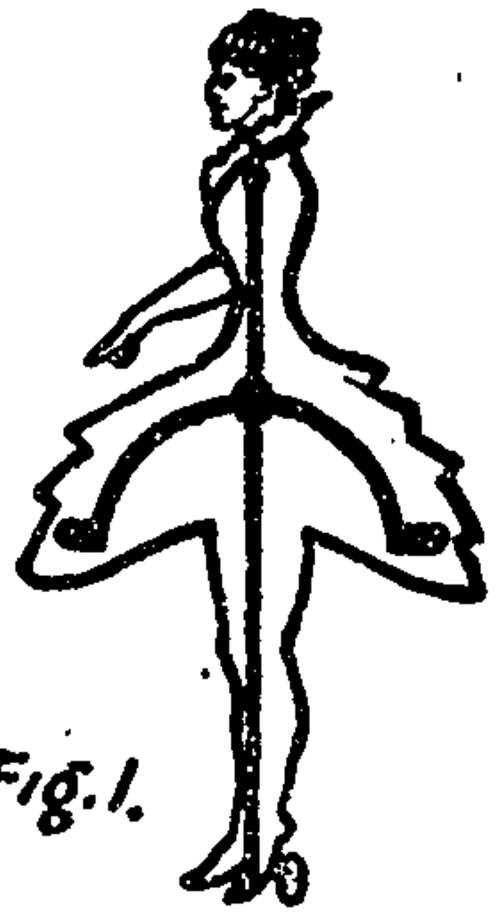
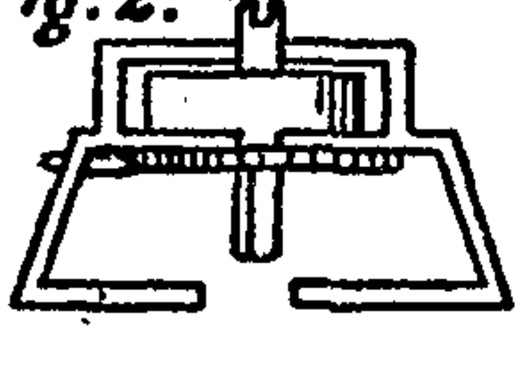


Fig. 1.

Fig. 2.



In re Goulard and Gibbs, 1888, 5 R. P. C. 536.—Petition for revocation. Goulard and Gibbs took out a patent, which, as amended, did not claim any special form of instrument, but claimed generally the sending a high-tension alternating current of electricity through the primary circuits of a number of induction coils, each of which had a secondary coil from which a current of different tension was drawn

CHAP. III. SECT. 7.

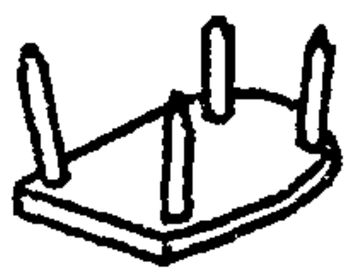
Cases of insufficient ingenuity to support the patent.

for lighting or power. Induction coils were old, and had been used before for electric lighting. The patent did not say that the instrument was to be so arranged that the current drawn off the secondary coils for use was to be lower than the current supplied to the primary coils; on the contrary, the arrangement was such that the tension could be raised according to the desire of the consumer. It was known that such coils could be used either to raise or lower the tension of alternating currents, though in general such coils had previously been used to raise it. Held, that the patent could not be supported. (Before this case is quoted, it requires careful attention, because it seems that if the patent had been more carefully restricted, it could have been made to hold.)

See Fletcher v. Arden, ante, p. 126.

United Horseshoe Co. v. *Swedish Horse Nail Co.*, 1888, 6 R. P. C. 1.—Substitution of a pivot for a hinge in nail-making machine held bad.

Blakey v. *Latham*, 1889, 6 R. P. C. 29, 184.—Clinkers, *i.e.*, double-pronged nails, had been used in the toes of boots, and plates of iron had also been nailed on. Held, that a patent for pieces of iron cast in one piece with a number of spikes upon them, to be driven on to the soles and heels of boots, displayed no inventive power in spite of evidence of large user.



Longbottom v. Shaw, ante, p. 126.

Griffin v. *Feaver*, 1889, 6 R. P. C. 396.—The plaintiff's patent was for a preserved meat tin box, which could be opened by putting a lever under the edge of the lid, and raising it (Fig. 1). It had been anticipated by



Fig. 1.



Fig. 2.

Fig. 2 in which, however, a subsidiary thin cover was added, to be cut away as soon as the cover was removed. The patent was declared bad.

Herrburger v. *Squire*, 1889, 6 R. P. C. 194.—The mere alteration in the position of the lever in a piano-string damper is not the subject of a patent. (It is, however, to be noted here, that evidence was given that the very same alteration had been shewn on a previously-published drawing, so that the patent was bad for anticipation as well as want of invention.)

post, p. 158.

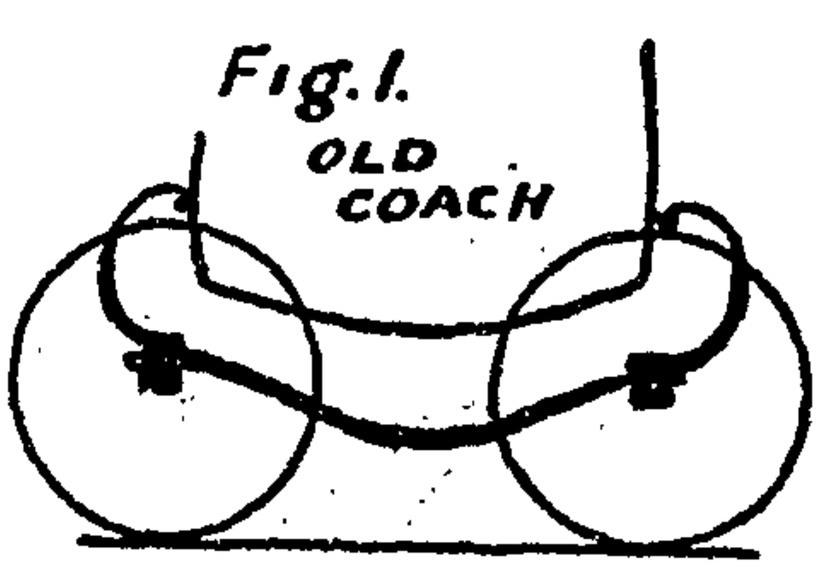
Williams v. *Nye*, 1890, 7 R. P. C. 62.—Plaintiff patented a sausage-making machine consisting of cutters revolved by a shaft, and on the same prolonged shaft, a series of propeller blades for forcing the minced meat into the skins after the mincing had been finished. Prior to this, a propeller had been combined with the cutters by Gilbert and Nye, and a new form of cutter, of shape like the plaintiff's, had been invented by Donald. Plaintiff had, therefore, only put Donald's cutter on to Gilbert and Nye's machine. Held bad.

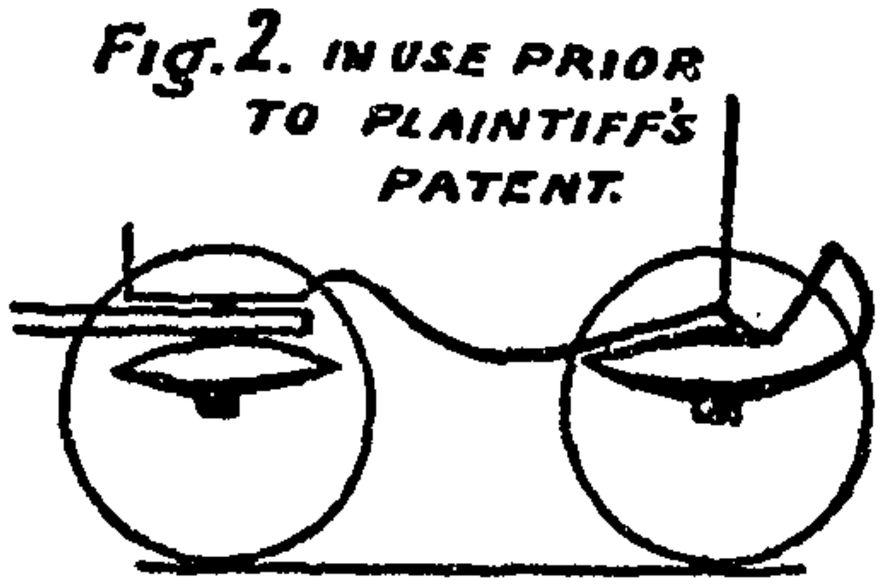
Morgan and Windover, 1888, 5 R. P. C. 296, 7 R. P. C. 131.—It was proved that prior to the plaintiff's patent the old form of coach had a body suspended from C-springs at front and back, but in order to make the carriage capable of turning, it was necessary to fix at least one of the pairs of wheels, preferably the front one, to a vertical pivot so that the axles could become inclined to one another instead of always remaining parallel. This necessitated the use of a perch or rigid framework whose front end was pivoted to the front axle. The back axle was rigidly fixed to the perch (Fig. 1). This plan was gradually superseded by "elliptic springs" consisting of two elliptic segments fastened together, as

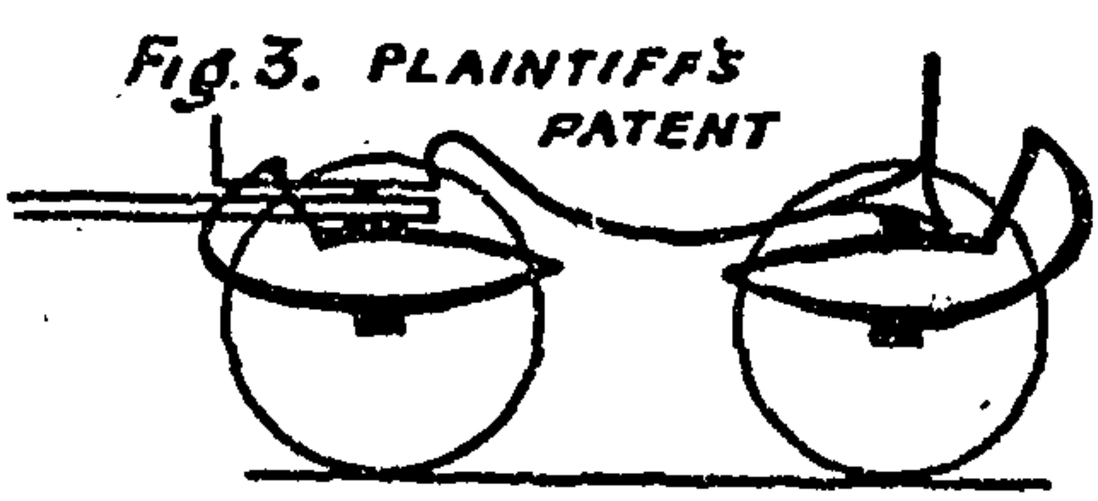
CHAP. III. SECT. 7.

Cases of insufficient ingenuity to support the patent.

now in use. But to make the motion more easy, a combination of the elliptic spring and the C-spring was used as shewn in Fig. 2. This combination was only fitted to the back axle perhaps because it was not readily seen how to adapt it to the front axle, which could not be rigidly attached to the carriage, but required to turn on a pivot. The plaintiff surmounted this difficulty (which, if it ever existed, was a very imaginary one) by simply







substituting for the front elliptic spring, a combined C and elliptic spring, such as had been used (Fig. 2) for the back of the carriage, and arranged it so that the upper end of it should be attached, not to the body of the coach, as in the case of the back spring, which would have prevented the pivoting action, but to the movable part to which the shafts were fastened. The question was whether this exhibited ingenuity: The Court below, and the Court of Appeal, thought it did, but the House of Lords decided that it did not.

Elias v. *Gravesend Tinplate Co.*, 1890, 7 R. P. C. 455.—Prior to the plaintiff's patent, one Morewood, had

invented a machine for dipping iron plates in grease to clean them before being tinned. They were removed from the grease by being lifted up a short way by a cradle till the ends were caught between vertical rollers, which raised them up out of the grease. All that the plaintiff did, was to double the length of the tank and of the rollers, so as to work two plates simultaneously. Patent held bad.

Leadbeater v. *Kitchin*, 1890, 7 R. P. C. 235.—A safety guard had been used to protect persons from injury by geared cogwheels in motion. No patent could be granted for the same contrivance for protecting them from belted pully wheels, for this would be merely the analogous use of an old contrivance.

Newsum v. *Mann*, 1890, 7 R. P. C. 307.—A patent which claimed making the parts of a printing machine in one casting, which had previously been made separate, held bad: (*Ormson* v. *Clarke* followed.) *ante*, p. 120.

Tucker v. *Kaye*, 1891, 8 R. P. C. 61.—Door locks had been made with a detent so as when the handle was turned, to catch and hold back the bolt, which remained back till the door was again shut, upon which a pin on the *face* of the door struck the jamb and released the detent, and the bolt shot home. A patent for a lock containing a bolt held back by a detent which was released by the pressure of the door-jamb against a pin on the *edge* of the door held bad.

Winby v. *Manchester Steam Tram Co.*, 1891, 8 R. P. C. 68.—In a patent for switches for tramway crossings, held, that the substitution of a spring for its mechanical equivalent, a weighted lever, was bad.

Nuttall v. *Hargreaves*, 1891, 8 R. P. C. 273.—A tap, which differed from previous ones only by having a

Cases of insufficient ingenuity to support the patent.

gauze strainer instead of a perforated metal strainer, held bad.

Embossed Metal Co. v. *Saupe*, 1891, 8 R. P. C. 355.—Embossing thick metal sheets between non-elastic dies was known; also the embossing of thick metal by tools upon pitch; also by engraved rollers pressing thin plates on indiarubber. Patent for embossing thick plates by stamping them from the reverse side on to a soft india-rubber pad held bad.

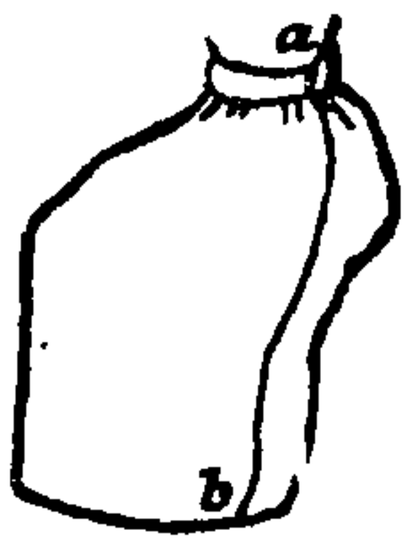
Fairfax v. *Lyons*, 1891, 8 R. P. C. 401.—A patent for improvements in moving targets held bad, because the mechanical means, which were complicated and varied were not materially different from similar means employed previously for a similar object.

Heyes v. *Hallmark*, 1891, 9 R. P. C. 27.—A patent for a window-sash weight which only differed in shape from others in previous use held bad.

Wilson v. *Union Oil Mills Co.*, 1892, 9 R. P. C. 57.—It is of course well-known that soap is made by mixing fat or oils with alkalis, such as soda to make hard soap, or potash to make soft soap. Cotton-seed oil is used for soap-making. Soap could also be made by adding soda to the fatty substance (called railway grease) which is left after the distillation of cotton-seed oils, but it is dark and has a bad smell. The plaintiff patented the use of chlorine or hypochlorite of soda boiled with it to bleach and deodorize it. Hypochlorite of soda was better than using chlorine gas, as the pure chlorine, not in the form of hypochlorite of soda, was apt to injure the fatty matter. But it was proved that hypochlorite of soda had been used before for bleaching other sorts of soap, and chlorine water had been used to bleach cotton-seed soap. The patent was therefore held to have been anticipated.

Baker v. *Kinnell*, 1892, 9 R. P. C. 441.—A joint had previously been used for hot-water coils. Held, no invention to apply it to boiler tubes in which the heat was applied outside the tube; that this was an application of an old thing to a merely analogous purpose.

Nicoll v. *Swears*, 1893, 10 R. P. C. 240.—The plaintiff's patent was for a riding skirt for ladies with a burstable seam on the left side, *a*, *b*, continued right up to, and including the waist. If the lady fell, and her skirt caught in the pommel, the seam burst, and she fell clear of the skirt which was left on the saddle.



Prior to this, Busvine had patented a burstable riding habit, with a large hole in it on the right hand side into which the pommel of the saddle projected. This would of course be certain to catch, in case of a fall. To prevent it, a slit was made downwards from the hole to the bottom of the skirt, and laced up with elastic which tore away in case of a fall, so that the skirt remained on the wearer. It was held that, having regard to the fact that burstable seams were old, the plaintiff's invention displayed no novelty.

8. Want of ingenuity in part of the subject matter of a patent will render the patent void.—This depends on the principle that part failure in the consideration recited in a Crown grant, renders the whole grant bad

See Chap. I., sect. 8. *ante*, p. 60.

CHAPTER IV.

THE EFFECT OF COMMERCIAL SUCCESS UPON A PATENT.

CHAP. IV. SECT. 1.

1. General Remarks.—In supporting a patent, it is of the utmost importance to try and shew that the subject of it was a commercial success, and that all similar inventions which have preceded it were failures. For commercial success goes far to prove utility by the best of all possible methods, namely, by actual use; it also is evidence of ingenuity, for if the thing was obvious, it would probably have been invented before; and it is also evidence of novelty, for its success when tried is evidence that if it had been known before it would have been put in practice. Hence, no form of argument in support of a patent is more effective than to shew that the invention was one which all the world had been looking for, and trying to get, that attempts had been made before but had failed; then came the patentee, who shewed how to do it, and made an immediate commercial success.

Compare ante, p. 20.

2. The effect of Commercial Success of an invention as evidence of its utility.—The effect of commercial success as evidence of utility is very considerable, specially when contrasted with the failure of previous efforts to attain a result: see the judgment of Bowen, L.J., in *The American Braided Wire Co.* v. *Thomson*, 1888, 5 R. P. C. 125—patent for bustles. With regard to

The effect of commercial success of an invention as evidence of its utility.

this case, Kekewich, J., said: "I conceive the following proposition to be established by that case, and by other cases in which similar questions have been discussed. If, within a short time of the manufacture and sale, an article of commerce commands a ready and extensive sale, that fact, which is proof of utility, must also be accepted as evidence, not conclusive, but cogent, of novelty": *Ehrlich* v. *Ihlee*, 1888, 5 R. P. C. 205. "When a man proves that in the course of I think rather less than two, or about two, years, he has sold 5,448 dozens of this new toy (dancing dolls). ... I think that is strong evidence of utility, and conclusive until it is contradicted" (Kekewich, J.): *Cole* v. *Saqui*, 1888, 5 R. P. C. 495; see also *Deutsche Nähmachinen Fabrik* v. *Pfaff*, 1890, 7 R. P. C. 16, 251. On the other hand, mere want of commercial success is not conclusive against the utility of an invention, "for possibly it might at once have been superseded by simpler constructions, involving the same principle" (*per* Lord Maclaren): *United Telephone Co.* v. *Maclean*, 1882, *Engineering* newspaper quoted with approval in *United Telephone Co.* v. *Bassano*, 1886, 3 R. P. C. 313, and followed in *Edison* v. *Holland*, 1889, 6 R. P. C. 283; and see *Otto* v. *Linford*, 1881, 46 L. T. (N.S.) 41; or again, the state of the arts and sciences might explain the non-user of the invention in spite of its utility: *Goulard* v. *Gibbs' Patent*, 1883, 5 R. P. C. 536. In truth, utility has really two meanings, and it is often difficult to see which of them is being used. There is utility in the sense that a machine will work well and efficiently, and there is utility in the sense that it is useful to and desired by the public. The latter must always be proof of the former, but it may well be that a most excellent machine which works well, may not, for

ante, p. 65.

CHAP. IV. SECT. 2.

The effect of commercial success of an invention as evidence of its utility.

some reason, be appreciated. The cases shew that it is the good working of the machine that is necessary to constitute utility, and that commercial success is only relevant as evidence of this.

It is, therefore, not needful that a patent should be commercially useful at the exact time it was patented, for "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 of the patent it could not be worked at a profit?" (*per* Lord Herschell): *Badische Anilin und Soda Fabrik* v. *Levinstein*, 1887, 4 R. P. C. 466, 12 App. Cas. 719, followed in *Siddell* v. *Vickers*, 1888, 5 R. P. C. 96; *Otto* v. *Linford*, 1882, 46 L. T. (N.S.) 41. (*Simpson* v. *Holliday*, 20 Newton's Lond. Journal (N.S.) 107, 120, must therefore, on this point, be considered as disapproved.)

ante, p. 67.

post, p. 337.

Under the heading Extension of Patents, Chap. XXV., sect. 13, many instances will be found in which the Privy Council allowed the apparent want of utility of an invention arising from its non-user, to be explained by such circumstances as public prejudice, strikes, want of money, and other similar difficulties.

3. Commercial success is also evidence of Novelty, that is to say, of absence of Anticipation, but is not so strong evidence of novelty as it is of utility: *Ehrlich* v. *Ihlee*, 1888, 5 R. P. C. 205.

4. Commercial success is also evidence of ingenuity.—"It is true that where there has been for some

Commercial success is also evidence of ingenuity.

time a long unsatisfied demand, and then suddenly an article springs into existence and satisfies it, the length of time during which the demand has remained uncomplied with, is matter from which it may be inferred that it is ingenuity alone which has enabled the inventor to surmount the obstacle that otherwise would seem, from the mere existence of the long unsatisfied demand, to have existed somewhere in some shape. But it may be that the demand is quite new, and that the novelty of the demand has produced immediately, and without any operation of ingenuity, an obvious article to satisfy it" (*per* Bowen, L.J.): *Gosnell* v. *Bishop*, 1888, 5 R. P. C. 158. In *Edison* v. *Holland*, 1889, 6 R. P. C. 283, Lindley, L.J., remarks: "If Swan's lamp had been a commercial success instead of a failure, it would, in my opinion, have been an anticipation of the plaintiff's patent": see also *Otto* v. *Linford*, 1882, 46 L. T. (N.S.), p. 41.

CHAPTER V.

ANTICIPATION.

CHAP. V. SECT. 1.

1. A patent will be bad, if prior public knowledge of the invention can be shewn.—For the consideration of a patent is, the introduction of some new art or manufacture. "If the public once becomes possessed of an invention, by any means whatever, no subsequent patent for it can be granted either to the first and true inventor himself, or to any other person; for the public cannot be deprived of the right to use the invention, and the patentee could not give any consideration to the public for the grant, the public already possessing everything that he could give": Hindmarch; cited with approval by Lord Blackburn in *Patterson* v. *Gas Light & Coke Co.*, 1877, L. R. 3 App. Cas. 239, 47 L. J. Ch. 402, and again by Bowen, L.J., in *Humpherson* v. *Syer*, 1857, 4 R. P. C. 414. There are three different ways by which an invention may become so public as not to be the subject of a patent, viz., (1) by prior public knowledge; (2) by prior user; or, (3) by prior publication.

All the inventions which are commonly found in books, encyclopædias and dictionaries, are part of the common heritage of knowledge, and in a patent case it is not necessary in shewing that those inventions are old to specify peculiar instances. For example, if a plaintiff sued on a patent for a lever, or screw, it would not be

A patent will be bad, if prior public knowledge of the invention can be shewn.

needful to rely on particular anticipations, general evidence of prior knowledge would be sufficient. Nor, of course, need such knowledge be general. It is enough that knowledge should be shewn on the part of those who usually practice the trade to which the invention relates. Thus, in *Plimpton* v. *Malcolmson*, L. R. 3 Ch. D. 556, Jessel, M.R., said: "When you say a thing is known to the public, and part of common knowledge, of course you do not mean that every member of the public knows it. That would be absurd. What is meant is, that if it is a manufacture connected with a particular trade, the people in the trade shall know something about it; if it is a thing connected with a chemical invention, people conversant with chemistry shall know something about it. And it need not go so far as that. If a sufficient number know it, or if the communication is such that a sufficient number may be presumed or assumed to know it, that will do. Now how are they to know it? They are to know it by being told of it, or informed of it in some way. You may shew that they know it by shewing that the trade had commonly used it. That is the best evidence you can have. You may shew the thing was known because it was used and brought into practice. . . . But you may shew that they knew it in another way, that it was published, or made known to the public."

The general law was laid down at length by Tindal, C.J., in *Cornish* v. *Keene*, 1835, 1 W. P. C. 508, and it is to be noted that in questions of prior public knowledge there is great difference between the practical public knowledge of manufacturers and the knowledge of learned persons in their studies. The latter will always have a far weaker effect on the validity of a patent than

CHAP. V. SECT. 1.

A patent will be bad, if prior public knowledge of the invention can be shewn.

the former: *Gibson* v. *Brand*, 1841, 1 W. P. C. 628; *Betts* v. *Menzies*, 10 H. L. C. 117; *Shaw* v. *Jones*, 1889, 6 R. P. C. 336; *Hills* v. *Evans*, 4 De G. F. & J. 288; *Edison* v. *Holland*, 1889, 6 R. P. C. 277; see further on this point, Prior Publication by Documents in General Chap. V., sect. 9 (*post*, p. 151).

2. Prior public user.—There is a second sort of prior publicity of an invention which will render a patent invalid, arising from prior user. Where such prior user is so general that the invention is commonly known, then it may be said to be part of the common stock of public knowledge, and comes within the cases discussed in the preceding chapter. But where the prior user is not such as indicates a common public knowledge, but has been confined to certain persons and places, several questions arise of some intricacy. For the prior user may be by the patentee, or by others; and again it may be secret or in public; and again it may be experimental or for manufacturing purposes. It is believed that all possible cases may be brought under one or other of the three following groups which will be treated in order.

(1.) Where prior public user is shewn of such a character as fully to reveal to the public the nature of the invention, the patent is void, whether such user be by the patentee or any one else.

(2.) Merely private and experimental user by the patentee or by others, will not avoid a subsequent patent.

(3.) Where the prior user is of such a character that though the results of the invention are made public, the art by which those results are obtained is not revealed, then it will depend whether the prior user has been by

Prior public user.

the patentee or by "others." If by the patentee, he can still have a valid patent. If the user has been by "others," the conditions of the Statute of Monopolies will have been broken, for the invention will not be one which "others" at the time of granting the letters patent did not use.

By public user is not meant user *by* the public, but user *in* public: *Croysdale* v. *Fisher*, 1884, 1 R. P. C. 17; *Elias* v. *Gravesend Tin-plate Co.*, 1890, 7 R. P. C. 466. Thus, in *Carpenter* v. *Smith*, 1842, 1 W. P. C. 539, 9 M. & W. 300, a lock having been for some years on a gate in a public place, a subsequent patent for it was invalidated. And where pavement had been laid in a covered portico of a private house, the user was still considered sufficiently public to avoid a patent for similar pavement: *Stead* v. *Williams*, 1844, 2 W. P. C. 136; *Stead* v. *Anderson*, 1846, 2 W. P. C. 149. In *Adamson's Patent*, 1856, 6 De G. M. & G. 420, 25 L. J. Ch. 456, an invention for machinery which had been used for building a pier in a place to which the public had access, was held not patentable.

One, Jackson, having publicly ridden a bicycle, called by the neighbours, "Jackson's threshing machine," was held to have anticipated by public user a patent for a similar machine: *Brereton* v. *Richardson*, 1884, 1 R. P. C. 163; see also *Lifeboat Co.* v. *Chambers*, 1891, 8 R. P. C. 418. Where five firms used an invention for making steel by means of carburet of manganese, held, a public user: *Heath* v. *Smith*, *Heath* v. *Unwin*, 1854, 2 W. P. C. 268. See also *Westley Richards* v. *Perkes*, 1893, 10 R. P. C. 193.

In *Podmore* v. *Wright*, 1888, 5 R. P. C. 380 (Umbrella-top Notches); *Badham* v. *Bird*, 1888, 5 R. P. C. 238

CHAP. V. SECT. 2.

Prior public user.

(Sewer Manholes); *Cheetham* v. *Oldham*, 1890, 7 R. P. C. 116; *Lister* v. *Norton*, 1886, 3 R. P. C. 210, prior public user was established. These cases do not contain any express enunciation of the principles, but are examples of the kind of evidence necessary to establish prior user.

But though prior public user will invalidate a patent for an invention, the mere public use of articles made according to the invention, but whose nature is not such that by looking at them an expert could tell how they were made, will not of itself invalidate a subsequent patent. Thus, in *Hancock* v. *Somervell*, 1851, 39 Newton's London Journal, 158, the patent was for vulcanising india-rubber goods by means of sulphur. The prior user which the defendant endeavoured to establish was the public sale in England of some goloshes made with sulphur in America. It was urged, and evidence was given that by the appearance of the articles and their smell an expert could tell that the india-rubber composing the goloshes had been made with sulphur. *Williams*, J., directed the jury that if they thought so, they should find for the defendant, but that if they thought not, then they should find for the plaintiff. This direction seems plainly in accordance with the principles of the Statute of Monopolies which was passed (*inter alia*) for the encouragement of those who should discover the secrets of the modes of manufacturing articles abroad, and reveal them to their own countrymen.

3. Prior private user of an experimental character will not invalidate a patent.—It is quite clear that prior user of an experimental character, and which has never been made public, will not invalidate a patent,

Prior private user of an experimental character will not invalidate a patent.

whether such user be by the patentee, or by others. Thus, where Dr. Hall discovered the achromatic telescope, but kept his experiments secret, a patent afterwards granted to Dollond was upheld (1776) cited 1 W. P. C. 43; and prior secret user by the patentee himself was held not to invalidate: *Bentley* v. *Fleming*, 1844, 1 C. & R. 587, 1 C. B. 479; *Betts* v. *Menzies*, 1857, 8 E. & B. 937, 1 E. & E. 990. On the other hand, prior public user by the patentee himself would invalidate his patent, whether such user were experimental or not. *Morgan* v. *Seaward*, 1837, 2 M. & W. 559, 1 W. P. C. 194.

See also sect. 7 as to prior user, but subsequent abandonment of the invention.

In *Newall* v. *Elliot*, 1858, 4 C. B. (N.S.) 269, 27 L. J. C. P. 337, the experimental user of a submarine cable-laying machinery did not vitiate the patent, and the fact that the patentee had received benefit made no difference. But the Court laid stress on the fact that it had only been done once, and not repeatedly. In *The Useful Patents Co.* v. *Rylands*, 1885, 2 R. P. C. 254, where even 600 dozens of bottles, together with the tools with which they were made, were sent to an aërated water company for trial, it was still held that this was experimental. In *Morgan* v. *Seaward*, 1837, 2 M. & W. 544, 1 W. P. C. 187, a number of wheels were made in confidence and exported; this was held no prior public user. All these cases seem to turn on the meaning of the word "use" in the Statute of Monopolies, which means not "experimentally use," but "use for a regular trade purpose": see the preceding section.

Jessel, M.R., seems to have thought that the intention to take out a patent was essential to prevent experimental user, even in secret, from establishing prior user. In the House of Lords, Lord Blackburn thought that the

CHAP. V. SECT. 3.

Prior private user of an experimental character will not invalidate a patent.

intention might be presumed from the fact of the user being experimental: *Saxby* v. *Gloucester Waggon Co.*, 1883, Griff. App. 57; see also *re Adamson's Patent*, 1856, 25 L. J. Ch. 457, and as to secrecy, see *Humpherson* v. *Syer*, 1887, 4 R. P. C. 414. It is not merely the article made which must be shewn to have been anticipated by user, but the invention. Thus, in *Poupard* v. *Fardell*, 1869, 18 W. R. 59, 127, 21 L. T. (N.S.) 696, where the tail-piece of a skid for wheels had been previously lengthened *for the purpose of hanging it up*, it was held that a patent might be had for lengthening the skid for making it more effective in skidding.

4. Prior user of the invention by the patentee or others within the realm of such a character, that the results of it are made public, but not the means whereby they are brought about.—It is quite clear that where the mere inspection of the articles reveals the invention, prior public user of them will avoid a subsequent patent.

Thus, where the defendants proved that tea-pots, similar to those patented, had been previously sold by others, the plaintiff was defeated. *Hollins* v. *Capper*, 1888, 5 R. P. C. 289. See also, *Guilbert-Martin* v. *Kerr*, 1886, 4 R. P. C. 18, where the sale of steam gauge glasses similar to those patented, invalidated a patent. See also *Honiball* v. *Bloomer*, 1854, 2 W. P. C. 199.

Nor is it needful that the article should be sold. If it is placed in some public position where it can be seen, and the nature of the invention understood by inspection, here also the patent will be defeated. *Life Boat Co.* v. *Chambers*, 1891, 8 R. P. C. 418; *Mullins* v. *Hart*, 1852, 3 C. & K. 297.

Prior user which reveals the results but not the invention.

Again, where a patentee uses his invention in his own works without concealment, and publicly sells the proceeds, there is little doubt that this would be considered a prior user, even although it would not be possible from the look of the article to tell how it was made. Thus, in *Wood* v. *Zimmer*, 1815, 1 W. P. C. 82, the patentee made paint in his own factory, but apparently took no particular means to keep it secret, and sold the proceeds. It was held (*inter alia*) to invalidate his patent, though no one on looking at the paint could tell how it was made. And again, in *The Germ Milling Co.* v. *Robinson*, 1886, 3 R. P. C. 259, where the patentee had, prior to his patent, made the article in his own mills and sold it, this was held to invalidate his patent.

On the other hand, where the only publicity that a patentee gives to his invention is to sell the results of it, and at the same time instead of using the invention regularly and openly in his factory, conceals his operations in order that his method may not become known, it seems more consonant with reason that he should afterwards be able to take out a valid patent.

It is true there are some *dicta* contrary to this view. Thus, in *Morgan* v. *Seaward*, 1836, 1 W. P. C. 195, Heath, J., says: "If an inventor could sell his invention, keeping the secret to himself, and when it was likely to be discovered by another, take out a patent for it, he might have practically a monopoly for a much longer period than fourteen years." But in truth a monopoly consists of a right to prevent the competition of others, and this he would not have except for fourteen years. Again, in *Heath* v. *Smith*, 1854, 2 W. P. C. 278, Erle, J., expresses a doubt upon the point, but it seems very

CHAP. V. SECT. 4.

Prior user which reveals the results but not the invention.

difficult to reconcile the cases of *Hills* v. *London Gas Light Co.*, 1860, 5 H. & N. 336, with this view.

And if the prior sale in England of goloshes made by others in America by a process which is not published, would not invalidate a patent, by the same reasoning the sale of goloshes made in England by the patentee, by a secret process ought not to invalidate it: *Hancock* v. *Somervell*, 1851, 39 Newton's Lond. Journal 158.

Lastly, let us suppose a case of a prior secret user of the invention in Great Britain by others than the patentee, and of a public sale by them of the proceeds, but that the character of the articles sold is such that the nature of the invention by which they were made could not be ascertained by inspection. Here clearly is no publication of the *invention*. The only questions are (1.) whether the invention can be said to be one which "others at the time of making such letters patent and grant shall not use," or (2.) whether in such circumstances the patentee can be said to be the true and first inventor? As to the second point there does not appear to be much difficulty. If the prior secret use by others without sale of the products would not prevent the patentee from being the true and first inventor, it is hard to see why a sale in circumstances which did not reveal the invention could make him the less the true first inventor. The first point is, however, more difficult. For by the use of the word *others* the statute expressly seems to differentiate prior user by "others," from prior user by the patentee. It is submitted that it is clear that such prior user by others in the circumstances above named would vitiate the patent. To see this we have only to consider the state of the arts and manufactures in

Prior user which reveals the results but not the invention.

England at the time of the Statute of Monopolies. For in those days, in consequence of the want of books, and difficulty of locomotion, almost every trade was a mystery, and it was quite in accordance with popular notions that it ought to be so, and very many trades were only carried on by a single manufacturer. Hence if it had been held that any third person might have a patent for any mystery that was at that time only practised by one or two people, a large number of the trades then in existence might have been stopped.

Moreover, in the early days of patents and until the reign of Queen Anne, *publication* of the invention was not needed at all as a condition of its grant. See, *e.g.*, *The Smalt Patents*, 1606, 1 W. P. C. 9, and *Bailey* v. *Roberton*, 3 App. Cas. 1074.

But before this, the mere introduction even of a secret trade or mystery was considered to deserve a patent for a limited time (*Mansell's patent*, 1624, 1 W. P. C. 19), and hence to grant a patent to a man which would give him a monopoly of a mystery already practised by others, and that, too, with no condition that he should publish it, would have been plainly against the spirit of the Act. It was, of course, quite a different matter to give him a monopoly, for a limited time, of an art which he had himself invented or brought from abroad, and which others did not use, even though he might have invented it some time previously. For that would clearly be for the encouragement of trade, and would not injure any one else.

Accordingly, in *Tennant's Case*, 1798, 1 W. P. C. 125, it was held that prior secret user of a process of bleaching by others than the patentee, vitiated the patent. See also *Hill* v. *Thompson*, 1818, 1 W. P. C. 240; *Cornish* v. *Keene*, 1835, 1 W. P. C. 511. Again, in *Cheetham* v.

CHAP. V. SECT. 4.

Prior user which reveals the results but not the invention.

Oldham, 1890, 7 R. P. C., at p. 124, the patentee had invented a peculiar method of veneering felt hats, with a layer of finer wool. But it was proved that hats had been previously made and sold by persons other than the patentee, and the appearance of which was not necessarily an indication how they were made. This was held to invalidate the patent.

5. Prior user by sale, or offering for sale.—It is not necessary in proving prior user to prove that the article had been made for sale, but of course proof of sale in Great Britain even of an article made abroad, where the nature of the invention could be seen by inspecting the article, will avoid a subsequent patent: *Jensen* v. *Smith*, 1885, 2 R. P. C. 249; *Honiball* v. *Bloomer*, 1854, 2 W. P. C. 199 (new form of lubricating apparatus). And so will proof of an article having been made publicly in England for exportation: *Carpenter* v. *Smith*, 1841, 1 W. P. C. 536.

The mere offering of the article for sale, if done publicly, is sufficient to invalidate a subsequent patent: *Hancock* v. *Somervill*, 1851, 39 Newton's Lond. Journal, 158; *Oxley* v. *Holden*, 1860, 8 C. B. (N.S.) 666; *Mullins* v. *Hart*, 1852, 3 C. & K. 297.

6. The user necessary to invalidate a patent, must be in the United Kingdom.—*Brown* v. *Annandale*, 1842, 1 W. P. C. 433, 8 Cl. & F. 437; *Roebuck* v. *Sterling*, 1774, 1 W. P. C. 45, 451 n., where a distinction was endeavoured to be drawn between England and Scotland. But user in a Crown Colony would not avoid an English patent: *Rolls* v. *Isaacs*, 1878, 19 Ch. D. 268.

7. Public user at public exhibitions held either in or out of the kingdom, certified as such by the Board of Trade, does not invalidate a patent, nor does its publication during the holding of the exhibition, nor its use elsewhere without the privity of the inventor. But an exhibitor, before exhibiting the article, must give seven days' notice that he intends to apply for a patent, and must do so within six months of the opening of the exhibition: Patents Act, 1883, s. 39; Patents Act, 1886, s. 3; Patent Rules, 1890, 15, Form O, and Schedule of Fees; see also the International Convention of Paris, March 20, 1883, between Belgium, Brazil, Spain, France, Guatemala, Italy, the Netherlands, Portugal, Salvador, Servia, and Switzerland: Article XI. In addition to this, special enactments are often passed to encourage exhibitors. Thus, the U.S. Congress passed a law that at the Chicago Exhibition no exhibitor of any other country should be held to have infringed a U.S. patent by reason of anything done at the exhibition: see Patent Journal, May 4, 1892, p. 1. As a rule there is a growing feeling among manufacturers against exhibiting at exhibitions other things than merely their finished goods. It is most dangerous for inventors to exhibit incomplete inventions, and of late years medals of bronze, silver, and gold (which in some cases the winners have been requested to pay for), have been showered with such profusion as to render these honours (even if they are worth attaining at all), certainly not worth the risk of causing an invention to be improved upon by a rival patentee.

post, pp. 457, 477.

post, pp. 485, 527.

post, p. 558.

8. The effect of a prior invention which has been abandoned, upon subsequent patents for the same invention.—Evidence of prior public user, or prior

CHAP. V SECT. 8.

The effect of a prior invention which has been abandoned, upon subsequent patents for the same invention.

publication, is often met, by shewing that the invention was after a short time abandoned. This fact, however, standing alone would not be sufficient to rebut clear evidence of prior publication or user; it would only be *evidence* that the prior invention was imperfect, or else different from that which was made the subject of a posterior useful and successful patent. "Suppose an invention executed, 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, with respect to such an invention as that, it signifies one rush whether it was completely abandoned or whether it continued to be used down to the very date of the patent" (*per* Lord Brougham): *Househill Co.* v. *Neilson*, 1843, 1 W. P. C. 713, approved; *Morgan* v. *Windover*, 1888, 5 R. P. C. 306; and in *King, Brown & Co.* v. *Anglo-American Brush Co.*, 1889, 6 R. P. C. 424. At the same time, however, the fact of the abandonment of an invention, even after it has been publicly used, is strong evidence that it was not completed or perfected, and thus has not really anticipated the subsequent patent: *Househill Co.* v. *Neilson*, *supra*, at p. 692, and see *Lewis* v. *Marling*, 1829, 1 W. P. C. 492 n.; *Minter* v. *Mower*, 1835, 1 W. P. C. 139; *Morgan* v. *Seaward*, 1836, 1 W. P. C. 186; *Jones* v. *Pearce*, 1832, 1 C. P. C. 529, 1 W. P. C. 122; *Galloway* v. *Bleaden*, 1839, 1 W. P. C. 525; *Bovill* v. *Goodier*, 1866, Griff. App. 48. "I am not aware of any principle or authority upon which the exhibition of a useless machine which turns out a failure can be held to affect the right of a patentee who has made a successful machine, though there may be a degree of similarity between some of the details of the two machines" (*per* James, L.J.): *Murray* v. *Clayton*, 1872, L. R. 7 Ch. 581,

20 W. R. 650. See also *Lyon* v. *Goddard*, 1893, 10 R. P. C. 121.

The effect of a prior invention which has been abandoned, upon subsequent patents for the same invention.

The principles upon which the abandonment of an unsuccessful invention is considered as evidence of its difference from a subsequent successful one, resemble closely those in accordance with which commercial success is considered evidence of novelty and utility: see Chap. IV.

ante, p. 134.

A worthless or abandoned patent may likewise be an anticipation of a subsequent invention if it describes such invention in terms which fully and sufficiently disclose it, and the manner in which it is to be practised (*semble*): *Kaye* v. *Chubb*, 1888, 5 R. P. C. 648.

9. Prior publication by documents in general, and sufficiency of description in the anticipating document.—Prior publication of an invention in a book, newspaper, or other document will invalidate a patent by reason of the public knowledge thereby afforded, subject, however, to two principles: first, that the prior information must be clear, practical, such as an ordinary intelligent workman accustomed to the trade could understand, and not merely contained in a theoretic form in some scientific treatise, nor requiring further experiment or ingenuity to discover it. And secondly, though the information may be contained in more than one document, it must not, in order to be an anticipation, require experiment or invention, or even extended labour, to piece the information together.

The general principles applicable to the question of prior publication are laid down in *Hill* v. *Evans*, 1862, 31 L. J. Ch. 463, 8 Jur. (N.S.) 529: "The information given by the prior publication must, for the purposes of

Prior publication by documents in general, and sufficiency of description in the anticipating document.

practical utility, be equal to that given in the subsequent patent; whatever is essential to the invention must be read out of the prior publication. . . . 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" (*per* Westbury, L.C.). In *Neilson* v. *Betts*, 1871, 40 L. J. Ch. 326, Lord Westbury repeated and confirmed what he had said here, which was read with approval in *Bray* v. *Gardner*, 1887, 4 R. P. C. 405. In this case the patent was for a hook for securing boot-laces, made by milling and boring from a solid wire. It consisted of a head, b^2, a neck, *e*, a shoulder, *c*, and a tube, *a*, which was inserted into a hole in the leather and swedged out like an eyelet. The same patentee had patented the invention in America, and the Official Gazette contained the drawing of it, with this description: "A stud or hook for lacing boots and shoes, and other purposes, having

Compare the Plimpton Skate patents, post, p. 395.



a tubular sank or body, *a*, closed at one end and provided with a shoulder, discs b^1 and b^2, and an eccentric neck, *e*, all made from a single solid piece of wire substantially as and for the purpose described." Kekewich, J., held that this drawing and description were insufficient to enable a workman to make the hook, and hence were no anticipation of the plaintiff's patent. This case goes far: see also *Haslam* v. *Hall*, 1888, 5 R. P. C. 19. The same principles are also laid down by Grove, J., in *Philpot* v. *Hanbury*, 1885, 2 R. P. C. 43, who expressed an opinion that the degree of accuracy requisite to make an anticipation need not be so great as that required to make a specification good: see also as to this last point *Kaye* v. *Chubb*, 1887, 4 R. P. C. 23, 289, 5 R. P. C. 641.

Prior publication by documents in general, and sufficiency of description in the anticipating document.

Anticipation by a prior publication deprives a patentee of being the "first and true inventor," even if he got the information from his own wits, and quite independently of the publication: *Stead* v. *Williams*, 1844, 2 W. P. C. 142; though in the same case, and in accordance with the principles laid down above, sect. 1, Tindal, C.J., remarked that a copy of a work brought from a depository where it had "long lain in a state of obscurity" would, as an anticipation, stand on a different footing from an Encyclopædia.

"Publications . . . must be regarded as of two classes, those addressed to the scientific world, and those addressed to working or practical men. . . . There is the scientific literature, and there is the technical literature . . . publications having reference to chemical science and intelligibly expressed will always be enquired after, and studied in the laboratories by scientific chemists . . . but generally it is not the fact that such publications are sought after by practical working chemists, whose labours for the most part commence after the useful purpose has been ascertained" (*per* Bagallay, L.J.): *Badische Anilin und Soda Fabrik* v. *Levinstein*, 1885, 29 Ch. D. 385.

One Dobbs had patented in 1804 the coating of lead with tin by rolling them together when clean. He did not specify the thickness of the plates. Betts in 1859 patented casting lead plates about $\frac{3}{4}$-inch thick and tin plates from $\frac{1}{4}$th to $\frac{1}{16}$th thick. The lead plates were then separately rolled to about $\frac{1}{4}$-inch thick and the tin to about $\frac{1}{20}$th of the thickness of the lead. Then both lead and tin were rolled together till they adhered and were quite thin, and fit to be made into capsules for wine bottles. Held, by the House of Lords, that Betts' patent

CHAP. V. SECT. 9.

Prior publication by documents in general, and sufficiency of description in the anticipating document.

was good in the absence of expert evidence to shew that Dobb's patent was really an anticipation of it: *Betts* v. *Menzies*, 1861, 31 L. J. Q. B. 233.

The patent was then tried again in the Chancery Division: *Betts* v. *Neilson*, 1865, 34 L. J. Ch. 537. At this trial expert evidence was given that Dobbs' patent would work, and was really the same as Betts'. The Vice-Chancellor rejected the evidence on account of the House of Lords' decision in *Betts* v. *Menzies*. On appeal (37 L. J. Ch. 321), the Chancellor thought the evidence relevant, but insufficient. The case was then carried to the House of Lords, when the patent was confirmed, on the ground that the evidence was insufficient. It was, however, explained that the decision in *Betts* v. *Menzies* did not mean that Dobbs' patent clearly could not be an anticipation of Betts', but only that it *required evidence* to shew it to be so: see also *Betts* v. *De Vitre*, 1864, 11 L. T. (N.S.) 445, 533. The principles laid down in *Betts* v. *Neilson* were followed by Jessel, M.R., in *Plimpton* v. *Malcolmson*, 1876, L. R. 3 Ch. D. 568. In *Ehrlich* v. *Ihlee*, 1888, Cotton, L.J., said: "We know what is necessary if there is said to be anticipation, not by the existence of an actual thing, but by description either in a specification or otherwise, that the description must be sufficient to enable anyone competent to make the machine for which protection is claimed by the patentee, and to make it from the description given": 5 R. P. C. 450 referred to with approval in *Winby* v. *Manchester Steam Tram Co.*, 1889, 6 R. P. C. 363. "The mention in a book does not signify unless it is in such a way that anybody could easily make it and use it" (*per* Lord Brougham): *Woodcroft's Patent*, 1846, 2 W. P. C. 23. "If it requires this mosaic of extracts from annuals and treatises spread over

post, p. 294.

Prior publication by documents in general, and sufficiency of description in the anticipating document.

a series of years to prove the defendant's contention, that contention stands self-condemned . . . his diligent study of such works would as much entitle (the patentee) to the character of an inventor, as the diligent study of the works of nature would do" (*per* James, L.J.): *Von Heyden* v. *Newstadt*, 1880, 50 L. J. (N.S.) Ch. 128; quoted with approval in *Moseley* v. *Victoria Rubber Co.*, 1887, 4 R. P. C. 252. A patent for a dressmaker's measuring-machine was held to have been anticipated by two prior specifications taken together, or probably even taken separately. "If the previous specification," says Grove, J., "reasonably discloses what the invention is, so that a person skilled in the trade can practise the invention from it, then I am of opinion that there is anticipation": *Philpot* v. *Hanbury*, 1885, 2 R. P. C. 43; see also *Otto* v. *Linford*, 1882, 46 L. T. (N.S.) at p. 44; *Betts* v. *De Vitre*, 1864, 11 L. T. (N.S.) 445, which decided that the fact that all the world had been desiring the invention, but that it had not been made, was strong evidence that the prior description had not been sufficient to amount to an anticipation. It is not needful that the prior publication should have been put in practice, provided that it properly discloses the invention: *Thomson* v. *Macdonald*, 1891, 8 R. P. C. 8.

10. Prior publication by a provisional specification.—The mere filing in the Patent Office of a provisional specification is no publication of the invention, for under the Patents Act, 1885, s. 4, provisional specifications are not published or printed unless the patent is proceeded with. Nor is the filing of the provisional specification a dedication of the invention to the public: *Oxley* v. *Holden*, 1860, 8 C. B. (N.S.) 666, 30 L. J.C. P.68; followed

post, p. 476.

CHAP. V. SECT. 10.

Prior publication by a provisional specification.

in *Lister* v. *Norton*, 1884, 3 R. P. C. 199. In *Stoner* v. *Todd*, 1876, L. R. 4 Ch. D. 58, Jessel, M.R., said: "A provisional specification was never intended to be more than a mode of protecting an invention 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 to make it." He was therefore of opinion that in general, even in the days when abandoned provisional specifications were published, mere publication in a provisional specification would not be an anticipation, unless it was so complete and perfect as to enable the article to be actually made. In *Lister* v. *Norton*, 1884, 3 R. P. C. 199, it was further held that user by a patentee under a provisional specification was not such user as would amount to an anticipation of a subsequent patent to him for the invention.

It appears, therefore, that a patentee might take out a series of provisional protections and successively abandon them, without any prejudice to his invention, while he was completing it, provided he worked it secretly. Of course this would not protect him against the danger of the publication of his invention by another person; but if that occurred, he could then at once complete the last of his provisional specifications and thus save his patent. He would, of course, also be exposed to the danger that some rival inventor, working on the same lines (and who had sent in a provisional specification prior to his own last provisional), might incorporate the invention in a final specification.

11. Prior publication by a complete specification.—This was discussed at some length in *Betts* v. *Menzies*, 1862, 10 H. L. C. 117.

Prior publication by a complete specification.

A final specification stands on the same footing as any other document. In *Betts* v. *Neilson*, 1868, L. R. 3 Ch. D. 429, 37 L. J. Ch. 321, it is pointed out that a prior specification may well avoid a subsequent patent, although such prior specification is itself bad for want of sufficient description. The point is further explained by Jessel, M.R., in *Plimpton* v. *Malcolmson*, 1876, L. R. 3 Ch. D. 567. In *Otto* v. *Linford*, 1881, 46 L. T. (N.S.) 35, Brett, L.J., said that the question to be considered was whether the prior specification fairly read by a person conversant with such matters would give a reasonably clear description of the latter invention: see *Dobbs* v. *Penn*, 1849, 3 Ex. 427; *Kaye* v. *Chubb*, 1888, 5 R. P. C. 648.

12. Prior publication in a book.—The question, what is sufficient publication in a book, must rest upon the same ground. Thus, in *Arkwright's Case*, 1785, 1 W. P. C. 72, the patent was held anticipated by a description in a book by Emmerson: see also *Plimpton* v. *Spiller*, 1877, 6 Ch. D. 412. In *Harris* v. *Rothwell*, 1885, 35 Ch. D. 416, a German patent, a copy of which had been in the Patent Office Library, and notice of it given in the Patents Journal, was held an anticipation: *Hill* v. *Thompson*, 1817, 8 Taunt. 375, 1 W. P. C. 232 (Aikin's Dictionary). But in accordance with the principles above set forth, a book merely generally describing an invention, and not specifying how to carry it out, would, of course, be insufficient: *Woodcroft's Patent*, 1846, 2 W. P. C. 23 (Tredgold's book). A valuable note upon the whole subject is to be found in 1 W. P. C. 718.

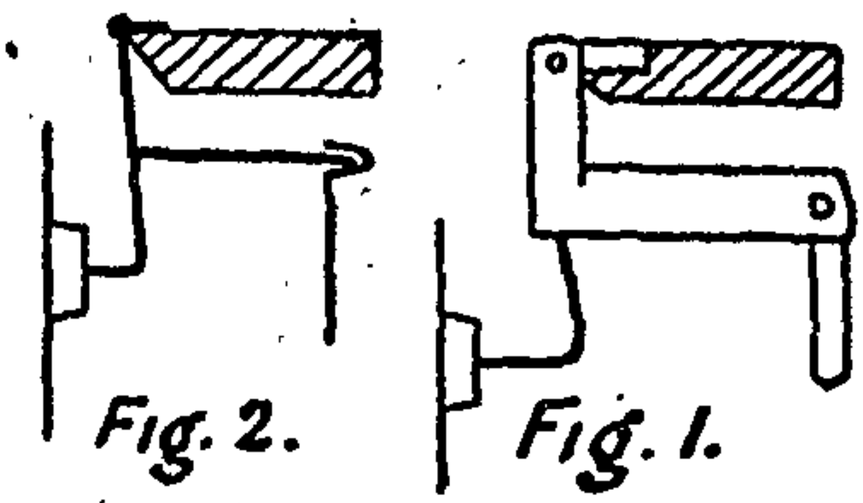
13. A book in a foreign language may also be an anticipation: *Harris* v. *Rothwell*, 1887, 35 Ch. D. 425

CHAP. V. SECT. 13.

A book in a foreign language.

(German); *United Telephone Co.* v. *Harrison*, 1882, 21 Ch. D. 720, 51 L. J. Ch. 705 (German); *Heurteloup's Patent*, 1836, 1 W. P. C. 553 (French); *Otto* v. *Steel*, 1885, 31 Ch. D. 241 (French); *Lang* v. *Gisborne*, 1862, 31 Beav. 135, 31 L. J. Ch. 770 (French). It may, however, be doubted whether languages rarely understood, such as Russian or the Oriental languages, would be sufficient. The point was mentioned, but not decided, in *Harris* v. *Rothwell*, 1887, 35 Ch. D. 426.

14. Drawings.—Publication by drawings without any description may avoid a patent: *Herrburger* v. *Squire*, 1889, 5 R. P. C. 581, 6 R. P. C. 194. In this case a pianoforte string-damper (Fig. 1.) made of wood, was held to have been anticipated by the drawing (Fig. 2.) of a similar damper in metal without a description. *Tetley* v. *Easton*, 1852, 2 C. B. (N.S.) 706, 26 L. J. C. P. 269. See also the Plimpton Skate cases, *post*, p. 294.



15. Models.—Prior publication may be by the exhibition of models: *Humpherson* v. *Syer*, 1887, 4 R. P. C. 415; *Winby* v. *Manchester Steam Tram Co.*, 1889, 6 R. P. C. 359, 7 R. P. C. 30; *Galloway* v. *Bleaden*, 1839, 1 W. P. C 526. The exhibition of a specimen lifeboat in dockyards, with no precautions as to secrecy, was held fatal: *Lifeboat Co.* v. *Chambers*, 1891, 8 R. P. C. 418.

16. The prior publication must have been accessible to the public.—This will be a question of fact

The prior publication must have been accessible to the public.

in each case. It is not necessary that the book should have been actually sold, but it must have been exhibited or deposited in a public place. "The existence of a single copy of a work brought from a place of obscurity would afford a very different inference from the production of an encyclopædia": *Stead* v. *Williams*, 1844, 2 W. P. C. 143. Mere mention of a book in a catalogue circulated in England would be insufficient: *Otto* v. *Steel*, 1885, 31 Ch. D. 241. But if once the book is deposited on the shelves of a library open to the public, it will be enough, even though it is the only copy so accessible: *United Telephone Co.* v. *Harrison*, 1882, 21 Ch. D. 731. Or even though only one person has seen it: *Harris* v. *Rothwell*, 1887, 35 Ch. D. 427, 3 R. P. C. 383, 4 R. P. C. 225. This latter case is important, because from the judgment of Cotton, L.J., and Lindley, L.J., it seems as though, even after proof had been given of the deposit of the book in a public place, if the patentee could shew that no one had as a fact seen it who could understand it, his patent might be upheld. But Lopes, L.J., took a different view, holding that, once the book had been accessible to the public, it did not the least matter whether it had been seen as a fact or not (p. 432). On the other hand, if the book were in a private room in a public library, and not accessible to the public, nor catalogued, and (*semble*) that if only one copy of it had been merely put in a shop window one day, and destroyed the next, this would be insufficient: *Plimpton* v. *Malcolmson*, 1876, 3 Ch. D. 557, where the whole subject is treated at length by Jessel, M.R.; approved, *Plimpton* v. *Spiller*, 1876, 6 Ch. D. 412. In *Pickard* v. *Prescott*, 1892, 9 R. P. C. 195, a book kept by the Edinburgh branch of a firm of publishers contained an entry shewing the

CHAP. V. SECT. 16.

The prior publication must have been accessible to the public.

sending to a customer of a French periodical, fourteen days before the application for the patent. The customer was called, and said he had read it but did not remember when. Held, that this was evidence of prior publication. The conclusion to be drawn from these cases seems to be that proof of the deposition of an anticipating document in some place accessible to the public, and in a language which is fairly well known, is strong and *primâ facie* evidence of publication, but that it is not necessarily conclusive, and that each case must be considered on its own merits.

17. Anticipation in a part of an invention will invalidate the whole patent: *Templeton* **v.** *Macfarlane*, 1848, 1 H. L. C. 595; *Pether* **v.** *Shaw*, 1893, 10 R. P. C. 297.

CHAPTER VI.

THE SPECIFICATIONS AND THE TITLE OF A PATENT.

THE enormous number of patents now taken out in England and America, renders it a matter of great difficulty for an inventor to know whether what he has discovered is really new. In consequence, few patents can be drawn so as to ensure novelty in all parts of them, and almost every specification contains claims of a more or less speculative character.

The impossibility of knowing what has been previously done, is producing a growing tendency to rely on special details which are less likely to have been anticipated. The principles which ought to govern the choice of a title, and the drafting of the specifications, will be treated in detail, but they may be summarized in the following leading rules.

1. The specifications must be clear and intelligible to an ordinary workman who understands the trade to which the invention relates.

2. They must define the invention, distinguishing the new from the old, and the useless from the useful.

3. They must give the best information at the disposal of the applicant, at the date on which they are sent in.

4. They must contain no misleading statements.

5. The title, provisional and complete specifications, must conform to one another.

CHAP. VI. SECT. 1.

General principles regulating the choice of a title.

1. General principles regulating the choice of a title.—The general principles which regulate the form of the title of a patent are :—

(1) That it must correctly describe the invention.
(2) It must be framed in the utmost good faith.
(3) It must not be ambiguous.
(4) It must neither be too wide nor too narrow.
(5) In construing a title the specification may be looked to to explain it.

A change has come over the spirit in which titles used to be interpreted. For (prior to 1852) when no provisional specifications were filed, the title of the invention was the only check on the patentee who had filed a title from putting anything he liked into a specification. An example of this is *Crossley* v. *Potter*, 1853, M. P. C. 240. An inventor had invented a machine for weaving coach lace. He filed a title "for improvements in weaving figured fabrics." The specification as prepared by him and handed over to the assignees was only for weaving coach lace. He sold the patent; the assignees did not use his specification, but filed a new final specification, describing the machinery as suitable for making (*inter alia*) *carpets*. The inventor, on cross-examination, admitted that carpets were not in his mind when he filed his title, and the patent was upset. "In my mind the safest course for patentees to adopt, in framing their specifications, is, instead of claiming everything, to confine themselves specifically to one good thing, and a jury will always take care, that if it be a real invention, no man, under colour of improvement, shall be allowed to interfere with that which is the offspring of his genius" (*per* Pollock, C.B.).

As soon as the use of provisional specifications was intro-

General principles regulating the choice of a title.

duced, the use of the title became more what it is at present—to indicate to a searcher the general scope of the invention. By the Patents Act, 1883, the duty of seeing that the title is suitable is now cast on the Comptroller, and is no longer a ground of opposition (s. 7, 11, Patents Act, 1883, s. 2). But a faulty title may still invalidate a patent. The following list of cases decided upon titles to inventions is useful, always, however, remembering that the title is now less strictly looked at than formerly, so that many of the older cases would now probably not be followed.

Hornblower v. *Boulton*, 1799, D. P. C. 220, 8 T. R. 95. —"The specification may be looked at to explain the title."

See Newton v. *Vaucher*, *post*, p. 166.

Bainbridge v. *Wigley*, 1810, Parl. Rep. 1829, 197, 1 C. P. C. 270.—Title for improvements in a flute, "whereby notes were produced which never before were produced." Only one new note was produced. Patent held bad.

Compare with Derosne v. *Fairie*, p. 164; *and Hastings* v. *Brown*, p. 186.

Cochrane v. *Smethurst*, 1816, D. P. C. 354.—Title was for an improved method of lighting cities: the specification only shewed a new sort of lamp. Held bad (doubted in *Cook* v. *Pearce*, 1843, 8 Q. B. 1043).

post, p. 165.

R. v. *Metcalf*, 1817, 1 W. P. C. 141 n., 2 Stark. 249.—Title for a tapering brush. The specification only shewed that the bristles were of unequal length. Held bad.

R. v. *Wheeler*, 1819, 2 B. & Ald. 345.—Title, "A new or improved method of drying and preparing malt." The specification shewed only a process for colouring the malt, by further heating after it had been dried. Held bad.

Campion v. *Benyon*, 1821, 6 B. Moo. 71.—The title as well as the specification was for a "new mode of making double canvas and sailcloth, without any starch what-

CHAP. VI. SECT. 1.

General principles regulating the choice of a title.

post, p. 90

ever." Held to mean that the invention was for dispensing with starch, that canvas had previously been made without starch, and that the title was bad for suggesting as new that which was really old.

Bloxam v. *Elsee*, 1827, 6 B. & C. 169.—Title, "A machine for making paper of various widths, from 1 to 12 feet wide." Held to represent that *one* machine would make all different widths, whereas each machine only made paper of one width. Held bad.

Sturtz v. *De la Rue*, 1828, 1 W. P. C. 83.—Title, "Improvements in copper and other plate printing." *Semble*, that that was enough to cover an invention for preparing paper for copper-plate printing, by means of size and whitelead. (Patent held bad on other grounds.)

Crossley v. *Beverley*, 1829, 9 B. & C. 63, 1 W. P. C. 112. —Title, "For extracting inflammable gas by heat from pit coal, tar, or other substance from which gas or gases capable of being employed for illumination, can be extracted by heat." At the trial it was shewn (1) that inflammable gas could be got from oil, but at great expense, (2) that patentee's process would not do for oil. Held, that the words "or other substances," must be read "ejusdem generis." That no workman would have considered oil as ejusdem generis with coal or tar. Patent supported.

See Wright v. *Hitchcock*, *post*, p. 166.

Felton v. *Greaves*, 1829, 3 C. & P. 611.—Title, "A machine for sharpening knives, razors, scissors, and other cutting instruments." The machine would do for knives but not for scissors. Patent held bad.

Derosne v. *Fairie*, 1835, 1 W. P. C. 154.—The word "improvements" was held sufficient in the title, though only one improvement was shewn, as the patent was for a process consisting of various steps.

Fisher v. *Dewick*, 1838, see *Cook* v. *Pearce*, 8 Q. B. 1056.—"Improvements in machinery for *making* bobbin-net lace." The effect of the machinery was to make spots on the lace. Held sufficient.

Neilson v. *Harford*, 1841, 8 M. & W. 806, 1 W. P. C. 295.—Title for "the improved application of air to produce heat in fires, forges, and furnaces." "Though that is ambiguous, it is sufficiently explained by the specification, and not at variance with it, as was the case in *Rex* v. *Wheeler*" (*per* Parke, B.). The same question again arose in *The Househill Co.* v. *Neilson*, 1843, 1 W. P. C. 678; *Nickels* v. *Haslam*, 1844, 13 L. J. C. P. 146, 7 M. & G. 378 (same point as in *Derosne* v. *Fairie*, *supra*).

Cook v. *Pearce*, 1843, 8 Q. B. 1044.—Title, "Improvements in carriages." The invention was for a peculiar mode of fixing folding shutters to carriages. Held bad on the authority of *Cochrane* v. *Smethurst* (*supra*); reversed on appeal. *Cochrane* v. *Smethurst* doubted.

Stead v. *Williams*, 1844, 2 W. P. C. 136.—"A mode of making and paving public streets and highways with timber or wooden blocks." Held, not too vague.

Beard v. *Egerton*, 1846, 3 C. B. 97, 15 L. J. C. P. 270.—Title, "A new *or* improved method of obtaining photographic images." Held, not ambiguous.

Croll v. *Edge*, 1850, 19 L. J. C. P. 261, 9 C. B. 479.—Title, "Improvements in the manufacture of gas . . . and in the apparatus used when transmitting and measuring gas." The specification recited the patent, as for "improvements in the manufacture of gas, *and in the apparatus used therein*, when transmitting and measuring gas." Held bad, as extending the original title, which did not claim any apparatus for manufacturing gas.

CHAP. VI. SECT. 1.

General principles regulating the choice of a title.

Electric Telegraph Co. v. *Brett*, 1851, 10 C. B. 838, 20 L. J. C. P. 123.—Title, "Improvements in giving signals . . . in distant places, by means of electric currents transmitted through *metallic* circuits." Held, to cover cases where part of the circuit was an earth return.

Hornblower v. *Boulton*, *ante*, p. 163; *and Lister* v. *Norton*, *post*, p. 167.

Newton v. *Vaucher*, 1851, 21 L. J. Ex. 305, 6 Ex. 866. "Specifications must be read together with their titles."

Patent Bottle Envelope Co. v. *Seymer*, 1858, 28 L. J. C. P. 22, 5 C. B. (N.S.) 164.—Title, "Improvements in the manufacture of cases and envelopes for bottles." The specification claimed "a certain combination of machinery for this purpose, and the making of the envelopes as described." Held, not to be a claim for the form of envelope, but the mode of making it.

N B.—In 1852, Provisional Specifications were introduced, after which titles were less strictly construed, post, p. 168.

Oxley v. *Holden*, 1860, 8 C. B. (N.S.) 707, 30 L. J. C. P. 74.—"Improvements in doors and sashes of *carriages*." The specification described the invention as applied "to carriages, or in any other position where windows and doors are subject to vibration." It was urged this carried the invention outside the title, but it was held the title and specification might be read together, and being so read, the invention was sufficiently limited.

Hills v. *London Gas Co.*, 1860, 5 H. & N. 370, 29 L. J. Ex. 409.—"A new mode of *purifying* gas." Held, sufficiently described as "Improved mode of manufacturing gas."

Newall v. *Elliot*, 1864, 13 W. R. 15, Pollock, C.B., stated that, when Attorney-General, he refused an application for a patent for "An improvement in locomotion," as too general.

Wright v. *Hitchcock*, 1870, L. R. 5 Ex. 37, 39 L. J. Ex. 97.—Title, "Improvements in the manufacture of frills or ruffles." The specification described it as for "frills,

ruffles, and *trimmings*." The last word held to be ejusdem generis, and the title wide enough.

General principles regulating the choice of a title.

Lister v. *Norton*, 1884, 3 R. P. C. 203.—Title, "Improvements in the manufacture of velvets and *of* pile fabrics in imitation of sealskin." There the word velvet was read as if it, as well as the pile fabrics, was intended to be in imitation of sealskin. This reading supported the patent. "The repetition of the preposition 'of' before pile fabrics gives rise to the defendant's argument that velvets are here spoken of without reference to the imitation of skins. If the title is read alone, that might be the strict grammatical meaning, but I think that reading the specification as a whole . . . velvets are spoken of, not separately, but in reference to imitation skins" (*per* Chitty, J.).

See Crossley v. *Beverley*, *ante*, p. 164.

Brown's Patent, 1887, Griff. App. 1.—The title, "Improvements in casks and tubs," was objected to by the Comptroller-General, as not covering the specification which described improvements in casks, tubs, and analogous vessels. The Attorney-General thought the title sufficient, without expressing any opinion as to whether it limited the claim to casks and tubs only.

The examiners frequently suggest to patentees improvements in the wording of the title. In this case if the patentee accepts the suggestion, the alteration is made without expense to him, the copies sent in being merely initialled and re-signed. Great caution should be exercised in accepting alterations proposed by examiners, for they have no conclusive legal validity, and may perhaps in reality injure the patent, although suggested with the best intention.

CHAPTER VII.

THE PROVISIONAL SPECIFICATION.

CHAP. VII. SECT. 1.

1. General remarks.—Under the old procedure, before 1852 a patentee received a patent merely on the suggestion that he was the inventor of a new manufacture, and after the time of Queen Anne the grant was made conditional on his filing, within a specified period, a specification explaining for the benefit of the public how his invention was to be performed.

In 1852 it was required, in addition, that he should file a provisional specification explaining more fully the scope of his invention than the mere title could do. The patent was then sealed, but with the condition that it should be of no effect unless a final specification were filed. Thus, the use of the provisional specification was to explain the title more precisely. The provisional and final specifications were always published if filed, whether the application was proceeded with or not.

post, p. 476. By the Patents Act, 1885, s. 4, this is modified. The provisional specification is never published unless the applicant goes on with the complete specification (sect. 4), and the patent is not sealed until after the complete specification has been sent in and accepted; Patents

post, p. 446. Act, 1883, s. 12.

There is no doubt, therefore, that the true function of

General remarks.

a provisional specification is to describe the invention, and that the true function of the complete specification is not only to describe it, but also to say in what manner it is to be performed. In truth, this distinction is the source of some confusion. For if the object of the provisional is to *describe* and *define* the invention, then, according to strict logic, the claims ought to be affixed to the provisional, leaving the complete to point out, not *what* the invention is, but only the manner of performing it. As it is, the present law requiring the claims, which *define* the invention, to be in the complete specification, whereas the description is to be in the provisional, really is often a source of error, constantly tempting inventors to go beyond the provisional specification, to the great danger of their patents; for any claim which extends the invention beyond that described in the provisional specification, is bad. And, on the other hand, if the provisional specification is required, not merely to foreshadow the invention and describe its general nature, but to limit and define it, then the only course for an inventor, in order to be safe, will be to make his complete specification a mere repetition of his provisional with, perhaps, a few details to make the manner of performing it more clear. In this case, the advantage of nine further months to develop his invention will almost disappear. In most patent cases disconformity is now pleaded, and the end of it will probably be to compel an alteration of the law.

2. The object therefore of a provisional specification is to describe the nature of the invention (Patents Act, 1888, s. 5, s-s. 3), but not to describe how the invention is to be performed, nor to give instructions

CHAP. VII. SECT. 2.

The object therefore of a provisional specification is to describe the nature of the invention (Patents Act, 1888, *s.* 5, *s-s.* 3), but not to describe how the invention is to be performed.

for the performing it, but to describe it, so that it can be known what it is that the patentee has discovered. "The function of a provisional specification is very different from that of a complete specification. . . A provisional specification was never intended to contain a complete and exhaustive description of the invention. It was intended to be sufficiently specific to disclose the nature of the invention so as to protect the inventor until the time of filing the final or complete specification, but permitting him in the meantime to perfect any details, to modify, supplement, and develop his invention, always keeping within the ambit of his invention as disclosed in his provisional specification" (*per* Cotton, L.J.): *Woodward* v. *Sansum*, 1887, 4 R. P. C. at pp. 176–178. He cited this opinion with approval in *Siddell* v. *Vickers*, 1888, 5 R. P. C. at p. 426. "The office of the provisional specification, as appears by sect. 6 of 15 & 16 Vict. c. 83, and sect. 7 of the Patents Act, 1883, is to describe the nature of the invention—nothing more is desired of it" (*per* Chitty, J.): *Moseley* v. *Victoria Rubber Co.*, 1887, 4 R. P. C. p. 248, citing with approval the judgment of Blackburn, J., in *Bailey* v. *Roberton*, 1878, L. R. 3 App. Cas. 1055, 27 W. R. 17, and also that of Jessel, M.R., in *Stoner* v. *Todd*, 1876, L. R. 4 Ch. D. 58, 46 L. J. Ch. 32. Exactly similar opinions were laid down by the Court in *Newall* v. *Elliot*, 1858, 4 C. B. (N.S.) 269, 1 H. & C. 797, 32 L. J. Ex. 120; *Penn* v. *Bibby*, 1866, L. R. 2 Ch. 127, 132. See a paper on Provisional Protection by J. Imray, in the Proceedings of the Institute of Patent Agents, vol. x. p. 184.

ante, p. 156.

3. The complete specification must therefore not go outside the limits of the title and the provisional

"Disconformity."

specification.—This fault is called "disconformity." What is considered an undue excess will be a matter of opinion in each case (see also cases collected under the head of "Title," Chap. VI.). For if an inventor discovers a new and useful detail of his invention, he has not merely a right, but it is his duty, to disclose it, in his complete specification: *Moseley* v. *Victoria Rubber Co.*, 1887, 4 R. P. C. 241. It is therefore inevitable that to some extent the complete specification should be an advance on the provisional specification. Provided, then, the invention remains the same, improvements in detail will not invalidate the patent: *Crampton* v. *Patent Investments Co.*, 1888, 5 R. P. C. 397; *Lucas* v. *Miller*, 1885, 2 R. P. C 159; *Penn* v. *Bibby*, 1866, L. R. 1 Eq. 548, 2 Ch. 127; *Horrocks* v. *Stubbs*, 1886, 3 R. P. C. 236; *Watling* v. *Stevens*, 1886, 3 R. P. C. 151. And in *Woodward* v. *Sansum*, 1887, 4 R. P. C. 166, the question of disconformity was discussed, and it was held that improvements in the disposition of parts within the scope of the provisional specification could not produce disconformity.

On the other hand, an unnecessary part mentioned in the provisional specification may in the complete specification be omitted: *Thomas* v. *Welch*, 1866, L. R. 1 C. P. 192.

The principle upon which the cases went before 1883 was, that on filing his provisional specification, representing what he had invented, the patentee got his patent sealed. If, then, he exceeded it in his complete, he had deceived the Crown, and his patent was void. Thus, in *United Telephone Co.* v. *Harrison*, 1882, 21 Ch. D. 746, the provisional specification described an instrument whereby the friction of a point on a moving surface was

CHAP. VII. SECT. 3.

"Disconformity."

The complete specification must therefore not go outside the limits of the title and the provisional specification.

electrically caused to vary its pressure in accordance with changes in the vibrations of the human voice. Varying sounds were thus produced, as when a slate-pencil is made to squeak upon a slate. The final specification also included the phonograph. Held, a fatal disconformity.

For some time after the Act of 1883 was passed it was thought by some that objections on the ground of non-conformity were obsolete. For the complete was sent in before the patent was granted, and being, moreover, the subject of examination in the Comptroller's Office, it might be supposed that if, after such examination, the sealing of the patent was ordered, the Crown ought to be considered satisfied.

In *Siddell* v. *Vickers*, 1888, 5 R. P. C. 426, Cotton, L.J., says: "I do not at all enter into the question of non-conformity, as it is called, of the complete and provisional specification. That is a matter upon which . . . I think it better not to express my opinion. I only mention this, that if the question ever necessarily arises I may be free to deal with the question how far the fact that the complete specification goes beyond the nature of the invention described in the provisional will have the effect under the present law of vitiating the patent. Of course we must have to consider the great alteration in the law made by the Act of 1883." This case was carried to the House of Lords, where the necessity for conformity was affirmed: 7 R. P. C. 303. After this the following cases were decided: *Morgan* v. *Windover*, 1888, 4 R. P. C. 423, 5 R. P. C. 295, in which the question of disconformity was raised but not decided. In *re Goulard* v. *Gibbs*, 1888, 5 R. P. C. 533, the point was again raised, but the decision went on other grounds.

"Disconformity."

The complete specification must therefore not go outside the limits of the title and the provisional specification.

In the Court of Appeal, however (6 R. P. C. 215), the necessity for conformity was affirmed: *Hutchinson* v. *Pattullo*, 1888, 4 R. P. C. 329, 5 R. P. C. 351. In *King, Brown & Co.* v. *Anglo-American Brush Corporation*, 1889, 6 R. P. C. 421, the provisional had described a cylindrical commutator for a dynamo, the complete introduced metal insulated segments to fill up the gaps and make the wear uniform. This was considered too great a departure. The patent was also found to have been anticipated, so that the decision did not go alone upon disconformity. Finally the question came directly before the Court of Appeal in *Nuttal* v. *Hargreaves*, 1891, 8 R. P. C. 450, when it was formally decided that disconformity was still an objection, and accordingly in 1892, in the case of *Lane Fox* v. *The Kensington Co.*, the patent was held bad on this ground: 9 R. P. C. 221. This case was confirmed on appeal: 9 R. P. C. 413. It may be interesting to give a short account of it. With small and fluctuating sources of electricity, there is always some difficulty in arranging incandescent lamps so as to burn well in parallel. For electricity always takes the easiest path. Hence, if one lamp has a greater resistance than another, the greater part of the electricity goes through the lamp of least resistance, and the other is improperly lit. When gas lamps are close together something of a similar effect may be observed. The obvious manner of rectifying these defects, is to improve the lamp construction, and to afford a large reservoir of electricity at a very steady pressure. Before, however, the remedy was seen, the problem was stated as "the dividing the electric light," and in early days the newspapers were full of sensational announcements that some one had "divided the elcctric light." One of the first people who ever saw

CHAP. VII. SECT. 3.

"Disconformity."

The complete specification must therefore not go outside the limits of the title and the provisional specification.

the true nature of the problem and its solution, was St. George Lane Fox.

In his patent of 1878, he pointed out the necessity of forming "reservoirs" of electricity which he accomplished by placing groups of "storage cells" or accumulators at various points of his system. He also invented a form of electrometer, by which when the pressure varied, the steam of the engines was increased or diminished, and the proper pressure was restored. As a matter of fact, his reservoirs also had the effect of regulating the pressure, by the very fact of storing it, just as a large mill pool will steady the action of a mill. But in his provisional specification he did not indicate that he knew of this result, or proposed the accumulation as a means of attaining it. His final specification pointed out that the regulation was to be obtained both by the storage system of accumulators and by his regulating machine, which latter he subsequently disclaimed, leaving his complete specification claiming only the use of accumulators for "regulating" the pressure.

At the trial, the Judge distinguished between the use of secondary batteries "to keep the electromotive force constant in the mains for the benefit of the dynamo," and their use "to regulate the electromotive force in the mains for the benefit of the lamps," *i.e.*, their "storing" effect, as distinguished from their "regulating" effect, and held that, as in his provisional specification he had only described their "storing" effect, he could not, in his complete, turn the invention into one for using them for "regulating." Of the accuracy of the principles of law laid down, there cannot be the slightest doubt: but it may admit of question, whether the words in the provisional, "the electro-motive force of the electric mains

"Disconformity."

The complete specification must therefore not go outside the limits of the title and the provisional specification.

should be kept nearly as constant as possible, say at 100 volts, or B A units of electro-motive force. A number of Plante's lead and sulphuric cells joined together in series between the main and the earth will serve as a reservoir of electricity," were not such as would fairly indicate to a reader skilled in the subject, that the cells were to be used in regulating the pressure as well as for storing the electricity.

In addition, however, to the disconformity, the patent was held bad for want of utility, because it was shewn that in order to charge accumulators, a higher pressure is required than the pressure of discharge, and hence, while the accumulators were being charged, the lamps would be over-driven, unless switches were contrived to shunt off some of the cells, which were not mentioned or described. On the evidence given this certainly appeared so, but, as a fact, accumulators can be used as regulators in this manner, without any switches at all. It was further held that the complete specification did not sufficiently shew how the invention was to be performed. On this point, opinions also might differ, but certainly the description was so vague, as to amount to little more than the emancipation of a "principle," rather than an application of a principle to practice.

This was the chief ground upon which the Court of Appeal supported the decision of the Court below, 9 R. P. C. 416.

ante, p. 49.

In contrast with the above case, *Moseley* v. *The Victoria Rubber Co.*, 1887, 4 R. P. C. 242, may be cited. The patent here was for a process of colour-printing on india-rubber goods coated with farina by means of colours mixed with media, which dissolved the india-rubber. The provisional specification mentioned that the printing

CHAP. VII. SECT. 3.

"Disconformity."

The complete specification must therefore not go outside the limits of the title and the provisional specification.

could be done, but the proper media for mixing the colours were only mentioned in the complete specification. Another objection was, that in the provisional specification the plaintiff had only mentioned the cold roller process of vulcanization, *i.e.*, wetting the fabric with the vulcanizing solution; whereas, in his complete, he described the cold vapour process, and again that whereas the provisional only contemplated printing after the farina had been applied, the complete specification also spoke of applying the farina after the printing. All these criticisms were regarded as not shewing disconformity, but only as legitimate developments of the invention. Disconformity was also held fatal in *Gadd* v. *Mayor of Manchester*, 1892, 9 R. P. C. 259.

These decisions shew the danger of disconformity, and where a patentee is sure that his invention has not leaked out, it may often be wise simply to abandon his provisional, and take out a new patent, filing the complete specification at once, and thus avoiding nonconformity, and obtaining a longer life for his patent (see Chap. XV., sect. 1).

post, p. 237.

4. A provisional specification may perhaps be looked at to assist in explaining the final, but not to cure a defect in it: *Mackelcan* v. *Rennie*, 1862, 13 C. B. (N.S.) 52.—The provisional specification was for a vessel with *iron* framing. The complete left out the word *iron*. Timber framing for docks was old. Held, that the provisional specification could not be used to limit the final, and the patent was bad. (This case may be advantageously compared with *Lister* v. *Norton*, and others collected in the chapter dealing with "Title of a Patent."

5. If needful for its comprehension, the provisional specification must also have drawings attached to it: Patents Act, 1883, s. 5, s-s. 3.

post, p. 442.

6. Abandonment of provisional specification.—This does not involve publication (Patents Act, 1885 s. 4), so that it may be done and a new patent taken out. As is pointed out, Chap. V., sect. 2, user by the patentee under provisional protection does not constitute anticipation, so that if a patentee is doubtful whether his provisional will cover his final he may abandon it, and proceed to take out another patent, filing the complete specification at once if he pleases, and thus running no risk of disconformity: Patents Act, 1885, s. 4; see *Oxley* v. *Holden*, 1860, 30 L. J. C. P. 68, 8 C. B. (N.S.) 666; *Lister* v. *Norton*, 1886, 3 R. P. C. 199. But the danger of filing a complete specification in the first instance is pointed out hereafter.

ante, p. 168.
post, p. 476.
ante, p. 140.
post, p. 237.
post, p. 238.

7. The effect of provisional protection is to prevent public user between the date of the application and the sealing of the patent from invalidating it: Patents Act, 1883, s. 14.

post, p. 447.

CHAPTER VIII.

THE COMPLETE SPECIFICATION.

CHAP. VIII. SECT. 1.

1. General Remarks.—The object of a complete specification is to put the public in possession of the invention. It is sometimes spoken of as the "consideration" or "price paid" for the grant: *e.g.*, *Brunton* v. *Hawkes*, 1821, 4 B. & Ald. 551; *Walton* v. *Potter*, 1841, 1 W. P. C. 595; *Cartwright* v. *Eamer*, 1800, cited 14 Ves. 136; *Gibson* v. *Brand*, 1841, 1 W. P. C. 629. This mode of expression is not strictly accurate; the accuracy of the complete specification is rather the "condition" of the grant, for, strictly speaking, there is no absolute bargain between the Crown and the patentee: *Feather* v. *The Queen*, 1865, 6 B. & S. 285. Formerly, the grant was made subject to the filing of a complete specification. Now, the patent is not sealed till after the complete has been accepted: Patents Act, 1883, s. 12.

post, p. 330.

2. The specification should point out whether the invention be a thing, or process, or a combination.—A patent may be for an article, or for a process of making it, and either the thing invented may be new, or else it may consist of a new addition to old parts, in which case it is called "an improvement," or else it may be a com-

bination of old parts, in which case the essence of the invention is, not the parts, but the mode of combining them.

The specification should point out whether the invention be a thing, a process, or a combination.

3. Claim for a new machine.—If a man "simply claims a machine" without stating that he claims any particular part, or that he claims the combination of the whole as new, then it was formerly held that his patent was to be taken to be a patent for the whole, and for each particular part, and his patent was void if any particular part turned out not to be new, or the combination itself was not new: *Carpenter* v. *Smith*, 1841, 1 W. P. C. 532. This rule is however now relaxed, so that a claim for a machine "as described" would not be held to mean a claim for each individual part of it if the reasonable intendment was that the patent was for the combination of parts forming the machine. Thus in *Peckover* v. *Rowland*, 1893, 10 R. P. C. 234, the patentee claimed "the apparatus as fully set forth and described." The defendant's counsel tried to treat this as a claim for each of the parts, and cited *Carpenter* v. *Smith* and several of the older cases; but Lord Esher decided, p. 237, that it was clearly a claim not for each of the parts, but for the combination of them: see also *Watling* v. *Stevens* 1886, 3 R. P. C. 41, 153.

4. Claim for an improvement on an existing machine.—In this case it is necessary to pick out and specify the improvement; it will not be sufficient merely to describe the improved machine as a whole and claim it: *Parkes* v. *Stevens*, 1869, L. R. 8 Eq. 365; *Hill* v. *Thompson*, 1818, 1 W. P. C. 247. The improvement may be specified by reference to a former specification: *Harmar* v. *Playne*, 1809, 11 East. 101, D. P. C. 311. In *Holmes*

CHAP. VIII. SECT. 4.

Claim for an improvement.

v. *London & N. W. Railway Co.*, 1852, M. P. C. 27, the patentee had claimed "the improved turning-table hereinbefore described," and as he had not claimed this as a combination, it was held that he must be taken to have claimed the parts as well as the whole. Only one of these parts was new. Hence his patent really was for an improved machine, and he ought so to have claimed it, and specified the improvement. His patent was held bad, as not having sufficiently distinguished the new from the old, nor shewn in what his alleged improvement consisted: see also *Potter* v. *Parr*, 1860, 2 B. & S. 216 n., *Cartsburn Sugar Refining Co.* v. *Sharp*, 1884, 1 R. P. C. 181.

ante, p. 53.
post, p. 305.

5. Claim for a combination.—It is obvious how difficult it frequently is to distinguish a claim for an improvement on a machine from a claim for a combination. It is, however, important to do this, because the mode of treating them at law is different. For the gist of a patent for an improved machine is the addition of something new to that which was old, or the substitution of a new part for an old one. But the gist of a combination is the uniting together of old things in a new way. In a patent for an improvement the new part must be clearly distinguished, as explained above, but in a patent for a combination, where once it is made clear that it is not any specific part, but the *combination* which is claimed, it is not necessary to explain what integral parts of the combination may have been previously used separately, or what other combination of them may have been previously made. Many inventions may be looked upon either as "improvements" or as "combinations," according to the point of view from which they

are regarded. And it is obviously often to the patentee's interest to construe his patent as a combination if he can; even though in reality it is rather of the nature of an improvement.

The law with regard to the manner in which a claim for a combination is to be construed has been developed by a series of decisions. In *Foxwell* v. *Bostock*, 1864, 10 L. T. (N.S.) 144, 4 De G. J. & S. 298, Lord Westbury treated a claim for a combination as though it were in fact a claim for an improvement, and therefore laid it down that "in a patent for an improved arrangement, or new combination of machinery, the specification must describe the improvement and define the novelty otherwise, and in a more specific form, than by the general description of the entire machine:" see also *Newall* v. *Elliot*, 1863, 1 H. & C. 797, 10 Jur. (N.S.) 954; *Lister* v. *Leather*, 1858, 8 E. & B. 1004. Although this is perhaps strictly an outcome of the doctrine that the *invention*, and not merely the machine, must be described, yet in the case of a combination, if more were required than to specify the combination and claim it, it is obvious that it would be needful to go into all the various other sorts of combinations of the same things that had been made, and distinguish them. This would be most embarrassing, and the theory that it is necessary became so impossible in practice, that the doctrine soon afterwards was modified (*per* Cairns, L.C.): *Harrison* v. *Anderston Foundry Co.*, 1876, L. R. 1 App. Cas. 577. In that case Lord Hatherley said that Lord Westbury's decision in *Foxwell* v. *Bostock* only meant that, if you specifically claim an improvement on some specific machine which you name, you must specify your improvement. "To use an illustration which was adopted by Lord Justice James (in

CHAP. VIII. SECT. 5.

Claim for a combination.

Parkes v. *Stevens*, 1869, L. R. 8 Eq. 365), 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." Again, in *Clark* v. *Adie*, 1877, Lord Hatherley said, "I apprehend, my lords (and I do not read the decision in *Foxwell* v. *Bostock* as deciding more than I am stating), you must inform the public . . . whether you have subdivided, if I may use the term, your machine into those separate parts, and claim for each part the merit of novelty, or whether you are simply making a combination of things *per se* old, but which have never been used before in combination."

Lord Justice James, in the same case, corrected the supposed doctrine (in *Lister* v. *Leather*), that a combination patent could be read as claiming the parts as well as the combination. In *Moore* v. *Bennett*, 1884, 1 R. P. C. 138, a revival of *Foxwell* v. *Bostock* was attempted by Cotton, L.J., who thought that, where *an improved* combination was made, it would be necessary to specify the improvement. This theory certainly seemed to have strict logic on its side, but it was not approved in the House of Lords, where (p. 149) Lord Blackburn explained Lord Westbury's decision in *Foxwell* v. *Bostock*, and said: "If that principle were applied to specifications, it would, I think, make it impossible to draw a good specification for a combination of old materials without such a degree of prolixity as would render it practically impossible. That, if it had been logically and clearly followed, would certainly make it impossible to have a good patent for a combination." The Court, while affirming the decision on other grounds, expressly disapproved it on the point above mentioned (p. 152).

Claim for a combination.

In *Rowcliffe* v. *Morris*, 1885, 3 R. P. C. 17, the patentee had described his invention as consisting of four things, but had not clearly claimed the combination of them, thus leaving it doubtful whether it was a combination he was claiming, or the whole machine, or some parts of it. Bristowe, V.-C., after an exhaustive review of *Foxwell* v. *Bostock* and the succeeding cases, decided on this ground against the patent. A similar defect was held fatal in *Fairburn* v. *Household*, 1886, 3 R. P. C. 128. On the other hand (*Watling* v. *Stevens*, 1886, 3 R. P. C. 41, 153), in a patent for an improved tipping-waggon, the claim was the construction of the tipping-waggon substantially as described; it was suggested that this was a claim of the individual parts. The Court, however, considered that in substance it was a claim for a combination, and the patent was supported. In *Procter* v. *Bennis*, 1887, 36 Ch. D. 740, 4 R. P. C. 333, a patent for a mechanical stoker claimed "the employment of certain lappets and springs, in combination with certain doors, for the purposes described. It was agreed that the portions which were new were not pointed out, but Cotton, L.J., said (p. 351): "When a combination is claimed to be an invention, if that combination is new, it is immaterial on the question of the insufficiency of the specification and the validity of the patent, that the patentee should point out how far he does or does not claim particular portions"; and Bowen, L.J., says: "When a combination, and nothing more, is claimed, the combination being the novelty, it is immaterial that the patentee should point out how far he claims the particular portions which go to make up the combination. Those portions are not his claim, but it is the putting them together and combining them that constitutes his claim": see also (*per* Lord

CHAP. VIII. SECT. 5.

Claim for a combination.

Watson) in *Kaye* v. *Chubb*, 1888, 5 R. P. C. 649. The specification must make it clear, in words or otherwise, that it is a *combination* that is being claimed, and not an improvement. It is not, however, needful that the exact word "combination" should be used, if it is clear that it is a combination which is really the gist of the invention: *United Telephone Co.* v. *Harrison*, 1882, L. R. 21 Ch. D. 720, 51 L. T. Ch. 705.

6. A complete specification must particularly describe and ascertain (1) the nature of the invention; (2) in what manner it is to be performed; and (3) must be accompanied with drawings if required:

post, p. 441.

Patents Act, 1883, s. 5, s-s. (4).

"The public, on the one hand, have a right to expect and require that the specification shall be fair, honest, open, and sufficient; and, on the other hand, the patentee should not be tripped up by captious objections" (*per* Alderson, B.): *Morgan* v. *Seaward*, 1836, 1 W. P. C. 174; see also *Neilson* v. *Thompson*, 1841, 1 W. P. C. 283; *Holmes* v. *London & N. W. Railway Co.*, 1852, M. P. C. 16; *Hills* v. *London Gas Co.*, 1860, 5 H. & N. 340; *Thomas* v. *Welch*, 1866, L. R. 1 C. P. 201; *Bray* v. *Gardner*, 1887, 4 R. P. C. 402; *Newbury* v. *James*, 1817, 2 Mer. 451, 1 C. P. C. 368. A specification for preserving animal substances described how to make certain solutions numbered 1, 2, 3, 4. It then proceeded to describe how to use 2, 3, 4, but left it uncertain what was to be done with 1. Held, a fatal defect: *Bailey* v. *Roberton*, 1878, L. R. 3 App. Cas. 1055; *R.* v. *Metcalf*, 1817, 2 Stark. N. P. 249, 1 W. P. C. 141 n. "These two requirements, the description of its nature, and also of the mode of performing it, must both be fulfilled" (*per*

post, p. 302.

A complete specification must particularly describe and ascertain (1) the nature of the invention; (2) in what manner it is to be performed; and (3) must be accompanied with drawings if required.

Best, J.) : *Brunton* v. *Hawkes*, 4 B. & Ald. 556. In *Philpot* v. *Hanbury*, 1885, 2 R. P. C. 38, Grove, J., pointed out the distinction between describing what an invention is, and shewing how it is to be performed, and laid it down that both must be done : see also *Edison* v. *Holland*, 1889, 6 R. P. C. 243; *Morton* v. *Middleton*, 1863, 1 Ct. Sess. Cas. 3rd ser. 721.

7. The subject matter must be proper, and there must be utility, ingenuity, and novelty in the sense of absence of anticipation : see those various headings, Chaps. I., II., III., V.

8. If a provisional specification has preceded it, the complete must conform to it and the title : see "Title," Chap. VI., and "Provisional Specification," Chap. VII., sect. 3. *ante*, p. 170.

9. If the specification fail in a material part from any defect, the whole patent falls (*per* Bayley, J.) : *Brunton* v. *Hawkes*, 1821, 4 B. & Ald. 551; *Morgan* v. *Seaward*, 1836, 2 M. & W. 544, 1 W. P. C. 170, and see further, Chap. I., sect. 8. *ante*, p. 60.

10. The specification must be clear and unambiguous : *Galloway* v. *Bleaden*, 1839, 1 W. P. C. 524; *Campion* v. *Benyon*, 1821, 6 B. & Moo. 71, 3 B. & B. 5. "It is incumbent on the patentee to give the specification of the invention in the clearest and most unequivocal terms of which the subject is capable" (*per* Ashurst) : *Turner* v. *Winter*, 1787, 1 W. P. C. 77. If in the invention it is needful to use some special kind or sort of an article, it is not enough simply to direct the article to be used

CHAP. VIII. SECT. 10.

The specification must be clear and unambiguous.

without directing attention to the variety of the article which it is needful to employ. Thus, where a patent for grinding meal directed rollers to be covered with "china," and it was shewn that all china would not do, but only a special kind of oriental china, the patent was held bad for ambiguity: *Wegman* v. *Corcoran*, 1878, L. R. 13 Ch. D. 65, 83, 39, L. T. (N.S.) 563, 41 L. T. (N.S.) 358; see also *Ellington* v. *Clark*, 1888, 5 R. P. C. 327.

In *Hastings* v. *Brown*, 1853, 1 E. & B. 450, 22 L. J. Q. B. 161, a patent for "a windlass intended to hold *a* cable of any size" was held bad, as it did not explain whether or not the same windlass would hold different sized cables, or whether different windlasses would be required; and in *Bloxam* v. *Elsee*, 1825, 1 C. & P. 558, 6 B. & C. 169, a similar objection was upheld.

ante, p. 164.

11. The specification must clearly distinguish what is claimed as new from what is represented as old.—In *Manton* v. *Manton*, 1 C. P. C. 278, D. P. C. 349, Gibbs, C.J., said: "It is necessary that the patentee should shew that he has accurately explained the nature of his invention, separating that which is new from that which is old." "It is essential to point out that which is new from that which is old": *Macfarlane* v. *Price*, 1816, 1 W. P. C. 74, 1 Stark. 199; *Gibson* v. *Brand*, 1842, 1 W. P. C. 640. "In a combination patent, as has been shewn, sect. 5, when the combination is claimed, that is understood to be the new thing, and nothing else is considered as alleged to be new by the patentee.

ante, p. 180.

12. The specification must distinguish the useful from the useless: *Easterbrook* v. *G. W. Railway Co.*, 1885, 2 R. P. C. 210. In this case the patentee repre-

The specification must distinguish the useful from the useless.

sented that a new apparatus for railway-signalling was useful in all cases. It turned out to be useless if used in a particular way. The patent was held bad, on the authority of *The Badische Anilin Fabrik* v. *Levenstein*, 1883, L. R. 29 Ch. D. 366.

13. The specification, in claiming a thing as an improvement, need not necessarily explain why it is an improvement: *Neilson* v. *Thompson*, 1841, 1 W. P. C. 283.

14. It is not needful to describe any obvious or well-known step in the process: *Boulton* v. *Bull*, 1795, 2 H. Bl. 497; *Morgan* v. *Seaward*, 1836, 1 W. P. C. 176; *Heath* v. *Unwin*, 1852, 2 W. P. C. 245; *Crossley* v. *Beverley*, 1829, 3 C. & P. 513, Moo. & Mal. 283, 1 W. P. C. 106; *Derosne* v. *Fairie*, 1835, 5 Tyrr. 393, 1 W. P. C. 158.

15. Nor is it necessary formally to disclaim what is obviously old.—"There are some things so old and well-known that it is not necessary for a patentee to say, 'I do not claim them.' If he mentions a wheel, or an inclined plane, or a screw, he is not bound to disclaim each of those well-known mechanical instruments" (*per* Fry, L.J.): *Watling* v. *Stevens*, 1886, 3 R. P. C. 147. "If a patentee had occasion to introduce a hinge into his machinery, it would be absurd for him to point out that the hinge is not new": *Haworth* v. *Hardcastle*, 1834, 1 W. P. C. 484; *Tetley* v. *Easton*, 1853, M. P. C. 88.

16. A patent is not vitiated by reason of the claim of some non-material part which turns out not to be useful, in the absence of deceit or misrepresentation: *Lewis* v. *Marling*, 1829, 1 W. P. C. 495; but it is

Compare post, p. 198.

CHAP. VIII. SECT. 16.

otherwise if that part is material: *R.* v. *Cutler*, 1849, M. P. C. 137, 14 Q. B. 372 n.

17. It is not necessary to describe every known method, nor every known substance, for performing the invention; general words may be introduced where no ambiguity is caused.—Thus, "gunpowder or other proper combustible matter," would be sufficient if those conversant with the trade would not be misled: *Bickford* v. *Skewes*, 1841, 1 Q. B. 948, 1 W. P. C. 218.

18. It is not necessary to describe what is in reality the best method, or the best proportions, if what is described is useful, and the patentee describes the best he knows of: *Macnamara* v. *Hulse*, 1842, C. & M. 471; *Patent Type Co.* v. *Richards*, 1859, 1 John. 381, 6 Jur. (N.S.) 39; *Thomson* v. *Batty*, 1888, 6 R. P. C. 84; *Neilson* v. *Harford*, 1841, 1 W. P. C. 318; *Otto* v. *Linford*, 46 L. T. (N.S.) 35.

post, sect. 21, p. 191.

19. The specification must be intelligible to an ordinary workman who understands the subject-matter without further experiment, or seeing it tried: *R.* v. *Arkwright*, 1785, 1 W. P. C. 66, D. P. C. 106; *Arkwright* v. *Nightingale*, 1785, 1 W. P. C. 60, D. P. C. 37; *Hornblower* v. *Boulton*, 1799, 8 T. R. 100, D. P. C. 277; *Harmar* v. *Playne*, 1809, D. P. C. 318. The specification must always be sufficiently clear to enable the machine to be made from it: *Otto* v. *Linford*, 1881, 46 L. T. (N.S.) 44. The specification is not addressed to a person unskilled in the kindred arts: *Manton* v. *Manton*, 1815, D. P. C. 349; *Sturtz* v. *De la Rue*, 1828, 5 Russ. 327; *Galloway* v. *Bleaden*, 1839,

The specification must be intelligible to an ordinary workman who understands the subject-matter without further experiment, or seeing it tried.

1 W. P. C. 524; *Elliot* v. *Aston*, 1840, 1 W. P. C. 224; *Foxwell* v. *Bostock*, 1864, 10 L. T. (N.S.) 147. It is addressed to artists of competent skill in the branch of manufacture to which it relates: *Bickford* v. *Shewes*, 1841, 1 Q. B. 938, 1 W. P. C. 214, 10 L. J. Q. B. 302; *Household Co.* v. *Neilson*, 1842, 1 W. P. C. 676. "Certainly the patentee does not satisfy the law if he says men of the highest science, first-rate engineers, could understand him." "The specification is not addressed to a person who is determined to misunderstand, but to one who is willing to understand": *Beard* v. *Egerton*, 19 L. J. C. P. 36, 8 C. B. 165. "It is plain that the specification of a patent is not addressed to persons who are ignorant of the subject-matter. But there are various kinds of persons who know something about it. If it is a mechanical invention, you have first of all scientific mechanicians of the highest 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 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, 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 first two classes,

CHAP. VIII. SECT. 19.

The specification must be intelligible to an ordinary workman who understands the subject-matter without further experiment, or seeing it tried.

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, 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" (*per* Jessel, M.R.): *Plimpton* v. *Malcolmson*, 1876, L. R. 3 Ch. D. 568, followed in *Bray* v. *Gardner*, 1887, 4 R. P. C. 40; see also *Badische Anilin Fabrik* v. *Levinstein*, 1887, 12 App. Cas. 710, 4 R. P. C. 463, and *Cassella* v. *Levinstein*, 1891, 8 R. P. C. 475. The evidence of a workman as to what he can understand is relevant to enable the Court to say whether the specification is sufficient: *Edison* v. *Woodhouse*, 1887, 3 R. P. C. 183, 4 R. P. C. 99.

20. No further experiments must be needful in order to enable the invention to be worked: *R.* v. *Wheeler*, 1819, 2 B. & Ald. 353; *Neilson* v. *Harford*, 1841, 1 W. P. C. 341; *Macnamara* v. *Hulse*, 1842, 1 C. & M. 471, 2 W. P. C. 129; *Muntz* v. *Foster*, 1844, 2 W. P. C. 109; *Stevens* v. *Keating*, 1847, 2 W. P. C. 175, 19 L. J. Ex. 57; *Hinks* v. *Safety Lighting Co.*, 1876, [illegible] R. 4 Ch. D. 616; *British Dynamite Co.* v. *Krebs*, 1879, 1 Good. Pat. Cas. 91; *Gandy* v. *Reddaway*, 1885, 2 R. P. C. 49. In *Edison* v. *Holland*, 1889, 5 R. P. C. 459, 6 R. P. C. 243, at p. 278, Cotton, L.J., expressed an opinion that when an invention is new, or delicate, some small degree of experiment may frequently be necessary, however clear the specification may be.

21. The inventor in his specification must disclose the best method with which he is acquainted, and must keep nothing back which it would be of advantage to the public to know. This important rule is often neglected by ignorant inventors, who sometimes keep back a portion of their invention, or at least pretend to have done so, so as to endeavour to get employment in teaching it to those who have purchased a right to use it. By this foolish conduct, they put it into the power of anyone who hears them to destroy their patent. In *Wood* v. *Zimmer*, 1815, Holt. N. P. 58, 1 W. P. C. 82, the patentee used secretly to put aquafortis into the boiler in making verdigris by a process which he patented. The effect of this was simply to save labour, but he did not disclose it. Held fatal: see also *R.* v. *Arkwright*, 1785, 1 W. P. C. 66, D. P. C. 61; *Bovill* v. *Moore*, 1816, D. P. C. 400; *Morgan* v. *Seaward*, 1836, 1 W. P. C. 174; *Neilson* v. *Harford*, 1841, 1 W. P. C. 320. The inventor's best knowledge should be given up to the time of sending in the complete specification: *Crossley* v. *Beverley*, 1829, 1 W. P. C. 117; *Jones* v. *Heaton*, 1 W. P. C. 404 n. It was objected, in *Edison* v. *Woodhouse*, 1886, 3 R. P. C. 167, 4 R. P. C. 79, that the patentee had not revealed all he knew in the final specification, because it was shewn that, prior to sending it in, and after the provisional, he had taken out another provisional specification shewing improvements. It was held, that as he had given all he knew to the world, his complete specification could not be impugned on the ground of bad faith.

If a man knows that he can make the article for which the patent is granted with cheaper materials than those which he has enumerated in the patent, although the

CHAP. VIII. SECT. 21.

The inventor in his specification must disclose the best method with which he is acquainted.

latter will answer the purpose equally well, the patent is void (*per* Buller, J.): *Turner* v. *Winter*, 1787, 1 W. P. C. 81. A patentee who had taken out a patent for making brown bread, was proved to have given directions of a special nature as to how to bake it, which were very essential to the clearness of the specification, but which directions he had not revealed. Patent held bad: *Pooley* v. *Pointon*, 1885, 2 R. P. C. 172; see also *Walton* v. *Bateman*, 1842, 1 W. P. C. 622; *Tetley* v. *Easton*, 1852, M. P. C. 70; *Heath* v. *Unwin*, 1852, 2 W. P. C. 248.

In the case of a communicated invention, the importer who takes out the patent is, for the purposes of this rule, the patentee. Hence, he is the person who must communicate all he knows: *Plimpton* v. *Malcolmson*, 1876, 3 Ch. D. 570; *Wegman* v. *Corcoran*, 1879, L. R. 13 Ch. D. 65. But where a foreign inventor has a patent taken out in the name of his agent in England, for his own advantage, it is submitted that he would not be allowed fraudulently to withhold information, and still reap the benefit of the patent, by insufficiently instructing his agent in the method of performing the invention.

The specification must not contain any misleading or false statements or suggestions.

giving the names of the ingredients, all of which were well known, viz., Rochelle salt, carbonate of soda, and tartaric acid, went on *ex abundanti cautelâ*, to explain how to make all those ingredients. Held, that by so doing he had misled the public into thinking they could not make the powders out of the common commercial substances named. Patent held bad. A patent which described how to make a certain glaze of size and the "finest and purest chemical white lead," was held bad on the ground that the substance which would ordinarily be bought in London under that name would not answer: *Hurtz* v. *De la Rue*, 1828, 5 Russ. 327, 1 W. P. C. 83.

Where a patentee said that he used cloths "of any suitable material, but I *prefer* it to be made of linen warp, and woollen weft," and in evidence it was proved that he had tried other materials and failed with all except these; held, his expression always quoted was misleading, for he ought to have warned the public against the use of other materials which his specification was an invitation to try: *Thompson* v. *Winton*, 1838, Thom. & J. 132, 1 W. P. C. 66, 1 P. C. 202. It is not

CHAP. VIII. SECT. 23.

An error, obvious on the face of the specification, and which any workman would at once correct without further experiment, would not vitiate a patent.

Gandy v. *Reddaway*, 1883, 2 R. P. C. 52 (*per* Brett, M.R.). Where a specification directed the use of a "carbon gas or liquid," and it was shown that some carbon gases and liquids would not do, it was held no defect, because the specification sufficiently showed what were the particular sorts of carbon gases or liquids referred to: *Edison* v. *Woodhouse*, 1887, 4 R. P. C. at p. 107; compare this with *Stevens* v. *Keating*, 1848, 2 W. P. C. 104 (*post*, p. 209).

The doctrine is further exemplified in *Beard* v. *Egerton*, 1849, 8 C. B. 105, 13 Jur. 1004, 19 L. J. C. P. 30. The Court must have been desirous to sustain this patent, for it was for the daguerreotype process of photography, and exhibited great ingenuity and novelty. By inadvertence, however, in the specification it was said that you were to clean the silver plate with acid and pounce just before the moment of using the plates in the camera. This was obviously absurd, for it would have destroyed the sodium coating of silver upon which the light acted to take the pictures. All that was really meant was that the plates were to be well cleaned before sodizing, which was always just before putting the plate in the camera, and the Court held that anyone could so understand it. Patent specifications are "instruments of specification,"

post, p. 209

Thorp, *N.*, *post*, 1; *Sea also Hopkinson* v. *St. James Electric Light Co.*, 1882, 20 R. P. C. 77, 81, 101; *Miller* v. *Beard*, 1885, 22 R. P. C. 201,

CHAPTER IX.

THE CLAIMS.

1. The nature, functions, and objects of claims.—By the Patents Act, 1883, s. 5, s-s. 5, every specification should end with a distinct statement of claim or claims. This rule is, however, merely directory, and if the patent is passed by the officials, the absence of a distinct claim will not invalidate a patent: *Siddell* v. *Vickers*, 1887, 5 R. P. C. 432, L. R. 30 Ch. D. 62. It has been decided, that provided there is a claim or claims at the end of a patent, the question of nonconformity with the provisional specification ought not to be raised by the officials at the Patent Office, provided that such claim are correct in form, and not a mere redundant evasion (as, for example, to say, "I claim what I have described"): *Smith's Patent*, post, p. 213. Cleft, 2018, "The object of a claim is pointed out by Lord Cottenham in *Hill* v. *Marshall*, 1833, 2 W. P. C. 511, 1 My. & Cr. 511, to be for the patentee's protection, to define and limit his invention. It is in reality a distinct (per Jessel, L.J.): *Plimpton* v. *Spiller*, L. R. 6 Ch. D. 412. In practice the Patent Office officials do not trouble themselves with claims, but leave the applicant to make those things on the patent which they think, [illegible] purpose and "Invention," by A. Jessup, Barrister-at-Law [illegible] Patent Agents, vol. II, 1891.

CHAP. IX. SECT. 2.

2. Everything not claimed must be considered as expressly disclaimed, and hence open to the public: *Harrison* v. *Anderston Foundry Co.*, 1876, L. R. 1 App. Cas. 581; *United Telephone Co.* v. *Harrison*, 1882, L. R. 21 Ch. D. 741; *Jackson* v. *Wolstenhulmes*, 1884, 1 R. P. C. 108; *Lucas* v. *Miller*, 1885, 2 R. P. C. 159; *Easterbrook* v. *G. W. Railway Co.*, 1885, 2 R. P. C. 208.

ante, p. 179.

3. Claims must be unambiguous and clear: *Tetley* v. *Easton*, 1853, M. P. C. 87; *Hinks* v. *Safety Lighting Co.*, 1876, 4 Ch. D. 612; and must state the limits and scope of the invention distinctly. Thus, it will not do to say: "What I claim is the general construction of the several parts . . . as herein set forth." This is not a "distinct" statement, and though it may not make the patent bad, it may greatly be prejudiced: *Siddell* v. *Vickers*, 1888, 5 R. P. C. 433, affirmed 7 R. P. C. 292. A claim is not intended to be a description, but only a marking out of the invention; hence, "expressions are permissible in claims which would be too general if they professed to be part of the description" (*per* Cottenham, L.C.): *Kay* v. *Marshall*, 1836, 2 W. P. C. 39. And a certain latitude is permissible, when the nature of the subject demands it. Thus, a patent for type-metal composed of seventy-five parts of tin and twenty-five of antimony was not held bad on account of its being stated in the claim "that these proportions might be to a certain extent varied": *Patent Type-founding Co.* v. *Richards*, 1860, 1 John. 381.

4. In interpreting the claims, the description in the specification must be looked at: *Heath* v. *Unwin*, [illegible], 5 H. L. Cas. 505, 25 L. J. C. P. 20.

5. A claim of "every method by which a thing can be done" would not be sufficiently specific.—"To claim every method would be equivalent to claiming a principle" (*per* Alderson, B.): *Neilson* v. *Harford*, 1841, 1 W. P. C. 355. A patent related to a method of making gas from seeds. "We are also of opinion that the claim is too large, and cannot be supported. It is a claim to make gas direct from seeds, not in any mode pointed out in the specification, but generally . . . we think that the plaintiff's second patent was not for any particular mode of doing it, but for the doing it by any method; and we think that even if it had been new (which it turns out not to be), such a mode of specifying and claiming the invention cannot be sustained as a good specification" (*per* Pollock, C.B.): *Booth* v. *Kennard*, 1856, 1 H. & N. 527, 2 H. & N. 84. In *Wyeth* v. *Stone* an American patentee had said: "I claim every mode of cutting ice except by human power." Lord Hatherley called this "a preposterous claim": *Arnold* v. *Bradbury*, 1871, L. R. 6 Ch. 711, in which case the claim, though wide, was supported; see also *Tetley* v. *Easton*, 1852, M. P. C. 71 (*per* Pollock, C.B.).

see p. 48.

6. When a claim is clear and distinct for a substantial object, or part of an invention, the patentee will be held to it, and not allowed to depart from it, either for the purpose of restricting it, so as to save his patent, nor, on the other hand, to expand it, so as to cover an infringement. This rule depends upon the principle that a patentee's claims define what he represents he has invented. We shall hereafter see that, in the case of a genuine invention, every effort will be made by the Courts to support it, where the language admits of it; but where

CHAP. IX. SECT. 6.

When a claim is clear and distinct for a substantial object, or part of an invention, the patentee will be held to it.

post, p. 203.

a claim is distinct, it cannot be departed from. Of course the claim will be read so as to cover not only precisely what is specifically claimed, but also all that can fairly be described as coming within the scope of the invention. No patentee will be held so exactly to what he has claimed, as to protect him from nothing but exact imitations of his machine. For otherwise a patent would be useless. But he will not be allowed to play fast and loose with his claims, or to adopt that construction of them which happens at the moment to be convenient. And his patent must stand or fall, not by what he meant, but by what he has said: *Hill* v. *Thompson*, 1817, 1 W. P. C. 237; *Minter* v. *Mower*, 1835, 1 W. P. C. 142; *R.* v. *Else*, 1785, 1 W. P. C. 76; *Gibson* v. *Brand*, 1842, 1 W. P. C. 634; *Heath* v. *Unwin*, 1855, 25 L. J. C. P. 12, 5 H. L. C. 505, 16 C. B. 713; *Bloxam* v. *Elsee*, 1827, 6 B. & C. 169; *Jordan* v. *Moore*, 1866, L. R. 1 C. P. 624; see also *Cropper* v. *Smith*, 1884, 1 R. P. C. 87; *Clark* v. *Adie*, 1873, 2 App. Cas. 315; *Britain* v. *Hirsch*, 1888, 5 R. P. C. 229, cited in the next section.

7. Where, however, a claim may be read as merely auxiliary or subordinate, this will be done in order to save the patent.—This rule depends on the principle of beneficial construction (see Chap. XI., sect. 1). "If the claim to the material can be substantiated by the patent, the specification of a particular user of it comprehended in the general area claimed, cannot for a moment be accepted as a ground for vitiating the patent" (*per* Westbury, L.C.): *Betts* v. *Neilson*, 1871, 5 H. L. C. 21. In *Plimpton* v. *Spiller*, 1876, 6 Ch. D. 426, one of the claims was for "a mode of holding runners" by bolting them between pieces of wood. The

post, p. 201.

ante, p. 187.

idea of holding a thing by bolting it between pieces of wood is of course as old as the hills, but the patent was saved by treating the claim as merely subsidiary to the claims for the runners themselves.

CHAP. IX. SECT. 7.

Where, however, a claim may be read as merely auxiliary or subordinate, this will be done in order to save the patent.

In *Frearson* v. *Loe*, 1878, L. R. 9 Ch. D. 48, Jessel, M.R., held "that it is not because an inventor thinks that he has invented more than he really has, that his claims must be upset, *if they can be limited so as to save his invention.*" This view was in the next year carried further. An inventor had patented dynamite, which consists of dry clay soaked in nitro-glycerine. It was well known at the date of the patent that all explosives of the "fulminating" kind, in order to explode violently, must either be strongly confined, or else fired with a detonator. The patentee claimed, first, the manufacture of dynamite, secondly, the method of firing the same by special ignition (*i.e.*, by confinement or by a detonator). It was argued that as those modes of firing fulminating explosives were old, the patent was bad. Fry, J., however, supported it. His judgment was reversed by the Court of Appeal, but restored by the House of Lords, who considered that the means of using the new substance was really essential to it, and part of it, and that the claim might be regarded as "appendant" to the claim for the dynamite: *British Dynamite Co.* v. *Krebs*, 1879, 1 Good. P. C. 88; see also *Oxley* v. *Holden*, 1860, 8 C. B. (N.S.) 666, Judgment of Erle, C.J.

On the other hand, none of these cases can prevent a *clear* claim for a subordinate part of an invention being held, either for good or ill, to be binding on the patentee. He may claim the combination of A, B, C, and D, and in addition a sub-combination of A and B, and in addition he might claim C and D separately. If, however, he

CHAP. IX. SECT. 7.

Where, however, a claim may be read as merely auxiliary or subordinate, this will be done in order to save the patent.

does so clearly, and makes them into distinct claims, he will be bound by them, and they cannot be read as auxiliary: *Clark* v. *Adie*, 1877, 2 App. Cas. 320, and *Cropper* v. *Smith*, 1884, 1 R. P. C. 87. The cases of *Plimpton* v. *Spiller*, *Frearson* v. *Loe*, and the *British Dynamite Co.* v. *Krebs*, must, therefore, be considered as proceeding upon the principle of beneficial construction adopted where possible in order to save the patent. The distinction between such cases and *Clark* v. *Adie* was pointed out by Cotton, L.J., in *Britain* v. *Hirsch*, 1888, 5 R. P. C. 229. "If," said he, "in the *British Dynamite Co.* v. *Krebs*, the House of Lords had found the words 'What I claim is a *new cap* for the purposes of igniting,' I think they could not reasonably have come to the conclusion, to which, indeed, they did come, on the words of that specification." See also *Pether* v. *Shaw*, 1893, 10 R. P. C. 293.

CHAPTER X.

THE DRAWINGS.

1, Drawings are to be attached to specifications if required: Patents Act, 1883, s. 5, s-s. 4, s. 6; and if they have been attached to the provisional specification, they may be referred to in the complete: Patents Act, 1886, s. 2; P. Rules, 1890, r. 30–33. The rules regarding drawings are framed with a view of making them uniform in size and pattern, and of facilitating their reproduction by photolithography. They are sometimes very rough. It is, however, better to make them carefully, for in a patent action the Court may be apt to think slightly of a patent which the inventor has not troubled himself to draw with accuracy and neatness.

post, p. 442.

post, pp. 477, 489.

2, Drawings are to be taken as part of the specification: *Morgan* v. *Seaward*, 1836, 1 W. P. C. 173; and examined in connection therewith: *Morton* v. *Middleton*, 1863, 1 Ct. Sess. 3rd ser. 722. They may be used to explain the specification, and a description consisting of a drawing alone might even be sufficient: *Poupard* v. *Fardell*, 1869, 18 W. R. 129, overruling *Ex parte Fox*, 1812, 1 V. & B. 67, 1 W. P. C. 431; see also *Foxwell* v. *Bostock*, 1864, 4 De Gex. J. & S. 303, 10 L. T. (N.S.) 146. In *Brunton* v. *Hawkes*, 1820, 1 C. P. C. 410, Abbot, C.J.,

CHAP. X. SECT. 3.

Drawings are to be taken as part of the specification.

says: "If a drawing or figure enables a workman of ordinary skill to construct the improvement, it is as good as any description": see also *Bloxam* v. *Elsee*, 1825, 1 C. & P. 564. Drawings may also explain an ambiguity in the description: *Hastings* v. *Brown*, 1853, 1 E. & B. 454; *Daw* v. *Eley*, 1867, L. R. 3 Eq. 500 n., 14 W. R. 126; *Miller* v. *Scarle Barker & Co.*, 1893, 10 R. P. C. 106.

3. It is not sufficient for a patentee to shew an important part of his patent in a drawing if he does not call attention to it in the description: *Fairburn* v. *Household*, 1886, 3 R. P. C. 267; *Clark* v. *Adie*, 1877, 2 App. Cas. 315; and mere inference from the drawings cannot control the clear language of the specification: *Stewart* v. *Briggs*, 1883, 11 Ct. of Sess. Cas. 4th ser. 236.

4. The drawings need not be well executed if they satisfy the requirements of the Patents Acts and Rules.—It is enough if they enable a competent workman to understand them: *Bovill* v. *Moore*, 1816, D. P. C. 369. They ought to have a scale where needful to explain the invention: *Morton* v. *Middleton*, 1863, 1 Ct. Sess. Cas. 3rd ser. 724. A drawing which is obviously erroneous may be corrected by reference to the specification: *Otto* v. *Linford*, 1881, 46 L. T. (N.S.) 40.

5. Anticipation by drawings.—A drawing without a description may be an anticipation.

ante, p. 158.

6. If the provisional specification has a drawing, reference to it may be made in the complete specification, and no new drawing is needful: Patents Act, 1886, s. 2.

post, p. 242.

post, p. 477.

CHAPTER XI.

CONSTRUCTION OF SPECIFICATIONS.

1. The beneficial construction.—The construction of specifications has been the subject of many decisions, which, when examined, shew no contradiction of principle, though the mode in which the principle is expressed differs. The rules of construction are three: (1) That the ordinary meaning of words is to prevail; (2) Subject to expert evidence to explain technical terms, (3) That where it is possible to give two different constructions to a specification, then, if it can be done without a violation of the words, such a construction should be given as will support the patent. *see ante*, p. 198.

Patents in old law were, like all grants, construed most strongly against the grantee, and upset upon the smallest suggestion that the full consideration for them had not been given, or that the Crown had been deceived. In order to try and avoid this harsh construction, it was usual to insert in the recitals the words, "Ex mero motu et certa scientia," which were held in *R.* v. *Mussary*, 1738, Bull. N. P. 76 a., 1 W. P. C. 41, "to occasion the grant to be taken in its most liberal and beneficial sense." In addition to this, a clause used to be (and still is) inserted, that "the patent should be considered to be most available" for the patentee: 1 W. P. C. 26 (see *ante*, p. 15. *ante*, p. 13. *post*, p. 265,

CHAP. XI. SECT. 1.

The beneficial construction.

Chap. XVII., sect. 7). In accordance with these principles, a beneficial interpretation has always been given to patents, although at one time, viz., before 1830, the Courts were stricter in construing them: *Neilson* v. *Harford*, 1841, 1 W. P. C. 310 (*per* Parke, B.).

But though they were once very strictly applied, the general principles in favour of a beneficial construction have always been admitted, as appears from the following cases, which, however, are now of less importance, because more recent cases, to be presently cited, have amplified and explained them: *Boulton* v. *Bull*, 1795, D. P. C. 212; *Hullett* v. *Hague*, 1831, 2 B. & Ad. 377; *Haworth* v. *Hardcastle*, 1834, 1 W. P. C. 485; *Russell* v. *Cowley*, 1835, 1 W. P. C. 470; *Minter* v. *Mower*, 1835, 1 W. P. C. 141; *Bickford* v. *Skewes*, 1841, 1 Q. B. 950, 1 W. P. C. 219; *Neilson* v. *Harford*, 1841, 1 W. P. C. 372 (followed in *Edison* v. *Holland*, 1888, 5 R. P. C. 474); *Household Co.* v. *Neilson*, 1843, 1 W. P. C. 679; *Elliot* v. *Turner*, 1845, 2 C. B. 446, 15 L. J. C. P. 49; *Newton* v. *Grand J. Rail Co.*, 1845, 5 Ex. 335, 20 L. J. Ex. 427 n.; *Stevens* v. *Keating*, 1848, 2 W. P. C. 187; *Sellers* v. *Dickinson*, 1850, 5 Ex. 324; *Tetley* v. *Easton*, 1852, M. P. C. 74; *Palmer* v. *Wagstaffe*, 1854, 9 Ex. 501.

The words "of our especial grace, certain knowledge, and mere motion" always remained, and still remain, in the form of the patent. In the form prior to 1852 a clause was inserted validating the patent, "notwithstanding the not full and certain describing the nature and quality of the said invention": Hindmarch, p. 628. After the Patents Act of 1852, however, that form was altered, and then stood, "shall be taken, construed, and adjudged in the most favourable and beneficial sense for the best advantage of the patentee": see forms at the

The beneficial construction.

end of Patents Act, 1852. In form D, attached to the Patents Act of 1883, and which, with slight modification, is now in use, the words "of our especial grace, certain knowledge, and mere motion" are retained, as also "that these our letters patent shall be construed in the most beneficial sense for the advantage of the said patentee."

The Courts have always endeavoured to give force to the words of favourable construction contained in the grant. This was at one time known as the benevolent construction, a term which is now in disfavour, and which has been replaced by the term "beneficial" construction. The following cases, from the year 1864 to the present time, exemplify this:—

Simpson v. *Holliday*, 1864, 20 Newton's Lond. Journal (N.S.) 107, 13 W. R. 578, 12 L. T. (N.S.) 99.—"The rules which govern the construction of specifications . . . are the ordinary rules for the interpretation of written documents. If the words, 'the most liberal construction, are intended to denote some principle of interpretation different from the ordinary rules for the interpretation of written documents, I am not aware of any such authority" (*per* Westbury, L.C.): followed in *Edison* v. *Holland*, 1888, 5 R. C. P. 475.

Newton v. *Halbard*, 1872, John. 152.—"A specification should not be construed in any technical or captious spirit, but with a fair intention to give it effect, if it be reasonably intelligible."

Harrison v. *Anderston Foundry Co.*, 1876, L. R. 1 App. Cas. 581.—"A specification ought not to be subjected to what has been called the benign interpretation, or to the strict one. The language should be construed according to the ordinary meaning."

Hinks v. *Safety Lighting Co.*, 1876, 4 Ch. D. 612.—"I

CHAP. XI. SECT. 1.

The beneficial construction.

am anxious . . . to support honest bonâ fide inventors . . . and to prevent their patents being overturned on mere technical objections. . . . This is sometimes called a 'benevolent' mode of construction. Perhaps that is not the best term to use, but it may be described as construing a specification fairly with a judicial anxiety to support a really useful invention, if it can be supported on a reasonable construction of the patent. Beyond that the benevolent mode of construction does not go" (*per* Jessel, M.R.).

Plimpton v. *Spiller*, 1877, 6 Ch. D. 422.—"It is the duty of a judge to construe a specification fairly with a judicial anxiety to support a really useful invention . . . it is the duty of the judge to adopt the construction which makes the patent reasonable and sensible, rather than that which makes it utterly absurd" (*per* Jessel, M.R.).

Clark v. *Adie*, 1877, 2 App. Cas. 436.—"In construing the specification, we must construe it like all written documents. But when it is attempted . . . to say that inasmuch as these specifications shew matters . . . which were old when the patent was taken out . . . therefore the patent must be so construed as not to include them, that seems to me both contrary, so far as I know, to the course of decision, and contrary to principle (*per* Lord Blackburn).

Dudgeon v. *Thompson*, 1877, L. R. 3 App. Cas. 53.—"The duty of the Court is fairly and truly to construe the specification, neither favouring one side nor the other" (*per* Lord Blackburn).

Otto v. *Linford*, 1882, 46 L. T. (N.S.) 38.—"There should be a bias in favour of that construction which supports a patent" (*per* Jessel, M.R.).

The beneficial construction.

Cropper v. *Smith*, 1884, 1 R. P. C. 89.—"We were pressed very earnestly to give this document that which has been called a benevolent construction. It seems to me that prayer for grace is very often addressed to Courts under circumstances which preclude the idea of their entertaining it for a moment. It is quite true that in old times a great many judges were supposed to be astute to defeat patents, and as a corrective, so to speak, to that inclination of the Courts it became necessary for the tribunal to warn itself that patentees must be fairly dealt with, as between themselves and the public; and as a canon of construction, accordingly, reference has been from time to time in various cases made to the idea that a benignant or benevolent construction was one that ought to be involved, that is to say, reference has been made to an old principle of construction, which is not at all special to the subject-matter of patents, but applies to all documents and all deeds, which is as old as Coke and Shepherd's Touchstone, to the effect that the interpretation of a written document ought to be benevolent or benign—'Verba debent intelligi cum effetu 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" (*per* Bowen, L.J.).

CHAP. XI. SECT. 1.

The beneficial construction.

Needham v. *Johnson*, 1884, 1 R. P. C. 58.—"I do not like the expression 'benevolent interpretation'; I do not believe in it. The question is, whether a given construction is the true construction; but of course if any patent is capable of more constructions than one, the general rule would be applied, that you would put upon it that construction which makes it a valid patent, rather than a construction which renders it invalid. There is no particular benevolence in that. It is a general principle of interpretation applicable to all documents, but of course those who talk about benevolent interpretation do not mean more than that" (*per* Lindley, L.J.).

Philpot v. *Hanbury*, 1884, 2 R. P. C. 38.—"I should read the specification liberally . . . is this such, that a fair man, willing and wishing to understand the specification, can reasonably gather from it what the patentee considers his invention?" (*per* Grove, J.).

Sugg v. *Bray*, 1885, 2 R. P. C. 231.—"The patent must be construed . . . by giving the ordinary and natural meaning to the words" (*per* North, J.).

Lister v. *Norton*, 1886, 3 R. P. C. 203.—"The specification ought to be construed like any other legal document, as a whole. It certainly ought not to be construed malevolently—I will not say it ought to be construed benevolently—I do say it ought to be construed fairly. It must be read by a mind willing to understand, not by a mind desirous of misunderstanding. Inventors and those who assist them are seldom skilled adepts in the use of language; faults of expression may be got over where there is no substantial doubt as to the meaning" (*per* Chitty, J.).

Automatic Weighing Machine Co. v. *Knight*, 1889, 6 R. P. C. 307.—"We are told by the statute that we are

The beneficial construction.

to consider all patents in the most beneficial sense for the advantage of the patentee. Why this clause should have been put in I do not know . . . we must ascertain the real meaning, and must, in obedience not only to the command, but to common sense, construe it so as to uphold it, if it can be reasonably done" (*per* Lindley, L.J.).

Leadbitter v. *Kitchin*, 1890, 7 R. P. C. 244.—"A specification is to be construed neither in favour of the grantee nor against him, but precisely according to the rules applied to any other document" (*per* Brett, L.J.). (The patentee had described a guard for toothed wheels and belted pulleys. To avoid anticipation, he wanted the Court beneficially to read it as though he had only claimed the guard for the belted pulleys. Held, it could not be done.)

A consequence of the principle that a patent is to be supported if the language reasonably admits of it is, that a patentee is not to be presumed to claim things that he must have known were in general use (see Chap. VIII., sect. 15); and where a claim in a patent is too widely stated, and would if isolated be bad, the beneficial construction is often applied to restrict it, and thus save the patent (see Chap. IX., sect. 7).

ante, p. 187.

ante, p. 198.

2. The title, specifications, and claims, may all be looked at, to explain one another.—"You must always construe a claim with reference to the whole context of a specification" (*per* James, L.J.): *Plimpton* v. *Spiller*, 1877, 6 Ch. D. 427. In *Edison* v. *Woodhouse*, 1887, 4 R. P. C. 106, where a claim was for the use of a "carbon gas or liquid," the words "carbon gas" were allowed to be explained as not meaning every sort of carbon gas

CHAP. XI. SECT. 2.

The title, specifications, and claims may all be looked at, to explain one another.

(some of which, as a fact, would not succeed), but as meaning only certain sorts of carbon gas, the nature of which could be gathered from the specification. This case may be compared with *Stevens* v. *Keating*, 1847, 2 W. P. C. 194, where a claim to the use of "acids as hereinbefore described" was held to mean all sorts of acids, some of which would do, and some would not do, and the patent was held bad.

The specifications are to be read in connection with their titles (*per* Parke, B.): *Newton* v. *Vaucher*, 1851, 6 Ex. 859; *Hornblower* v. *Boulton*, 1799, D. P. C. 220, 8 T. R. 95; *Oxley* v. *Holden*, 1860, 8 C. B. (N.S.) 747, 30 L. J. C. P. 74, 8 W. R. 627; *Household Co.* v. *Neilson*, 1843, 1 W. P. C. 679.

Although the provisional specification may be used to explain the final, it is not permissible to supplement it; *Mackelcan* v. *Rennie*, 1862, 13 C. B. (N.S.) 52; see also *ante*, p. 176. Chap. VII., sect. 4.

Compare ante, p. 77, Chap. III., s. 3.

Compare post, "*ambit of an invention*," p. 299.

3. Construction with reference to public knowledge at the time.—The specifications are to be construed with reference to public knowledge at the time they are sent in. For this purpose former specifications may be consulted, and evidence of experts taken: *Hocking* v. *Hocking*, 1886, 3 R. P. C. 293. "If the words of the specification are clear, of course these specifications cannot help in any way, nor could the public knowledge at the time help in any way, but if they are doubtful, then I think it may be legitimate and useful, in ascertaining the true construction of the terms of the specification, to look to all matters which could help the judge to determine what was the state of public knowledge at the time when this patent was granted" (*per* Cotton, L.J.);

see also *Couchman* v. *Greener*, 1884, 1 R. P. C. 199 (*per* Lord Esher, M.R.).

Thus, in *The Badische Anilin Fabrik* v. *Levenstein*, 1887, the word "naphthylamine" was used. It was argued that there were two sorts, viz., alpha- and beta-naphthylamine, that only the former would do, and that the patent did not distinguish them. It was the fact that, at the date of the patent, both were known, but under the names "naphthylamine" and "new naphthylamine." Hence the patentee, in describing as "naphthylamine" what was afterwards termed "alpha-naphthylamine," had correctly used the language in vogue when it was sent in, and the patent was supported: 4 R. P. C. at p. 463; see also *Lewis* v. *Marling*, 1829, 1 W. P. C. at p. 496, 10 B. & C. 22. This principle was also affirmed by the House of Lords: *King Brown* v. *Anglo-American Brush Co.*, 1892, 9 R. P. C. 322; and see *Heath* v. *Unwin*, 1852, 2 W. P. C. 228, 12 C. B. 522, 5 H. L. C. 505 (*per* Alderson, B.); *Clark* v. *Adie*, 1877, 2 App. Cas. 436; *Westinghouse* v. *Lancashire and Yorkshire Rail. Co.*, 1884, 1 R. P. C. 98; *Ellington* v. *Clark*, 1888, 5 R. P. C. 325; *Crossley* v. *Beverley*, 1829, 1 W. P. C. 107; *Ashworth* v. *Roberts*, 1892, 9 R. P. C. 92.

Construction with reference to public knowledge at the time.

4. Lapse of time has some effect upon the construction of a patent, so that if a patent has stood inquiry and the test of time, this is evidence that the specification is intelligible: *Neilson* v. *Betts*, 1871, L. R. 5 H. L. C. 1, 40 L. J. Ch. 317, 19 W. R. 1121.

5. The use of particular words in patents.—Foreign words in a patent, such as "vis de pression" and "centimetres," will not vitiate it, if the meaning is

Examples of use of particular words.

CHAP. XI. SECT. 5.

Examples of use of particular words.

comprehensible: *Bloxam* v. *Elsee*, 1825, 1 C. & P. 558, 6 B. & C. 169; see also *Cassella* v. *Levinstein*, 1891, 8 R. P. C. 473.

"**Manufacture.**"—This word is used in the widest sense: *Cornish* v. *Keene*, 1835, 1 W. P. C. 508, 2 C. P. C. 314; *Bush* v. *Fox*, 1852, M. P. C. 176, 23 L. J. Ex. 257; *Ralston* v. *Smith*, 1865, 11 H. L. C. 223, 20 C. B. (N.S.) 28, 35 L. J. C. P. 49.

"**As above described.**"—These words have a limiting effect: *Plating Co.* v. *Farquharson*, 1879, Griff. 191; *Barber* v. *Grace*, 1847, 1 Ex. 339, 17 L. J. Ex. 122.

"**Substantially as described.**"—These words, according to Grove, J., "come to nothing," and the word "substantially" is mere verbiage: *Westinghouse* v. *Lancashire and Yorkshire Rail. Co.*, 1884, 1 R. P. C. 241.

"**Substantially as hereinbefore described,**" interpreted by North, J.: *Lawrence* v. *Perry*, 1885, 2 R. P. C. 183; *Easterbrook* v. *G. W. Rail. Co.*, 1885, 2 R. P. C. 208.

"**As above set forth.**"—In the sentence "provided with a shoulder . . . made from a piece of wire *as* above set forth" the word "as" was read as relating to "provided," not to "made": *Bray* v. *Gardner*, 1887. 4 R. P. C. 403.

"**Substantially as set forth,**" must refer to the description in the specification: *United Telephone Co.* v. *Bassano*, 1886, 3 R. P. C. 315 (*per* Cotton, L.J.).

"**As described and illustrated,**" refers to the drawings: *Fairburn* v. *Household*, 1886, 3 R. P. C. 267.

"**Other substances,**" is not too general, and means other substances ejusdem generis: *Crossley* v. *Beverley*, 1829, 9 B. & C. 63; *Bickford* v. *Skewes*, 1841, 1 Q. B. 948, 1 W. P. C. 218.

"**Any mechanical equivalent,**" are useless words.

They are implied, and need not be stated: *Curtis* v. *Platt*, 1863, 3 Ch. D. 137, n.

"**Analogous**": see *Brown's Patent*, Griff. App. 1. "The inventor does not limit himself. . . . "; "It will be evident that the process may be varied," are useless words: *Binney* v. *Feldtman*, H. L. (*per* Cairns), 1875, Griff. 52.

"**More or less**," means a substantial quantity: *Plating Co.* v. *Farquharson*, 1883, Griff. 192.

"**Effect**," read as "beneficial effect": *Neilson* v. *Harford*, 1841, 1 W. P. C. 372.

"**A**," must be read in the singular. Thus, "a" machine to do various things, means that *one* machine must do them all, not that various machines of different sizes are required: *Hastings* v. *Brown*, 1853, 1 E. & B. 450, 22 L. J. Q. B. 161; *Bloxam* v. *Elsee*, 1827, 6 B. & C. 169, 9 D. & R. 215. *ante*, p. 186.

"**And**."—"Metal fittings *and* the mode of applying them." Held, a patent only for the fittings, in accordance with the rule of interpretation laid down in *Oxley* v. *Holden*, 1860, 8 C. B. (N.S.) 666; Chap. VI., sect. 1. *ante*, p. 166.

"**Etc., etc.,**" held to mean another name for the thing after which they were put, and not necessarily too vague: *Shaw* v. *Jones*, 1839, 6 R. P. C. 333.

"**Or**," must be read disjunctively. Thus, where a patentee said, "I do A," *or* "I accelerate it by B," and it was shewn that B was indispensable to success, the patent was held bad: *Simpson* v. *Holliday*, 1864, 20 Newton's Lond. Journal (N.S.) 108; see also *Elliot* v. *Turner*, 1845, 2 C. B. 446, 15 L. J. C. P. 49. In the case of *Hills* v. *London Gas Light Co.*, 1860, 5 H. & N. 312, 27 L. J. Ex. 60, 29 L. J. Ex. 409, "hydrated *or* precipitated oxide of iron" was allowed to be read as if the word *or* was omitted.

CHAP. XI. SECT. 5.

Examples of use of particular words.

"S."—In a patent for improvements, one improvement was allowed to be enough, for every part of the new plan might be considered as an improvement: *Derosne* v. *Fairie*, 1835, 1 W. P. C. 162; see also *Nickels* v. *Haslam*, 1844, 8 Scott N. R. 97, 7 M. & G. 378, 8 Jur. 474, 13 L. J. C. P. 146. But where the patent said that "notes" were produced that never were before produced, held, that one new note would not satisfy the description: *Bainbridge* v. *Wigley*, 1810, Parl. Rep., 1820, 197, 1 C. P. C. 270.

ante, p. 163.

CHAPTER XII.

AMENDMENT OF THE SPECIFICATION.

1. Practice prior to the Patents Act, 1883.—Formerly the patent was in the custody of the Chancellor, but the enrollment thereof and the specifications were under the custody of the Master of the Rolls, who allowed the amendment of clerical errors, but no others: 1 W. P. C. 641. By 5 & 6 Wm. IV., c. 83, disclaimers were first allowed, which, however, could only repudiate some matter claimed, and which could not amend errors in the specification. When made, the disclaimers were held to date back to the specification. By the Patents Act, 1852, 15 & 16 Vict., c. 83, s. 29, it was provided that no action should be brought for infringements prior to the disclaimer, except by leave of the law officer.

2. Amendment of the Specification under Patents Act, 1883.—As soon as a specification has been sent in the Comptroller may require it to be amended: Patents Act, 1883, ss. 7, 9. But if the applicant for the patent, or the patentee, after it has been granted, desire to amend a specification, he must do so under sect. 18 of the Act of 1883: *In re Jones*, Griff. 313. The word patentee means the "person" for the time being entitled to the patent, and thus includes assignees and

post, p. 442.

post, p 448.

CHAP. XII. SECT. 2.

Amendment of the specification under Patent Act, 1883.

personal representatives: 13 & 14 Vict., c. 21, s. 4; Patents Act, 1883, s. 46. Infants or lunatics would be represented, as provided in sect. 99. It may be doubtful whether a mortgagee would be entitled to amend a specification without the mortgagor: (see "Parties to an Action," Chap. XXVIII., sect. 2).

post, p. 357.

Amendments may, under sect. 18, be made at any time, and from time to time, except when an action for infringement, or proceeding for revocation, is pending: Patents Act, 1888, s. 5. See also Patent Rules, 1890, r. 16, 16A.

post, p. 481.
post, p. 486.

3. Amendment of specification when no action is pending, is governed by sect. 18, and the Patent Rules, 1890, 52–59, and Form F. When the amendment has been made and allowed it cannot be afterwards objected to, on the ground that the advertisements were not duly inserted, or that an action was pending, and hence, that the making of it was ultra vires. The order of the Comptroller would be conclusive upon these points: *Farben Fabrik* v. *Bowker*, 1891, 8 R. P. C. 396.

post, p. 448.
post, p. 494.
see also post, p. 550.

4. Amendment of specification when an action of infringement or petition for revocation is pending.—The method is first, under sect. 19, to obtain leave of the Court (Patents Act, 1883, s. 117), to apply to the Comptroller, and then to proceed as under sect. 18 (as amended by Patents Act, 1888, s. 5), and Patent Rules, 1890, 55–59, Form F, and see Rule 58 (*per* Cave, J.): *re Hall and Others*, 1888, 5 R. P. C. 312. It is, however, to be noticed, that in this case the amendment will have to be limited to a mere disclaimer. By this it is not meant that words may only be struck out, and none inserted, but that substantially, the essence of the amendment

post, pp. 450, 474.

must be a disclaimer, and not a correction: *Ralston* v. *Smith*, 1865, 11 H. L. C. 245; *Thomas* v. *Welch*, 1866, L. R. 1 C.P. 195. It is to be observed that the necessity for leave of the Court is not necessary when an action for threats is pending. Leave is not necessary after judgment, by which is meant not necessarily the judgment of a Court of Appeal, but the judgment of the Court below, so that after judgment, the fact that an appeal is pending is no objection to the patentee's right to apply to amend without leave: *Cropper* v. *Smith*, 1884, 1 R. P. C. 254; *Lawrence* v. *Perry*, 1885, 2 R. P. C. 188; *Haslam* v. *Hall*, 1887, 5 R. P. C. 24.

Amendment of specification when an action of infringement or petition for revocation is pending.

The application for leave to apply to the Comptroller can be made at Chambers: *Singer* v. *Slassen*, 1884, 1 R. P. C. 122.

In granting the application, the Court has an absolute discretion as to the conditions which it will impose: *Allen* v. *Doulton*, 1887, 4 R. P. C. 383; *Lang* v. *Whitecross Co.*, 1889, 6 R. P. C. 574; *re Lang*, 1890, 7 R. P. C. 469.

In framing these conditions the Court will see that no one against whom the leave is granted is prejudiced: *Goulard* v. *Gibbs' Patent*, 1888, 5 R.P.C. 191; *Goulard* v. *Lindsay*, 1888, 5 R. P. C. 193; *Bray* v. *Gardner*, 1887, 4 R. P. C. 42. As a general rule the terms are that the amended specification shall not be given in evidence at the trial; that no damages shall be recovered for infringements prior to the date of the amendment, and some provision as to the costs in the action; but the terms vary in each case, and evidence of the amended specification has sometimes been allowed to be given, on the terms that no damages should be asked, nor injunction obtained, in respect of anything done before the disclaimer: *Lang* v. *Whitecross Co.*, 1889, 6 R. P. C. 570.

CHAP. XII. SECT. 4.

Amendment of specification when an action of infringement or petition for revocation is pending.

Examples of the conditions imposed are to be found in *Singer* v. *Stassen*, 1884, 1 R. P. C. 122; *Winter* v. *Baybut*, 1884, 1 R. P. C. 76; *Codd* v. *Bratby*, 1884, 1 R. P. C. 209; and *Fusee Vesta Co.* v. *Bryant & May*, 1887, 4 R. P. C. 171, in which no conditions as to damages for prior infringement were imposed, and the amended specification was directed to be given in evidence, although those conditions were asked for by the defendant: see *Allen* v. *Doulton*, 1887, 4 R. P. C. 375; *Haslam Foundry* v. *Goodfellow*, 1888, 5 R. P. C. 30, where an order was made substantially on the same principle as in the *Fusee Vesta Co.* v. *Bryant & May*. The application to amend may be made at the hearing, after defendant has closed his case: *Meyer* v. *Sherwood*, 1890, 7 R. P. C. 283.

Where the Court imposes no conditions the law officer and the Comptroller ought not to do so: *Hearson's Patent*, 1884, 1 R. P. C. 213.

When more than one action for infringement or proceeding for revocation is pending, it is not necessary to get leave to apply to amend in all of them: *Re Hall*, 1888, 5 R. P. C. 310; *Goulard & Gibbs' Patent*, 1888, 5 R. P. C. 194. The practice was formerly different: *Codd's Patent*, Griff. 305.

post, pp. 449, 494.

ante, sect. 3, p. 216.

5. Opposition to the amendment is governed by Patents Act, 1883, s. 18, and Patent Rules, 1890, 53–59, and Form G. Notice of opposition may be given within a month of the first advertisement of the application to amend. The opponent may then within fourteen days from the expiration of the month leave at the Patent Office statutory declarations in support of his opposition (Rule 55), and by Rule 56 the proceedings to the hearing

Opposition to the amendment.

will go on according to Rules 38–41, as in the case of oppositions to grants of patents. The case is then heard by the Comptroller, from whom an appeal lies to the law officer: Patents Act, 1883, s. 18, s-s. 3. Where an applicant fails to appeal to the law officer, he cannot make a fresh application and then appeal: *Arnold's Patent*, Griff. App. 5. The appeal will be conducted according to the law officer's rules made under s. 38 of the Patent Act, 1883. No appeal lies from the law officer, nor is he "a Court" to which a prohibition can go, if he exceeds his authority: *Ex parte Simon*, 1888, 6 R. P. C. 22. The Comptroller, as well as the law officer, has power to determine whether an opposer has a locus to be heard: *Bell's Case*, 2 Griff. 10. A prior patentee, or a person working according to a patent which he has purchased, but which has expired, is entitled to oppose if the amendment might affect his rights: *Glossop's Patent*, Griff. 285; *Heath & Frost's Patent*, Griff. 288; *Hampton & Facer's Application*, 1885, Griff. App. 13; and compare further the observations on "Opposition to Grants of Letters Patent," Chap. XVI.

post, p. 449.

post, p. 457.

post, p. 246.

6. The hearing of the application for leave to amend, and the conditions imposed.—If the application is by leave and an action is pending, as has been seen above, the conditions are fixed by the Court, and not by the Comptroller or law officer; but if no action is pending, both the law officer and also the Comptroller (*Hearson's Patent*, 1884, Griff. 309; *Re Pietschman*, 1884, Griff. 314) have power to impose conditions. One of them might, for example, be compensation to be paid to some opponent who had been put to expense incurred in the belief that the patent was invalid: *Re Pietschman*,

ante, p. 217

CHAP. XII. SECT. 6.

The hearing of the application for leave to amend, and the conditions imposed.

1884, Griff. 315; but the Comptroller having no power over costs, could not impose the paying of costs to a partially successful opponent as a condition of being allowed to amend: *ibid.*, p. 314.

Formerly it used generally to be stipulated on the allowance of a disclaimer that no action should be brought in respect of infringements committed prior to the infringement: *Tranter's Patent*, John. Pat. Man., 5th ed. 91; *Smith's Patent*, 1855, M. P. C. 232; *Harrison's Patent*, 1853, M. P. C. 32. But this was not always the case: *Lucas' Patent*, 1854, M. P. C. 239. With regard to patents taken out prior to 1884, it is still generally required that no action should be taken on infringements prior to the amendment: *Re Hearson*, 1884, 1 R. P. C. 213; *Re Cheeseborough*, 1884, Griff. 303; *Re Westinghouse*, 1885, Griff. 315; *Re Ashworth*, 1886, Griff. App. 6. But with regard to patents taken out after 1883 under the new Act, this is not usually done. The reason is, that by the Patents Act, 1883, s. 20, the fact of amending a specification under sect. 18 deprives the patentee of damages for all breaches prior to the amendment, unless the Court is satisfied of the original good faith and reasonable skill and knowledge with which the original specification was framed: *Re Allen*, 1887, Griff. App. 3. But in special circumstances such a condition might still be imposed; *Re Ashworth*, 1886, Griff. App. 9; *Re Hadden*, 1886, Griff. App. 12.

post, p. 450.

A condition might be imposed of allowing an opponent to use machinery which he had in good faith erected, proper precautions being taken for marking and limiting him to the use of what he had already erected: *Edison's Patent*, 1887, Lawson, 64; *Westinghouse Patent*, 1874, Griff. 315; *Hadden's Patent*. Griff. App. 12.

The hearing of the application for leave to amend, and the conditions imposed.

A condition that no action is to be brought in respect of certain machines, means no action on the patent in respect of which the amendment is allowed, but does not prevent proceedings on another patent which those machines may have infringed: *United Telephone Co.* v. *Globe Telephone Co.*, 1884, 26 Ch. D. 766. When there is a condition that no action shall be brought for infringements prior to a certain date, this covers articles made before that date, even though they may be sold afterwards: *Cheeseborough's Patent*, 1878, Griff. 303.

7. The nature of the amendments allowed.—Formerly disclaimers only were allowed, but now the power of amendment is wider: Patents Act, 1883, ss. 7, 9, 18. It is to be remembered that the Comptroller can himself require alterations prior to the acceptance of the specifications; and in a proper case, where no harm to anyone can ensue, the Comptroller might, if he chose, spare the applicant the expense of proceeding under sect. 18, and make the corrections under sects. 7 and 9, and it has been laid down by Webster, A.G., that where a patentee desires to limit his invention in his complete specification, and for that purpose to restrict his title and provisional specification, this course ought to be pursued. Thus, where an application has been made for a *dynamo and motor*, and after the provisional specification had been accepted the applicant found the invention inapplicable to motors, the A.G. considered that the Comptroller ought to have accepted the complete specification without mention of motors, and then, under sects. 7 and 9, to have amended the title and the provisional specification accordingly: *Dart's Patent*, Griff. 308. This is a better plan for

post, pp. 443, 449.

CHAP. XII. SECT. 7.

The nature of the amendments allowed.

the patentee, as it leaves him with a clean unamended patent.

Under the present Act, no limits are placed upon the amendments which the Comptroller may require under sects. 7 and 9; and in pursuance of a requisition to amend, an inventor might re-model and add as much as the Comptroller thought proper to allow. But when an applicant or patentee seeks to amend under sect. 18, he cannot be allowed any amendment which either substantially extends or alters his invention; and if such an amendment were allowed, it might afterwards be considered as vitiating his patent: *Van Gelder's Patent*, 1889, 6 R. P. C. 22; *Nairn's Patent*, 1891, 8 R. P. C. 444. In doubtful cases the amendment ought to be allowed, for it can do no harm; and if it makes the patent bad, that can always be questioned: see *Van Gelder's Patent, supra*; also, *Lake's Patent*, 1887, Griff. App. 16, *Bateman and Moore's Disclaimer*, 1854, M. P. C. 118; *Dudgeon* v. *Thompson*, 1877, L. R. 3 App. Cas. 34.

post, p. 449.

post, p. 225.

Under the old practice it was not allowed, under guise of restricting a specification, to turn it from a vague and general one into a good one by making it more precise, for that would not be restriction, but amendment: *Ralston* v. *Smith*, 1865, 11 H. L. C. 223; nor could, by disclaimer, a claim for one combination be turned into a claim for another: *Foxwell* v. *Bostock*, 1864, 4 De G. J. & S. 298. Moreover, disclaimers must be clear and definite, and a reason for a disclaimer is no part of the disclaimer: *Cannington* v. *Nuttall*, 1871, L. R. 5 H. L. 205; see also *Seed* v. *Higgins*, 1860, 8 H. L. C. 568; *R.* v. *Mill*, 1850, 10 C. B. 379. On the other hand, not only disclaimers are now allowed but amendments, so that a patentee may correct an error or want of clearness in his specification.

The nature of the amendments allowed.

Thus, where a patentee had claimed pipes of "novel form," and it appeared from the specification that he meant not of novel *form* but arranged in a new way, he was allowed to amend: *Re Allen*, 1887, Griff. App. 3. A patentee who had stated that aluminium might be added to molten metal, "shortly before it was poured, *or earlier*," was allowed to take out those last words: *Re Nordenfeldt*, 1887, Griff. App. 20; but he was not allowed to insert an explanation of the principles of his invention. An alteration in the description was allowed without altering the claims: *Re Lake*, 1887, Griff. App. 16. Where a patentee had patented a blasting cartridge surrounded by a case full of water, substantially as described, and incidentally mentioned that with dynamite, or other water-resisting substances, the case of the cartridge might be dispensed with, and then wanted to amend by leaving out all his main claim, and simply claiming the use of dynamite in water without a case, it was held that he could not do so, as this would be to alter the invention: *Re Heath & Frost*, 1886, Griff. 312; see also *Re Walker*, Griff. App. 22. A patent for a method of re-inforcing electrical contacts, *i.e.*, making them more perfect, could not be altered into one for keeping the contact pieces clean, even though the machinery employed was not altered: *Re Serrell*, 1888, 6 R. P. C. 101: see also *Ryland's Patent*, 1888, 5 R. P. C. 665. One of the most extreme cases in which an amendment was allowed was *Kelly* v. *Heathman*, 1890, 7 R. P. C. 343. Here a patentee had claimed: (1) A telescopic ladder; (2) a cord to raise it; (3) a bracket lever to secure it. Having found these things to be old, Mr. Macrory very ingeniously struck out all his claims, and suggested an amendment, claiming them in com-

CHAP. XII. SECT. 7.

The nature of the amendments allowed.

bination only, and then the plaintiff brought an action. North, J., held that this amendment did not vary or extend the invention, because though the plaintiff had originally claimed three things separately, yet it was clear that he had meant to claim only the combination of them. See a paper on this case by Mr. Lloyd Wise. Proceedings of the Institute of Patent Agents, vol. ix. p. 36. An imperfect description of a drawing was allowed to be amended: *Re Morgan*, 1886, Griff. App. 17. Knowledge subsequently acquired is not allowed to be introduced by way of amendment: *Re Beck & Justice*, 1877, Griff. App. 10. If a specification on the face of it admits of two meanings, it may be amended: *Re Ashworth*, 1886, Griff. App. 6; and this may be done though the ambiguity was not pointed out in the applicant's reasons.

No appeal lies from the decision of the law officer as to amendments, and no prohibition would be granted if he wrongly exercised his authority, for a prohibition can only be directed to a Court: *Van Gelder's Patent*, 1888, 6 R. P. C. 28.

8. The amendment when made dates back to and forms part of the original specification: Patents Act, s. 18, s-s. 9, 10.—When leave to amend has been obtained an action may be brought, although the amendment has not in fact been made, for the latter is merely a ministerial act: *Andrew* v. *Crossley Bros.*, 1892, 9 R. P. C. 165.

post, p. 448.

9. The title, the provisional (*Dart's Patent*, Griff. 307), **and the complete specification may all be amended;** so also may the drawings: Patents Act, 1883, s. 18, s-s. 1.

A new grantee may also be added by way of amendment: *Evans & Otway's Patent*, 1884, Griff. 279.

The title, the provisional and the complete specification may all be amended.

10. The effect of an amendment which widened the patent beyond its former scope, would not merely be to make the amendment void, but it would vitiate the patent: *Ralston* v. *Smith*, 1865, 11 H. L. C. 550; *Dudgeon* v. *Thompson*, 1877, L. R. 3 App. Cas. 55; *Re Goulard* v. *Gibbs' Patent*, 1888, 5 R. P. C. 189, 7 R. P. C. 367; *Moser* v. *Marsden*, 1893, 10 R. P. C. 215; *Farben Fabrik* v. *Bowker*, 1891, 8 R. P. C. 391; but see *Foxwell* v. *Bostock*, 1864, 4 De G. & S. 298. On the other hand, a disclaimed portion of an invention is open to the use of the public: *The Plating Co.* v. *Farquharson*, 1883, Griff. 187.

11. An amendment has the effect of depriving the patentee of all right to damages for infringements committed prior to it, unless he can satisfy the Court that his original claim was framed in good faith, and with reasonable care and skill (Patents Act, 1883, s. 20): *Wenham* v. *Carpenter*, 1887, 5 R. P. C. 68. In *Hopkinson* v. *St. James Electric Light Co.*, the specification was held to be in good faith, and an account granted as from the date of the patent: 1892, 10 R. P. C. 62.

post, p. 450.

12. An amendment may be made out of caution; therefore, the mere fact of making it is not an admission that without it the patent is defective: *Stocker* v. *Waller*, 1845, 1 C. B. 148, 14 L. J. C. P. 90; but see dictum of Kay, J., *Fusee Vesta Co.* v. *Bryant & May*, 1886, 4 R. P. C. 72. Formerly a disclaimer was not allowed to assist in explaining the specification. *Tetley* v. *Easton*, 1857, 2 C. B. (N.S.) 706; but as amend-

CHAP. XII. SECT. 12.

ments are now allowed, that rule would probably no longer apply.

An amendment may be made out of caution.

13. Amendment of clerical errors.—The Master of the Rolls had always power to correct clerical errors in documents enrolled under his care: 1 W. P. C. pp. 641-664; and the Patents Act, 1883, has not taken this power away: *Re Gare's Patent*, 1884, L. R. 26 Ch D. 105; *Re Johnson's Patent*, 1877, 5 Ch. D. 503. He could also even order the enrolment of a patent which had been sent in a day too late, owing to the error of an official: *Adam's Patent*, 1853, 21 L. T. (N.S.) 38; but this power exists only after the patent is sealed, for not till then is it in his custody.

As to rectification of the register.

see post, p. 267.

Power also existed for the Master of the Rolls to take a disclaimer off the file which had been filed without the consent of the patentee: *Re Berdan's Patent*, 1875, L. R. 20 Eq. 346, 44 L. J. Ch. 544. Delay would, however, be a bar to such an application: *Re Blumoud's Patent*, 1860, 3 L. T. (N.S.) 800; and in future the usual course will probably be under ss. 18, 91, of the Patents Act, 1883, Form P. This gives the Comptroller power to correct any clerical error in an application, and any error in name, address, etc., of a registered proprietor.

post, pp. 448, 454.

14. Costs of amendments.—The Comptroller has no power over costs, nor can he allow an amendment conditionally on their being paid: *Pietschman's Patent*, 1884, Griff. 314; but the law officer has, and by sect. 38 his order may, on non-payment, be made a rule of Court. He may either fix the costs or else direct how they shall be ascertained: Law Officer's Rules, 11.

post, p. 501.

Costs are generally given against unsuccessful parties,

Costs of amendments.

except that, where a patent is amended a second time, the applicant will rarely get his costs, "for second amendments are not to be encouraged": *Haddan's Patent*, 1885, Griff. App. 12. The Comptroller does not in general either give or receive costs: *Re Lake*, 1887, Griff. App. 16; but the return of the stamp on the notice might be asked for: *Re Morgan*, 1886, Griff. App. 17. The Court, in granting leave to apply to amend pending an action, might perhaps make it a condition that the defendant should have in any event his costs of opposing the amendment; but this is not the usual rule, and Kay, J., having made this condition, revoked it: *Fusee Vesta Co.* v. *Bryant & May*, 1887, 4 R. P. C. 73; see also *Re Bell*, 1887, Griff. App. 10.

CHAPTER XIII.

PATENTEES.

See also post, p. 541.

CHAP. XIII. SECT. 1.

post, pp. 441, 474, 497.

1. Who may take out a patent.—By the Act of 1883, s. 4, any person, whether a British subject or not (including a body corporate: s. 117, and Patent Rules, 1890, 73) may take out a patent. The patent may be granted to the inventor or inventors, or to the survivor of them, singly or jointly with other persons, who are not the first inventor or inventors. A body corporate, though not likely to be an inventor, might have a patent for an invention communicated from abroad, or else jointly with the true inventor. Questions may arise as to the rights of co-owners of patents, as to which see Chap. XXII., sect. 2.

Form G.

ante, p. 158, & *P. Act*, 1885, *sect.* 5, *post*, p. 476.

post, p. 274.

A person who has obtained knowledge of an invention in a public capacity cannot take out a patent: *Patterson* v. *Gas Light & Coke Co.*, 1876, L. R. 2 Ch. D. 833, 3 App. Cas. 239.

2. Infancy, lunacy, married women, and aliens.—Patents may be granted to infants: Patents Act, 1883, s. 99; *Cheavin* v. *Walker*, 1877, L. R. 5 Ch. D. 858; married women, lunatics (sect. 99), and aliens, or, at all events, to friendly aliens: *Bloxam* v. *Elsee*, 1825, 6 B. & C. 178, 9 D. & R. 224; see 1 W. P. C. 418 n.

post, p. 466.

Legal representatives.

3. Legal representatives.—Within six months after the death of an inventor a patent may be applied for by his personal representatives: Patents Act, 1883, s. 34. And if a person who has applied for a patent dies within fifteen months of his application, then the patent may be granted to his legal representatives, and sealed within twelve months after his death: Patents Act, s. 12, sub-s. 3. The legal representatives must furnish an office copy of the will, or letters of administration: Patent Rules, 20. The form of the grant when made is varied to suit the case: see "Grant," Chap. XVII., sect. 1.

post, p. 456.

post, p. 276.

post, p. 446.

post, p. 487.

post, p. 258.

4. International grants of patents for foreign inventions are dealt with: Chap. XXXIII.

post, p. 432.

5. The first and true inventor must be one at least of the grantees, except where the patent is granted to his legal representatives after his death. The 6th sect. of the Statute of Monopolies, 21 Jac. 1, c. 3, provides for the giving of patents "to the first and true inventor or inventors of such manufactures." The first and true inventor must be the person who has exercised the ingenuity which is required in every invention, and (subject to what is hereafter said as to servants and workmen), he must have made the invention *himself*, he must not have borrowed it from some other person in the United Kingdom, or from any book, or, it is submitted even from an unpublished manuscript in the United Kingdom. It is clear that if a patentee takes the invention from another person resident in the United Kingdom, he cannot be considered the inventor: *Marsden* v. *Saville Street Foundry*, 1878, L. R. 3 Ex. D. 203; *Barber* v. *Walduck*, 1823, 1 C. P. C. 438. In *Tenant's Case*, 1802,

ante, p. 228.

post, p. 247.

CHAP. XIII. SECT. 5.

The first and true inventor.

1 W. P. C. 125, a patent was held invalid on the ground (*inter alia*) that the patentee had received part of his invention from a chemist who communicated it to him.

It will be observed that the words of the statute refer not only to the true, but the first inventor. It might seem as though, if a prior inventor had used an invention in secret, a subsequent inventor could not be called the *first* inventor. This doubt has, however, been removed by decisions, and it is now clear that by the first inventor is meant, not the first in point of time, but the first who applies for the patent: *Dollond* v. *Champness*, 1766, 1 W. P. C. 43; see also *Bramah* v. *Hardcastle*, 1789, Holroyd, 81, 1 W. P. C. 44. "There may be several rivals starting at the same time; the first who comes and takes a patent, it not being generally known to the public. that man has the right to clothe himself with the authority of the patent, and enjoys the benefit of it" (*per* Tindal, C.J.): *Cornish* v. *Keene*, 1835, 1 W. P. C. 508, 2 Hodg. 294, 3 Bing. N. C. 588; *Lewis* v. *Marling*, 1829, 1 W. P. C. 496; and see further "Anticipation," Chap. V., sects. 2, 3, 7, which shews that secret user of the patent, or even abandoned user in public, of something which closely resembles the patent, will not avoid it, or prevent the patentee from being considered the first and true inventor.

ante, p. 142.

6. The assistance of servants and workmen.—As inventors naturally often have assistants, the question early arose how far their co-operation prevented a patentee from being the first and true inventor, and how far the results of the inventive power of a man, exercised when in the service of another, remained his own property.

In the first place, it is clear that if a servant in the

The assistance of servants and workmen.

employ of his master makes an invention, the invention is the invention of the servant, and not of the master, and the servant is the proper patentee: *Bloxam* v. *Elsee*, 1825, 1 C. & P. 558; *Homan's Case*, 1889, 6 R. P. C. 104; *Heald's Patent*, 1891, 8 R. P. C. 429. This was assumed throughout in *Siddell* v. *Vickers*, 1888, 5 R. P. C. 93; see also *Saxby* v. *Gloucester Waggon Co.*, 1880, Griff. App. 56.

But an inventor may employ a servant to assist him, and in that case the question will be, Who really invented it? "If Sutton (the assistant) suggested the principle to Minter, then he would be the inventor. If, on the other hand, Sutton was assisting him, then Mr. Minter would be the first and true inventor, and Sutton would be a machine, so to speak. . . . Suppose two persons engaged on an invention of this description. They know perfectly well between themselves who is the real inventor of it, and who is the workman to carry into effect the conception; but they would destroy the value to both if they did not take it out in the name of the right person" (*per* Alderson): *Minter* v. *Wells*, 1834, 1 W. P. C. 132; compare *R.* v. *Arkwright*, 1785, D. P. C. 61; *Barker* v. *Shaw*, 1823, 1 W. P. C. 126, n. Valuable discoveries accessory to the main principle, and tending to carry it out in a better manner, if made by engineers, agents, and other persons to assist an inventor, will not make his patent bad: *Allen* v. *Rawson*, 1845, 1 C. B. 551; *Kurtz* v. *Spence*, 1888, 5 R. P. C. 181. In this case the improvements are those of the master, and the servant cannot patent them: *David & Woodley's Application*, 1888, Griff. App. 26.

But in some cases the master and servant will both be held interested in the patent, and on opposition by one of them to its being granted to the other, the Court may direct that it shall be vested in trust for both: *Russell's*

CHAP. XIII. SECT. 6.

The assistance of servants and workmen.

Patent, 1857, 2 De G. & J. 130; *Healey's Application*, 1872, John. 165 (see further as to this subject, "Opposition to the Grant," Chap. XVI. *post*, p. 246).

7. Inventions imported or communicated from abroad.—In the earlier cases it was held that under the word "invent" might be included the "bringing in" from abroad. Thus, one Edisbury or Edgebury had described himself as "an inventor" of certain rollers for carriages. In the case of *Edgebury* v. *Stephens*, 1691, 1 W. P. C. 35, it was held that, whether learned by study or travel, it is the same thing. "A man has a right to a patent, not only for his own original invention, but . . . if he is the first person who brings into England an invention which is used abroad and not known in England" (*per* Abinger, C.B.): *Carpenter* v. *Smith*, 1841, 1 W. P. C. 536. In Lombes' Act of Parliament, the words, "his invention" are applied in a case in which it is clear that the invention was obtained from abroad: 1 W. P. C. 38; and see *Walton* v. *Bateman*, 1842, 1 W. P. C. 615; *Nickels* v. *Ross*, 1849, 8 C. B. 679. In *Beard* v. *Egerton*, 1846, 3 C. B. 97, it was expressly held that a patent might be granted to a British subject in his own name *as an inventor*, but really in trust for an *alien amy* resident abroad. Where, therefore, a man has derived an invention from abroad in his travels but from no particular person, it seems clear that he can describe himself as the first and true inventor, and take out the patent as for his own invention and in his own name. But where the patent has been expressly communicated by some person living abroad, then, inasmuch as under the Patent Rules of 1890, made by virtue of s. 101 of the Patents Act, 1883, a special form, A1, has been set out for applications

post, pp. 488, 510

ante, p. 192.

Inventious imported or communicated from abroad.

or patents communicated from abroad, it is better to adopt that form, though it does not seem to have been definitely decided whether it is absolutely necessary to do so. The point partly arose in *Avery's Patent*, 1887, 4 R. P. C. 152, 322; 36 Ch. D. 307. The patent had been taken out by one Lindsay in his own name as his invention, though in reality it was a communication from abroad, but upon which he had made certain improvements. On petition for revocation by the person who alleged he had communicated it, on the ground of fraud, Stirling, J., inclined to the opinion that, so far as the form went, it was good, for that the word "inventor" included an importer. The same point was raised but not decided in *Moser* v. *Marsden*, 1893, 10 R. P. C. 216. In *Milligan* v. *Marsh*, 1856, 2 Jur. (N.S.) 1083, the question also partly arose. Further examples of patents granted to importers even against theopposition of the foreign inventors will be found under "Opposition to the Grant," Chap. XVI., sect. 4.

post, p. 247.

In *Re Wirth's Patent*, 1879, L. R. 12 Ch. D. 303, it was decided that a patent might be granted to an alien resident abroad, for an invention communicated to him by another alien resident abroad. This decision followed logically the principles that an importer might be considered as an inventor, and that a patent could be granted to an alien resident abroad. But now, by notice April 21st, 1884, P. O. J. May 9th, 1884, the Patent Office has announced that no such patents will in future be granted, and the Form of Application A1, naming the "county" of the applicant, will prevent a foreigner from applying for a patent for a communication from some one else. It is to be noticed that Form A does not contain this word of description of the applicant's address. (As to "Extension," see p. 329.)

post, p. 510.

CHAP. XIII. SECT. 8.

8. Meaning of the word "patentee."—The word "patentee" means in the Act the person for the time being entitled to the patent, and includes executors, administrators, and assigns: 13 & 14 Vict. c. 21, s. 4, and Patents Act, 1883, s. 46. When a patent is mortgaged, the mortgagor is the "patentee." See also as to personal representatives, Chap. XXII., sect. 7, and as to assignees generally, Chap. XXII.

post, p. 462.

post, p. 281.

CHAPTER XIV.

PATENT AGENTS.

1. Patent agents, though employed before the Patents Act, 1888, were for the first time recognised by that Act: s. 1. The only privilege a patent agent apparently has, is that no one else has a right so to call himself under a penalty of £20. By merely writing "Agent for X.," a man does not render himself liable to this penalty: *Graham* v. *Fanta*, 1892, 9 R. P. C. 164. Communications with a patent agent are not privileged like those with a solicitor: *Moseley* v. *Victoria Rubber Co.*, 1886, 3 R. P. C. 355; and he is liable to his principal for fraud or misconduct: *Lee* v. *Walker*, 1872, L. R. 7, C. P. 121. The relation of agent to a patentee creates the duty of exercising uberrima fides, so that an infringement by him is to be more strictly viewed than one by a rival manufacturer: *Wheatstone* v. *Wilde*, 1861, Griff. 247. In order to become a patent agent it is necessary to be placed on the Register of Patent Agents; and for this purpose a preliminary examination must be passed or else a university matriculation, or Civil Service examination, or else the candidate must have been for seven years pupil or assistant of a registered patent agent or agents. A final examination in patent law is in all cases necessary. The law regulating the admission of patent agents on the register is governed by the rules of the Board of Trade, made on June 11th, 1889. They are not officers

post, p. 479; *see also P. R.*, 8, *post*, pp. 484, 533.

CHAP. XIV. SECT. 1. Patent agents.

of the High Court of Justice, but of the Board of Trade, by whom their names may be removed from the register for misconduct or other specified causes.

post, p. 533.

In August, 1891, the Institute of Patent Agents was re-incorporated by Royal Charter. Mere registration as a patent agent does not make the person so registered a member of the Chartered Institute of Patent Agents. (A description of the objects of the Institute is given in the

post, p. 613.

President's address, November, 1891.) On November 18, 1891, a set of rules was made applying the rules of 1889 to the Chartered Institute.

The rights and privileges granted to patent agents do not seem to be commensurate with the duties and responsibilities imposed upon them. They have no lien on documents, such as a solicitor possesses, though no doubt they have the usual common law lien on any document which they themselves have prepared or procured, or in respect of which they have paid fees or other money.

The Patent Agents' rules provided for the payment of an annual fee. This rule has been held invalid and ultra

post, p. 536.

vires by the Scotch courts: *Chartered Institute of Patent Agents* v. *Lockwood*, 1893, 10 R. P. C. 167. (An appeal has been lodged against this decision.)

post, p. 553.

Lists of patent agents can be purchased.

Elsewhere the very unsatisfactory state of the law relating to patent agents has been pointed out, and every day the number of unqualified persons who pretend to be patent agents is increasing. Ignorant inventors are being lured into taking out patents for inventions that are clearly old, and it is high time that a remedy should be applied to the evil. See the Presidental Address by Mr. Lloyd Wise to the Institute of Patent Agents, 1891. Proceedings, vol. x. p. 59; also a paper by A. V. Newton, *ibid.*

CHAPTER XV.

PROCEDURE TO OBTAIN A PATENT.

[N.B.—*For further details of Procedure the circular of information published by the Patent Office may be usefully consulted. It is printed in the Appendix.*] post, p. 541.

1. Whether to send in a provisional specification or a complete specification in the first instance.—There are two modes in which an inventor may proceed to take out a patent, viz., to file a provisional specification, and then, within nine months, to follow it with a complete specification, or else to file a complete specification at once. In considering which of these courses to pursue, it is to be remembered that the date of the patent, from which its life begins to run, is the date of the application: Patents Act, 1883, s. 13. The first date after which damages can be recovered is the date of the publication of the complete specification; but no legal proceedings can be commenced till the patent is sealed: sect. 15. A provisional specification, if abandoned, is not published, and hence does not prejudice a second or a third application for the same or another invention: Patents Act, 1885, s. 4. post, p. 447. post, p. 476.

From one point of view it is, of course, desirable to have an early date for the patent, for from the date of application no subsequent publication of the invention, or independent discovery of it by another, can vitiate it: Patents Act, 1883, s. 14. Hence, then, it may often be desirable to apply as early as possible, even before the post, p. 447.

CHAP. XV. SECT. 1.

Whether to send in a provisional specification or a complete specification in the first instance.

invention is complete in detail. On the other hand, its life begins to run from the date of the application; and hence, if the inventor could be certain that his discovery would not leak out or be made independently, he would desire to commence the life of the patent only when he was completely ready to carry it out, and obtain the acceptance of the complete specification as soon as possible after his application. The reason why inventors usually commence with the provisional specification is, that after that date they can then shew the invention to capitalists; and hardly any invention is thus shewn without suggestions in detail being made to render it more likely to be a commercial success, which details can then be embodied in the complete specification. Besides, inventors often draw their provisional specifications very badly, and then, if they succeed in finding a capitalist, the matter is placed in the hands of some patent agent in whom the capitalist has confidence, and it is not too late either to draw a really good complete specification, or, if needful, to abandon the old provisional specification and commence de novo. If it is possible to file a complete specification at once, there is this further advantage, that the risk of disconformity is avoided: see "Provisional Specification," Chap. VII., sect. 3. On the other hand, however, there is a danger in filing the complete specification too soon. For when it becomes public, all those who have pending applications, that is to say, who have sent in their provisional specifications, but not yet sent in their complete specifications, would be able to take from the complete so sent in any parts that pleased them, and which they could include within the limits of their provisional specifications; and as their date of application

ante, p. 171.

Whether to send in a provisional specification or a complete specification in the first instance.

would be prior to that of the inventor whose case we are considering, they could pilfer from him with impunity. From these considerations we derive the result, that where an invention is very original, quite complete, and not the least likely to be the subject of contemporaneous patents, an inventor, having scanned all pending applications, and finding that there is none whose title could cover his patent, might send in a complete specification in the first instance. In all other cases his wisest course would be to apply provisionally, and wait the full nine months before sending in his complete specification. (This question is very skilfully discussed by Mr. Lloyd Wise, in *Engineering*, date Jan. 29th, 1886.)

2. Procedure in sending in an application.— Having determined upon a title, and decided on the scope and nature of the invention, and fixed upon the parties who are to be the applicants (see "Who may be a Patentee," Chap. XIII., s. 1,), the applicant procures from the Royal Courts of Justice, Strand, London, or else from any money order office in the United Kingdom, Form A or A 1, as the case may be, for which he will pay £1. At the same time two copies of Form B will be given to him, which he must fill up carefully without erasure: Patents Act, 1883, s. 5. No stamp is required for them. (Paper suitable for continuations of Form B can be got at any law stationer's, known as patent paper.) He then sends in the application and the provisional specification to the Comptroller: Patent Rules, 1890, 18. Where needful a drawing must accompany the provisional: Patents Act, 1883, s. 5, sub-s. 3. But this is not commonly done, for the object of the provisional is not to describe how to perform the invention, but to identify it: Chap. VII., s. 2.

post, p. 542.
ante, p. 228.
post, p. 508.
post, p. 497.
post, p. 441.
post, p. 484.
post, p. 487.
post, p. 326.
ante, p. 169.

CHAP. XV. SECT. 2.

Procedure in sending in an application.

These are then submitted to an examiner (Patents Act, 1883, s. 6), whose duty is to report upon whether the nature of the invention has been fairly described, whether the application and specification are in due form, whether the title sufficiently indicates the subject-matter, and whether the specification includes more than one invention: Patents Act, 1883, s. 33; or whether it contains anything contrary to law or morality: Patents Act, 1883, s. 86.

post, p. 456.

post, p. 463.

post, p. 442.

ante, p. 161.

As to the provisional specification, see sect. 5, sub-s. 3, and as to title, see Chap. VI. The question what constitutes "one invention" was discussed in *Jones' Patent*, Griff, 265. Lord Herschell (then A.-G.), said: "If you have a particular general (*sic*) 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 it was one invention; but if there is no common purpose, so that you could say, 'I use this as a substitute for that,' . . . 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, then those are six inventions." An application was made for a patent for "improvements in rapidly heating water, a part of which improvements is applicable to other purposes." The invention consisted in a means of interlocking taps, so that they could only be turned on or off in a certain order. It was stated that this plan was also useful for the cocks of oxy-hydrogen and other apparatus. It was pointed out by Davey, S.G., that he might either have a patent for his combination of cocks, or for its

Procedure in sending in an application.

application to geysers, or for its application to oxy-hydrogen apparatus, but that these were distinct inventions, and required separate patents: *Hearson's Patent*, 1886, Griff. 266. Again, another inventor who proposed to patent "improvements in the art of producing and utilising induced electrical currents *for telegraphic and other purposes*," was informed that he could either patent it for *all* purposes, or else take out separate patents for its application to telegraphy and for its application to other subjects. The inventor preferred the former alternative, and the words in italics were struck out; *Robinson's Patent*, Griff. 267. An inventor who has included more than one invention in his application may amend it so as to apply to one invention only, or may make application for separate patents for the different machines: still preserving the date of his application. Patent Rules, 1890, 19.

post, p. 487.

3. If the patent is contrary to law or morality it may be refused: Patents Act, 1883, s. 86. A patent for a lottery machine has been thus refused: Griff. 20.

post, p. 463.

4. The report of the examiner is private, but may in certain cases be produced: Patents Act, 1883, s. 9, sub-s. 5. If the report is against the applicant he will receive by letter an intimation of the fact, and be required to amend or correct his application or specification. But he may appeal if he please from the decision of the Comptroller to the law officer: Patents Act, 1888, s. 7; and see Law Officer's Rules made under sect. 38. The Comptroller is not bound to follow the examiner's report: *C.'s Application*, 1890, 7 R. P. C. 250.

post, p. 444.

post, p. 443.

5. Acceptance of the application and provisional *post*, p. 443.

CHAP. XV. SECT. 5.

Acceptance of the application and provisional specification.

specification.—As soon as the Comptroller is satisfied with the application and provisional specification, he will intimate by letter that they have been accepted, and publish a notice of the acceptance in the official journal: Patent Rules, 1890, r. 21. The patentee has now got nine months from and exclusive of the day of application to send in his complete specification, which may be extended for one month more. The date of the application is the day on which it is received at the Patent Office, not the day on which it is dated. The last day of sending in the complete specification is the same day of the month nine months on. Thus, an application dated, say, March 20th, might be received at the office on March 21st. This would be the date of the application and of the patent. The complete would then have to be in the office on December 21st. Documents are received up to twelve midnight by the policeman on duty if the other officials have gone home.

P. Act, 1883, *sect.* 8, *post*, p. 382, *and* p. 371.

As to Sundays and holidays, see sect. 98, *post*, p. 350.

6. Sending in the complete specification.—This is done on Form C, in duplicate, stamped with £3, and is accompanied by duplicate drawings (a specimen of which is to be found in the copies of the Patent Rules, 1890, which are supplied by the Patent Office, price 6*d*. It is also printed in Griffin's Patent Cases, p. 326.) If a drawing has been sent in with the provisional specification, it will be sufficient to refer to it if no further one is needed: Patents Act, 1886, s. 2. The drawings must be carefully prepared, according to Patent Rules, 1890, rr. 30–33. They should be clear, and black, to facilitate photo-lithographic reproduction. As to the complete specification, see Chap. VIII. It must conform to the provisional, and should end with claims: Patents Act, 1883, s. 5, sub-s. 5;

ante, p. 201.

post, p. 477.

post, pp. 489, 544.

ante, p. 178.

post, p. 442.

though this is not fatal to its validity if it have been passed by the Comptroller: see "Claims," Chap. IX. By a distinct claim is meant more than a merely colourable evasion of the requirements of the Act; but when once there is a clear claim, the Comptroller has no power to reject the application, because the claim goes beyond the description: *Smith's Patent*, 1884, Griff. 268.

ante, p. 195.

For the purpose of seeing whether the complete specification is in due form, and whether it conforms to the provisional, it will be submitted to an examiner, who will report upon it: Patents Act, 1883, s. 9; and if his report is unsatisfactory, the applicant will, by letter, be required to amend it.

ante, pp. 215, 221.

If he please, the Comptroller who has required alterations to be made may postpone the date of the patent till his requirements are complied with: Patents Act, 1888, s. 2. The patentee can, if he please, appeal to the law officer: Patents Act, 1883, s. 9, sub-ss. 2, 3, and Law Officer's Rules; and see *e.g.*, *Re Everitt*, 1886, Griff. App. 27.

post, p. 444.

In the case of *Grenfell* v. *McEvoy's Patents*, the curious point was raised whether, when two persons had jointly applied for a patent, and jointly sent in a provisional specification, they could sever, and each send in a complete specification. This was not decided, but it was decided that one could proceed with the complete specification if he pleased, and that it need not be signed by both: 1890, 7 R. P. C. 151.

The fact that the complete specification is narrower than the provisional is no ground for the Comptroller refusing to accept it: *Re Everitt*, Griff. App. 27; but in that case he may, and ought to, require the applicant to amend the title and provisional if needful: *Dart's Patent*, Griff. 307.

ante, p. 221.

7. Acceptance of the complete specification.—As soon as the complete specification is accepted, the acceptance of it is published in the official journal, and the application, specifications, and drawings are open for public inspection: Patents Act, 1883, s. 10. The Comptroller also gives notice to the applicant: Patents Act: s. 7. sub-s. 4; Patent Rules, 1890, rr. 21, 22. This is an important date, as from it the possibility of infringement begins: Patents Act, 1883, s. 13. The specifications appear in print for sale about three weeks afterwards, and abstracts of them are given in the Patent Office Journal.

post, p. 445.
post, p. 487.
post, p. 447.
post, p. 552.

If the complete specification is not accepted within twelve months from the date of the application, or within a further extended period of three months, then, except where an appeal against a refusal to accept is pending, the application is void: Patents Act, 1883, s. 9, sub-s. 4.

post, p. 444.

8. Sending in the complete specification with the application: Patents Act, 1883, s. 5, sub-s. 4; as to the advisability of this, see Chap. XV., sect. 1.

ante, p. 237.

9. Rival applications; interference.—If, after a patent had been applied for, but before it had been sealed, a second application came in bearing the same or a similar title, it was, under the Patents Act, 1883, customary to give an interference notice to the first applicant, and to let the two applicants dispute the question before the Comptroller, under s. 7, sub-ss. 5 and 6. But by the Patents Act, 1888, s. 2, this was changed: see Chap. XVI.

post, p. 480.

No such notices are now sent, but the second applicant may at any time within two months of the grant of the patent on the first application abandon his application,

or surrender his patent if it have been granted: see Chap. XVI., sect. 2 (*post*, p. 246).

Rival applications; interference.

10. Powers of the Comptroller.—The Comptroller may require any applicant to give a written or oral explanation of any matter: Patent Rules, 1890, 13; and in all these cases of discretionary power of the Comptroller he is required (Patents Act, 1883, s. 94; Patent Rules, 11, 13), before deciding, to give ten days' notice to the applicant that he may be personally heard. If the applicant desires to be heard, he should then, within five days, give notice on Form E (£1 stamp): Patent Rules, 1890, r. 12. The Comptroller always notifies his decisions to the applicant: Patent Rules, 1890, r. 14. He has no power to award costs.

post, p. 485.

post, p. 465.

11. An appeal lies to the law officer from any decision of the Comptroller: Patents Act, 1883, s. 9, sub-s. 3. The Comptroller neither asks nor gives costs: see further Chap. XVI., sect. 8.

post, p. 444.

post, p. 255.

12. Amendments of the specifications have been already dealt with in Chap. XII.

ante, p. 215.

13. Constitution of the Patent Office and powers of the Comptroller are dealt with in Patent Act, 1883, ss. 82, 83, 102; and it is provided that he cannot exercise a discretion adversely without affording the person affected an opportunity of being heard: sect. 94; Patent Rules, 11–14. He may also dispense with evidence: Patent Rules, 80; and may refer doubtful questions to the law officer.

post, p. 462.

post, pp. 465, 485, 499.

post, p. 465.

CHAPTER XVI.

OPPOSITION TO THE GRANT OF A PATENT.

CHAP. XVI. SECT. 1.

1. Before the Patents Act, 1883, opposition to patents was regulated by the Patents Act, 1852, ss. 12, 13, 14, and the rules thereunder, and objections were referred to the law officer, and also could be taken before the Lord Chancellor. As a general rule, the sealing of the patent was not refused, except in a very clear case, on the ground that the effect of the refusal would be irreparable: *Russell's Patent*, 1857, 2 De G. & J. 130; *Spence's Patent*, 1859, 3 De G. & J. 523; *Ex parte Sheffield*, 1872, L. R. 8 Ch. 237, 42 L. J. Ch. 356.

2. Procedure under the Patents Act, 1883.—The old procedure is now abolished, and oppositions may now be made within two months after the advertisement of the acceptance of the complete specification, on which date the applications, specifications, and drawings become open to public inspection: Patents Act, 1883, s. 10. The procedure is regulated according to Patents Act, 1883, s. 11, Patents Act, 1888, s. 4, Patent Rules, 34–44, and Form D. In *Brennaud's Patent*, 1861, 7 Jur. 690, an extension of time for opposing was granted. See a paper by Mr. Lloyd Wise, in the "Proceedings of the Institute of Patent Agents," vol. 8, p. 90.

post, pp. 445, 491.

3. Grounds of opposition.—The only grounds upon which an opposition may be made are those specified in s. 11 of Patents Act, 1883, as amended by Patents Act, 1888, s. 4. In substance they are: (*a*) That the applicant has derived the invention from the opponent or an invention of whom the opponent is the legal representative, or his legal representatives; (*b*) That the invention has already been patented on an application of prior date; (*c*) That the applicant, after lodging his provisional specification, has incorporated into his complete specification a different invention, for which the opponent has, in the interval, applied for a patent.

4. Opposition on the ground that the invention has been obtained from the opponent.—The obtaining must be within the United Kingdom, and not abroad. For an introducer is on the same footing as an inventor. Hence, no opponent can appear to say that the applicant has merely got the invention from him abroad: *Edmunds' Patent*, 1886, Griff. 281; *Bairstow's Patent*, 1888, 5 R. P. C. 287; *Lake's Patent*, 1888, 5 R. P. C. 415; *Spiels' Patent*, 1888, 5 R. P. C. 281; *Higgins' Patent*, 1892, 9 R. P. C. 74; see also Chap. XIII., sect. 7. *ante*, p. 232.

But even when the applicant obtained the invention from the opponent with his consent in the United Kingdom, the patent was refused, as the applicant was not the first and true inventor: *Marshall's Patent*, 1888, 5 R. P. C. 661. *ante*, p. 229.

It is to be observed, that only the person from whom the invention has been obtained, or his legal representative, can oppose under this section, and it has been held that an assignee of an assignee is not sufficiently a "legal representative": *Spiels' Patent*, 1888, 5 R. P. C. 281; and it has been queried whether a person holding a power of

CHAP. XVI. SECT. 4.

Opposition on the ground that the invention has been obtained from the opponent.

attorney is a "legal representative": *Edmunds' Patent*, 1886, Griff. 280. Probably the words here have the same meaning as in Patents Act, 1883, s. 34.

An opposition was made on behalf of a workman to a grant to his employer, but it was considered that the workman in that case had only suggested improvements which belonged to his employer: *David's & Woodley's Patent*, 1886, Griff. App. 26; *Homan's Patent*, 1888, 6 R. P. C. 104; see further, Chap. XIII., sect. 6 (p. 230).

In the following cases the opposition was successful: *Paterson & Dundon's Patent*, 1886, Griff. 295; *Griffin's Patent*, 1888, 6 R. P. C. 296.

In order that a patent may be refused on the ground that the invention was obtained from the opponent, the evidence must be very strong indeed; for that ground of opposition could always be employed to overturn the patent in an action: *Stuart's Application*, 1892, 9 R. P. C. 452.

Cases, however, may arise in which the idea of the invention has been got from an opponent, and yet has been so improved upon as to change the character of the invention. In these instances it is not necessary that the patent should be absolutely refused. Conditions may be imposed. Thus, where Hoskins had obtained from Needham an idea of a cot, held, he might have a grant, but on condition of stating that it was an improvement on a cot for which Needham had taken out provisional protection: *Hoskins' Patent*, 1884, Griff. 291; followed in *Newman's Patent*, 1887, 5 R. P. C. 279. Cutting and Evans had been experimenting together, and Cutting took out a patent which Evans did not oppose. Subsequently, Evans and Otway (a capitalist) applied for a

Opposition on the ground that the invention has been obtained from the opponent.

patent, which Cutting opposed. Held, that a patent would be granted to Evans and Otway on condition that Cutting and Evans each assigned half his patent to the other. Otway subsequently disappeared and could not be found, so finally an order was made that a patent be *not* granted to Evans upon Cutting assigning to him half of his patent: *Evans' Patent*, 1885, Griff. 279. Tatham opposed Luke's application on the ground that Luke had obtained the invention from him. The law officer made them share the patent, and provided for the event of either of them refusing to carry out his order: see the form of order, *Luke's Patent*, 1886, Griff. 294. Where B. had communicated an idea to E., who improved upon it, and suggested a joint patent, on B.'s opposition the patent was directed to issue to B. and E. jointly: *Eadie's Patent*, 1885, Griff. 279. King and Garthwaite were joint inventors, and had each applied for a patent. On King's opposition to Garthwaite's patent, it was held, that they must either have a joint patent or else each take out a patent and assign one half to the other: *Garthwaite's Patent*, 1886, Griff. 284.

5. Opposition on the ground that the invention had been previously patented on an application of prior date.—This was formerly a well known ground of opposition: see, *e.g.*, *Stoll's Patent*, 1853, 21 L. T. 233; *Tolson's Patent*, 1856, 6 De G. M. & G. 422; *Ex parte Yates*, 1869, L. R. 5 Ch. 1; *Manceaux's Patent*, 1870, L. R. 6 Ch. 272, 18 W. R. 1184; *In re Scott & Young*, 1871, 19 W. R. 425.

It is not open to anyone to oppose on the ground that a prior patent for the same invention exists: *Hookham's Patent*, 1886, Griff. App. 32. The opposer must be the

CHAP. XVI. SECT. 5.

Opposition on the ground that the invention had been previously patented on an application of prior date.

prior patentee, or else a licensee of the prior patentee: *Hill's Application*, 1888, 5 R. P. C. 599; *Webster's Application*, 1888, 6 R. P. C. 165; or one who has purchased the prior patent, or worked under it, even though it has expired: *Glossop's Patent*, 1884, Griff. 285. But merely to have manufactured according to the prior patent is not sufficient: *MacEvoy's Application*, 1888, 5 R. P. C. 285; nor to be intending to use the prior patent: *Bairstow's Patent*, 1888, 5 R. P. C. 286; nor has the agent of a prior patentee a locus to oppose: *Heath & Frost's Patent*, 1886, Griff. 288.

An objection on the ground of a prior patent is equally good whether the prior patent has or has not expired: *Lancaster's Patent*, 1884, Griff. 293. An accepted prior complete specification is, for the purpose of opposition, sufficient, though the patent may not yet have been sealed, by virtue of s. 15, Patents Act, 1883: *L'Oiseau & Pierraud's Application*, 1886, Griff. App. 36. But a prior provisional specification for the same invention is not enough: *Bailey's Patent*, 1886, Griff. 269; nor, again, is a mere right to have a patent antedated under s. 103, Patents Act, 1883: *Everitt's Application*, 1888, Griff. App. 28.

post, p. 447.

But it is no objection to the sufficiency of a prior patent as giving locus to oppose that the invention has been put in the complete specification, but is not contained in the provisional: *Green's Patent*, 1886, Griff. 286; *Haythornthwaite's Application*, 1890, 7 R. P. C. 70.

post, sec. 6, p. 253.

A prior invention that has been merely *described*, but not claimed, will not afford a ground of opposition: *Von Buch's Application*, 1887, Griff. App. 40.

The earlier view, that patents are not to be refused on mere suggestion of prior patents having been taken out

Opposition on the ground that the invention had been previously patented on an application of prior date.

for the same invention, has been re-affirmed in the cases since 1883. "I am not here to stop patents, and certainly not at the instigation of an opponent because there is some general principle of patent law that has been infringed": *Newman's Patent*, 1887, 5 R. P. C. 277; *McHardy's Patent*, 1891, 8 R. P. C. 432; *Re Todd*, 1892, 9 R. P. C. 487. "By allowing a specification in any particular form no harm is done to persons who have a prior patent . . . but the law officer is bound to protect the public, so that they may not be misled" (*per* Webster, A.G.); opposition disallowed: *Lorrain's Patent*, 1888, 5 R. P. C. 143; *Hill's Application*, 1888, 5 R. P. C. 599. In *Tattersall's Patent* it appeared that the second patent for a blower was very similar to the first on which the opposition was based, except that it provided for a receiver into which the blown air was to be gathered before being used. Held, that this was a possible improvement, and the second patent (subject to the insertion of a disclaimer of the first), was allowed to go: 1892, 9 R. P. C. 150; *Atherton's Application*, 1889, 6 R. P. C. 547. A real dispute as to an anticipation will not be tried under guise of an opposition, nor for that purpose will evidence be taken before the law officer: *Lake's Application*, 1889, 6 R. P. C. 548. Examples of successful opposition on the ground of a prior patent are to be found in *Daniel's Patent*, 1888, 5 R. P. C. 413; *Aire & Calder's Patent*, 1888, 5 R. P. C. 345; *Wallis & Radcliffe's Patent*, 1888, 5 R. P. C. 347; *Webster's Patent*, 1888, 6 R. P. C. 163; *Re Bailey*, 1887, Good. Prac. Cas. 57; *Boult's Patent*, 1893, 10 R. P. C. 275. The alleged anticipation must be clear and definite, and not depend on the piecing together of a number of prior patents: *Re Ross*, 1891, 8 R. P. C. 477.

Unsuccessful oppositions—*Pitt's Patent*, 1888, 5 R. P. C.

CHAP. XVI. SECT. 5.

Opposition on the ground that the invention had been previously patented on an application of prior date.

343; *Dundon's Patent*, 1885, Griff. 278; *Huth's Patent*, 1884, Griff. 292; *Fletcher's Patent*, 1889, Griff. App. 30; where the inventions were almost, but not quite, identical. See also *Cumming's Patent*, 1884, Griff. 277; *Stubbs' Patent*, 1884, Griff. 298; *Jones' Patent*, 1885, Griff. App. 33.

It is frequently usual, upon an opposition to a grant on the ground of a prior patent, to impose on the applicant the condition of disclaiming the prior invention: *Curtis* v. *André*, 1892, 9 R. P. C. 495. The disclaiming clause must disclaim not merely the invention as *described*, but as *claimed*: *Gozney's Application*, 1888, 5 R. P. C. 597. Sometimes a specific disclaimer naming the prior patent is required: *Hall & Hall's Patent*, 1888, 5 R. P. C. 283; *Welch's Patent*, 1885, Griff. 300; *Airey's Patent*, 5 R. P. C. 348; *Lynde's Patent*, 1888, 5 R. P. C. 663; and this specific disclaimer is especially enforced when the applicant's patent contains a specific reference to the prior patent: *Hookham's Patent*, Griff. App. 32; *Wallace's Patent*, 1888, 6 R. P. C. 134; or again, where the prior patent is a "master patent": *Hoffman's Patent*, 1890, 7 R. P. C. 92. But otherwise specific mention of previous patents in disclaimers is not generally desirable: *Andersen & Mackinnell's Patent*, 1887, Griff. App. 25, approved in *Sielaff's Application*, 1888, 5 R. P. C. 484; *Guest & Barrows' Patent*, 1888, 5 R. P. C. 312; *Stell's Patent*, 1891, 8 R. P. C. 235; *Kilner's Patent*, 1891, 8 R. P. C. 35; *Welch's Patent*, 1891, 8 R. P. C. 442; and where a disclaimer might prejudice the construction of a patent a similar reference to the prior patent may be sufficient: *Van Gelder's Patent*, 1892, 9 R. P. C. 325. A successful opponent is sometimes allowed to elect whether applicant's claim should be struck out or a disclaiming clause inserted: *Teague's Patent*, 1885, Griff. 298.

6. Opposition on the ground that the applicant is seeking to put into his complete specification an invention for which the opponent has applied for a patent in the interval between the applicant's provisional and complete specifications: *Andersen & Andersen's Patent*, 1890, 7 R. P. C. 323. In the older cases the person who by diligence could first get his patent sealed was allowed the patent: *Ex parte Dyer*, 1812, Holroyd, 59; *Re Sampson*, 1853, 21 L. T. 81; *Bates & Redgate's Application*, 1869, L. R. 4 Ch. 577; 38 L. J. Ch. 501; *Henry's Application*, 1872, L. R. 8 Ch. 167, 42 L. J. Ch. 363. This was called "racing for a patent," or "racing for the seal." But this procedure was disapproved by Lord Cairns: *Re Dering*, 1880, 13 Ch. D. 393. Sometimes where the applications were concurrent, joint patents were granted: *Heath* v. *Smith*, 1854, 2 W. P. C. 271; or else if the inventions were different they were severed: *Macfarlane's Application*, 1883, Johns. 165. This racing for a patent was stopped to some extent by the Patents Act, 1883, which antedated the grant to the date of application. But a danger was still left, for if A. had (provisionally) applied, say, on January 1st, and B. on February 1st, then A., if he could discover B.'s invention, and if his provisional specification were sufficiently wide, might incorporate into his complete specification what was really B.'s invention, and retain it against B. On the other hand, B. was unable to do this as against A., whose priority of application always protected him. B. thus required protection against A. The Patents Act, 1883, s. 11, instead of giving this protection to B., only aggravated the evil by allowing A. to put what he pleased into his complete specification, to the detriment of B., even though by this disconformity was produced

post, p. 445.

in A.'s patent, and then when he had thus practically ruined B.'s patent, he was also allowed to oppose the grant of it: *Green's Patent*, 1886, Griff. 286. This glaring injustice was remedied by the Patents Act, 1888, s. 4.

post, p. 445

7. Hearing before the Comptroller.—The notice of opposition must be accurately drawn, and as a rule oppositions will not be allowed on grounds which have not been given in the notice (Patent Rules, 1890, r. 42). In a notice of opposition on the ground that the invention has been patented before, the title, name, and date of the prior patent must be given. But a defect in this respect has been allowed to be amended at the hearing: *Airey's Patent*, 1888, 5 R. P. C. 349; and where a patent agent died after the notice, but before the hearing, the notice was allowed to be amended by inserting the opponent's name: *Lake's Application*, 1887, Griff. App. 35. The notice should not state that the invention is "substantially the same": *Jones' Patent*, 1886, Griff. App. 33; nor should it say that the invention, "or material parts thereof," are the same: *Fawcett's Application*, 1889, Good. P. P. 10; for this would be to raise the question of construction and of infringement, which could not be tried. It is only cases of substantial *identity* which are the grounds of opposition.

The Comptroller cannot take oral evidence; hence, when it is desired to try the case on examination and cross-examination of witnesses it is usual to take merely a formal order from the Comptroller, and then to appeal to the law officer, who has full powers in this respect: *Luke's Patent*, 1886, Griff. 294; *Hatfield's Patent*, 1884, Griff. 288. The Comptroller cannot give costs.

Where an opponent did not appear owing to not having

received the notice of the day fixed for hearing, and the Comptroller declined to re-hear, the law officer directed him to do so: *Warman's Application*, 1886, Griff. App. 43.

Hearing before the Comptroller.

8. Appeals to the law officer.—The time for appeal dates, not from the hearing, but from the time when the order or amendment is made after that hearing: *Chandler's Patent*, 1887, Griff. 270; *Cooper & Ford's Patent*, 1886, Griff. 275. Every appeal is a re-hearing: *Stubbs' Patent*, Griff. 298; but in general fresh evidence will not be allowed which might have been produced before the Comptroller: *Hampton & Facer's Patent*, 1887, Griff. App. 13. An appeal is allowable, though it does not ask that the grant should be refused, but only that terms should be imposed: *Brownhill's Patent*, 1889, 6 R. P. C. 135. The applicant usually begins, except where an opponent alleges fraud: *Luke's Patent*, 1886, Griff. 294. Notice of appeal need not be given to the applicant by an opposer, but is to be given by the Patent Office or official clerk: *Hill's Application*, 1888, 5 R. P. C. 599. On the non-appearance of a party costs can be given against him: *Dietz' Patent*, 1889, 6 R. P. C. 297; *Ainsworth's Patent*, 1886, Griff. 269; in which latter case a re-hearing was fixed on the respondent's explaining his absence. An appellant withdrawing his appeal may also be compelled to pay costs: *Knight's Application*, 1887, Griff. App. 35.

see Law Officers' Rules, post, p. 500.

As a rule the costs of the opposition will follow the event: *Anderton's Patent*, 1886, Griff. App. 25; except where an opponent who successfully demanded an alteration in certain terms ought to have asked the applicant to consent to it before appealing: *Woodhead's Application*, 1887, Griff. App. 44. As the Comptroller cannot take

CHAP. XVI. SECT. 8.

Appeals to the law officer.

oral evidence, nor have a cross-examination conducted before him, it is important that the declaration should be in the fullest good faith, and, therefore, when the applicant's declaration did not give the whole truth he was not allowed the costs even when successful on an appeal: *Anderton's Application*, Griff. App. 25. On appeal, each party should hand in a statement of what fees have been paid by him, so as to enable the law officer to fix the costs at once (*per* Webster, A.G.): *Sielaff's Application*, 1888, 5 R. P. C. 487. A stamp of £3 on the appeal will be allowed as part of these costs: *Aire & Calder's Patent*, 1888, 5 R. P. C. 345.

The law officer has power to order the assistance of
post, p. 446. an expert (Patents Act, 1883, s. 11, sub.-s. 4), but this power is not often exercised. He has once looked at a model which had not been properly made an exhibit, but only to explain the drawings, not as evidence: *Lancaster's Patent*, 1884, Griff. 293.

The decision of the law officer is not reviewed on
ante, p. 219. appeal by way of prohibition: *Van Gelder's Patent*, 1888, 6 R. P. C. 22.

9. Opposition on the ground of fraud.—Prior to the Act of 1883 there was always a jurisdiction in the Court to prevent an inventor being robbed of his invention by a fraudulent application made by some other person: *Ex parte Scott* v. *Young*, 1871, L. R. 6 Ch. 274. The Act
post, p. 456. of 1883, s. 35, provided that "a patent granted to the first and true inventor shall not be invalidated by an application in fraud of him, nor by provisional protection obtained thereon, nor by any use or publication of the invention subsequent to that fraudulent application during the period of provisional protection:" see also

Edmunds' Patent, 1886, Griff. 283; *Anderson's Patent*, 1890, 7 R. P. C. 324; and *Fiechter's Patent*, Griff. 284; *re Hetherington*, 1889, 7 R. P. C. 419.

Opposition on the ground of fraud.

(N.B.—Mr. Goodeve has published a useful abstract of cases decided by the Comptroller and law officers, 1893.)

CHAPTER XVII.

THE GRANT OF THE PATENT.

CHAP. XVII. SECT. 1.

1. Form of the grant.—Under the Patents Act, 1883, s. 12, the patent is sealed with the Patent Office seal, which has the same effect as the Great Seal of the United Kingdom, and by sect. 84 is to be judicially noticed and given in evidence. The time for sealing is within fifteen months of the date of application, except where (1) the sealing is delayed by an appeal or opposition to the grant; (2) where the applicant dies within fifteen months; (3) where the time for leaving the complete specification has been extended: Patents Act, 1883, s. 12, sub-s. 3, and Patents Act, 1885, s. 3. The grant may be in the form in the first schedule to the Patents Act, 1883 (s. 33), which form may, however be altered or amended by the Board of Trade under sect. 101, sub-s. 2. There are now in use eight special forms of grant, the different forms being modified to suit the cases: (A) single inventor, (B) joint inventor, (C) importer, (D) joint applicants, some of whom are inventors, (E) legal representatives of a deceased applicant, (EE) legal representatives of a deceased inventor, (F) to a female applicant, (G) joint applicants where one of the original applicants is dead.

post, p. 463.

post, p. 446.

post, p. 456.

post, p. 467.

Form of the grant.

Form A of a grant to a single inventor is as follows, slightly altered from the Form given in the Schedule to the Act of 1883, by leaving out after the word "hath" * the words "by his solemn declaration," which, by virtue of Patents Act, 1885, s. 2, and Patent Rules, 1892, 5 (2), is now no longer required.

post, p. 442.

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:

Whereas *John Smith*, of 29, *Perry Street*, *Birmingham*, in the county of *Warwick*, *Engineer*, hath * 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

Note (*a*)

Note (*b*)

Note (*c*)

Note (*d*).

CHAP. XVII. SECT. 1.

Form of the grant.

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 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

Note (*e*).

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 com-

Form of the grant.

missioners 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 other of the said cases, these our letters patent, and all privileges and advantages whatever hereby granted shall determine and become void notwithstanding anything herein-before 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

Note (*f*).

Seal of Patent Office.

2. Note (a).—The ordinary effect of a recital in a grant would be to bind the grantor by estoppel, but it is different in the case of the Crown. For here the recitals are taken to be on the suggestion of the grantee, and hence each one of them must be strictly true, or else the grant is void. The leading case on this subject is *The Alton Woods Case, R.* v. *Bushopp*, 1600, Coke's Reports, pt. 1, p. 40 b. This was a grant by letters patent of Henry VIII. The note by Sir E. Coke contains a treatise on the whole subject, and especially as to estoppels. In the body of the case it is reported (p. 43 a): "It was said by some that the recital shall conclude the King, according to the opinion in

CHAP. XVII. SECT. 2.

Note (a)

9 Hen. VII., 2 a; but the two Chief Justices did deny that, for the King shall not be concluded to shew or to say the truth, but the law shall adjudge him rather to be deceived." On referring to the case in the year books, 9 Hen. VII., 2 a, we find a distinction drawn between patents which contain the words "ut informamur" and those which contain "ex certa scientia et mero motu,"

ante, p. 14.

the Court being of opinion that the former words clearly gave the Crown a right to say that it had been wrongly informed, but the latter words (called an assertive clause), took that right away. This view, however, did not prevail in Coke's time, where it was held that the certain knowledge here spoken of was only "verity, which is the proper object of science, and not of falsity, which is a 'non-ens,' and thereof the King cannot have knowledge": see Coke's note, C. 3, p. 43 b. In other words, the certain knowledge must be knowledge of what is true and not what is false; and hence, when the King, in a recital, says he "knows" a thing, it must be taken that he knows it if it is true, but not otherwise. This after all is no more than a repetition of the doctrine that estoppels do not bind the King. For if he is not estopped by the recital of a fact, how can he be estopped by a recital "that he knows of certain knowledge that it is a fact?" If he may go behind one, he may go behind the other. In the case cited it was accordingly held that the words "ex gratia speciali certa scientia et mero motu" did no more than provide that the grant should be "favourably taken for the patentee," but created no estoppel of what was recited in the recitals: 46 b; see also as to recitals, 1 W. P. C. 41, and 2 Bl. Comm. Ch. 21,

ante, p. 203.

and Chap. XI., sect. 1. From this it follows that though the grant recite "the inventor hath, by and in his

complete specifications, particularly described the nature of his invention," yet that if in fact he has not done so, the recital is false, the King deceived, and the patent void; and so with the other recitals. Note (a).

3. Note (b).—The word "patentee" means persons for the time being entitled to the benefit of the patent: Chap. XIII.; and by the prior recital in the patent includes executors, administrators, and assigns. This shews that the patent is a chattel, but of an incorporeal character. And were it not for the above words, would be personal to the patentee, and not assignable (*per* Littledale); *Duvergier* v. *Fellows*, 1830, 10 B. & C. 829.

4. Note (c).—The area of the patent includes the Isle of Man and used to include the Channel Islands, but this is no longer so. They are excluded from sect. 16 of the Act, but there is a process of registration by which an English patent may be extended to the Channel Islands. Note also sect. 117. *post*, p. 448. *post*, p. 484.

5. Note (d).—Formerly the grant contained clauses enabling constables to enter and search dwellings for prohibited contraventions; but these clauses have been long disused.

6. Note (e).—The provision that the grant shall be void "if it be made to appear to us or six or more of our Privy Council, etc.," enables the Crown to revoke the patent if it be not new, or contrary to public policy. But, quite apart from this, any false suggestions or illegality in the grant would always have rendered it liable to revocation upon a *scire facias* being brought.

CHAP. XVII. SECT. 6.

Note (*e*).

The word "us" means of course the Courts of Law, in which the King is always supposed to be present, and gives no power to the King to revoke a patent, except by regular process. The provision that the grant may be revoked if six or more of the Privy Council shall find it illegal, is very old, and appears in early patents. The first instance of its use is in a patent (No. 26, 1623) to Gormeldon. The clause then seems to have been disused. It reappears again in 1632, since which time it has been always, or almost always, inserted. It would not, however, give the Privy Council power to revoke a patent nor enable a petition to be presented there for its revocation. For by the second section of the Statute of Monopolies, it is expressly provided that all patents and charters for monopolies shall be examined, tried, and determined according to the Common Laws of the realm. And the Privy Council does not possess the requisite machinery for a regular common law trial of a patent. It is difficult to see why the words were originally introduced, and still more difficult to see why they are now retained. It is possible that they were inserted with a view of endeavouring to preserve the jurisdiction of the Star Chamber. For up to the time of the abolition of that Court, the number of councillors who sat to hear ordinary causes was six, and a portion of its regular work was to inquire into forestalling and repeating; and quite up to the end of the reign of Charles I. we find persons cited before it for breach of the laws affecting trade and commerce, and fined, or obliged publicly to stand in the streets with a paper attached to them specifying their offences. The Star Chamber also always claimed jurisdiction to inquire into and examine the validity of all Royal grants. The decrees of the Star Chamber have

unfortunately perished by fire, but the bills and pleadings exist, and specimens are to be found in Rushworth's collection.

Note (e).

Both Clarendon and Coke bear witness to the fact that infringers of monopoly grants were summoned before it, but few instances will probably be found of Star Chamber patent cases after the date of the Statute of Monopolies. See Hudson's treatise on the Star Chamber.

7. Note (f).—As to the beneficial construction, see note (a) above, and "Construction of Specifications," Chap. XI., sect. 1. *ante*, p. 203.

8. Duration of the grant.—A patent thus granted is for fourteen years from the date thereof. *post*, p. 448. It is dated as of the same date as the day of the application. *post*, p. 447. This period is computed inclusively of the day of application, so that a patent dated Feb. 26th, 1825, would expire at midnight, Feb. 25–6, 1839: *Russell* v. *Ledsam*, 1845, 14 M. & W. 574, 16 M. & W. 633, 14 L. J. Ex. 353, 1 H. L. C. 687 (*per* Parke, B., whose decision, though reversed, was affirmed so far as the computation of the time of expiry was concerned). The patent thus granted ceases, however, if the patentee fails to make the proper payments. The dates for making these payments are specified in the table of fees, and the time for making them is computed exclusively of the date of the patent: *Williams* v. *Nash*, 1859, 28 Beav. 93, 28 L. J. Ch. 886. *ante*, p. 242. *post*, p. 270.

Therefore, if a patent were dated May 1st, 1890, the first renewal fee would have to be paid on May 1st, 1894, but the patent would expire at midnight on April 30th, 1904.

No proceedings can be commenced for infringement

CHAP. XVII. SECT. 8.

Duration of the grant.

until the patent is sealed, and then only for infringements committed after the acceptance of the application: Patents Act, 1883, sect. 15.

9. Lost Patent.—If a patent is lost or destroyed or its non-production accounted for to the satisfaction of the Comptroller, a duplicate may be sealed: Patents Act, 1883, sect. 37.

post, p. 457.

10. Sealing of a patent in respect of an invention for which a prior patent has been obtained is permissible, provided the patent so sealed was on an earlier application: Patents Act, 1883, sec. 13.—For the intention of the Act is that patents shall date and take effect, not from the actual day on which the Great Seal is affixed to them, but from the date of their application.

post, p. 417.

CHAPTER XVIII.

THE REGISTER OF PATENTS.

The keeping of the register.—This is governed by Patents Act, 1883, ss. 23, 85, 87, 88, 89, 90, 91, 93, 101, 114, and Patent Rules, 1890, 67–79, which point out the procedure to be followed by any person applying to have any matter relating to the patent registered. The register contains a notice of the grant, any assignments, mortgages, licenses, extension, or revocation, together with a note of what fees have been paid. The register is open for inspection, and copies may be taken.

post, pp. 451, 463, 496.

Trusts are not entered on the register: Patents Act, 1883, s. 85; but an equitable assignment of a share of a patent is more than a mere trust, and should be registered: *Stewart* v. *Casey*, 1891, 8 R. P. C. 259; contrary to the previous decision in *Haslett* v. *Hutchinson*, 1891, 8 R. P. C. 457. The register may be rectified by order of Court: sect. 90. Clerical errors may be altered by the Comptroller: sect. 91; and false entries punished: sect. 93.

post, p. 473.

post, p. 474.

ante, p. 226.

post, p. 431.

The Comptroller is not bound to enter on the register of any patent an assignment not specifically relating to that patent. Thus, an agreement relating

CHAP. XVIII.

The keeping of the register.

generally to "future" patents would not be registered. Again, the Comptroller is not obliged to register, until the patent is taken out, an agreement which had been made previously: *Parnell's Patent*, 1888, 5 R. P. C. 126.

If a deed is made, either fraudulently: *Green's Patent*, 1857, 24 Beav. 145; *Morey's Patent*, 1858, 25 Beav. 581; or which is clearly ultra vires on the part of the grantor, as if it purported to assign a patent belonging to someone else, the register may be corrected by expunging it: *Horsley & Knighton's Patent*, 1869, L. R. 8 Eq. 475, 39 L. J. Ch. 157. There used formerly to be no appeal against the order of the Master of the Rolls for rectifying the register: ibid.; but now the rectification is done by the H. C. J.: Patents Act, 1883, s. 90; and see *Morgan's Patent*, 1876, 24 W. R. 245; *Myer's Patent*, 1882, W. N. 1882, 53; and an appeal would lie.

post, p. 464.

Registration is necessary to give third parties notice of an assignment, and used formerly to be necessary to enable an assignee to sue a third party: *Chollett* v. *Hoffman*, 1857, 7 Ell. & B. 686, 26 L. J. Q. B. 249; but not as between assignor and assignee. It may perhaps be doubted whether registration is now needful to enable a plaintiff to sue: see "Action of Infringement," Chap. XXVIII., sect. 2. When an assignment is registered (semble), that the registration dates back to the date of the assignment, so as, under the old law, to enable an assignee to sue, not as from the date of the registration, but as from the date of the assignment: *Hassall* v. *Wright*, 1870, L. R. 10 Eq. 509.

post, p. 357.

Registration is notice to the world of the ownership of a patent, but not necessarily of all the terms and conditions of the assignment, so that where a license had

been granted to a person for a particular district, purchasers who bought in good faith patented articles out of the district were not held to infringe by bringing them into the district: *Heap* v. *Hartley*, 1889, 42 Ch. D. 461, 6 R. P. C. 495.

The register is *primâ facie* evidence of any matters contained therein. *post*, p. 451.

The seal of the Patent Office is also to be judicially noticed: Patents Act, 1883, sects. 84, 89. *post*, p. 453.

As to enrolment in Scotland and Ireland, see Patents Act, 1883, sect. 100. *post*, p. 456.

CHAPTER XIX.

FEES.

CHAP. XIX. SECT. 1.

1. The fees to be taken under the Patents Acts are regulated by Patents Act, 1883, s. 24; Patent Rules, 1890, rr. 4, 75, 76. A new schedule of fees came out on October 1st, 1892.—These fees are very easy to recollect; £1 is charged on application, £3 on sending in the complete, and then in respect of the fifth year of the patent £5; the sixth year £6; and so on for each year as many pounds as the years of the life of the patent. If the fees are not paid at the proper time the patent lapses. The Patent Office is open from 10 to 4 every day, except the public holidays: Patent Rules, 1890, r. 7; and the time for payment of the fees excludes the day of the date of the patent: *Williams* v. *Nash*, 1859, 28 Beav. 93.

post, pp. 451, 493, 505.

post, p. 448.

post, p. 484.

ante, p. 265.

Where a patentee contracts to complete the patent, he is not bound to go on and pay the fees to the end of its life; he has done his duty if he files the complete specification and obtains the grant: *Seguelin* v. *Terrell*, 1867, 16 L. T. (N.S.) 539.

2. Enlargement of time for paying the renewal fees may be granted up to three months: Patents Act, 1883, s. 17, on payment of enlargement fees as prescribed in the schedule.

post, pp. 448, 551.

For form of application see Patent Rules, 1890, r. 49, and Form R. (*post*, p. 377).

Enlargement of time for paying the renewal fees.

After the time for enlargement has passed, a patentee's only remedy is to obtain a private Act of Parliament extending the time. In 1887 a Select Committee reported that Extension Acts ought not to be granted without serious illness or some other similar cause, and that clauses should be put in for the protection of those who may have infringed after the publication of the lapse of the patent in the official journal. For an example of an extending Act where the assignees had omitted to pay the fee through illness, see Potter's Patents Act, 50 & 51 Vict. c. cxxi., 1887. These Acts are usually obtained with the aid of parliamentary agents. For an example of the advertisement employed, see official journal, May 25, 1892, p. 1.

Formerly, notice of the impending expiration of the time for paying fees used to be given to patentees. This is now no longer done.

3. Stamps.—The fees, as in cases of judicial fees, are charged by means of stamps.

4. The Privy Council fees are given in a Table in the Appendix.

CHAPTER XX.

THE CROWN.

CHAP. XX.

Prior to the Act of 1883 the Crown was not restricted in using an invention by reason of the grant of letters patent: *Feather* v. *The Queen*, 1865, 6 B. & S. 257. But a mere contractor for the Crown was liable: *Dixon* v. *Small Arms Co.*, 1875, L. R. 10 Q. B. 130, 1 App. Cas. 632. But this is now altered by the Patents Act, 1883, s. 27, sub-s. 1, which provides that a patent shall have to all intents the like effect as against the Queen as it has against a subject, with, however, the proviso (sub-s. 2) that the Crown may use the invention upon terms to be settled by agreement, or in default of agreement, by the Treasury (see also sect. 44).

post, p. 454.

post, p. 459.

In granting extension of patents, it used to be customary to insert a clause in favour of the Crown: see "Extensions of Patents; Conditions," Chap. XXV., sect. 17); but this has not been done since the Act of 1883, though there is nothing to prevent its being inserted if the Judicial Committee thought fit: Patents Act, 1883, s. 25, sub-s. 5.

post, p. 452.

The Science and Art Department has a right to demand models of patented inventions on paying for them: Patents Act, 1883, sect. 42.

post, p. 458.

Subject as aforesaid the Crown's prerogative is expressly saved, sect. 116.

post, p. 474.

CHAPTER XXI.

FOREIGN GOVERNMENTS.

The rights of foreign governments not to be made amenable to the laws of Great Britain, have always been recognised. A patentee had obtained an injunction against the agent of a foreign government which had bought some shells in Germany and brought them to England to be put on board a ship of war. The patentee applied to have the shells delivered up to be destroyed. Held, that before making the order, the foreign government which owned the shells must be before the Court, and the foreign government having been made a defendant, was allowed to remove the shells, notwithstanding the injunction: *Vavasseur* v. *Krupp*, 1878, 9 Ch. D. 351.

post, p. 404.

CHAPTER XXII.

ASSIGNMENT; DIVISION; MORTGAGE; AND DEVOLUTION OF PATENTS BY DEATH OR BANKRUPTCY. CO-OWNERSHIP AND PARTNERSHIP IN PATENTS.

CHAP. XXII.

1. Assignments.—An inventor has no property in his invention analogous to a copyright, for all monopolies are illegal unless allowed by a patent; and hence it is not the invention that he may assign, but the patent: *Duvergier* v. *Fellows*, 1830, 10 B. & C. 829. But breach of an agreement to keep an invention secret gives rise to damages: *Smith* v. *Dickinson*, 1804, 3 B. & P. 630; though an injunction to restrain a person from revealing a secret invention will not in general be granted unless it has been revealed for the purpose of taking out a patent.

The form of grant of a patent gives a right to the patentee to assign it, without which form it would be unassignable: see *Duvergier* v. *Fellows*, cited *supra*.

ante, p. 263.

An assignment may be made to any person, or number of persons, capable of holding a patent, including a corporation or public company: Patents Act, 1883, s. 117, sub-s. 1. The former law, that the patent became void if vested in more than a given number of persons, has been abolished.

post, p. 474.

An assignment must be by deed. This rests on two

grounds, first, that it is an incorporeal chattel: Co. Litt., 9 C.; and secondly, on the principle that that which cannot be created without deed cannot be assigned without deed: Coke's Rep., part 3, 63 a; Morris on Patent Conveyancing, p. 111; *Stewart* v. *Casey*, 1891, 8 R. P. C. 259.

Where there is an agreement to assign, it may in equity be treated as an assignment, and enforced as in the case of leases: Morris, "Patent Conveyancing, Form of Agreement for Sale of Patent," p. 70.

2. Division of a patent, and assignment of portions of it.—A patent may be divided up in three different ways to an indefinite extent, (*a*) by separating the parts of the invention, (*b*) by dividing the geographical area into districts, (*c*) by a number of persons each having concurrent rights to use it.

(*a*) The case of *Dunnicliff* v. *Mallet*, 1859, 7 C. B. (N.S.) 209, 29 L. J. C. P. 70. Two joint patentees of a patent containing two inventions for "warp fabrics" and "purles," split it up, Donnicliff to take the "warp fabrics," Bagley the "purles," and each assigned to the other accordingly. Donnicliff then assigned his share to Ball and others, who reassigned to Donnicliff, with the assent of Bagley, all the patent, "as far as it related to the 6th claim" (which really related both to warp fabrics and purles. This of course left a part of the patent still remaining in Ball, viz., all such parts of Donnicliff's share as had not been reassigned to him.) Donnicliff and Bagley then brought an action of infringement in respect of the 6th claim (as to which of course they were complete owners). Plea in abatement that Ball had not been joined was held bad, for that portion of the patent upon which they were suing was completely

CHAP. XXII. SECT. 2.

Division of a patent, and assignment of portions of it.

post, p. 456.

vested in them, and was severable from that which was not so vested.

(*b*) A patent may be geographically divided into districts. This power is expressly given by the Patents Act, 1883, Ch. 36. For a form of agreement for such a division, see Morris's Patent Conveyancing, p. 115, *et seq.*, and 139. In thus subdividing a patent, special care should be taken as to the rights of the patentees *inter se*. Thus, for instance, if a patent were divided between two counties, a purchaser who bought an article in good faith in one, without notice of the subdivision, might use it in the other: see *Heap* v. *Hartley*, 1889, 42 Ch. D. 461, 6 R. P. C. 495; for the registration of the division does not affect all the public with notice of the details of it. Hence, then, the agreement ought to provide that articles should be marked, "To be used only in such and such a district," unless it is intended to allow user in other districts.

(*c*) A patent may be owned jointly, in common, or in shares. This point first seems to have come before the Court in *Walton* v. *Lavater*, 1860, 8 C. B. (N.S.) 162, 29 L. J. C. P. 275, in which it was argued that a patent being a franchise, was indivisible. But the judges decided that the Patents Act, 1852, had, in sects. 35 & 36, clearly recognised "shares" in patents, and that they were quite common. At that time the form of the patent to joint patentees differed from the present form. For it used to be "to the patentees, their executors, administrators, and assigns, that they, *and every of them* . . . by themselves, their servants, and those with whom they shall agree, may use, exercise, and vend," etc. This certainly points to the subdivision of interest in shares. The modern form of patent to joint patentees

does not contain the words in italics: see further on this point under the heading, "Co-ownership in Patents," Chap. XXII., sect. 9; and see a paper by C. M. Owen in the "Proceedings of the Institute of Patent Agents," vol. 9, p. 157; see also a paper by W. Carpmael, vol. 3, p. 175.

3. Agreement to assign.—An agreement to assign may be by parol, and need not be in writing, under the Statute of Frauds, even though the assignee agrees to pay the fees which extend over a period of more than a year. For, in order that a contract may come within the 4th sect., the things to be done by *both* parties must be to be performed in a time greater than a year: *Smith* v. *Neale*, 1857, 2 C. B. (N.S.) 67, 26 L. J. C. P. 143. A covenant to assign on the happening of a future event is interpreted as constituting an assignment conditional on the happening of it, and hence, when it happens, the assignment is complete without further deed: *Cartwright* v. *Amatt*, 1799, 2 B. & P. 43, D. P. C. 240. An agreement to purchase a patent may of course be set aside on the ground of fraud: *Lovell* v. *Hicks*, 1836, 2 Y. & C. 46, 481; *Chevasse* v. *Stevens*, 1874, W. N. 193. Where a purchaser agreed to find £300 by a given day to enable the patentee to take out foreign patents, and did not perform it by that day, held, that this was of the essence of the contract, and that the patentee could rescind: *Payne* v. *Banner*, 1846, 15 L. J. Ch. 227.

There is nothing against public policy in an agreement by a patentee to give the benefit of all future inventions of like character to a purchaser: *Printing and Numerical Registering Co.* v. *Sampson*, 1875, L. R. 19, Eq. 462; 44, L. J. Ch. 705. It is a very common clause in assignments.

CHAP. XXII. SECT. 3.

Agreement to assign.

For an example shewing when a clause in an agreement will be construed as a condition, see *King* v. *Oliver*, 1884, 1 R. P. C. 23, 42.

4. Warranties and estoppels in assignments.—The warranties implied in the assignment of patents are the same as those usual in assignments of other things. Thus, just as the vendor of an article does not in general warrant its quality, so the assignor of a patent does not warrant its validity: *Hall* v. *Conder*, 1857, 2 C. B. (N.S.) 22, 53, 26 L. J. C. P. 138, 288; *Smith* v. *Neale*, 1857, 2 C. B. (N.S.) 67, 26 L. J. C. P. 143; *Smith* v. *Buckingham*, 1870, 18 W. R. 314, 21 L. T. (N.S.) 819; *Liardet* v. *Hammond Electric Light Co.*, W. N. 1883, 96, 31 W. R. 710. Hence, to an action by the assignee for the purchase money, it is no plea that the patent is bad. "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 all know that everybody who buys it as a rule takes it for what it is worth" (*per* Bowen, L.J.): *Cropper* v. *Smith*, 1884, 1 R. P. C. 94; *Stavert* v. *Passburg Grain Syndicate*, 1891, 8 R. P. C. 400.

The warranty of title given by the assignor is exactly that which occurs in ordinary sales of chattels, and if he expresses to sell "as beneficial owner," of course a warranty of title to convey will be included.

There is no implied warranty by a patentee who assigns that he will refrain from communicating to others facts which might invalidate the patent: *London Hosiery Co.* v. *Griswold*, 1886, 3 R. P. C. 251.

On an assignment of a patent on terms of the assignor receiving payment upon each article manufactured, there

is no implied undertaking by the assignee to manufacture: *Re Railway Appliances Co.*, 1888, 38 Ch. D. 597.

Fraud of course would vitiate an assignment of a patent, and though neither the validity nor the actual goodness of the patent are warranted, yet a sale by one who knew or must have known that he had no title, or that the patent is invalid, would naturally not be enforced.

Estoppel arises where a litigant is not allowed to dispute a state of facts which he has agreed to take for granted, or on the faith of which he has induced others to act. It arises either by record; by recital in deeds; or in pais, that is to say by reason of conduct. If therefore there be a recital in a deed respecting the validity of a patent, it binds those who have signed the deed, none of whom can dispute it. *Bowman* v. *Taylor*, 1834, 2 A. & E. 278. But it only binds the actual signatories and not even their partners.

post, p. 288.

Again a judgment between two parties as to the validity of a patent would estop either from raising the question.

Estoppels on the assignment of patents may also arise by reason of conduct. Thus, for example, an assignor of a patent is estopped from alleging its invalidity against the assignee by his conduct in receiving the price of it: *Walton* v. *Lavater*, 1860, 29 L. J. C. P. 275; *Oldham* v. *Langmead*, 1789, 3 T. R. 439; *Chambers* v. *Crichley*, 1864, 33 Beav. 374; *Hocking* v. *Hocking*, 1889, 6 R. P. C. 72. But in case of fraudulent representations, such estoppels would not be allowed to prevail. For no estoppel can be of effect in a case of fraud. So that where an assignee sued for the recovery of money paid for a patent which was a mere bubble and the nature of which had been misrepresented, the deed was set aside and the money ordered to be refunded: *Hayne* v. *Maltby*,

CHAP. XXII. SECT. 4.

Warranties and estoppels in assignments.

1789, 3 T. R. 439. *Lovell* v. *Hicks*, 1836, 2 Y. & C. 46; and mutual mistake would also, like fraud, invalidate any agreement or deed: *Ashworth* v. *Law*, 1890, 7 R. P. C. 234.

But where no such fraud existed a person who had worked a patent could not recover back the payments he had made before the patent was declared invalid: *Hare* v. *Taylor*, 1803, 1 W. P. C. 292.

The true ground of the estoppel which arises on the sale of the patent, therefore, either is, the recitals in a deed, or else the conduct of the parties. Hence, then, in a sale where neither of these grounds exists there is no estoppel. Thus, where the owner of a patent who had purchased from a trustee in bankruptcy sued the bankrupt for infringement, it was held that the bankrupt was not estopped from alleging that the patent was bad. For there was no estoppel by conduct, as he had not taken the purchase money, nor by recitals, for there were none which he had signed, nor was there any estoppel of record against him by reason of the statements in his petition saying that "he was the true inventor": *Cropper* v. *Smith*, 1884, 1 R. P. C. 92. On the question of estoppels, see further under the head of "Licenses," for many of the cases apply *mutatis mutandis* to Assignments,

post, p. 288. Chap. XXIII., sect. 2.

5. An assignee with notice of prior covenants takes subject to them, so that if a patentee assigns, reserving a right to an account against his assignee, a second assignee who takes knowing of this right is bound to render an account to the original assignee: *Werderman* v. *Société Générale d'Electricité*, 1881, L. R. 19 Ch. D. 246.

6. Mortgage of a patent.—A patent may be mortgaged and the mortgage registered, but the mortgagee

is not in the position of an assignee. On the contrary, the mortgagor in possession remains the "person entitled to the benefit of the patent," and hence is the "patentee," under the Patents Act, 1883, s. 87. It, hence, follows that he can sue alone, as a mortgagor in possession is entitled to do, without joining the mortgagee: *Van Gelder* v. *Sowerby Bridge Flour Society*, 1890, 7 R. P. C. 211.

7. Death and devolution of the patent to personal representatives.—By the form of the grant executors and administrators acquire the patent on the death of the patentee: Chap. XVII., sect. 1; and under the Patents Act they have further time to complete the taking out of a patent applied for by the patentee during his life, or to apply in respect of an invention of which he died possessed: Chap. XIII., sect. 3. *ante*, p. 263.

The executor may validly assign a patent before obtaining registration of the probate: *Ellwood* v. *Christy*, 1864, 17 C. B. (N.S.) 757, 34 L. J. C. P. 130. *ante*, p. 229.

Where, however, by agreement two persons had taken an assignment as tenants in common, and not as joint tenants, and the patent was infringed, and one of them died, and the other sued alone, it was held that the right of action survived, and that the plaintiff might recover the whole damages: *Smith* v. *London & N. W. Rail. Co.*, 1853, 2 E. & B. 69.

In the absence, however, of such express agreement, the rights of a co-owner of a patent would descend by the terms of the grant to his personal legal representatives: Form B of grant, Chap. XVII., sect. 1. *ante*, p. 258.

8. Bankruptcy of patentee.—In *Hesse* v. *Stevenson*, 1803, 3 B. & P. 577, it was contended that a patent, being the fruit of invention, is not such property as

CHAP. XXII. SECT. 8.

Bankruptcy of patentee.

passes to a bankruptcy assignee; but held, that it did pass: *Bloxam* v. *Elsee*, 1827, 6 B. & C. 169, 9 D. & R. 215. In *Ex parte Granger* the question was raised whether a patent used and worked by a bankrupt patentee, after he had mortgaged it, continued in his "use and occupation," so as to pass to his creditors. The question was not decided: *Ex parte Granger*, 1812, Godson's Pat., 2nd ed., 225. If a bankrupt take out a patent before he obtains a certificate of discharge, it goes to his creditors, but if after his discharge he patent something that he had discovered before, it does not pass: *Hesse* v. *Stevenson*, 1803, 3 Bos. & P. 565.

A patentee whose patent has passed to his trustees in bankruptcy is not estopped from disputing its validity as against one who buys it from those trustees, for there is no privity whereby the estoppel may arise: *Cropper* v. *Smith*, 10 App. Cas. 249, 2 R. P. C. 17.

ante, p. 280.

9. Co-ownership and partnership in patents.—A patent is a franchise, that is to say, a privilege which may be enjoyed by a number of persons to the exclusion of others. If a patent be granted to A and B, each of them may use it, and it is clear that in the absence of some agreement for a partnership, neither is bound to share with the other the profits he makes out of it. In *Mathers* v. *Green*, 1865, 1 Ch. App. 32, the defendants had paid the patent fees, and the patent was taken out jointly by them and the plaintiff. Held, that the plaintiff had no right to share in their profits: see also *Steers* v. *Rogers*, 1892, 9 R. P. C. 185; confirmed on appeal, L. R. App. Cas. [1893] 232. These cases only decide that the mere fact of joint ownership creates no duty to share the profits, but if there are circumstances from which a joint adventure

Co-ownership and partnership in patents.

could be inferred, as, for instance, joint contribution towards expenses, then it might well be argued that this gave rise to a duty to share the profits. The law has been differently laid down in the case of joint copyrights: *Powell* v. *Head*, 1879, 12 Ch. D. 686 (*per* Jessel, M.R.).

The rights of co-owners are very curious. For in the absence of agreement each of them can cut his share into as many pieces as he pleases, each of which will give full powers of user to the grantee. Hence, to possess one-tenth of a patent is just as valuable as to possess the remaining nine-tenths. This seems to raise some inference that where a patent is divided into aliquot shares, it was intended that some division of profits should ensue, but this view was not taken in *Steers* v. *Rogers* above-mentioned.

In every case the question of partnership in the profits must be one of fact. Plaintiff agreed to try a patent, and if it succeeded to employ the patentee to work it for him, at a salary and a share of the profits. The experiment succeeded, but nothing was done. Plaintiff filed a bill for dissolution of the quasi-partnership; but held, that there was no partnership at all: *Osborne* v. *Jullion*, 1856, 26 L. J. Ch. 6. Plaintiff agreed to lend defendant £59 to perfect two inventions, on terms of receiving half profits. The question whether this constituted a partnership was raised, but not decided: *Elgie* v. *Webster*, 1839, 5 M. & W. 518; see also *Kenny's Patent Buttonholing Co.* v. *Somerville*, 1878, 38 L. T. (N.S.) 878; *Wilson* v. *Barbour*, 1888 (Ir.) 5 R. P. C. 675.

10. Assignments to the Secretary of State for War are regulated by Patents Act, 1883, sec. 44, which contains twelve subsections dealing with the matter. *post*, p. 459.

CHAPTER XXIII.

LICENSES.

CHAP. XXIII. SECT. 1.

ante, p. 260.

1. Licenses.—The form of the grant expressly gives power to the patentee to grant licenses to persons to use any part of the invention, in any way, for any time, or over any part of the area of the patent: Chap. XVII., sect. 1; and if each of two joint patentees may assign his share (Chap. XXII., sect. 2), it is to be presumed that each of them may also license. The somewhat extraordinary result seems to follow that one of two co-owners might by licensing everyone who asked for it, ruin the patent altogether if he were in the mind to do so.

ante, p. 275.

The permission to use a patent, though in form a license, may in some cases, if the operative words are sufficiently wide and the license is exclusive, to one person, and for the whole invention and whole duration of the patent, amount to a grant, just as a lease of premises for the remainder of the term may amount to an assignment. *Renard* v. *Levinstein*, 1864, 3 N. R. 665; 5 N. R. 301; *Newby* v. *Harrison*, 1861, 1 J. & H. 393.

But it by no means follows that an exclusive license would always be construed as a grant, and accordingly in *Heap* v. *Hartley*, 1889, 6 R. P. C. 501, an exclusive license for a particular district for four years from the second year of the life of the patent was not considered as an assignment, and hence the licensee was held not entitled to sue without joining the patentee.

The law respecting the form which a licence ought to have is still somewhat obscure. For it is by no means clear from the terms of the grant whether licenses ought to be by deed or may be by parol. In the early part of the grant it is said "the patentee by himself his agents or licensees and no others, may .... make use exercise and vend the said invention." But further on we find the words "the consent license or agreement of the said patentee in writing under his hand and seal," and at the end, "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." This last proviso was originally attached to the old condition (now obsolete) rendering the patent void if assigned to more than twelve persons, and was inserted in order to prevent the wide grant of exclusive licenses for the life of the patent to a large number of persons from being considered as voiding the patent. When the main clause was removed the proviso was left, though its effect in its present position is difficult to determine.

ante, p. 259.

Upon the whole it seems probable that in order to affect third parties, and give a real interest to the licensee as against all the world, a deed would be necessary.

But the cases shew that as between the patentee and his licensees, licenses by parol (*i.e.*, verbal or in writing) are not wholly inoperative.

For example, it is certain that a man who buys a patented article from an inventor acquires a license to use it, without any deed. And a person who uses an invention under a parol license would have to pay for that use. *Chanter* v. *Dewhurst*, 1844, 12 M. & W., 823, 13 L. J. Ex. 198. *Crossley* v. *Dixon*, 1863, 10 H. L. C. 293, 32 L. J. Ch. 617. *Wilson* v. *Union Oil Mills*, 1892,

CHAP. XXIII. SECT. 1. Licenses.

9 R. P. C. 63. *Crosthwaite* v. *Steel*, 1889, 6 R. P. C. 190, and compare *Chanter* v. *Leese*, 1838, 4 M. & W. 311, 5 M. & W. 698. A license in writing does not need any stamp, *Chanter* v. *Johnson*, 14 M. & W. 408, though it would if it amounted to an agreement. *Wilson* v. *Union Oil Mills*, cited supra. A license by deed must be duly stamped.

An agreement for a license, by which the preparation of a formal deed is in contemplation, differs from a parol license, for it can be specifically performed, and in equity will be equivalent for many purposes to the deed itself. *Postcard Automatic Supply Co.* v. *Samuel*, 1889, 6 R. P. C. 562.

A license may be granted after the provisional specification, but before the complete specification has been filed or the patent granted, *Otto* v. *Singer*, 1889, 7 R. P. C. 7. An agreement to work a patent "as long as it could be worked at a profit" was held as meaning profit after paying royalties. *Kernot* v. *Potter*, 1861, 30 Beav. 343. For an example of interpretation of a particular license see *Bown* v. *Humber*, 1889, 6 R. P. C. 9.

At common law a license is by its nature revocable, and therein differs from a grant. Brooke's Abridgment, License, pl. 9. And provided that it is only a license it is equally revocable whether it is by parol or by deed. *Wood* v. *Ledbitter*, 1845, 13 M. & W. 838, 14 L. J. Ex. 161. It is equally revocable even though a consideration had been paid for it, though if revoked the consideration would probably be recoverable, *ibid.*

If however the license be coupled with an interest this would make it irrevocable, and indeed every irrevocable license, depending not merely on the continuing will of the licensor, does give an interest.

In each case the question of revocability must depend upon the intention of the parties, but it seems clear, that

a mere license to use a patent without specifying any time would be interpreted as meaning only as long as the respective parties chose, *Clark* v. *Adie*, 1873, L. R. 2 App. Cas. 315. *Crossley* v. *Dixon*, 1863, 10 H. L. Cas. 293. *Redges* v. *Mulliner*, 1892, 10 R. P. C., 21. A revocation of a license granted by deed should be by deed.

And notice of revocation is necessary. *Cornish* v. *Stubbs*, 1870, L. R. 5 C. P. 334. *Mellor* v. *Watkins*, 1874, L. R. 9 Q. B. 400.

The words "*upon the terms and conditions following*" in a license were held to give a right of revocation if those terms were broken: *Ward* v. *Livesey*, 1887, 5 R. P. C. 102. A right of rescision reserved in a patent license may of course be waived by receipt of royalties: *Warwick* v. *Hooper*, 1850, 3 Mac. & G. 60.

Where an exclusive license is given by deed there is no implied condition that the licensees shall pay the fees or keep up the patent: *Re Railway & Electrical Appliances Co.*, 1888, 38 Ch. D. 597. In *Mills* v. *Carson*, 1892, 9 R. P. C. 338, 10 R. P. C. 9, a patentee had granted a license by deed for the residue of the term of the patent, with covenants for quiet enjoyment and payment of the royalties during the term of the patent, royalties to cease if the patent should not be novel or the patentee should not defend his patent. The patent fees were not paid, and, therefore, the licensee refused to pay further royalties, and endeavoured to set up want of novelty in the patent. Held, (1) That it was doubtful whether the covenant for quiet enjoyment made it the duty of the plaintiff to pay the fees. (2) That even if it did, the covenant for quiet enjoyment and that for payment of royalties were not co-extensive, so that one was conditioned upon the other. (3) That inasmuch as the deed contained express provi-

sions for defeasance of the royalties (among which failure to keep up the patent was not included), it must be held to have not been intended that the failure to keep up the fees absolved the licensee from paying royalties, and (4) That the condition making the royalties cease if the patent was not novel did not release the licensee from the ordinary doctrine of estoppel. A license may in its terms be assignable: Hindmarch, 242; *Bower* v. *Hodges*, 1853, 22 L. J. C. P. 194. An agreement for a license does not constitute a partnership, as was argued in *Ridgeway* v. *Philip*, 1834, 1 C. M. & R. 415.

2. Estoppel may arise either (a) by deed, (b) by conduct, that is to say, "in pais," or else (c) by record.—It is an equitable doctrine in its nature, though it has always been applied at common law, and arises in cases where it would be against good faith to assert facts which might be true. Hence, an estoppel can never be created by fraud: Chap. XXII., sect. 4. When the license comes to an end the licensee is released from his estoppel, *Dangerfield* v. *Jones*, 1865, 13 L. T. N.S. 142. *Axman* v. *Lund* 1874, 18 Eq. 330. *Neilson* v. *Fothergill*, 1841, 1 W. P. C. 290; (a) The parties to a deed are estopped by its recitals, but not their partners: *Heugh* v. *Chamberlain*, 1877, 25 W. R. 742; *Goucher* v. *Clayton*, 1865, 34 L. J. Ch. 239, 13 W. R. 336. Where the license is by deed, the licensee cannot dispute the validity of the patent, and it is not enough simply to allege that the licensor knew that the invention was not new, unless distinct fraud is alleged and proved: *Smith* v. *Scott*, 1859, 28 L. J. C. P. 325; *Oldham* v. *Langmead*, 1789, 3 T. R. 439; *Cutler* v. *Bower*, 1848, 11 Q. B. 973, 17 L. J. Q. B. 217; *Hills* v. *Laming*, 1853, 23 L. J.

ante, p. 270.

ante, p. 279.

Estoppel may arise either (*a*) by deed, (*b*) by conduct, that is to say, "in pais," or else (*c*) by record.

Ex. 60; *Bowman* v. *Taylor*, 1834, 2 A. & E. 278; *Collinge* v. *Bowman*, 1834, 1 W. P. C. 294; *Grover Sewing Machine Co.* v. *Millard*, 1862, 8 Jur. (N.S.) 714; (b) Estoppel by conduct or in pais arises where the parties so act as to render it inequitable for them to deny the existence of the facts in question. Thus even where no regular license by deed has been made and subsists, yet a licensee who has used the license is estopped from denying the licensors title, just as a tenant is prevented from disputing his landlord's title. "A man has no right to work the patent of another without enquiry for a long time under an agreement whereby he contracted to pay royalty, and then when he is called upon to pay royalty to say, 'Oh, your patent is invalid'" (*per* Charles, J.): *Wilson* v. *Union Oil Mills*, 1892, 9 R. P. C. 63. *Crossthwaite* v. *Steel*, 1889, 6 R. P. C. 190. *Clark* v. *Adie*, 1873, L. R. 2 App. Cas. 423. *Noton* v. *Brooks*, 1861, 7 H. & N. 499. *Crossley* v. *Dixon*, 1863, 10 H. L. C. 293. *Trotman* v. *Wood*, 1864, 16 C. B. (N.S.) 479. *Ashworth* v. *Law*, 1890, 7 R. P. C. 234. *Lawes* v. *Purser*, 1856, 6 Ell. & Bl. 930. (c) Estoppel by record would arise in a patent case by reason of a judgment between the same parties and in respect of the same subject matter. But the estoppel would have to be precise and clear. A mere *general* finding by an arbitrator that a patent is not illegal nor void would not estop the same defendant from raising the same plea to a fresh action by the same plaintiff: *Newall* v. *Elliot*, 1863, 32 L. J. Ex. 120. On the other hand, consenting to an injunction in an action where he had pleaded want of utility and novelty would certainly estop a defendant on a motion to attach him for again infringing from raising the question of the validity of the patent.

CHAP. XXIII. SECT. 2.

Estoppel may arise either (*a*) by deed, (*b*) by conduct, that is to say, "in pais," or else (*c*) by record.

A patentee by taking out a patent does not estop himself by record from denying the validity of his own patent: *Cropper* v. *Smith*, 1884, 1 R. P. C. 94.

Estoppel by record must not be confused with such quasi estoppel as arises from the prior decision of a Court of competent jurisdiction upon the validity of the patent. For the decision of a superior Court upon a patent, so far as it is upon law (*e.g.*, upon the construction of a patent), will be followed till it is reversed, but so far as the decision merely depends upon evidence (*e.g.*, as to novelty or utility), it might be varied on the production of evidence of a different description in an action between different parties: *Edison* v. *Holland*, 1889, 6 R. P. C. 243.

A licensee against whom an action is brought for royalties is in the position of an infringer, and though he may not dispute validity, he may of course shew that what he has done is outside the patent upon its true construction: *Young* v. *Hernand Oil Co.*, 1891, 8 R. P. C. 293, and cases there cited. This case was reversed on appeal (9 R. P. C. 373), on the ground that the licensee's acts constituted infringement, but the principle in the text was left untouched.

post, p. 476.

3. Compulsory licenses.—By the Patents Act, 1883, s. 22, it is provided that where the patent is not worked in the United Kingdom, or the reasonable requirements of the public are not complied with, or where any person is prevented from working to the best advantage an invention of which he is possessed, the Board of Trade may compel the patentee to grant licenses on terms to be settled: see Patent Rules, 1890, 60–66, Forms H., I. No petitions under this section appear to have been prosecuted.

post, p. 495.

CHAPTER XXIV.

INFRINGEMENT.

1. Infringement in general.—By the form of grant scheduled to the Act of 1883 (Chap. XVII., sect. 1), it is provided that the patentee, "by himself, his agents, or licensees, and no others, may at all times hereafter during the term of years herein mentioned, *make, use, excercise, and vend* the *said invention* within our United Kingdom of Great Britain and Ireland, and the 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, and . . . we do by these presents . . . strictly command all our subjects that they do not at any time during the continuance of the said term of fourteen years *either directly or indirectly make use of, or put in practice, the said invention, or 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," etc.

ante, p. 259.

These words have remained practically unaltered for a very long period: compare *Walton* v. *Bateman*, 1842, 1 W. P. C. 616. If an invention consist of several distinct and severable parts, it is obviously not needful to constitute an infringement that the thing done should

CHAP. XXIV. SECT. 1.

Infringement in general.

infringe all of them: *Gillet* v. *Wilby*, 1839, 9 C. & P. 336; *Cornish* v. *Keene*, 1835, 6 L. J. C. P. 225. In considering an infringement two questions arise, first, whether the essence of the invention has been infringed by some machine or article or process which resembles it; and, secondly, what are the acts of user complained of.

2. The infringement must infringe the essence of the invention.—For an infringement is not a mere resemblance in outward appearance, nor a similarity of result, but a user of the essence of the invention: *Automatic Weighing Machine Co.* v. *National Exhibitions Association*, 1892, 9 R. P. C. 41.

The law as to this is thus laid down in *Dudgeon* v. *Thompson*, 1877, L. R. 3 App. Cas. 34. "The words 'colourable imitation' are words which appear to me not very happily chosen, and calculated to create some confusion. I am quite aware that they are words which are used sometimes in the argument of patent cases, but I doubt very much whether the particular expression is one which has any great authority for its use. There is a well known manner in which the word 'colourable,' or 'colourably,' is used in patent cases. I have referred to the ordinary form in which injunctions are granted in patent cases by the Court of Chancery, and I take from Mr. Seton's book an example which appears to me to be exactly in accordance with what I recollect to be the practice of the Court in granting injunctions. It is in a case which, I think, came before my noble and learned friend as Vice-Chancellor, the case of *De la Rue* v. *Dickenson*. The injunction restrains the defendants, their agents, and servants, during the continuance of the patent from 'using or employing any

The infringement must infringe the essence of the invention.

machines similar to the machine in the plaintiff's bill stated, or any machinery, mechanism, or mechanical contrivance made or arranged according to the plaintiff's said patent inventions, or differing therefrom only colourably, or by the substitution of mere mechanical equivalents for the same.' Now, my Lords, what I understand by that is this, that if there is a patented invention it will not save you from the punishment of the Court that you have, at the same time that you have taken the invention, dressed it up colourably, added something to it, or 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 . . .' (*per* Cairns, L.C.).

"If part of the property in the invention be really taken, then there is an infringement, however much that may be disguised or sought to be hidden" (*per* Lord Blackburn): see also *Hill* v. *Thompson*, 1818, 1 W. P. C. 242. "There never were two things more different to the eye than the plaintiff's invention and what the defendant had done in contravention of his patent right": *Jupe* v. *Pratt*, 1836, 1 W. P. C. 146. "One (the infringement) is a servile copy of the other, with that degree of non-resemblance that shall operate to cast a blind over the attempt to mislead the public": *Minter* v. *Wells*, 1834, 1 W. P. C. 128. "The two machines are alike in principle . . . and though the defendant may have carried it into effect by substituting one mechanical equivalent for another, still, you are to look at the substance, not the mere form" (*per* Alderson, B.): *Morgan* v. *Seaward*, 1836, 1 W. P. C. 171. "Variations in form or immaterial circumstances of the subject matter of a

CHAP. XXIV. SECT. 2.

The infringement must infringe the essence of the invention.

patent will be infringements": *Walton* v. *Potter*, 1841, 1 W. P. C. 586; *Plimpton* v. *Malcolmson*, 1875, L. R. 3 Ch. D. 531; *Plimpton* v. *Spiller*, 1876, L. R. 4 Ch. D. 286; *Thorn* v. *The Worthing Skating Rink Co.*, 1876, L. R. 6 Ch. D. 415 (*n*), all deal with the patent for the Plimpton skate.—The patentee, recognising that it would be necessary in a roller skate to imitate the motion of the real skates, that is to say, to cause the skate to curve outwards on the side on which the skater

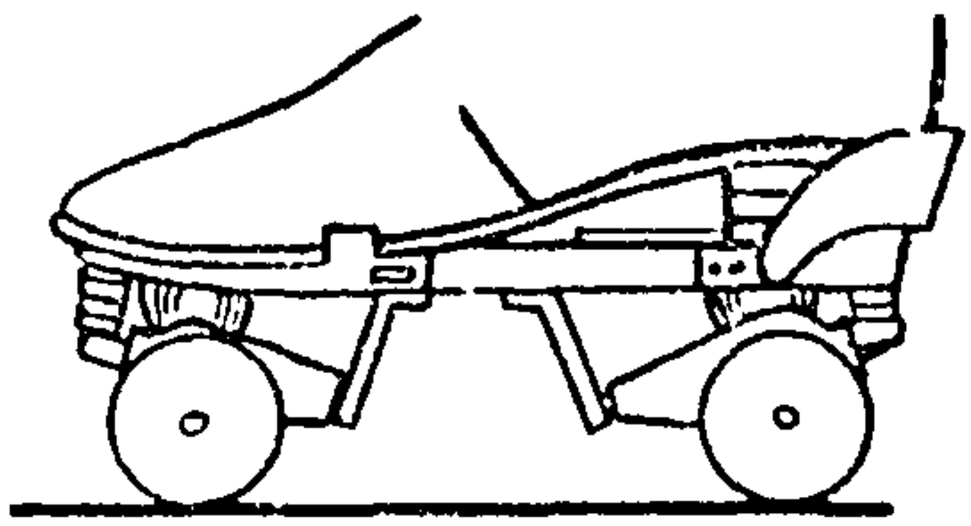


Fig. 3.

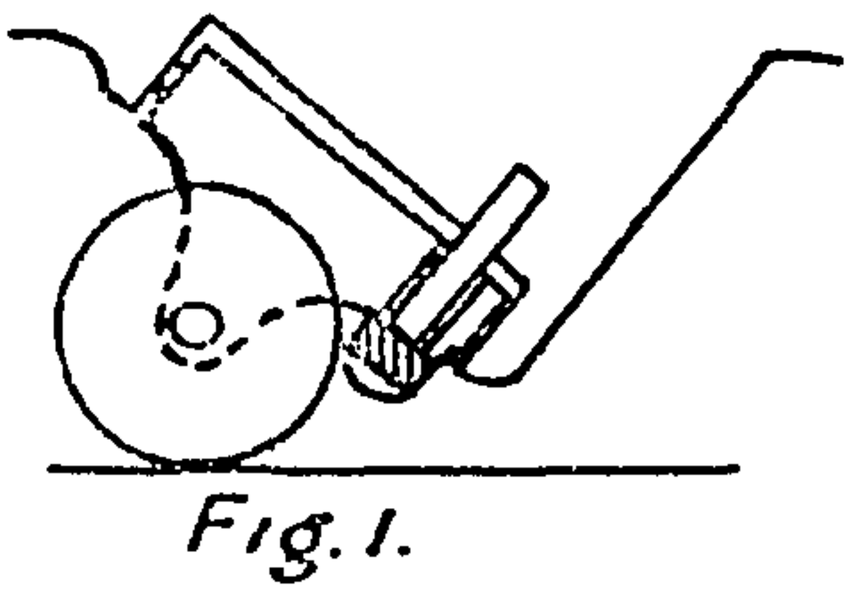


Fig. 1.

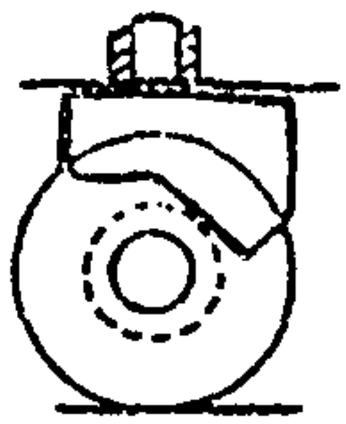


Fig. 2

leans, saw that for this purpose the wheel-axles must be caused to incline inwards, on the side on which pressure is applied. For this purpose he mounted his wheels in manner shewn in Fig. 1. The axles are horizontal, and fixed to a body which is pivoted at an inclined plane. Of course that pivoting must resist pressure, so a bolt is fixed through the body into the stand of the skate, but with an india-rubber washer beneath its head. When the skater leans on one side, the body is slightly pressed

The infringement must infringe the essence of the invention.

round in its bearings, and this in turn causes the wheel-axles to become inclined to each other. Two infringements were complained of; one by Spiller, in which a spiral spring was substituted for the india-rubber pad. This of course was held to be an infringement. The other infringement was the Wilson skate. The body, which carried the wheels, was pivoted to the stand of the skate, by an elastic vertical bearing so that the axles of the wheels could become inclined. To cause them to do so, a cone, or inclined plane was fixed to each side of the skate, so as to press forward the body which carried the wheels, on that side on which the pressure was applied (Fig. 2). This was in appearance different, but was held to be an infringement, regard being had to the wide ambit of Plimpton's patent. The invention was also attacked on the ground of anticipation, for it had been previously patented in America, and a description of it then had come to England. The drawing, of which Fig. 3 is an outline, and some letterpress, which, with a figured drawing, will be found at p. 535 of the Law Reports, 3 Chancery Division (1876).

It was held that from this description no workman could have understood the invention sufficiently to carry it out, and hence this was no anticipation. And it was also held, that the drawing, having been on the shelf of a room in the Patent Office, not generally accessible to the public, had not been sufficiently published to constitute an anticipation.

Voeverk v. *Evans*, 1890, 7 R. P. C. 265.—This was a patent for (*inter alia*) a method of weaving curved ribbands with one edge longer than the other by the use of conical drawing-off rollers. The main features of the machinery were shewn to have been anticipated by a

CHAP. XXIV. SECT. 2.

The infringement must infringe the essence of the invention.

specification which, though not so drawn perhaps as to describe a workable machine, was sufficient to narrow very greatly the ambit of the plaintiff's patent. In consequence it was held that the defendant had not infringed it.

Automatic Weighing Machine Co. v. *Knight*, 1889, 6 R. P. C. 113; *Automatic Weighing Machine Co.* v. *Combined Weighing Machine Co.*, 1889, 6 R. P. C. 120, 367; *Automatic Weighing Machine* v. *National Exhibitions Association*, 1892, 8 R. P. C. 345, 9 R. P. C. 41; *Automatic Weighing Machine Co.* v. *International Hygienic Society*, 1889, 6 R. P. C. 475.—This group of cases affords an example of the application of the rule under discussion.

The patent of Everitt was for a weighing machine, in which a counter-weighted lever rose when a person stood on a platform, and this indicated his weight. But that result was concealed. In order to render it visible, a penny put in a slot caused a visible arm to rotate till it came in contact with the counterweight, and thus the weight was indicated. Knight's alleged infringement was a machine so arranged that when a penny was put in a slot, it became possible for the person being weighed to draw out a handle, which, being done, the weighing mechanism came into play, and the result was visible. It was held that Everitt could not claim every mode of weighing people by means of a penny-slot arrangement, for that would be to claim a principle. Hence, therefore, the plan by which the person being weighed pulled a handle in order to operate the machine was so different from the plaintiff's as not to infringe his patent. The alleged infringement by the Combined Weighing Machine Company also operated as Knight's did, by

The infringement must infringe the essence of the invention.

means of a button or handle pushed by the person being weighed, but with this difference, that whereas in Knight's machine, when the coin was put in it allowed the pushing of the knob to do the work of releasing the machinery, in the Combined Weighing Machine Company's machine when the knob was pushed in, it pressed against the coin, and the coin so pressed, then released the catch and set the machinery at work. This was held to make all the difference, and the latter machine was held to be an infringement. The test applied was whether substantially the coin did the work of releasing the catch, or whether the coin merely permitted the knob to do the work. The infringement of the National Weighing Machine Company consisted of an arrangement whereby when a penny was put into a slot, it made an electric contact, which caused an armature to revolve and carried a visible hand to the proper positions to indicate the weight. This was held an infringement, as it was clearly only a modification of Everitt's machine. The infringement by the International Hygienic Society was a machine so constructed that when a person stood on a platform he was weighed by the rotation of a counter-weighted lever, but the result was concealed until a penny was put into a slot, upon which a door was opened which enabled the result to be seen. This also was held to be an infringement. A patent directing the use of the finest copper for making an alloy for sheathing ships may be infringed by the use of an inferior copper: *Muntz* v. *Foster*, 1844, 2 W. P. C. 101. Patent for two iron retorts worked in connection with one another at different temperatures for two stages of the process of making sulphate of soda. Held, substantially an infringement to use a chamber of brick and an iron retort

CHAP. XXIV. SECT. 2.

The infringement must infringe the essence of the invention.

for the same purpose: *Gamble* v. *Kurtz*, 1846, 3 C. B. 435. A patent for mixing two chemical substances and boiling them to produce a certain result may be infringed by mixing them in the presence of a third without boiling: *Simpson* v. *Holliday*, 1864, 20 Newton's Lond. Journal (N.S.) 111. A patent for prismatic reflecting pavement lights which were shewn made with prisms with plane surfaces. Held, infringed by the use of prisms with curved surfaces: *Hayward* v. *Pavement Light Co.*, 1884, 1 R. P. C. 207. The Edison telephonic speech transmitter consisted of a diaphragm in contact with a "tension-regulator," or piece of substance kept in contact with it either by its own resilience or by a spring. When vibrated by the voice the combination offered a tremulous varying resistance to an electric current passing through it, and thus transmitted speech. Defendant used a diaphragm of carbonised leather and a ball of carbon held on by a spring. Held, an infringement: *United Telephone Co.* v. *St. George*, 1886, 3 R. P. C. 321. A patent for an organette consisted of a circular perforated disc rotated over a fixed wind-chest so as to actuate levers and open and close organ-pipes, and thus play tunes. An organette in which the wind-chest rotated and the disc was fixed, was held an infringement, and though it might be an improvement, this made no difference: *Erhlich* v. *Ihlee*, 1888, 5 R. P. C. 453; see also *Stead* v. *Anderson*, 1847, 2 W. P. C. 155; *Pennycook* v. *Mackenzie*, 1882, 19 Scottish Law Reports 353; *Cochrane* v. *Braithwaite*, 1830, 3 Lond. Jour. C. S. 42; *Kaye* v. *Chubb*, 1888, 5 R. P. C. 651. In *Laine* v. *Herold*, 1892, 9 R. P. C. 447, it was held, that a patent for a beetle poison was infringed by the use of the same ingredients with immaterial alterations.

ante, p. 32.

The ambit of an invention.

3. The ambit of an invention.—From the above-mentioned rule it follows that every invention has an area or "ambit," or, as it might be termed, certain "limits of deviation," within which the patentee will be protected. And in every patent case the real difficulty is to determine what these limits are. The fixing of these limits depends on the language of the specification, but always with regard to the state of knowledge at the time. In the case of a very new and original invention which strikes out a fresh path in discovery these limits would be widely construed, whereas, if the invention is not of a novel character, the limits will be narrow. For instance, the Court would be much more liberal in construing a patent for the first invention of the telephone than it would be in construing a patent for some special sort of telephone at the present day. "Where the thing is wholly novel, and one which has never been achieved before, the machine itself which is invented necessarily contains a great amount of novelty in all its parts, and one looks very narrowly and very jealously upon any other machines for effecting the same purpose. . . . When the object itself is one which is not new, but the means only are new, one is not inclined to say that a person who invents a particular means of doing something that has been known to all the world long before has the right to extend very largely the interpretation of those means which he has adopted for carrying it into effect" (*per* Wood, V.-C.): *Curtis* v. *Platt*, 1863, L. R. 3 Ch. D. 136 n.; commented upon in *Thompson* v. *Moore*, 1889, 6 R. P. C. 426; see *Procter & Bennis*, 1887, 36 Ch. D. 756, 4 R. P. C. 333; and *Couchman* v. *Greener*, 1884, 1 R. P. C. 200, where weight is given by Lord Blackburn to the fact that the common object of the

CHAP. XXIV. SECT. 3.

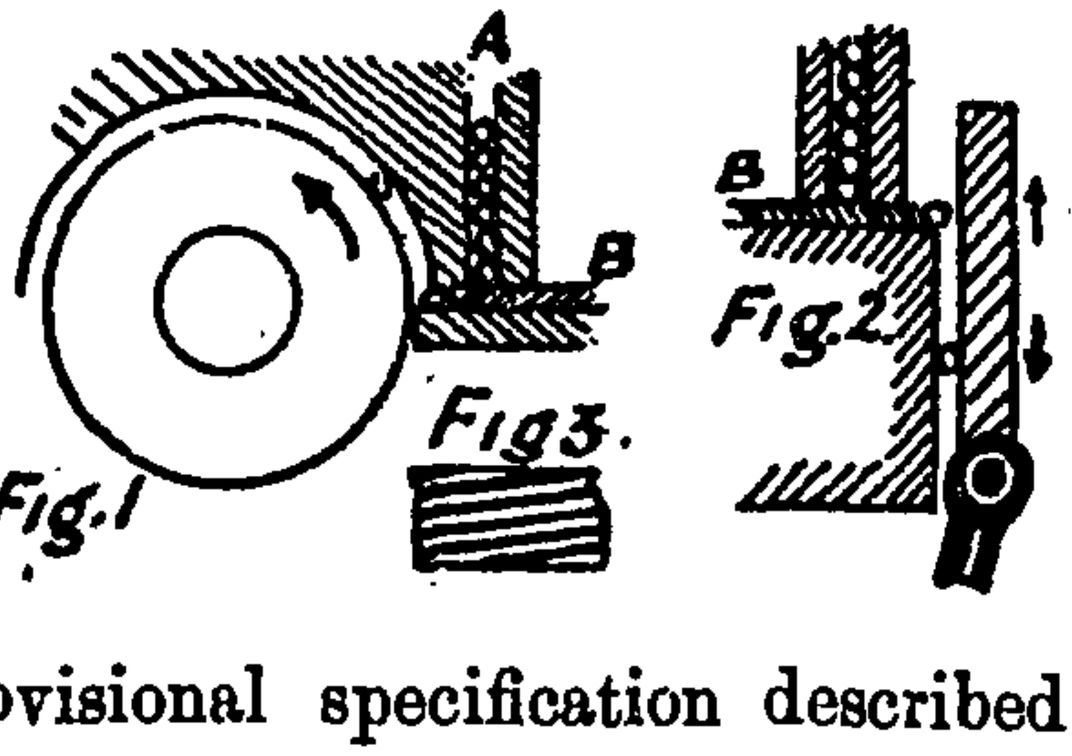
The ambit of an invention.

plaintiff and defendant had been known before. In *Gosnell* v. *Bishop*, 1888, 5 R. P. C. 159, Bowen, L.J., says: "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 certain 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": see also the same principles applied in *Hocking* v. *Hocking*, 1889, 6 R. P. C. 76, by the Lord Chancellor; *Bovill* v. *Pinn*, 1856, 11 Ex. 739; *Seed* v. *Higgins*, 1860, 8 H. L. C. 551; *per* Lindley, L.J., in *Jahncke* v. *Bell*, 1892, 9 R. P. C. at p. 100; *Nettlefold* v. *Reynolds*, 1892, 9 R. P. C. 270; where the doctrine of mechanical equivalents was held not to apply, because the ambit was so narrow; see also *Miller* v. *Clyde Bridge Street Steel Co.*, 1892, 9 R. P. C. 470.

ante, p. 34.

Nettlefolds v. *Reynolds*, 1891, 8 R. P. C. 410. This was a patent for making carpenter's wood screw. Screws used formerly either to be cut out of the solid or else squeezed into shape by screwing them into screw-plates, which latter operation lengthened them. Gradually, however, the idea grew up that they might be made by rolling wire between grooved rollers. This does not appear to have been a sucess until the patent of Nettlefold in 1884. According to this invention, the wires which are to be made iuto screws fall down a trough A. When they arrive at the bottom they are pushed forward by a metal finger B., so as to be caught

between the outside of a revolving cylinder and a concentric circular recess (Fig. 1.) These are fluted on the inside in an ingenious manner (Fig. 3) so as to roll a thread on the screw, which falls out at the other side. But owing to previous inventions, this patent was held to have a very narrow ambit. The infringement complained of is shewn in Fig. 2, and consisted in the substitution of two flat dies for the curved ones of the plaintiffs. If the invention of the plaintiffs had been the first of its kind, there can be no doubt that the machine of the defendant would have been held to infringe it, but prior discovery had so narrowed it, that it was held good only for the particular arrangement of circular dies shewn in it, and the defendant's machine was held not to be an infringement.



Bailey v. *Roberton*, 1878, 3 App. Cas. 1055.

The plaintiff in his provisional specification described his invention as a means of preserving meat by coating it with a liquid made of certain proportions of bisulphite of lime, gelatine, and water. But in the complete specification he described the preparation of four liquids, viz: —No. 1, A certain solution of bisulphite of lime. No. 2, A mixture of No. 1 with gelatine in certain proportions. Nos. 3 and 4, a mixture of No. 1, with salt in two different defined proportions. The modes of using No. 2, 3, and 4 were described, but no mode of using No. 1 was given, except for cleansing vessels or mixing to form Nos. 2, 3, and 4. The claims were for the use of Nos. 1, 2, 3, and 4 for preserving animal substances, and a

CHAP. XXIV. SECT. 3.

The ambit of an invention.

disclaimer of the use of No. 1, except for preserving animal substances, or in connection with salt or gelatine. The use No. 1 for cleansing vessels was also disclaimed. The infringement complanied of, was the use of No. 1 solution alone for preserving meat. It was proved that the use of bisulphite of lime for preserving meat was old at the date of the patent.

The Court considered that the patent was bad. (1) For want of novelty in having claimed the use of No. 1, for preserving meat, which was old. (2) For want of sufficient description how to use No. 1. (3) For disconformity in not having described the use of No. 1 alone in the provisional; and further, that if the patent could be read as not claiming No. 1 for preserving meat (which would be the only way to save it) then there had been no infringement.

It is impossible to construe a patent, either for the purpose of determining whether it has been infringed or anticipated, without considering the specification, in the light of the knowledge at the time. Some patents will require much of this evidence to throw light upon them; some are so sharply defined and narrow as to enable it almost to be dispensed with; in most cases it is useful, if not indispensable. A patent with a very wide ambit is called a master-patent.

4. Infringement by the substitution of mechanical or chemical equivalents.—In the sections dealing with the necessity that the "essence" of the invention should have been infringed, and that in order to determine this essence the ambit must be determined in the light of the state of knowledge at the time the specification was sent in, examples were given of the mode in which

Infringement by the substitution of mechanical or chemical equivalents.

infringements have been considered: Chap. XXIV., sects. 2, 3. Some examples in which infringements have been considered to have been committed by the use of mere mechanical or chemical equivalents may be added, always, however, remembering that in order to be able to use these cases the ambit of the invention must be moderately wide: see cases cited in last section. "If you believe that the defendant's instrument, though he might have employed skill and knowledge upon it, was taken by him substantially from the plaintiff's, and that what he has produced is nothing more than a substitution of other and equivalent means for producing the same end, even though the means employed might be better than those of the plaintiff's, it is an infringement. . . . If it were permitted to persons of ingenuity to substitute, in lieu of the patent, some equivalent, it would be useless to grant patents of this kind, for an ingenious man could at any time infringe them by adopting other and possibly better means than those specified" (*per* Martin, B.): *Bateman* v. *Gray*, 1855, M. P. C. 102. "The next thing is to see what really has been done. In one sense what has been done is undoubtedly a mechanical equivalent, but whether it is a mechanical equivalent in the sense in which that expression is used in patent law is, of course, the question I have to decide" (*per* Jessel, M.R.): *Thorn* v. *Worthing Skating Rink Co.*, L. R. 6 Ch. D. 415 n.; *Saxby* v. *Clunes*, 1874, 43 L. J. Ex. 228. "The question, What is an equivalent? depends on the state of knowledge at the time; "and chemical equivalents are by no means so obvious as mechanical equivalents": *Stevens* v. *Keating*, 1847, 2 W. P. C. 188. A patent had been granted for using carburet of manganese for the manufacture of steel. The

CHAP. XXIV. SECT. 4.

Infringement by the substitution of mechanical or chemical equivalents.

defendant mixed oxide of manganese and tar in the crucible to effect the same purpose. It was proved that this would really produce carburet of manganese, but it was not shewn that at the time the patent was taken out it was known that the mixture would be a chemical equivalent for carburet of manganese. The defendant's method was cheaper. Held, that it was not an infringement (*per* Lord Cranworth): *Heath* v. *Unwin*, 1850, 2 W. P. C. 319. On the other hand, a patent for improving caoutchouc by heating it with sulphur was held to be infringed by the process of heating it with hyposulphate of lead and artificial sulphuret of lead: *Hancock* v. *Moulton*, 1852, John. Pat. Man., 3rd ed., 208. In *Barrett* v. *Vernon*, 1877, 35 L. T. (N.S.) 755, the plaintiff had obtained a patent for stopping soda-water bottles by means of a plug of heavy wood. The defendant substituted a plug of light wood, but temporarily applied a weight to it to effect the stopping. Held, an infringement. In a door lock, the substitution of a V-spring acting on a lever for a spiral spring is merely a colourable variation: *Kaye* v. *Chubb*, 1888, 5 R. P. C. 651. In *Johnson* v. *Rylands*, 1873, Griff. 138, the patent was for an arrangement for testing wire and expanding it by rolling it off one drum on to another moving at a greater surface speed. The defendant rolled it on to one drum from another which was retarded by a clip, and thus it was strained and expanded. Held, no infringement: see *Winby* v. *Manchester Steam Tramways Co.*, 1889, 6 R. P. C. 365; *R.* v. *Lister*, 1826, 1 W. P. C. 80; in which the heating of rollers for a certain purpose with hot irons was held an infringement of a patent for heating them for the same purpose with steam: *Hills* v. *Liverpool Gas Light Co.*, 1862, 32 L. J. Ch. 28,

7 L. T. (N.S.) 537; see also *Peckover* v. *Rowland*, 1893, 10 R. P. C. 234.

5. Infringement of a combination.—As the essence of a combination patent is the union of its parts, and not the parts themselves (Chap. I., sect. 8, Chap. VIII., sect. 5), it follows that an infringement must be, not of the individual parts, but of the combination. But a patent is infringed when its essence is infringed, although each particular part may not have been taken: Chap. XXIV., sect. 2. Applying this doctrine to patents for combinations, it follows that a combination may be infringed by a machine which, though it substantially consists of the combination, does not take every part of it. In fact, one combination may be a colourable imitation of the other. This was decided in *Lister* v. *Leather*, 1858, 8 Ell. & B. 1031. But the case was subsequently misunderstood, as if it meant that unless all the parts of the combination were taken there could not be an infringement. That view, however, was corrected in three cases in which the whole law of infringement of combinations is to be found: *Clarke* v. *Adie*, 1873, L. R. 2 App. Cas. 315. "One mode of infringement would be a very simple and clear one. The infringer would take the whole instrument from beginning to end, and would produce a clipper made in every respect like the clipper described in the specification. About an infringement of that kind no question could arise. The second mode would be one which might occasion more difficulty. The infringer might not take the whole of the instrument here described, but he might take a certain number of parts of the instrument he had described. He might make an instrument which in many respects might

ante, pp. 55, 180.

ante, p. 292.

CHAP. XXIV. SECT. 5.

Infringement of a combination.

resemble the patent instrument, but would not resemble it in all its parts, and then the question would be, either for a judge, or for any tribunal which was judging of the facts of the case, whether that which was done by the alleged infringer amounted to a colourable departure from the instrument patented, and whether in what he had done he had not really taken and adopted the substance of the instrument patented. But there is a third way in which it is possible to conceive an infringement of a patent of the kind to which I have referred. Inside the whole invention there may be that which 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" (*per* Lord Cairns).

Harrison v. *Anderston Foundry Co.*, 1876, 1 App. Cas. 593. —"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 parts, or at least such of them as are new and material. It is plain, however, that the 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" (*per* Lord Penzance); and in *Nordenfelt* v. *Gardner*, 1884, 1 R. P. C. 10, 61, Lord Esher, M.R., says: "Some stress was laid by some of the counsel, not by all, I think, upon the words 'the general construction.' I take it that the general construction there means the whole of the construction. The arrangement, that is, the

CHAP. XXIV. SECT. 5.

Infringement of a combination.

whole of the arrangement, and mode of using the feeding apparatus, that is, the general construction of the combination, or the construction of the whole combination. The general arrangement, that is, the whole arrangement, and the mode of using what?—the feeding apparatus. 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; although not mathematically exactly the same, they are substantially the same, and in any case, notwithstanding such colourable alteration, there may be an infringement. An alteration by addition may be an improvement, but then that will leave the whole of the original combination, and add something to it. If such an alteration of the combination be made, it seems to me that no good patent can be made with regard to the new machine except by claiming the invention as an improvement, and by 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 material subtraction, I should think that it was a new combination. But an alteration by substitution, that is, by substitution of one of the material elements of the original combination, must, to my mind, be a new combination. The second combination, then, is a combination of different things from the first; there is the 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. Somebody tried to express these things by A, B, and C. But if the original combination is of A, B, C, and you take away C, and make a combination of A, B, and D, it seems to me as clear as possible that the new combination is a different combination from the old."

ante, p. 306.

From these cases it is clear that an infringement of a combination may be committed by any substantial union of the essential parts composing it, whether or no anything is added, or anything immaterial be substituted, and that the question is one of fact in each case; but that as the essence of a combination patent is not the parts, but the combination, it must be the combination which is infringed, not the parts composing it: *Proctor* v. *Bennis*, 1886, 36 Ch. D. 740; *Parkes* v. *Stevens*, 1869, L. R. 8 Eq. 358; *Sellers* v. *Dickinson*, 1850, 5 Ex. 324, *Hill* v. *Thompson*, 1818, 8 Taunt. 391, 2 B. Moo. 448, 1 W. P. C. 242; *Flower* v. *Lloyd*, 1877, 6 Ch. D. 297, 10 Ch. D. 327. The following cases also may be referred to as examples of these principles.

Wenham Gas Co. v. *May*, 1887, 4 R. P. C. 303.—Patent for a combination and arrangement of a gas lamp consisting (*inter alia*) of two gauze coverings to moderate

CHAP. XXIV. SECT. 5.

Infringement of a combination.

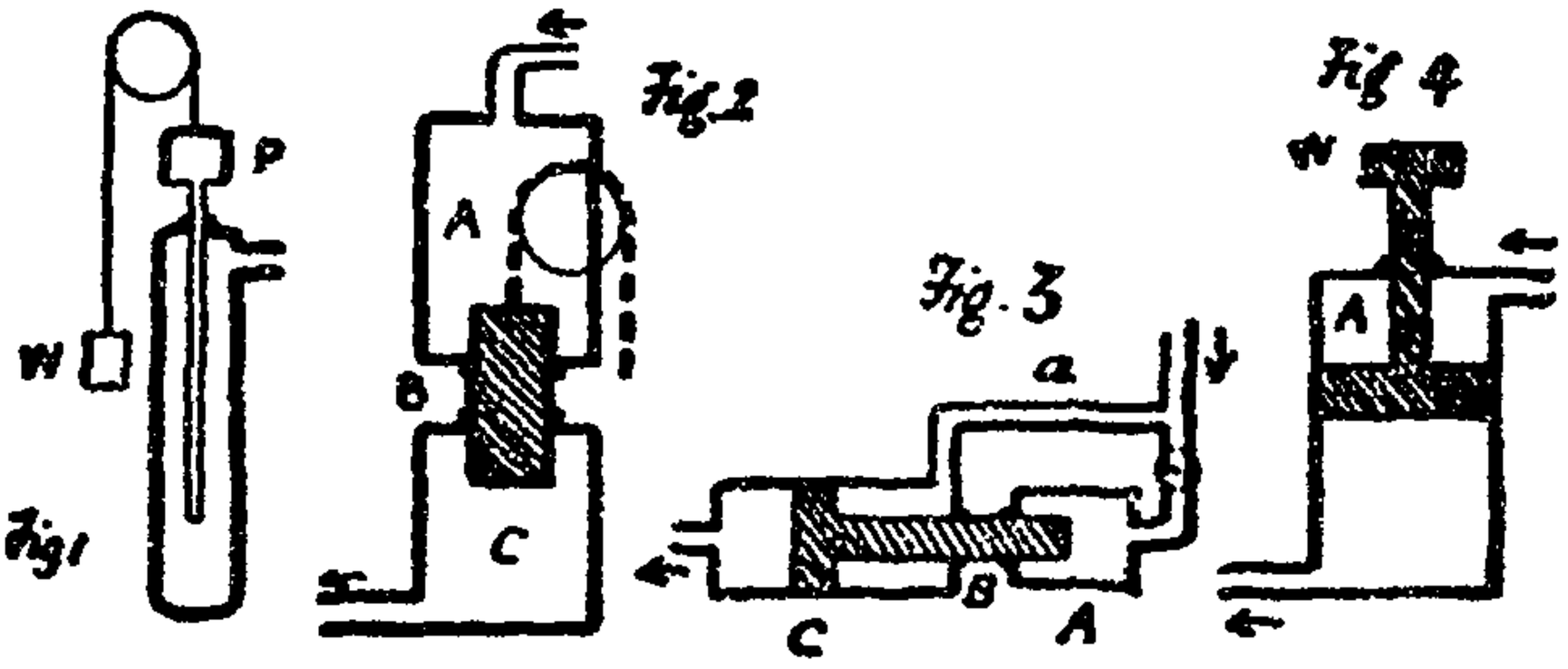
and equalize the air. Held, that a substantially similar lamp with but one gauze covering was an infringement. Kekewich, J., after citing *Clarke* v. *Adie*, 1875, L. R. 2 App. Cas. 335, said: "One must ascertain whether the differences really go to the essence of the patent article."

Thompson v. *Moore*, 1889, 6 R. P. C. 426.—A patent for a compass-card, consisting of a large but very light rim of aluminium and card attached by silk threads to a group of very small needles. The object was to get a slow swing and yet with a small inertia, and a small magnetic moment. The defendants made a very similar compass-card, but with differently arranged needles, and aluminium wire was used instead of the silk thread. Held, by the Master of the Rolls, that as plaintiff's invention was only a new means of obtaining an old result, it must be strictly construed on the principles of *Curtis* v. *Platt*. But on appeal this judgment was reversed, on the ground that the results obtained by the plaintiff's invention were new, and that the essence of the combination had been infringed. This case is important as limiting and explaining the scope of *Curtis* v. *Platt*.

For infringements of combinations see also the following cases: *Smith* v. *London & N. W. Rail. Co.*, 1853, 2 Ell. & B. 76; *Bovill* v. *Keyworth*, 1857, 7 Ell. & B., 725; *De la Rue* v. *Dickenson*, 1857, 7 Ell. and B. 738, 3 Jur. (N.S.) 841; *Finlay* v. *Allen*, 1857, 19 Dec. C. Sess. 2nd Series, 1,087; *Patent Bottle Envelope Co.* v. *Seymer*, 1858, 5 C. B. (N.S.) 164: 28 L. J. C. P. 22; *Thomas* v. *Foxwell*, 1858, 5 Jur. (N.S.) 39; *Lister* v. *Eastwood*, 1864, 9 L. T. (N.S.) 766; *Bovill* v. *Crate*, 1867, 5 Griff. App. 46; *Bovill* v. *Smith*, 1867, Griff. App. 49; *White* v. *Fenn*, 1867, 15 W. R. 348, 15 L. T. (N.S.) 305; *Tatham* v. *Dania*,

1869, Griff. 213; *Saxby* v. *Clunes*, 1874, 43 L. J. Ex. 228; *Flower* v. *Lloyd*, 1877, W. N. 1877, 71, 132; Johnson's Pat. Man., 4th ed., 245; *Henderson* v. *Clippens Oil Co.*, 1883, 20 Scott, Law Rep. 423; *Lawrence* v. *Perry*, 1885, 2 R. P. C. 184; *United Telephone Co.* v. *Nelson*, 1887, W. N. 1887, 193; *Ellington* v. *Clark*, 1888, 5 R. P. C. 319; *Garrard* v. *Edge*, 1889, 6 R. P. C. 372, 563, 44 Ch. D. 224; *Mason* v. *Goodwin*, 1889, 6 R. P. C. 235; *Boyd* v. *Horrocks*, 1892, 9 R. P. C. 77; *Peckover* v. *Rowland & Co.*, 1893, 10 R. P. C. 118.

Ellington v. *Clarke*, 1888, 5 R. P. C. 135, 319.—The



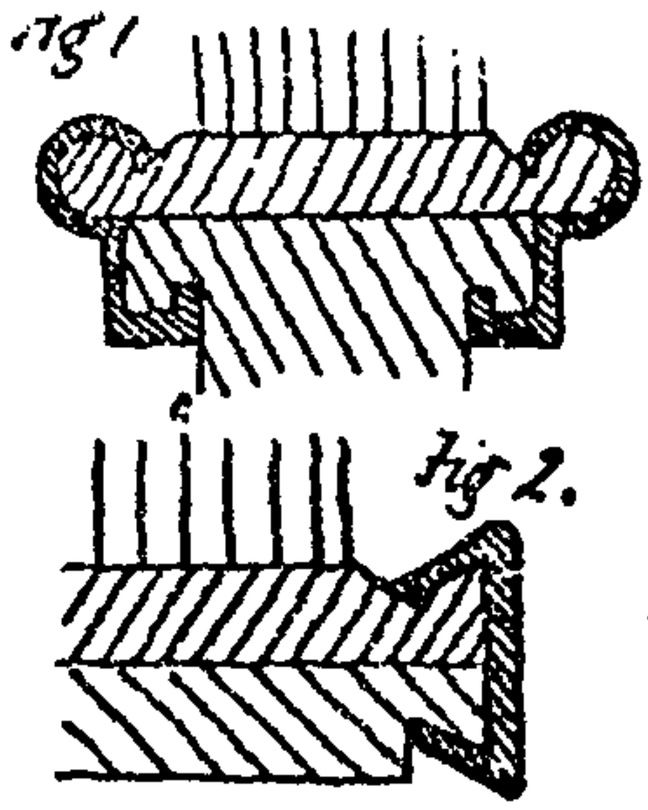
patent was for improvements in hydraulic lifts. The old form of hydraulic lift is shewn in Fig. 1. The cage (P) is raised by the pressure of water acting on a long piston working in a water-tight collar. The cage is balanced by a weight (W). A great deal of water is wasted upon each ascent. To remedy this, as also to get rid of the chain and weight, which are sometimes dangerous, Berly devised the form shewn in Fig. 2. The water is admitted to the chamber (A) and drives down the piston (B), which in its turn drives the water out of the cylinder (C) into the cylinder of the lift. B is counterweighted by a chain consisting of heavy weights linked together, and passing over a pulley; so that as it descends the

CHAP. XXIV. SECT. 5.

Infringement of a combination.

weight pressing on it increases. Ellington's invention is shewn in Fig. 3. The cylinder (A) was made smaller and placed horizontal, so as to work with high pressure; but this was not specifically claimed, and the weight, pressing B downwards, was replaced by a water-tube (*a*) connected into the cylinder (C), which pressed on the back of the piston (B). The infringement complained of was made according to Andrews' patent. Fig. 4.—Here both cylinders are amalgamated. The arrangement is such that the upper cylinder (A) is really the smaller, as the water only acts on an annular surface. The weight on B is put at W; so that this machine is midway between 2 and 3. It was held that the weight (W) was really only a mechanical equivalent for the tube (A) in Fig. 3, but on appeal this was reversed on the ground that defendant's machine was essentially the same as Fig. 2.

In the case of *Tweedale* v. *Ashworth*, 1892, 9 R. P. C. 121, the plaintiff had invented a new mode of attaching the cards on to the flats of carding engines. The cards consist of "foundations" of some elastic substance in which the carding-pins are fixed; and the foundation was fixed on to the flat by bent strips of metal, as shewn in section in Fig. 1. These metals gripped hold of the sides of the foundation, and the width of the card being rather smaller than that of the flat on which it was placed, the strips stretched the card into its place. The defendant's method (complained of as an infringement) is shewn on Fig. 2. There is no gripping action of the metal clips, only a wedging or squeezing of the foundation



against the flat, and the foundation has to be stretched by a special machine. The case was carried to the House of Lords, where it was decided that the method of gripping flexible substances with metal strips was old; hence the patent could only be for a particular application of that method carried out in a particular way, and they considered that the defendant had not infringed it.

6. A patent is not infringed by the use of the same means for a different purpose.—Thus, where a patent had been granted for treating sewage-water chemically by means of hydrate of lime in order to make manure, it happened that this process also purified water, but this purpose was not claimed in the patent. The defendants used the process for purifying water, and did not sell or use any of the precipitated manure so obtained. Held, no infringement: *Higgs* v. *Goodwin*, 1858, E. B. & E., 529, 27 L. J. Q. B. 421; compare semble by Parke, B., in *Morewood* v. *Tupper*, 1855, 3 C. L. R. 718; *Lister* v. *Eastwood*, 1864, 9 L. T. (N.S.) 766.

In *Fletcher* v. *The Glasgow Gas Commissioners*, a piece of metal attached to the latch of an oven to prevent the door flying open was held not to infringe a patent comprising a similar arrangement for keeping an oven door open to admit the air: 1887, 4 R. P. C. 389. On the other hand, if the different purpose for which the infringement was used were simply in addition to the purpose disclosed in the patent, there would be infringement: *Cannington* v. *Nuttall*, 1871, L. R. 5 H. L. 205; *Edison* v. *Holland*, 1888, 5 R. P. C. 482.

7. It is no answer to an allegation of infringement for the defendant to say that the means used

CHAP. XXIV. SECT. 7.

It is no answer to an allegation of infringement for the defendant to say that the means used are an improvement on the original patent.

are an improvement on the original patent, for, as has been seen (Chap. I., sect. 5), a patent may be granted for an improvement on a previous patent, but the use of the second may be an infringement of the first: *Neilson* v. *Harford*, 1841, 1 W. P. C. 310; *per* Parke, B., *Russell* v. *Ledsam*, 1843, 14 M. & W. 578; *Needham* v. *Johnson*, 1884, 1 R. P. C. 53.

8. Coextension of anticipations and infringements.—A test sometimes applied to decide whether a thing is an infringement is to ask whether it would have been sufficient as an anticipation to invalidate the patent. In *Davis* v. *Feldtman*, 1884, 1 R. P. C. 13, 193, the plaintiff had patented an improvement in umbrellas. It was found that, so far as the defendant had infringed, he had only used an old contrivance: *per* Fry, L.J.: "I think the plaintiff is in a dilemma. If his second claim covers the defendant's user, then he has been anticipated by Weeks." The Court, however, held there had been no infringement; see also *Downes* v. *Falcon Engine Works*, 1886, 3 R. P. C. 70, 2 R. P. C. 197. In *Young* v. *Rosenthal*, 1884, 1 R. P. C. 29, the patentee had been anticipated by the use of curved instead of straight lines for corsets. Held, that he was in a similar dilemma with regard to an infringement in which such curved lines were used.

In applying this principle, some care must be exercised. For the above rule assumes that at the supposed time of the hypothetical prior invention public knowledge is in the same condition as it is at the time of the infringement. For instance, take the case of an inventor who has tried a certain process imperfectly and abandoned it owing to a mistaken notion that it

would not work, and that his experiments and results are published and known. A subsequent experimenter tries it again, shews that it can be made a success, and patents it. No doubt this patent would be good (Chap. V., sect. 7). And yet, suppose the patent had been taken out before the operations of the first inventor? Those very operations of the first inventor would no doubt have been infringements, although, as has been said, they would not have been sufficient anticipations to have invalidated the patent; so that here you have a case in which infringement is not tested by seeing whether or no it would have been an anticipation. The explanation is, that the first process prior to the invention was conducted blindly, in the dark, whereas the very same process conducted subsequently to the invention would be in the light of the knowledge which the invention has conferred. This, it is submitted, is the true meaning of *Caldwell* v. *Van Vlissengen*, 1851, 9 Hare, 421, and *Murray* v. *Clayton*, 1872, L. R. 7 Ch. 585, where it was held, 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 an inventor's right to a patent: see also *Daw* v. *Eley*, 1865, L. R. 3 Eq. 501 n.; *Newton* v. *Grand Junction Rail. Co.*, 1846, 5 Ex. 334.

9. Time when an infringement may be committed.—An infringement may be committed after the publication of the complete specification and during the life of the patent (Patents Act, 1883, s. 13). Extensions are now dated the day after they are granted, but if an interval occurred between the expiration of a patent and its extension, no act done in the interval could constitute

post, p. 447.

CHAP. XXIV. SECT. 9.

an infringement: *Russell* v. *Ledsam*, 1845, 14 M. & W. 574, 16 M. & W. 641, 1 H. L. C. 687.

Time when an infringement may be committed.

10. The intention to infringe is not material.—The question of infringement does not depend upon the intention of the infringing party. The view that intention is material was at one time held: *Heath* v. *Unwin*, 1845, 2 W. P. C. 227; but in the same case, at p. 300, it was negatived, and in *Stead* v. *Anderson*, 1847, 2 W. P. C. 156, the Court says: "We think it clear that the action is maintainable in respect of what the defendant does, not what he intends": *Wright* v. *Hitchcock*, 1870, 39 L. J. Ex. 103; *McCormick* v. *Gray*, 1861, 31 L. J. Ex. 48, 7 H. & N. 25; *Newall* v. *Elliot*, 1864, 10 Jur. (N.S.) 954, 13 W. R. 11; *Curtis* v. *Platt*, 1863, 11 L. T. (N.S.) 245. Nor is it necessary that the defendant should have known that the invention he infringes was the subject of a patent at all: *Walton* v. *Lavater*, 29 L. J. C. P. 279; *Nobel's Explosives* v. *Jones*, 1880, L. R. 17 Ch. D. 721; *Young* v. *Rosenthal*, 1884, 1 R. P. C. 39; *Davenport* v. *Rylands*, 1865, L. R. 1 Eq. 303; *Wright* v. *Hitchcock*, 1870, 39 L. J. Ex. 103; *Wittman* v. *Oppenheim*, 1884, 27 Ch. D. 260; *Geary* v. *Norton*, 1846, 1 De. G. & S. 9; *Plimpton* v. *Spiller*, 1876, L. R. 4 Ch. D. 286. Innocence of intention may, however, have a great effect upon costs:

post, p. 408. Chap. XXVIII., sect. 39.

11. In order to constitute an infringement, the act complained of must be one calculated to injure the trade profits of the patentee.—Having regard to the words "*the whole profit and advantage of the invention*," and remembering that the object of patent law is not to reward scientific discovery, but to encourage trade, it

follows that in general only those acts will be treated as infringements which are held either directly or indirectly to injure the trade of the patentee.

In order to constitute an infringement, the act complained of must be one calculated to injure the trade profits of the patentee.

And therefore, merely to use a patented invention for experiment will not be an infringement. And perhaps even to use a patent in a private way for self-instruction, not for profit or for business purposes, would not be an infringement, though that is more doubtful. But to make use or sell an object made according to the invention for the purposes of profit will be an infringement, and to buy an article made according to the patent would also be an infringement. The true test in every case will be whether the acts complained of are calculated substantially to interfere with the profits of the patentee.

post, p. 320.

12. Infringement by manufacture.—It is an infringement to make a patented article with a view directly or indirectly to obtain profit therefrom. But inasmuch as the very nature of the power of the Crown to grant monopolies depends on its position as protector of *trade*, it follows that merely to make a thing is no infringement unless in some way the trade in the thing is affected. Thus, Patterson, J., considered that to "make a thing merely for amusement or as a model was not an infringement: *Jones* v. *Pearce*, 1832, 1 W. P. C. 125. But it is submitted that it would not be permissible to make a patented invention for private amusement unless for the purposes of experiment or of improving it, and if the article has been made for profit and is a piracy, the buyer would no doubt be liable as well as the seller, even though the buyer had merely purchased it for amusement, and not to make any profit by means of it (*per* Kay, J.): *United Telephone Co.* v. *Sharples*, 1885, L. R. 29 Ch. D. 164.

CHAP. XXIV. SECT. 13.

Experimental user.

13. Experimental user.—Mere experimental user will not infringe a patent provided no pecuniary benefit is obtained thereby. "If a man makes things merely by way of *bonâ fide* experiment, and not with the intention of selling and making use of the things 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 a 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. . . . But when you see a man using a machine as this defendant has done, under a 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 a patent, he claims a right to make and use it, and his experiment is made to see how his machine works" (*per* Jessel, M.R.): *Frearson* v. *Loe*, 1878, L. R. 9 Ch. 67; see also *Muntz* v. *Foster*, 1844, 2 W. P. C. 101. An instructor who bought pirated instruments to teach his pupils so as to save the expense of the patented articles, was held to have infringed, as he had done so indirectly for profit: *United Telephone Co.* v. *Sharples* 1885, L. R., 29 C.D. 164, 54, L.J., Ch. 633.

14. Infringement by user.—Subject to what has been said as to experimental user, the unauthorized use of a patented invention will be an infringement of it. Thus, in *Betts* v. *Neilson*, 1865, 6 N. R., 221, L. R. 3 Ch. 429, the defendants sent some beer in bottles, fastened with a

capsule, from Scotland to an English port for shipment abroad. Held, that during the time the bottles were in England the capsules were being used to hold the beer. Wood, V.-C., said he could conceive a case in which foreign tools lying inert in boxes, and merely for transhipment, could not be said to be used so as to infringe a patent, and referred to the case of *Caldwell* v. *Van Vlissingen*, 1851, 21 L. J. Ch. 97; 9 Hare, 415, in which case the use of a screw-propeller in English waters was held an infringement. But custom-house agents merely receiving goods and storing them are not infringers: *Nobel's Explosives Co.* v. *Jones, Scott & Co.*, 8 App. Cas. 5, 17 Ch. D. 721. In *Adair* v. *Young*, 1879, L. R. 12 Ch. D. 13, an injunction was granted to prevent a master of a ship from using pumps which the owners had fitted up on the ship. This was on the ground, not that he had committed an infringement by simply having the pumps there, but that he might do so. In *Proctor* v. *Bailey*, 1889, 6 R. P. C., 106, the putting-up of fire-engines was held not to be experimental but an infringing user. The possession of a number of instruments by a trading company is sufficient to warrant the granting of an injunction, although they have not sold any: *United Telephone Co.* v. *Globe Telephone Co.*, 1884, 26 Ch. D. 766; *Forsyth* v. *Riviere*, 1819, 1 W. P. C. 97.

15. After a patent has been granted, a man who has previously used the invention privately may not continue to do so except experimentally: *Smith* v. *Davidson*, 1857, 19 C. S. 697; and compare *Cornish* v. *Keene*, 1835, 1 W. P. C. 571. It thus appears as if by obtaining a patent a man can stop another from doing what he was doing before. This, however, is not

CHAP. XXIV. SECT. 15.

After a patent has been granted, a man who has previously used the invention privately may not continue to do so except experimentally.

involved in the above proposition. For if the prior user were experimental and secret, the experimenter may still continue to experiment as before, and he will not infringe. If the prior user were abandoned, and had never been brought to perfection, then the rediscoverer and patentee is the true inventor. If on the other hand the prior user were public, then the patent would be invalid.

16. Infringement by sale or purchase.—The sale of a patented article or of an article made according to a patent is an infringement: *Gibson* v. *Brand*, 1841, 1 W. P. C. 630. It was apparently considered in *Minter* v. *Williams*, 1835, 1 W. P. C. 137, 5 Nev. & M. 647, 4 A. & E. 251, that the mere exposing for sale was not an infringement. In *Muntz* v. *Foster* the making of a quantity for sale was held to be an infringement: 1844, 2 W. P. C. 101; and offering for sale was also held to be an infringement in *Oxley* v. *Holden*, 1860, 8 C. B. (N.S.) 666, 30 L. J. C. P. 68. A buyer of a patent article infringes the patent as well as the seller: *United Telephone Co.* v. *Sharples*, 1885, L. R. 29 Ch. D. 164; though perhaps a small quantity bought in ignorance for private purposes would not render the buyer liable: *Wright* v. *Hitchcock*, 1870, 39 L. J. Ex. 106; *Davonport* v. *Rylands*, 1865, L. R. 1 Eq. 308.

In the *United Telephone Co.* v. *Henry & Co.*, 1885, 2 R. P. C. 12, a workman of the plaintiffs' went to the defendants to buy a pirated telephone which he saw in their shop. He, however, only got a loan of it, and promised to return it. Held, that the defendants were not proved to have sold or intended to sell the telephone, and the action was dismissed.

17. The sale in Great Britain of an article patented in Great Britain but made abroad is an infringement: *Walton* v. *Lavater*, 1860, 29 L. J. C. P. 279; see also 1 W. P. C. 48 n.; and a sale in Great Britain of an article made abroad according to a process patented in Great Britain is an infringement, though the patent is not for the article but the process of making it: *Elmslie* v. *Boursier*, 1869, L. R. 9 Eq. 217, 39 L. J. Ch. 328; *Von Heyden* v. *Neustadt*, 1880, 14 Ch. D. 230; *Cartsburn Co.* v. *Sharpe*, 1884, 1 R. P. C. 181.

"If a man buys and sells he may be said to be 'making' by the hands of another": *Holmes* v. *London & N. W. Rail. Co.*, 1852, M. P. C. 23.

It is no answer to an action of infringement to say that the number of articles made is small: *Cole* v. *Saqui*, 1888, 5 R. P. C. 489. Where, however, a patentee or his licensee sells an article to a purchaser there is an implied permission to use it and to resell it again and again within the area which the patent covers: *Thomas* v. *Hunt*, 1864, 17 C. B. (N.S.) 183; *Smith* v. *Buchanan*, 26 S. J. 347. But a license to manufacture articles in a foreign country under a foreign patent does not give an implied right to sell them here: *Betts* v. *Willmot*, 1870, L. R. 6 Ch. 239, 19 W. R. 369; *Société Anonyme des Glaces* v. *Tilghmans*, 1883, 25 Ch. D. 1. A person who buys from a patentee without notice of the area within which the patent may be used takes it with power to resell in the whole area of the patent: *Heap* v. *Hartley*, 1888, 5 R. P. C. 603, 6 R. P. C. 496.

18. It is no infringement of a patent to sell the materials for infringing it, provided that the vendor does not take such part or profit in the putting them

CHAP. XXIV. SECT. 18.

It is no infringement of a patent to sell the materials for infringing it.

together, or preparing them for being put together, as makes him a partner or joint tort feasor. This was laid down by Jessel, M.R., in *Townsend* v. *Haworth*, 1875, L. R. 12 Ch. D. 831 n., but a fuller account of the judgment is given in Higgins' Digest of Patent Cases, 2nd Ed. p. 166; see also *Sykes* v. *Howarth*, 1879, L. R. 12 Ch. D. 832; *Goucher* v. *Clayton*, 1865, 11 Jur. (N.S.) 462, 13 L. T. (N.S.) 115; *McCormic* v. *Gray*, 1861, 31 L. J. Ex. 47. But to sell the component parts of an invention so adapted to one another that they merely require to be put together, would be an infringement: semble *United Telephone Co.* v. *Dale*, 1884, 25 Ch. D. 778; and see *Newall* v. *Elliot*, 1864, 10 Jur. (N.S.) 958, where Bramwell, B., said: "If a man fits up on board a ship a part of a machine, and has the other part there so that he may apply the whole part of the invention when he gets out of England, he may infringe the invention": see also *Abbot* v. *Williams*, 1837, 9 Rep. Arts. 103.

19. Repairs.—When a machine has been purchased from a patentee or his licensees, and the patentee has thus been paid for the use of the patent, its component parts may not be restored if broken, if the parts form an essential part of the combination, except by persons duly licensed to do so: *United Telephone Co.* v. *Nelson*, 1887, W. N. 1887, 193.

20. Use on board ships.—The jurisdiction of the Courts to restrain patent infringements extends to British waters: *Adair* v. *Young*, 1879, L. R. 12, Ch. D. 13; but not to British vessels on the high seas: *Newall* v. *Elliot*, 1864, 10 Jur. (N.S.) 954, 13 W. R. 11. By Common

Use on board ships.

Law this jurisdiction extends also to foreign vessels in British waters. In *Caldwell* v. *Van Vlissingen*, 1851, 16 Jur. 115, 21 L. J. Ch. 97, a Dutchman was restrained from using on board a Dutch vessel a screw-propeller which was the subject of an English patent. In 1852, however, this law was altered by statute, and it is now provided by the Patents Act, 1883, s. 43, that a patent shall not prevent the use in a foreign vessel of anything, provided (*a*) that it is used for the purpose of navigation; (*b*) that it is not used for or in connection with the manufacture or preparation of anything intended to be sold or exported from the United Kingdom; (*c*) that the state to which the ship is subject shall afford like privileges to English vessels.

post, p. 458.

21. Manufacture, use, and sale by agents.—The ordinary law of principal and agent as applied to torts applies also to infringement of patents. Thus a principal is liable for the acts of his agent: "He that comes and procures articles to be made may well be said to have made them himself" (*per* Tindal, C.J.): *Gibson* v. *Brand*, 1842, 1 W. P. C. 631. If, however, the work is done by a contractor, he need not necessarily be the agent of the person who employs him, nor need the employer be necessarily liable for the contractor's acts: *Denley* v. *Blore*, 1851, 38 Lond. Jour. 224. On the same principle, the mere fact that the defendants were contractors for the Crown, was held not to justify them in infringing a patent which *agents* of the Crown could have done with impunity under the then law: *Dixon* v. *Small Arms Co.*, 1877. L. R. 1 App. Cas. 632, 1 Q. B. D. 384. The defendant contracted to clothe a machine with cards, which infringed a patent if they were fixed

CHAP. XXIV. SECT. 21.

Manufacture, use, and sale by agents.

on in a peculiar manner, but not otherwise. The defendant paid a nailer to do the work who was, however, chosen by the owner of the machine. Held, that defendant had infringed: *Sykes* v. *Howarth*, 1879, L. R. 12 Ch. D. 832.

Directors of a company may make themselves liable by directing acts of infringement: *Betts* v. *De Vitre*, 1868, L. R. 3 Ch. 441, 37 L. J. Ch. 325; *Spencer* v. *Ancoats Vale Rubber Co.*, 1888, 6 R. P. C. 46, 4 T. L. R. 681.

Of course servants and managers can be restrained as well as principals: *Betts* v. *Neilson*, 1865, 6 N. R. 221; but a mere workman would not in general be treated as an infringer: *Townshend* v. *Haworth* (*per* Jessel, M.R.), Higgins' Digest, p. 168.

Custom-house officials merely storing goods, and not having possession or control over them, would not be considered as infringers: *Nobel's Explosive Co.* v. *Jones, Scott & Co.*, 1883, 8 App. Cas. 5, 17 Ch. D. 721; and public carriers would probably be in the same position. Where a defendant committed an infringement at the instance of the plaintiff who wished to entrap him, held that he did so as agent for the plaintiff, and the action failed: *Kelly* v. *Batchelar*, 1893, 10 R. P. C. 289.

22. The question of infringement is one of fact, and therefore is for the jury if the action is being tried by jury: *Walton* v. *Potter*, 1841, 1 W. P. C. 586; *Macnamara* v. *Hulse*, 1842, Car. & M. 471; *Newton* v. *Grand Junction Rail. Co.*, 1846, 5 Ex. 331; *Stevens* v. *Keating*, 1847, 2 W. P. C. 191; *Sellers* v. *Dickinson*, 1850, 5 Ex. 323; *De la Rue* v. *Dickinson*, 1857, 7 E. & B. 738; *Seed* v. *Higgins*, 1858, 8 H. L. C. 550. Sometimes, however,

it may be a mixed question: *Curtis* v. *Platt*, 1866, 35 L. J. Ch. 852; see also Chap. XXVIII., sect. 24.

23. The opinion of an expert as to facts is admissible, but not to say whether or no there has been an infringement: *Seed* v. *Higgins*, 1860 (*per* Lord Wensleydale), 8 H. L. C. 550.

CHAPTER XXV.

EXTENSION OF LETTERS PATENT.

CHAP. XXV. SECT. 1.

1. Old practice.—Prior to the year 1835 patents were occasionally extended by Act of Parliament. A number of instances of such acts are given in Webster's Patent Cases (see Index, "Extension of Terms"). In 1835, by 5 & 6 Will. IV. c. 83, s. 4, power to extend patents for seven years was given upon report of the judicial committee of the Privy Council: see also 2 & 3 Vict. c. 7, and 7 & 8 Vict. c. 69, s. 2. Opposition to such extension was made by entering a caveat. For cases under the Act of 1835, see 1 W. P. C. 557.

post, p. 451.

2. Practice under the present law.—Under the Act of 1883, s. 25, a patentee may, at least six months before the expiration of his patent, petition for extension, upon which a further term of seven years, or in exceptional cases of fourteen years, may be granted, on such conditions as the judicial committee of the Privy Council thinks fit. Any one may enter a caveat against the petition. Rules of procedure may be made by the Privy Council, who may also award costs.

For the Rules see *post*, p. 565.

All petitions presented at present are for the extension of patents which were granted under the old acts,

and hence are governed by the old law: *Brandon's Patent*, 1884, 1 R. P. C. 154; though when once the extension is granted, a new patent is sealed under the Patent Act, 1883, as will be seen hereafter. Hence the limit of six months does not apply to applications for extension of patents granted under the old acts, and the rules of the Privy Council are still in force, and no new ones have been made. There is really no practical difference between the old practice and the new, except as to the requirement of petitioning six months before the expiration of the patent.

Practice under the present law.

post, p. 347.

3. The persons who may petition.—The Patents Act, 1835, s. 4, provided that "if any person who now hath, or shall hereafter obtain, a patent, shall petition," etc. The Patents Act, 1883, provides that "a patentee" may petition which now, by sect. 46, includes the persons for the time being entitled to the patent.

post, pp. 451, 462.

Under the Act of 1835, a patentee might petition though he were only trustee of the patent for an alien: *Newton's Patent*, 1861, 14 Moo. P. C. C. 156; and a public company may also be a petitioner: *Cook's Patent*, 1851, 38 Lond. Jour. 223; *Deacon's Patent*, 1887, 4 R. P. C. 119; and Patent Act, 1883, ss. 25, 46, 117.

post, pp. 451, 462.

An executor can petition: *Bodmer's Patent*, 1849, 6 Moo. P. C. C. 469; and an administrator: *Downton's Patent*, 1839, 1 W. P. C. 565; *Heath's Patent*, 1853, 2 W. P. C. 247; *Willacy's Patent*, 1888, 5 R. P. C. 690.

Under the Act of 1835, extensions were and are frequently granted on the petition of assignees: *Wright's Patent*, 1837, 1 W. P. C. 561; *Morgan's Patent*, 1843, 1 W. P. C. 737; *Whitehouse's Patent*, 1838, 1 W. P. C. 476; *Russell* v. *Ledsam*, 1845, 14 M. & W. 574, 16

CHAP. XXV. SECT. 3.

Who persons who may petition.

M. & W. 633, 1 H. L. C. 687; *Norton's Patent*, 1863, 1 Moo. P. C. (N.S.) 339; *Pitman's Patent*, 1871, 8 Moo. P. C. C. (N.S.) 297; see also 1 W. P. C. 725 note (*e.*).

An equitable assignee is entitled to be a co-petitioner: *Noble's Patent*, 1850, 7 Moo. P. C. C. 191. An assignee's title must, however, be strictly proved: *Wright's Patent*, 1843, 1 W. P. C. 737; *Galloway's Patent*, 1843, 1 W. P. C. 725. The executor of an assignee may also petition: *Bodmer's Patent*, 1849, 6 Moo. P. C. C. 469.

It is usual to join in the petition all who have an interest in the patent. Thus, in *Deacon's Patent*, 1887, 4 R. P. C. 119, where a patentee had assigned to a company for a sum down and shares, both the patentee and the company joined in the petition. In *Church's Patent*, 1886, 3 R. P. C. 95, the Privy Council decided that where a patent had been mortgaged, the mortgagee as legal owner ought to have joined in the petition. In *Derosne's Patent*, a part assignment had been made, but only for the original term of the patent, the assignees did not join in the petition which was granted to the patentee: 1844, 2 W. P. C. 2, note *e.*

The claims of an inventor to an extension rest on his ingenuity, and are far more favourably considered than the claims of an importer of an invention, or of an assignee: *Electric Telegraph Co.'s Patent*, cited, 1 Moo. P. C. C. (N.S.) 339. Thus in *Norton's Patent*, 1863, 1 Moo. P. C. 339, the Master of the Rolls said, "It must always be borne in mind that the assignee of a patent does not, unless under peculiar circumstances, apply on the same favourable footing as the original inventor": see *Morgan's Patent*, 1843, 1 W. P. C. 737; *Normand's Patent*, 1870, 6 Moo. P. C. C. 477; *Pitman's Patent*, 1871,

8 Moo. P. C. C. (N.S.) 297; *Bovill's Patent*, 1863, 1 Moo. P. C. (N.S.) 348.

The persons who may petition.

A mere importer of an invention is not so favourably regarded as the inventor: *Claridge's Patent*, 1851, 7 Moo. P. C. C. 394; *Soame's Patent*, 1843, 1 W. P. C. 733; *Berry's Patent*, 1850, 7 Moo. P. C. C. 187; *Betts' Patent*, 1846, 2 W. P. C. 160. As to the conditions sometimes inserted for the benefit of inventors, see "Conditions," sect. 17. *post*, p. 345.

4. Procedure.—The first step is to advertise, as provided by 4 & 5 Will. IV., c. 83, and P. C., rule ii. For forms of advertisement see Appendix and sect. 6, *infra*. The petition (sect. 7, *infra*) is presented within a week after the last advertisement (Privy Council Rules III.), accompanied by affidavits verifying the insertion of the advertisements (and under the Act of 1883, at least six months before the expiration of the patent).

post, p. 565.
post, p. 565.
post, p. 565.
post, p. 452.

By entering a caveat, any person (see sect. 9, *infra*) obtains the right to have served upon him by the petitioner a copy of the petition, within a fortnight of receiving which he must give notice of objections if he means to oppose the grant of the patent: Rule VI. (see sect. 10, *infra*). An application is then made by the petitioner, on the day named in the advertisement, to the Privy Council to fix a hearing day for the petition, on affidavit of service of the petition, on all persons who have entered caveats: Rule V. The hearing day is thus fixed, and the petitioner gives four weeks' notice of it to all the persons who have entered caveats: Rule III. Certain copies of the specification and accounts must be lodged at the Privy Council one week before the hearing day: Rule IX. (see sect. 11, *infra*),

post, p. 332.
post, p. 332.
post, p. 332.
post, p. 332.

CHAP. XXV. SECT. 4. Procedure.

and all parties at their own expense may have copies of any documents lodged in respect of any application.

5. Inspection by an opponent of the petitioner's accounts is not allowed before the hearing day: *Bridson's Patent*, 1852, 7 Moo. P. C. C. 499; but copies of them are sent from the Privy Council Office to the law officer for examination.

6. The advertisements should be inserted in newspapers in places where the patent is being worked: *Derosne's Patent*, 1844, 2 W. P. C. 2, and should contain the names of all who wish to support the petition, as, for instance, the equitable as well as the legal assignees: in *Re Noble's Patent*, 1850, 7 Moo. P. C. C. 191.

7. The petition.—The petition should contain all the facts upon which the petitioners rely, for it will be very difficult, if not impossible, for them to bring forward at the hearing facts which they have not set out in outline in their petition: *Pitman's Patent*, 1871, L. R. 4 P. C. 84. In drawing a petition great care must be taken to set out the facts clearly, fully, in order, without repetition, and yet in as condensed a form as possible. A well-drawn petition is of great influence in gaining the case. It should be in paragraphs, and, where necessary, clear marginal references should be given to the pages and lines of any documents cited. In all petitions to the Privy Council, the utmost good faith in their preparation is required. They are not like pleadings, where affirmations and denials are made in order to cast the burden of proof on other parties, and perhaps secure a right to reply, or for some such tactical advantage. They are supposed to be statements of the facts, and nothing but the facts, and

The petition.

uberrima fides is expected in their preparation. In *Horsey's Patent* a petition set out an assignment to a company, but did not state (as the fact was) that the company, though registered, had not, in any commercial sense, been formed at all, and that the only real owners of the patent were the patentee and his creditors. The Privy Council considered that they had not been treated with candour, and though the invention had merit, and the patentee had not been sufficiently remunerated, the petition was rejected: 1884, 1 R. P. C. 225; see also *Pitman's Patent*, 1871, L. R. 4 P. C. 84, 8 Moo. P. C. C. (N.S.) 293; *Johnson's Patent*, 1871, L. R. 4 P. C. 83; *Adair's Patent*, 1881, L. R. 6 App. Cas. 176. In one case where certain facts relating to the petitioner's title had been omitted in the petition, leave to amend was granted, and the hearing postponed: *Hutchinson's Patent*, 1861, 14 Moo. P. C. C. 364. In *Fountain Livet's Patent*, where a petitioner knew of a prior patent, which might be held to anticipate his own; held, that he ought to have disclosed it in his petition: 1892, 9 R. P. C. 327. As to the grounds upon which the petition is granted, and which should be specified in the petition: see *infra*, sect. 13, and for a form of petition; see *e.g.*, *Nussey & Leachman's Patent*, 1889, 7 R. P. C. 22. The petition should state if the patent is an importation: *Pitman's Patent*, 1871, *supra*.

post, p. 333.

also *post*, p. 597.

ante, p. 327.

8. The time for presenting the petition is shortly before the last six months of the patent's life. A petition presented too long before its expiration (*e.g.*, eighteen months) may be ordered to stand over to see what the profits will be: *Mackintosh's Patent*, 1837, 1 W. P. C. 739. The petition should be presented within a week of the publication of the last advertisement: Rule III.;

ante, p. 327.

post, p. 566.

CHAP. XXV. SECT. 8.

The time for presenting the petition.

but a mistake of a few days has been allowed to be rectified: *Hutchinson's Patent*, 1861, 14 Moo. P. C. C. 364.

9. Caveators.—Any one may enter a caveat, but at the hearing the caveat must be supported by a real opponent, and not simply by a patent agent: *Lowe's Patent*, 1852, 8 Moo. P. C. C. 1.

post, P. Act, 1883, sec. 25, ss. 2, p. 452.

10. Notice of objections to the extension should be full and detailed, but the committee may notice an anticipation not set forth in the objections, in which case they may deprive the opponents of costs: *Stewart's Patent*, 1885, 3 R. P. C. 7.

The Attorney-General is not bound to give any notice of objections, and may raise objections at the hearing without any notice: *Ball's Patent*, 1879, L. R. 4 App. Cas. 171; *Stewart's Patent*, 1885, 3 R. P. C. 7; *Church's Patent*, 1886, 3 R. P. C. 101; *Fountain Livet's Patent*, 1892, 9 R. P. C. 327.

11. Lodging of the documents at the Privy Council Office one week before the hearing day: P. C., r. ix. Non-compliance with this rule may not be fatal: *Bell's Patent*, 1846, 2 W. P. C. 159; but the accounts ought to be lodged in time, otherwise the committee may dismiss the petition (see *infra*, sect. 14, "As to Accounts").

post, p. 338.

12. The hearing.—The evidence follows as nearly as possible the rules of the H. C. J. The advertisements must be duly proved: *Perkins' Patent*, 1845, 2 W. P. C. 8; *Bell's Patent*, 1846, 2 W. P. C. 160; and the evidence is orally given. The Attorney-General appears to watch the case for the Crown: *Erard's Patent*, 1835, 1 W. P. C. 557 n.; and this whether or no a caveat has been entered: *Pettit Smith's Patent*, 1850, 7 Moo. P. C. C. 133.

No more than two counsel are heard in any one interest: *Woodcroft's Patent*, 1841, 3 Moo. P. C. C. 171 n. A preliminary objection is often taken that the accounts are on the face of them insufficient. If this is well founded the petition is at once dismissed, if not then the evidence proceeds. The Court, under the Patents Act, 1883, s. 28, sub-s. 2, may call in the aid of a skilled assessor: see Chap. XXVIII., sect. 21.

post, pp. 385, 454.

13. Grounds upon which a petition is granted: (a) **Public interest in the extension.**—In the Acts of Parliament by which prior to 1835 patents were extended, it was usual to recite matters shewing that it was for the public interest as well as that of the patentee, that the patent should be extended: see, *e.g.*, *Liardet's Patent*, 1776, 1 W. P. C. 52; *Hartley's Patent*, 1777, 1 W. P. C. 55; and the same considerations will weigh with the Privy Council in granting extensions under the statute: 1 W. P. C. 557 n. In *McDougall's Patent*, the fact that the public would be excluded from using alum, clay, and charcoal in certain proportions for deodorizing manure, held, to weigh against the somewhat dubious utility of the patent: 1867, L. R. 2, P. C. 1, 5 Moo. P. C. C. 1; *Sillar's Patent*, 1882, Good. P. C. 581; see also *Morgan's Patent*, 1843, 1 W. P. C. 739; *Soame's Patent*, 1843, 1 W. P. C. 734. A patentee had granted an exclusive licence to a company for a patent, and any prolongation that should be granted. Held, to be against the extension, for such exclusive use is contra to public policy: *Cardwell's Patent*, 1856, 10 Moo. P. C. C. 488. But in *Shone's Petition for Prolongation*, 1892, 9 R. P. C. 438, this objection was not pressed, and the patent granted, but on condition that the exclusive licence

post, P. Act, sec. 25, ss. 4, p. 452.

CHAP. XXV. SECT. 13.

Grounds upon which a petition is granted: (a) Public interest in the extension.

should cease. It was held, no ground for refusing to extend a patent for smoke prevention (which had been recently rendered compulsory in furnaces in the metropolis by Act of Parliament) that the public might be compelled to use the invention: *Foarde's Patent*, 1855, 9 Moo. P. C. C. 376.

(b) The benefit already received by the public from the invention.—In *Derosne's Patent*, the patentee had made over £8000 by a patent for refining sugar. The public had benefited by from 1½*d.* to 2*d.* per lb. The committee considered that though the profit to the patentee had been great, that the public had so greatly benefited, that they gave an extension of six years: 2 W. P. C. 4; *Erard's Patent*, 1835, 1 W. P. C. 557; *Soame's Patent*.—"The public has somewhat gained": 1843, 1 W. P. C. 735; *Jones' Patent*, 1840, 1 W. P. C. 557.—"An invention may not be a very difficult one, but it may be of such usefulness to the public that it may seem fair that the patentee should have a further portion of remuneration" (*per* Lord Hobhouse): *Beanland's Patent*, 1887, 4 R. P. C. 491. In this case, however, the application was refused, as there was no exceptional merit in the invention.

See *post*, p. 342.

(c) The merit of the invention.—The merit of the invention, that is to say, its ingenuity, novelty and utility, are looked upon from a different point of view in a petition for extension to that in which they are regarded in an action for infringement. For on the one hand, the mere fact that a patent would be supported on those grounds is not sufficient to make out a case of such exceptional merit as to warrant an extension. It is not every meritorious patent that will be extended, but only patents of exceptional character. On the other hand, the

Grounds upon which a petition is granted: (σ) The merit of the invention.

Court, if convinced that the invention has exceptional merit, will not try out questions of novelty or anticipation. "It is not the practice of this tribunal to decide upon the novelty or utility of a patent; and although they would of course abstain in any case from prolonging a patent which was manifestly bad, yet they are in the habit . . . to consider not only that amount of utility which would be necessary to support a patent, but that sort of utility which might more properly be described as merit" (*per* Lord Cairns): *Saxby's Patent*, 1870, L. R. 3 P. C. 294, quoted with approval in *Cocking's Patent*, 1885, 2 R. P. C. 153; see *Stewart's Patent*, 1885, 3 R. P. C. 10. *Church's Patent*, 1886, was on the same principle extended for five years in spite of alleged anticipation: 3 R. P. C. 101 (an action of infringement was then pending: 2 R. P. C. 175, 3 R. P. C. 127). *Heath's Patent*, 1853, 2 W. P. C. 247, was extended, the Court expressing no opinion on its validity; it was ultimately found bad for want of novelty: *Heath* v. *Smith*, 1854, 2 W. P. C. 275. Similarly, *Kay's Patent*, for spinning machinery, was extended for three years in 1839: 1 W. P. C. 568; but Chancery proceedings which had been commenced in 1835, and which were then pending, ended in 1841 by the invalidation of the patent by the House of Lords: 2 W. P. C. 83; see also *Lane-Fox's Patent*, 1892, 9 R. P. C. 411, where pending proceedings were not considered as preventing an application for extension, even though the judgment of a Court of the High Court of Justice had recently declared the patent invalid. *Pinkus' Patent*, 1848, 12 Jur. 234; *Betts' Patent*, 1862, 1 Moo. P. C. C. (N.S.) 49. "Before their Lordships can recommend . . . the prolongation of a patent they must be convinced that the patentee has been inadequately

CHAP. XXV. SECT. 13.

Grounds upon which a petition is granted: (c) The merit of the invention.

remunerated; . . . but that is not all, . . . there must be some exceptional merit in the invention" (*per* Lord Hobhouse): *Beanland's Patent*, 1887, 4 R. P. C. 491; and see *Stoney's Patent*, 1888, 5 R. P. C. 522; *Swaine's Patent*, 1837, 1 W. P. C. 559; *Woodcroft's Patent*, 1846, 2 W. P. C. 32; *McInnes' Patent*, 1868, 5 Moo. P. C. C. (N.S.) 72, L. R. 2 P. C. 54.

It is, however, no objection against the merit of an invention for the purposes of an extension that great subsequent improvements have been made in it, which are being worked: *Galloway's Patent*, 1843, 1 W. P. C. 727; *Soame's Patent*, 1843, 1 W. P. C. 734.

(d) Utility of the invention as evidenced by its successful working: *Downton's Patent*, 1839, 1 W. P. C. 565. If the invention has not been practically and successfully worked, this, on petition for its extension, will put its merits as to utility in an unfavourable light unless some explanation be forthcoming as to why it was not made a success: *Allan's Patent*, 1867, 4 Moo. P. C. C. (N.S.) 443; *Pinkus' Patent*, 1848, 12 Jur. 234; *Hughes' Patent*, 1879, L. R. 4 App. Cas. 174; *Norton's Patent*, 1863, 1 Moo. P. C. C. 339; *Simister's Patent*, 1842, 4 Moo. P. C. C. 161, 1 W. P. C. 721. "We expect a very strong case of hardship to be made out, as well as a strong case upon the utility of the invention" (*per* Lord Lyndhurst): *Erard's Patent*, 1835, 1 W. P. C. 559; *Willacy's Patent*, 1888, 5 R. P. C. 694; *Perkins' Patent*, 1845, 2 W. P. C. 6. But even though the invention may not have been largely used, if the non-user is explained by difficulties in the way of making it known or working it, an extension may be granted. Thus, where the very nature of the invention rendered it difficult to introduce, the non-user may be explained: *Woodcroft's Patent*, 1846, 2 W. P. C. 32;

Stoney's Patent, 1888, 5 R. P. C. 522; *Herbert's Patent*, 1867, 4 Moo. P. C. C. (N.S.) 300; *Roper's Patent*, 1887, 4 R. P. C. 201; *Kohlman's Patent*, 1839, 1 W. P. C. 564. A fire believed to be by an incendiary and a combination of workmen, and piracies, were held to excuse non-user in *Roberts' Patent*, 1839, 1 W. P. C. 573. (Bankruptcy and legal proceedings), *Southworth's Patent*, 1837, 1 W. P. C. 487; (pecuniary embarassment of inventor), *Wright's Patent*, 1839, 1 W. P. C. 575; (prejudice against the inventor), *Jones' Patent*, 1840, 1 W. P. C. 578; (prejudice and impecuniosity of patentee), *Stafford's Patent*, 1838, 1 W. P. C. 563; *Payne's Patent*, 1854, Coryton 220; (prejudice and difficulty of teaching workmen), *Erard's Patent*, 1835, 1 W. P. C. 558; (prejudice and litigation), *Heath's Patent*, 1853, 2 W. P. C. 247; (derangement of the labour market), *Napier's Patent*, 1861, 13 Moo. P. C. C. 543; (actions at law), *Pettit Smith's Patent*, 1850, 7 Moo. P. C. C. 133. In *Southby's Patent*, where great merit was admitted by the Crown, an extension was granted though no user was proved; the non-user was accounted for by the fact that unforeseen difficulties of detail had presented themselves, and that the machine was large and expensive: 1891, 8 R. P. C. 433. But the mere fact that the patentee had disputes with assignees: *Patierson's Patent*, 1849, 6 Moo. P. C. C. 469; or that he tried in vain to form a company, without which he could not work it, are not sufficient: *Bakewell's Patent*, 1862, 15 Moo. P. C. C. 385.

Grounds upon which a petition is granted: (*d*) Utility of the invention as evidenced by its successful working.

(e) The position, circumstances and conduct of the petitioners are also matters to be considered. Thus, in *Stewart's Patent*, the committee "were not quite satisfied that the patentee had at all times been so ready to give the public the benefit of his invention as might be

CHAP. XXV. SECT. 13.

Grounds upon which a petition is granted.

desired," and rejected his petition, but on the ground of want of merit: 1885, 3 R.P.C. 10. Where the petitioner had not made large profits, but had slumbered on his rights, and not brought an action of infringement, the extension was refused: *Simister's Patent*, 1841, 1 W. P. C. 721.

(e) The position, circumstances and conduct of the petitioners.

(f) Smallness of profit made by the inventor: see "Accounts," sect. 14 (*post*, p. 340).

(g) Pending legal proceedings is no bar to obtaining an extension: see supra, sect. 13 (*c.*).

(h) The having taken out foreign patents was formerly a reason against extension, but it is doubtful whether it is so now: *Fountain Livet's Patent*, 1892, 9 R. P. C. 327.

14. Accounts shewing the profits made from the invention.—At the hearing, after the formal proofs of advertisements have been put in, the accounts are first looked at to see if they are *primâ facie* in order. For if they are not, or if they shew no case for the petitioner, the petition may be dismissed at once: *Saxby's Patent*, 1870, 7 Moo. P. C. C. 82; *Trotman's Patent*, 1866, L. R. 1 P. C. 118; *Clark's Patent*, 1870, 7 Moo. P. C. C. (N.S.) 255; *Wield's Patent*, 1871, 8 Moo. P. C. C. (N.S.) 300; *Thomas' Patent*, 1892, 9 R. P. C. 367. On the other hand, if they are satisfactory *primâ facie*, the petitioner may prove the merits of his invention before going further into them: *Houghton's Patent*, 1871, 7 Moo. P. C. C. 309 (Saxby and Clark's cases explained).

The accounts presented must be clear and full: *Adair's Patent*, 1881, L. R. 6 App. Cas. 176; *Quarril's Patent*, 1 W. P. C. 740; *Saxby's Patent*, 1870, 7 Moo. P. C. C. 85; *Hill's Patent*, 1863, 1 Moo. P. C. C. (N.S.) 258; *Betts' Patent*, 1862, 1 Moo. P. C. C. (N.S.) 49; *Lake's*

Patent, 1891, 8 R. P. C. 228. They should be kept clear and separate for each part of the invention, if severable, so that if part only is to be extended the accounts for that part may be severable: *Willacy's Patent*, 1888, 5 R. P. C. 690. If the patent has been assigned, the assignee's accounts ought also to be presented: *Deacon's Patent*, 1887, 4 R. P. C. 119. In some cases where books had been destroyed, and their non-production was accounted for, an affidavit of want of profits was allowed: *Hutchinson's Patent*, 1861, 14 Moo. P. C. C. 364; *Heath's Patent*, 1853, 8 Moo. P. C. C. 222; *Lowe's Patent*, 1846, 10 Jur. 363; *Markwick's Patent*, 13 Moo. P. C. C. 310. But in *Yates & Kellett's Patent* the destruction of books was considered fatal. "The destruction of his books, for aught their Lordships know, may have been a perfectly honest and perfectly reasonable operation for him to perform, but he cannot escape from the consequences" (*per* Lord Hobhouse): 1887, L. R. 12 App. Cas. 147, 4 R. P. C. 150; see also *Lawrence's Patent*, 1892, 9 R. P. C. 85. The accounts ought also to shew clearly licensee's and manufacturer's profits, so that the Privy Council may see what has been made out of the patent altogether: *Thomas' Patent*, 1892, 9 R. P. C. 370, and cases there cited. The same view was taken in *Lane-Fox's Patent*, 1892, 9 R. P. C. 411, where, though the patentee had received no remuneration, the omission to shew all the profits made by licensees and others in his accounts was held fatal. See also *Newton's Patent*, 1884, L. R. 9 App. Cas. 592.

In the case of very heavy losses, the exact accounts need not be proved with that accuracy which is required when the losses are not heavy, or when there has been a gain: *Darby's Patent*, 1891, 8 R. P. C. 380.

The accounts must, previously to the hearing, have been

CHAP. XXV. SECT. 14. Accounts.

filed in accordance with the rules: *Johnson & Atkinson's Patent*, 1873, L. R. 5 P. C. 87; *Chatwood's Patent, ibid.*, 88 n. One reason of this is, in order that they may be sent for the inspection of the law officer: *Perkins' Patent*, 1845, 2 W. P. C. 14. But as has been said *supra*, the opponents are not allowed to inspect them until the hearing.

The question of remuneration must be considered as a whole, not for each separate part of the invention: *Perkins' Patent*, 1845, 2 W. P. C. 9.

The fact that the profits have been very recent, and that in the earlier years nothing was got, is no reason for granting an extension if the total is sufficient: *Ryder's Patent*, 1855, John. 213; but see *Perkins' Patent*, 1845, 2 W. P. C. 16; *Downton's Patent*, 1839, 1 W. P. C. 566.

Amendment of the accounts is sometimes, but very rarely, allowed: *Perkins' Patent*, 1845, 2 W. P. C. 17; *Heath's Patent*, 1853, 2 W. P. C. 257, contra, *Yates & Kellett's Patent*, 1887, 4 R. P. C. 150. The following deductions in favour of the applicant have been allowed in the accounts:—

(*a*) Expenses of taking out and defending the patent at law: *Roberts' Patent*, 1839, 1 W. P. C. 573; *Kay's Patent*, 1839, 1 W. P. C. 572; *Galloway's Patent*, 1843, 1 W. P. C. 729; *Betts' Patent*, 1862, 1 Moo. P. C. C. (N.S.) 49. But where a case was compromised, and costs surrendered, this would not be a proper deduction, for benefit was obtained thereby: *Hill's Patent*, 1863, 1 Moo. P. C. C. (N.S.) 258.

(*b*) Patentee's time devoted to perfecting the invention and bringing it into use: *Roberts' Patent*, 1839, 1 W. P. C. 575; *Carr's Patent*, 1873, L. R. 4 P. C. 539; *Newton's Patent*, 1861, 14 Moo. P. C. C. 156; *Furness' Patent*, 1885, 2 R. P. C. 175; *Bailey's Patent*, 1884, 1 R. P. C. 2.

(*c*) Making experiments: *Kay's Patent*, 1839, 1 W. P. C. 572; *Bates' Patent*, 1836, 1 W. P. C. 739 n.

(*d*) Manufacturer's profits; and these should be kept strictly separate from the patentee's profits: *Betts' Patent*, 1862, 1 Moo. P. C. C. (N.S.) 49; *Galloway's Patent*, 1843, 1 W. P. C. 729; *Saxby's Patent*, 1870, 7 Moo. P. C. C. 82. By manufacturer's profits is here meant that part of the total profit which may have arisen, not by reason of the patent monopoly, but as a fair return to the capital employed, and the manufacturer's labour of superintendence. It will of course only be deducible where the patentee is himself the manufacturer, or where manufacturers have been selling under a license and making profits. Two-thirds of total profit would be considered an excessive share to assign to this head: *Hill's Patent*, 1863, 1 Moo. P. C. C. (N.S.) 258; *Duncan & Wilson's Patent*, 1884, 1 R. P. C. 257 (which affords an example of the way in which accounts are criticised). Where the manufacturing profits only arise by reason of the patent and not otherwise, they should all be reckoned as profits made by the patent: *Johnson's Patent*, 1871, 8 Moo. P. C. C. (N.S.) 291; *Muntz' Patent*, 1846, 2 W. P. C. 121.

(*e*) Expenses of bringing the invention into use: *Galloway's Patent*, 1843, 1 W. P. C. 729; such as allowing half profits to an agent for introducing the invention: *Poole's Patent*, 1867, L. R. 1 P. C. 514.

It is quite evident that, in dealing with the profits, it is not only the *patentee's* profits that are to be considered, but the *profits made out of the invention* over and above the ordinary trade profits, that are really in question, no matter in whose hands, or by whom such profits have been made. For a patentee would have no right to sell his patent for a small sum to assignees who made an

CHAP. XXV. SECT. 14. — Accounts.

enormous profit out of it, and then come and say that the invention had been improperly rewarded. The insufficient remuneration of the inventor is one circumstance, but only one, in the various questions that have to be considered.

The following items must be reckoned into the profits: (*a*) Gains from foreign patents: *Adair's Patent*, 1881, L. R. 6 App. Cas. 176; *Johnson's Patent*, 1871, 8 Moo. P. C. C. (N.S.) 291, explaining *Poole's Patent*, 1867, 4 Moo. P. C. C. (N.S.) 456. (*b*) Gains from articles made and exported must also be reckoned in as profits: *Hardy's Patent*, 1849, 6 Moo. P. C. C. 441.

Gains or losses by speculative dealings with the patent, as by buying and re-selling it, are not to be reckoned either as profits or losses: *Wield's Patent*, 1871, 8 Moo. P. C. C. (N.S.) 300; nor the rise in values of shares taken in payment for it: *Child's Patent*, 1883, John. 214. Of course the high dividends will have been counted, but if the dividends paid had been small through (say) the creation of an enormous reserve fund which caused the share values to rise, surely this should be reckoned?

The following are examples of cases in which the remuneration was held insufficient, and the patent was extended: *Deacon's Patent*, 1887, 4 R. P. C. 119, where three years' extension was granted though the patentee had made £6000 and his accounts were not very satisfactory; *Bischof's Patent*, 1884, 1 R. P. C. 162, for purification of water. A loss had been made here, and seven years' extension was granted: *Derosne's Patent*, where over £8000 had been made, but the public benefit had been very great: 1844, 2 W. P. C. 4. In *Fountain Livet's Patent*, where extension was refused, it was said that if the invention had possessed merit, £6000 profit

would not be too much for fourteen years' work: 1892, 9 R. P. C. 327. In *Joy's Patent* an extension for seven years was granted, though the patentee had made over £6000: 1893, 10 R. P. C. 89. In *Thomas' Patent* a profit had been made of £250,000: 1892, 9 R. P. C. 367. This was considered far too large. In *Nussey & Leachman's Patent*, 1889, 7 R. P. C. 22, the patentees had made £4000, including payment for patentees' whole time, and were working another patent which had practically superseded the old one. The merit was not considered very great, and extension refused. *Beanland's Patent*, 1887, 4 R. P. C. 489, where a patent for keeping windows open had brought in about £1000, and there was no exceptional merit, extension refused. *Furness' Patent*, 1885, 2 R. P. C. 175, extension refused where the patentee had made £6000. *Muntz' Patent*, 1846, 2 W. P. C. 113, the invention was considered most valuable, but the patentee had made £55,000, and therefore extension was refused. See also *Betts' Patent*, 1846, 2 W. P. C. 160.

The account should be entered debtor and creditor for each year of the patent, and a summary be put at the end. The following form may give some idea of what is required:

IN THE PRIVY COUNCIL. ———'s PATENT, 18 , No. .

[*Title* .]

PETITIONS FOR PROLONGATION.

Account of expenditure and receipts of Petitioner for the th year, from 18 , to 18 .

EXPENDITURE.	£. s. d.	RECEIPTS.	£. s. d.
Expenses of experiments, *i.e.*:—		Royalties on articles from . .	
Models		Fees (from licensees?)	
Journeys . . .		Cash on account of expenses . . .	
Materials . . .			
Labour . . .			

CHAP. XXV. SECT. 14.

Accounts.

	£. s. d.		£. s. d.
Expenses of taking out patent:—		By sale of articles less discount and commission, if any	
Paid to for making articles		Value of articles on hand, plant, furniture, less depreciation	
Travelling expenses.		Any other receipts .	
Trials			
Law expenses . .			
Experiments . .			
Photographs. . .			
Models			
Law expenses:—			
In connection with action ——*v.*——			
for infringement .			
Salaries.			
Rates and taxes . .			
Exhibition expenses .			
Show cases, rent of show rooms. . .			
Commissions to agents			
Bank commission . .			
Advertising . . .			
Stationery and printing			
Insurance			
Postage			
Bad debts			

N.B.—Many of the above items would be proportioned if other business was being carried on as well as the patent business.

The above is a patentee's account, but where there have been licenses or assignments the account will of course be much more elaborate.

15. The period of extension.—By the Act of 1835, power was given to extend for seven years, but this was increased to fourteen years by the Act of 1844. Under the Act of 1883, c. 25, seven years' extension is permitted,

post, p. 452.

The period of extension.

or in exceptional cases, fourteen years. *Stoney's Patent*, for rollers for sluice gates, to which the patentee devoted his attention for fourteen years, and which at last ended in a success, was considered an exception, and was extended for ten years; 1888, 5 R. P. C. 524.

16. When an extension has been granted, the powers of the committee are exhausted, and no second extension can be given: *Goucher's Patent*, 1865, 2 Moore P. C. C. (N.S.) 532.

17. Conditions of extension.—In extending a patent the committee frequently stipulate for some further remuneration to the patentee, if he have parted with his rights. Thus, in *Whitehouse's Patent*, 1838, 1 W. P. C. 476, extension was granted on condition that the assignees executed an agreement to pay the inventor an increased annuity (this agreement afterwards became the subject of a lawsuit: *Russell* v. *Ledsam*, 1845, 14 M. & W. 574, 1 H. L. Cas. 687); see also *Markwick's Patent*, 1860, 13 Moo. P. C. C. 310; *Pitman's Patent*, 1871, L. R. 4 P. C. 87. But this will not be done where the patentee has sold for value, and the assignee has made a loss: *Bodmer's Patent*, 1849, 6 Moo. P. C. C. 468; *Napier's Patent*, 1861, 13 Moo. P. C. C. 543.

Where contractual relations exist between the petitioner and others, the committee will protect them. Thus, on extension granted to the assigns of a moiety of a patent, it was stipulated that they should hold a moiety in trust for the legal representatives of a deceased inventor who possessed the other moiety: *Herbert's Patent*, 1867, 4 Moo. P. C. C. (N.S.) 300; and see *Normanby's Patent*, 1855, 9 Moo. P. C. C. 441. Two

CHAP. XXV. SECT. 17.

Conditions of extension.

apprentices opposed an extension on the ground that they had served the patentee in the expectation of using the patent on its expiration. Held, that if that had been proved they might have been entitled to a clause in their favour, but it was not proved: *Baxter's Patent*, 1849, 13 Jur. 593.

Conditions as to the price at which the patent article is to be sold are sometimes put for the benefit of the public. This extension was granted to assignees on terms of securing half profits to the patentee, and selling to the public at a fixed price: *Hardy's Patent*, 1849, 6 Moo. P. C. C. 441. Extension granted on terms of licensing the public upon terms not higher than those licenses already granted: *Mallet's Patent*, 1866, 4 Moo. P. C. C. (N.S.) 175.

In *Pettit Smith's Patent*, 1850, 7 Moo. P. C. C. 133, a condition was imposed that the Admiralty Commissioners might use the invention without license; see also *Napier's Patent*, 1881, L. R. 6 App. Cas. 174. But like conditions were refused to the Crown in *Lancaster's Patent*, 1864, 2 Moo. P. C. C. (N.S.) 189, and *Carpenter's Patent*, 1854, 2 Moo. P. C. C. (N.S.) 191 n.

18. Costs.—Under the Patents Act, 1883, s. 25, sub-s. 7, costs are in the control of the committee. This power they always had. Costs are usually given to a successful petitioner where there is no good ground of opposition: *Downton's Patent*, 1839, 1 W. P. C. 567; but where there is good ground of opposition, and the patent is doubtful, they may be refused: *Church's Case*, 1886, 3 R. P. C. 102.

post, p. 452.

Costs are usually given to a successful opponent: *Westrupp & Gibbin's Patent*, 1836, 1 W. P. C. 554;

Wield's Patent, 1871, 8 Moo. P. C. C. (N.S.) 300; unless where the opponents have been guilty of misconduct: *Honiball's Patent*, 1855, 9 Moo. P. C. C. 394; or where the petitioner has very fully and fairly stated all the facts both for and against himself, and the opposition has not been of any assistance to the committee: *Muntz' Patent*, 1846, 2 W. P. C. 122; or where an opponent raises at the hearing a new ground of opposition not mentioned in his objections: *Stewart's Patent*, 1885, 3 R. P. C. 7.

These costs are sometimes assessed by the committee at a gross sum: *Jones' Patent*, 1854, 9 Moo. P. C. C. 41, where £100 was directed to be divided between two successful opposers; and *Hill's Patent*, 1863, 1 Moo. P. C. C. (N.S.) 282, where £1000 was similarly apportioned; see also *Johnson's Patent*, 1871, 8 Moo. P. C. C. (N.S.) 282.

In the case of an abandoned petition the opposer's costs are also given: *Macintosh's Patent*, 1837, 1 W. P. C. 739; *Bridson's Patent*, 1852, 7 Moo. P. C. C. 499; *Morgan Brown's Patent*, 1886, 3 R. P. C. 212 (on motion by opposer for costs after notice of withdrawal of the petition). Sometimes in such case of abandonment a lump sum is given: *Milner's Patent*, 1853, 9 Moo. P. C. C. 503.

19. The extension and new grant.—Formerly, when the committee had decided to extend a patent in part, but not to extend all of it, they used to put the patentee on terms of disclaiming part of his patent before the extension was granted: *Bodmer's Patent*, 1853, 6 Moo. P. C. C. 282. But this mode of attaining the result is not needed now, and it is customary to direct a new patent to be sealed only for such part of the patent as the committee has seen fit to prolong: *Lee's Patent*, 1856, 10 Moo. P. C. C. 226; *Napier's Patent*, 1881, L. R. 6 App.

CHAP. XXV. SECT. 19.

The extension and new grant.

Cas. 174; *Church's Patent*, 1886, 3 R. P. C. 102; *Willacy's Patent*, 1888 (*per* Sir Barnes Peacock), 5 R. P. C. 695.

The extension of the patent has always been virtually considered as a new grant: *Betts' Patent*, 1862, 1 Moo. P. C. C. (N.S.) 49; *Stoney's Patent*, 1888, 5 R. P. C. 524. Under the Patents Act, 1883, the Privy Council may either extend the time, or make a new grant commencing at or after the expiration of the old one. The usual practice is to make a new grant dated the day after the expiration of the old one. It hence follows that patents extended after the Act of 1883 are subject to the conditions of patents granted under that Act, *e.g.* sect. 22 as to licenses, and sect. 27 as to the Crown: *Cooking's Patent*, 1885, 2 R. P. C. 152; *Wasteneys Smiths' Patent*, 1885, 2 R. P. C. 14. No new specification need be filed; *ibid.*

An office copy of the order of the Privy Council must be left at the Patent Office: Patent Rules, 1890, r. 74. It used to include the Channel Islands, but having regard to the provisions of the Patents Act, 1883, s. 16, it is doubtful how far the provisions of such a grant would apply to them. If a gap occurred between the expiration of the patent and the new grant, the patent would not be considered as existing during that period: see "Infringement," Chap. XXIV., sect. 9.

post, p. 497.

ante, p. 314.

20. There is power to revoke an order for extension when it has not been acted on by reason of the grantee's laches and long delay: *In re Schlumberger's Patent*, 1853, 9 Moo. P. C. C. 1.

CHAPTER XXVI.

CONFIRMATION OF PATENTS.

By the Patents Act, 1835, 5 & 6 Wm. IV., c. 83, s. 2, it was provided, that if in any suit or action it should be found that a patent had been anticipated, the patentee might petition the King in Council to confirm the patent.

This Act is now abolished, but since, by Patents Act, 1883, s. 113, the privileges of patents granted prior to that Act are preserved (*Brandon's Patent*, 1884, 1 R. P. C. 154), it would still be possible to apply for confirmation of patents granted prior to the coming into force of the Patents Act, 1883: *Jablochkoff's Patent*, 1891, 8 R. P. C. 281. In such case, however, the applicant cannot have a confirmation on grounds dependent on the privileges conferred by the Act of 1883. If, for the purpose of obtaining a confirmation, he relies on the older law, his patent must be treated as subject to the older law, and not to the new.

post, p. 473.

It is not very likely that a similar application will again occur, as the patents granted prior to the Act of 1883 are rapidly running out. The following cases were decided under the old law, and may serve as examples of the practice then in vogue: *Westrupp & Gibbin's Patent*,

CHAP. XXVI.

1836, 1 W. P. C. 555; *Heurteloup's Patent*, 1836, 1 W. P. C. 553; *Robinson's Patent*, 1845, 5 Moo. P. C. C. 65; *Stead's Patent*, 1846, 2 W. P. C. 146; *Card's Patent*, 1848, 2 W. P. C. 161; *Lamenaude's Patent*, 1850, 2 W. P. C. 164; *Honiball's Patent*, 1855, 2 W. P. C. 201; *Stead* v. *Carey*, 1845, 1 C. B. 496.

CHAPTER XXVII.

INTERIM INJUNCTIONS AND INTERIM ACCOUNTS.

1. General principles.—Prior to the Judicature Acts, the power of granting injunctions was only possessed by the Court of Chancery. The usual practice was to grant an interim injunction, and then send certain issues to be tried before a jury in a court of law. But the necessity for this is now removed by the Judicature Acts, and the modern practice is to apply for an interim injunction as soon as the writ has been issued: J. A. 1873, s. 25, sub-s. 8. The object of the application is to preserve the rights of the parties until the trial, and the "balance of convenience" is generally considered as the foundation of the order: *Harmer* v. *Plane*, 1807, 14 Ves. 130; *Neilson* v. *Thompson*, 1840, 1 W. P. C. 278; *Bridson* v. *McAlpine*, 1845, 8 Beav. 229; approved in *Plimpton* v. *Spiller*, 1876, 4 Ch. D. 290; *Thomson* v. *Hughes*, 1890, 7 R. P. C. 77; *Bracher* v. *Bracher*, 1890, 7 R. P. C. 422.

P. Act, 1883, sect. 30, *post*, p. 455.

2. Long and uninterrupted user is good ground for an application for an interim injunction. In *Jackson* v. *Needle*, where the patent was of very recent date, the Court refused an interim injunction: 1884, 1 R. P. C. 176. In *Lister* v. *Norton*, 1884, Chitty, J., intimated an opinion that more than three years' peaceful enjoyment

CH. XXVII. SECT. 2.

Long and uninterrupted user.

of a patent was needful to support the application: 1 R. P. C. 115. In *Briggs* v. *Lardeur*, 1884, 1 R. P. C. 126, where a patent was ten years old, an interim injunction was granted; see also *Shillito* v. *Larmouth*, 1884, 2 R. P. C. 1. And in *Rothwell* v. *King*, 1886, 3 R. P. C. 380, user for six years, coupled with the fact that the plaintiffs had on four occasions induced infringers to abstain, was sufficient. In the *British Tanning Co.* v. *Groth*, 1889, 7 R. P. C. 1, two years' user was held too little.

In earlier cases also some period of user was required to warrant the Court in granting an injunction: *e.g.*, *Harmer* v. *Plane*, 1807, 14 Ves. 130; *Hill* v. *Thompson*, 1817, 3 Mer. 622; *Beeston* v. *Ford*, 1839, 2 Coop. Ch. Cas. 58; *Bickford* v. *Skewes*, 1838, 1 W. P. C. 213; *Collard* v. *Allison*, 1839, 4 My. & C. 487; *Curtis* v. *Cutts*, 1839, 2 Coop. C. C. 60 n.; *Muntz* v. *Foster*, 1843, 2 W. P. C. 95; *Electric Telegraph Co.* v. *Nott*, 11 Jur. 273; *Stevens* v. *Keating*, 1847, 2 W. P. C. 177; *Caldwell* v. *Van Vlissingen*, 1851, 9 Hare 424; *Hancock* v. *Moulton*, 1852, Monthly Digest, 506; *Lister* v. *Eastwood*, 1855, 26 L. T. 4; *Betts* v. *Menzies*, 1857, 3 Jur. (N.S.) 358; *Davenport* v. *Richards*, 1860, 3 L. T. (N.S.) 503; *Bernard* v. *Levinstein*, 1864, 10 L. T. (N.S.) 177 (in which Knight, V.-C., thought that three years might be sufficient); *Davenport* v. *Goldberg*, 1865, 2 H. & M. 282; *Dudgeon* v. *Thomson*, 1874, 30 L. T. (N.S.) 244.

The user must have been an actual active user by the plaintiff, even where the patent is eight years old, for it is not simply the age of the patent, but the long public user of it, on which the interim injunction is founded: *Plimpton* v. *Malcolmson*, 1875, L. R. 20 Eq. 37, 44 L. J. Ch. 257.

The period of user ought to be computed from and

after the time when the patentee ceases to pay royalty under a prior patent: *Heugh* v. *Magill*, 1877, W. N. p. 62.

Long and uninterrupted user.

3. Prior judicial establishment of the patent, though not absolutely conclusive, greatly strengthens the application: *Farbenfabrik Co.* v. *Dawson*, 1891, 8 R. P. C. 397; *Hayward* v. *Pavement Light Co.*, 1884, 1 R. P. C. 206; *Dudgeon* v. *Thomson*, 1877, 30 L. T. (N.S.) 244; *Newall* v. *Wilson*, 1852, 2 De G. M. & G. 282; *Lister* v. *Eastwood*, 1855, 26 L. T. 4 (where an award of an arbitrator had previously affirmed the validity); *Bovill* v. *Goodier*, 1866, 35 L. J. Ch. 174; *Davenport* v. *Jepson*, 1862, 1 N. R. 173.

4. The inability of the defendant, if defeated in the action, to compensate the plaintiff, or to pay costs, is also considered: *Newall* v. *Wilson*, 1852, 2 De G. M. & G. 282; *Plimpton* v. *Spiller*, 1876, 4 Ch. D. 291; *Kensington Co.* v. *Lane-Fox Co.*, 1891, 8 R. P. C. 277.

5. Delay greatly prejudices an application for an interim injunction: *Thomson* v. *Batty*, 1888, 4 T. R. 36; and even a delay of three weeks after knowledge of defendant's infringement was fatal in *Greer* v. *Bristol Tanning Co.*, 1885, 2 R. P. C. 268; see also *Bovill* v. *Crate*, 1866, L. R. 1 Eq. 388; *Baxter* v. *Coombe*, 1850, 1 Ir. Ch. R. 284; *Bridson* v. *Benecke*, 1849, 12 Beav. 3; *Bacon* v. *Jones*, 1839, 4 My. & Cr. 439; *Smith* v. *London & S. W. Rail. Co.*, 1854, 23 L. J. Ch. 564; *Lister* v. *Norton*, 1884, 1 R. P. C. 116.

But the delay may be accounted for and explained. Thus, where the plaintiffs had been advised not to take action on mere threats of infringement, but to

CH. XXVII. SECT. 5.

Delay greatly prejudices an application for an interim injunction.

wait for actual infringement, their delay did not prevent an interim injunction being obtained: *United Telephone Co.* v. *Equitable Telephone Co.*, 1888, 5 R. P. C. 233. And where the plaintiff had reasonably spent some two months in making enquiries, the application was held not to be too late: *Losh* v. *Hague*, 1837, 1 W. P. C. 201; see also *Osmond* v. *Hirst*, 1885, 2 R. P. C. 265. Acquiescence by the plaintiff in the infringement will generally be fatal to the application: *Neilson* v. *Thompson*, 1841, 1 W. P. C. 280.

Interim injunctions may be granted "quia timet": *Frearson* v. *Loe*, 1878, 9 Ch. D. 65; *Adair* v. *Young*, 1879, 12 Ch. D. 13, 20; *United Telephone* v. *London & Globe Telephone*, 1884, 1 R. P. C. 117; *Proctor* v. *Bailey*, 1888, 6 R. P. C. 106, 538.

6. In rare cases interim injunctions are granted ex parte: *Gardner* v. *Broadbent*, 1856, 2 Jur. (N.S.) 1041; but only when there is a danger of some property being lost or destroyed, and such cases will be very rare in patent practice: R. S. C., O. L., r. 6.

7. The infringement must be plain and clear to give rise to an application for an interim injunction: *Electric Telegraph Co.* v. *Nott*, 1847, 2 Coop. 41.

8. Affidavits in support of the application should clearly state the nature of the patent, that it is valid, that the plaintiff was the first and true inventor, and that there has been infringement, and the nature of the infringement should be set forth: *Hill* v. *Thompson*, 1817, 1 W. P. C. 230; *Whitton* v. *Jennings*, 1860, 1 Dr. & S. 110; *Mayer* v. *Spence*, 1860, 1 J. & H. 87. The affidavits

should always be made in the utmost good faith: *Dagleish* v. *Jarvis*, 1850, 2 Mac. & G. 231 (a copyright case).

9. In granting interim injunctions the Court endeavours to avoid any expression of opinion as to the validity of the patent: *Plimpton* v. *Malcolmson*, 1875, 20 Eq. 37; *Briggs* v. *Lardeur*, 1884, 1 R. P. C. 128; *Shillito* v. *Larnouth*, 1885, 2 R. P. C. 3; *Plimpton* v. *Spiller*, 1876, 4 Ch. D. 289.

10. An interim injunction is most frequently refused on the defendant undertaking to keep an account till the hearing: *Lister* v. *Norton*, 1884, 1 R. P. C. 114; *Jackson* v. *Needle*, 1884, 1 R. P. C. 174; *Copeland* v. *Webb*, 1862, 11 W. R. 134; *Gardner* v. *Broadbent*, 1856, 2 Jur. (N.S.) 1041.

11. Sometimes the interlocutory application is ordered to stand over till the hearing without any undertaking to keep an account: *British Tanning Co.* v. *Groth*, 1889, 7 R. P. C. 1. This is done in order to postpone the consideration of the costs on the interlocutory application, and is preferable where there is some case against the motion, as delay, or acquiescence: *Lister* v. *Norton*, 1884, 1 R. P. C. 114.

12. Terms upon which interlocutory injunctions are granted.—Upon the grant of an interim injunction, the Court always requires that the plaintiff should give an undertaking to be responsible in damages, supposing it should turn out that it ought not to have been granted: *Fenner* v. *Wilson*, 1893, 10 R. P. C. 287. In addition to

CH. XXVII. SECT. 12.

Terms upon which interlocutory injunctions are granted.

this, other terms are also sometimes imposed. Thus, where it was alleged by the plaintiffs that the defendants were infringing, but by the defendants that the plaintiffs had contracted to supply them with instruments, an interim injunction was granted upon the usual terms as to damages, but also, lest the injunction should ruin the defendants' business, the plaintiffs were compelled to undertake till the hearing to supply the defendants with telephones on the usual terms of payment: *United Telephone Co.* v. *Tasker*, 1888, 5 R. P. C. 633; see also *Bovill* v. *Smith*, 1866, L. R. 2 Eq. 459. An undertaking is also sometimes required as to prompt procedure: *Muntz* v. *Grenfell*, 1842, 2 W. P. C. 91.

13. By consent, the hearing of the interim injunction is sometimes treated as the final hearing to save expense where the point is chiefly one of law: *e.g.*, *United Telephone Co.* v. *Townshend*, 1885, 3 R. P. C. 10.

14. An interim injunction, when granted, may be dissolved upon application if the plaintiff makes undue delay in prosecuting his action: *Stevens* v. *Keating*, 1847, 2 W. P. C. 175. Interim injunctions are also granted in case of threats: *Kensington Co.* v. *Lane-Fox Co.*, 1891, 8 R. P. C. 277; see Chap. XXIX., sect 5.

post, p. 402.

15. Breach of the interim injunction, and committal for contempt: *United Telephone Co.* v. *Dale*, 1884, 25 Ch. D. 778. If the injunction be against a company, the proper remedy is by a sequestration order against the company, and committal against the directors: *Spencer* v. *Ancouts Vale Co.*, 1888, 6 R. P. C. 68.

CHAPTER XXVIII.

ACTION FOR INFRINGEMENT.

(*The nature of infringements is dealt with in Chapter XXIV.*) *ante*, p. 189.

1. Courts in which actions can be brought.—Actions on patents must be brought in the superior Courts wherever the "title to the franchise" comes in question. For titles to franchises cannot be tried in the County Court: see County Court Act, 1888, s. 56; and besides, the County Courts have not the machinery for trying a patent action properly: *Reg.* v. *County Court of Halifax*, 1891, 8 R. P. C. 338.

In *Procter* v. *Sutton Lodge Co.* 1887, 5 R. P. C. 184, Day, J., seems to have thought that the Chancery Court of the Duchy of Lancaster was not a superior Court within the meaning of the Patents Act, 1883. But it has been decided that it is; *Reg.* v. *County Court of Halifax*, 1891, 8 R. P. C. at p. 344; *per* Brett, M.R., and by a recent Act, 53 & 54 Vict. c. 23 (1890), it has now the full powers of a Court of Chancery.

2. Parties: Plaintiffs.—As a general rule it is desirable, and, where an account is claimed, necessary, that all the persons interested in a patent should be joined in a suit for its infringement—as plaintiffs, if they will; if not, then as defendants. For the Court will then be able to assess the damages and divide them, and the account can be taken once for all. A case which illus-

CH. XXVIII. SECT. 2.

Parties: Plaintiffs.

trates this is *Bergman* v. *Macmillan and Willeringham*, 1881, 17 Ch. D. 423. M. appointed W. his sole licensee, and assigned to R. half of the profits of his patent, who assigned same to B. M. also assigned other portions to other persons. B. sued M. and W. for an account; M. did not appear. It was argued that W., though liable to account to M., was not liable to account both to M. and to B. (*per* Fry, L.J.: He may not be liable to account, but can he not give the assignee the same account which he has given the principal?). Held, that B. had a right to an account against M., and might have proceeded against him alone, but that if he joined W. he ought also to have joined in the action all the other owners, so that W. would only have to account once, and for this, and other reasons, his bill was dismissed with costs. See also *Westhead* v. *Keene*, 1838, 1 Beav. 289, 8 L. J. Ch. 89.

If, however, the defendant does not object, one part-owner of a patent can sue alone: *Davenport* v. *Richards*, 1860, 3 L. T. R. (N.S.) 503; and where the plaintiff is owner of a complete and severable part of the patent, he ought to sue alone: *Dunnicliffe* v. *Mallet*, 1859, 7 C. B. (N.S.) 209, 29 L. J. C. P. 70. If the defendant desires joinder of other owners, so as to free him from liability to multiplicity of actions, he ought to come promptly to have them joined: *Sheehan* v. *G. E. Rail. Co.*, 1880, 16 Ch. D. 59.

Assignees have the same right to sue as the original patentee: *Boulton* v. *Bull*, 1795, 2 H. Bl. 464; *Electric Telegraph Co.* v. *Brett*, 1851, 10 C. B. 838; and the assignees of a bankrupt are in the same position: *Bloxham* v. *Elsee*, 1827, 6 B. & C. 169. An assignee of a half share in a patent sued thereon in *Anderson* v. *Patent Oxonite Co.*, 1886, 3 R. P. C. 279.

In order to sue third parties it seems the better opinion that the plaintiff ought to have a regular assignment to him by deed: *Stewart* v. *Casey*, 1891, 8 R. P. C. 259. But where the action is between assignor and assignee, an agreement to assign would no doubt be treated in equity as an assignment. There is no enactment rendering registration necessary to enable an assignee to sue, but it is better to register before commencing the action. It was formerly necessary: see *Hassall* v. *Wright*, 1870, L. R. 10 Eq. 509; and *Chollet* v. *Hoffmann*, 1857, 7 Ell. & Bl. 686.

A mortgagor in possession of a patent should sue alone without joining the mortgagee, unless there is reason to fear that the defendant might be prejudiced by his non-joinder: *Van Gelder* v. *Sowerby Bridge Flour Co.*, 1890, 7 R. P. C. 208. In this case the important rule was laid down that where it is desirable that parties should be joined, the judge *ought* to join them, and not allow the action to be defeated by reason of non-joinder: *per* Bowen, L.J., 215.

But a licensee is not in such a position that he can sue, even though his license be exclusive: *Heap* v. *Hartley*, 1889, 6 R. P. C. 501; *Derosne* v. *Fairie*, 1835, 1 W. P. C. 155. But Lord Eldon thought that damages might be given him for losses he might have suffered by the infringement: *Beaumont* v. *George*, 1815, 1 C. P. C. 294.

The general agent of a foreigner owning English patents is not in a position to sue for infringement of them: *Adams* v. *N. B. Rail. Co.*, 1873, 29 L. T. R. 367.

There is a case given in the *Times*, March 13, 1884, which decides that a *cestui que trust* of a patent may sue,

CH. XXVIII. SECT. 2.

Parties: Plaintiffs.

even if the patent be registered in the name of his trustee, and trustees could sue in their own name, though, if needful, the *cestui que trust* might be joined. This branch of the subject belongs to the general principles as to joinder of parties, as to which see R. S. C., O. XXI.

3. Parties: Defendants.—The person who really uses the infringing machine is the true defendant, provided he be not a mere workman or servant. Thus, the contractor who infringed a patent for house-building should be the defendant, not the architect: *Denley* v. *Blore*, 1851, 38 Lond. Jour. 224; *Washburn* v. *Cunard*, 1889, 6 R. P. C. 398. It has been pointed out elsewhere that a foreign government cannot be made liable for an action of infringement. Directors of a company whose workmen infringe may be liable personally: *Betts* v. *De Vitre*, 1868, L. R. 3 Ch. 441, 37 L. J. Ch. 325. But assignees who have become so after action cannot of course be joined at defendant's request against the plaintiff's consent: *Briggs* v. *Lardeur*, 1884, 2 R. P. C. 13.

Third parties, who have agreed to indemnify the defendants even after action brought, may be allowed to appear, but if they have not been regularly made defendants, an injunction cannot be granted against them. If they appear, costs may be given against them: *Edison* v. *Holland*, 1886, 3 R. P. C. 395, 6 R. P. C. 243.

A plaintiff sued an infringer for using his patented machine. The maker of the infringing machine, who claimed to be making it under a subsequent patent, applied to be joined as a defendant against the will of the plaintiff, and suggested that the defendant would not fight the action properly. Held, that he could not be so joined: *Moser* v. *Marsden*, 1892, 9 R. P. C. 214.

4. When the action of infringement can be brought.—No action of infringement can be brought until the patent is actually sealed: Patents Act, 1883, s. 15; and then not in respect of infringements committed prior to the publication of the complete specification: sects. 10, 13. Hence the effect of provisional protection is not to enable the patentee to proceed for infringements during its currency, but only to protect him against publication during the nine months which intervene between the sending in of his provisional specification and the sending in of his complete specification.

5. Writ in a patent action.—The service of the writ is the same as in any other action: see S. C. Rules, O. IX. As to service on a London agent of a writ against a Scotch firm, see *Baillie* v. *Goodwin*, 1886, 3 R. P. C. 285.

Leave to serve the writ in Scotland out of the jurisdiction has been given where the defendant has infringed by sending articles into England. For although the defendant had no place of business in England, yet since an injunction was sought the case came within O. XI., r. 1: *Speckhart* v. *Campbell*, W. N. 1884, p. 24; see also *Washburn Co.* v. *Cunard Co.*, 1889, 6 R. P. C. 398. As to these points, see the new rules of the S. C. J. which have just come into force (1893–4).

6. Consolidation of actions.—The consolidation of actions was originally in its essence a temporary stay of all actions but one, made at the request of the defendant or defendants to avoid vexatious multiplicity. The procedure is now under O. XLIX., r. 8, of the S. C. Rules, 1883. Where a plaintiff brought 134 actions against different defendants, they moved in groups to consolidate

CH. XXVIII. SECT. 6. Consolidation of actions.

them. Kindersley, V.-C., refused the application, on the ground that each defendant ought to answer on affidavit and interrogatories, and that they had come too soon. But on appeal Lord Westbury ordered either consolidation or else that an issue should be tried as to the validity of the patent between the plaintiffs and certain selected defendants, reserving to each individual defendant his right to a separate issue as to infringement by him, all the defendants to file affidavits as to their user of the machines, and whence they obtained them: *Foxwell* v. *Webster*, 1863, 4 De G. J. & S. 77.

In case of consolidation the stay is only temporary, so that unless the plaintiff consents to be bound by the issue of the first test action, he can pursue his actions against the other defendants after the first action has been disposed of.

7. Statement of claim.—The claim usually asks for an injunction, damages, an account, and for the delivery up or destruction of the infringing articles, or for one or more of these. The plaintiffs discontinued an action against the defendants, and paid costs in consequence of evidence given by them. Having ascertained the falsity of this evidence, the plaintiffs brought a fresh action, claiming relief and also the costs which they had paid in the first action. This was struck out as embarrassing under O. XVIII., r. 1, and O. XIX., r. 27: *United Telephone Co.* v. *Tasker*, 1889, 6 R. P. C. 38.

8. Particulars of breaches.—In an action for infringement, the plaintiff must deliver with his claim (or by order at any subsequent time) particulars of breaches, and his evidence at the trial will be confined to them: Patents Act, 1883, s. 29, sub-ss. 1, 4. The necessity for these particulars arose from the fact that with a compli-

post, p. 455.

cated patent, it was impossible for a defendant to know what part of the patent the plaintiff alleged to have been infringed, and therefore the ordering of particulars was usual under the general powers of the Court long before it became statutory: *Perry* v. *Mitchell*, 1840, 1 W. P. C. 269; *Electric Telegraph Co.* v. *Nott*, 1847, 16 L. J. C. P. 174, 4 C. B. 471, and in Chancery; *Curtis* v. *Platt*, 1861, 35 L. J. Ch. 853; and these particulars could be amended if needful: *Bovill* v. *Goodier*, 1867, 36 L. J. Ch. 360. For most purposes particulars of breaches may be regarded as forming part of the statement of claim: *United Telephone Co.* v. *Smith and Mitchell*, 1889, 38 W. R. 70.

The following are the principles which appear to have guided the Courts in ordering particulars of breaches:—

(*a*) **The plaintiff must specifically point out what part of his invention has been infringed:** *Haslam* v. *Hall*, 1887, 4 R. P. C. 203; *Germ Milling Co.* v. *Robinson*, 1884, 1 R. P. C. 219; *Needham* v. *Oxley*, 1863, 1 H. & M. 248. And, if need be, he must refer to the pages and lines of his specification: *Wren* v. *Weild*, 1869, L. R. 4 Q. B. 213, 38 L. J. Q. B. 88; *Lamb* v. *Nottingham Manufacturing Co.*, 1874: Seton's Decrees, ed. 4, p. 349.

In the case of a simple patent it is enough if the plaintiff specifies which of the claims he says are infringed, without giving special references to lines and words in the specification: *Cheetham* v. *Oldham*, 1888, 5 R. P. C. 624; *Batley* v. *Kynoch*, 1874, L. R. 19 Eq. 232; *Church Engineering Co.* v. *Wilson*, 1886, 3 R. P. C. 123; *Moseley* v. *Victoria Rubber Co.*, 1886, 3 R. P. C. 357; *Ehrlich* v. *Ihlee*, 1887, 5 R. P. C. 41. Where the plaintiffs specify the claims which they say have been infringed, they are not bound to say what it is they mean by their claims, so as to specify whether they claim a particular

CH. XXVIII. SECT. 8.

(a) The plaintiff must specifically point out what part of his invention has been infringed.

described lamp having certain features, or all lamps which have these features. In short, while they are compelled to say what claims have been infringed, they are not, for the defendant's convenience, bound to put an interpretation upon those claims and explain them: *Wenham Co.* v. *Champion Co.*, 1891, 8 R. P. C. 22; see also *Cassella* v. *Levinstein*, 1891, 8 R. P. C. 473.

(*b*) **The plaintiff must specify what portions or characteristics of the articles complained of infringe his patent:** *Jones* v. *Lees*, 1856, 25 L. J. Ex. 241; *Wren* v. *Weild*, 1869, L. R. 4 Q. B. 213, 38 L. J. Q. B. 88. Where, however, the article complained of is simple, and the nature of the alleged infringement is obvious, this need not be done. Thus, where some cartridges had been made an exhibit, it was held enough to say that they were an infringement: *Batley* v. *Kynoch*, 1874, L. R, 19 Eq. 229; *Haslam* v. *Hall*, 1887, 4 R. P. C. 203.

(*c*) **The plaintiff must give such instances of infringement as he knows of,** and this may be done by reference to some actual article or exhibit in the action: *Batley* v. *Kynoch*, 1874, L. R. 19 Eq. 229; *Tilghman's Patent Sand Blast Co.* v. *Wright*, 1884, L. R. 1 R. P. C. 103: *Maudleberg* v. *Morley*, 1893, 10 R. P. C. 256.

But when the plaintiff has indicated a type of infringing article, he may allege in general terms that the defendant has made or sold it without specifying each instance of sale, which will be better in the defendant's knowledge than the plaintiff's: *Talbot* v. *La Roche*, 1854, 15 C. B. 310; *Russell* v. *Hatfield*, 1885, 2 R. P. C. 144; *Tilghman's Patent Sand Blast Co.* v. *Wright*, 1884, 1 R. P. C. 103.

(*d*) **But the plaintiff is not allowed to group together generally** infringements which may differ in type, for this might lead to the defendant coming

prepared to meet one alleged infringement but being required to defend another: *Patent Typefounding Co.* v. *Richards*, 1859, 2 L. T. (N.S.) 359. In this view the words, "In particular, by way of illustration," are embarrassing, and ought not to be allowed: *Church Engineering Co.* v. *Wilson*, 1886, 3 R. P. C. 123. Examples of particulars of breaches will be found in the Forms in the Appendix.

(*d*) But the plaintiff is not allowed to group together generally.

9. Amendment of particulars of breaches.—Amendments may be made with the leave of the Court or a judge at the instance of the party who has delivered them, or of his opponent: Patents Act, 1883, s. 29, sub-s. 5. The rules as to the amendment of particulars of breaches are very similar to those for the amendment of particulars of objections: sect. 14.

post, p. 455.

post, p. 375.

10. The defence.—The defence to an action of infringement is usually a formal document raising the questions of infringement, novelty, that plaintiff is not the first and true inventor, utility, and that plaintiff is not the assignee, &c. See Form of Defence in the Appendix.

post, p. 576.

11. Particulars of objections—old practice.—Prior to the year 1834 the defendant, by pleading "not guilty," could raise every defence to a patent, but the rules in that year required special pleas to raise objections to the validity of the patent. The Act of 1835 (5 & 6 Wm. 4, c. 83, s. 5) required particulars, but the particulars ordered were often of a very unsatisfactory kind: see *Bulnois* v. *Mackenzie*, 1837, 1 W. P. C. 260; *Fisher* v. *Dewick*, 1838, 1 W. P. C. 267; *Losh* v. *Hague*, 1838, 1 W. P. C. 203 n.; *Galloway* v. *Bleaden*, 1839, 1 W. P. C. 268 n.; *Gillett* v. *Wilby*, 1839, 1 W. P. C. 270; *Carpenter* v. *Walker*,

CH. XXVIII. SECT. 11.

Particulars of objections—old practice.

1 W. P. C. 268 n.; *Neilson* v. *Harford*, 1841, 8 M. & W. 806, 1 W. P. C. 331; *Walton* v. *Bateman*, 1842, 1 W. P. C. 616; *R.* v. *Walton*, 1842, 2 Q. B. 969; *Macnamara* v. *Hulse*, 1842, 2 W. P. C. 128 n.; *Heath* v. *Unwin*, 1842, 10 M. & W. 687; *Russell* v. *Ledsam*, 1843, 11 M. & W. 647; *Bentley* v. *Keighley*, 1844, 7 M. & G. 652; *Jones* v. *Berger*, 1843, 1 W. P. C. 544; *Leaf* v. *Topham*, 1845, 14 M. & W. 146; *R.* v. *Mill*, 1850, 10 C. B. 379; *Betts* v. *Walker*, 1850, 14 Q. B. 363.

The Patents Act, 1852, s. 41, made the requirements as to particulars of objections stricter, and under this Act the following cases were decided:—

Holland v. *Fox*, 1853, 1 C. L. R. 440, 1 W. R. 448; *Palmer* v. *Cooper*, 1853, 9 Ex. 231; *Palmer* v. *Wagstaffe*, 1853, 8 Ex. 840, 22 L. J. Ex. 295; *Hull* v. *Bollard*, 1856, 1 H. & N. 134; *Chollet* v. *Hoffman*, 1857, 7 E. & B. 686; *Curtis* v. *Platt*, 1863, 8 L. T. (N.S.) 657; *Renard* v. *Levinstein*, 1864, 11 L. T. (N.S.) 505, 13 W. R. 229; *Daw* v. *Elcy*, 1865, L. R. 1 Eq. 38; *Bovill* v. *Goodier* 1865, L. R. 1 Eq. 35; *Morgan* v. *Fuller*, 1866, L. R. 2 Eq. 297; *Bovill* v. *Smith*, 1866, L. R. 2 Eq. 459; *Penn* v. *Bibby*, L. R. 1 Eq. 548; *Bovill* v. *Goodier*, 1867, 36 L. J. Ch. 360; *Grover* v. *Wilson*, 1870, W. N. 1870, p. 78; *Finnegan* v. *James*, 1874, L. R. 19 Eq. 72; *Wilson* v. *Gann*, 1875, 23 W. R. 546; *Flower* v. *Lloyd*, 1876, 45 L. J. Ch. 746, in which Field, J., said: "I cannot follow the cases which have been cited; we have advanced in our ideas since they were decided" (viz., since 1853): see *Solicitors' Journal*, 1876, p. 860; *Baird* v. *Moule*, 1876, 17 Ch. D. 139 n.; *Sugg* v. *Silber*, 1877, 2 Q. B. D. 493; *Edison Telephone Co.* v. *India Rubber Co.*, 1881, 17 Ch. D. 137; *Birch* v. *Mather*, 1883, 22 Ch. D. 629; *Cropper* v. *Smith*, 1885, 10 App. Cas. 249, 2 R. P. C. 17.

12. Practice as to particulars of objections under the Patents Act, 1883, s. 29.—This Act provides for particulars being given of any objections in support of the statement of defence: sub-ss. 2, 3; and that except by leave at the hearing no evidence shall be given of any alleged objection of which particulars are not so delivered: sub-s. 4, see *Britain* v. *Hirsch*, 1888, 5 R. P. C. 230. In *Hill* v. *Adams*, 1893, 10 R. P. C. 105, leave to raise a new objection at the hearing was given, but the case was postponed. In *Peckover* v. *Rowland & Co.*, 1893, 10 R. P. C. 118, leave to amend was refused. It also provides for amendment of particulars: sub-s. 5; and necessitates a certificate by the judge that they were reasonable and proper, in order that the costs of them may be allowed: sub-s. 6.

post, p. 339.

If the defendant objects to part only of the invention as old or as defective, he should, in his particulars, specify the part to which he objects.

The particulars sometimes take a hypothetical form, as, for example, in *Hocking* v. *Hocking*, 1886, 3 R. P. C. 291. "If such a construction is put upon the claims . . . as would include within them the condensers, etc., . . . used by the defendant, such construction would cause the said claims to be bad for want of novelty," and then followed the alleged anticipations. On a summons to strike this out as embarrassing, the Court of Appeal refused to do so, saying that the worst that could be said of such a form was that it was not necessary.

Where a defendant objects on the ground of prior *general* user, he must give instances if he knows of them, so as to put the plaintiff on enquiry.

The following are the kinds of particulars most usually employed:—

see also the forms in the Appendix, pp. 576 *et seq.*

Practice as to particulars of objections under the Patents Act, 1883, s. 29.

(a) **Denial of plaintiff's title.**—"*That the plaintiff is not the patentee, or that the patent has lapsed through non-payment of fees.*"

(b) **Denial of infringement.**—"*That the defendant has not infringed the letters patent in the statement of claim mentioned, nor any of them.*" Under this plea of course no objections to the validity of the patent can be raised: *Russell* v. *Crichton*, 1837, 1 W. P. C. 677, n.; *Household Co.* v. *Neilson*, 1843, *ibid.*

(c) **Plaintiff not the true inventor.**—"*That the plaintiff was not the true and first inventor of the alleged invention in respect of which the letters patent in the statement of claim mentioned were alleged to have been granted.*" This form has been used very loosely, but the true meaning is not that the invention has been anticipated, but that the patentee got the invention from some one else. It should therefore only be used for the purpose of that defence (*per* Kekewich, J.): *Thomson* v. *Macdonald & Co.*, 1890, 8 R. P. C. 8; *Household Co.* v. *Neilson*, 1843, 1 W. P. C. 689. It is submitted that, if it is so used, the name of the person from whom the invention is alleged to have been obtained ought to be given; see *e.g.*, *Siddell* v. *Vickers*, 1887, 5 R. P. C. 85. It was declared unnecessary in *Russell* v. *Ledsam*, 1843, 11 M. & W. 647, 12 L. J. Ex. 439, but that was under the old law.

(d) **Invention not proper subject-matter for patent.**—"*That the said alleged invention is not the proper subject-matter of letters patent.*" This would be on the ground either that the patent is for a principle, or else that it is for some mathematical object, as for a mathematical theory, or again that it is contrary to public policy. In each of these cases the reason should be stated in the objection.

Practice as to particulars of objections under the Patents Act, 1883, s. 29.

(e) The Patent a derogation from a former grant.—"*That the said alleged letters patent are void by reason that the invention in respect of which they purport to be granted formed the subject of a grant to* (name, date, and number), *which said grant was prior to the alleged grant to the plaintiff.*" This defence could only be useful in a case where the plaintiff's patent had been applied for previously to the publication of the specifications of the prior patent, and thus where the specifications of the prior patent could not be used as an anticipation. It is no doubt a good defence, but it has this peculiarity, that the plaintiff would probably reply that the prior patent, from which his is alleged to be a derogation, is bad. Of course he would not dare to set up its invalidity on the ground of want of novelty, for that would be to destroy at the same time the very patent upon which he had founded his action. But he might attack it on the ground of disconformity or fraud, or almost on any other ground. In this case the question of the validity of the prior patent would then be fought out in the absence of the patentee. This would not be very satisfactory. No case has as yet settled the mode of procedure, but the point very nearly arose in *Hill* v. *Adams*, 1893, 10 R. P. C. 102. The mode of pleading adopted there was the allegation that the acts constituting the alleged infringement were done by virtue of the prior patent, for in this case the prior patent belonged to the defendant.

ante, pp. 8, 37.

(f) Want of utility.—"*That the said alleged invention (or some specific part thereof) was not useful, or not of public utility.*" No details are required to be given here specifying the particular points wherein the invention is not useful, and with regard to this particular of

CH. XXVIII. SECT. 12.

Practice as to particulars of objections under the Patents Act, 1883, s. 29.

objection there do not appear to be any decided cases. It is as a rule not very easy to procure the invalidation of a patent for want of utility.

(g) **Want of novelty.** (See Patents Act, 1883, s. 29, ss. (31).)

(1.) **Through public common knowledge.**—"*That the said alleged invention was not new or the proper subject of letters patent, having regard to the common and public knowledge at the date of the aforesaid patent.*" No detailed allegations of prior publications are here needful, nor are they proper, and if inserted would be held embarrassing. For the gist of this objection is not any particular anticipation, the true meaning of the objection is public *general* knowledge: *Holliday* v. *Heppenstall*, 1889, 6 R. P. C. 320; *Philips* v. *Irel Cycle Co.*, 1890, 7 R. P. C. 82; *Automatic Weighing Machine Co.* v. *Knight*, 1889, 6 R. P. C. 302; *Boyd* v. *Horrocks*, 1886, 3 R. P. C. 281 (objection to second particular); *Siemens* v. *Karo*, 1891, 8 R. P. C. 377. At the trial, under this objection, though evidence of general knowledge could be given, and perhaps common and well-known scientific books referred to, yet no prior specifications, or particular or rare books, could be adduced in evidence as these ought to have formed the subject of separate particulars. *Solvo Laundry Co.* v. *Mackie*, 1893, 10 R. P. C. 68 (leave given to amend particulars). In *Siemens* v. *Karo*, above quoted, the defendant objected "*By the general use of . . . for several years prior to the patent.*" This was objected to, and struck out by consent as being embarrassing, for it was really a plea of *user*, not of general knowledge, in which case particulars of that user ought to be given.

Practice as to particulars of objections under the Patents Act, 1883, s. 29.

(2.) **Through prior publication.**—"*That the said invention was not new at the date of the said letters patent, but was published within the realm before the date thereof, in and by the publications, and by the persons at the times and places, and in the manner following . . .*"

(*a*) **By a prior specification.**—*By the specifications of letters patent, No. , of* 18 , *granted to , page , line .*

In many cases it has been held that the pages and lines must be set out. For prior publication in a printed book is an objection, not merely evidence of an objection, and hence must be specified: *Jones* v. *Berger*, 1843, 1 W. P. C. 550; *Fowler* v. *Gaul*, 1886, 3 R. P. C. 247; *Boyd* v. *Horrocks*, 1886, 3 R. P. C. 285; *Boyd* v. *Farrar*, 1887, 5 R. P. C. 36; *Harris* v. *Rothwell*, 1886, 3 R. P. C. 246. But later cases have dispensed with this necessity where the parts of the specification alleged as an anticipation are made clear and distinguishable: *Holliday* v. *Heppenstall*, 1889, 6 R. P. C. 320. Each case must stand on its own ground: *Siemens* v. *Karo*, 1891, 8 R. P. C. 378. Thus, a reference to a specified drawing or figure, and "*that part of the letter-press which refers to it*," has been held sufficient (*ibid.*, p. 379). The defendant, where he honestly cannot distinguish a part of the anticipating specification, is allowed to rely on "the whole": *Sidebottom* v. *Fielden*, 1891, 8 R. P. C. 266; *Nettlefolds* v. *Reynolds*, 1891, 8 R. P. C. 410. In all cases of particulars, if the defendant objects to part only of the invention as old or as defective, he should specify the part to which he objects: *London & Leicestershire Hosiery Co.* v. *Higham*, 1883, Lawson, 498, approved in *Boyd* v. *Horrocks*. 1886, 3 R. P. C. 288: see also *Harris* v. *Rothwell*, 1886,

CH. XXVIII. SECT. 12.

Practice as to particulars of objections under the Patents Act, 1883, s. 29.

3 R. P. C. 243; *Boyd* v. *Farrar*, 1887, 5 R. P. C. 33; *Law* v. *Ashworth*, 1890, 7 R. P. C. 89.

(β) **By a book or other publication.**—"*By an article in* (*translated by*), *published at* , *date* , *No.* , *volume* , *page* (*or by drawings*)."

The parts of the book must be specified: *Harris* v. *Rothwell*, 3 R. P. C. 246. The practice of giving too many references of anticipation in the particulars when only a very few will be used is condemned by Kekewich, J., in *Thomson* v. *Batty*, 1888, 6 R. P. C. 96. If the instances are so numerous as to amount to public knowledge, it is better to plead that distinctly (*per* Kekewich, J.): *Phillips* v. *Ivel Co.*, 1890, 7 R. P. C. 82. On the other hand, in *Cole* v. *Saqui*, 1888, 5 R. P. C. 496, Kekewich, J., compared a large number of specified anticipations to "reserve forces" not called into action, but which "it was prudent to have at hand."

(γ) **By user.**—"*By the* (*use, manufacture, sale, exposure for sale*) *of at on , etc.* (*or of models.*)"

A sufficient description of the anticipating articles must be given. It is not enough to say merely "by the sale of *articles*": *Boyd* v. *Farrar*, 1887, 5 R. P. C. 35. Nor would it be enough to say "by the use of 'the Wenham Lamp,'" which might mean any lamp made by Wenham: *Siemens* v. *Karo*, 1891, 8 R. P. C. 379. On the other hand, it is not needful to describe minutely each of the alleged anticipating articles: *Sidebottom* v. *Fielden*, 1891, 8 R. P. C. 272 (*Boyd* v. *Farrar* distinguished). It is not enough to say "*by the manufacture, sale, use, or public exhibition of wire rope made*

Practice as to particulars of objections under the Patents Act, 1883, s. 29.

according to the alleged invention by . . . from 1832 *to* 1862." Better and more precise particulars must be given: *Smith* v. *Lang*, 1890, 7 R. P. C. 150; *Palmer* v. *Wagstaffe*, 1853, 8 Ex. 840, decided that under a general objection of "user in London and its vicinity," detailed instances need not be given; but in *Alliance Pure White Lead Syndicate* v. *MacIvor*, 1891, 8 R. P. C. 321, an interrogatory as to the particular instances was allowed. The true distinction seems to be whether the plea is only one of "general knowledge," or whether it is really a plea of public user in a particular place, such as London. In the former case, as pointed out above, detailed particulars are impossible, but in the latter they should be given: see p. 370, *supra*.

(h) Specification defective.

(1.) Disconformity.—"*That the alleged invention described in the complete specification* (*as amended*), *is a different invention from that described in the provisional specification* (*and title*) *in that* . . . (here the disconformity must be specified): *Anglo-American Brush Co.* v. *Crompton*, 1886, 4 R. P. C. 27; *Boyd* v. *Horrocks*, 1886, 3 R. P. C. 288 (objection to tenth particular); *Fisher* v. *Dewick*, 1838, 1 W. P. C. 551, n.; and see "Provisional Specification," Chap. VII., s. 3; Chap. VIII., s. 8.

ante, pp. 170, 185.

(2.) Disconformity by amendment.—"*That the alleged invention described in the complete specification as amended is a different invention from that described in the provisional specification, and in the complete specification as originally drawn and accepted, in that* . . ." This objection is directed against an amendment, which alters the scope of the invention; see *Farben Fabrik* v. *Bowker*, 1891, 8 R. P. C. 391, line 52.

ante, p. 225.

(3.) New not distinguished from old.—"*That the*

CH. XXVIII. SECT. 12.

Practice as to particulars of objections under the Patents Act, 1883, s. 29.

plaintiff did not by his complete specification or his claims sufficiently distinguish which of the parts he claimed to have invented from those which he admits to be old . . ." (Here specify parts complained of): *Fisher* v. *Dewick*, 1838, 1 W. P. C. 551, n.

(4.) Ambiguity.—"*That the complete specification of the plaintiff is vague and ambiguous in its terms, and does not sufficiently or intelligibly describe the alleged invention, and that the same is calculated to mislead, in that . . .*" Particulars should here be given of the points wherein the specification is ambiguous: *Farben Fabrik* v. *Bowker*, 1891, 8 R. P. C. 391.

ante, p. 185.

(5.) That the letters patent contain false suggestions.—These must be specifically set out; most of them, however, come more properly under other titles.

(6.) Insufficient description.—"*That the complete specification is insufficient inasmuch as it does not contain sufficient direction to enable a workman skilled in trade to . . .*" (Here details should be given): *Crompton* v. *Anglo-American Brush Co.*, 1887, 4 R. P. C. 197.

ante, p. 188.

(7.) Most beneficial method known to inventor not described.—"*That the plaintiff in his complete specification did not state the most beneficial method with which he was then acquainted of practising his said invention . . .*" Held enough in *Jones* v. *Berger*, 1843, 5 M. & G. 208. This case was not followed in *Russell* v. *Ledsam*, 1843, 11 M. & W. 651, and it is submitted that now it would be necessary to specify wherein the directions were insufficient.

13. Amendment of defence and particulars.—A defence denying infringement may be amended so as to impeach the patent, after the action is set down for trial, on

payment of all costs, in spite of the fact that the validity of the patents has been previously affirmed in a court of law: *United Telephone Co.* v. *Bassano*, 1885, 2 R. P. C. 70.

Striking out pleas.—The court, under R. S. C., O. XIX., *r.* 27, can strike out an embarrassing plea or objection: *McDougall* v. *Partington*, 1890, 7 R. P. C. 216, but, unless the objection be really embarrassing, it need not be struck out, though it may be considered unnecessary: *Hocking* v. *Hocking*, 1886, 3 R. P. C. 291.

14. Amendment of particulars of objections before hearing.—This rests on Patents Act, 1883, s. 29, sub-s. 5, and in *Holste* v. *Robertson* it was said that the Court would at any time allow the defendant to raise a fresh issue on discovery of facts which he could not with due diligence have discovered before: 1876, L. R. 4 Ch. D. 9; *Tildsley* v. *Harper*, 1878, L. R. 10 Ch. D. 393. Amendments may be made at the instance of either party. The particulars of objection may be amended after the cause is in the list for trial, or by adding fresh instances of anticipation, on giving the plaintiff full opportunity to inspect the newly-particularized machines, and reserving plaintiff's rights at the trial, if he should be embarrassed: *Otto* v. *Sterne*, 1885, 2 R. P. C. 139; *Baird* v. *Moule's Earth Closet Co.*, 1876, 17 Ch. D. 139, and *Aveling* v. *Maclaren*, 1880, 17 Ch. D. 139. But sometimes the amendment is only allowed on terms that the plaintiffs may have an option to discontinue with their costs: *Edison Telephone Co.* v. *India Rubber Co.*, 1881, 17 Ch. D. 137. In *Ehrlich* v. *Ihlee*, 1887, 4 R. P. C. 115, after the action had been set down for trial, the plaintiff was to have six weeks after amendment to elect to discontinue, in which case he was to have his costs from the date of

CH. XXVIII. SECT. 14.

Amendment of particulars of objections before hearing.

the defendant's first delivery of particulars, but was to pay defendant the other costs of the action (see the order, p. 119). In *Parker* v. *Maignen's Filtre Rapide Co.*, 1888, 5 R. P. C. 207, after the cause had been entered for trial, an order for amendment was made on payment of costs. In *Darrah* v. *Purser*, 1889, 6 R. P. C. 365, an order for leave to amend was made on terms that the plaintiffs should have four weeks time to discontinue as in the case of the *Edison Telephone Co.* v. *India Rubber Co.* (*supra*); see also *Wilson* v. *Gann*, 23 W. R. 546; *Morris* v. *Coventry Co.*, 1891, 8 R. P. C. 353.

The application is usually made at Chambers in the Queen's Bench Division, Judicature Act, 1883, s. 39; R. S. C. 1883, O. XIX., r. 7, and to the Court on motion in Chancery.

15. Amendments at the hearing.—At the trial, either an amendment can be allowed, or else the Court, or the Court of Appeal, can permit the evidence to extend beyond the particulars: *Britain* v. *Hirsch*, 1888, 5 R. P. C. 231. But where the defendant did not shew that with reasonable care he could not have discovered the new facts earlier, leave to amend at the trial was refused: *Moss* v. *Malins*, 1886, 33 Ch. D. 603, 35 W. R. 165. An amendment during the trial was reluctantly allowed in *Blakey* v. *Latham*, 1889, 6 R. P. C. 36.

In Chancery a defendant was allowed to amend his particulars of objections at the hearing, even after the close of the plaintiff's case, but on payment of all costs: *Renard* v. *Levinstein*, 1864, 11 L. T. (N.S.) 505, 13 W. R. 382; and a somewhat similar leave was given in *Daw* v. *Eley*, 1865, L. R. 1 Eq. 38. Amendment at the hearing is a question of discretion, and when it appeared clear that

the defendant's amendment would not be of avail, and that the case was really undefended, leave to amend was refused: *Edison Electric Light Co.* v. *Shippey*, 1887, 4 R. P. C. 471. In *Pascall* v. *Toope*, the defendants in their objections and interrogatories had alleged that a certain method was in common use, which had anticipated the plaintiff's patent. At the trial they gave evidence of another method which seemed an anticipation. Held, that they might amend their particulars—action to stand over—and plaintiff to have leave to discontinue: 1890, 7 R. P. C. 125.

It is dangerous for a plaintiff not to insist upon the limitation and definition of the defendant's particulars of objections, for if he leave them vague, he may be surprised at the trial: *Sugg* v. *Silber*, 1876, L. R. 2 Q. B. D. 493; *Neilson* v. *Harford*, 1841, 1 W. P. C. 332; *Hull* v. *Bollard*, 1856, 1 H. & M. 137, 25 L. J. Ex. 304; *Curtis* v. *Platt*, 1866, 35 L. J. Ch. 852.

16. Amendment of particulars of objection on appeal.—This will not often be allowed, and never except in case of discovery of new evidence, which could not with reasonable diligence have been previously obtained. In a new trial, the defendant was always considered entitled to amend: *Bovill* v. *Goodier*, 1865, 36 L. J. Ch. 369. But in *Hinde* v. *Osborn*, a motion for leave to adduce fresh evidence alleged to have been discovered since the trial, and raising a new issue as to novelty, was dismissed: 1885, 2 R. P. C. 45. The Court, however, said that had it been the case of a lost document suddenly discovered it might have been allowed, but not mere anticipations in books, which were sought for, but could not before the trial be found.

CH. XXVIII. SECT. 16.

Amendment of particulars of objection *on appeal.*

When an order to amend particulars of breaches or objections is not obeyed, the proper course is to apply to strike out the particulars which were ordered to be amended.

The other party has (unless it is otherwise ordered) the same time to plead from the delivery of the amended particulars, as he would have had from the return day of the summons: R. S. C., O. XIX., r. 8.

17. Inspection: Old practice.—As early as the year 1815 Lord Eldon intimated that the plaintiff might be empowered by a Court of Chancery to inspect the machines of a defendant, who was alleged to be making lace which must have been made by an infringing machine: *Bovill* v. *Moore*, 1815, 2 Coo. C. C. 56 n. Similar inspection was ordered in *Brown* v. *Moore*, 1816, 3 Swan 264; *Russell* v. *Cowley*, 1832, 1 W. P. C. 458; *Morgan* v. *Seaward*, 1835, 1 W. P. C. 169; and in *Russell* v. *Crichton*, 1837, 1 W. P. C. 677; viewers were appointed to inspect, who were not to reveal what they saw, except for the purposes of the action: 1837, 15 Dec. of Court of Sessions, 1270.

By the Patents Act, 1852, s. 42, this power was extended to courts of law on the application of plaintiff or defendant, under which Act were decided: *Amies* v. *Kelsey*, 1852, 22 L. J. Q. B. 84; *Shaw* v. *Bank of England*, 1852, 22 L. J. Ex. 26; *Harrison* v. *Spire*, 1853, 22 L. T. 92; *Jones* v. *Lees*, 1856, 25 L. J. Ex. 241; *Meadows* v. *Kirkman*, 1860, 29 L. J. Ex. 205; where inspection was refused on the defendant swearing that he had no such machinery as was suggested. In *Patent Type-founding Co.* v. *Lloyd*, 1860, 5 H. & N. 192, 29 L. J. Ex. 207, the Court was asked not merely to give inspection, but to

allow samples to be taken. The Court doubted its power, but a Chancery Court made the order: Johns. 727. In *Davenport* v. *Jepson* the plaintiffs were empowered to take samples, and to work the defendant's machines; 1862, 1 N. R. 307. In the *Singer Machine Co.* v. *Wilson*, it was treated as of course that inspection should be allowed when a *primâ facie* case had been made out: 1865, 5 N. R. 505; see also *Neilson* v. *Betts*, 1871, L. R. 5 H. L. 11. In *Piggott* v. *Anglo-American Telegraph Co.*, 1868, 19 L. T. (N.S.) 46, inspection was refused where it would have disclosed important secrets, and where plaintiffs could have no difficulty in otherwise proving the infringement. Where plaintiff and defendant are competitors in trade the order to inspect, it was thought, should not be given except to an expert to report to the Court: *Flower* v. *Lloyd*, 1876, 10 Ch. D. 327; and the Court will not necessarily allow that report to be seen: *Plating Co.* v. *Farquharson*, 1883, Griff. 187. In *Morgan* v. *Seaward*, 1835, 1 W. P. C. 169, inspection was given of paddle-wheels made, or to be made, by defendants, under a contract, which wheels were alleged by plaintiffs to be an infringement.

18. Inspection: Practice under Patents Act, 1883, s. 30.—The powers under this Act are wider, and under R. S. C., O. XXX., r. 3, not only may samples be taken, observations made, and experiments conducted, but any lands or buildings in the possession of any party may be entered for the purpose: R. S. C., O. L., r. 3. Moreover, orders may be made for the inspection of the alleged infringing articles, or the articles alleged to be anticipations, or else the articles made by the plaintiff according to the patent sued on, provided that those articles are in the

post, p. 455.

CH. XXVIII. SECT. 18.

Inspection: Practice under Patents Act, 1883, s. 30.

possession of the parties. For the inspection order would not apply to strangers to the suit, nor to the witnesses (see *infra*).

There is thus hardly any limit to the powers of the Court to grant inspection of machines in the possession or on the lands of any party to the action, and to examine and experiment as may be deemed necessary. In the *Germ Milling Co.* v. *Robinson*, the plaintiffs applied for inspection of the defendant's mills. This was refused, as the plaintiffs could make out no *primâ facie* case of infringement. The defendants then consented to the inspection, and then asked that they might inspect the plaintiffs' processes. The plaintiffs did not allege the possession of any trade secret. Ordered that an expert, and the defendants' solicitor, might inspect and take samples, and that the mills should be worked before them: 1884, 1 R. P. C. 217; 1885, 3 R. P. C. 11. In *Drake* v. *Muntz Metal Co.*, 1886, 3 R. P. C. 43, Bacon, V.-C., seemed to think he had no right to order the machines to be worked for the experts appointed to inspect the defendants' processes. In *Moore* v. *Bennett*, where most conflicting evidence had been given as to whether a machine would work or not, the Court of Appeal ordered a thorough trial in the presence of an expert and both parties, and acted upon his report: *Moore* v. *Bennett*, 1884, 1 R. P. C. 134. Inspection by the defendants of the plaintiff's glass bottles was ordered, where the utility of the plaintiff's invention was denied by the defendants—the machinery to be worked if necessary: *Rylands* v. *Ashley's Patent Bottle Co.* 1890, 7 R. P. C 175. In *Cheetham* v. *Oldham* it was held, that to entitle a party to inspection a *primâ facie* case must be made out: 1888, 5 R. P. C. 617. Where a plaintiff

Inspection: Practice under Patents Act, 1883, s. 30.

applied to inspect the defendant's alleged anticipations of the plaintiff's patent in the possession of the defendant's witnesses; held, that there was no jurisdiction to make it, except by consent, and this ruling was upheld by the Court of Appeal: *Garrard* v. *Edge*, 1889, 6 R. P. C. 374. But where the alleged anticipations are in his custody a defendant must produce them for inspection: *Sidebottom* v. *Fielden*, 1891, 8 R. P. C. 266; and where the anticipating articles were in the custody of the Court as exhibits, the Court ordered inspection of them to be given to the plaintiff. But as it turned out that they were exhibits in another action, the Court thought that the parties in that other action ought to consent: *Smith* v. *Lang*, 1890, 7 R. P. C. 151. Hence then, it appears that the party applying for inspection must make out a strong case for the belief that articles exist, which are infringements, or which ought to be inspected, and that they are in the other party's possession, and that they are material to his case, together with the grounds for his belief: *Germ Milling Co.* v. *Robinson*, 1884, 1 R. P. C. 217. This may be met by the demand that only an independent expert shall see them, and report to the Court: *Flower* v. *Lloyd*, W. N. 1876. p. 169; *Plating Co.* v. *Farquharson*, 1883, Griff. 187; *Hill* v. *Tombs*, 1881, Lawson, 499.

The application may be made at any stage of the action, and is obtained on motion or summons at Chambers in the Queen's Bench Division: S. C. R., O. XXXIV., r. 12; O. XXXV., r. 6; O. LIV., r. 12; O. LV., r. 15; and *Frearson* v. *Loe*, 1878, 26 W. R. 138. Delay in applying is no objection to the granting it: *Patent Type-founding Co.* v. *Walter*, 1860, Johns, 727.

19. Discovery and production of documents.—There is nothing special about discovery and inspection of documents in a patent action. Thus the case of *Haslam* v. *Hall*, 1887, 5 R. P. C. 1, decided that documents other than those which have come into existence for the purpose of the litigation ought to be produced. *Bown* v. *Sansom*, 1888, 5 R. P. C. 510, decided that affidavits and shorthand notes used in a former action, relative to the same patent, must be produced: *Westinghouse* v. *Midland Rail. Co.*, 1883, 48 L. T. (N.S.) 98, 462. Where discovery has not been pressed for certain documents in Chambers, the Court of Appeal does not willingly extend the order made by the Court below: *Thomson* v. *Hughes*, 1890, 7 R. P. C. 190. When the validity of a patent is questioned, the plaintiff is not at liberty to see books or documents which would tend to shew a number of acts of infringement, until the validity of the patent is established. Hence application for such documents would be refused, but without prejudice to an application at the trial, or at some later stage. "It may over and over again occur that it would be a very oppressive and wrong thing to order a defendant, who disputes the validity of the patent, to produce to a rival in trade the details of what he has had, simply because he is alleged to have infringed" (*per* Lindley, L.J.): *Rawes* v. *Chance*, 1890, 7 R. P. C. 281; see *Lister* v. *Norton*, 1885, 2 R. P. C. 68; *Smith* v. *G. W. Rail. Co.*, 1854, 3 W. R. 69.

20. Interrogatories.—The principles governing interrogatories in patent cases are the same as those in ordinary actions with some modifications, chiefly with the purpose of protecting genuine trade secrets.

Interrogatories.

The proper time for interrogatories is after issue joined: *Jones* v. *Pratt*, 1861, 30 L. J. Ex. 365.

Interrogatories as to the existence of documents are not allowed where a conclusive and complete affidavit of documents has been filed: *Hall* v. *Trueman*, 1885, 29 Ch. D. 307; but where the affidavit appears inconclusive, interrogatories, not of a roving, but of a definite character, as to particular documents believed to exist, may be permissible: *Moseley* v. *Victoria Rubber Co.*, 1886, 3 R. P. C. 355; *Edison* v. *Holland*, 1888, 5 R. P. C. 217.

Interrogatories may enquire into the same matter as particulars, so that it is no ground for refusing to answer an interrogatory to say that it would be a proper matter for particulars: *Birch* v. *Mather*, 1883, 22 Ch. D. 629. The interrogatories must only enquire into questions of fact, not into the details of the evidence by which the facts will be established: *Delta Metal Co.* v. *Maxim Nordenfelt*, 1891, 8 R. P. C. 169. But where a defendant pleads as anticipation, "Prior user in London and its vicinity," he must answer interrogatories as to the names and addresses of the particular persons who have used the invention: *Alliance Pure White Lead Syndicate* v. *MacIvor*, 1891 8 R. P. C. 321. Here the case of *Palmer* v. *Wagstaffe*, 1853, 8 Ex. 840, was cited to shew that particulars of a similar nature need not be given. But that was an old case, and North, J., decided that each case must stand on its own footing. For form of interrogatories see *Thomas* v. *Tillie*, 1866, 17 Ir. C. L. R. 783.

A patentee may by interrogatories be asked to indicate what portions of his patent he says are infringed; but neither plaintiff nor defendant can be asked in answers to interrogatories, or in particulars, to tie himself down to a particular construction of a patent:

CH. XXVIII. SECT. 20

Interrogatories.

Moseley v. *Victoria Rubber Co.*, 1886, 3 R. P. C. 352. Compare also *Wenham Co.* v. *Champion Co.*, 1890, 8 R. P. C. 22; *Delta Metal Co.* v. *Maxim Nordenfelt*, 1891, 8 R. P. C. 169. It will from this case be noticed that a good deal depends upon the form in which the questions are put: see also cases given in Chap. XXVIII. sect. 8., "Particulars of Breaches"; and see *Hoffman* v. *Postill*, 1869, 4 Ch. 680.

Where the utility of a patent machine is denied, a plaintiff may be asked whether he has successfully made articles with a machine made according to his patent, or whether it has been necessary to introduce alterations or additions, but he is not obliged to answer what those alterations or additions were, for that is his secret, and not necessarily relevant: *Rylands* v. *Ashley's Patent Bottle Co.*, 1890, 7 R. P. C. 175; *Renard* v. *Levinstein*, 1864, 11 L. T. (N.S.) 505; *Rolls* v. *Isaacs*, 1878, W. N. 37; *Crossley* v. *Tomey*, 1876, 2 Ch. D. 533.

If a defendant admits infringement, but rests his case on invalidity of the patent, he will not, before the plaintiff's rights have been established, be compelled to reveal the names of the persons who bought from him: *Lister* v. *Norton*, 1885, 2 R. P. C. 68; *Crossley* v. *Tomey*, 1876, 2 Ch. D. 533.

If a defendant denies infringement, then he must answer all questions tending to establish infringement. Thus, if asked whether he did not sell certain specified goods to certain specified persons he must answer in detail unless he admits the sale of such goods, to an amount sufficient to enable the plaintiff to prove his case: *Lister* v. *Norton*, 1885, 2 R. P. C. 68; *De la Rue* v. *Dickenson*, 1857, 3 K. & J. 391; *Lea* v. *Saxby*, 1875, 32 L. T. (N.S.) 731; *Howe* v. *M'Kernan*, 1862, 30 Beav. 547.

Interrogatories.

Where, however, the taking of an account or assessing of damages is proceeding, the defendant must set out the sales, and give the names of his customers, and it is no answer to say that such discovery might expose them to actions: *Tetley* v. *Easton*, 1856, 25 L. J. C. P. 293, 18 C. B. 643; *Jourdain* v. *Palmer*, 1866, L. R. 1 Ex. 102; *Swinborne* v. *Nelson*, 1853, 16 Beav. 416.

In interrogatories, just as in general in all cases of discovery in patent cases, caution will be observed in not compelling the disclosure of trade secrets to rivals: *Moore* v. *Craven*, 1870, L. R. 7 Ch. 94 n. A form of interrogatories by defendant will be found in *Pascall* v. *Toope*, 1890, 8 R. P. C. 2; and another in *Benno Jaffé* v. *Richardson & Co.*, 1893, 10 R. P. C. 136.

21. The mode of trial in patent actions is regulated by the rules of the Supreme Court, O. XXXVI. Prior to the Patents Act, 1883, patent actions were generally tried at common law with a jury, and issues were sent for that purpose from Chancery. The method being considered unsatisfactory, it was provided by the Patents Act, 1883, s. 28, that in all proceedings for infringement or revocation, the Court may and shall, on the request of either party, call in the aid of a specially qualified assessor, whose remuneration is to be paid in the same manner as the other expenses of the execution of that act, that is to say, out of public money: sect. 83, subsect. 2; and that the action should be tried without a jury, unless the Court should otherwise direct. The power of calling in an assessor was first exercised in a patent case in *Pearce* v. *Thompson*, tried before Wills, J., on February 1st, 1893. The appointment of an assessor should enable the Court to dispense with much scientific

post, p. 454.

post, p. 453.

CH. XXVIII. SECT. 21.

The mode of trial in patent actions.

evidence, and thus reduce costs; and may be useful to a party who fears that his means will not admit of his procuring sufficient expert evidence to meet the expert evidence of his opponent. There are already, attached to the Board of Trade, scientific advisers in railway, electrical, and other matters, whose position would probably make them desirable assessors. Jury trials of patent cases have been sometimes allowed after the Act of 1883: *Westinghouse* v. *Lancashire Rail. Co.*, 1884, 1 R. P. C. 229; *Young* v. *Rosenthal*, 1884, 1 R. P. C. 29; but are becoming quite obsolete, except where a fraudulent conspiracy is alleged: *e.g.*, *Edge* v. *Harrison*, 1891, 8 R. P. C. 74; or in action for threats.

The Court has, under R. S. C., O. XXXVI., r. 8, power to direct that one or more issues of fact may be tried before the others. Under the Arbitration Act, 1889, s. 13, the judge has power to appoint referees to report upon any particular questions to be referred to an official or special referee for enquiry or report (see Chap. XXVIII., sect. 18, and "Notes" in the Annual Practice). This power is frequently used in patent cases. The order may provide for assistance to the referee in performance of his duties (as was done in the *United Telephone Co.* v. *Leeds Tramways Co.*, tried before Kekewich, J., in January, 1893), and should contain directions as to what is to be reported, how the enquiry is to be made, and what parties on each side may attend the referee, and should appoint a date for the sending in of the report. The referee who made the report, Mr. Macrory, Q.C. (assisted by the author), was in that case placed in the box to answer questions relating to his report, but the questions that might be asked of him would be under the control of, and in the discretion of, the judge.

ante, p. 381.

The mode of trial in patent actions.

In an action for infringing a telephone patent the defendants had sold separately, magnets and bobbins. They admitted the validity of the plaintiffs' patent for a telephone, but denied that it included the parts of a telephone. On application by the defendants that the infringement question should be tried first, the judge pointed out that the question of infringement was so mixed up with the question of construction of the patent that they could not be tried separately, and refused the order, unless defendants admitted validity of patent: *United Telephone Co.* v. *Mottishead*, 1886, 3 R. P. C. 213.

Postponement or expedition of trial.—Under the old practice an action of infringement was sometimes postponed, pending the trial of a sci. fac., for repeal of the patent: *Smith* v. *Upton*, 1843, 6 M. & G. 251; *Patteson* v. *Holland*, 1845, Hindmarch, Pat. 293. But it was sometimes refused: *Muntz* v. *Foster*, 1844, 2 W. P. C. 93 n. As a rule the Court will not order the expedition of a trial, except upon very strong grounds: *Farben Fabrik* v. *Bowker*, 1890, 8 R. P. C. 136.

22. Change of venue.—Chancery actions may be put down to be tried at assize towns: *Edmond's Patent*, 1889, 6 R. P. C. 355; and if so put down, ought not to be sent back to London by the assize judge on the ground of want of time. The proper mode would be to apply to the Chancery judge in London to change the venue: *Fairburn* v. *Household*, 1885, 2 R. P. C. 195.

23. The hearing: Evidence.—At the hearing any question which would settle the whole action is frequently disposed of first: *Richardson* v. *Castrey*, 1887, 4 R. P. C. 265; *Badham* v. *Bird*, 1888, 5 R. P. C. 238.

CH. XXVIII. SECT. 23.

The hearing: Evidence

The proof of letters patent is given by producing the original or a certified copy, and if the patent professes to be an improvement on a previous patent, the previous patent must be put in: *Lewis* v. *Davis*, 1829, 1 W. P. C. 489. The production of a printed copy is *primâ facie* evidence of the originality of the invention, and of the grant of the patent: *Russell* v. *Crichton*, 1837, 1 W. P. C. 677. But it seems that the plaintiff ought also to give some, though it may be slight, evidence of the nature of his invention, if that has been disputed: *Turner* v. *Winter*, 1787, 1 T. R. 606; *Galloway* v. *Bleaden*, 1839, 1 W. P. C. 523; and if the alleged infringement is not an infringement of the invention exactly as it is described, but is an infringement of its essence, then evidence should be given of the ambit of the invention, shewing that on its true interpretation the defendant has infringed it: Chap. XXIV., sects. 2, 3. A commission to examine a witness abroad was granted in *Lister* v. *Norton*, 1884, 2 R. P. C. 138.

ante, p. 292.

The evidence of infringement necessary to entitle a plaintiff to succeed may also be slight. Thus, it is enough to prove that an article was made by the defendant, and to produce skilled witnesses who say that it must, in their opinion, have been produced by the plaintiff's patent method. This, unless displaced, would be sufficient: *Huddart* v. *Grimshaw*, 1803, 1 W. P. C. 91. On the other hand, where other machinery exists, capable of producing the article complained of, and which machinery is not an infringement of the patent, the plaintiff is not entitled to succeed unless he gives some reason for thinking that it is by his patent the article was manufactured: *Cartsburn Co.* v. *Sharpe*, 1884, 1 R. P. C. 186; compare *Palmer* v. *Wagstaffe*, 1854, 9 Ex. 494,

23 L. J. Ex. 217. Distinct evidence should be given that the article was not made by the plaintiff: *Betts* v. *Willmot*, 1871, L. R. 6 Ch. 239, 25 L. T. (N.S.) 188; see also *Farben Fabrik* v. *Bowker*, where mere proof of sale of an infringing article by defendant, with no proof of non-manufacture by plaintiff, was held to be insufficient, but an opportunity was given to the plaintiff to correct this if he could, after his case was closed, 1891, 8 R. P. C. 395.

Scientific evidence is allowed to explain mechanical and chemical expressions and operations: *Batley* v. *Kynoch*, 1875, L. R. 20 Eq. 637; but not to say whether there has or has not been an infringement, for that is a matter for the tribunal: *Seed* v. *Higgins*, 1860, 8 H. L. C. 550, 30 L. J. Q. B. 314.

Sometimes evidence of a secret process is allowed to be given in Camera so as not to be disclosed: *Badische Anilin und Soda Fabrik* v. *Levinstein*, 1883, 24 Ch. D. 156.

Experiments are frequently made by experts with a view of giving evidence. In *Young* v. *Fernie*, 1864, 4 Giff. 609, it was said that such experiments should be looked upon with distrust; and indeed they do, to a great extent, depend on the good faith of those who have made them. Evidence is allowed of persons who have made articles in accordance with the patent and with no other description than that contained in the specifications: *Cornish* v. *Keene*, 1835, 1 W. P. C. 502. Sometimes a "specimen ordinary workman" is put into the box to shew what such a man would make of the instructions in the specification.

Experiments and inspection are often ordered by the Court to be made by an expert, selected by the Court, to which they make a secret report: S. C. R. 1883, O. L., r. 3. *ante*, p. 381.

In preparing the evidence in support of a patent case,

CH. XXVIII. SECT. 23.

The hearing: Evidence.

ante, p. 134.

the chief points to be attended to are, to convince the Court that the inventor has behaved honestly and with *bona fides*—that the invention was a real and solid improvement at the time it was made—that it resulted in a commercial (Chap. IV.), or at least a practical success; that there was a wide desire for the invention at the time; and that others had tried to do it and failed, or had after experiment abandoned it as not practicable. Evidence should also be given of the utility of the invention, and, if possible, of its beneficial nature to the public, as in making things cheaper, or better than before, or in introducing a new article or manufacture.

So far as the evidence of experts is adduced, it should be considered with reference to their callings and experience, and to their ingenuity and readiness in surmounting the attempt of the opposing counsel to confuse and puzzle them. The prolixity of counsel in patent cases has been more than once the subject of remark; thus, in *Ehrlich* v. *Ilslee*, 1888, 5 R. P. C. 446, it was commented upon at some length. In *Ungar* v. *Sugg*, 1892, 9 R. P. C. 116, Brett, L.J. says: "There is something catching in patent cases, which is, that it makes everybody argue and ask questions to an interminable extent. A patent case, with no more difficult question to try than any other case, instead of lasting six hours is invariably made to last six days if not twelve. I am sure there ought to be some remedy for it."

The Court will sometimes look at a model which has not been strictly proved if it is used to explain counsel's argument (and no doubt sketches might be similarly employed): *Boyd* v. *Horrocks*, 1889, 6 R. P. C. 152.

Hearsay evidence is of course not allowable, so that

where a witness proved that a dead man had sold a certain article to another, that other was not allowed to give evidence that on a subsequent occasion the deceased had said he did not wish it to be publicly known. If the declarations had accompanied the act of selling the article in question, the decision would have been different: *Hyde* v. *Palmer*, 1863, 3 B. & S. 657, 32 L. J. Q. B. 126.

The plaintiff is entitled to call evidence in reply to the defendant's evidence of prior user, but the defendant is not entitled as of right to call further evidence rebutting this: *Penn* v. *Jack*, 1866, L. R. 2 Eq. 314, 14 L. T. (N.S.) 495.

In the basement of the Royal Courts of Justice there are rooms which are let out to parties in patent actions, and in which they can deposit, and in some cases work, machines and models under lock and key. The judge, if desired, will sometimes go and inspect them with the parties.

Considerable experience and care is needed in the preparation of the evidence in a patent case. The issues must be carefully looked at to see what the plaintiff will have to prove. The patents and specifications are generally admitted by consent; if not, they must be proved by means of certified copies; merely to produce a printed copy of the specifications will not be enough. Anticipations by means of books are most simply proved, if they exist, in the Patent Office Library, by a gentleman from the Patent Office. The librarians keep a record of the date on which each book is placed in the library, which greatly facilitates the proof. To prove the infringement it is not enough simply to produce an article, evidence must be given of its sale by defendants. If the patent be for a process, proof must be given that

post, p. 464.

Cu. XXVIII. sect. 23.

The hearing: Evidence.

the article was made by that process. This, if other means fail, may be by an expert, who, looking at it, can say how he believes it was made. Comparatively slight evidence of this will be enough to establish a *primâ facie* case, but if the article might have been made by other processes, which are not infringements of the plaintiff's process, some reasons must be given why the patentee concludes that it was made by his process. In such cases interrogatives are generally expedient. The plaintiff should be prepared with proof that the invention is useful, new, and that the specification is clear and easy to be comprehended. In addition to this, he should also be provided with evidence of the state of knowledge in the trade at the time the patent was granted, so that light may be thrown upon the manner in which it ought to be interpreted, and its true ambit determined. The evidence on these heads is very important. For even though the utility be not directly questioned, yet the whole position of the plaintiff is greatly strengthened if he can shew that the patent has been the means of putting the public in possession of a desired result which had previously been sought in vain, and that the patent was a commercial success.

In his choice of witnesses, the plaintiff has to elect between employing regular scientific witnesses, and witnesses specially engaged in the trade. The advantage of the former is, that they really serve almost as advocates. They foresee difficulties, their ingenuity overcomes objections, and they are usually accustomed to being cross-examined.

The danger of employing only mechanics engaged in the trade is, that they will generally insist on being too clever, and in making some point on which they are

bent, without seeing that they are damaging the other parts of the case. But if a reticent and experienced witness of this class can be got who thoroughly and honestly believes in the case, he is of great assistance.

In patent cases there is a great tendency to multiply witnesses, and to secure quantity at the expense of quality. Nothing is a greater mistake. Each witness put into the box is a source of danger to his own side, for it is impossible to foresee what damaging admissions or silly remarks he may not be induced to make under cross-examination.

Another danger to be avoided is to be too nervous over unimportant parts of the case, and to take a number of false points. When each of a dozen weak objections to a patent is insisted on, a judge is apt to think that there cannot be much in any of them. A case, like a chain, depends not on the aggregate weight of its links, but on the strength of the weakest of them.

Wherever the subject admits of it, models are very useful, and some judgment is required in making them easy to move about, and yet large enough for their action to be seen. The important parts may be painted in distinctive colours, and they should be labelled clearly. Before they are finally finished it is of advantage for counsel and the expert witnesses to see them, so as to suggest alterations or improvements. Sometimes it is useful to have the drawings of the machine mounted on cards and coloured, to make the parts more clear. If there are many patents, they should be bound in books, and provided with parchment tags with the names on them, so as to be easily referred to.

Care is also needed in preparing the briefs. After they have been written they should be gone through and

CH. XXVIII. SECT. 23. — The hearing: Evidence.

condensed as much as possible, and great pains taken with the arrangement. A table of events with their dates, including the applications, sending in of specifications, etc.; of all the patents, every step in the action, and every circumstance of importance is very useful. In preparing a brief, when in doubt, always adopt chronological order. A *short* abstract or table of the witnesses names, and what they can prove, is of advantage. It is a help to understanding the brief, if small sketches are made in it. They are not allowed on taxation, but a great deal can be done by an intelligent clerk with a pen and two or three chalk pencils of different colours. An abstract of the patents with small sketches, shewing the important feature of each, will often be useful.

24. Questions of law and fact.—A decision upon a question of construction in a specification is one of law, and hence, when it has been decided, it ought to be followed in other cases, by Courts of inferior or co-ordinate jurisdiction: *Slazenger* v. *Feltham*, 1889, 6 R. P. C. 132; *Automatic Weighing Machine Co.* v. *Combined Weighing Machine Co.*, 1889, 6 R. P. C. 120, 367.

But this only applies to findings upon points of law, not findings of fact, as to which, if fresh evidence is brought in a new case, the decision may be different: *Edison Co.* v. *Holland*, 1888, 5 R. P. C. 459, where, after the Court of Appeal had decided on the validity of a patent, Kay, J. in a subsequent action *in which new and different evidence of want of novelty was brought*, declared the same patent invalid. His decision was reversed by the Court of Appeal, 1889, 6 R. P. C. 243, but the principle upon which he had acted was approved. As to questions of Infringement, see Chap. XXIV., sect. 22 (*ante*, p. 324).

25. Construction of documents.—In general the construction of documents which are not susceptible of evidence to explain them, is for the Court. If then it is necessary merely to compare specifications without evidence, this will be done by the Court: *Tetley* v. *Easton*, 1852, M. P. C. 68; *Otto* v. *Linford*, 1882, 46 L. T. (N.S.) 44. But where they need to be supplemented by expert or other evidence, they are questions of fact for a jury, if there is one: *Neilson* v. *Harford*, 1841, 1 W. P. C. 350, and see p. 678; *Stead* v. *Williams*, 1843, 2 W. P. C. 137; *Stead* v. *Anderson*, 1846, 2 W. P. C. 147; *Thomas* v. *Foxwell*, 1858, 5 Jur. (N.S.) 38, 6 Jur. (N.S.) 271; *Seed* v. *Higgins*, 1860, 8 H. L. C. 561; and see remarks on this case in *Clark* v. *Adie*, 1873, 2 App. Cas. 332.

26. In determining the quantum of invention, the question will be one of fact if the evidence of experts is needful: *Thorn* v. *Worthing Skating Co.*, 1876, 6 Ch. D. n. 415; *Steiner* v. *Heald*, 1851, 6 Ex. 607, 17 Jur. 875, 20 L. J. Ex. 410; *Bush* v. *Fox*, 1851, M. P. C. 166, 23 L. J. Ex. 257, 5 H. L. C. 707, 25 L. J. Ex. 251.

27. The question of anticipation, by prior publication, is also one of fact if the matter is one which depends on scientific evidence to connect the two documents: *Muntz* v. *Foster*, 1844, 2 W. P. C. 107.

The question of prior publication by user will invariably be one for the jury, as it is a matter of fact: *Elliot* v. *Aston*, 1840, 1 W. P. C. 224; *Cornish* v. *Keene*, 1837, 1 W. P. C. 519, 2 Hodg. 294, 3 Bing. N. C. 588; *Spencer* v. *Jack*, 1864, 11 L. T. (N.S.) 242.

28. The question of utility is one of fact, and is for the jury: *Neilson* v. *Harford*, 1841, 1 W. P. C. at p. 315;

CH. XXVIII. SECT. 28.

The question of utility is one of fact.

Hill v. *Thompson*, 1817, 3 Mer. 630, 1 W. P. C. at p. 237; *Bloxam* v. *Elsee*, 1825, 1 C. & P. 365, Ry. & Moo. 187, 1 C. P. C. 434; *Cornish* v. *Keene*, 1835, 1 W. P. C. 501, 2 C. P. C. 314; *Macnamara* v. *Hulse*, 1842, C. & M. 471, 2 W. P. C. 128. On this ground, the finding as to utility, of a Court of first instance, will be very difficult to disturb: *Siddell* v. *Vickers*, 1888, 5 R. P. C. 429–30. On the other hand, the finding of a Court below as to utility is not absolutely conclusive, especially if coupled with what the Court of Appeal considers as an erroneous construction of the specification: *Edison* v. *Holland*, 1889, 6 R. P. C. 284.

29. The question of the intelligibility of a specification or whether it is covered by the title, or by another specification, will in general be for the Court: *Betts* v. *Menzies*, 1862, 10 H. L. C. 134; but when it becomes necessary to take evidence as to materials or ingredients, or to make experiments to see if the methods described sufficiently explain the nature of the invention, the question will then become one of fact for the jury: *Hills* v. *Evans*, 1862, 31 L. J. Ch. 457, 8 Jur. (N.S.) 525, 6 L. T. (N.S.) 90; *Bickford* v. *Skewes*, 1839, 1 W. P. C. at p. 216, 218; *Elliot* v. *Turner*, 1845, 2 C. B. 446; *Wallington* v. *Dale*, 1852, 7 Ex. 888; *Muntz* v. *Foster*, 1844, 2 W. P. C. 107; *Parkes* v. *Stevens*, 1869, L. R. 8 Eq. 358, 38 L. J. Ch. 627, L. R. 5 Ch. 36, 22 L. T. (N.S.) 635. This, however, always presupposes there is sufficient evidence to go to the jury: *Derosne* v. *Fairie*, 1835, 1 W. P. C. at p. 159. The question whether from the specification a workman could perform the invention is also one of fact for the jury: *Walton* v. *Bateman*, 1842, 1 W. P. C. 621.

The above questions of what for the Court, and what for the jury, are now of less importance owing to the extended powers of the Court of Appeal in reviewing facts, and the disuse of juries to try patents. But still they cannot altogether be ignored, as they are useful in determining how far the Court of Appeal will review cases submitted to it. For errors in law are freely reviewed and corrected; conclusions drawn from evidence are only reversed with great difficulty. As to questions of Infringement, see Chap. XXIV., sect. 22.

The question of the intelligibility of a specification or whether it is covered by the title, or by another specification, will in general be for the Court.

ante, p. 324.

30. Judgment.—Various forms of judgments will be found given at length in the following cases: *Westinghouse* v. *Lancashire & Yorkshire Rail. Co.*, 1884, 1 R. P. C. 252; *Washburn Co.* v. *Patterson*, 1884, 1 R. P. C. 191; *Moore* v. *Bennett*, 1884, 1 R. P. C. 133.

post, p. 591.

As to the power of counsel and solicitors to agree to a compromise: see *Alliance Pure White Lead Syndicate* v. *McIvor*, 1891, 8 R. P. C. 323.

Where a plaintiff sued two persons, one of whom allowed judgment to go by default, but the other made a successful defence and invalidated the patent. Held, that the judgment against the other must be reversed: *Cropper* v. *Smith*, 1884, 2 R. P. C. 23.

A judgment in an action will, of course be conclusive, not only as between the parties, but as against all actions in Court of co-ordinate jurisdiction, in so far as such judgment decides questions of law: *Automatic Weighing Machine Co.* v. *Combined Weighing Machine Co.*, 1889, 6 R. P. C. 120, 367. But in so far as mere questions of fact are concerned, they may be raised again: *Edison* v. *Holland*, 1882, 6 R. P. C. 343; *Slazinger* v. *Feltham*, 1889, 6 R. P. C. 130, 232. The above cases

CH. XXVIII. SECT. 30. Judgment.

however shew, that where a case has been once fought out on the merits, the judges discourage the trial of the same questions of fact over again.

31. Judgment for an account.—A finding for the plaintiff is followed by a judgment for damages or else for an account—with or without a perpotual injunction, and at the same time certificates may be given that the validity of the patent came in question. On judgment for the defendant, a certificate should be demanded of the sufficiency of the objections.

P. Act, 1883, sect. 30, *post*, p. 455.

post, p. 406.

post, p. 410.

Formerly, the granting of an account was attendant upon the granting of an injunction, but now accounts may be ordered to be taken whether the action is brought before or after the infringement of the patent; R. S. C. 1883, O. xv., r. 1: *York* v. *Stowers*, 1883, W. N. 1883, 174.

A plaintiff cannot take both damages and an account, he may have which he pleases, but he must elect between them: *Neilson* v. *Betts*, 1871, L. R. 5 H. L. 1; *De Vitre* v. *Betts*, 1873, L. R. 6 H. L. 321; *Siddell* v. *Vickers*, 1892, 9 R. P. C. 162.

The mere taking of an account of profits or the assessing of damages do not of themselves so purge the tort, that the articles in respect of which accounts are taken or damages paid become thereby licensed, and they may still be stopped in the hands of purchasers: *Penn* v. *Bibby*, 1866, L. R. 3 Eq. 308—unless such account or damages is paid and accepted as a royalty: *Penn* v. *Jack*, 1867, L. R. 5 Eq. 81; *Cropper* v. *Smith*, 1882, 24 Ch. D. 305, 312. The amount of a royalty usually received by the plaintiff is not necessarily the measure, or the limit of the damages he may receive, though it is evidence of it: *Penn* v. *Bibby*, 1866, L. R. 3 Eq. 308.

Judgment for an account.

Trivial accounts would not be gone into: *Bergman* v. *Macmillan*, 1881, L. R. 17 Ch. D. 427; *Sanitas Co.* v. *Condy*, 1887, 4 R. P. C. 533; *Watson* v. *Holliday*, 1882, L. R. 20 Ch. D. 780, 30 W. R. 747, 31 W. R. 536.

Where it is suspected that the account may turn out insignificant, it is sometimes referred to a referee with power over costs: *Shaw* v. *Jones*, 1889, 6 R. P. C. 328.

It by no means follows that the money payable under an account would be the same as the money payable as damages. In damages the plaintiff receives compensation for the injury he has suffered: *United Horseshoe and Nail Co.* v. *Stewart*, 1888, 5 R. P. C. 260, 13 App. Cas. 401; *Ledgard* v. *Bull*, 1886, 11 App. Cas. 648, 654.

But in an account he treats the defendants, as it were, as his agents, and takes the profits they make. Hence, a patentee who has never attempted to put his invention into practice, would probably prefer an account, for he might have great difficulty otherwise in shewing what his profits would have been, whereas a manufacturing patentee, against a defendant who had only used the invention, might prefer damages.

At the same time, however, an account does not merely extend to the profits made by the infringer, it also includes any indirect savings or collateral profits, or advantages which he may have reaped: *Crossley* v. *Derby Gaslight Co.*, 1834, 3 M. & Cr. 428; *Household Co.* v. *Neilson*, 1843, 1 W. P. C. 697 n.; *Bacon* v. *Spottiswoode*, 1839, 1 Beav. 387.

Where the plaintiff is assignee, the account or damages would only run from the date of the assignment, unless the assignment were wide enough to cover all the patentee's past rights.

Acquiescence or delay is prejudicial to the demand

CH. XXVIII. SECT. 31.

Judgment for an account

for an account: *Crossley* v. *Derby Gaslight Co.*, 1834, 1 W. P. C. 120.

On the taking of an account, the defendants must disclose the profits made by them before the infringement for the purpose of comparison with those made afterwards, so that the difference may be estimated: *Siddell* v. *Vickers*, 1889, 6 R. P. C. 464, and this is the proper basis to take them upon: *ibid.* 1892, 9 R. P. C. 152.

The account is taken down to the last article sold or used by the defendant. In the case last cited, the Court of Appeal having heard, and by consent, having assessed the amount, ordered a lump sum of £3000 and costs to be paid to satisfy all claims.

32. Damages may be awarded, though not specifically claimed in the proceedings: *Betts* v. *Neilson*, 1868, 18 L. T. (N.S.) 159, and are measured by the loss consequent upon the defendant's acts: *United Horseshoe Co.* v. *Stewart*, 13 App. Cas. 413, 5 R. P. C. 260. Damages, if they cannot be assessed at the trial, are referred to an officer of the Court for inquiry: O. XXXVI, rr. 57, 58, and are taken down to the date of the assessment, and an enquiry will not be granted where the damage appears to be only trivial: *Dicks* v. *Brooks*, 1880, L. R. 15 Ch. D. 39; *United Telephone Co.* v. *Sharples*, 1885, 2 R. P. C. 28; *Cole* v. *Saqui*, 1888, 5 R. P. C. 489. If, by oversight at the trial, the plaintiff forgets to ask for damages, a subsequent application for them may be made: *Edison* v. *Holland*, 1888, 5 R. P. C. 483.

The royalties, usually reserved by the plaintiff, though not a conclusive measure of his damages, are evidence of it: *United Telephone Co.* v. *Walker*, 1886, 4 R. P. C. 64.

In certain old cases exemplary damages were given, but recent decisions have been entirely against the giving of exemplary or vindictive damage.

If a plaintiff has obtained judgment on admissions of infringement in the pleadings, his enquiry into damages can only go for the admitted infringements: *United Telephone Co.* v. *Donohoe*, 1886, 31 Ch. D. 399.

When the defendant only partly used the plaintiff's invention the measure of damages was held only to be a portion of the defendant's profits. *United Horseshoe Co.* v. *Stewart*, 1887, 4 R. P. C. 130; but this was reversed on appeal.

After an order has been made for an enquiry into damages, it is doubtful whether the plaintiff is entitled to have such an enquiry made by a jury. At all events, if he so desire it, he should apply at the trial, and not subsequently: *American Braided-Wire Co.* v. *Thomson*, 1888, 5 R. P. C. 696.

Acquiescence on the part of the plaintiff is evidence against his having sustained damage: *Smith* v. *Lond. & N. W. Rail. Co.*, 1853, M. P. C. 188.

33. Perpetual injunction.—An injunction will be granted to restrain the sale of all articles made in infringement of the patent, whether they are sold after the patent has expired or not: *Crossley* v *Beverley*, 1829, 1 W. P. C. 119, 1 R. & M. 166; *Crossley* v. *Derby Gaslight Co.*, 1834, 4 L. J. Ch. 25. *post*, p. 455.

The injunction impliedly depends on the patents continuing in force. If it were determined then quoad all articles made after that date, it would cease: *Daw* v. *Eley*, 1867, 3 Eq. 496.

Injunctions may be granted, "quia timet," where there

CH. XXVIII. SECT. 33.

Perpetual injunction.

is no actual infringement, but only a clear intention to infringe, as, for instance, where the defendants had made articles, similar to those patented, before the date of the acceptance of the complete specification, and announced their intention of going on doing so: *Frearson* v. *Loe*, 1878 L. R. 9 Ch. D. 48; *Dowling* v. *Billington*, 1890, 7 R. P. C. 208.

A defendant who has consented to an injunction by mistake or surprise may be allowed to withdraw such consent: *Elsas* v. *Williams*, 1884, 1 T. R. 144.

34. Disobedience to an injunction.—An order for an injunction is enforced by commitment, and this may be done as soon as the existence of the order for the injunction is served on the defendants or brought to their notice: *United Telephone Co.* v. *Dale*, 1884, 25 Ch. D. 778. But the evidence must be very strong and clear of the breach of the injunction: *Dick* v. *Haslam*, 1891, 8 R. P. C. 196. In order to obtain an order for commitment, the procedure must be very strictly followed, and attention paid to the special rules which exist as to the practice of obtaining commitment orders, non-observance of any of which will generally be fatal. It is not proposed to go through these rules in detail as they will all be found in the "Annual Practice," but attention may be called to the necessity of personal service, the necessity of serving a copy of the affidavits with the notice of motion and other kindred regulations.

Even when a defendant does not know that he has infringed, a commitment order might be made against him if in fact he has done so: *Plimpton* v. *Spiller*, 1876, 4 Ch. D. 287; *Thomson* v. *Moore*, 1889, 6 R. P. C. 445. Nor again need the act of infringement which is com-

Disobedience to an injunction.

plained of as a breach of the injunction be the same sort of infringement as caused the making of the order for the injunction: *Thomson* v. *Moore*, 1889, 6 R. P. C. 445; and *Plimpton* v. *Spiller*, 1876, 4 Ch. D. 285.

Mere selling of materials to perform the invention would not in general be an infringement of the injunction, unless it was done in such a way as to be really a colourable evasion, as, for instance, the selling of parts which merely required to be put together: see Chap. XXIV., sect. 18.

ante, p. 321.

Nor again is it any breach of an injunction to publish advertisements asking for subscriptions towards the expense of an appeal: *Plating Co.* v. *Farquharson*, 1883, 17 Ch. D. 49.

As a matter of practice, commitments rarely, if ever, take place; the defendant on promising not to repeat his offence, and to pay the costs of the motion, is generally absolved: *Edlin* v. *Pneumatic Tyre Agency*, 1893, 10 R. P. C. 317. But such costs are usually made as between solicitor and client: *Plating Co.* v. *Farquharson* 1883, 17 Ch. D. 49; *Steele* v. *Hutchinson*, 1879, W. N. 18, unless the infringement was committed in the *bonâ fide* belief that the injunction was not being broken, in which case only ordinary costs would generally be given: *Spencer* v. *Ancoats Vale Co.*, 1888, 6 R. P. C. 46.

If the defendant be a company, an attachment may be asked against any directors who have personally given orders for the commission of the breach of the injunction, and in addition a writ of sequestration may be demanded against the goods and chattels of the company: *Spencer* v. *Ancoats Vale Co.*, 1888, 6 R. P. C. 46.

Public necessity will justify the breaking of an injunction, as where a master of a ship uses a patent pump

CH. XXVIII. SECT. 34.

Disobedience to an injunction.

which he has been enjoined not to use, to extinguish a fire (semble, *per* L.J. James): *Adair* v. *Young*, 1879, 12 Ch. D. 21. This wise and reasonable expression of opinion seems to set at rest doubts which formerly prevailed upon such points as this. For it is narrated that a fire having broken out in the Temple, in the chambers of a barrister, his neighbours debated whether it would be a trespass to break in and enter his room to put it out. They could not resolve the point, and while they were debating it, his books were burned.

35. Delivering up of the infringing articles.—Where a number of the infringing articles exist they may be ordered to be ascertained and given up, and if they have been removed from the country after such order they must be brought back and surrendered: *Washburn Co.* v. *Patterson*, 1884, 1 R. P. C. 191. They are sometimes ordered to be marked by the plaintiff so as to prevent them from being sold: *Westinghouse* v. *Lancashire Rail. Co.*, 1884, 1 R. P. C. 253.

It must, however, be observed that this jurisdiction to order the articles to be given up so as to be marked or destroyed, does not affect the *property* in them, over which the Court has no power. Therefore the plaintiffs cannot sell them and retain the proceeds. But they may be ordered to be destroyed: *Vavasseur* v. *Krupp*, 1878, L. R. 9 Ch. D. 351, and in order that such an order may be made, it is necessary (as it affects the goods) that the owner of them should be cited before the Court (*ibid.* 360).

36. Discovery in aid of execution is given by S. C. R., O. XXXIII. and XLII. Under the powers thus

conferred a defendant may be compelled to file an affidavit showing what goods he has made or sold and the names and addresses of the purchasers: *Murray* v. *Clayton*, 1872, L. R. 15 Eq. 115; and he may also be ordered to produce his books and documents: *American Braided Wire Co.* v. *Thompson*, 1888, 5 R. P. C. 375; *Saxby* v. *Easterbrook*, 1872, L. R. 7 Ex. 207.

37. Stay of execution.—This can be granted by R. S. C., O. LVIII., r. 16, and is sometimes done pending an appeal: *Hocking* v. *Fraser*, 1886 (on terms of appealing in fourteen days and keeping an account), 3 R. P. C. 7; *Woodward* v. *Sansum*, 1886 (on terms of appealing promptly), 3 R. P. C. 366; *Kaye* v. *Chubb*, 1887, 4 R. P. C. 23; *Nordenfelt* v. *Gardner*, 1884, 1 R. P. C. 63. In *Humpherson* v. *Sayer*, 1887, 4 R. P. C. 184, a stay was refused, pending an appeal, but a stay of the taking of the account was allowed. Kekewich, J., commenting on *Hocking* v. *Fraser* and *Kaye* v. *Chubb*, said he considered that the orders in those cases had been made by consent.

In the case of *Otto* v. *Steel*, a motion was made subsequently to the judgment for a stay pending an appeal, of the taking of an account, and of the injunction, on the ground of the irreparable injury that would be done to the defendant by the disclosure of the names of his customers. Pearson, J., refused the application. On appeal, and application to the Court of Appeal to advance the hearing day, the Court of Appeal refused the application, saying that if it were allowed, a stay would have to be granted in every case: 1886, 3 R. P. C 120; and see *Edge* v. *Johnson*, 1892, 9 R. P. C. 142. In *Thomson* v. *Moore*, 1889, 6 R. P. C. 426, a stay of an order for attachment for disobedience to an injunction

CH. XXVIII. SECT. 37.

Stay of execution.

was ordered upon certain terms pending an appeal (see p. 464).

38. Certificate of validity of the patent.—By the Patents Act, 1835, s. 3, when a patentee in an action had obtained a certificate that the validity of his patent had been in question, he was entitled to treble costs in subsequent actions (unless the judge certified to the contrary). Treble costs are now abolished, but after such a certificate he may now get "his full costs," charges, and expenses as between solicitor and client: Patents Act, 1883, s. 31.

post, p. 455.

In *United Telephone Co.* v. *Patterson* these costs were given, although in that case the defendant had not again questioned the validity of the patent, but only denied infringement: 1889, 6 R. P. C. 140; *Davenport* v. *Rylands*, 1865, L. R. 1 Eq. 302, 35 L. J. Ch. 204.

In an earlier case, however, where the validity was attacked on different grounds to those on which it had been considered valid in the first action, the extra costs were refused: *Otto* v. *Steel*, 1886, 3 R. P. C. 120.

The certificate may be asked for by the plaintiff whether he has or has not been successful: *Haslam* v. *Hall*, 1887, 5 R. P. C. 27; and see *Automatic Machine Co.* v. *Knight*, 1889, where the certificate was given, though the plaintiff lost the action by failing to prove infringement: 6 R. P. C. 120; and see p. 129, where, in a second action on the same patent, the higher costs were refused on the ground that when the second action was tried, the first (in which the certificate had been granted) was already on the paper for trial.

From the form of the statute, when a certificate has

Certificate of validity of the patent.

been given, the higher costs follow unless otherwise ordered, so that great care must be taken to ask for them to be disallowed.

The second action must, however, be commenced after the date of the certificate in the prior action, in order that the rule may apply: *Automatic Weighing Machine Co.* v. *International Hygienic Society*, 1889, 6 R. P. C. 480, and see the decision at 6 R. P. C. 120, cited supra.

The certificate may be granted in an undefended action: *Haydock* v. *Bradbury*, 1887, 4 R. P. C. 75, but secus, *Peroni* v. *Hudson*, 1884, 1 R. P. C. 263; and see *Ball* v. *Lelm*, 1881, Times, April 14th, and *Stocker* v. *Rodgers*, 1843, 1 C. & K. 99. The certificate may be granted where the action has been compromised and judgment given by consent: *Delta Metal Co.* v. *Macim Nordenfelt*, 1891, 8 R. P. C. 248.

The certificate is not granted more than once: *Edison* v. *Holland*, 1889, 6 R. P. C. 287, except when the attack on the validity of the patent proceeds on different grounds from those on which it was made in the first, in which case a certificate of validity may be given as regards some particular claim: *Otto* v. *Steel*, 1886, 3 R. P. C. 120.

Where there has been a previous action, and a certificate of the question of validity given, it is more prudent to put a claim founded on it into the statement of claim in the second action, so as to give the defendant warning that such costs will be demanded if he proceeds. On the other hand, in *Newall* v. *Wilkins*, 1851, 17 L. T. 20, in a jury case, it was considered that such prior trial ought not to be put in evidence so as to prejudice the defendant's case, but ought to be proved after the verdict. It is hence no flaw in pleading not to plead it,

CH. XXVIII. SECT. 38.

Certificate of validity of the patent.

but not to have done so might be considered unfair, if thereby the defendant had been kept in ignorance of the fact.

No appeal lies from the grant or refusal of a certificate of validity: *Haslam* v. *Hall*, 1888, 20 Q. B. D. 491; 5 R. P. C. 144.

39. Costs.—In general only two counsel are allowed, and it will be very exceptional that the costs of three counsel are allowed on taxation: *Betts* v. *Clifford*, 1860, 1 J. & H. 74; *Betts* v. *Cleaver*, 1872, L. R. 7 Ch. 513; *Smith* v. *Buller*, 1875, L. R. 19 Eq. 473. The fee allowed is from £5 5s. to £7 7s. a day (*ibid*).

Charges "for luxuries" are not allowed, as for instance, drawings on margin of counsel's briefs; or a solicitor's clerk in addition to a solicitor (*ibid*).

Costs of scientific witnesses will be allowed in moderation, and also costs of models in proper cases: *Batley* v. *Kynoch*, 1875, L. R. 20 Eq. 632.

The ignorance of a defendant as to the existence of a patent, and his offer to submit will affect costs: *Nunn* v. *D'Albuquerque*, 1865, 34 Beav. 595. Where a retail dealer had sold articles which unwittingly infringed the plaintiff's patent, and on being informed, gave every information, and promised not to do so again, it was held that plaintiff was not entitled to the costs of the action: *Betts* v. *Willmot*, 1870, 18 W. R. 946, L. R. 6 Ch. 239; *Nunn* v. *D'Albuquerque*, 1865, 34 Beav. 595; *Upman* v. *Elkan*, L. R. 7 Ch. App. 130.

In a case where a defendant had infringed, but discontinued his infringement before action, and offered to pay reasonable damages, but the plaintiff persisted in his action, the Court considered his action vexatious, and

Costs.

made him pay the defendant's costs: *Fletcher* v. *Glasgow Gas Co.*, 1887, 4 R. P. C. 386.

As a rule, however, a successful plaintiff who has conducted his action fairly, and not been guilty of any misconduct, is entitled to his costs: *Cooper* v. *Whittingham*, L. R. 15, Ch. D. 501; *Upman* v. *Forrister*, 1883, 24 Ch. D. 231; *Burgess* v. *Hateley*, 1858, 26 Beav. 249; *Fradella* v. *Weller*, 1828, 2 Russ. & M. 247; *Colburn* v. *Sims*, 1843, 2 Hare, 543.

In *Upman* v. *Forrister* (a trade-mark case), Chitty, J., held that a plaintiff was not always bound to give notice to the defendant before commencing his action, if there were a fear of his making away with the spurious articles, and that hence the want of such notice was by no means fatal to costs; 1883, 24 Ch. D. 231.

40. Costs of separate issues as a rule follow the event: R. S. C. 1883, O. LXV. r. 2. This apportionment may be made in patent actions in either of two ways, by dividing the issues, and ordering the costs of each to be separately dealt with, or else by giving a certificate of particulars, under the Patents Act, 1883, s. 29, sub-s. 6. If no order about costs is made, the successful party will get the costs of the action, but, as will be seen below, neither would get the costs of proving his particulars.

post, p. 455.

The result of this is, that in patent actions the duty of considering the issues and deciding who is to bear the cost of them, will in every case fall on the Court, and that a successful party may either ask to have a certificate of particulars, or else for an apportionment of costs, under O. LXV. r. 2.

41. Certificate of particulars of breaches and

CH. XXVIII. SECT. 41.

Certificate of particulars of breaches and objections.

objections.—In the Patents Act, 1835, provisions were made for the costs of issues, on which the plaintiff had not succeeded.

The Patents Act, 1852, went further, and required a successful plaintiff or defendant to obtain a certificate of the particulars from the judge.

post, p. 455.

By the Patents Act, 1883, s. 29, sub-s. 6, it is provided that no plaintiff or defendant shall be allowed costs in respect of any particulars, unless the same are certified by the Court or a judge, to have been proven, or else to have been reasonable and proper.

It was at one time doubted whether these words, "the Court or a judge," included the judge of the Court of the Duchy of Lancaster (*per* Day, J.): *Proctor* v. *Sutton Lodge Co.*, 1888, 5 R. P. C. 184; but see *Heyes* v. *Hallmark*, 1892, 9 R. P. C. 27; *Ashworth* v. *Law*, 1892, 9 R. P. C. 194: and the opinion of Brett, L.J., in *R.* v. *C. C. of Halifax*, 1891, 8 R. P. C. 344; and see 53 & 54 Vict., c. 23, 1890, which now gives it the full powers of a Court of Chancery.

The Court of Appeal can also give a certificate, and will do so, where it reverses the decision of the Court below: *Cole* v. *Saqui*, 1889, 6 R. P. C. 41; but it will not on appeal re-try an issue which is not material to its judgment, merely in order to decide whether or no to grant the certificate: *Boyd* v. *Horrocks*, 1886, 6 R. P. C. 162. Approved in *Longbottom* v. *Shaw*, 1888, 6 R. P. C. 147, 510: *Kaye* v. *Chubb* (*post*, p. 298).

A certificate of objections cannot be given unless a trial has taken place (*per* Bristowe, V.-C. of Lancaster): *Rothwell* v. *King*, 1887, 4 R. P. C. 399. If, however, by mistake omission was made to ask it at the trial, it may be asked for subsequently, but no costs of the motion

Certificate of particulars of breaches and objections.

will be granted (*per* Bristowe, V.-C.): *Roucliffe* v. *Morris*, 1886, 3 R. P. C. 145. As a general rule, certificates are not given in respect of particulars which have not been proved: *Billington* v. *Hill*, 1891, 8 R. P. C. 332; and see next section.

42. Apportionment of costs.—The apportionment of costs depends upon the facts of each case, and the conduct of the parties, but as a general rule, the costs of the issues are severed, and made, so far as is possible, to follow the event.

The Court sometimes certifies for particulars, under Patents Act, 1883. s. 29, sub-s. 6; sometimes gives directions as to the costs of issues: under O. LXV. r. 2. The following cases are examples: *Wegman* v. *Corcoran*, 1878, 27 W. R. 357, 362; *Simmonds* v. *Hitchman*, 1881, 29 Ch. D. 417 n; *United Telephone Co.* v. *Harrison*, 1882, 21 Ch. D. 747;—where a certificate for particulars of breaches was refused, because, though the infringement was proved, the patent was held bad.

post, p. 455.

Young v. *Rosenthal*, 1884, 1 R. P. C. 29, 41.—Plaintiffs proved infringement, but failed as to novelty and utility. Certificate of breaches for plaintiff, but only as to cost of delivering them, and subpœnaing witnesses, defendants entitled to certificate for part of their particulars of objections.

Needham v. *Johnson*, 1884, 1 R. P. C. 49, 59.—The Court below had found for the plaintiffs with costs. On appeal the Court of Appeal found no infringement, they gave the defendants the general costs of the action, with no costs on either side on the issues of novelty.

Nordenfelt v. *Gardner*, 1884, 1 R. P. C. 61.—Judgment for plaintiff; on appeal held no infringement.

CH. XXVIII. SECT. 42.

Apportionment of costs.

Examples of cases.

Costs to be defendant's, but plaintiff to have costs on issue of novelty.

Westinghouse v. *Lancashire Rail. Co.*, 1884, 1 R. P. C. 229, 253.—Where a trial had been by jury, the Court of Appeal directed the costs to be according to the findings.

Badische Anilin Fabrik v. *Levinstein*, 1885, 29 Ch. D. 366.—A patentee proved infringement, but his patent was proved invalid. Held that the plaintiff must pay the general costs of the action, but that the defendant must pay costs on the issue of infringement. (A collection of cases will be found in the argument.)

Pooley v. *Pointon*, 1885, 2 R. P. C. 167.—Plaintiff to have costs of Nos. 1 and 2, particulars of objections; defendant, of Nos. 3, 5, 6. No order as to 4.

Lawrence v. *Perry*, 1885, 2 R. P. C. 179.—Certificate refused as to all the alleged anticipating specifications which had not been actually put in, and out of these, certificate given for 8.

Laurie v. *Baker*, 1885, 2 R. P. C. 213.—Defendant held not to have infringed, but to be liable for nominal damages, for passing off his goods as the plaintiff's, plaintiff to have general costs of action, but costs on issue of infringement to be defendant's.

Sugg v. *Bray*, 1885, 2 R. P. C. 248.—Each party ordered to pay his own costs.

Hocking v. *Fraser*, 1885, 3 R. P. C. 7.— Costs apportioned where plaintiff succeeded on one patent, but offered no evidence on the other.

Edison v. *Woodhouse*, 1886, 3 R. P. C. 167.—Plaintiff sued on three patents; as to two of them there was no evidence of infringement. Defendant held entitled to costs occasioned by plaintiff's including them.

Guilbert-Martin v. *Kerr*, 1886, 4 R. P. C. 23.—Where

Apportionment of costs. Examples of cases.

a patent was held invalid; Kekewich, J., gave defendants who had pleaded invalidity, want of utility, and no infringement, all the costs, on the ground that the issues could not be distinguished sufficiently to apportion them.

Kaye v. *Chubb*, 1887, 4 R. P. C. 300, 302.—Defendant's appeal allowed, and certificate of objections given by Court of Appeal.

American Braided Wire Co. v. *Thompson*, 1887, 4 R. P. C. 322.—Defendants, though successful in action, ordered to pay costs of particulars of objections which they had not raised. (Judgment reversed on appeal.)

Blakey v. *Latham*, 1888, W. N. p. 126, 6 R. P. C. 38, 186, 190.—The Court found infringement, but that patent was invalid. They refused to apportion the costs of the issue of infringement in plaintiff's favour.

Badham v. *Bird*, 1888, 5 R. P. C. 238.—Defendants put to plaintiff an anticipation which at once broke down his case. Their certificate of objections was limited to what was put to plaintiff on cross-examination.

Blank v. *Footman*, 1888, 5 R. P. C. 661.—"As a rule costs of issues ought to follow the event." General costs of action ought to follow the event in spite of some of the issues being found against the successful party (*per* Kekewich, J.).

Edison v. *Holland*, 1888, 5 R. P. C. 483.—Certificate that objections were reasonable and proper. (Judgment reversed on appeal.)

43. Costs on the higher scale are sometimes allowed in cases of special difficulty: R. S. C., O. LXV. r. 9. Thus in *Ellington* v. *Clark*, the Court of Appeal considered that inasmuch as the plaintiffs had brought

Ch. XXVIII. sect. 43.

Costs on the higher scale.

scientific witnesses, and thus forced the defendants also to bring scientific witnesses, the successful defendants should have costs on the higher scale: 1888, 5 R. P. C. 328; see also *Moseley* v. *Victoria Rubber Co.*, 1887, 4 R. P. C. 241, 57 L. T. (N.S.) 148; *Wenham* v. *May*, 1887, 4 R. P. C. 310; *Kaye* v. *Chubb*, 1887, 4 R. P. C. 303; *Kurtz* v. *Spence*, 1887, 5 R. P. C. 184; *Westinghouse* v. *Lancashire Rail Co.*, 1884, 1 R. P. C. 103; *Easterbrook* v. *G. W. R. Co.*, 1885. 2 R. P. C. 212; *Watling* v. *Stevens*, 1886, 3 R. P. C. 43; *Otto* v. *Steel*, 1886, 3 R. P. C. 120; *Davies* v. *Davies*, 1887, 56 L. J. Ch. 481; *Farben Fabrik* v. *Bowker*, 1891, 8 R. P. C. 397.

The special grounds must rest not merely on the importance of the case, but on the necessity for special expense: *Grafton* v. *Watson*, 1884, 51 L. T. (N.S.) 141; *American Braided Wire Co.* v. *Thompson*, 1890, 7 R. P. C. 163. In *Crampton* v. *Patent Investments Co.*, 1888, 5 R.P.C. 382, the consideration of an application for costs on the higher scale was postponed till after taxation on the lower scale had been made. In *Fraser* v. *Brescia Tram. Co.*, 1887, 56 L. T. (N.S.) 771, 3 Times' Rep. 587, permission was given to the master to give all or any part of the costs which he thought fit, on the higher scale.

Where, however, the necessity for specially expert evidence arose from the dubious wording of the plaintiffs' specification, costs on the higher scale were refused to him: *Wenham Gas Co.* v. *Champion Gas Co.*, 1891, 8 R. P. C. 315. In *Siemens* v. *Taylor*, 1892, 9 R. P. C. 401, costs on the higher scale were refused.

CHAPTER XXIX.

ACTIONS FOR THREATS.

1. Old practice.—Actions for damages and injunction to restrain threats were not unknown before the Patents Act of 1883: see *Wren* v. *Wield*, 1869, L. R. 4 Q. B. 730; *Dalziel* v. *Railway Carriage Co.*, cited, L. R. 13 Eq. 358; *Rollins* v. *Hinks*, 1872, L. R. 13 Eq. 355, 41 L. J. Ch. 358; *Axman* v. *Lund*, 1874, L. R. 18 Eq. 330; *Halsey* v. *Brotherhood*, 1881, 19 Ch. D. 386; *Burnet* v. *Tak*, 1882, 45 L. T. 743; *Sugg* v. *Bray*, 1886, 1 R. P. C. 45, 2 R. P. C. 223: *Société Anonyme des Glaces* v. *Tilghman's Sand Blast Co.*, 1883, 25 Ch. D. 1, 53 L. J. Ch. 1; *Sharp* v. *Brauer*, 1884, 3 R. P. C. 193.

Actions founded upon threats made before the Act of 1883 proceeded under the old practice. The principles of the old law were, that in order to succeed in the action, the plaintiff must show (1) that the threats were uttered in bad faith, and (2) that he had not infringed. The validity of the patent was assumed, and not allowed to be questioned in such an action.

2. Modern practice.—The law relating to threats is now governed by the Patents Act, 1883, s. 32, and provides that an action for damages or an injunction may be brought by any one aggrieved by the threats, provided (1) that the alleged manufacture or use to which

post, p. 456.

CH. XXIX. SECT. 2.

Modern practice.

such threat refers is not an infringement of any legal right of the person making the threat, and (2) that the said person making the threat does not with due diligence commence and prosecute an action for infringement. To say of a person that his patent has been proved to be an infringement is libellous, and an action of libel will lie for it: *Crampton* v. *Swete*, 1886, 58 L. T. 516.

3. What constitutes a threat.—A threat may be directed not only against something which is going to be done, but against something which has been done, and either will give rise to an action: *Challender* v. *Royle*, 1887, 36 Ch. D. 427, 4 R. P. C. 363, or it may be directed against the continuance of something which has been done: *Kurtz* v. *Spence*, 1887, 5 R. P. C. 171. The words "otherwise" in section 32 cover any sort of threat, whether by circulars or by letters directed to the infringer: *Crampton* v. *Patent Investments Co.*, 1888, 5 R. P. C. 393; *Walker* v. *Clarke*, 1887, 4 R. P. C. 113; *Driffield* v. *Waterloo*, 1886, 3 R. P. C. 46, 31 Ch. D. 638; *Automatic Weighing Machine Co.* v. *Combined Weighing Machine Co.*, 1889, 6 R. P. C. 367; *Burt* v. *Morgan*, 1887, 4 R. P. C. 278; *Colley* v. *Hart*, 1888, 6 R. P. C. 18.

If the threats are addressed to the customers of the plaintiff, he is a person aggrieved, or if the threats are addressed to the customers of his licensees he is aggrieved and can sue: *Burt* v. *Morgan*, 1887, 4 R. P. C. 278; *Kensington Co.* v. *Lane Fox Co.*, 1891, 8 R. P. C. 277. General threats may give rise to an action on the part of the person aggrieved by them: *Johnson* v. *Edge*, 1892, 9 R. P. C. 142; *Challender* v. *Royle*, 1887, 4 R. P. C. 363, explained in *Day* v. *Foster*, 1890, 7 R. P. C. 54. In *Skinner & Co.* v. *Perry*, a letter by a patentee saying in

answer to enquiries, that he considered a certain machine an infringement of his patent, and would stop it, was held to be a threat: 1892, 9 R. P. C. 406, 10 R. P. C. 1.

Any person who by his threats "claims" to be entitled to a patent, may be proceeded against, whether he is really so entitled or not; and as a person who has claimed, but really has no patent rights, cannot protect himself by bringing a patent action, nor by shewing that the article complained of is an infringement, such person is in a very awkward position: see *Kensington Co.* v. *Lane Fox Co.*, 1891, 8 R. P. C. 277.

4. What issues may be raised in an action for threats.—In an action of threats the plaintiff may deny that he has infringed, and may deny the validity of the patent: *Challender* v. *Royle*, 1887, 4 R. P. C. 363; *Kurtz* v. *Spence*, 1888, 5 R. P. C. 161, in which the plaintiff maintained that the defendant was not the first and true inventor. The plaintiff will have to give particulars of objections exactly as the defendant would be obliged to do in an infringement action: *Union Electrical Power Co.* v. *Electrical Power Storage Co.*, 1888, 5 R. P. C. 329; *Law* v. *Ashworth*, 1890, 7 R. P. C. 86 (Duchy of Lancaster Court case). The defendant will have to give particulars of the patents on which he relied in issuing his threats: *Union Electrical Power Co.* v. *Electrical Power Storage Co.* (supra). A certificate that the validity of the patent came in question may be granted: *Crampton* v. *Patents Investments Co.*, 1888, 5 R. P. C. 382. The burden of proof of infringement is on the defendant: *Ungar* v. *Sugg*, 1889, 6 R. P. C. 337.

5. Interim injunction to restrain threats.—The

CH. XXIX. SECT. 5.

Interim injunction to restrain threats.

applicant must show a *primâ facie* case of non-infringement: *Challender* v. *Royle* (*per* Bowen, L.J.), 1887, 4 R. P. C. 376; *Barney* v. *United Telephone Co.*, 1885, 2 R. P. C. 173, 28 Ch. D. 394; *Colley* v. *Hart*, 1889, 6 R. P. C. 20; *Walker* v. *Clarke*, 1887, 4 R. P. C. 111, must now be considered doubtful law as to part of the dicta contained in it. The application should not be made *ex parte*; *Wilson* v. *Church Engineering Co.*, 1885, 2 R. P. C. 175. Plaintiff commenced an action to restrain threats, and defendant commenced an action for infringement. Plaintiff moved to restrain the threats, but no order was made, defendant to proceed with diligence and not threaten in the meantime: *Mackie* v. *Solvo Laundry Co.*, 1892, 9 R. P. C. 465.

The bringing of an infringement action as a justification of the threats.—The action which, if brought promptly, will protect the utterer of the threats from an action against him, need not necessarily be against the person threatened, but against any one who may have infringed the patent: *Challender* v. *Royle*, 1887, 4 R. P. C. 375; *Day* v. *Foster*, 1890, 7 R. P. C. 60; nor need such action, if brought *bonâ fide*, necessarily be successful, to protect the person making the threats: *Colley* v. *Hart*, 1890, 7 R. P. C. 101, 44 Ch. D. 179; *Brauer* v. *Sharpe*, 1886, 3 R. P. C. 193.

It must be commenced and prosecuted *bonâ fide*, and with due diligence. Thus, where it was only begun a year after the threat, this was held not enough: *Herburger* v. *Squire*, 1889, 5 R. P. C. 589; but see *Edlin* v. *Pneumatic Tyre Agency*, 1893, 10 R. P. C. 311. The action must be brought substantially for the same infringement as that in respect of which the threats were made: *Automatic Weighing Machine Co.* v. *Combined Weighing Machine Co.*,

Interim injunction to restrain threats.

1889, 6 R. P. C. 367. Sometimes the hearing of the motion for an injunction for threats is postponed till the trial of the action for infringement: *Barnett* v. *Barretts Co.*, 1884, 1 R. P. C. 10.

6. Damages for threats were not given where no real stoppage of works occurred in consequence: *Driffield Co.* v. *Waterloo Co.*, 1886, 3 R. P. C. 46. In *Kurtz* v. *Spence*, 1887, 5 R. P. C. 161, forty shillings damages were given. The question of damages for threats ought to be tried by the Court on hearing of the action, and not referred: *Ungar* v. *Sugg*, 1892, 9 R. P. C. 115, and *Herrburger* v. *Squire*, 1888, 5 R. P. C. 596, 6 R. P. C. 194 (in which also an injunction was granted).

7. Issuing warning circulars. — Even, however, where a plaintiff is suing for infringement, and thus protected from the consequences of uttering threats, under the Patents Act, he is still not at liberty to issue circulars warning the public against using the defendant's goods, for there is a general jurisdiction in the Court to protect the fair trial of the action, and to keep all rights intact till it can be decided. Each case must be considered on its own footing, for it is one thing to warn against the commission of infringements, but another thing to assert that infringements have taken place: *Goulard* v. *Lindsay*, 1887, 4 R. P. C. 189; *Fusee Vesta Co.* v. *Bryant & May*, 1887, 4 R. P. C. 191. But where there is no *mala fides* the defendants to an action for threats may, if they continue to prosecute their proceedings for infringement with vigour, go on issuing their circulars—for in this case there is really no statutory case against them—and the only remedy would be by an

Issuing warning circulars.

interlocutory application by the defendant in the patent suit, on the ground that the action against him was being prejudiced: *Household* v. *Fairburn*, 1884, 2 R. P. C. 140; and injunctions on this ground ought not to be lightly granted: *Fenner* v. *Wilson*, 1893, 10 R. P. C. 287.

CHAPTER XXX.

PROCEDURE FOR REVOCATION OF THE PATENT.

1. Old method.—The old method of revoking a patent was by *scire facias*, on suggestion that the Queen had been deceived. This made the patent utterly void: Chap. XVII., sect. 1.

ante, p. 258.

The writ of *scire facias* issued out of the Petty Bag Office of the Court of Chancery directed to the sheriff of the county where the defendant dwelt, commanding him to "give notice" (*scire facias*) to the patentee that the Queen had been informed that his patent was invalid, and requiring him to come into Court to shew why it should not be cancelled. As soon as the writ had been served, and the patentee was "in Court," the Attorney-General on behalf of the Queen filed a declaration against him, to which he pleaded, and when all the issues where joined, a writ of *venire facias* was issued to summon a jury returnable in the Queen's Bench. The trial having taken place the verdicts were returned into the Chancery, and if the verdict was against the patentee, the patent was ordered to be brought in to be cancelled, which could be enforced by attachment. As the proceedings on *scire facias* were between the Crown and the subject, no costs could be given on either side, the patentee could not plead double; in fact, the proceedings all bore the stamp of a suit in which the

CHAP. XXX. SECT. 1. — Old method.

Crown was prosecutor. The party who set the proceedings on foot, had to give a bond to secure the payment of costs to the patentee, if the patent were upheld, but if the patent were cancelled the petitioner got no costs.

The Patent Act, 1883, substituted proceedings by way of petitions for revocation. In them, interrogations can be administered and discovery had; in fact the petition resembles an action, though perhaps it is a moot point whether on such proceedings estoppel arising from a previous trial between the same parties could be set up.

2. New procedure.—The proceedings by *scire facias* are now abolished and proceedings for revocation are substituted, which may be presented in all cases in which *scire facias* would have lain: Patents Act, 1883, sect. 26, 109 (Scotland); except where the patent is assigned to the Secretary of State for War: sect. 44, sub-s. 3, 9.

post, p. 452.

A petition may be presented by the Attorney-General or by any one authorized by him, or by any one alleging that the patent was obtained in fraud of his rights, or that he was the true inventor, or that he had previously publicly used the invention.

3. Attorney-General's fiat.—This is obtained by sending to Room No. 519, Royal Courts of Justice, the following documents:—

(1.) Memorial to the A.-G. asking for his authority and stating all the circumstances.

(2.) Statutory declaration verifying the statements in the memorial.

(3.) Two copies of the proposed petition and of the

particulars proposed to be delivered with it under sect. 26 (5).

(4.) Certificate of a barrister that the petition is proper to be authorized by the A.-G. — Attorney-General's fiat

(5.) Certificate by a solicitor that the proposed petitioner is a proper person to be a petitioner, and that he is competent to answer the costs of all proceedings in connection with the petition if unsuccessful.

The Attorney-General may grant leave *ex parte*, or else may direct the patentee to appear before him. The fiat has been granted without notice to the patentees: *Goulard & Gibbs' Patent*, 1887, Griff. 320.

The grounds of such an application to the Attorney-General may be, that the person who desires to petition has made an invention which the respondent has claimed as embraced in his patent: *Ferranti's Application (Goulard & Gibbs' Patent)*, Griff. 320, 5 R. P. C. 529, 6 R. P. C. 215. A fiat was granted on a similar ground to *King's Trustees*, against whom *Rothwell* had commenced an action which was abandoned: 1886, Griff. 320, 3 R. P. C. 379, 4 R. P. C. 76, 397. The fiat was refused where an action was pending in Scotland: *Bell & Coleman's Patent*, Griff. 320. The fiat was refused in *Siddell's Case* upon the patentee undertaking to bring an action: Griff. 320. Where the application is abandoned, there is no power to give costs: *Martin's Patent*, Griff. 320.

No costs can be given on such application, though by consent they may be made costs in the cause: Griff. 320.

4. Locus of petitioner who has not obtained the Attorney-General's fiat.—This is regulated by Patents Act, 1883, sect. 26, sub-s. 4. *post*, p. 153.

CHAP. XXX. SECT. 4.

Locus of petitioner who has not obtained the Attorney-General's fiat.

post, p. 456.

(*a.*) **Patent obtained in fraud of another:** *Edge* v. *Harrison*, 1891, 8 R. P. C. 74. A certain Mrs. Edge, who happened to be in the employ of a patentee of the same name, took out, in conjunction with the patentee's foreman, Harrison, a patent for a wrapper for blue dye, and then with Harrison proceeded to sell dye wrapped up in the wrapper under the name of "Edge's Blue." A petition was lodged for revocation of the patent, and an action of fraud brought against Harrison. The action and petition came on for hearing before a jury who found a verdict for £500 damages, and the patent was revoked. See also *Gale's Patent*, 1891, 8 R. P. C. 438.

(*b.*) **First and true inventor.**—A person to whom a patent had been granted petitioned for the revocation of a patent subsequently granted to another, on the ground that he was the first and true inventor. This was held to give him a good locus, but the inventions were considered different; so his petition failed: *Walker* v. *Hydro-Carbon Syndicate*, 1884, 2 R. P. C. 3; *Gale's Patent*, 1891, 8 R. P. C. 439.

(*c.*) **Any one who has publicly used the invention prior to the date of the patent may present a petition for its revocation:** *Haddan's Patent*, 1885, 2 R. P. C. 218; *Morgan's Patent*, 1888, 5 R. P. C. 186; *Edmond's Patent*, 1889, 6 R. P. C. 355.

5. When once a petitioner has a locus, he may impeach the patent on any ground: *Morgan's Patent*, 1888, 5 R. P. C. 186. A petition for revocation may be ordered to be tried at the same time as an action for infringement: *Edge's Patent*, 1890, W. N. 149.

6. A petition for revocation is in reality precisely analogous to a defence to an action for infringement:

Goulard & Gibbs' patent, 1887, 34 Ch. D. 396. Hence interrogatories may be allowed: *Haddan's Patent*, 1885, 54 L. J. Ch. 126; and query whether the writ may be served out of the jurisdiction on a Scotchman resident in Scotland: *Drummond's Patent*, 1889, 6 R. P. C. 576, 43 Ch. D. 80.

A petition for revocation is in reality precisely analogous to a defence to an action for infringement.

7. Particulars of objections must be delivered with the petition: Patents Act, 1883, sect. 26, sub-s. 5; which may by leave be amended: ss. 6. For forms of such particulars, see 2 R. P. C. 219, 3 R. P. C. 356. No certificate of particulars under sect. 29, ss. 6, can be given on a petition for revocation: *Goulard & Gibbs' Patent*, 1888, 5 R. P. C. 526; hence it is to be presumed that a successful party would get his costs without such certificate. But costs of issues might no doubt be apportioned under the Supreme Court rules, which would come to the same thing as a certificate.

post, p. 453.

8. The defendant begins on a petition for revocation: Patents Act, 1883, sect. 26, sub-s. 7.

post, p. 453.

9. On the order for revocation being made, a copy of it must be left at the Patents Office: P. R., 1890, r. 74.

post, p. 497.

10. On revocation for fraud, the comptroller may, on the application of the true inventor, grant a patent to him of co-ordinate date and term with that revoked.—Patents Act, 1883, sect. 26, sub-s. 8. All parties interested in the patent should be joined as defendants. *Re Avery's Patent*, 1887, 4 R. P. C. 159.

CHAPTER XXXI.

APPEALS.

CHAP. XXXI. SECT. 1.

1. Appeals are now by way of re-hearing: R. S. C., 1883, O. LVIII., r. 1. If the respondent is also dissatisfied with the judgment or order, he should give notice of a cross appeal: *ibid.* r. 6. Security for costs of appeal is ordered in case of bankruptcy: *United Telephone Co.* v. *Bassano*, 1886, 31 Ch. D. 630; and if such security is not given, the appeal may, after a reasonable period (say three months), be dismissed: *Washburn Co.* v. *Patterson*, 1885, 2 R. P. C. 27, 29 Ch. D. 48.

The Court of Appeal may either order a new trial or re-try the case themselves: R. S. C., O. LVIII., rr. 4, 5; and may call in an assessor.

ante, p. 454.

2. The Court of Appeal may receive further evidence, but only by special leave, and on special grounds: R. S. C., O. LVIII., r. 4; and they may do so upon appeals from interlocutory orders and *inter alia* on motions for interim injunctions, sequestrations, and attachments: *Spencer* v. *Ancoats Vale Co.*, 1888, 6 R. P. C. 54. The usual test which applies in such a case is whether the party asking to adduce fresh evidence could, with reasonable diligence, have obtained it at the trial; if so,

The Court of Appeal may receive further evidence, but only by special leave.

he will in general not be allowed to bring it forward on appeal: *Hinde* v. *Osborne*, 1885, 2 R. P. C. 47.

Walker v. *Hydro-Carbon Syndicate*, 1886, 3 R. P. C. 253:—A petition was presented for revocation on the ground of a prior patent granted to the petitioner for the same invention. At the trial the respondents produced a patent to one Wise, which they contended rendered the petitioner's patent invalid. The petitioner, being defeated, appealed, and on the appeal applied to adduce further evidence on the ground that he was surprised by the production of Wise's patent. But this was refused, as it was shewn that *before the hearing* he had been cross-examined as to Wise's patent on an examination before an examiner, and therefore he knew of it, and ought to have come prepared with his evidence.

Blakey v. *Latham*, 1889, 6 R. P. C. 186: Where it was alleged that two witnesses had sworn falsely in the court below, the C.-A. allowed them to be re-summoned.

American Braided Wire Co. v. *Thomson*, 1888, 5 R. P. C. 113: Further evidence was admitted on the ground that defendants had been misled by the opening of the plaintiffs' case. In *Nordenfeldt* v. *Gardner*, where a plaintiff had made one omission in a chain of assignments, this would in the Court of Appeal have been allowed to be corrected had the objection been insisted on: 1884, 1 R. P. C. 61.

The application to hear further evidence should be made in time, and where an appellant only produced on the second day of the appeal an affidavit that the facts had not been previously known to him, it was held that his application was too late: *Watling* v. *Stevens*, 1886, 3 R. P. C. 150.

Where the judge below is believed to have deterred

CHAP. XXXI. SECT. 2.

a party from adducing evidence, the C. A. will allow his recall: *Britain* v. *Hirsch*, 1888, 5 R. P. C. 226.

The Court of Appeal may receive further evidence, but only by special leave.

3. The judge's notes in the Court below must be ready, and it is the duty of the appellants to get a copy of them and lodge it. The notes of counsel may be referred to, and also the notes of a regular professional shorthand writer, if verified; but notes even in shorthand made by a solicitor's clerk would not be permitted to be referred to: *Ellington* v. *Clark*, 1888, 5 R. P. C. 322. The Court of Appeal as a rule requires that reports cited before it should have been taken by barristers as a guarantee that the legal questions are properly stated.

If the judge's notes are not ready, the case may be ordered to stand over at the appellant's expense.

4. Costs on appeals.—On appeal, costs generally follow success; but an appellant who appeals on two grounds, and only succeeds on one, and has the other decided against him, may lose his costs: *Moore* v. *Bennett*, 1884, 1 R. P. C. 129. Costs paid below may be ordered to be refunded on appeal: *Kaye* v. *Chubb*, 1888, 5 R. P. C. 653.

In granting costs the conduct of the parties is looked to. Thus where, after judgment given in the Court below, the Appeal Court in another case decided the same point differently:—the appellants wrote to the respondents desiring that they would consent to a modification of the judgment in accordance with the law just laid down, but otherwise offering to withdraw the appeal which they had lodged. The respondents insisted on their going on with the appeal. Held, that this conduct was unreasonable, and defendants ordered to pay

all the costs from the date of their unreasonable refusal: *De Vitre* v. *Betts*, 1873, L. R. 6 H. L. C. 319.

(N.B.—It will be understood that the above notes on practice only embrace such points as are peculiar to, or have been decided in, patent cases. The practice in patent actions, in general, of course follows the usual rules of the H. C. J.)

In jury cases, of course, a new trial may be ordered: R. S. C., O. XXXIX.

CHAPTER XXXII.

OFFENCES.

Ch. XXXII. sect. 1.

1. Selling unpatented articles as patented.—By the Common Law it was actionable to pass off goods as those of another person, either by putting them in wrappers or by marking them so as to deceive. This Common Law right existed quite independently of the Trade Marks Act or of other Statutes: *Sykes* v. *Sykes*, 1824, 3 B. & C. 541; *Blofield* v. *Payne*, 1833, 4 B. & Ad. 410; and was also enforced by injunction: *Ransome* v. *Bentall*, 1834, 3 L. J. (N.S.) Ch. 161; *Knott* v. *Morgan*, 1839, 2 Keen. 213. By the Patents Act, 1835, a penalty was imposed for doing so, but this Act is repealed by the Patents Act, 1883, which provides that "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 to a fine not exceeding £5 on summary conviction." Under this section, in order to justify the sale of the alleged patented article, it is necessary that the patent should have been *granted*, not merely applied for: *Reg.* v. *Crampton*, 1886, 3 R. P. C. 367; nor provisionally protected: *Reg.* v. *Wallis*, 1886, 3 R. P. C. 1.

post, p. 470.

The section is somewhat obscure. If a man sold an article marked "patent," would it be competent for him to shew that it once was patented though the patent had expired? Or again, would he be liable if he sold an

article marked patent, when in truth it was an infringement of someone else's patent? The words, "has been granted *for the same*," seem to shew that the patent must have been granted for the article sold, and that therefore, an infringer would be liable if he sold an unauthorized infringement of someone else's patent. The point arose in *Reg.* v. *Walliss*, but was not decided.

Selling unpatented articles as patented.

2. Falsification of registers is a misdemeanour: Patents Act, 1883, s. 93. This includes "causing falsification." Falsely assuming the name of a patent agent is also punishable: see Chap. XIV., sect. 1; Patents Act, 1888, s. 1.

post, p. 465.

post, p. 479.

3. To assume the Royal Arms, or a colourable imitation of them is also punishable on summary conviction by a fine not exceeding £20: Patents Act, 1883, s. 106.

post, p. 471.

CHAPTER XXXIII.

INTERNATIONAL AND COLONIAL ARRANGEMENTS.

(*As to practice, see P. O. Circular, post*, p. 555.)

CH. XXXIII. THE growth of trade and increase of intercourse among nations, made the want of international patent arrangements felt, and on March 20th, 1883, a convention was signed at Paris by several Powers to which a number of others have now adhered.

post, p. 458. This convention is given in the appendix. By Patents
post, p. 469. Act, 1883, ss. 103, 104, powers were given to the Crown to join in this convention. The effect of the convention is to give any one who applies for a patent in one of the
post, p. 472. countries or colonies seven months within which to apply in any of the other countries. During the seven months he is protected from the effects of publication of his invention by other persons, and he has a prior right to have the patent granted to him over other persons. In fact, by applying for a patent in one country, he obtains what is very analogous to a seven months' provisional protection in all the others.

An application in Great Britain for a patent for an invention which has been previously patented in one of the countries of the Union must be made on Form A2,
post, p. 488. and see Patent Rules, 1890, rr. 24–29; several cases have been decided under this branch of the Act of 1883, viz., *Re Everett*, 1888, Griff. App. 29.

Main's Patent, 1890, 7 R. P. C. 13, which decided that when a country adopts the convention, patents in that country prior to the date of the convention acquire the advantages of it.

The rights granted by the convention are personal rights, and hence the contemporaneous patents can only be granted to the same persons as those who took out the foreign patent: *Re Shallenberger*, 1889, 6 R. P. C. 550; *Re Van de Poele*, 1889, 7 R. P. C. 69. A corporation can apply: *Re Carez*, 1889, 6 R. P. C. 552.

It is necessary for the person who wishes to avail himself of the privileges of sects. 103, 104, to apply properly, for if he applies in the ordinary way, and has his patent dated as of the date of the application and not antedated back to his first patent in the other country, he will be taken to have elected to take out simply an English patent, and not to be entitled to the protection against publication given by sect. 103: *British Tanning Co.* v. *Groth*, 1891, 8 R. P. C. 113. This disposes of the doubts raised in *L'Oiseau & Pierraud's Patent*, 1887, Griff. App. 36.

post, p. 469.

A copy of a translation of the Convention of Paris will be found in the Appendix. The following countries and colonies have adopted it:—

Belgium.
Brazil.
Curaçao.
Surinam.
East Indian Colonies of the Netherlands.
France.
Great Britain.
Guatemala.
Italy.
Netherlands.
New Zealand.
Norway.
Portugal.
Queensland.
San Domingo.
Servia.
Spain.
Sweden.
Switzerland.
Tunis.
United States.

CH. XXXIII. and similar arrangements have also been made with Mexico, Paraguay, Roumania (Designs and Trade Marks only), Hungary: (see Circular of Information, para. 22, Appendix).

post, p. 474.

ante, p. 263.

Note that by Patents Act, 1883, s. 117, the Channel Islands are not included in the words, "British Possessions." On the other hand, the Patents Acts do not apply to it.

It is not the purpose of the present work to deal with foreign patents. The patent laws of the world have been collected in a most useful work by Mr. Carpmael, which has been continued and brought up to date by a Committee of the Institute of Patent Agents. Mr. Lloyd Wise has also a book in the press upon the same subject, portions of which have been published in the weekly journal, *Work*.

APPENDIX OF STATUTES.

The only Statutes in force as to Patents are the Statute of Monopolies, 21 *James I. c.* 3, *and the Patent Acts of* 1883, 1885, 1886, *and* 1888.

21 JAC. 1, C. 3. [A.D. 1623 (*k*).] 21 Jac. 1, c. 3.

An Act concerning Monopolies and Dispensations with Penal Laws, and the Forfeitures thereof.

All monopolies, &c., shall be void.

"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 realm: And whereas your Majesty was further graciously pleased expressly to command that no suitor should presume to move your Majesty for matters of that nature; yet nevertheless upon misinformations and untrue pretences of public good, many such grants have been unduly obtained, and unlawfully put in execution, to the great grievance and inconvenience of your Majesty's subjects, contrary to the laws of this your realm, and contrary to your Majesty's most royal and blessed intention so published as aforesaid." For avoiding whereof, and preventing the like in time to come, may it please your excellent Majesty, 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 any thing 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 forfeitures 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 ure or execution.

Monopolies, &c., shall be tried by the common laws of this realm.

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.

All persons disabled to use monopolies, &c.

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 incapable 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 liberty, power or faculty, grounded or pretended to be grounded upon them or any of them.

The party grieved by pretext of a monopoly, &c., shall recover treble damages and 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 or 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 or 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, or 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

He that delayeth an action grounded upon this statute incurs a præmunire.

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 such order, warrant, power, 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.

[Sec. 5 is repealed, Stat. Law Rev. Act, 1883.]

Letters patent hereafter to be granted for fourteen years, for new manufactures, saved.

ante, p. 19.

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 grant 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.

This Act not to extend to grants sanctioned by *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, heretofore made, granted, allowed

and confirmed by any Act of Parliament now in force, so long as the same shall continue in force.

Warrants granted to justices, saved.

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 depending in suit and question before them, or any of them respectively, after plea pleaded by the party defendant.

Charters granted to corporations, saved.

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; or unto any corporations, 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.

[The rest of the Statute is repealed by Stat. Law Rev. Act, 1863, and P. Act, 1883.)

THE PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.

46 & 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.]

post, p. 475. **48 & 49 Vict. c. 63.—An Act to amend the Patents, Designs, and Trade Marks Act, 1883. [14th August, 1885.]**

post, p. 477. **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.]**

post, p. 479. **51 & 52 Vict. c. 50.—An Act to amend the Patents, Designs, and Trade Marks Act, 1883. [24th December, 1888.]**

(The repealed parts are printed in italics, and the additions in heavier type.)

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:

PART I.

Preliminary.

Short title. **1. This Act may be cited as the Patents, Designs, and Trade Marks Act, 1883.**

2. This Act is divided into parts, as follows:— Division of Act into parts.

Part I.—PRELIMINARY.
II.—PATENTS.
III.—DESIGNS.
IV.—TRADE MARKS.
V.—GENERAL.

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. Commencement of Act.

PART II.

PATENTS.

Application for and Grant of Patent.

4. (1.) Any person, whether a British subject or not, may make an application for a patent. Persons entitled to apply for patent.

(2.) Two or more persons may make a joint application for a patent, and a patent may be granted to them jointly. *ante*, p. 228.

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. Act 1885, s. 5. Power to grant patents to several persons jointly.

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. Application and specification. *ante*, p. 337.

(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. *post*, p. 510.

Act 1885, s. 2. (5 & 6 Will. 4, c. 62.)

The declaration may be either a statutory declaration under the Statutory Declarations Act, 1835, or not, as may be from time to time prescribed.

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

ante, pp. 201, 177.

(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.

Act 1886, s. 2.

ante, p. 201.

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 that the complete specification was not accompanied by drawings, but referred to those which accompanied the provisional specification.

ante, p. 168.

(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.

ante p. 195.

Reference of application to examiner.

ante, p. 240.

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.

Repealed by Act 1888, *s.* 2.

[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.*]

Act 1888 s. 2. Power of comptroller to refuse application or require amendment. *ante*, p. 241.

"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."

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.

Act 1885, s. 3.

A complete specification may be left within such extended time, not exceeding one month after the said nine months, as the comptroller may on payment of the prescribed fee allow.

ante, p. 242.

(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.

ante, p. 243.

(2.) If the examiner reports that the conditions hereinbefore contained have not been complied with, the comptroller may 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.

ante, p. 244.

(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.

A complete specification may be accepted within such extended time, not exceeding three months after the said twelve months, as the comptroller may on payment of the prescribed fee allow. Act 1885, s. 3.

(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 power to order discovery in such legal proceeding shall certify that such production or inspection is desirable in the interests of justice, and ought to be allowed. *ante*, p. 241. Repealed. Act 1888, s. 3.

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. Advertisement on acceptance of complete specification. *ante*, p. 244.

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 between the leaving of the provisional specification and the leaving of the complete specification, but on no other ground. Opposition to grant of patent. *ante*, p. 246. Repealed. Act 1888, s. 4. Act 1888, s. 4.

(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.

ante, p. 258.

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.

Act 1885, s. 3.

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.

Date of patent.
ante, p. 315.

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.

ante, p. 266.

Specifications, &c., not to be published unless application accepted.
Act 1885, s. 4.
ante, p. 176.

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.

Provisional Protection.

Provisional protection.
ante, p. 176.

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 proceedings for infringement unless and until a patent for the invention has been granted to him.

Patent.

Extent of patent.

ante, p. 263.

16. Every patent when sealed shall have effect throughout the United Kingdom and the Isle of Man: (*post*, p. 472).

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 or in this Act, cease if the patentee fails to make the prescribed payments within the prescribed times.

ante, p. 270.

(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:

post, p. 551.

(*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 he shall think fit, refuse to award or give any damages in respect of such infringement.

Amendment of Specification.

Amendment of specification.

ante, p. 215.

post, p. 494.

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 amend-

ment 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 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. *ante*, p. 225.

(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.*] Repealed. Act 1888, s. 5.

(10.) The foregoing provisions of this section do not apply Act 1888, s. 5.

when and so long as any action for infringement or proceeding for revocation of a patent is pending.

Power to disclaim part of invention during action, &c.

ante, p. 215.

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.

ante, p. 225.

20. Where an amendment by way of disclaimer, correction, or explanation, has been allowed under this Act, no damages shall be given in any action in respect of the use of the invention before the disclaimer, correction, or explanation, unless the patentee establishes to the satisfaction of the Court that his original claim was framed in good faith and with reasonable skill and knowledge.

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.

ante, p. 290.

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.

See sects. 85, 87, 88, 89, 90, 91, 93, 101, 114. *and ante*, p. 267.

(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 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.

ante, p. 270.

post, pp. 493, 505.

(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.

ante, p. 326.

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.

ante, p. 332. (2.) Any person may enter a caveat, addressed to the registrar of the council at the council office, against the extension.

ante, p. 329. (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.

ante, p. 333. (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.

ante, p. 344. (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.

post, p. 567. (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.

ante, p. 452. (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.

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. *See Chap. XXX. ante*, p. 422.

(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, 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.

ante, p. 272.

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.

ante, p. 385.

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.

sect. 83, p. 463.

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. *ante*, p. 332.

(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. *ante*, p. 365.

(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, &c., 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. *ante*, pp. 379, 397, 401.

Certificate of validity questioned and costs thereon. *ante*, p. 406.

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.

ante, p. 415.

32. Where any person claiming to be the patentee of an invention, by circulars, advertisements or otherwise threatens any other person with any legal proceedings or liability in respect of any alleged manufacture, use, sale or purchase of the invention, any person or persons aggrieved thereby may bring an action against him, and may obtain an injunction against the continuance of such threats, and may recover such damage (if any) as may have been sustained thereby, if the alleged manufacture, use, sale, or purchase to which the threats related was not in fact an infringement of any legal rights of the person making such threats: Provided that this section shall not apply if the person making such threats with due diligence commences and prosecutes an action for infringement of his patent.

Miscellaneous.

Patent for one invention only.

sect. 102 (2), *post*, p. 467.

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.

ante, p. 229.

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.

ante, p. 256.

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 part of the United Kingdom 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. *ante*, p. 275.

Loss or destruction of patent. *ante*, p. 164

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. *post*, p. 500. *ante*, p. 255.

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.

Exhibition at industrial or international exhibition not to prejudice patent rights. *ante*, p. 149.

39. 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.

Whereas it is expedient to provide for the extension of this section to industrial and international exhibitions held out of the United Kingdom, be it therefore enacted as follows:

Protection of patents and designs exhibited at international exhibitions. Act 1886, s. 3.

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.

Publication of illustrated journal, indexes, &c.

40. (1.) The comptroller shall cause to be used 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.

(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 seem 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. *ante*, p. 323.

(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. *ante*, p. 283,

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.

(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 authorised 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.

(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 application 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.

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."

(*Parts III. and IV., secs.* 47–81, *relate to designs and trade marks.*)

PART V.

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 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, &c., in certain cases.
ante, p. 241.

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.
ante, p. 267.

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 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, licence, or dealing. Provided that any equities in respect of such patent, design, or trade mark may

Act 1888, s. 21.

be enforced in like manner as in respect of any other personal property.

Inspection of and extracts from registers. Act 1888, s. 22.

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 such regulations as may be prescribed; and certified copies, sealed with the seal of the patent office, of any entry in any such register shall be given to any person requiring the same on payment of the prescribed fee.

Sealed copies to be received in evidence. *post*, p. 498.

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. Act 1888, s. 23. *ante*, p. 268.

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 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;

(*c*) and (*d*) relate to trade marks.

92. Relates to trade marks.

Alteration of registered mark.

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 misdemeanor.

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, &c.

ante, p. 228.

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 the 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.

Transmission of certified printed copies of specifications, &c.

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 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.

See Rules of 1890, 1892, *post*, p. 483.

See also sect. 102*a*, *post*, p. 468.

(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. Act 1888, s. 25.

"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.

(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.

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 in such foreign state.

ante, p. 316.

Act, 1885, s. 6.

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 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.

post, p. 474.

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 purposes 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.

Scotland, Ireland, &c.

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 shewn 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

111. (1.) The provisions of this Act conferring a special

jurisdiction of Courts.

jurisdiction on the Court as defined by this Act, shall not, except as 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 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.

Isle of Man.

Se'ante, P. Act, 1883, *sect.* 16. p. 448.

112. This Act shall extend to the Isle of Man, and—

(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 l[illegible]r, 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, &c.

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.

Construction of principal Act. Act, 1888, s. 27.

The principal Act shall, as from the commencement of this Act [i.e., Act of 1888], 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.

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.

ante, p. 218.

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:

"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.

Here follow the schedules to the Act of 1883.

Schedule I. contains forms of applications and specifications A. B. C., which are now replaced by others under the Patent Rules, 1890. *Then follows D., form of the grant, which has now been modified, see p.* 159 *of this book.*

Schedule II. contains fees, which are now altered by the Rules of 1892. *post*, p. 505.

Schedule III. contains the enactments repealed.

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. 4, c. 62.

Amendment of sects. 8, 9, and 12 of 46 & 47 Vict. c. 57.

3. Where as 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 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, &c. 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.

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." Amendment of sect. 103 of 46 & 47 Vict. c. 57.

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: 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:

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. Short title and construction. 46 & 47 Vict. c. 57. 48 & 49 Vict. c. 63.

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 The same drawings may accompany both specifications.

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 exhibited at international exhibitions.

3. Whereas by section thirty-nine of the Patents, Designs, and Trade Marks Act, 1883, as respects patents, and by section 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 controller the prescribed notice of his intention to do so:

ante, pp. 467, 149.

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 controller 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. *ante*, p. 235.

(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. *post*, p. 533.

(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.

(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 drawing 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.

ante, p. 443.

"(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 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."

(*Sections* 6–20 *relate to trade marks.*)

Sect. 87, as to entry of assignments, &c.

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 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.

The Court of the County Palatine has now by 52 & 53 Vict. c. 47, the full powers of a Court of Chancery.

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.

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 :— *sect.* 101. *ante*, p. 467.

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. *ante*, p. 270. *post*, p. 505.

Forms.

post, pp. 508–532.

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 2 of section 5 of the Act of 1883 and section 2 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 Other forms.

set 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 authorised to the satisfaction of the Comptroller, and if he so require resident in the United Kingdom.

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, &c., 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.

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 of hearing.

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, &c.

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 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.

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.

ante, p. 149.

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, &c.

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 authorised 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 authorised 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 authorised 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.

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.

ante, p. 506.

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.

ante, p. 232. Communication from abroad. *post*, p. 510.

23. An application for a patent for an invention communicated from abroad shall be made in the form A 1 set forth in the Second Schedule to these Rules.

ante, p. 432. 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 7 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.

26. The application in the United Kingdom shall be made in the Form A² 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 Possessions 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 said 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 connection 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. *ante*, p. 201.

Drawings for specifications. see also *post*, p. 544.

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 letter-press should appear in the specification itself.

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.

Requirements as to paper, &c., 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 two 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 ½ 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, not less than $\frac{1}{8}$ 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, &c. 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, &c. 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. Restrictions as to wood engravings.

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." Copies of drawings.

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." Provisional drawings used for complete specification.

(A specimen drawing can be obtained from the Patent Office together with a copy of these rules, price sixpence.)

Opposition to Grants of Patents.

ante, p. 216.

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. Notice of opposition.

35. On receipt of such notice the copy thereof shall be transmitted by the Comptroller to the applicant. Copy for applicant.

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. Particulars of prior patent.

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. Opponent's evidence.

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 appli-

cant 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 time prescribed by these rules, the opposition shall be deemed to be abandoned, and a patent shall be sealed forthwith.

44. The decision of the Comptroller, after hearing any party who applies under Rule 41, shall be notified by him to the parties. Decision to be notified to parties.

CERTIFICATES OF PAYMENT OR RENEWAL.

Rules 45, 46 *and* 47 *are repealed by the Patent Rules*, 1892.

PATENT RULE 4, 1892.

Payment of Annual Fees for continuance of Patent. *ante*, p. 270.

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. *post*, p. 505. 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.

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. Certificate of payment.

ENLARGEMENT OF TIME.

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. Enlargement of time for payments.

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.

ante, pp. 215, 448.

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 original specification and drawings, shewing in red ink the proposed amendment, and

Advertisement.

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.

Notice of opposition.

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.

Copy for the applicant.

54. On receipt of such notice the copy thereof shall be transmitted by the Comptroller to the applicant.

Opponent's evidence.

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.

Further proceedings.

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.

Requirements thereon.

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.

Leave by Order of Court.

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.

Advertisement of amendment.

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.

COMPULSORY LICENSES.

ante, p. 290.

Petition for compulsory grant of 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.

To be left with evidence at Patent Office.

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.

Directions as to further proceedings unless petition refused.

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.

Procedure.

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.

Petitioner's evidence.

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 shew cause against the petition.

REGISTER OF PATENTS.

ante, p. 267.

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 pro-

prietor, or by his agent duly authorised to the satisfaction of the Comptroller, and in the case of a body corporate by their agent, authorised 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.

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.

ante, p. 228.

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

ante, p. 348.

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.

ante, p. 464.

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, &c.

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 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.

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. Repeal.

Dated the 31st day of March, 1890.

M. E. HICKS-BEACH,
President of the Board of Trade.

The First Schedule of fees is now repealed and a new scale is provided by the rules of 1892. The Second Schedule contains the official forms hereinafter set out.

RULES REGULATING THE PRACTICE AND PROCEDURE ON APPEALS TO THE LAW OFFICERS.

(MADE BY VIRTUE OF SECT. 38 PATENTS ACT, 1883.)

ante, p. 456.

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 14 days from the date of the decision appealed against file in the Patent Office a notice of such his intention.

ante, p. 255.

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 14 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: *Re Thwaite*, 1892, 9 R. P. C. 515.

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.

THE PATENTS RULES, 1892 (*First Set*).

By virtue of the Patents, Designs, and Trade Marks Acts, 1883 to 1888, the Board of Trade do hereby make the following Rules:— As to powers to make, *ante*, p. 466.

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.

(Signed) M. E. HICKS-BEACH,
President of the Board of Trade.

19*th day of February*, 1892.

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.

19*th 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 to 1888, 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, and 47 of the Patents Rules, 1890, are hereby repealed.

Payment of Annual Fees for Continuance of Patent.

ante, pp. 270, 451, 493.

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.

SCHEDULE.

List of fees payable on and in connexion with Letters Patent.

N.B.—A fuller list of fees is given in the P. O. Circular, *post*, p. 546.

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

		£	s.	d.
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
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 1 month	1	0	0
25.	„ „ 2 months	3	0	0
26.	„ „ 3 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

		£	s.	d.
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 1 month		2	0	0
„ 2 months.		4	0	0
„ 3 months.		6	0	0

M. E. HICKS-BEACH,
President of the Board of Trade.

4th July, 1892.

(Approved) SIDNEY HERBERT,
HERBERT EUSTACE MAXWELL,
Lords Commissioners of Her Majesty's Treasury.

* Notice inserted in Patents Journal, Feb. 24, 1892.

NOTICE.

Certified copies of Registers kept in the Patent Office and of Statutory Declarations, Assignments, and other stamped legal documents filed in the Patent Office will in future be required to bear a Stamp Duty of One Shilling under the Stamp Act, in addition to the Office Fee of One Shilling under the Patents, &c., Act.

Stamped forms for this purpose will be obtainable at the Patent Office.

H. READER LACK,
Comptroller.

PATENT
£1.

OFFICIAL FORMS UNDER THE PATENTS RULES, 1890.

(For index to Forms *see* TABLE OF CONTENTS.
As to purchase of them, see *post* p. 546.)

SECOND SCHEDULE.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

ante, p. 239.

Form A. (Rule 5.)

To be accompanied by two copies of Form B or of Form C.

APPLICATION FOR PATENT.

(a) Here insert name and full address and calling of applicant or applicants.

(a) _____

_____

_____

_____

_____

_____do hereby declare that_____in possession of an invention the title of which is (b)_____

_____

_____

(b) Here insert title of invention.

(c) In the case of more than one applicant, state whether all, or if not, who is or are the inventor or inventors.

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.

Dated_____day of_____18____

(d) To be signed by applicant or applicants.
In the case of a Firm, each member of the Firm must sign.

(d) _____

_____

_____

_____

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.

† _____

PATENT £1.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

Form **A 1.** (Rule 5.)

To be accompanied by two copies of Form B or of Form C.

ante, pp. 232, 488.

APPLICATION FOR PATENT FOR INVENTIONS COMMUNICATED FROM ABROAD.

(*a*) Here insert name and full address and calling of applicant.

I (*a*) _____

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.

_____

_____

_____

(*c*) Here insert name, address and calling of communicant.

which invention has been communicated to me by (*c*) _____

_____

_____

_____

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*) To be signed by applicant or applicants.

(*d*) _____

_____

_____

_____

ante, p. 484.

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.

†_____

_____

_____

_____

PATENT
£1.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

Form **A 2.** (Rule 26.)

APPLICATION FOR PATENT UNDER INTERNATIONAL AND COLONIAL ARRANGEMENTS.

ante, pp. 432, 469, 488.

(*a*) Here insert name and full address and calling of applicant, or of each of the applicants.

(*a*)

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.

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*)

(*e*) Here insert the official date of the earliest foreign application.

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.

[No stamp needed.]

Form **B**. (Rule 5.)

PROVISIONAL SPECIFICATION.

(To be furnished in Duplicate.)

ante, pp. 168–177.

(*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*)_____

_____

_____

_____

_____

_____

(c) Here insert short description of invention.

do hereby declare the nature of this invention to be as follows:—(c)

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.

PATENT £3.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

Where Provisional Specification has been left, quote No. and date.
No._____
Date._____

Form C. (Rule 5.)

COMPLETE SPECIFICATION.

(To be furnished in Duplicate—one unstamped.)

ante, pp. 178–194.

(a) Here insert title as in declaration.

(b) Here insert name and full address and calling of applicant or applicants as in declaration.

(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

Here state distinctly the features of novelty claimed.

(a) _____

(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) _____

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.

PATENT
10s.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

Form D.

FORM OF OPPOSITION TO GRANT OF PATENT.

(Rule 34, *et seq.*)

(To be accompanied by an unstamped copy.)

ante, pp. 246–257.

* Here state name and full address.

* I_____

_____

_____

_____

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.

PATENT £1.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

Form E. (Rule 12.)

FORM OF APPLICATION FOR HEARING BY THE COMPTROLLER.

ante, p. 465.

IN CASES OF REFUSAL TO ACCEPT, OPPOSITION, OR APPLICATIONS FOR AMENDMENTS, &c.

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.

PATENT
£1 10*s.*
£3.

The fee stamp is £1 10*s.* by an applicant and £3 by a patentee.

ante, p. 215.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

Form **F.** (Rule 52, *et seq.*)

FORM OF APPLICATION FOR AMENDMENT OF SPECIFICATION OR DRAWINGS.

* 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.

PATENT 10*s.*

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

Form G. (Rule 53.)

FORM OF OPPOSITION TO AMENDMENT OF SPECIFICATION OR DRAWINGS.

(To be accompanied by an unstamped copy.)

ante, p. 216.

* 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.

PATENT £5.

ante, p. 290.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

Form H. (Rule 60.)

FORM OF APPLICATION FOR COMPULSORY GRANT OF LICENSE.

(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 below.

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

Form H 1. (Rule 60.)

---

ante, p. 290.

FORM OF PETITION FOR COMPULSORY GRANT OF LICENSES.

To the LORDS of the COMMITTEE of PRIVY COUNCIL for TRADE.

THE PETITION of (*a*) of
in the county of , being a person interested in the matter of this petition as hereinafter described:—

SHEWETH as follows:—

1. A patent dated No.
was duly granted to
for an invention of (*b*)

2. The nature of my interest in the matter of this petition is as follows:—(*c*)

3. (*d*)

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*)

(*a*) Here insert name, full address, and description.

(*b*) Here insert title of invention.

(*c*) Here state fully the nature of petitioner's interest.

(*d*) Here state in detail the circumstances of the case under section 22 of the said Act, and show that it arises by reason of the default of the patentee to grant licenses on reasonable terms. The statement of the case should also show as far as possible that the terms of the proposed order are just and reasonable. The paragraphs should be numbered consecutively.

(*e*) Here state the ground or grounds on which relief is claimed in the language of section 22 subsections (*a*), (*b*), (*c*), as the case may be.

Your petitioner therefore prays that an order may be made by the Board of Trade (*f*)

(*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.

or that the petitioner may have such other relief in the premises as the Board of Trade may deem just.

PATENT £5.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

Form I. (Rule 64.)

ante, p. 290

FORM OF OPPOSITION TO COMPULSORY GRANT OF LICENSE.

* 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. (Rule 48.)

ante, pp. 451, 493, 505.

APPLICATION FOR CERTIFICATE OF PAYMENT OR RENEWAL.

_____

_____hereby transmit the fee prescribed for the continuation in force of *_____Patent No._____, of 18___for a further period of_____.

* Here insert name of patentee.

† Here insert name and full address.

Name †_____

Address_____

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane London, W.C.

PATENT.

(This part of the Form to be filled in at the Patent Office.)

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 in force.*

* See section 17 of the Patents, Designs, and Trade Marks Act, 1883.

Seal.

Patent Office, London.

PATENT.

The stamp here is dependent on the length of enlargement asked for

ante, p. 270.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

Form K. (Rule 50.)

FORM OF APPLICATION FOR ENLARGEMENT OF TIME FOR PAYMENT OF RENEWAL FEE.

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*) Here insert full address to which receipt is to be sent.

(*b*)_____

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

PATENT
10*s*.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

Form L. (Rule 68.)

FORM OF REQUEST TO ENTER NAME UPON THE REGISTER OF PATENTS.

ante, p. 262.

(*a*) *Or* We. Here insert name, full address, and description.

I (*a*)_____

(*b*) My or our.
(*c*) Or names.
(*d*) I or we.
(*e*) Here insert the nature of the claim.
(*f*) Here give name and address, &c., of Patentee or Patentees.
(*g*) Here insert title of the invention.
(*h*) Here specify the particulars of such document, giving its date, and the parties to the same, and showing how the claim here made is substantiated.
(*i*) Here insert the nature of the document.
(*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.

hereby request that you will enter (*b*)_____name (*c*) in the Register of Patents:—

(*d*)_____claim to be entitled (*e*)_____

of the Patent, No._____of 188 , granted to (*f*)_____

for (*g*)_____

by virtue of (*h*)_____

And in proof whereof I transmit the accompanying (*i*)_____ with an attested copy thereof (*j*)

I am,
Sir,
Your obedient Servant,

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

PATENT
10*s*.

ante, p. 267.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

Form **M.** (Rule 77.)

FORM OF REQUEST TO ENTER NOTIFICATION OF LICENSE IN THE REGISTER OF PATENTS.

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) Here insert full address.

(a)_____

_____

_____

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

PATENT £2.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

Form N.

APPLICATION FOR DUPLICATE OF PATENT.

ante, p. 266.

Date

SIR,

I REGRET to have to inform you that the Letters Patent

[* Here insert dat:. 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 Letters Patent.§

[§ Here state interest possessed by applicant in the Letters Patent.]

[Signature of Applicant.]

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

PATENT
10*s*.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

Form O. (Rule 15.)

NOTICE OF INTENDED EXHIBITION OF AN UNPATENTED INVENTION.

ante, p. 119.

* Here state name and full address of applicant.

* _____

_____

_____

hereby give notice of my intention to exhibit a_____

of_____at the_____

_____

_____

† State "opened" or "is to open."

Exhibition, which †_____ _____ of_____ _____18—, under the provisions of the Patents, Designs, and Trade Marks Act of 1883.

‡ Insert brief description of invention, with drawings if necessary.

‡_____herewith enclose_____

_____

(Signed)_____

To the Comptroller,
Patent Office, 25, Southampton Buildings,
Chancery Lane, London, W.C.

PATENT.

Before the patent is sealed the stamp is 5*s.*, afterwards £1.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

Form P.

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 shown in red ink in the certified copy of the original (*b*) _____

_____

hereunto annexed.

(*a*) or errors.

ante, p. 226.

(*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.

PATENT
1*s.*
or 5*s.*

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

Form Q. (Rules 77, 79.)

CERTIFICATE OF COMPTROLLER-GENERAL.

ante, pp. 498, 507.

Patent Office,
London,
18

I, , Comptroller-General of Patents, Designs, and Trade Marks, hereby certify

* Here insert name and full address of person requiring the information.

To *_____

PATENT 5*s*.

ante, pp. 267, 496.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

Form R.

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.

PATENT. 10*s*.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

Form **S.** (Rule 74.)

FORM OF APPLICATION FOR ENTRY OF ORDER OF PRIVY COUNCIL IN REGISTER.

ante, p. 348.

(*a*) Here state name and full address of applicant.

(*a*)_____

_____

_____

_____

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.

PATENT £3.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

Form **T.** (Law Officers' Rules 1.)

FORM OF APPEAL TO LAW OFFICER.

(*a*) Here insert name and full address of appellant.

I, (*a*)_____of (*a*)_____

_____

(*b*) Here insert "the decision" or "that part of the decision," as the case may be.

(*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.

hereby give notice of my intention to appeal to the Law Officer from (*b*)_____

_____

of the Comptroller of the_____day of_____

18__ , whereby he (*c*)_____

_____

(*d*) Insert number and year.

No. (*d*)_____ of the year 18___(*d*)___.

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.

PATENT £2.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

Form **U.** (Rule 50.)

FORM OF APPLICATION FOR EXTENSION OF TIME FOR LEAVING A COMPLETE SPECIFICATION.

ante, p. 444. and p. 507.

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.

PATENT.

The stamp is dependent on the enlargement asked for; *ante*, p. 507.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

Form V. (Rule 50.)

FORM OF APPLICATION FOR EXTENSION OF TIME FOR ACCEPTANCE OF A COMPLETE SPECIFICATION.

SIR,

I _____ 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.

* not exceeding 3 months. *ante*, p. 445.

_____

_____

_____

_____

_____

_____

_____

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.

31*st March*, 1890.

PATENT AGENTS' RULES, 1889.

PATENTS, DESIGNS, AND TRADE MARKS ACT, 1888.

Register of Patent Agents' Rules, 1889.

After the formation of the Chartered Institute of Patent Agents, a set of rules, dated 1891, was promulgated by the Board of Trade, making these rules applicable to the Chartered Institute, see p. 613.

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:— *ante*, p. 235. *ante*, pp. 479, 484.

1. A Register shall be kept by the Institute of Patent Agents, 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.

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.

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 pur-

* Altered to February, and at such other times as the Chartered Institute may think desirable. R. P. A. R., 1891 (*post*, p. 613).

porting 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.

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.

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 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.

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.

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 practise as such solicitor or law agent.

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.

Appendix B is cancelled and now replaced by Appendix B to the rule of 1891, *post*, p. 685.

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.

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.

11. The Registrar shall erase from the Register the name of any registered person who is dead.

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 Registrar may send by post to a registered person to his registered address a notice inquiring 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 practise, and his name may be erased accordingly.

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,

ante, p. 236.

as the Institute or the Board of Trade (as the case may be) may in each particular case direct.

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.

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.

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 or misdemeanour, or after due inquiry 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 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.

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 think fit restore to the Register any 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.

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 inquiry 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.

19. Any person aggrieved by any order, direction, or refusal of the Institute or Registrar may appeal to the Board of Trade.

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.

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.

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.

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.

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.

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.

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.

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.

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.

29. In these Rules, unless the context otherwise requires—

"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.

31. These Rules may be cited as the Register of Patent Agents' Rules, 1889.

By the Board of Trade,

COURTENAY BOYLE,

Assistant Secretary, Railway Department.

The 11th day of June, 1889.

INSTITUTE OF PATENT AGENTS.

Notice is hereby given that, in accordance with Rule 3 of the above-named Rules, the Register of Patent Agents for the year 1889 has been printed under the direction of the Institute of Patent Agents, and published and placed on sale at the Offices of the Institute, 19, Southampton Buildings, London, W.C. Price *One Shilling*.

H. HOWGRAVE GRAHAM,

Secretary.

December 13th, 1889.

CHARTERED INSTITUTE OF PATENT AGENTS.

Her Majesty has been graciously pleased to cause Letters Patent to be issued, granting a Charter for the incorporation of the Institute of Patent Agents, under the style of "The Chartered Institute of Patent Agents."

The objects of the Chartered Institute are similar to those for which the Institute of Patent Agents was formed in 1882, namely, the promotion of the education, status, and training

of Patent Agents, and the maintenance of a high standard of professional conduct on the part of the Members of the Institute.

The said Charter provides that Fellows of the Institute may use, after their names, the designation "Chartered Patent Agent," or the initials "C. P. A.," being an abbreviation of the same.

H. READER LACK,
Comptroller.

August 26th, 1891.

CIRCULAR OF INFORMATION OF THE PATENT OFFICE.

The following circular is kept in print at the Patent Office and supplied to those about to take out patents. It has not the force of the Patent Office Rules, and is only used for the information of those about to take out patents:—

CIRCULAR.

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. *ante*, p. 237.

(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 page 553, 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.

A company 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 A[1]), or under the International and

Colonial arrangements (Form A[2]). The application should be signed by the secretary or other principal officer, who should add after his signature the words "For 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 A[1] or A[2]) 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 arrangement (see page 555, paragraph 22).

(iii.) Applications may 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, 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, in which case a provisional specification will be 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) A[1], or (for applications under the International and Colonial arrangements) A[2], stamped 1*l.*, duly filled in as directed by the marginal notes on the form, and signed by the applicant or applicants.

(*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 (xii.) 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 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 "filed with my 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) A^1, or (for applications under the International and Colonial arrangements) A^2, stamped 1*l.*, duly filled in, as directed by the marginal notes on the form, and signed by the applicant or applicants.

(*b.*) The complete specification, Form C, stamped 3*l.*, and unstamped duplicate.

(x.) The complete specification must be begun upon Form C (bearing a 3*l.* 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.

ante, p. 195. 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 by their patent.

Claims are not intended to be made for the efficiency or advantages of the invention.

In the statement of claims only the actual processes or apparatus (or improvements therein) should be stated which are considered by the inventor to be new.

See (xii.) below for regulations as to drawings.

Specifications and other Documents.

(xi.) The specifications and all other documents must be written or printed in large and legible characters upon strong wide-ruled foolscap paper measuring 13 by 8 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.

ante, p. 201. (xii.) The provisional or complete specification need not 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), 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 shown 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.

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 shown outside the figure, and connected with the part referred to by a fine line.

The scale adopted should be large enough to show clearly wherein the invention consists, and only so much of the apparatus, machine, &c., need be shown as effects this purpose. When the scale is shown 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 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."

ante, p. 508.

2. *Forms of Application and other Patent Forms.*—(i.) Forms are not supplied by the Patent Office, but can be purchased at the Inland Revenue Office, Royal Courts of Justice (Room No. 6), or they can be obtained at a few days' notice through any Money Order Office in the United Kingdom upon prepayment of the value of the stamp.

Neither the Inland Revenue Department nor the Post Office being authorised to furnish Patent Forms upon written application, persons resident abroad should order such forms as they require through a correspondent in England.

		£	*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
„ C[1].	On postal request for printed copy of specification	0	0	8
„ D.	On notice of opposition to grant of patent. By opponent.	0	10	0

		£	s.	d.
Form 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
	Before the expiration of the 5th year from date of patent, and in respect of the 6th year.	6	0	0
	Before the expiration of the 6th year from date of patent, and in respect of the 7th year.	7	0	0
	Before the expiration of the 7th year from date of patent, and in respect of the 8th year.	8	0	0
	Before the expiration of the 8th year from date of patent, and in respect of the 9th year.	9	0	0
	Before the expiration of the 9th year from date of patent, and in respect of the 10th year	10	0	0
	Before the expiration of the 10th year from date of patent, and in respect of the 11th year	11	0	0
	Before the expiration of the 11th year from date of patent, and in respect of the 12th year	12	0	0
	Before the expiration of the 12th year from date of patent, and in respect of the 13th year	13	0	0
	Before the expiration of the 13th year from date of patent, and in respect of the 14th year	14	0	0
* Form K.	On enlargement of time for payment of renewal fees. Not exceeding 1 month .	1	0	0
	On enlargement of time for payment of renewal fees. Not exceeding 2 months .	3	0	0
	On enlargement of time for payment of renewal fees. Not exceeding 3 months .	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
„ S.	For every entry of an extension of patent .	0	10	0

* The scale of fees given above applies only in those cases where payment falls due on or after October 1st, 1892.

		£	s.	.
Form 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
„ T.	On appeal from Comptroller to Law Officer .	3	0	0
„ U.	On enlargement of time for filing 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
	On enlargement of time for acceptance of complete specification after 12 months. Not exceeding 2 months	4	0	0
	On enlargement of time for acceptance of complete specification after 12 months. Not exceeding 3 months.	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, 226, Commercial Road, E.
„ 9, Blackman Street, Borough, S.E.
„ Charing Cross, W.C.
„ 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.
Middlesborough.
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 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.) *ante*, p 246.

4. *Amendment of Specification.*—Under Section 18 of the *ante*, p. 215.

ante, p. 216.

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 Sale Office, 38, Cursitor Street, Chancery Lane, price 8*d.*, including inland postage. (See Par. 25.) The fee for certifying the printed copy is 1*s.* 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.—Persons proposing to amend their specifications should remember that the proposed amendments are made public and advertised whether the same are allowable or not. This publication might be a bar to the valid patenting of matter disallowed by way of amendment. No amendment of a provisional specification, after acceptance of the same, 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 the whole or any portion of the aggregate of such prescribed annual fees in advance.

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 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.)

Note.—The scale of fees given above applies only in those cases where payment falls due on or after October 1st, 1892.

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, &c.*—Deeds of assignment 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 deed sent for registration must be 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.)

ante, p. 267.

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

Patents, &c., Act, 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.)

10. *Provisional Protection.*—Provisional protection 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.

11. *Searches, Office Copies, &c.*—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 1s.)	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.

12. *Information by Post.*—Any person wishing to know whether a particular patent is still in force, or any similar details, may obtain a copy of, or an extract from, the Register of Patents, upon stating the number and year of the patent, and forwarding the fee of 1s.

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.

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 shall be liable for every offence on summary conviction to a fine not exceeding five pounds. *ante*, p. 430.

16. *Advice on Patent Matters, Opinions as to the Merit or Novelty of Inventions, the Infringement or Fraudulent Appropriation of Inventions, &c.*—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. Any solicitor will be able to point out to his client an agent qualified to give advice in patent matters, to make searches for patents or examinations, to determine questions of novelty, to draw up specifications, and to conduct other business relating to grants of patents.

It is left to every person to protect his rights by opposition or otherwise. (See Par. 3.) A patent is granted upon an application, whether the invention be novel or not, which passes the prescribed stages and is unopposed.

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.*

17. *Application for Assistance, Reduction of Fees, &c.*—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.

For 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.	Half sheets Imperial.	Foolscap Size.	Half-foolscap Size.
	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 in the British Colonies and Foreign States.*—Applications for Colonial or Foreign patents must be made to the Government of the Colony or Foreign State in which protection is desired. Most of the Colonial and Foreign patent laws 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 :— *ante*, p. 432.

Belgium.	Guatemala.	Santo Domingo.
Brazil.	Italy.	Servia.
Curaçoa and Surinam.	Netherlands.	Spain.
East Indian Colonies of the Netherlands.	New Zealand.	Sweden.
	Norway.	Switzerland.
France.	Portugal.	Tunis.
Great Britain.	Queensland.	United States.

A copy of the Text of the Convention may be purchased for 2*d.* through any bookseller. *post*, p. 558.

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 on the other :—

Mexico. Paraguay. Roumania (Designs and Trade Marks only). Uruguay.

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*l.* 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 MM. Jent & Reinert, Imprimeurs, 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 4, 5, or 6 p.m., according to the season. 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, Good Friday, and Christmas Day.

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.

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, &c. (a list is given in the original Document). They are also on sale at the Patent Office Sale Branch, 38, Cursitor Street, Chancery Lane, E.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 Sir Reader Lack.* 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, the number of patent, and year in which applied for must be given. These particulars can be obtained by searching the Indexes of Patents and (for recent specifications) the Illustrated Official Journal. The Indexes (see page 13) and the Journals can be referred to at the places named in the List "A" following, 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 number 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.

Lists of Places Receiving Donations of Patent Office Works.

A.—*Places in the United Kingdom receiving a complete set of the publications of the Patent Office, including the Specifications, on condition that they shall be daily accessible to the public, for reference or for copying*, free of all charge.

Here follows a list of towns.

The document concludes with a list of Patent Office publications, including reprints of scarce pamphlets, and 103 volumes of abridgments of specifications from the earliest times up to recent years, all of which are on sale.

The Reading Rooms at Chancery Lane are open from 10 a.m. till 10 p.m. every day except Sundays, Good Friday, and Christmas Day.

ante, p. 432.

I.—INTERNATIONAL CONVENTION FOR THE PROTECTION OF INDUSTRIAL PROPERTY.

Signed at Paris, March 20th, 1883.

(*Translation.*)

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.

Article II.

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.

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.

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.

ARTICLE V.

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.

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.

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.

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.

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 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.

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.

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.

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 Confederation, and shall work under its supervision. Its functions shall be determined by agreement between the States of the 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.

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.

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.

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 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 affect the denouncing State, the Convention remaining in operation as regards the other Contracting Parties.

ARTICLE XIX.

The present Convention shall be ratified, and the ratifications exchanged in Paris, within one year at the latest.

In witness whereof the respective Plenipotentiaries have signed the same, and have affixed thereto their seals.

Done at Paris the 20th March, 1883.

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, &c.), and to mineral products employed in commerce (mineral waters, &c.).

2. Under the word "patents" are comprised the various kinds of industrial patents recognised by the legislation of each of the Contracting States, such as importation patents, improvement patents, &c.

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 XIII., are in no case to exceed for a single year a total sum repre-enting an average of 2,000 francs 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.
2nd „	. . . . .	20 „
3rd „	. . . . .	15 „
4th „	. . . . .	10 „
5th „	. . . . .	5 „
6th „	. . . . .	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 „	. . . .	Spain.
3rd „	. . . .	Belgium, Brazil, Portugal, Switzerland.
4th „	. . . .	Holland.
5th „	. . . .	Servia.
6th „	. . . .	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.

(*Then follow the signatures.*)

PRIVY COUNCIL RULES IN PATENT CASES BEFORE THE JUDICIAL COMMITTEE.

RULES TO BE OBSERVED IN PROCEEDINGS before the RIGHT HONOURABLE the LORDS of the JUDICIAL COMMITTEE OF THE PRIVY COUNCIL under the Act of the 5th and 6th William IV., intituled "An Act to amend the Law touching letters patent for inventions," cap. 83.

ante, p. 326, 329.

No rules have yet been made under sect. 25, sub-s. 6 of the Act of 1883, and these Rules, which were made to regulate procedure under the statute 5 & 6 Will. IV. c. 83, are still in force.

Petition for confirmation.

RULE I.—A party intending to apply by petition, under sect. 2 of the said Act, shall give public notice by advertising in the *London Gazette* three times, and in three London papers, and three times in some country paper published in the town where or near to which he carries on any manufacture of anything made according to his specification, or

near to or in which he resides, in case he carries on no such manufacture, or published in the county where he carries on such manufacture, or where he lives, in case there shall not be any paper published in such town, that he intends to petition His Majesty under the said section, and shall in such advertisements state the object of such petition, and give notice of the day on which he intends to apply for a time to be fixed for hearing the matter of his petition (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*), and that on or before such day, notice must be given of any opposition intended to be made to the petition; and any person intending to oppose the said application shall lodge notice to that effect at the council office, on or before such day so named in the said advertisements, and having lodged such notice shall be entitled to have from the petitioner four weeks' notice of the time appointed for the hearing.

Petition for prolongation.

RULE II.—A party intending to apply by petition, under sect. 4 of the said Act, shall in the advertisements directed to be published by the said section, give notice of the day on which he intends to apply for a time to be fixed for hearing the matter of his petition (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*), and that on or before such day caveats must be entered; and any person intending to enter a caveat shall enter the same at the council office, on or before such day so named in the said advertisements; and having entered such caveat, shall be entitled to have from the petitioner four weeks' notice of the time appointed for the hearing.

Petitions. When petition must be presented.

RULE III.—Petitions under sects. 2 and 4 of the said Act must be presented within one week from the insertion of the last of the advertisements required to be published in the *London Gazette.*

Affidavits of advertisements.

RULE IV.—All petitions must be accompanied with affidavits of advertisements having been inserted according

to the provisions of sect. 4 of the said Act, and the 1st and 2nd of these rules and the matters in such affidavits may be disputed by the parties opposing upon the hearing of the petitions.

Caveats.

RULE V.—All persons entering caveats under sect. 4 of the said Act, and all parties to any former suit or action touching letters patent, in respect of which petitions shall have been presented under sect. 2 of the said Act, and all persons lodging notices of opposition under the 1st of these rules, shall respectively be entitled to be served with copies of petitions presented under the said sections, and no application to fix a time for hearing shall be made without affidavit of such service.

Grounds of objection.

RULE VI.—All parties served with petitions shall lodge at the council office, within a fortnight after such service, notice of the grounds of their objections to the granting of the prayers of such petitions.

Copies.

RULE VII.—Parties may have copies of all papers lodged in respect of any application under the said Act, at their own expense.

Costs.

RULE VIII.—The registrar of the privy council, or other officer to whom it may be referred to tax the costs incurred in the matter of any petition presented under the said Act, shall allow or disallow in his discretion all payments made to persons of science or skill examined as witnesses to matters of opinion chiefly.

Document to be lodged at Council Office.

RULE IX.—A party applying for an extension of a patent, under sect. 4 of the said Act, must lodge at the council office six printed copies of the specification, and also four copies of the balance sheet of expenditure and receipts relating to the patent in question, which accounts are to be proved on oath before the Lords of the Committee at the hearing. In the event of the applicant's specification not having been printed, and if the expense of making six copies of any drawing therein contained or referred to would be

considerable, the lodging of two copies only of such specification and drawing will be deemed sufficient.

All copies mentioned in this rule must be lodged not less than one week before the day fixed for hearing the application.

The Crown. The Judicial Committee will hear the Attorney-General, or other Counsel, on behalf of the Crown, against granting any application made under either the 2nd or 4th section of the said Act, in case it shall be thought fit to oppose the same on such behalf.

Council Office Fees.

On Petitions to the Queen in Council.

	£	*s.*	*d.*
Entering	1	1	0
Setting down Petition	0	10	0
Summons	0	10	0
Committee Report	1	10	0
Order of Her Majesty in Council	3	2	6
Committee Order.	1	12	6
Lodging Affidavit	1	1	0
„ Petition.	1	1	0
Searching Books for Information for Parties	0	10	0
Committee References	2	2	0
Lodging Caveat	1	1	0
Subpœna to Witnesses	0	10	0
Fee for Taxation (Petitions)	1	1	0

FORMS.

Form of Notice of Opposition to Grant of a Patent.

See *ante*, pp. 246–257.

See *Pitt's patent*, 1888, 5 R. P. C. 344. *Hill's application*, 1888, 5 R. P. C. 599. *Anderson's patent*, 1890, 7 R. P. C. 323.

Form of Indorsement on Writ in an Action for Infringement.

1. The plaintiff's claim is for an injunction restraining the defendant, his servants, workmen and agents from manufacturing, selling, exposing for sale, or using articles made according to, or in colourable imitation of, the articles described in the plaintiff's patent, dated —— 18—, No. —, or from otherwise infringing the said patent.

2. Damages; or, at the option of the plaintiff, an account of the proceeds of sale of all such articles manufactured or sold as aforesaid by the defendant in infringement of the plaintiff's said patent.

3. Delivery up to the plaintiff, or destruction of all articles in the defendant's possession made in infringement of the plaintiff's patent.

4. Costs.

Notice of Motion for Interlocutory Injunction.

Take notice that this Honourable Court will be moved before his lordship, Mr. Justice ——, on the — —day of ——, 18—, or so soon thereafter as counsel can be heard, by

Mr. —— of counsel on behalf of the above-named plaintiff, that the defendant, his servants and agents, may be restrained until the trial of this action or until further order during the continuance of the letters patent bearing date the —— day of ——, 18—, and numbered ——, from making, selling, supplying, using or putting in practice any—— [*here describe articles, &c., which are the subject of the patent*] made according to or in the manner described in the specification of the invention for which the said letters patent were granted, or according to or in any manner only colourably differing from the same and from in any manner infringing the said letters patent, and that such further order may be made as to this Honourable Court shall seem meet.

Order for an Interlocutory Injunction.

Upon motion this day made unto this Court, and upon hearing counsel for the plaintiff and for the defendant, and upon reading the plaintiff's statement of claim and particulars of breaches, and the following affidavits . . . . it is ordered that the defendants be restrained until the trial of this action or until further order during the continuance of the said letters patent to ——, dated the —— day of ——, 18—, No. ——, from making, selling, using or supplying any (. . . . . .) made according to or in the manner described in the specification filed in pursuance of the same, or according to or in any manner only colourably differing therefrom, and from in any manner infringing the said letters patent, No. ——, dated the —— day of ——, 18—.

Interlocutory Injunction Refused upon the Defendants Undertaking to Keep an Account.

Upon motion this day made unto this Court by counsel for the plaintiffs that the defendants might be restrained, etc. [*here set out the terms of the notice of motion*], and upon reading the plaintiff's statement of claim and particulars of

breaches, and the following affidavits . . . . and the defendants undertaking by their counsel until the trial of this action, or until the further order of this Court (not to buy, make, use, or sell any (——) such as those complained of and) to keep an account of all (——) alleged to be an infringement of the plaintiff's patent. This Court doth not think fit to make any order on the said motion other than that the costs thereof be costs in the action.

Statement of Claim.

In the High Court of Justice.
—— Division.

18—. B. No. ——.

Writ issued,

Between A. B. —— *Plaintiff.*
and C. D. —— *Defendant.*

Statement of Claim.

1. The plaintiff is the owner of certain letters patent granted to him, and dated the —— day of —— 18—, and numbered ——, for [*here set out the title*]. (The said letters patent were amended the —— day of —— 18—, pursuant to the order of ——, dated ——.)

1*a*. The plaintiff is the registered legal owner of certain letters patent granted to X. Y., and dated the —— day of —— 18—, and numbered ——, for [*here set out the title*]. The said letters patent were duly assigned to the plaintiff by an assignment dated the —— day of —— 18—, which said assignment was on the —— day of —— 18— duly registered in the Patent Office on the —— day of —— 18—, since which time the plaintiff has remained the sole registered owner of the said letters patent. [The above form must of course be varied in the case of actions by administrators or executors to suit the nature of the case.]

2. Since the said —— day of —— 18—, and prior to the issue of the writ herein, the defendants have infringed the

said letters patent, and have made, sold, supplied, let on hire and used (——) manufactured according to the invention in respect of which the said letters patent were granted, and they have since continued and threaten and intend to continue so to do, unless restrained by the order of this Honourable Court.

The plaintiffs claim :—

Injunction. 1. That the defendants, their servants, agents, and workmen, may be restrained by injunction during the continuance of the said letters patent from manufacturing, selling, letting on hire, supplying, or using any (——) manufactured according to or in the manner described in the specifications filed in pursuance of such letters patent, or according to or in any manner only colourably differing from the same, and generally from infringing the rights of the plaintiffs in respect of such letters patent.

Infringing articles. 2. That the defendants may be ordered to deliver up to the plaintiffs all such (——) as aforesaid as are in the possession or power of the defendants.

Account. 3. That an account may be taken of all gains and profits made by the defendants by the manufacture, sale, letting on hire, supply, or user of such (——) manufactured, sold, let on hire, supplied, or used by the defendants, or by any person or persons by the order or for the use of the defendants, and that the defendants may be ordered to pay the amount of such gains and profits to the plaintiffs.

Damages. 4. That the defendants may be ordered to pay damages to the plaintiffs for the infringement of their said patent rights.

Costs. 5. That the defendants may be ordered to pay the costs of this action.

Costs as between solicitor and client. 6. The plaintiffs claim their full costs, charges, and expenses as between solicitor and client. In an action brought by the plaintiffs (and others) against —— 18—, B. No. ——, for infringements of the said letters patent, Mr. Justice —— certified that the

validity of the said respective letters patent came in question.

7. Such further or other relief as the nature of the case may require.

(Signed) ——

Delivered the —— day of —— 18— by —— of —— in the ——, solicitors for the plaintiffs.

See *Useful Patents Co.* v. *Rylands*, 1885, 2 R. P. C. 257; *Hicking* v. *Fraser*, 1885, 3 R. P. C. 5.

Particulars of Breaches.

"In the High Court of Justice.

—— Division.

18—. B. No. ——.

Writ issued,

Between A. B. —— *Plaintiff.*
and C. D. —— *Defendant.*

The following are particulars of the breaches complained of in this action.

Delivered the —— day of —— 18— by —— defendant's solicitor.

The object of particulars of breaches is to inform the defendant, first, of what he is alleged to have done; secondly, what parts of the plaintiff's patent he is alleged to have infringed, and also, when necessary, how his acts constitute infringement. See *ante*, p. 362, and cases there cited. In the case of a very simple patent the following form has been held sufficient.

"That the defendants have at divers times during the years 1887 and 1888 infringed the patent of the plaintiff in the statement of claim mentioned by the manufacture and sale at the defendant's works at Hyde, in the county of Chester, or elsewhere in Great Britain, of felt hats, caps, and other head coverings made or manufactured in accordance, or substantially

in accordance, with the invention forming the subject of the plaintiff's patent and described in the specification filed under the said letters patent and claimed in the first five claims therein: Such felt hats, caps, and other head coverings having a veneering material consisting of wool or fur cut, ground, or otherwise reduced to a short staple, applied to the forms or bodies thereof: (*Cheetham* v. *Oldham*, 1888, 5 R. P. C. 625).

But, as a general rule, more particulars of the dates and places of sale would be required, thus:

"In particular the plaintiffs complain of the sale [*here set out time, place, and articles of the sales or manufactures complained of. There may also be added*] Save as aforesaid the precise date and number of the defendant's infringements are not at present known to the plaintiffs; but the plaintiffs will seek to recover from the defendants full compensation in respect of the same.

When the infringement amounts only to a colourable imitation, it is sometimes essential to describe more in detail what the defendant has done. See for example: *Haslam* v. *Hall*, 1887, 4 R. P. C. 204, in which case an order was made that the claims alleged to have been infringed should be particularised. If an article complained of has been made an exhibit in some affidavit, the simplest way in describing the infringing article is to refer to it. In addition to the cases cited, *ante*, p. 363, see *Fairburn* v. *Household*, 1886, 3 R. P. C. 265; *Ehrlich* v. *Ihlee*, 1888, 5 R. P. C. 200; *Miller* v. *Scarle, Barker & Co.*, 1893, 10 R. P. C. 109; *Casella* v. *Levinstein*, 1891, 8 R. P. C. 474.

Form of Application for Further and Better Particulars of Breaches.

This will be in the usual form of a summons, specifying what further particulars are required, asking that the further particulars shall be delivered within a named time,

and that the defendant have a certain number of days after their delivery to deliver his defence; and for costs, see *Walter Church Engineering Co.* v. *Wilson*, 1886, 3 R. P. C. 126, and *Tilghman's Patent Sand Blast Co.* v. *Wright*, 1884, 1 R. P. C. 104.

Form of Order for Further and Better Particulars of Breaches.

"(Upon the application of the defendants for directions, under Order 30, Rule 1 of the Rules of the Supreme Court, 1883, which, upon hearing the solicitors for the applicants and for the plaintiffs, and upon reading the writ of summons issued the —— the statement of claim and particulars hereinafter mentioned delivered the —— and an affirmation of —— was adjourned to be heard accordingly) upon hearing counsel for the applicants and for the plaintiffs, and upon reading the said affirmation, an order dated —— made in an action entitled —— an affidavit of —— in the last-mentioned action, and the particulars in writing of the breaches alleged to have been committed by the defendants delivered by the plaintiffs on the —— with their statement of claim; this Court being of opinion that such particulars are insufficient doth order that the plaintiffs do within —— days deliver to the defendant further and better particulars in writing of the breaches alleged to have been committed by the defendant on which the plaintiff intends to rely at the time of the trial of this action, specifying by reference to the pages and lines the parts of the plaintiff's specification in respect of which such alleged breaches have been committed, and the names of the persons to whom infringing goods have been sold as alleged in the particulars of breaches, together with the dates of the breaches alleged. And it is ordered that the defendant do have —— days after the delivery of such particulars to amend (deliver) his statement of defence. And it is ordered that the costs of the said application (in chambers, and occasioned by the adjournment thereof into Court) be costs in the action.

Form of Statement of Defence.

(*Heading as usual.*)

1. The defendant has not infringed the said letters patent.
2. The plaintiff is not the registered legal owner of the said letters patent, nor were the same assigned to him as alleged or at all.

Other pleas are usually added, as, that the patent is bad for want of novelty or utility. They should be in the most general form, the details being supplied in the particulars of objections.

Form of particulars of Objections.

General remarks upon particulars of objections will be found *ante*, p. 267. They sometimes include what might be more properly given under the defence, *e.g.* denial of infringement. This perhaps is due to the somewhat vague form of the statute, *ante*, p. 455. The sufficiency of particulars is a matter for the discretion of the court. The use of them is to prevent surprises, and each case must naturally stand on its own merits. When fraud is alleged, particulars of it should always be given. For general examples of forms of particulars the following cases may be consulted: *Germ Milling Co.* v. *Robinson*, 1886, 3 R. P. C. 256; *American Braided Wire Co.* v. *Thompson*, 1887, 4 R. P. C. 318; *Goulard & Gibbs' Patent*, 1888, 5 R. P. C. 530, 6 R. P. C. 218; *Morgan* v. *Windover*, 1890, 7 R. P. C. 446; *Baker* v. *Kinnell*, 1893, 10 R. P. C. 443.

The general form of particulars of objections will be as follows:—

'In the High Court of Justice.

—— Division.

18—. B. No. ——.

Between A. B. —— *Plaintiff.*

and C. D. —— *Defendant.*

The following are the particulars of objections to the said letters patent in the statement of claim set forth

upon which the defendant intends to rely at the trial of this action.

Declared the —— day of —— 18—, by —— defendant's solicitor.

Particulars of objections may be grouped under the following heads:—

1. That the plaintiff is not the true and first inventor.
2. That the patent is bad as being
   (*a*) For a bare principle;
   (*b*) Contra bonos mores.
3. That the patent is bad for want of utility.
4. That the patent is bad for want of novelty, being for a matter of public general knowledge at the time it was applied for.
5. That the patent had been anticipated by prior publications, *e.g.*, prior specifications, books, articles, exhibitions, etc.
6. That the patent had been anticipated by prior public user.
7. That the specification is bad on the ground
   (*a*) of disconformity;
   (*b*) the new not sufficiently distinguished from the old;
   (*c*) that the specifications are ambiguous and unintelligible;
   (*d*) that the specifications are misleading;
   (*e*) that the specifications contain false suggestions;
   (*f*) that the specification does not contain sufficient information to enable the invention to be used;
   (*g*) that the invention did not disclose the most beneficial method with which he was acquainted.
8. That the plaintiff's patent is bad as being in derogation of a prior grant. This objection is dealt with on p. 369.

These objections are treated in order.

1.—*The plaintiff not the first and true inventor.*

"That the plaintiff was not the true and first inventor of the alleged invention in respect of which the letters *ante*, p. 368.

patent in the statement of claim mentioned are alleged to have been granted.

This objection is commonly used, but is somewhat vague: *see ante*, p. 368. If it is meant that the plaintiff fraudulently got the invention from some one else, then greater detail ought to be given, *e.g.*

"That the plaintiff obtained his patent by misrepresentation, in falsely alleging that he was the first and true inventor. [Details should here be given.] (In *Oddy* v. *Smith*, 1888, 5 R. P. C. 506, no further details were given, but the objection was not insisted on at the trial. The necessity for further detail appears from the following cases: *Haddans' Patent*, 1885, 2 R. P. C. 219; *Thomson* v. *Macdonald & Co.*, 1890, 8 R. P. C. 8; *Siddel* v. *Vickers*, 1887, 5 R. P. C. 85.)

2.—*Patent bad as being for a principle or contra bonos mores.*

"That the said alleged invention was not the proper subject-matter for a patent, in that —— [Here should be set out the reason, as that such and such parts, or all of the invention were for a principle and not for a manufacture, or that the subject-matter was against the law, or public morality.]

ante, p. 45.
ante, p. 63.

3.—*That the patent is bad for want of utility.*

"That the said alleged invention [or some specific part thereof] was not useful at the date of the said alleged letters patent for the same. (No details are required.)

ante, pp. 65, 369.

4.—*Want of novelty in regard to general public knowledge at the time.*

"That the said alleged invention, in so far as it consists [*Here describe the parts objected to, Baker* v. *Kinnell* 1893, 10 R. P. C. 443], was not new or the proper

subject of letters patent, having regard to the common and public knowledge at the date thereof. *ante*, p. 259.

See *Siemens* v. *Karo*, 1891, 8 R. P. C. 377; *Holliday* v. *Heppenstall*, 1889, 6 R. P. C. 326; *Nettlefolds* v. *Reynolds*, 1892, 9 R. P. C. 377, and *ante*, p. 370. The use of this objection is to introduce evidence of general public knowledge, but under it no special books or specifications could be introduced (unless the plaintiff chose to cross-examine to them). It somewhat resembles the general evidence of character given in criminal cases. See also *Automatic Weighing Machine Co.* v. *Knight*, 1889, 6 R. P. C. 302; *Boyd* v. *Horrocks*, 1886, 3 R. P. C. 281; *Solvo Laundry Co.* v. *Mackie*, 1893, 10 R. P. C. 68. This objection sometimes takes the following form:

"That the said alleged invention was a mere application to (——) of means previously well known to engineers for the purpose of ——

See *Gadd* v. *Mayor of Manchester*, 1892, 9 R. P. C. 251; *Deutche Nähmaschinen Fabrik* v. *Pfaff*, 1890, 7 R. P. C. 252; *Moseley* v. *Victoria Rubber Co.*, 1886, 4 R. P. C. 245; *Goulard & Gibbs' Patent*, 1890, 7 R. P. C. 371; *Delta Metal Co.* v. *Maxim Nordenfelt*, 1891, 8 R. P. C. 170.

The objection sometimes takes a hypothetical form, thus:

"That if the specification of the plaintiff's patent is construed so as to include (the spindles and bobbins) of which complaint is made in this action, the plaintiff's alleged invention was not the proper subject-matter of letters patent, having regard to the state of public general knowledge at the date of the granting of the said letters patent: *Sidebottom* v. *Fielden*, 1891, 8 R. P. C. 267.

5.—Objection on the ground of prior publication.

Objections on the ground of want of novelty, under which special publications or uses are intended to be given in evidence, take a more precise and special form.

"That the said invention [as to so much of it as—*Here set out the parts complained of*; *Law* v. *Ashworth*, 1890, 7 R. P. C. 86], was not new at the date of the said letters patent, but was published within the realm before the date thereof, in manner following, that is to say:

ante, p. 259.

This serves as a general heading to cover objections of prior publication or user. In what is to follow reasonable particularity should be given as to the part of the plaintiff's patent alleged to be old, as to the user and publications, and, if needful, as to the mode in which they constitute anticipations. See *Blakey* v. *Latham*, 1889, 6 R. P. C. 31; *Tucker* v. *Kaye*, 1891, 8 R. P. C. 231; *Ehrlich* v. *Ihlee*, 1888, 5 R. P. C. 440; *Boyd* v. *Horrocks*, 1888, 5 R. P. C. 561; *Morgan* v. *Windover*, 1890, 7 R. P. C. 446, and consult the cases cited, *ante*, p. 371. Sometimes the anticipating books or patent specifications are put into a tabular form so as readily to catch the eye: *Fairfax* v. *Lyons*, 1891, 8 R. P. C. 405. The above given form may then proceed.

ante, p. 371.

"By the complete (or provisional) specifications of letters patent granted to —— and dated —— day of —— 18—, No. —— page —— line —— to page —— line ——.

The necessity of giving the pages where practicable is discussed, *ante*, p. 372.

"By the publication of an article in —— dated —— day of —— 18—, page —— column —— lines ——.

This form may be varied as necessary to suit translations, publication of drawings, exhibition of models, for example.

By the exhibition and description of (——) on the —— day of —— 18—, at ——. [*Here should follow the exhibition, lecture hall, or other place where the publication took place*]. *Nettlefolds* v. *Reynolds*, 1892, 9 R. P. C. 277.

Objections on the ground of prior specific publication may sometimes also take a hypothetical form, thus:

"That if the specification of the plaintiff's patent is construed so as to include the (spindles and bobbins), of which complaint is made in this action, the plaintiff's alleged invention was not new at the date of the said letters patent, but had been published within this realm before the date in and by [*Here follow the specific instances of prior publication* ——] *Sidebottom* v. *Fielden*, 1891, 8 R. P. C. 267; *Hocking* v. *Hocking*, 1886, 3 R. P. C. 291, *ante*, p. 371.

6.—*Objection on the ground of prior public user.*

Particulars of objections founded on prior user take almost the same form as those given above in the cases of prior publications, thus:

"By the use, manufacture, sale, exposure for sale, or letting for hire, of [*Here describe the anticipating articles, and the places at, persons by, and dates when they were used*].

The instances of prior user should be given in fairly full detail, so as to enable enquiry to be made: *Smith* v. *Lang*, 1890, 7 R. P. C. 150, and the cases cited, *ante*, p. 372. This objection is also sometimes put in a hypothetical form as raised only in case such a construction is given to the patent as causes the defendant's acts to be infringements: *Ashworth* v. *Law*, 1890, 7 R. P. C. 232; *Boyd* v. *Farrar*, 1887, 5 R. P. C. 33.

7.—*Objection that the specification is imperfect.*

"That the complete specification of the said letters patent purporting to have been sent in and accepted prior to the grant thereof is imperfect, and misleading on the following grounds—

This objection constitutes an attack on the form and substance of the specification, and, as a general rule it will always be needful to specify what parts are attacked, and the grounds of objection. These, as a rule, are, disconformity, *ante*, p. 373.

insufficient description, ambiguity, or failure to reveal the best method known to the patentee. In all these cases specific details of the objection are needful.

(*a*) *Disconformity.*

"That the alleged invention described in the complete specification is a different invention from that described in the provisional specification (and title), in that —— [*Here specify the disconformity*]. *Goulard and Gibbs's Patent*, 1890, 7 R. P. C. 371; see *ante*, p. 373.

ante, pp. 170, 373.

The objection of disconformity by amendment is treated, *ante*, p. 222.

"That the alleged invention described in the complete specification as amended is a different invention from that described in the provisional specification and in the title, and in the complete specification as originally sent, in that —— [*Here specify the disconformity. Moser* v. *Marsden*, 1893, 10 R. P. C. 207].

The objection of disconformity is sometimes put into a hypothetical form, thus:

"That if the complete specification be so construed as to include the alleged infringements of the defendants, it claims an invention different from that described in the provisional specification [*Here specify the objection*]. *Nuttall* v. *Hargreaves*, 1891, 8 R. P. C. 274, 451.

(*b*) *What is new not sufficiently distinguished from what is old.*

"That the specification of the alleged invention is insufficient in that the parts which are claimed to be new, are not sufficiently distinguished from those which are old —— [*Here specify the parts complained of*]. *Baker* v. *Kinnell*, 1893, 10 R. P. C. 443; *Delta Metal Co.* v. *Maxim Nordenfelt*, 1893, 8 R. P. C. 170;

ante, p. 183.

Thomson v. *Batty*, 1888, 6 R. P. C. 88; *Fisher* v. *Dewick*, 1838, 1 W. P. C. 551, n.

(c) *Specification ambiguous and unintelligible.*

"That the specification of the alleged inventions are vague and ambiguous and do not intelligibly or sufficiently describe the said invention or how it is to be performed —— [*Here specify the parts complained of, and the objection*]. *ante*, p. 185

(d) *Specification misleading.*

"That the specifications of the said alleged invention are ambiguous and calculated to mislead in that —— [*Here specify the parts complained of, and the objections to them*]. (*Goulard and Gibbs's Patent*, 1890, 7 R. P. C. 371.)

This objection is sometimes put into a hypothetical form, for example:

"If the specification be construed so as to comprise [*compass cards*] as made by the defendants, then the defendants will object that such specification is ambiguous, insufficient and misleading, inasmuch as it does not sufficiently ascertain what the plaintiff claimed to have invented, and by what means such invention was to be performed. (*Thomson* v. *Batty*, 1888, 6 R. P. C. 89.)

(e) *That the specification contains false suggestions.*

"That the said alleged letters patent contain false suggestions, to wit, that (such and such parts ——) are described as useful and necessary, whereas the said —— is not of any utility: *Nettlefolds* v. *Reynolds*, 1892, 9 R. P. C. 276.

---

ante, p. 188.

(*f*) *That the specification does not contain sufficient information to enable the invention to be practised.*

"That the specification of the said alleged invention is insufficient in that it does not contain sufficient description to enable a workman skilled in —— trade to —— [*Here details should be given*]. (*Nettlefolds* v. *Reynolds*, 1892, 9 R. P. C. 276; *Crompton* v. *Anglo-American Brush Co.*, 1887, 4 R. P. C. 197.)

---

ante, p. 191.

(*g*) *That the inventor did not disclose the best method with which he was acquainted.*

"That the inventor in his complete specification did not state the most beneficial method with which he was then acquainted of practising his said invention —— [*Here specify the objection*]. (*Ante*, p. 374.)

Summons for (or to be allowed to give) further and better Particulars of Objections.

The form of this will be the usual form (*see* Summons for further and better Particulars of Breaches). It should specify the further particulars asked for or proposed. *Boyd* v. *Horrocks*, 1886, 3 R. P. C. 287. The application may be made by either party: *ante*, p. 375.

Order for further and better Particulars of Objections.

See ante, p. 375.

The application of the plaintiff, which, upon hearing, &c. in Chambers, was adjourned to be heard in Court, coming on this day to be heard accordingly, and upon hearing counsel for the plaintiff and defendant, and upon reading the particulars of objections delivered by the defendant with his statement of defence, this Court doth order that the de-

fendant do on or before the —— day of —— 18— deliver to the plaintiff or his solicitors further and better particulars of objections.

1. As to paragraph — of the said particulars delivered by giving the times and places of prior users which will be relied on under this paragraph, and by stating with reference to each of such prior users which parts of plaintiff's invention by reference to claiming clauses of the specification are alleged to be anticipated thereby.
2. As to paragraph — of the said particulars delivered, by giving particulars of the alleged untruth and misrepresentations.
3. As to paragraphs — and —, by stating in what respects the invention described in the plaintiff's specification is alleged to differ from that disclosed in or described by the provisional specification.
4. As to paragraphs — and —, by giving such particulars of each of the articles relied upon as will suffice to identify specifically each of such alleged prior users.
5. As to paragraph —, by stating with reference to each specification relied upon which parts of plaintiff's invention, by reference to claiming clauses of the plaintiff's specification, are alleged to be anticipated thereby. And the plaintiff's costs of this application, so far as it relates to the said paragraphs —, —, —, —, and — of the said particulars, and as it relates to paragraphs — and —, except as hereinafter mentioned, are to be their costs in any event, and the defendant's costs of this application, so far as it relates to paragraphs — and —, and so much of paragraphs — and — of the said particulars as is not varied by this order, are to be their costs in any event.

Form used in Boyd v. Farrar, 1887, 5 R. P. C. 33.

Upon the application of the plaintiffs, and hearing the solicitors, and also counsel for the said plaintiffs, and for the defendants, and upon reading the particulars of the defen-

dants' objections, delivered on the 3rd February, 1887, it is ordered that the defendants do within seven days deliver to the plaintiffs further and better particulars in writing of paragraph 5 of the defendants' particulars of objections, shewing how and in what respect the specification filed in pursuance of the letters patent does not sufficiently describe and ascertain the nature of the alleged invention, and in what manner the same is to be performed by reference when necessary to the subject-matter of the said specification. And it is ordered that the plaintiffs' costs of and consequent upon the said application, be their costs in any event.

Form used in Crompton v. *Anglo-American Brush Corporation*, 1887, 4 R. P. C. 197.

When a defendant obtains leave to amend his particulars of objections after the cause is in the list for trial, it is not unusual to add a clause giving the plaintiff leave to discontinue; and that the defendants should pay his costs as from the time of the delivery of the first set of objections: *ante*, p. 375.

Form of Interrogatories.

Interrogatories may be delivered by either party: *ante*, p. 382. If infringement is denied, those by the plaintiff usually go through the whole patent; asking the defendant whether he uses such and such parts of the plaintiff's invention. An example will be found in *Benno Jaffe* v. *Richardson*, 1893, 10 R. P. C. 137. Or again, if the defendant has pleaded that the invention is not new, by reason of general public knowledge, he may be interrogated as to any facts he knows relating to such general knowledge. *Pascall* v. *Toope*, 1890, 7 R. P. C. 126; 8 R. P. C. 1.

A Form of Interrogatory by defendants to the plaintiffs with a view to shewing that plaintiffs' patent is not useful, will be found in *Rylands* v. *Ashley*, 1890, 7 R. P. C. 176. Interrogatories by defendant with a view of shewing that the plaintiff's patent is not novel, were put in *Ehrlich* v. *Ihlee*, but most of them considered too fishing and disallowed: 1888, 5 R. P. C. 38

Application for Leave to Amend Specification during Action, and Order thereon.

See *Bray* v. *Gardner*, 1887, 4 R. P. C. 40.
Singer v. *Stassen*, 1884, 1 R. P. C. 122
Cropper v. *Smith*, 1884, 1 R. P. C. 254.
Allen v. *Doulton*, 1887, 4 R. P. C. 378.

The application may be made at Chambers: *ante*, p. 217.

Upon motion this day made unto this Court by counsel for the plaintiffs, and upon hearing counsel for the defendants, and upon reading the pleadings in this action, an affidavit, &c. It is ordered that the plaintiffs be at liberty to apply at the Patent Office for leave to further amend the specifications of their patent, No —— 18—, by striking out the second claim thereof, and by making such other alterations (if any) as will be rendered necessary thereby. And it is ordered that after such amendment has been made the plaintiffs be at liberty within fourteen days to amend their statement of claim, so as to limit this action to the amended specification of the said patent, and in default thereof it is ordered that this action do stand dismissed out of this Court with costs to be taxed by the taxing master, and paid by the plaintiffs to the defendants. And it is ordered that the costs of the defendants, of this application, and of and occasioned by such last-mentioned amendment, be their costs in any event, and be borne by the said plaintiffs. And it is ordered that (in the event of this action proceeding) all other costs be reserved. Used in *Haslam* v. *Goodfellow*, 1887, 5 R. P. C. 28.

In pursuance of this order, an application to amend may be made: see form, p. 518.

Notice of Opposition to Amendment.

ante, p. 218.

This will be in form on p. 520. The following is an example of the grounds of an opposition:

(1) That the invention claimed by the patentee was not novel.

(2) That the first and second claims in the said specifications were purposely prepared, so as to includ[illegible]tters now sought to be disclaimed (althou[illegible] the time the said claims were prepared, and the final specification was filed, the invention so claimed was known to the patentee not to be new), in order that the patent might be used for the purpose of threatening litigation against persons manufacturing reservoir penholders, according to methods known at the date of the said letters patent.

(3) That if the specification was prepared in good faith (which the opponents deny), the same specification was not prepared with reasonable knowledge and skill in that behalf. *Re Hearson's Patent*, 1884 1 R. P. C. 214.

(1) —— That by the proposed amendment, the applicant sought to extend the right granted in and by the patent, and to insert in the specification matter [illegible]ther than by way of disclaiming [*correction or explanation*] —— And also on the grounds that the addition of drawings is not by way of disclaimer, correction or explanation —— and that an action by the opponent was pending to restrain the patentee and his partners from continuing threats of legal proceedings in respect of alleged infringements of the patent —— and on the ground that the opponents were licensees of the said patent, and that the proposed amendment would limit and curtail the rights granted to the licensees. *Lang's Patent*, 1890, 7 R. P. C. 470.

It is to be noticed that when an action is pending, the powers of amendment are narrow, being limited to disclaimer only. Whereas when no action is pending they may be made by way of disclaimer, correction or explanations (*ante*, p. 216). For this reason, as also from the fact that conditions

are frequently imposed by the Court in giving leave to apply to amend (*ante*, p. 220), it is very frequently better, and even less costly, for a plaintiff to discontinue and pay the costs, to amend, and then bring a fresh action.

Form of Order for Inspection of Plaintiff's Premises, with a View of seeing how Plaintiff's Process is worked.

ante, p. 379.

See *Germ Milling Co.* v. *Robinson*, 1885, 3 R. P. C. 14.

Form of Order for Inspection of Defendant's Premises.

ante, p. 380.

Upon motion, &c., and upon reading the writ issued in this action, affidavits, &c., of —— filed in the action of *G.* v. *The H. F. E. Co., Ltd.*, 1887, G. 573, namely, affidavits, &c. And the plaintiffs by their counsel undertaking during the inspection hereinafter directed or until further order not to threaten the defendants, Messieurs G. and M., or their customers, or any other person or persons by circulars, advertisements, or otherwise, with any legal proceedings or liability in respect of the manufacture, use, sale, or purchase of refrigerating engines or machines by the said defendants, or the use, sale, or purchase of such engines or machines sold by or offered for sale by any purchaser from the said defendants. This Court doth order that the plaintiffs be at liberty on giving four days' notice by —— [*experts*] and solicitor to inspect refrigerating machines manufactured and in course of manufacture by the defendants, Messrs. G. and M., for the other defendants or one of them which are referred to in the said affidavit of R. M. in the said action of *G.* v. *The H. F. E. Co., Ltd.*, 1887, G. 573. And it is ordered that the costs of this application be costs in the action. See *Haslam* v. *Goodfellow*, 1887, 5 R. P. C. 28. An order was also made in *Plating Co.* v. *Farquharson*, 1883, Griff. P. C. 187.

---

ante, pp. 380, 386.

Order for Experiments to be Conducted by an Independent Expert Selected by the Court.

The Court being desirous of obtaining the opinion of Professor Roscoe upon the questions set forth or referred to in the schedule hereto, doth order that such questions be referred to the said Professor for inquiry and report, and that a specification of the patent dated 25th February, 1878, No. 786, be supplied to the said Professor.

Schedule.

A question has arisen in the trial of this action between the owners of the patent and the parties who are alleged to have infringed it, as to the sufficiency of the specification as regards the first process described in it. For the information of the Court, Professor Roscoe is requested to perform the experiments which may be necessary to answer the questions hereafter stated, following exactly the directions contained in the example given [*in the specification—here follows the description in the specification*].

Professor Roscoe is requested to state to the Court whether he obtained any and what results from the experiments so made——. If Professor Roscoe has any difficulty in understanding the instructions, he is requested to see the Judge personally, who will give him such instructions as are necessary. He is requested to test carefully all the materials he employs, and to see that he has no communication at all with the parties in the action or any of their agents or advisers while making the experiments, but one chemist representing either party is permitted to be present; and the costs to be costs in the cause. See *Badische Anilin Fabrik* v. *Levinstein*, 1885, 2 R. P. C. 77.

Order Directing Issue of Infringement to be Tried before Trial of the Other Issues.

Made under R. S. C., Ord. XXXVI. r. 8. *United Telephone Co.* v. *Mottishead*, 1886, 3 R. P. C. 213. See *ante*, p. 386.

Forms of Final Judgment.

ante, p. 397.

A form will be found set out at length in *Westinghouse* v. *Lancashire Railway Co.*, 1884, 1 R. P. C. 252, together with the amendments on appeal. For a form of judgment in default of defence, see *Wenham* v. *Carpenter*, 1887, 5 R. P. C. 69; and a consent judgment, *Spencer* v. *Ancoats Vale Co.*, 1888, 6 R. P. C. 48.

Form of Special Case stated for the Opinion of the Court.

See *Harris* v. *Rothwell*, 1887, 4 R. P. C. 226.

Order for Inquiry as to Damages.

See *American Braided Wire Co.* v. *Thompson*, 1888, 5 R. P. C. 538.

ante, p. 400.

Report as to Damages by Official Referee.

See *ibid.*, 7 R. P. C. 48, 153.

Discovery in Aid of Execution.

ante, p. 405.

Upon, &c. And upon reading the judgment dated the —— an order of the Court of Appeal dated the —— an order dated the —— and an affidavit of the defendants —— this Court doth order that the defendants T. & Co. do within seven days after the service of this order at all seasonable times upon reasonable notice produce at —— for the inspection of the plaintiffs all such parts of the documents as are set out in the second part of the first schedule to the affidavit of the defendants filed the —— as discloso the names

of the customers of the firm of T. & Co. to whom any articles made in infringement of the plaintiffs' letters patent in the order of the Court of Appeal of the —— mentioned have been sold by the defendants, and also the prices for which any such articles were respectively sold. And the applicants, their solicitors and agents, are to be at liberty to inspect and peruse the parts of the documents so produced, and to take copies thereof and abstracts thereof, and extracts therefrom, as the applicants shall be advised at their expense. And it is ordered that the defendants do produce the same in this cause as the plaintiffs shall require, and the plaintiffs are to be at liberty to make such further application as to all or any of the documents mentioned in such affidavit as they may be advised. And it is ordered that the defendants T. & Co. do pay to the plaintiffs —— their costs of the application in chambers and occasioned by the adjournment thereof into Court, such costs to be taxed by the taxing master. See *American Braided Wire Co.* v. *Thompson*, 1888, 5 R. P. C. 697; and *Siddell* v. *Vickers*, 1892, 9 R. P. C. 153. *Ante*, p. 405.

---

ante, p. 426.

Form of Motion for a New Trial.

The grounds of the motion are set out in *King* v. *Oliver*, 1884, 1 R. P. C. 42.

---

ante, p. 415.

Form of Indorsement on Writ in an Action for Threats.

The plaintiff's claim is:—

1. For an injunction to restrain the defendants from continuing to threaten the plaintiff, or any other person or persons whereby the plaintiff may be aggrieved, by circulars, advertisements, or otherwise, with any legal proceedings or liability in respect of any alleged manufacture, use, sale, or purchase of any invention in infringement of the defendant's patent rights (if any).
2. For damages for injury accrued to the plaintiff in respect of the said threats.

Statement of Claim in Actions for Threats.

For an outline of such a claim, see *Kurtz* v. *Spence*, 1887, 5 R. P. C. 164.

The particulars of objections in the case of actions for threats will resemble those given in an action for infringement.

Form of Writ, Motion for an Interim Injunction and Order for an Interim Injunction in an Action to Restrain Threats.

ante, p. 417.

The plaintiff's claim is:—

For an injunction to restrain the defendant personally or by his servants, agents, and workmen, by circulars, letters, or otherwise, from threatening any person with legal proceedings or liability in respect of the manufacture, use, sale, or purchase of a certain tap-union of which the plaintiff is the patentee, and from interfering by such threats or otherwise with the manufacture, use, sale, or purchase of the plaintiff's invention. (Form used in *Challender* v. *Royle*, 1887, 36 Ch. D. 427, and followed in *Colley* v. *Hart*, 1888, 6 R. P. C. 21. In *Challender* v. *Royle* the defendant Royle was a prior patentee of the same invention, and had commenced an action against the vendors of the plaintiff's goods.)

A form of interim injunction to restrain threats is also given in *Barnett* v. *Barrett*, 1884, 1 R. P. C. 9, and *Fenner* v. *Wilson*, 1893, 10 R. P. C. 286, where an undertaking as to damages was required (as is usual).

Form of Petition for Revocation of a Patent.

ante, p. 421.

See *Avery's Patent*, 1887, 4 R. P. C. 157, 323. The following form was used in the petition of Ferranti for revocation of the patent granted to Messrs. Goulard and Gibbs, 1887, 5 R. P. C. 189, 525.

In the Matter of Goulard and Gibbs's Patent, No. 4362, 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 Sebastien Ziani de Ferranti,

Sheweth as follows :—

1. Your petitioner is an electrician, and the patentee of many inventions in connection with the production, distribution, and utilisation of electric currents, which inventions are now in extensive practical use.

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 with the conductor conveying the current.

3. In or about the month of —— 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. ——— A.D. 1885, 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 Sir Coutts Lindsay and Co. The same 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 Lucien Goulard and John Dixon Gibbs, and numbered 4362, A.D. 1882. The invention in respect of which the said letters patent were granted was in nowise 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 ——— 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. 4362, A.D. 1882, or that such order may be made in the premises as to this honourable Court may seem meet.

And your petitioner will ever pray, &c.

(Signature of Petitioner.)

The particulars of objections which accompanied the above petition will be found, 5 R. P. C. p. 529.

Order for Revocation of Patent.

In the Matter of Goulard and Gibbs's Patent, No. 4362, A.D. 1882.

and

In the Matter of the Patents, Designs, and Trade Marks Act, 1883.

Kekewich, J. 9th July, 1888.

Upon the petition of Sebastien Ziani de Ferranti of ——— in the ——— on December 11th, 1886, preferred unto this Court, and upon hearing counsel for the petitioner, and for the respondents, G., G., and the N. Co. for the Distribution of Electricity by Secondary Generators, Ltd., on July 29th and on June 3rd, 4th, 5th, 6th, and 9th, and upon reading the petition, the amended particulars of objections 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. 4362, A.D. 1882, in the petition mentioned granted to G. and G. be revoked.

And it is ordered that the respondents, Goulard and Gibbs, and the N. Co. for the Distribution of Electricity by Secondary Generators, Ltd., pay to the petitioner, F., his costs of the said petition (to be taxed by the taxing master on the higher scale).

Form of Petition to the Privy Council for Extension.

ante, p. 330.

Extension was refused to this patent, on the ground of want of merit in the invention, but the accounts afford a good example of the manner of preparing them.

In the Privy Council.

Presented the 24th day of December, 1891.

To the Queen's Most Excellent Majesty in Council.

In the matter of Letters Patent granted to Fountain Livet, formerly of 11 Western Road, Ealing, in the County of Middlesex, but now of 67 Finsbury Pavement, in the City of London, Civil Engineer, for his Invention of Improvements in Internal Fire Steam Boilers, also in Furnace Bars and Flues for the same and other like purposes for effecting combustion of any sort of fuel and utilising heat with greater economy than hitherto, bearing date the 29th day of March, 1878, No. 1242.

The Humble Petition of the above-named Fountain Livet Sheweth—

1. That for several years prior to 1878 your petitioner devoted considerable time and attention to the scientific study of heat, and its practical application to steam boilers which are internally fired.

2. Your petitioner had in view the following objects:—

(*a*) Economy of coal.

(*b*) The utilisation of any kind of fuel.

(*c*) No smoke.

(*d*) Quickly getting up steam, and keeping the steam pressure constant.

(*e*) Steam dry, and consequently no priming.

(*f*) Reduction of chimney stacks in height.

3. That your petitioner, after numerous practical experiments and great personal application and expense, succeeded in perfecting his invention, which attained each of the objects he had in view, and his invention was and is of great benefit to manufacturers and also to the public.

4. That your Majesty was graciously pleased by your Majesty's Royal Letters Patent under the Great Seal of the United Kingdom of Great Britain and Ireland, bearing date the 29th day of March, 1878, No. 1242, to grant unto your petitioner, his executors, administrators, and assigns, the sole privilege and authority to use his said invention within the United Kingdom, the Channel Islands, and the Isle of Man for the term of fourteen years from the date of the said letters patent.

5. That your petitioner, in compliance with a proviso in the said letters patent contained, duly made and caused to be filed in the Great Seal Patent Office, within six calendar months from the date of the said letters patent, an instrument in writing under his hand and seal, which together with the drawings particularly describe and ascertain the nature of the said invention, and the manner in which the same was to be performed.

ante, p. 339.

6. That your petitioner also obtained patent privileges or protection for the said invention in Hong Kong. The boilers set according to your petitioner's invention in Hong Kong were converted from ordinary brickwork set boilers, and the profits arising therefrom will be found in the accounts to be filed. The effect of this conversion was that over 25 per cent. of fuel was saved with an additional increase of steaming power of the boilers of 50 per cent.

Your petitioner also obtained patent privileges for the said invention in France and Belgium on the 18th and 24th June, 1879, and numbered 131, 273 and 48,574 respectively.

The foreign patents aforesaid lapsed shortly after they were obtained, in consequence of non-payment of fees and their not being worked as required by the laws of France and Belgium. Your petitioner not having been in a position to meet the expenses of keeping up the said patents, or of working the said invention, no licenses have been granted in respect of the aforesaid foreign patents. The Hong Kong patent is now in force and expires with the British patent.

Except as before mentioned, your petitioner has never obtained any foreign, Indian, or Colonial patents for his said invention.

7. The advantages attained by the invention of your petitioner can be briefly summarised as follows:—

(*a*) Saving in fuel. On an average over 20 per cent. of fuel is saved by the adoption of the petitioner's invention over any of the methods then in use.

(*b*) Any kind of fuel can be used, whereas manufacturers who require constant high pressure of steam are, as a rule, confined to particular classes of quickly-burning coal.

(*c*) Total absence of smoke, even when bituminous coals are used. Amongst the earlier years of this patent, namely in 1882, pour petitioner received the highest medal awarded at the Smoke Abatement Exhibition in London for his invention.

(*d*) Manufacturers are obliged to have larger boilers than necessary, in order to have the requisite amount of steam for their manufactures. In sugar refineries abundance of steam and constant pressures are absolutely essential. The invention of your petitioner allows the use of less number of boilers under like conditions.

(*e*) Steam very often carries off with it water not thoroughly converted into vapour; innumerable particles of water being in suspension with the steam, and this results in accidents in engines.

The disadvantages of "priming" are too well known to need description. Your petitioner's invention causes the steam to be dry, and there has been no instance of priming when the said invention has been used.

(*f*) The object of the high chimney stacks in general use is to obtain a draught, which in turn is to effect the combustion of the coal. The initial expense of building these high chimneys is great. A very usual height is 150 feet to 200 feet, costing about £200 to £300 per boiler on an installation of (say) twelve boilers. Where your petitioner's invention is adopted the chimney should be of such

a height as to be just above the level of the surrounding buildings, which would make the height usually between 50 to 70 feet. The cost of such a chimney averages from £50 to £60 per boiler on an installation of a similar number of boilers. A chimney stack of such moderate dimensions, in combination with your petitioner's invention, creates a natural and powerful draught and effects perfect combustion of any carbonaceous substances. Another advantage of your petitioner's invention, which is directly due to the successive expanding section of the flues, is the fact that workmen are enabled to clean them with great ease, and inspection is rendered much more easy. On account of the confined areas of the ordinary system inspection is often difficult.

8. The most important parts of the invention of your petitioner may be divided as follows, viz.:—

The compound fire-bar claimed in Claim 3 of his specification. The semi-circular form of side return flues, the sectional area of each flue increasing at each bend it makes around the boiler on its passage to the chimney (Claim 5).

and your petitioner only asks for a prolongation of the term of the said patent so far as concerns the said two parts of his invention referred to in Claims 3 and 5 of his said specification.

ante, p. 331.

9. About two months after the date of the patent your petitioner, by an indenture dated 15th May, 1878, granted an exclusive license to Messrs. Rennie of Blackfriars, during the term of the letters patent, to manufacture and sell land and marine steam boilers, with the improvements described in the said letters patent, and also the exclusive right of converting existing boilers within the following seven counties of England, viz.:—Sussex, Essex, Herts, Kent, Middlesex, Hants, and Surrey; but owing to the novelty of the invention and to manufacturers not caring for untried systems, they were unable to introduce the same and never

made use of their license, and your petitioner never received any royalty or other consideration under or for the same.

10. By indenture of mortgage of 10th March, 1879, your petitioner assigned the said letters patent to Harry Seymour Foster and Charles Hight by way of mortgage to secure £20 and further advances, and by an agreement of even date Messrs. Foster and Hight were to form a company for the purpose of working the said letters patent in consideration of £500 to be paid to them in cash and £500 in fully paid up shares of such company.

11. By an agreement dated also the 10th day of March, 1879, and made between your petitioner of the one part and the said Harry Foster as a trustee for a company therein proposed, being the company next hereinafter mentioned, your petitioner agreed to sell the said invention and patents to the said company for the sum of £7000, payable as to £2000, subject as in the said agreement mentioned, in cash, and as to the remaining £5000 in fully paid-up shares of the said company, the aforesaid sum of cash to be paid as to £500 within one calendar month after the allotment of shares and £500 within three calendar months after such allotment, and the remaining £1000 within four calendar months after such allotment, with power for the company in certain events therein mentioned to pay or discharge such two last-mentioned sums by the allotment of paid-up shares.

12. By an indenture of mortgage dated 22nd April, 1879, and made between the said Harry Seymour Foster and Charles Hight of the first part, your petitioner of the second part, and Thomas Edward Kershaw of the third part, the said letters patent were assigned by the said Harry Seymour Foster and Charles Hight and your petitioner to Thomas Edward Kershaw by way of mortgage to secure £400 and interest at 5 per cent., the aforesaid security of the said Harry Seymour Foster and Charles Hight being thereby postponed to the security made by the indenture now in statement.

Your petitioner subsequently transferred to the said

Thomas Edward Kershaw shares to the value of £400 in the company next mentioned in satisfaction of the last-mentioned debt. On the winding up of the company your petitioner paid off the aforesaid shares at par together with interest. Your petitioner has also paid and satisfied all claims of the said Harry Seymour Foster and Charles Hight under their said security.

13. That on the 15th day of July, 1879, a company was incorporated under the Companies Acts, 1862, under the name of "Livet's Improved Boilers and Furnace Company," as a limited company, with a capital of £10,000 divided into 1000 shares of £10, and by deed of assignment bearing date the 14th November, 1879, and made between your petitioner of the one part and Livet's Patent Improved Boilers and Furnace Company, Limited, of the other part, after reciting the above-mentioned agreement of the 10th March, 1879, between your petitioner and the said Harry Seymour Foster as trustee, and that by the memorandum of the 6th August, 1879, indorsed on the said agreement, it was agreed that the 500 fully paid-up shares agreed to be allotted to your petitioner should not be entitled to dividend in any year on which the ordinary shares had not previously received a dividend of ten per cent. on their subscribed capital; and after reciting the incorporation of the company, and that the company had paid to your petitioner the sum of £500 as provided by the said recited agreement, and had delivered to your petitioner the shares therein mentioned, your petitioner assigned to the said company the said invention and letters patent.

That your petitioner received shares in the said company to the nominal value, and received no cash except a sum of £500, which went to Messrs. Harry Seymour Foster and Charles Hight by virtue of clause 2 of the agreement of the 10th March, 1879, hereinbefore recited.

14. That your petitioner is a foreigner, and in 1879 spoke English imperfectly, and was but little acquainted with the English law relating to limited liability companies, and it came to his knowledge that he was liable in respect of the

shares allotted to him to the nominal amount of the shares held by him.

15. Under an agreement dated 10th May, 1880, your petitioner bound himself to serve the last-mentioned company for a term of three years, at a salary of £200 a year, with a further percentage on royalties received by the company as therein mentioned, the aggregate sum received by your petitioner not to exceed £2000 a year, and your petitioner was to devote all his time to the service of the company.

16. That your petitioner paid off each shareholder in the said company, which was wound up voluntarily, and with the assistance of friends interested in his invention formed a new company under the name of Livet & Co., Limited, which was incorporated on the 11th day of May, 1882, as a limited company under the Companies Acts 1862 to 1880; and by an indenture dated the 11th day of May, 1882, and made between Livet's Improved Boilers and Furnace Company, Limited, of the first part, Edward Gibbon Swann and Joseph Milligan, the liquidators of the last-mentioned company, of the second part, your petitioner of the third part, and Livet & Co., Limited, of the fourth part, the said letters patent were assigned to Livet & Co., Limited.

On the assignment to Livet & Co., Limited, your petitioner was paid partly in cash and partly in shares. The shares were not subscribed by the general public.

17. That Livet & Co., Limited, in order to raise money to carry on business, borrowed £1800 from Messrs. Williams, Deacon & Co., of Birchin Lane. John Macmeikan became responsible for this overdraft of £1800, and he also advanced a sum of £100 to the company. To secure this liability, the property of the company and the said letters patent were by indenture of 9th May, 1884, charged in favour of the said John Macmeikan with the moneys aforesaid and also with a further sum of £250 payable by way of bonus to the said John Macmeikan, and powers of sale to enforce the same were by the said indenture given to the said John Macmeikan.

18. In the year 1886 an arrangement was made by which your petitioner worked the said invention on a royalty.

By virtue of this arrangement your petitioner practically resumed the ownership of his invention, and has done much towards introducing the same to the favourable attention of manufacturers.

19. The said Livet & Co., Limited, was by an order of the Chancery Division of Her Majesty's High Court of Justice, dated the 22nd May, 1886, ordered to be wound up, and by an indenture dated the 20th March, 1888, John Joseph Steer, the liquidator of the last-named company, in consideration of £20, assigned to your petitioner the said invention and letters patent absolutely. And by indenture of re-assignment dated the 23rd day of September, 1891, and made between the said John Macmeikan and John Alexander Macmeikan of the one part and your petitioner of the other part, the said letters patent were released to your petitioner. And your petitioner was also released from the obligations of a certain agreement dated the 16th day of August, 1886, being an exclusive license granted to your petitioner by Messrs. John and John Alexander Macmeikan.

20. That your petitioner has used his best endeavours to introduce his invention to users of steam, but from the fact of his not being a boiler-maker he has had considerable difficulty in having his invention adopted, the boiler-makers having done all they could to stop the introduction of the invention. Moreover, the invention being an improvement upon the ordinary wheel draft setting it was not obvious at first sight that by the principle of successive expanding flues better results would be obtained therefrom, consequently engineers and manufacturers having formed their own opinion on such, refrained from investigating the practical results of the invention, to enable them to judge from facts the advantages to be derived from its use.

ante, p. 336.

21. That amongst the firms and others who have adopted and who either have used or are using the said invention are Messrs. Henry Tate & Sons, of Mincing Lane and Silvertown; Messrs. Bass, Ratcliff & Gretton, Limited, Burton-on-Trent; Messrs. Samuel Walker & Co., Engineers, Wolverhampton; the London Tramway Company, Limited; Messrs.

Hawks, Crawshay & Sons, Engineers, Gateshead-on-Tyne; Messrs. Fawcett, Preston & Co., Liverpool; Messrs. J. Muspratt & Sons, Widnes, Lancashire; Messrs. Brown, Stewart & Co., Greenock; Messrs. Hawthorn, Leslie & Co., Limited, Engineers, Newcastle-on-Tyne; Messrs. Laird & Co., Douglas, Isle of Man; Messrs. Hick, Hargreaves & Co., Engineers, Bolton; Messrs. J. Gamble & Sons, St. Helens, Lancashire; Messrs. Sir Joseph Causton & Sons, London; Messrs. Allen & Hanbury, Bethnal Green; the City Electric Railway, Stockwell Depôt; the Savoy Hotel, Limited; Messrs. B. Verity & Son, London; Messrs. D. Martineau & Son, Limited, London; Messrs. William Eastman & Son, London; Woodhouse & Rawson United, Limited, London; the London Road Car Company, London; Price's Patent Candle Company, London; and many others.

22. That during the past few years the invention has become much better known, but the result to your petitioner has been that until the last six years the patent has been unproductive, and he finds that just as the patent is about to expire the real value of the invention is becoming well understood and its use well established and extending.

23. That your petitioner's said invention has been shewn to be of great public value and importance, but, as will appear by the accounts, your petitioner has not received any return adequate to the merits of the invention, to its acknowledged importance, and to the years of labour and attention given to it by your petitioner, and to the considerable outlay made upon it. Under the circumstances aforesaid, the letters patent of 29th March, 1871, have not been productive of a sufficient reward.

24. That your petitioner has no doubt that if the said term of letters patent should be extended, he will be enabled to obtain some remuneration commensurate with the great public value and importance of his said invention.

25. That your petitioner humbly submits that under the circumstances of the case an exclusive right of using and vending the invention for the further period of seven years will not sufficiently reimburse and remunerate your petitioner.

ante, p. 330.

26. That your petitioner has given public notice by advertisements caused to be inserted in the "London Gazette" and in the metropolitan newspapers, pursuant to the statute in that case made and provided, of his intention to present a petition to your Majesty in Council praying that his said letters patent may be extended for a further term.

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 petitioner's said letters patent may be extended for the further and additional term of fourteen years, or for such other term as to your Majesty shall seem fit.

AND YOUR PETITIONER will ever pray, &c.

J. H. JOHNSON, SON, & ELLIS,
Agents and Solicitors for the Petitioners.

See *Fountain Livet's Patent*, 1892, 9 R. P. C. 327, *ante*, p. 342. The petition was refused on the ground of want of merit in the invention.

The petition will be accompanied by statements of account, shewing, first the patentee's profits, called the "general account of expenditure and receipts," and second, the "manufacturing account of expenditure and receipts." In addition to these a summary of the general account is usually given. These accounts are generally printed on large paper.

ante, p. 338.

In the following pages is a specimen of the commencement of the accounts sent in on the above petition. The succeeding years were very similar.

SUMMARY OF GENERAL ACCOUNT.

From July, 1879, to March, 1882, while the patent was in the possession of LIVET'S IMPROVED BOILERS AND FURNACE COMPANY, Limited.

Expenditure.

		£	s.	d.
A.	Part of Second Year, July to December, 1879 . .	569	9	8
	Third Year, 1880	798	4	11
	Fourth Year, 1881	959	8	4
	Part of Fifth Year, January to March 1882 .	249	8	3
	Ditto ditto ditto .	500	0	0
		£3,076	11	2

Receipts.

		£	s.	d.
	Part of Second Year, July to Dec. 1879 . . .	30	0	0
	Ditto ditto ditto . . .	420	0	0
	Third Year, 1880	85	0	0
	Fourth Year, 1881	250	12	0
	Part of Fifth Year, Jan. to Mar. 1882 . . .	14	14	6
		£800	6	6

From May, 1882, to May, 1886, while the Patent was in the possession of LIVET & Co., Limited.

Expenditure.

		£	s.	d.
B.	Further Part of Fifth Year, May to Dec. 1882 .	1,249	19	1
	Ditto ditto ditto . .	1,000	0	0
	Sixth Year, 1883	2,160	13	6
	Seventh Year, 1884.	1,378	17	1
	Eighth Year, 1885	731	1	7
	Part of Ninth Year, January to May, 1886. .	213	14	4
		£6,734	5	7

Receipts.

		£	s.	d.
	Further Part of Fifth Year, May to Dec., 1882 .	1,686	9	0
	Ditto ditto ditto . .	2,800	0	0
	Sixth Year, 1883	516	10	0
	Seventh Year, 1884.	1,230	4	0
	Eighth Year, 1885	227	12	0
	Part of Ninth Year, January to May, 1886 . .	67	0	0
		£6,527	15	0

From August, 1886, to December, 1891, while the Patent was in the possession of Petitioner.

Expenditure.

		£	s.	d.
C.	Further Part of Ninth Year, August to Dec. 1886 .	188	0	0
	Tenth Year, 1887	794	9	4
	Eleventh Year, 1888	519	5	9
	Ditto ditto	20	0	0
	Twelfth Year, 1889	649	12	3
	Thirteenth Year, 1890	767	1	8
	Fourteenth Year, 1891	744	1	7
		£3,682	10	7

Receipts.

	£	s.	d.
Further Part of Ninth Year, August to Dec. 1886	213	8	0
Tenth Year, 1887	506	16	0
Eleventh Year, 1888	449	10	0
Twelfth Year, 1889	1,666	4	0
Thirteenth Year, 1890	1,097	0	0
Fourteenth Year, 1891	462	0	0
	£4,394	18	0

Total Expenditure and Receipts.

Expenditure.

	£	s.	d.
Summary A . .	3,076	11	2
Summary B . .	6,734	5	7
Summary C . .	3,682	10	7
	£13,493	7	4

Receipts.

	£	s.	d.
Summary A . .	800	6	6
Summary B . .	6,527	15	0
Summary C . .	4,394	18	0
	£11,722	19	6

	£	s.	d.
Total Expenditure . . .	13,493	7	4
Total Receipts	11,722	19	6
Total Loss	£1,770	7	10

The details of this summary of course appear in the succeeding detailed accounts.

In the Privy Council.

FOUNTAIN LIVET'S PATENT (1878, March 29), No. 1242, IMPROVEMENTS IN INTERNAL FIRE STEAM BOILERS, FURNACE BARS AND FLUES, &c.

PETITION FOR PROLONGATION.

General Accounts of Expenditure and Receipts.

N.B.—The whole of these accounts are in relation to claims 3 and 5 of the Specification to Petitioner's Patent, nothing ever having been done in the way of working the rest of the claims after the first year of the Patent, by which time Petitioner found it useless to endeavour to persuade Manufacturers to take up the part of the invention claimed in the other claims.

FIRST YEAR.

29 March, 1878, to July, 1879. On the 15th July, 1879, Livet's Improved Boilers and Furnace Company, Limited, was formed, and prior to this date Petitioner had expended various sums for patenting the invention, for models, travelling and hotel expenses, salaries to draughtsmen, printing, stationery, &c., of which he kept no account, and is unable to specify them. He only received during that period a sum of £40 from Messrs. Rennie by way of royalty on two boiler settings, under the License dated 15th May, 1878, mentioned in the Petition. On the formation of the Company the License was cancelled.

Note.—The practice of the Petitioner and of the Companies who acquired the Letters Patent was to supply drawings and superintend the erection of the boilers, and the amounts appearing on the Receipt side of these accounts are the amounts received by way of royalty for supplying drawings and superintending erection as above. The difference in the amounts paid is according to the size of the boilers.

Second Year (Part of).

Account of Livet's Improved Boilers and Furnace Company, Limited.

Expenditure.

1879. July to December.	£	s.	d.
To Office Expenses	32	9	2
„ Travelling Expenses to the North of England .	17	5	2
„ Advertising in *Engineer*.	21	6	0
„ Printing, Stationery, &c., for Prospectus, Circulars, &c., in relation to the formation of the Company	76	17	4
„ Rent of Offices	21	15	0
„ Office Furniture (as per valuation) . . .	134	0	0
„ Law Costs for formation and registration of Company	92	5	0
„ Directors' Fees	28	7	0
„ Salaries to Secretary and Draughtsman . .	69	5	0
„ Salary to Engineer (Fountain Livet). . .	76	0	0
	£569	9	8

Receipts.

	£	s.	d.
By Royalty on one Boiler Setting—London Tramway Company	30	0	0
„ Cash, per T. E. Kershaw,* under an Indenture of Mortgage dated 22nd April, 1879 . . .	400	0	0
„ Cash to Petitioner of Messrs. Foster & Hight † by virtue of deed of mortgage, 10th March, 1879 .	20	0	0

Note.—10th March. There was due to Petitioner £500 in part payment of purchase money under agreement of 10th March, 1879. This amount was never actually received, however, but kept by Messrs. Foster & Hight

* N.B.—Petitioner transferred shares to the amount of £400 to T. E. Kershaw in Livet's Improved Boiler and Furnace Company, Limited, in satisfaction of this amount, and subsequently, on the winding up of the Company, paid the shares at par, together with interest.

† This was subsequently paid off by the Petitioner, as is acknowledged by Messrs. Foster & Hight in their letters dated 1st day of January, 1892. Petitioner did not receive any further advances.

under the agreement of 10th March, 1879, mentioned in the Petition. Petitioner received £5000 in shares of the Company, upon which no dividend has ever been declared.

(*The accounts for the succeeding years were in similar form.*)

In the Privy Council.

FOUNTAIN LIVET'S PATENT (1878, March 29), No. 1242, IMPROVEMENTS IN INTERNAL FIRE STEAM BOILERS, FURNACE BARS AND FLUES, &c.

PETITION FOR PROLONGATION.

Manufacturing Accounts of Expenditure and Receipts.

Note.—The amounts appearing on the Receipt side of this Account are amounts received by Petitioner and the various Companies who acquired the Letters Patent from clients for supplying ironwork and brickwork. As neither the Petitioner nor the Companies manufactured, they gave the work to Contractors to execute, and the amounts appearing on the Expenditure side are amounts paid to the Contractors.

Expenditure.

1881. January to December.	£	*s.*	*d.*
To Messrs. Kilby & Gayford	171	13	9
„ Williams & Sons, and J. Brooks . . .	19	0	0
	£190	13	9

Receipts.

1881. January to December.	£	*s.*	*d.*
By St. Luke's Hospital—Brick and Iron Work .	206	2	3
„ *City Press*—Iron	27	10	0
	£233	12	3

Note.—Prior to this year no business was done except as mentioned in the General Account.

Expenditure.

1882. January to December.				£	s.	d.
To G. Fletcher & Co.	.	.	.	8	18	0
„ J. Adamson & Co.	.	.	.	35	14	0
„ ditto	.	.	.	26	15	0
„ G. Fletcher & Co.	.	.	.	2	7	6
„ J. Adamson & Co.	.	.	.	291	19	6
„ ditto	.	.	.	23	3	9
„ ditto	.	.	.	41	9	9
„ ditto	.	.	.	36	15	9
„ ditto	.	.	.	27	7	0
„ T. & T. Vickers	.	.	.	118	15	0
„ J. Adamson & Co.	.	.	.	28	16	9
„ ditto	.	.	.	24	17	3
„ ditto	.	.	.	159	1	9
				£826	1	0

Receipts.

1882. January to December.			£	s.	d.
By Esdaile & Co.	.	Iron	10	5	6
„ The Saccharine Co.	.	„	44	12	6
„ Bass, Ratcliffe & Co.	.	„	26	15	0
„ Clay, Sons & Taylor	.	„	3	0	0
„ Jardine, Matheson & Co.		„	347	0	0
„ Bass, Ratcliffe & Co.	.	„	54	18	6
„ T. B. Ford & Co.	.	„	48	0	0
„ Bowling Iron Works	.	„	36	15	9
„ F. & E. Stanton	.	„	34	12	0
„ Chidley, Phillips & Co.	.	„	125	0	0
„ Thames Flint Fire Brick Co.		„	32	16	6
„ Keen, Robinson & Co.	.	„	28	15	0
„ Jardine, Matheson & Co.		„	195	19	10
			£988	10	7

(The accounts for succeeding years were in similar form.)

PATENTS, DESIGNS, AND TRADE MARKS ACT, 1888.

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.

Alteration of Appendix B.

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.

Commencement and citation.

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.

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.

INDEX.

PAGE

Abandonment of prior invention when not an anticipation . 149
Abandonment of invention 444
Abridgements of specifications published by comptroller . 458
Acceptance of specifications 241, 244, 443
Account (*interim*) 355
Final judgment for an account 397
Acquiescence (*see* INJUNCTION) 353
Action (*see* PRACTICE) 357
Addition (patent for) 60
Address of applicant 239, 484
Administrator of patentee, patent granted to . . . 229
Advertisement of acceptance of application . . . 241
„ **of acceptance of complete specification** 244
„ **of amendments** . . . 216, 448, 494
„ **of petition for extension** 329
Agents (Patant) 235, 479, 484, 533
Alien (*see* FOREIGN).
Ambit of an invention, its character 299
Its variation in case of different patents 300
Amendment of specifications.
Old practice 215
Practice under Act of 1883 215
When no action is pending 216
When an action is pending 216
Opposition to amendment 218
Hearing of application 219
Nature of amendments allowed, may correct an error, but not substantially alter the invention 221
The amendment dates back to the original specification . 224
The complete, provisional, title and drawings may all be amended. 224
An amendment which improperly widens the patent, vitiates it 225

PAGE

Amendment of specifications—*continued.*
No damages (except by leave) given for infringements prior to amendment. 225
May be made out of caution 225
Amendment of clerical errors. 226
Costs of amendments 226
Amendment of particulars of breaches (*see* PRACTICE) . 365
Amendment of defence and particulars of objections . 375
„ „ at hearing 376
„ „ on appeal 377
Amendment of petition for extension 331
Analogous use (*see* INVENTION, INFRINGEMENT) . . 87, 303
Analysis ordered by Court in a patent action . . . 380
Annual fees (*see* FEES) 270
Annual report of comptroller. 468
Anticipation (*see* NOVELTY).
By prior publication (*see* PRIOR PUBLICATION) . . . 151
Question of anticipation where evidence is given, is for the jury 395
Invalidates a patent 138
By prior user in public 140
Prior user must be in United Kingdom 148
Experimental prior user does not invalidate a patent . . 144
By sale or offering for sale 148
Exposure at public exhibition when no anticipation . . 149
No anticipation by an abandoned trial 149
But patent may be anticipated by a worthless or abandoned description or trial 150
Appeals are now by re-hearing 426
The Court may receive further evidence on . . . 426
Judge's notes in the court below must be produced . . 428
Costs on appeals 428
Stay of proceedings pending 405
Appeals to law officer 245, 255
He may employ an expert 256
Application for a patent 239
Acceptance of the application. 241
Rival applications—interference 244
Under international and intercolonial arrangements . . 432
(*see also* OPPOSITION).
Assessors may assist judge. 385
Or Privy Council. 333
Assignments 274
Must be by deed 274

PAGE

Assignments—*continued.*
Agreements to assign need not be in writing . . . 277
May be enforced in equity 275
Division of a patent, (a) of its parts, (b) geographically, (c) by giving concurrent rights to various persons . . 275
Warranties in assignments 278
An assignee with notice of prior covenants . . . 280
Assistance in perfecting invention (*see* SERVANT) . . 230
Attachment (*see* CONTEMPT) 401
Attorney-General (*see* LAW OFFICER 474
Is heard on a petition for extension 332

Bankruptcy of patentee 281
Board of Trade, power to make and vary rules, etc. . . 467
Rules of 1892 (first set) 503
„ „ (second set) 504
„ 1890 483
May order compulsory licenses 290
Book (*see* PRIOR PUBLICATION) 157
Book in foreign language when an anticipation . . . 157
Books, Inspection of (*see* INSPECTION AND DISCOVERY) . . 378
Breaches, Particulars of (*see* PRACTICE) 362

Caveat against extension of patent . . . 329, 332
Certificate of comptroller 465
Certificate of particulars of breaches and objections . 410
Certificates of payment and renewal . . 451, 493, 505
Certificate of Secretary for War as to secrecy of invention 459
Certificate of validity of patent 406
Certified copies of patents, specifications and other documents 464, 498
Channel Islands not subject to patent law. . 263, 434, 474
Circular of Information of Patent Office . . . 541
Circulars—warning 409
Claims (*see also* COMPLETE SPECIFICATION).
Nature, object and functions of claims 195
Everything not claimed is considered as disclaimed . . 196
Claims must be unambiguous and clear 196
Must be conformable to the specification 196
A claim of "every method" would be bad . . . 197
When a claim is clear and distinct, the patentee will be held to it 197

PAGE

Claims—*continued.*
When a claim can be read as subordinate, it will be done if possible to save the patent 198
Claim (statement of) (*see* PRACTICE) 362
Colonies (*see* INTERNATIONAL AND COLONIAL ARRANGEMENTS) 432, 474
Prior user in a colony does not invalidate patent for Great Britain 148
Combination patents 53
It is the combination which is patentable, not the parts . 58
Infringement of a combination 305
Commercial success.
Its influence on a patent 134
As evidence of utility 134
Not essential at the date of the patent 136
As evidence of novelty 136
As evidence of ingenuity 136
Communications from abroad may be patented 232, 488, 510
The communicator is the patentee, and it is his best knowledge that must be given in the specification . . 192
In a petition for extension the fact should be stated . . 381
Company may take out a patent (*see also* CORPORATION). . 228
Complete specification.
When it amounts to an anticipation 156
General remarks 178
Must point out whether the invention be a thing, a process or a combination 178
Claim for a new machine 179
Claim for an improvement 179
Claim for a combination 180
Must describe and ascertain the invention . . . 184
Must if needful have drawings 184
Must conform to the provisional . . . 170, 185
If a material part fails the whole patent fails . . . 185
Must be clear and ambiguous 185
Must distinguish the new from the old 186
Must distinguish the useful from the useless . . . 186
A claim for an improvement need not state why it is an improvement 187
Not necessary to disclaim formally things which are old . 187
A claim of some non-material part does not necessarily avoid a patent 187
Not necessary to describe every known method. . . 188

PAGE

Complete specification—*continued.*
Not necessary to describe the best method, if the best is given which the inventor knows 188
Must be intelligible to an ordinary workman . . . 188
No further experiments must be needful 190
Must disclose best method known to inventor . . . 191
Must not contain any misleading or false suggestion . . 192
An obvious error in specification will not vitiate a patent . 193
Sending in complete specification 242
Comptroller.
Definition of 474
Powers of 245
Must hear parties. 465
May be heard on appeal against his decision . . . 444
Shall refer application to examiner 442, 444
May refer doubtful questions to law officer . . . 445
Compulsory licenses 290
Concurrent applications (*see* APPLICATION). . . . 244
Conditions of grant. 258
„ **of extension** 345
Confirmation of patents.
Old practice 349
No new patents are now confirmed under the Act of 1883, but with regard to patents under the former Acts the old procedure still exists 349
Consideration.
Failure in part of, avoids a crown grant 11
And hence avoids a patent 60
Qualification of this doctrine 63
Consolidation of actions (*see* PRACTICE) 362
Construction of specifications.
The beneficial construction 206
The specification, claims and title may all be looked at to explain one another. 209
Construction with reference to public knowledge at the time 210
Lapse of time may affect the construction of a patent . . 211
Construction of particular words in patent, foreign words, manufacture as above described, illustrated, set forth, other substances, mechanical equivalent, analogous, more or less, effect, and, etc., or, s. 211
Construction of title to patent 161
Construction of documents is in general for the Court. . 395
Contempt 401

PAGE

Convention (*see* INTERNATIONAL ARRANGEMENTS) . . . 432
Co-ownership in patents 281
Copies of documents 464, 498
Corporation may be a patentee 228
Application, how to be signed 497
Costs.
Costs of separate issues 409
Apportionment of costs 411
Costs on the higher scale 414
Comptroller-General as a rule never asks or gives costs, except a remission of the stamp on the appeal . . 226
County court, patent action cannot be brought in . . . 357
Crown now subject to rights of patentee . . . 272, 454
But may use invention 272, 459
May demand models 272, 458
May have patent assigned by Secretary of War . . . 459

Damages.
Not to be given (except by leave) for infringements committed prior to an amendment 265, 447
In an action for infringement 400
„ „ „ threats 419
Date of patent is date of application 447, 487
On extension 347
Under international and colonial arrangements . . . 469
Death, devolution of patent on 281
Death of inventor, personal representatives may complete patent, or within limited time apply for patent (*see* PATENTEES).
Declaration of applicant 441
If incapacitated person 466
Dedication of invention to public, none by filing of provisional 177
Defence (*see* PRACTICE) 365
Amendment of defence 374
Striking out defence 375
Delivery up and destruction of infringing articles . 404
Directions, comptroller may ask from law officer . 245, 465
Directors who have infringed, order against . 324, 356, 404
Disclaimer (*see* AMENDMENT) 124
Disconformity between provisional and complete specifications 170, 185
Between specifications and title 161
Discovery and inspection (*see* PRACTICE) . . . 381

PAGE

Discovery in aid of execution 404
Discretion of comptroller (*see* COMPTROLLER) . . 245, 465
Documents (construction of) 395, 396
To be legible and on proper paper 484
Copies of lost documents 465, 498
Drawings, when an anticipation. 158
Where required 201
To be taken as part of the specification 201
The invention should be described in the specification, not only in a mere drawing 202
Drawings need not be well executed 202
If the provisional specification has a drawing, it may be referred to in the complete 202
Board of Trade Rules as to the character of the drawings required 201, 489

Enlargement of time for paying fees 270
Enlargement of time by Act of Parliament . . . 271
Equivalents.
Infringement may be by the use of an equivalent . . 302
Errors, amendment of clerical 226
In drawings may be amended 224
Obvious error does not avoid specification. . . . 193
(*See also* AMENDMENT) 215–227
Essence of the inventions, must be infringed to constitute infringement 292
Estoppels in assignments 278
In licenses 288
Evidence 387
Of secret process may be heard in camera. . . . 389
See PRACTICE . . . . . 387 *et passim*
Before law officer may be given on oath 457
Examiner, report of 240
Report is private 241
Exclusive license (*see* LICENSE) 284
Executor of inventor may have a patent 228
May petition for extension 327
Exhibitions, public user at, no anticipation under proper conditions 149
Existing patents to be subject to new statutes except in certain cases 461
Experiments by experts, sometimes directed . . . 389
Not infringements 317

PAGE

Experiments—*continued.*
Abandoned, not anticipation 149
Specification ought to be clear without experiments . . 190
Experts, evidence of 389
May be employed to assist law officer 256
Explanation, amendment by way of 221
Extension of letters patent.
Old practice 326
Present practice 326
Persons who may petition—assignees—equitable assignees . 327
All persons interested ought to join 328
Procedure, opposition 329
Inspection by an opponent of the petitioner's accounts . 330
The petition 330
Time for presenting the petition 331
Caveats 332
Notice of objections 332
Attorney-General's locus 332
Lodging of documents at Privy Council 332
The hearing; assessor 332
Grounds on which the petition is granted, public interest, public advantage, merit of invention, utility of the invention, position, circumstances, and conduct of the petitioners 333
Accounts must be complete and full 338
Examples of accounts, and items allowed. . . . 340
Specimen accounts 343
The period of extension 344
No second extension can be given 345
Conditions of extension 345
Costs 346
Extension and new grant 347
Order for extension when not acted on may be revoked . 348

Failure of consideration for patent 11, 60
Fees of Patent Office 270, 451, 493
Table of fees 505
Of Privy Council 270, 568
Enlargement of time for paying fees 270
Time for paying patent fees excludes day of date of application 265
First and true inventor 229
Foreign invention (*see* also INTERNATIONAL ARRANGEMENTS) 232

PAGE

Foreign governments.
Cannot be made amenable to British patent law . . 273
Foreign language 157
Foreign vessels, use of inventions upon . . . 322, 459
Foreigner may apply for patent 228, 441
Patent in trust for 232
„ „ „ „ may be extended. 327
Forfeiture of patent for non-payment of fees . . . 448
Forms (*see* TABLE OF CONTENTS).
Form of letters patent 258
Fraud, patent obtained by, may be revoked 424
Opposition to grant on ground of 256

Grant of the patent (*see* PATENT) 258
Grantee of letters patent, who may be 228
Great seal 448
Ground of patent.
Is by Crown prerogative at common law 2

Hearing (the) 387

Illegal subject matter 63
Illustrated journal of patents 458
Importation of infringing article 321
Improvement.
A patent may be procured for an improvement on an existing patent 59
Even though such patent is subsequently itself improved . 60
Index of patents 458
Infant may be patentee 228
Infringement in general 291
Essence of invention must be infringed 292
The ambit of an invention 299
Infringement by substitution of mechanical equivalents or analogues. 302
Infringement of a combination 305
A patent is not infringed by the use of the same means for a different object 313
No answer to an infringement to say that the means used are an improvement 313
Co-extension of anticipations and infringements. . . . 314
Time when an infringement may be committed. . . . 315
The intention to infringe is not material 316

PAGE

Infringement—*continued.*
Infringement by manufacture 317
The infringement must be one calculated to injure patentee's profits 316
Experimental user is not an infringement 318
Infringement by user 318
A patent may restrain the use by others in public of what they have previously used experimentally in private 319
Infringement by sale 320
Infringement by sale in England of articles made abroad . 321
No infringement to sell materials only 321
To repair a machine may constitute an infringement . . 322
Use on board ships 322
Manufacture, use, and sale by agents 323
The question of infringement is one of fact . . . 324
Opinions of experts inadmissible as to fact of infringement, but not as to circumstances from which infringement may be concluded 325
Action for infringement (*see* PRACTICE) 357
Denial of infringement 368

Ingenuity
(*see* INVENTION).

Injunctions (Interim).
Interim injunctions, general principles 351
Long enjoyment of patent ground of application . . 351
Prior judicial establishment of patent is also ground . . 353
Inability of defendants if defeated to pay costs . . . 353
Delay prejudices the application 353
Interim injunctions are sometimes granted ex parte . . 354
The infringement must be plain and clear . . . 354
Affidavits in support of application 354
In deciding an application for an interim injunction the Court avoids any expression of opinion on the case . . 355
Undertaking to keep an account 355
Application ordered to stand over 355
Terms on which injunctions are granted 355
Hearing sometimes treated as finally disposing of the case 356
Injunction may be dissolved 356
Breach of the interim injunction 356

Injunctions perpetual 401
Contempt 402

Inspection (*see* PRACTICE), old practice 378
New practice 379

PAGE

Institute of Patent Agents 236
Intelligibility necessary in a specification . . . 185, 188
Is generally a question for the Court 396
Intention to infringe not material 316
Interference 244
Interim injunctions (*see* INJUNCTIONS).
Interim injunction to restrain threats 417
International and Colonial patent arrangements 432, 469, 488
Interrogatories 332
Invention (ingenuity).
Necessary to a patent 74
Mere analogous use is not invention 87
Unless at the time of the invention it is not known to be analogous 87
Use of an old thing in a merely analogous way, no invention 87
The degree of invention is not material 94
Example of cases in which the invention was held sufficient 97
„ „ in which the invention was held insufficient 118
Quantum of invention, how determined 395
Inventor.
First and true inventor must be one of patentees . . 229
First and true inventor may petition for revocation . . 424
Inventor may petition for extension, his locus . . . 328
Ireland 365
Isle of Man 448

Joint inventors, patent to 228
Joint owners of a patent 282
Judgment 397
Judgment for an account 398
Jury 385, 395

Lancaster, Chancery court of, can try patent action . . 357
Law officer, appeals to 245, 255, 257
Who is 474
May make rules 457
Rules of law officers 500
Prohibition will not lie to 224
Appears on petitions for extension 332
He or his substitute may petition for revocation . . 452
Libel, an action will lie for libel of patent 416
License 284

PAGE

Lost patent may be replaced 266
Lunatic may be a patentee 228

Manufacture.
Meaning of words in the statute of James . . . 38
Includes a process as well as an article 44
Materials, no infringement to sell materials for infringing . 322
Merit of invention, reason for extension 333
Mode of trial 385
Models may be an anticipation 158
Are sometimes used at hearing to explain argument . . 390
Sometimes deposited in rooms in Royal Courts of Justice . 391
To be furnished to South Kensington if required . 272, 458
Monopolies.
Statute of 19
In time of Queen Elizabeth at common law . . . 16
Morality, no patent granted contrary to . . . 63, 241
Mortgage of a patent 280

New trial (*see* APPEAL) 426
Novelty.
Sometimes used to mean ingenuity 77
Sometimes used to mean absence of anticipation . . 77
(See INVENTION and ANTICIPATION).

Objections, particulars of (old practice) 366
" " (new practice) 367
Objections to extension 332
Offences, selling unpatented articles as patented . . . 430
Falsification of registers 431
Assuming the royal arms 431
Falsely assuming the title of "patent agent" . . . 235
Officials, patent 463
Old material.
Use of, for an analogous purpose not patentable, but good if for a new purpose 88
Old methods.
More efficient use of will not support a patent . . . 89
Opposition to grant of patent 246
Old procedure 246
Procedure under Act of 1883 246
Grounds of opposition 247

PAGE

Opposition—*continued.*
Opposition on ground that invention was obtained from opponent. 247
Opposition on ground that invention was previously patented 249
Opposition on ground that applicant is putting into his complete specification the invention of the opponent . 253
Hearing before the comptroller, appeals 254
Costs. 255
Opposition on the ground of fraud 256

Particulars of breaches (*see* PRACTICE) 362
Particulars of objections (*see* PRACTICE) 365
Parties plaintiffs (*see* PRACTICE) 357
Defendants (*see* PRACTICE) 360
Partnership in patents 281
Patent agents, their character, functions, and qualifications . 235
Patent, procedure to obtain.
Whether to send in complete specification at once. . . 237
Procedure in sending in application. 239
Grant of the patent 258
Form of patent (set out) 259
Recital in patent—Effect of, as against Crown . . . 261
Area of patent 263
Effect of the grant 265
Lost patent may be replaced 266
Patentees
Who may be a patentee 228
Infancy, lunacy, married women, aliens; intestacy, legal representatives 228
The first and true inventor 229
Servants and workmen. 230
Communications from abroad. 232
Meaning of the word "patentee" 234
Corporation may be a patentee 228
Patent office open, what days 270, 484
officials of 463
Penalty (*see* OFFENCES).
Perpetual Injunction (*see* INJUNCTIONS).
Personal representatives may have patent. 229
may petition for extension 327
Pleading (*see* DEFENCE) 365
Post office, documents may be sent by 465

PAGE

Pleas (see DEFENCE) 365
striking out pleas 375
Amendment of defence and particulars of objections before hearing 375
Amendment of defence and particulars of objections at the hearing 376

Practice.

Action for infringement. 357
Courts in which actions can be brought 357
Cannot be brought in county court 357
Parties, plaintiffs 357
All interested should join if account asked for . . . 357
Assignees may sue 358
Mortgagors 359
Licensees cannot sue 359
Cestuis que trustent 359
Defendants, agents and servants 360
The writ in a patent action 361
Consolidation of actions 361
Statement of claim 362
Particulars of breaches.
(*a*). The parts of the patent infringed must be specifically pointed out 363
(*b*). The characteristics of the articles complained of be described 364
(*c*). The instances of infringement must be given . 364
Amendment of particulars of breaches 365
The defence 365
Particulars of objections (old practice) 365
" " (new practice) 367
(*a*). Denial of plaintiff's title 368
(*b*). Denial of infringement 368
(*c*). Plaintiff not true inventor 368
(*d*). Invention not proper subject of a patent . . 368
(*e*). Invention a derogation from former grant . . 369
(*f*). Want of utility 369
(*g*). Want of novelty 370
(1). Through common public knowledge . . 370
(2). That the invention has been previously published 371
(*a*). By a prior specification 371
(*β*). In a book or other publication. . . . 372
(*γ*). By prior user 372
(*h*). The specification defective 373

PAGE

Practice—*continued.*
(1). From disconformity 373
(2). From disconformity by amendment . . 373
(3). New not distinguished from the old . . 373
(4). From ambiguity 374
(5). False suggestions. 374
(6). Insufficient description 374
(7). Most beneficial method known to inventor not described 374
Amendment of defence and particulars of objections . . 374
Striking out pleas 375
Amendment of particulars of objections before hearing . 375
„ „ „ at hearing . . 376
„ „ „ on appeal . . 377
Inspection (old practice) 378
„ (new practice) 379
Discovery and inspection of documents 382
Interrogatories 382
Mode of trial 385
Postponement of trial 387
Change of venue 387
The hearing, evidence, assessors 387
Quantum of invention may be for the jury . . . 395
Question of anticipation, if evidence is given is for the jury. 395
„ utility „ „ „ „ . 395
„ intelligibility „ in general is for the Court 396
Judgment 397
Judgment for an account 398
Damages 400
Perpetual injunction 401
Disobedience to an injunction. 402
Delivery up of infringing articles 404
Discovery in aid of execution 404
Stay of execution. 405
Certificate of validity of patent. 406
Costs. 408
Costs of separate issues 409
Certificate of particulars of breaches and objections . . 409
Apportionment of costs. 411
Costs on the higher scale 413
(*See also* APPEALS).

Principle.
A patent cannot be granted for a principle unless coupled with a mode of carrying it out 45

PAGE

Prior publication.
By a provisional specification 155
By a complete specification 156
In a book 157
By drawings 158
By models 158
In general 138
Must have been accessible to the public 158
Prior user (*see* ANTICIPATION).
Privy Council (*see* EXTENSION).
Rules of 567
Process.
A process may be patented as well as a result . . . 44
A process omitting a step in a previous process is patentable 52
Profits (*see* ACCOUNT), ... 338, 398
Prohibition will not lie to law officer 224
Property.
Inventor has none in invention apart from grant . . 1
Provisional specification.
General remarks 168
May amount to an anticipation 155
Object of, to describe nature of the invention . . . 169
Must be conformable to title (*see* TITLE) 170
May be looked at to explain, but not to supplement the complete 176
Must have drawings attached to it if needful . . . 177
Abandonment of 177
Effect of filing a provisional specification 177
Public policy.
No patent can be granted contrary to 63
Public user, when an anticipation 140
Publication (*see* PRIOR PUBLICATION) 151–156

Recital in patent does not bind Crown 261
Rectification of register 267
Register of patents.
How kept 267
Trusts not entered on 267
Rectification of 267
False entries in, punished 267, 431
Registration necessary to give notice to third parties . . 268
Registration whether necessary before commencing action . 268
Registration of assignment dates back to assignment . . 268

PAGE

Register of patents—*continued.*
Registration not necessarily notice to all persons of terms of assignment 269
Register is prima facie evidence 456
Register in Scotland and Ireland 466
Renewal of patents (*see* FEES). 505, 506
Repair of patented articles is an infringement . . . 322
Revocation of patent: old practice 421
New practice 422
Attorney-General's fiat 422
Locus of petitioner 423
Patent obtained in fraud of another 424
A petitioner who has a locus may petition on any ground . 424
A petition for revocation is analogous to an action for infringement 424
Particulars of objections on a petition for revocation . . 425
The defendant begins 425
A copy of an order for revocation must be left at the Patent Office 425
On revocation for fraud, the comptroller may grant a patent to the true inventor 425
Rival applications 244
Royal arms may not be assumed without authority . . 431
Royalties (*see* LICENSES) 284
Rules of 1890 483
of 1892, first set 503
of 1892, second set 504
of Law Officer 500
of Privy Council.

Sale, anticipation by 148
infringement by 320
Scientific evidence 389
Scire facias, proceedings by, abolished. 452
Scotland. 471
Seal of Patent Office to be judicially noticed . . . 269, 463
Sealing of patent 258
„ „ „ non obstante a prior patent . . 256, 447
Secret process, evidence of, may be heard in camera . . 389
Secretary of State for War may acquire patents . . 283
Servant, assistance by 230
Slander of a patent 418
Statement of claim (*see* PRACTICE) 362
Form of.

PAGE

Specifications (*see* PROVISIONAL AND COMPLETE SPECIFICATIONS, CLAIMS, TITLE, etc.).
Specifications, construction of (*see* CONSTRUCTION OF SPECIFICATIONS) 203–214
Stamps, fees are charged by means of 271
Stay of execution 405
Subject-matter of letters patent 37–64
General remarks 37
Must not derogate from a former grant 37
Must be a manufacture 38
And not a principle 45
May be for a process or a result 44
Or a process which only omits a step in a known process . 52
Or an improvement or combination 52
Partial failure of subject matter is fatal 60
Must not be illegal or immoral 63

Threats, action for, old practice 415
Modern practice 415
What constitutes a threat 416
What issues may be raised in an action for threats . . 417
Interim injunction to restrain threats 417
Issuing warning circulars 419
Title of a patent.
General principles regulating the choice of a title . . 162
Must correctly describe the invention 162
Must be framed in good faith. 162
Must not be ambiguous. 162
Must not be too wide or too narrow 162
Construction of 162
Example of cases upon title 162–167
Trade secrets protected in discovery 380
True and first inventor (*see* PATENTEES).
Trial, mode of 385
Postponement of 387
Trusts not entered on register 267
Trustee for alien amy (*see* FOREIGNER) . . . 232, 327

User (*see* ANTICIPATION, INFRINGEMENT).
Utility.
The invention must be useful at the date of the patent . 65
Meanings of the word utility, viz. commercial utility or mechanical utility 65

PAGE

Utility—*continued.*
The invention must be useful, not merely the things made according to it 69
Degree of utility is not material 70
Partial failure of utility is fatal 70
Where evidence is given is a question for the jury . . 396

Validity, certificate that it came in question. . . . 406
Variance (*see* DISCONFORMITY).
Venue, change of 387

Warranties in assignments 278
In licenses. 288
Workman.
Specification must be intelligible to. 188
Writ (*see* PRACTICE) 361

LONDON:

PRINTED BY WILLIAM CLOWES AND SONS, LIMITED,

STAMFORD STREET AND CHARING CROSS.