LAW AND PRACTICE

RELATING TO

LETTERS PATENT FOR INVENTIONS

A TREATISE

ON THE

LAW AND PRACTICE

RELATING TO

Letters Patent for Inventions

WITH

AN APPENDIX

OF

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

BY

ROBERT FROST, B.Sc. (Lond.)

FELLOW OF THE CHEMICAL SOCIETY;
OF LINCOLN'S INN, ESQUIRE, BARRISTER-AT-LAW

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TO

SIR RICHARD EVERARD WEBSTER, G.C.M.G., Q.C., M.P.,

HER MAJESTY'S ATTORNEY-GENERAL,

THIS WORK IS BY PERMISSION

Dedicated

PREFACE.

THE favourable reception which this treatise met with at the hands of the profession has induced me to undertake the preparation of a Second Edition.

The end I have had in view has been to more nearly attain the ideal stated in the Preface to the First Edition—viz., to produce a work which in a reasonable compass shall reliably state the law of England as it at present exists in reference to Letters Patent for Inventions.

It is not necessary to dwell on the importance of the patent law to those engaged in carrying on the manufactures and industries of the country; nor has it been any part of my task to point out or suggest directions, which are probably many, in which, by legislation, our law might possibly be altered in the interests of both inventors and the public.

A comparison of the present with the first edition will demonstrate that the book has been largely re-written. By printing the text slightly closer, and the employment of a somewhat smaller type for extracts from the judgments of the Courts and epitomes of cases given by way of examples of the principles of law involved, a very considerable quantity of new matter has been added to the body of the work whilst its bulk has not been seriously increased.

With the object of rendering reference to the various subjects treated of more easy to the reader in search of information on any particular head, heavy shoulder-notes, together with side-notes, have been employed; further, the various chapters have been freely divided and sub-divided into distinct sections,

and the Index has been increased by more than half its original size.

The decided cases, including some reported during last month, will be found referred to, and in most instances the date is given.

Though fully conscious of its defects, I venture to hope that the result of my labour may be found of use to the profession and to inventors generally.

ROBERT FROST.

5 NEW COURT,
LINCOLN'S INN, W.C.,
September 1898.

PREFACE TO THE FIRST EDITION.

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

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

My friend, Mr. H. H. Haldinstein, of the South-Eastern Circuit, has assisted me in the revision of the MSS. and in seeing the work through the press. My best thanks are due to him; I proffer them here.

ROBERT FROST.

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

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ABBREVIATIONS USED IN THIS WORK.

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

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

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Page 186, note (*m*); page 227, note (*d*); page 241, note (*k*); and page 494, note (*t*), *add* 15 R. P. C. 421.

Page 291, note (*p*), *add* See also Graham *v.* Eli, [1898] 15 R. P. C. 259.

Page 312, note (*r*), *add* as to reopening cases decided by the Comptroller or law officer, see Thomas and Prevost's Patent, [1898] 15 R. P. C. 257.

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Page 626, note (*l*), *add* See also Dunlop Pneumatic Tyre Co. *v.* New Ixion Tyre and Cycle Co., [1898] 15 R. P. C. 389.

Page 720, Rules 45, 46, and 47 should be omitted—*see* Erratum facing p. 840.

ERRATUM.

THE fees on certificate of renewal and enlargement of time for payment of renewal fees printed at p. 840 *ante*, and numbered 14 to 28 inclusive, are erroneous. The following fees were substituted by the Patent Rules, 1892 (second set):

On certificate of renewal:—

	£	s.	d.
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 one month	1	0	0
25. ,, two months	3	0	0
26. ,, three months	5	0	0

Rules 45, 46, and 47 of the Patent Rules, 1890 (p. 720 *ante*) are repealed, and it is provided by the Patent Rules, 1892 (second set) as follows:—

PAYMENT OF ANNUAL FEES FOR CONTINUANCE OF PATENT.

4. If a Patentee intends at the expiration of the fourth year from the date of his patent to keep the same in force, he shall, before the expiration of the fourth and each succeeding year during the term of the patent, pay the prescribed fee. The Patentee may pay the whole or any portion of the aggregate of such prescribed annual fees in advance.

The Form J in the Second Schedule, duly stamped, should be used for the purpose of this payment.

LETTERS PATENT FOR INVENTIONS.

CHAPTER I.

THE PATENTEE.

INTRODUCTORY.

Early monopolies.

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

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

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

Statute of Monopolies.

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

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

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

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

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

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

Introductory.

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

Statute of Monopolies.

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

Preamble.

The preamble recites:

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

First section.

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

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

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

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

(*f*) See Appendix.

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

Introductory

Statute of Monopolies.

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

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

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

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

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

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

> "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 patents and grants shall not use*, so as also they be not contrary to the law, nor mischievous to the State, by raising prices of commodities at home, or hurt of trade, or generally inconvenient; the said fourteen years to be accounted from the date of the first letters patents or grants of such privilege hereafter to be made, but that the

Who may Apply.

same shall be of such force as they should be if this Act had never been made and of none other."

WHO MAY APPLY FOR LETTERS PATENT.

Any person may be an applicant,

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

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

if he can make the necessary declaration.

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

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

Married woman.

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

(*g*) Marshall's Application, (1888) 5 R. P. C. 661.
(*h*) 46 and 47 Vict. c. 57, s. 4 (1).
(*i*) 46 & 47 Vict. c. 57, s. 4 (2).
(*k*) 48 & 49 Vict. c. 63, s. 5.
(*l*) 46 & 47 Vict. c. 57, s. 4 (2). See chap. vii.
(*m*) Chappell *v.* Pendry, (1845) 14 M. & W. 318; *In re* Wirth's Patent, (1879) L. R. 12 Ch. D. 303; Beard *v.* Egerton, (1846) 3 C. B. 97.
(*n*) Bloxam *v.* Elsee, (1827) 1 C. & P. 558; 6 B. & C. 169; see p. 19 *post*.
(*o*) M. W. P. Act (45 & 46 Vict. c. 75).

Who may Apply.

Infant.

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

Lunatic.

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

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

Legal representative.

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

The application of such a personal representative must be accompanied by an official copy of, or extract from, the will of the deceased, or the letters of administration granted of his estate and effects if he died intestate.(*s*)

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

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

True and First Inventor.

Patent invalid unless true and first inventor is a grantee.

Letters patent for an invention can, except in the above cases of the legal personal representatives of deceased persons,

(*p*) Cheavin *v.* Walker, (1877) L. R. 5 Ch. D. 858; 46 & 47 Vict. c. 57, s. 4 (2); 48 & 49 Vict. c. 63.

(*q*) Chap. vii.

(*r*) 46 & 47 Vict. c. 57, s. 34.

(*s*) See Patent Rules, (1890) r. 20.

True and First Inventor.

be validly granted only to the true and first inventor either alone or together with another person or persons.(*t*)

Any patent obtained by any person or persons who is not, or none of whom is or are, the true and first inventor or inventors, would be absolutely void, for the Crown would have been deceived in its grant.(*u*)

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

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

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

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

Inventor who first discloses the invention.

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

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

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

(*x*) pp. 15–17 *post*.

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

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

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

(*b*) Carpenter *v.* Smith, (1841) 1 W. P. C. 535; chap. iv.

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

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

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

(*f*) Chap. iii.

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

True and First Inventor.

Law as to first discloser stated by Tindal, C.J.

"Sometimes it is a material question to determine whether the party who got the patent was the real and original inventor or not; because these patents are granted as a reward, not only for the benefit that is conferred upon the public by the discovery, but also to the ingenuity of the first inventor; and although it is proved that it is a new discovery, so far as the world is concerned, yet if anybody is able to show that although that was new—that the party who got the patent was not the man whose ingenuity first discovered it, that he had borrowed it from A. or B., or taken it from a book that was printed in England, and which was open to all the world—then, although the public had the benefit of it, it would become an important question whether he was the first and original inventor. . . . . A man may make experiments in his own closet for the purpose of improving any art or manufacture in public use; if he makes these experiments and never communicates them to the world, and lays them by as forgotten things, another person who has made the same experiments, or has gone a little further, or is satisfied with the experiments, may take out a patent, and protect himself in the privilege of the sole making of the article for fourteen years; and it will be no answer to him to say that another person before him made the same experiment, and, therefore, that he was not the first discoverer of it—because there may be many discoverers starting at the same time, many rivals that may be running on the same road at the same time, and the first which comes to the Crown and takes out a patent, it not being generally known to the public, is the man who has a right to clothe himself with the authority of the patent and to enjoy its benefits."(*h*)

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

"A man may publish to the world that which is perfectly new in all its use, and has not before been enjoyed, and yet he may not be the first and true inventor; he may have borrowed it from some other person, he may have taken it from a book, he may have learnt it from a specification, and then the Legislature never intended that a person who had taken all his knowledge from the art of another—from the labours and assiduity or ingenuity of another—should be the man who was to receive the benefit of another's skill."

The proof of publication must be very clear indeed in order

(*g*) (1835) 1 W. P. C. 501, 507.
(*h*) See however chap. vii.
(*i*) (1841) 1 W. P. C. 627, 628.

True and First Inventor.

to invalidate a patent granted to a person for a process producing a useful article at an economical rate when that person was, *de facto*, the first to produce the thing to the public practically in a working state.(*k*)

Dollond's Case.

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

Tennant's Case.

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

Result of above cases.

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

Several inventors.

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

If a man makes a discovery and is enabled to produce an effect from his own experiments, judgment, and skill, it is no objection that some one else has made a similar discovery by his

(*k*) Von Heyden *v.* Neustadt, (1880) 50 L. J. N. S. Ch. 126; L. R. 14 Ch. D. 230. (*l*) Boulton *v.* Bull, (1795) 2 H. Bl. 463.
(*m*) (1798) Dav. P. C. 429; 1 W. P. C. 125.
(*n*) Hill *v.* Thompson, (1818) 1 W. P. C. 239. (*o*) p. 102 *post*.
(*p*) 46 & 47 Vict. c. 57, s. 103, chap. vii.

mind unless it has become public (*q*) or been put to practical use.(*r*)

True and First Inventor.

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

First person who produces a commercial success.

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

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

(*q*) Per Baley, J., Lewis *v.* Marling, (1829) 1 W. P. C. 496; also p. 102 *post*.

(*r*) See pp. 105–123 *post*.

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

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

True and First Inventor.

public a useful manufacture which amply supplied the market with that which, until the use of the materials, process, and temperature indicated by him, had never been supplied for commercial purposes. At the date of his patent something remained to be ascertained which was necessary for the useful application of the chemical discovery of paraffin and paraffin oil. This brought it within the principle laid down by Lord *Westbury*, L.C., in *Hill* v. *Evans*,(*u*) and the Court held that the manufacture, with the materials and process indicated by the inventor, according to the sense in which the word "manufacture" is used in the Statute of Monopolies, was a new manufacture not in use at the date of the patent.(*v*)

Inventors with similar objects in view.

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

For example, in the year 1828 *W. E. Knoller* obtained a patent for "improvements in evaporating sugar." The patent related to a method of evaporating water from a solution of sugar by blowing air into the liquid. This was done according to the specification by an apparatus consisting of a large horizontal pipe, placed near the surface of the liquid, from which a number of small blowing tubes radiated downwards in different directions. Two things were described as essential to the invention. (1) That a stream of air should issue from each blowing tube at the same time. (2) That the ends should all be in the same horizontal plane, whereby the fluid would exert the same pressure at each orifice. At the trial of an action(*y*) brought for the infringement of this patent, the defendant put in evidence the specification of a patent obtained in 1822 for a similar apparatus, consisting of a set of perforated pipes, coiled or otherwise, shaped and accommodated to the nature and form of the vessel. The pipes might be replaced by a shallow metallic vessel, in the nature of a colander. *Knoller's* patent was, however, declared valid, and Lord *Tenterden*, C.J., said, "I cannot forbear saying that I think a great deal too much critical acumen has been applied to the construction of

(*u*) (1862) 31 L. J. Ch. 457.
(*v*) See judgment of Stuart, V.C., 33 L. J. Ch. 192; 35 L. J. Ch. 523.
(*w*) Walton *v.* Potter, (1841) 1 W. P. C. 590; see chap. ii.
(*y*) Hullett *v.* Hague, (1831) 9 L. J. O. S. K. B. 242: 2 B. & Ad. 370.

patents, as if the object was to defeat and not to sustain them. It is evident that the object of the two patents is the same. But the mode of effecting that object is different."

True and First Inventor.

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

Omission of component parts.

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

Previous failures.

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

If the result produced by a new method is either a new article, or a better article, or a cheaper article to the public than that produced before by an old method, such new method is an invention, or manufacture intended by the statute to be

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

True and First Inventor.

protected, and may become the subject of a patent,(*d*) and there does not appear to be any principle or authority upon which the exhibition of a useless machine which turns out a failure can be held to affect the right of a patentee who has made a successful machine, although there may be a degree of similarity between some of the details of the two machines.(*e*)

Joint inventors.

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

Inventors may employ assistants.

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

Cases.

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

In *Minter* v. *Wells*, (1834) 1 W. P. C. 132, *Alderson*, B., addressing the jury, said: "*Minter* and *Sutton* were together about the time the invention took place: which of the two suggested the invention, and which carried it into effect, is the question for you to decide. If *Sutton* suggested the prin-

(*d*) Judgment of Tindal, C.J., (1842) Crane *v.* Price, 4 M. & G. 580; 1 W. P. C. 393.

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

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

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

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

In *Bloxam* v. *Elsee*, (1825) 1 C. & P. 558, an action in respect of two patents granted to *John Gamble*, it was objected that the improvements on the first invention, which formed the subject of the second patent, were the invention of one *Donkin*, an engineer. It was established that the improvements were the invention of *Donkin*, but it appeared that at the time he invented them he was employed by the patentee and one *Foudrinier*, his partner, as an engineer, for the purpose of bringing the machine to perfection, and was paid by them for so doing; and therefore he was acting as their servant for the purpose of suggesting improvements in the machine. The plaintiff, on the other hand, contended that the improvements were the patentee's inventions, and that *Donkin* was employed by him to carry his ideas into effect, and this view of the case seems to have prevailed with the Court.

Allen v. *Rawson*, (1845) 1 C. B. 551, is another case supporting the same principle. In this case it was sought to upset a patent for improvements in the manufacture of felted fabrics on the ground that parts of the invention were discovered by two workmen. *Erle*, J., in directing the jury, put his idea of the law thus: "I take the law to be that, if a person has discovered an improved principle, and employs engineers, agents, or other persons to assist him in carrying out that principle, and they, in the course of experiments arising from that employment, make valuable discoveries accessory to the main principle and tending to carry that out in a better manner,

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

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such improvements are the property of the inventor of the original improved principle, and may be embodied in his patent; and if so embodied the patent is not avoided by evidence that the agent or servant made the suggestion of the subordinate improvement of the primary and improved principle." A motion for a new trial on the ground that the Judge had misdirected the jury was refused, *Tindal*, C.J., (1 C. B. 574) saying: "It would be difficult to define how far the suggestions of a workman employed in the construction of a machine are to be considered as distinct inventions by him so as to avoid a patent incorporating those taken out by his employer. Each case must depend upon its own merits. But when we see that the principle and object of an invention are complete without it, I think it is too much that a suggestion of a workman employed in the course of the experiments, of something calculated more easily to carry into effect the conceptions of the inventor should render the whole patent void."

Master is not entitled to the invention of his servant,

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

but only to improvements in details made by him.

When, however, a workman, who is employed by his master to make models, or to carry out experiments, in the course of his employment, makes improvements in details, the improvements so made are the property of the master,(*m*) and the workman cannot patent them.(*n*) There is in fact a confiden-

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

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

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

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

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

tial relationship between a master who experiments with a view to taking out a patent for an invention, the leading idea of which originated with him, and the workmen he employs in aiding him to perform those experiments, and anything suggested by the workman during such confidential employment will not vitiate the subsequent patent of the master.(*o*) It is always, however, a question of evidence whether such confidential relationship actually existed between the employer and employed.(*p*)

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In the absence of special contract, the invention of a servant, even though made in the employer's time, and with the use of the employer's materials, and at the expense of the employer, does not become the property of the employer so as to justify him in opposing the grant of a patent for the invention to the servant, who is the proper patentee.(*q*)

There is no necessary confidential relationship between a workman and his fellow workmen which prevents the communication of an invention being made by one workman to another, violating, on the ground of lack of novelty, a patent taken out in respect of it.(*r*)

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

Inventions communicated from abroad.

It was stated in the celebrated *Clothworkers of Ipswich Case*,(*s*) which was prior to the Statute of Monopolies, "if a man hath brought in a new invention and a new trade within the kingdom in peril of his life and consumption of his estate, or stock, &c., or if a man hath made new discovery of anything, in such cases the King of his grace and favour in recompense of his costs and travail may grant by charter unto him that he only shall use such trade or trafique for a certain time, because at the first the people of the kingdom are ignorant, and have not the knowledge or skill to use it. But when that patent

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

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

(*q*) Healds, (1891) 8 R. P. C. 430; Homan's Case, (1889) 6 R. P. C. 184; Siddell *v.* Vickers, (1888) 5 R. P. C. 93; Saxby *v.* Gloucester Waggon Co., (1880) Griff. L. O. C. 56.

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

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

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is expired the King cannot make a new grant thereof." This practice was continued after the framing of the Statute of Monopolies of 21 James I., and has frequently been sanctioned by the judges in many cases, from *Edgebury* v. *Stephens*,(*t*) which decided that if the invention be new in England, a patent may be granted though the thing was practised beyond sea before; "for the statute speaks of new manufactures within this realm; so that if it be new here it is within the statute; for the Act intended to encourage new devices useful to the kingdom, and whether learned by travel or by study it is the same thing," down to cases such as *Carpenter* v. *Smith*,(*u*) *Nickels* v. *Ross*,(*x*) and *Plimpton* v. *Malcolmson*,(*y*) from which the proposition is established that the first actual importer of an invention into this country is *in law the true and first inventor*.

First importer is the true and first inventor.

The Act of 1883 and subsequent legislation does not contain anything to prevent a person who has become acquainted with an invention abroad, though it was not actually made by him, coming over to this country and applying for a patent for it in his own name, and making the declaration (*z*) as to true and first inventor comprised in Form A1,(*a*) in the schedule to the Patent Rules 1890, which is especially prepared to meet such a case. Before the Act of 1883 it was long the practice for a person applying for a patent in respect of a communication from abroad in his declaration (*b*) to state that he was the true and first inventor *within this realm*—though the words "within this realm" might have been omitted, without detraction, from the validity of the declaration; and in the form of declaration given in the schedule to the repealed Act of 1852 they were in fact so omitted. It was objected by some that under the Act of 1883 a person cannot obtain a valid patent for an invention communicated from abroad, seeing that the Act requires him to declare himself the true and first inventor, which it was said he cannot be unless he himself actually made the discovery, and the case of *Milligan* v. *Marsh*,(*c*) decided in 1856, and *Renard* v. *Levenstein*,(*d*) decided in 1885, were relied on as supporting this view. On a reference to these cases it will be found that

(*t*) (1691) Salkeld's Rep. 477; 1 W. P. C. 35; Dav. P. C. 36.
(*u*) (1841) 1 W. P. C. 530, 535.
(*x*) (1849) 8 C. B. 679.
(*y*) L. R., (1876) 3 Ch. D. 531.
(*z*) Chap. vii.
(*a*) See Appendix; see also Société Anonyme du Générateur du Temple's Patent, (1896) 13 R. P. C. 54.
(*b*) Chap. vii.
(*c*) (1856) 2 Jur. N. S. 1083.
(*d*) (1885) 10 L. T. N. S. 177.

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neither of them amounts to a decision on the point; they are at most dicta of *Wood*, V.C., and *Knight Bruce*, L.J.

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

Communicators of foreign inventions.

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

It must also be noticed that the clauses in the Act of 1883 relating to opposition to the grant of a patent provide for the case of a person without the knowledge or against the will of a foreigner endeavouring to forestall him in this country, and give the Comptroller and law officers ample powers to prevent any injustice from being done.(*g*)

Preference to foreign inventor who has made an application abroad.

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

Communications made in England.

The communication, made in England, by one British subject to another of an invention does not make the person to whom the communication is made the true and first inventor within the meaning of 21 Jac. I. c. 3, so as to enable him to obtain letters patent for the invention in his own name alone;(*k*) and it would appear that a valid patent could not be granted in respect of a communication by an alien permanently domiciled in this country.

Communications made abroad.

Wirth's patent (*l*) decided that letters patent may be granted to a foreigner resident abroad for an invention communicated

(*e*) Marsden *v.* Saville Street Foundry and Engineering Company, (1878) L. R. 3 Ex. D. 203.

(*f*) See Nickels *v.* Ross, (1849) 8 C. B. 679; Steadman *v.* Marsh, (1856) 2 Jur. N. S. 391; Avory's Patent, (1887) L. R. 36 Ch. D. 307, 318, 324; See chap. vii. *post*.

(*g*) See Edmunds' Patent. (1886) Griff. P. C. 281.

(*h*) See Appendix.

(*i*) See p. 303 *post*.

(*k*) Marsden *v.* Saville Street Foundry and Engineering Company, (1878) L. R. 3 Ex. D. 203.

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

Persons incapable of being Patentees.

to him by another foreigner resident abroad; but patents will not in future be granted to agents resident abroad in respect of inventions communicated to them by foreigners also resident abroad.(*m*)

Patentee need not be meritorious importer.

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

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

Persons Incapable of being Patentees.

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

The Queen.

It seems that the Queen herself could not become a patentee, for she could not grant to herself.

Body corporate.

Rule 73 of the Patent Rules 1890, provides that a body corporate may be registered as a proprietor by its corporate name; but it is clear that such a body could not alone obtain a grant of a patent for an original invention, for it could not make the requisite declaration,(*r*) invention being the act of the mind, which could not proceed from such a body in its corporate capacity.

Letters patent may be granted to a body corporate, together with the true and first inventor, since "person," as defined by the Act of 1883,(*s*) includes a body corporate.(*t*) It would appear, also, that in the case of an invention communicated from abroad a patent may be granted to a corporation alone,

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

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

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

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

(*q*) p. 206 *post*.

(*r*) p. 292 *post*.

(*s*) Sec. 117.

(*t*) *Ibid*.

since such corporation, as the first introducer of the invention into this country, might be in law the true and first inventor.(*u*) At any rate, a foreign corporation is entitled to apply for a patent under the provisions of Sec. 103 of the Act of 1883.(*x*)

Persons incapable of being Patentees.

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

Corporation sole.

It is to be doubted whether the exercise of a patent privilege by a beneficed clergyman would not be trading within the meaning of the Statute 57 Geo. III. c. 99, s. 3,(*y*) and, therefore, prohibited by that Act. And, if that be so, it might well be that a grant to such clergyman would be void, for the intent that the patentee should derive profit from the exercise of the privilege could not take effect.(*z*)

Beneficed clergyman.

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

Official persons.

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

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

Alien enemy.

(*u*) In the Matter of Carez's application, (1889) 6 R. P. C. 552, p. 18.

(*x*) Carez's patent, (1889) 6 R. P. C. 18; Société Anonyme du Générature du Temple, (1896) 13 R. P. C. 56; see p. 303 *post*.

(*y*) Hall *v.* Franklin, (1838) 3 M.&W. 259.

(*z*) Hindmarch on Patents, p. 35.

(*a*) (1875) L. R. 2 Ch. D. 812; L. R. 3 App. Cas. 239.

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

CHAPTER II.

SUBJECT-MATTER.

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

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

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

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

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

(*a*) pp. 1, 3. (*b*) Sec. 46.

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

Subject-matter must be an Art.

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

"Manufacture."

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

The subject of a valid patent must, consequently, be the working or making of a manner of new manufacture (in one or other of its two meanings) which must be new, useful, and not contrary to the law; new and useful because if it were not so the consideration for which the Crown makes the grant would fail, and not contrary to the law, for the Crown has not the power to make such a grant.

Subject-Matter must be an Art.—The subject-matter of letters patent for an invention must be an *art*. For, if any person other than the patentee makes any article or articles in accordance with the patentee's specification, he thereby commits an infringement of the patent, and yet the patent does not vest in the grantee the right to use the particular materials of which the articles made in infringement consist, for they may never have been his property. What the infringer does besides using the materials, which he has a right to do, and the physical power, which he is also entitled to avail himself of, is to use the art of applying the physical power to the materials in the manner set forth in the specification.(*e*) It

Subject-matter must be an art.

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

(*d*) Boulton *v.* Bull, (1795) 2 H. Bl. 463; Hindmarch on Patents, pp. 80, 81.

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

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

is this *art*, therefore, which is the exclusive property of the patentee, and which he, his agents or licensees, and no one else, is entitled to use during the continuance of the privilege. In the case of an article made in infringement of a patent the right of property remains in the infringer,(*f*) though he may be ordered to destroy such article, completely or partially, as may be necessary to render further infringements by its use impossible.(*g*)

By which vendible articles can be produced,

Only an art by the exercise of which vendible articles, or articles of trade or commerce, are capable of being produced can form the subject-matter of valid letters patent,(*h*) for two reasons:—(i) If the articles made by the exercise of the protected art cannot be sold, the invention will not be used, and therefore will not give any new employment to the people, and the public will receive no benefit from the invention. (ii) The intent of the patent is to reward the inventor by means of the profit arising from the making and selling the patent articles during the continuance of the privilege.(*i*)

and which is not to be exercised for illegal purposes.

An art which is to be exercised for the sole object of breaking the law, or for the sole purpose of producing anything designed to be used for an illegal purpose—*e.g.*, implements for housebreaking, picking pockets, locks, &c.—cannot form the subject-matter of valid letters patent. A grant of letters patent for such an object would be void, both on the ground of want of utility,(*k*) and as being contrary to public policy. "It would be absurd if by one law patents might be granted to reward persons for providing the means of violating any other law.(*l*) It is, however, no objection to a patent that it was taken out for the purpose of evading a statute—*e.g.*, the Pharmacy Act.(*m*)

Definition by Court of King's Bench.

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

> "A grant of the sole use of *a new invented art* is good, being indulged for the encouragement of ingenuity; but this is tied up by the Statute of 21 James I. c. 3, s. 6, to the term of

(*f*) Vavasseur *v.* Krupp, (1878) L. R. 9 Ch. D. 351.

(*g*) See chap. xiii. *post.*

(*h*) Boulton *v.* Bull, (1795) 2 H. Bl. 463; R. *v.* Wheeler, 2 B. & Ald. 349; Cornish *v.* Keene, (1837) 3 Bing. N. C. 570.

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

(*k*) Chap. iv. *post.*

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

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

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

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

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

Definition by Sir Edward Coke.

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

> In reference to the proviso in section 5 the learned author writes: "The first is that this Act shall not extend to any letters patents, or grants of privilege heretofore made of the sole working, or making, of any manner of new manufacture, but that new manufacture must have seven properties.
>
> "*First*, it must be for twenty-one years or under.
>
> "*Secondly*, it must be granted to the first and true inventor.
>
> "*Thirdly*, it must be of such manufactures which any other at the making of such letters patent did not use, for albeit it were newly invented, yet if any other did use it at the making, of the letters patents, or grants of privilege, it is declared and enacted to be void by this Act.
>
> "*Fourthly*, the privilege must not be contrary to law: such a privilege as is consonant to law must be substantially and essentially newly invented; but if the substance was *in esse* before, and a new addition thereunto, though that addition make the former more profitable, yet is it not a new manufacture in law; and so was it resolved in the Exchequer Chamber, Pasch, 15 Eliz., in *Bricot's Case*, for a privilege concerning the preparing and melting, &c., of lead ore: for then it was said that that was to put but a new button to an old coat, and it is much easier to add than to invent. And then it was also resolved, that if the new manufacture be substantially invented according to law, yet no old manufacture in use before can be prohibited.

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

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

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

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

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

"*Seventhly*, nor generally inconvenient.

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

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

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

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

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

time to come, they were left of such force as they were before the making of this Act."

Discovery and Invention.

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

Exhaustive definition is not possible.

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

Common Law authorities.

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

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

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

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

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

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

Difference between discovery and invention.

Many instances of discoveries which are incapable of pro-

(*q*) p. 207 *post*.

Discovery and Invention.

tection by letters patent, and the reasons why, will be found in the following pages.

Discovery and invention are clearly not the same thing. A discovery will not form the basis of a patentable invention unless the discoverer thereby adds something to the stock of public knowledge, which, besides being new and useful is, on the facts of the particular case, the outcome of skilful ingenuity.(*r*) The following words of *Lindley*, L.J., taken from his judgment in *Lane Fox* v. *Kensington and Knightsbridge Electric Lighting Co.*(*s*) are most instructive upon this point.

Per Lindley, L.J.

"An invention is not the same thing as a discovery. When *Volta* discovered the effect of an electric current from the battery on a frog's leg he made a great discovery, but no patentable invention. Again, a man who discovered that a known machine can produce effects which no one knew could be produced by it before may make a great and useful discovery, but if he does no more his discovery is not a patentable invention. *Britain* v. *Hirsch*, (1888) 5 R. P. C. 226 (on p. 232); *Harwood* v. *Great Northern Railway Co.*, (1865) 11 H. L. C. 654; *Horton* v. *Nabon*, (1862) 12 C. B. N. S. 437; *Saxby* v. *Gloucester Waggon Co.*, (1880) L. R. 7 Q. B. D. 305. He has added nothing but knowledge to what previously existed. A patentee must do something more; he must make some addition, not only to knowledge, but to previously known inventions and must use his knowledge and ingenuity so as to produce either a new and useful thing or result, or a new method of producing an old thing or result. On the one hand, the discovery that a known thing—such for example as a *Planté* battery—can be used for a useful purpose for which it has never been used before is not alone a patentable invention; but, on the other hand, the discovery how to use such a thing for such a purpose will be a patentable invention, if there is novelty in the mode of using it as distinguished from novelty of purpose; or if any new modification of the thing, or any new appliance is necessary for using it for its new purpose, and if such mode of using or modification or appliance involves any appreciable merit. It is often extremely difficult to draw the line between patentable inventions and non-patentable discoveries; but I have endeavoured to state the distinction as I understand it, and so far as is necessary for the purpose of the present case. I have, of course, been guided by the previous decisions on the subject, and especially by *Harwood* v. *Great*

(*r*) See p. 95 *post*.

(*s*) (1892) 9 R. P. C. 416.

Northern Railway Co., (1865) 11 H. L. C. 654, which is the most instructive of them all. I have been induced to make these observations in order to apply them to the question whether the plaintiff's invention is anything more than a discovery that *Planté* cells can be usefully employed for incandescent lighting."

Amount of Invention.

Amount of Invention.—The Crown has authority to grant letters patent for inventions to the true and first inventor only, *i.e.*, to the true and first inventor alone, or in conjunction with some other person or persons. This is the effect of the statements of the Common Law contained in the Statute of Monopolies.(*t*) It is evident, therefore, that the grantee of the patent, or one of the grantees as the case may be, must be an inventor. That is to say he must, in arriving at the discovery, which is the subject-matter of the patent, have exercised that faculty of the mind which is called invention.

Mere scintilla of invention is sufficient to support a patent.

The question arises as to whether any particular quantum of invention, in this sense, is necessary to the support of a grant of letters patent. The result of the cases on the point is that, provided the subject-matter of the patent is a manufacture within the meaning of the Statute of Monopolies,(*u*) which is new and useful, a mere *scintilla* of invention is sufficient.(*x*)

It is true that every invention capable of supporting a patent must be a new manufacture, but it does not follow that every novelty, though an important and useful one, is good subject-matter. In order to support a patent the novelty must be the outcome of thought, design, or skilful ingenuity. It is not, however, necessary that any great amount of thought, design, or skilful ingenuity must have actually been expended in making the invention, for the discovery may have been the outcome of a mere guess or happy accident, suggesting the novel application which is the real meritorious invention. Thus, the discovery of water tabbies was made by mere accident. A man having spat upon the floor, placed his hot iron on it, and observed that the moisture spread out into a kind of flower. He afterwards tried the experiment upon linen, and found it

(*t*) See p. 3 *ante*.

(*u*) p. 20 *ante*.

(*x*) American Braided Wire Co. *v.* Thomson, (1889) 6 R. P. C. 518; Vickers *v.* Siddel, (1890) 7 R. P. C. 292; Rickmann *v.* Thierry, (1896) 14 R. P. C. 105; Longbottom *v.* Shaw, (1891) 8 R. P. C. 333; Harwood *v.* Great Northern Ry. Co., (1865) 11 H. L. C. 654; 35 L. T. Q. B. 27; Losh *v.* Hague, (1837) 1 W. P. C. 202, 207; R. *v.* Cutler, (1847) 4 Q. B. 372 n.; 3 C. & K. 215; Neilson *v.* Harford (1841) 8 M. & W. 806; 11 L. J. Ex. 20; 1 W. P. C. 331; Crane *v.* Price, (1842) 4 M. & G. 580; 12 L. J. C. P. 81; 1 W. P. C. 393; Hayward *v.* Hamilton, (1879-81) Griff. P. C. 115.

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produced the same effect. He then obtained a patent for a process based on the accidental discovery, which proved of great value.(*y*)

Unsatisfied demand.

Where there is a long unsatisfied demand, and an article suddenly springs into existence which meets the demand, the length of time during which the demand was unsatisfied is matter from which it may be inferred that it is ingenuity alone which has enabled the inventor to surmount the obstacle, which otherwise would seem, from the mere existence of the long unsatisfied demand, to have existed somewhere, or in some shape. The fact, however, must not be overlooked that the demand itself may be quite new, and the novelty of the demand may have produced immediately, and without any operation of ingenuity, an obvious article to satisfy it, which consequently could not be good subject-matter.(*z*)

Essential considerations.

If the alleged invention is obvious, and it cannot be presumed that the exercise of thought, design, or skilful ingenuity was required in making it, the patent is void, on the ground of lack of subject-matter.(*a*)

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

Conception of the idea may be the whole merit.

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

(*y*) Liardet *v.* Johnson, (1778) 1 W. P. C. 54; see also 2 H. Bl. 486; Crane *v.* Price, (1842) 1 W. P. C. 411.

(*z*) Gosnell *v.* Bishop, (1888) 5 R. P. C. 158; American Braided Wire Co. *v.* Thompson, (1888) 5 R. P. C., 5 P. O. R. 125; Blakey *v.* Latham, (1889) 6 R. P. C. 187; Elias *v.* Grovesend Tinplate Co., (1890) 7 R. P. C. 455; Morgan *v.* Windover, (1890) 7 R. P. C. 131.

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

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

(*c*) See pp. 35, 36 *post*.

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

An obvious combination is not subject-matter.

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

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

The following are the leading authorities on the point that a mere *scintilla* of invention is sufficient to support a patent for subject-matter which is in fact a new and useful "manufacture" within the meaning of the Statute of Monopolies.

Harwood v. Great Northern Railway Co.

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

(*d*) Saxby *v.* Gloucester Waggon Co., L. R. (1880) 7 Q. B. D. 305; 50 L. J. Q. B. 577; Williams *v.* Nye, (1890) 7 R. P. C. 62; Ormson *v.* Clarke, (1862) 13 C. B. 339; 14 C. B. 490; Newsum *v.* Mann, (1890) 7 R. P. C. 307; Heys *v.* Hallmark, (1891) 9 R. P. C. 25.

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

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

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Blackburn, J., in delivering the opinions of himself and *Shee*, J., stated the law in the following terms, with which all the Judges consulted and the House agreed (11 H. L. C. 666): "The Statute of Monopolies (21 Jac. I. c. 3, s. 6) excepts from the abolition of monopolies patents for 'the sole working or making of any manner of new manufactures within this realm to the true and first inventor and inventors of such manufactures, which others at the time of making such letters patents and grants shall not use.' In order to bring the subject-matter of a patent within this exception, there must be *invention* so applied as to produce a practical result. And we agree with the Court of Exchequer Chamber that a *mere* application of an old contrivance in the old way to an analogous subject, *without any novelty or invention* in the mode of applying such old contrivance to the new purpose, is not a valid subject-matter of a patent. There are many decisions to that effect, which were referred to at your Lordships' Bar; and, if the matter were now, for the first time, to be decided on the construction of the statute, without reference to the cases, we should think on principle that such should be the conclusion of the Court. But then in every case arises a question of fact whether the contrivance before in use was so similar to that which the patentee claims that there is no invention in the differences, if any, between the old contrivance and that for which the patentee claims a monopoly; and, if there is none, there arises a further question—viz., whether the purpose to which the contrivance was before applied and the new purpose are so analogous or cognate that there is no discovery or invention in the new application? Whether, in short, it is a *mere* application or not? For if there is invention or discovery producing a practical benefit, as in the case of *Crane* v. *Price*, (1840) 1 W. P. C. 377; 4 Man. & Gr. 580, it is the valid subject of a patent. And we think it always must be a question of degree—a question of more or less—whether the analogy or cognateness of the purposes is so close as to prevent them being an invention in the application. Mr. *Grove*, in his very able arguments, contended, we believe correctly enough, that if there was any real invention, though a slight one, producing a practical beneficial result, the patent was good. But the question still remains, was there such an amount of cognateness in the purposes that there was no real invention or discovery?"

Lord *Westbury*, L.C., in moving the House to confirm the decision of the Court of Exchequer Chamber, said (11 H. L. C. 682): "Then, my Lords, the question is, whether there can be any invention of the plaintiff in having taken that thing which was a fish for a bridge, and having applied it as a fish to a railway. Upon

that I think the law is well and rightly settled, for there would be no end to the interference with trade and with the liberty of adopting any mechanical contrivance, if every slight difference in the application of a well-known thing should be held to constitute ground for a patent. There is the familiar contrivance of the button to the button-hole taken from the waistcoat or the coat, which may be applied in some particular mechanical combination in which it has not hitherto been applied; but it would be an idle thing, if it were possible, to take a well-known mechanical contrivance, and by applying it to a subject to which it had not hitherto been applied to constitute that application the subject of a patent to be granted as for a new invention. No sounder or more wholesome doctrine, I think, was ever established than that which was established by the decisions which are referred to in the opinions of the four learned Judges who concur in the second opinion delivered to your Lordships, namely, that you cannot have a patent for a well-known mechanical contrivance merely when it is applied in a manner or to a purpose, which is not quite the same, but is analogous to the manner or the purpose in or to which it has been hitherto notoriously used."

Elias v. Grovesend Tinplate Co.

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

Penn v. Bibby.

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

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

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according to the proposition, as he stated it, if the invention be applied to a new purpose there cannot but be some novelty in the application.

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

Thomson v. American Braided Wire Co.

Thomson v. *American Braided Wire Co.*, (1889) 6 R. P. C. 518, was a case near the border line, but the patent was upheld by the House of Lords on the ground that there was quite sufficient invention in the mode of application. Lord *Herschell's* judgment contains the following passage (6 R. P. C. 527): "It cannot be denied that both the prior patents to which I have referred afford some colour to the defendants' contention that the patentee has done nothing more than apply a known substance in a manner and to a purpose analogous to that in and to which it had been already applied, and that the patent therefore cannot be supported. If I thought that the patentee had claimed the mere use of tubular sections of braided wire as a bustle, however fastened or secured, I should arrive at the conclusion that the defendant's contention was well founded, but I do not thus construe the specification. I have already stated that in my opinion it is the combination alone for which protection is sought, and that the method of fastening the ends by clamping plates is an essential part of that which is claimed. Taking this view of the patent, I think that, even with the state of knowledge which existed at the time the patent was applied for, some invention was required to produce the bustle claimed to be protected by it. All the learned Judges in the Court of Appeal, although they arrived at the same conclusion, stated that they had done so with hesitation, and expressed the opinion that but little invention was requisite, and that the case was near the border line. I entirely agree, and have not been without doubt as to the proper decision to be arrived at."

Vickers v. Siddell.

In *Vickers* v. *Siddell*, (1890) 7 R. P. C. 292, the subject-matter of the patent related to an improved mechanical appliance for making or operating on large forgings in iron or steel. In the House of Lords, Lord *Herschell* said, 7 R. P. C. 304: "The objections of want of novelty and subject-matter cover to some extent the same ground, but it will be expedient to deal with them as far as possible separately. The invention, so far as we are concerned with it in this part of

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the case, consists of an apparatus for turning heavy forgings, composed of a wheel and endless chains, the wheel being internally toothed, and having a ratchet working in it, by means of which the wheel is caused to rotate, and the forging which rests in the endless chain is thus turned from time to time to the extent desired. It is admitted by the respondent that the elements which form this combination are all old. On the other hand the appellants admit that the combination was never in use prior to the date of the patent. But they allege that to combine these well-known elements into the apparatus needed no invention, and that it is therefore not proper subject-matter for a patent. Forgings, they say, had long rested in an endless chain, the idea of turning such forgings by turning the wheel over which the chain passed was not a new one, and a ratchet, working in teeth was a well-known device for causing a wheel to rotate to the desired extent. All this, I think, cannot be denied. But the result is an apparatus of extremely simple character, which possesses the advantage of being easily moved from place to place and applied wherever wanted. And the question remains whether this mode of dealing with forgings which require to be gradually turned was so obvious that it would at once occur to any one acquainted with the subject and desirous of accomplishing the end, or whether it required some invention to devise it. There is no doubt about the law applicable to such a question, though it is often difficult to apply it to the circumstances of a particular case, and its application is perhaps most difficult when the alleged invention consists of a new apparatus combining known elements. If the apparatus be valuable by reason of its simplicity, there is a danger of being misled by that very simplicity into the belief that no invention was needed to produce it. But experience has shown that not a few inventions, some of which have revolutionised the industries of this country, have been of so simple a character that when once they were made known it was difficult to understand how the idea had been so long in presenting itself, or not to believe that they must have been obvious to every one."

Invention purely a question of fact.

It is thus purely a question of fact in each instance whether, upon a consideration of the circumstances peculiar to each case and the state of public knowledge at the date of application for the patent, there has been an exercise of invention or not; and a decision of fact in one case is neither an authority, nor a help, to a decision of fact in another case.(*g*) In the words of the late Lord

(*g*) Crossley *v.* Beverley, (1829) 1 W. P. C. 107; Lewis *v.* Marling, (1829) 1 W. P. C. 496; King Brown *v.* Anglo-American Brush Corporation, (1889) 6 R. P. C. 414; 7 R. P. C. 436; 9 R. P. C. 313; United Telephone Co. *v.*

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Bowen (*h*): "Has there been an exercise of the inventive faculties? That depends on a true view of all the circumstances, and it cannot be governed in any one case by a finding of fact, on a totally different invention, by a tribunal like the House of Lords. We must apply our mind to the specific facts in the case before us; and nothing is more pernicious, or likely to lead the Court astray, than, when it has to decide a question of fact in one case, to wander into another case; to look at the decision of fact in that case and then to see what differentiations there can be between the facts in the cited case and the one before the Court. The Court that travels on these lines always goes wrong."(*i*)

Simplicity no bar to invention.

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

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

Harrison, Cox, Walker & Co., (1882) L. R. 21, Ch. D. 720; Actien Gesellschaft fur Cartonagen Industrie *v.* Schroeder, (1896) 13 R. P. C. 466.

(*h*) Lyon *v.* Goddard, (1893) 10 R. P. C. 346.

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

(*k*) Rickman *v.* Thierry. (1896) 14 R. P. C. 105; Hinks *v.* Safety Lighting Co., (1876) L. R. 4 Ch. D. 607; Brook *v.* Aston, (1857–9) 8 Ell. & B. 478; Ormson *v.* Clark, (1862) 13 C. B. 339, 14 C. B. 400; Saxby *v.* Gloucester Waggon Co., (1880) L. R. 7 Q. B. D. 305; 50 L. J. Q. B. 577; Williams *v.* Nye, (1890) 7 R. P. C. 62; Newsum *v.* Mann, (1890) 7 R. P. C. 307; Elias *v.* Grovesend Tinplate Co., (1890) 7 R. P. C. 455; Morgan *v.* Windover, (1890) 7 R. P. C. 131; Heys *v.* Hallmark, (1891) 9 R. P. C. 25; Duckett *v.* Whitehead, (1895) 12 R. P. C. 376; Actien Gesellschaft fur Cartonagen Industrie *v.* Schroeder, (1896) 13 R. P. C. 466.

completely removed, was known as an unguent to the ancients. The Courts nevertheless found that the process which yielded the highly useful product Lanolin was the outcome of great invention and the subject-matter of a valid patent.(*l*) Amount of Invention.

Sometimes the merit of an invention consists in clearly appreciating some particular useful end to be attained, or, as has been aptly said, in "apprehending a desideratum," the merit of the patent consisting not so much in the way in which the idea was carried out as in conceiving the idea itself.(*m*) Thus it has been held the fact that a chemist would know *a priori* that by mixing two known substances together an explosive would be the result, did not destroy the patent of a man, who by experimentally mixing them together and treating the result in a certain known way so as to waterproof it found he did get an explosive, Roburite, which satisfied commercial requisites which were not satisfied by explosives known before.(*n*) In this case the invention consisted, as it often does in other cases, of putting together items of common knowledge which no one else has ever thought of combining —common knowledge that you may mix, common knowledge that you may waterproof—but the essence of the invention was that the inventor had taken a great many things which were common knowledge and tried which of them would produce a useful and new result, and he thus ascertained that, following the process described by him in his specification, he arrived at a new and useful result, which was undoubtedly invention, and in the particular case invention of a somewhat high order.(*o*) Conception of an idea may be the merit of an invention.

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

So, though a class of bodies may have been employed before for a particular purpose, there may be sufficient invention in selecting one member of the class which possesses particular advantages not shared by the other members of the

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

(*m*) See Fawcett *v.* Harrison, (1896) 13 R. P. C. 405, 410; also p. 41 *post.*

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

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

(*p*) Farbenfabriken vorm F. Bayn *v.* Bowker, (1891) 8 R. P. C. 389; Lancashire Explosives Co. *v.* Roburite Explosives Co., (1895) 12 R. P. C. 470, 478; 13 R. P. C. 429; 14 R. P. C. 303.

Classes of Inventions.

class to support a patent for the use of that particular member.(*q*)

New application of known machine may be invention.

So also, though different machines of a certain general class or character be well known, if a person selects and applies one specially adapted for his purpose to effect a new object and produce a new article, or an old article in a substantially more expeditious and economical way than it was produced before, then he may properly claim, as subject-matter of a patent, that machine as applied to the new object, notwithstanding that he could not have claimed the machine *per se*—that is to say, without limitation as to its application.(*r*)

Mere adaptation of old idea,

On the other hand, it is not invention to adapt, without ingenuity, a well-known idea in a well-known manner for a well-known purpose, though the identical adaptation has not been made before and a very useful effect is the result.(*s*)

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

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

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

Exhaustive classification *not possible.*

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

It may, however, be pointed out that all inventions for

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

(*r*) Adamant Stone and Paving Co. *v.* Corporation of Liverpool, (1896) 14 R. P. C. 21.

(*s*) pp. 71–74 *post*.

(*t*) Heys *v.* Hallmark, (1892) 9 R. P. C. 25.

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

(*x*) 21 Jac. I. c. 3, s. 6.

which letters patent have hitherto been upheld on the ground of subject-matter may be classed under one or more of the following heads:— Principles.

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

PRINCIPLES.

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

Principles may be of the utmost value to mankind, as, for instance, the principle of gravitation or the doctrine of evolution, which have in the hands of their discoverers and others been productive of the greatest usefulness. The law, however, will not attempt to secure to the discoverer the sole use and enjoyment of such a bare principle, nor to prohibit others from making use of it. In the language of Lord *Kenyon*, it would be difficult to frame a specification of a philosophical principle, it would be something like an idea without a substratum.(*y*)

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

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

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

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

but may be together with a method of application.

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

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

"The first objection is that this is not the subject-matter of a patent, because it is said that what is claimed is a principle . . . . or, as it is sometimes termed, the idea of putting a cushion of air between the explosive mixture and the piston of the gas motor engine, so as to regulate, detain, or make gradual what would otherwise be a sudden explosion. Of course that could not be patented. I do not read the patent so. I read the patent as being to the effect that the patentee tells us that there is the idea which he wishes to carry out, but he also describes other kinds of machines which will carry it out, and he claims to carry it out substantially by one or other of these machines. That is the subject of a patent. If you have a new principle, or a new idea, as regards any art or manufacture, and then show a mode of carrying that into practice, you may patent that, though you could not patent the idea alone, and very likely could not patent the machine alone, because the machine alone would not be new. One of the strongest illustrations that I know of is the patent for the hot blast in the iron manufacture, where there was nothing new at all except the idea that the application of hot air instead of cold air to the mixture of iron ore and fuel would produce most remarkable results in the shape of economy in the manufacture of iron. The inventor or discoverer could not patent that, but what he did was this. He said: 'I will patent that idea in

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

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

Principles.

combination with the mode of carrying it out; that is, I tell you you may heat your air in a closed vessel next your furnace, and then that will effect the object.' It was held that that would do. . . . . Now that is a much stronger illustration than this of the validity of a patent as regards the subject-matter. For here is a complicated machine. . . . . In the case of the hot blast the man did not pretend to invent anything; he said a machine of any shape in which you can heat air is sufficient. Mr. *Otto* does allege he has invented a machine. It appears that he did, although a machine which, *per se*, was not of sufficient novelty probably to support a patent. It comes therefore to this, that we have a principle and a mode of carrying it out, and, I will assume for this purpose, sufficiently described, and that is good subject-matter for a patent."

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

A claim to every mode of carrying a new principle or idea into effect amounts to a claim for the principle or idea itself,(*c*) and therefore renders the patent void.

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

"There is nothing in this but the enunciation of a chemical truth that pure sulphide of calcium will absorb the sulphur compounds. The plaintiff believed that he had discovered that chemical truth, although it had been taught for many years in many books, and was well known to chemists. There is no invention of any particular process or means of employing the pure sulphide of calcium. If pure sulphide of calcium is to be used, it must be used in some separate purifier, and there is nothing therefore in any previous part of the specification to

(*c*) Neilson *v.* Harford, (1841) 1 W. P. C. 295; Booth *v.* Kennard, (1856) 2 H. & N. 84; 26 L. T. Ex. 23, 305; Wyeth *v.* Stone, 1 Story, 273; Arnold *v.* Bradbury, (1871) L. R. 6 Ch. App. 711; Patterson *v.* Gas Light and Coke Co., (1875) L. R. 2 Ch. D. 812; 3 App. Cas. 239; Automatic Weighing Machine Co. *v.* Knight, (1889) 6 R. P. C. 297.

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

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limit the universality of the claim to the employment of sulphide of calcium for the removal of sulphur in other forms than sulphuretted hydrogen. It is obviously impossible to support such a claim as that, which was plainly based on the plaintiff's mistaken idea that he had discovered that peculiar property in sulphide of calcium."

Illustrations of good claims to principles coupled with methods of application.

Neilson *v.* Harford, and Househill Co. *v.* Neilson.

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

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

> "It is quite true that a patent cannot be taken out solely for an abstract philosophical principle—for instance, for any law of Nature, or any property of matter, apart from any mode of turning it to account in the practical operations of manufacture, or the business, and arts, and utilities of life. The mere discovery of such a principle is not an invention in the patent law sense of the term. Stating such a principle in a patent may be

(*e*) (1841) 1 W. P. C. 295, 328, 331.
(*f*) (1843) 1 W. P. C. 673.
(*g*) (1843) 1 W. P. C. 673, 683.

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a promulgation of the principle, but it is no application of the principle to any practical purpose. And without that application of the principle to a practical object and end, and without the application of it to human industry, or to the purposes of human enjoyment, a person cannot in the abstract appropriate a principle to himself. But a patent will be good, though the subject of the patent consists in the discovery of a just, general, and most comprehensive principle in science or law of Nature, if that principle is by the specification applied to any special purpose, so as thereby to effectuate a practical result and benefit not previously attained. The main merit, the most important part of the invention, may consist in the conception of the original idea—in the discovery of the principle in science, or of the law of Nature, stated in the patent—and little or no pains may have been taken in working out the best manner and mode of the application of the principle to the purposes set forth in the patent. But still if the principle is stated to be applicable to any special purpose, so as to produce any result previously unknown, in the way and for the objects described, the patent is good. It is no longer an abstract principle. It comes to be a principle turned to account to a practical object, and applied to a special result. It becomes, then, not an abstract principle, which means a principle considered apart from any special purpose or practical operation, but the discovery and statement of a principle for a special purpose, that is, a practical invention, a mode of carrying a principle into effect. That such is the law, if a well-known principle is applied for the first time to produce a practical result for a special purpose, has never been disputed. It would be very strange and unjust to refuse the same legal effect, when the inventor has the additional merit of discovering the principle as well as its application to a practical object. The instant that the principle, although discovered for the first time, is stated, in actual application to, and as the agent of, producing a certain specified effect, it is no longer an abstract principle, it is then clothed with the language of practical application, and receives the impress of tangible direction to the actual business of human life."

Dangerfield v. Jones.

In *Dangerfield* v. *Jones*,(*h*) a patent for a mode of bending wood for the handles of walking-sticks, &c., in which the claim was "the application of a flame of gas or other combustible fluid or liquid as described for softening the fibres of the wood while being bent in combination with a clamping apparatus for securing the wood in its bent form until the fibres are set,

(*h*) (1865) 13 L. T. N. S. 142.

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so that the work may remain permanent as herein set forth," was declared to be perfectly valid, Vice-Chancellor *Wood*, before whom the case was tried, saying: "If, having a particular purpose in view, you take the general principles of mechanics, and apply one or other of them to a manufacture to which it has never been before applied, that is a sufficient ground for taking out a patent, provided that the Court sees that that which has been invented is new, desirable, and for the public benefit."(*i*)

Minter v. Wells.

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

Electric Telegraph Co. v. Brett.

In the *Electric Telegraph Company* v. *Brett* (*l*) the patentees claimed, substantially: (1) "We wish it to be understood that we make no claim to the application of the multiplying coils of conducting wires herein described (meaning thereby the

(*i*) (1865) 13 L. T. N. S. 142.
(*k*) (1834) 1 W. P. C. 134.
(*l*) (1851) 10 C. B. 838; 20 L. J. C. P. 123.

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galvanometer coils and magnetic needles), but the improvement and the adaptation of magnetic needles for giving signals consists in disposing the needles in vertical planes with fixed horizontal axes, making them heavier at one end than the other, so that they hang perpendicularly, and limiting the angular motion by stops, against which the needles may rest in suitable inclining directions for pointing out on a vertical dial the signification of the signals. (2) The combining several needles, so as to give signals by determinate angular motions. (3) The improvement whereby the complete apparatus for giving signals and sounding alarms, as described, may have duplicates of such apparatus at intermediate places between the two ends, all such duplicates operating simultaneously with each other." In the judgment, *Cresswell*, J., said: "It was insisted that the giving of duplicate signals at intermediate stations was not the proper subject of a patent, being an idea or principle only, and not a new manufacture. But we think that the patentees not only communicated the idea or principle that duplicate signals might be given, but showed how it might be done—*i.e.*, by duplicate apparatus at each station—and that this is a fit subject of a patent."

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

A claim to a particular general arrangement must be distinguished from a claim to a principle itself. If it falls short of a claim to a principle, it does not invalidate the patent. This may be illustrated by a reference to the history of the development of the phonograph. Phonographs were at one time made with a single diaphragm, with a single tool or point for recording and reproducing. Later, two diaphragms were used with separate recording and reproducing points, together with a floating weight applied to give the proper pressure to the reproducing point. Edison then discovered that the floating weight might also be applied to the recording point, and so a single diaphragm with both the points on it might be used. For this discovery a patent was obtained, and the specification claimed (*inter alia*) "In a phonograph, attaching both the recording point and the reproducing point to the same diaphragm, means being provided whereby either of the points may be brought into operative position on the surface of the phonogram." In an action brought for the infringement of this patent, it was sought on the defendant's behalf to invalidate the grant on the ground that the above claim was a claim for a mere idea of having both points on a single diaphragm divorced from the idea of carrying it out, and might so prevent any one

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else making a useful and totally different arrangement. It was however held, both by the Judge of first instance and the Court of Appeal, that on the evidence the claim was not for a principle, but for a novel and useful arrangement.(*m*) Lord *Esher*, M.R., in the Court of Appeal, adopted the decision of *Wright*, J., *ipsissimis verbis*, and said (*n*):

"Now, I have said I have confined this mode of dealing with this patent to the case of a machine, and I therefore adopt precisely the way in which Mr. Justice *Wright* has stated the matter: 'There remains the question whether the patent is invalidated by the first claim. That claim appears to me to be, on the face of it, a claim of monopoly for every form of phonograph in which two styles are attached to one diaphragm, so that each style can be brought to bear on the cylinder. It is stated that such a claim is a claim to monopolise a principle. I think not.' Now that is the part with which I say I agree. 'It is a claim for a particular arrangement of essential parts of a machine, which arrangement has obvious advantages, but has never before been made practicable in a way disclosed by the specification. Such a claim ought properly to be construed as a claim of monopoly for that arrangement carried out by any means substantially similar to those disclosed in the specification, and that appears to be sufficient.' I agree with that, and therefore I think that so far as this objection is concerned, applying it to each and every one of the claims, it shows that these claims are none of them wanting in that respect."

Ambit of patent for carrying a new principle into effect.

A patent for carrying a principle which is new into effect protects the grantee against all other modes of carrying the same principle into effect,(*o*) provided they can be construed as colourable imitations—*i.e.*, provided it can fairly be said that the real substance of the invention claimed has been pirated.(*p*)

When a new principle is applied for the first time, the Court looks very narrowly at what a person does who claims to carry the principle into effect by a means different to that employed by the patentee.(*q*)

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

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

(*o*) Jupe *v.* Pratt, (1837) 1 W. P. C. 146; Minter *v.* Wells, (1834) 1 W. P. C. 127; Household Co. *v.* Neilson, (1843) 1 W. P. C. 685; Otto *v.* Linford, (1881) 46 L. T. N. S. 35; Crossley *v.* Beverley, (1829) 1 W. P. C. 106; Badische Anilin und Soda Fabrik *v.* Levenstein, (1883) L. R. 24, Ch. D. 156, 171; Easterbrook *v.* The Great Western Ry. Co., (1885) 2 R. P. C. 201.

(*p*) Automatic Weighing Machine Co. *v.* Knight, (1889) 6 R. P. C. 297, 304, 308; see also Moore *v.* Thomson, (1890) 7 R. P. C. 325; 6 R. P. C. 426.

(*q*) Automatic Weighing Machine Co. *v.* Knight, (1889) 6 R. P. C. 304; Automatic Weighing Machine Co. *v.* Combined Weighing Machine Co., (1889) 6 R. P. C. 367.

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

Dictum of Alderson, B., explained.

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

> "You cannot take out a patent for a principle; you may take out a patent for a principle coupled with the mode of carrying the principle into effect, provided you have not only discovered the principle, but invented some mode of carrying it into effect. But then you must start with having invented some mode of carrying the principle into effect; if you have done that, then you are entitled to protect yourself from all other modes of carrying the same principle into effect, that being treated by the jury as piracy of your original invention."

The above expressions of *Alderson*, B., would at first sight appear to establish the proposition, that if a man has invented a new principle, and shows one method of carrying it into effect, he thereupon becomes entitled to protection against every other possible method of carrying out the new principle. *Cotton*, L.J., however, pointed out that the above language of *Alderson*, B., was used during the discussion of the case, probably to meet something that was said by counsel, and did not express his full opinion. A patentee can prevent any one from using the same method of carrying a new principle into effect, or from using the same thing with only a colourable difference. Where there is a principle first applied in a machine, capable of carrying it into effect, the Court looks more narrowly at those who carry out the same principle, and say they do it by a different mode, and looks to see whether, in effect, although the mode is not exactly the same, it is only a colourable difference—a mechanical equivalent for a substantial part of the patentee's invention, being looked upon as a mere colourable difference and therefore he is entitled to an injunction against that mode of carrying out his principle,

(r) 1 W. P. C. 145, 146.

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which is only the same in substance as that which he patented, though there are colourable differences.(*s*)

Ambit of patent for carrying old principle into effect.

If a principle is not new, then a patent for a method of applying it only secures to the patentee protection in respect of the particular method specified, and there may be other perfectly valid patents in respect of different methods of carrying the same principle into effect.(*t*)

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

PROCESSES.

Processes are subject-matter.

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

History of the cases.

For some time prior to that decision there were many cases and dicta of the Judges indicating the general opinion that grants made in respect of such subject-matter were not invalid. *Abbot*, C.J., in *R.* v. *Wheeler*,(*y*) pointed out that the word "manufacture" "may perhaps extend to a new process to be carried on by known implements, or elements, acting upon known substances, and ultimately producing some other known substance, but producing it in a cheaper or more expeditious manner, or of a better or more useful kind." In *Boulton* v. *Bull*,(*z*) the Court was divided in opinion, but *Eyre*, C.J., made the following remarks:

"It was admitted in the argument at the Bar that the word '*manufacture*' in the statute (*a*) was of extensive significa-

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

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

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

(*x*) 4 M. & G. 580; 1 W. P. C. 393; 12 L. J. C. P. 81; see p. 48 *post*.

(*y*) (1850) 2 B. & Ald. 493.

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

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

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

Hall v. *Jarvis*,(*c*) decided that though the application of the flame of oil to remove the superfluous fibres from lace and other goods was a mere process, yet a patent for this invention could be upheld on the ground of subject-matter. In *Hill* v. *Thompson*,(*d*) Lord *Eldon*, L.C., stated that "there may be a

(*b*) 4 Bun. 2397.

(*c*) (1822) 1 W. P. C. 100, approved in Losh *v.* Hague (1838), 1 W. C. P. 207, and Crane *v.* Price, (1842) 5 M. & G. 580; 1 W. P. C. 393; 12 L. J. C. P. 81.

(*d*) (1817) 1 W. P. C. 237.

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valid patent for a new combination of materials previously in use for the same purpose, *or for a new method of applying such materials.*" So also in *Morgan* v. *Seaward*,(*e*) *Park*, B., said that the word "manufacture" in the statute (*f*) must be construed in one of two ways; it may mean the machine when completed, *or the mode of constructing the machine;* but in *Gibson* v. *Brand*,(*g*) *Tindal*, C.J., pointed out that it was not necessary in that case to go into the question whether or not a patent can be supported for a *process* only. If the specification were properly prepared it probably might be considered a fit subject for a patent.

Law settled by Crane *v.* Price.

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

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

Decision in Crane *v.* Price doubtful upon the facts.

Though the above statement of the law by *Tindal*, C.J., in *Crane* v. *Price* has never been questioned, Judges have expressed doubts as to whether, upon the facts, the case was correctly decided.(*i*) Novelty of the result is, no doubt, evidence of invention in the process which produces it, but it is not necessarily conclusive evidence.(*k*) If the case were open

(*e*) (1837) 2 M. & W. 544; 1 W. P. C. 171.

(*f*) 21 Jac. I c. 3, s. 6.

(*g*) (1841) 4 M. & G. 179; 1 W. P. C. 627.

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

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

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

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to review on the facts, another Court would probably come to the conclusion that since the hot-air blast was known with bituminous coal, and the cold blast was in use with anthracite, and both processes were used for the manufacture of iron, the patent could not be supported; for all that the patentee did was to apply the hot blast in conjunction with anthracite to the manufacture of iron in a manner analogous to its former application to bituminous coal for the same purpose, and though the discovery was commercially very important, it was not one involving the exercise of invention. Further, the grant of the patent was an undue curtailment of the right of the public to use the hot blast in the manufacture of iron with bituminous coal, anthracite, or any other known fuel.

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

In the somewhat recent and analogous case of *Partington* v. *Hartlepools Pulp and Paper Co.*,(*l*) it appeared that paraffin had been used to make wood-pulp pass more easily through the meshes of machines in which it was manufactured, and had also been used for the purpose of cleaning the machine from resin deposited from the pulp. The patentee discovered that if the machine were perfectly clean to start with, the addition of paraffin to the contents of the machine thus prevented the formation of objectionable specks of a pitchy or resinous nature in the pulp, and also the partial coating or fouling of the machine. *Romer*, J., held that this commercially important discovery was not the subject-matter for a patent, since all the patentee claimed was to use the old process of adding paraffin, but in a clean machine where the process effected the additional advantages discovered by him. Had the patent been upheld the public would have been prevented from using the old process *with clean machines*, whether for the purpose of making the wood-pulp pass through the meshes as previously, or for the sake of the additional advantage discovered by the patentee. A patent which so curtailed the public right could not be supported.(*m*)

Discovery of theory of what was done before only empirically.

A man cannot have a patent merely because he discovers the theory and reason of that which has before been done empirically. On the other hand, if by reason of knowing the theory he is enabled to make some improvements he may take out a patent for those improvements, but he cannot have a patent to prevent others from using what they had used before, though empirically.(*n*)

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

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

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

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Discovery of a hidden property or virtue.

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

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

(*o*) (1844) 2 W. P. C. 96; see also Newton *v.* Vaucher, p. 89 *post*.
(*p*) 2 W. P. C. 103.

Processes.

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

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

Objection to the term "patentable process."

It is sometimes objected that to speak of a patentable process is in reality a misuse of terms, for the subject of the patent is *a manufacture according to a new process*, and therefore a new manufacture. To take the above case of *Crane* v. *Price*,(*s*) the subject there was the manufacture of iron by a new process —*i.e.*, the combination of a hot-air blast and anthracite in the furnace.

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

Bearing in mind, however, the very wide interpretation given

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

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

(*s*) (1842) 2 M. & G. 580; p. 48 *ante*.

(*t*) (1847) 2 W. P. C. 182.

Processes.

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

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

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

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

Thus a process for the manufacture of gelatine by cutting

(*u*) Eyre, C.J., in Boulton *v.* Bull, (1795) 2 H. Bl. 463.
(*x*) Cornish *v.* Keen, (1835) 1 W. P. C. 508.
(*y*) Bush *v.* Fox, (1852) Macr. P. C. 176.
(*z*) Ralston *v.* Smith, (1865) 11 H. L. C. 223.
(*a*) Forsyth *v.* Riviere, (1819) 1 Carp. Rep. 401.
(*b*) Hartley's Patent, (1777) 1 W. P. C. 54.
(*c*) (1851) 1 C. B. 838.
(*d*) Newall *v.* Elliott, (1858) 13 W. R. 11.

hides into thin slices and then submitting them in that state to the action of caustic alkali, whereby the use of blood, as in the method previously used, was rendered unnecessary, was declared to be subject-matter.(*e*) Processes.

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

Questions sometimes arise as to the ambit of patents for processes. As a result of the cases,(*g*) the apparently wide dicta in the earlier of which have been modified by the later ones, it may be stated that when a person has discovered a process for arriving at a new result not known before, or utilised a principle for the first time—*i.e.*, the patent is a pioneer patent(*h*)—and in the specification there is described one means which is effectual for the purpose of arriving at that result, new at the time when the patent is taken out, the patentee will be protected against all other *analogous* processes for arriving at the same result, and no one can without infringing his patent adopt simply a different process to achieve the same result. Where, on the other hand, the patent is one which achieves what at the date of the patent is a known result, any other person may obtain another patent for any new process for arriving at the same result; or he may use any other process without infringing the patent first taken out.(*g*) Ambit of patent for a process.

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

> "If the invention be, as I have already described, nothing more than a particular means to attain a given result which is perfectly well known, then you can no more say that the inven-

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

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

(*g*) Jupe *v.* Pratt, (1837) 1 W. P. C. 145; The Househill Co. *v.* Neilson, (1843) 1 W. P. C. 673; Curtis *v.* Platt, (1863) L. R. 3 Ch. D. 135 n.; L. R. 1 H. L. 337; The Badische Anilin und Soda Fabrik *v.* Levinstein, (1885) 2 R. P. C. 89; 4 R. P. C. 449; 6 R. P. C. 387; Proctor *v.* Bennis, (1887) 4 R. P. C. 333; L. R. 36 Ch. D. 740; 57 L. J. Ch. 11; Gosnell *v.* Bishop, (1888) 5 R. P. C. 158; Bovill *v.* Pimm, (1856) 11 Exch. 718, 739; Barber *v.* Grace, (1847) 1 Exch. 339; 17 L. J. Exch. 122; Automatic Weighing Machine Co. *v.* Knight, (1889) 6 R. P. C. 304; Nobel's Explosives Co. *v.* Anderson, (1894) 11 R. P. C. 519, 527; Incandescent Gas Light Co. *v.* De Mare Incandescent Gas Light System, Ltd., (1896) 13 R. P. C. 331.

(*h*) See chap. xiii. *post*.

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

Processes.

tion of one distinct set of means interferes with the invention of another than you could say originally that there ought not to be patents for the inventions of distinct means to an end. I would illustrate it familiarly by this example. If we suppose a patent may be for a ladder to go down a pit, that patent may be made to comprehend all ladders, whether constructed of wood or of iron, or of hemp or of wire; but if another man invented a mode of letting men down the pit by a rope and pulley, it would be impossible to say that the one means of attaining that particular end was to be regarded as identical with or comprehended in the other. . . . It is extremely desirable that when a beneficial idea has been started by one man he should have the benefit of his invention, and that it should not be curtailed or destroyed by another man simply improving upon the idea; but if the idea be nothing in the world more than the discovery of a road to attain a particular end, it does not at all interfere with another man discovering another road to attain that end, any more than it would be reasonable to say that if one man has a good road to go to Brighton by Croydon, another man shall not have a road to go to Brighton by Dorking."

Per Lord Halsbury, L.C.

Lord *Halsbury*, L.C., in *Moore* v. *Thomson*,(*k*) referring to the ambit of Lord *Kelvin's* invention of a card for the mariner's compass—which was in fact the first card in which the principle or system of employing a very light card with the greater part of its weight thrown on to the periphery was successfully applied in practice with all the attendant advantages of reduction of frictional and other sources of error—and overruling the judgment of the Irish *Master of the Rolls*, who had construed the patent as being merely for a new means of attaining an old object, stated the law applicable to the case in like manner thus:—

"Now what appears to me with all submission to be the fallacy, to be found in the very lucid and learned judgment of the *Master of the Rolls*, is that he has used the phrase 'a new instrument, and a new end, and a new means of attaining an old end,' as if those words in themselves were sufficient to explain the subject-matter to which he applied them. In certain relations those words may be sufficiently clear; but I will take the illustration which I think is that of Lord *Westbury* in one of the cases relied on (*l*), in which he points out that the end and object (that is to say, the end in the Greek sense) of a ladder is to get down to the bottom of a pit, and that a man

(*k*) (1890) 7 R. P. C. 332.
(*l*) See quotation from Lord Westbury's judgment in Curtis v. Platt, above.

might have taken out a patent for a ladder which would include all sorts of instruments of that kind, but that, if somebody invented a mode of lowering a man to the bottom of a pit with a rope, that could not be said to be an infringement of a patent for any sort of ladder, and yet the end and object of the invention would be the same, to get to the bottom of the pit. When the *Master of the Rolls*, using the word 'end' in that sense, says that the end and object of both instruments here is to obtain a mariner's compass which shall, under all circumstances, as nearly as possible point to the true north, he seems to me to omit to consider the machinery by which that is effected. I do not mean merely the construction of the particular machine, but he omits to consider that there may be new principles of construction by which that end is to be attained, as distinct as the lowering by a rope is from the lowering by a ladder. . . . . The moment you come to apply yourself to see how this compass differs from all other compasses which have been hitherto in use, you perceive (at least it appears to me to be so, as a matter of fact, upon the evidence) that it is absolutely different from any compass which anybody has ever seen before. Upon principles, the ascertainment of which was the result undoubtedly of great study and wonderful powers of invention, Sir *William Thomson* found out that he could obtain those great things which had been pointed out as most material for the purpose of securing the steadiness of the needle, that which should keep the needle in its position, notwithstanding the rolling of the ship, in whatever direction it should take place, and he invented an instrument accomplishing that object. I think it is a fallacy to say that this is an old instrument; it is not an old instrument; it is a new instrument. It is an instrument in which the end is attained by certain expedients, by the weight being thrown on to the circumference, and being in the position in which it is and the weight of the whole compass card, as it is called, being reduced."

Products.

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

Products.

The question arises whether a grant of a patent for a product is valid. There is no reported case in which the point has been fully discussed and definitely decided, though there

Is a patent for a product valid?

Products.

are dicta of various Judges which appear, at first sight at any rate, to be conflicting.(*m*)

The word "product" is defined in "Webster's Dictionary" as "anything that is produced, whether as the result of generation, growth, labour, or thought, or by the operation of involuntary causes."

When a claim for a product is good and when bad.

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

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

First, suppose a man finds a deposit of ore which is new to science, and contains a metal never isolated by chemists before. The discoverer of the ore applies to it a perfectly well-known process of refining and treatment which has been applied to other ores before, but he obtains, to his astonishment, the new metal, instead of what he expected, some known metal, *e.g.*, iron. Could he prevent, by means of a patent, other people from obtaining the new metal in the same way from similar ore, should they find it on their land? It is submitted he could not do so. The discoverer of the new ore could not have a patent for the application of the old process to the new-found ore, for it is *ex hypothesi* a mere analogous use,(*o*) though it yields a result which in a sense is new.

To grant the man a patent which would enable him to stop others from applying the old process to the new-found ore, and so obtaining the new metal, would be unduly to curtail the right of the public to apply the old process to any ore which comes to their hands, and would surely be "mischievous to the State . . . by hurt of trade and generally inconvenient," and consequently void at Common Law, as stated in the sixth section of the Statute of Monopolies.(*p*) The new metal is not a new product, in the sense of an article made by a new art. In

(*m*) See Ralston *v.* Smith, (1865) 35 L. J. C. P. 49; 11 H. L. C. 223; Vorwerk *v.* Evans, (1890) 7 R. P. C. 265; Automatic Weighing Machine Co. *v.* Knight, (1889) 6 R. P. C. 297; Nobel's Explosives Co. *v.* Anderson, (1894–5) 11 R. P. C. 519; 12 R. P. C. 164; Rickmann *v.* Thierry, (1896) 14 R. P. C. 106; Lancashire Explosives Co. *v.* Roburite Co., (1896) 13 R. P. C. 429, 476; 14 R. P. C. 303.

(*n*) See p. 21 *ante*.

(*o*) See p. 71 *post*.

(*p*) p. 3 *ante*.

the words of *Cotton*, L.J.,(*q*) "a thing is not to be called new, in the sense of *Crane* v. *Price*, simply because that particular thing has never been seen before. To be new, in a patent sense, it is necessary that the novelty must show invention." Products.

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

Thirdly, take the case of a new chemical dye. Suppose a chemist by experiment finds a process of treating certain salts never treated in the same way before, and thereby obtains a new compound which is a valuable dye. After describing how he obtains the new product he could, no doubt, claim the product as a "new manufacture" within the Statute of Monopolies. Here the claim to the product, when construed as it must be by reference to the specifications as a whole,(*s*) is really a claim to the product produced substantially by the exercise of the new art or process which is the real invention, and the novelty of which is evidence of the novelty of the result. In the words of *Eyre*, C.J.,(*t*) "When the effect produced is some new substance or composition of things the patent ought to be for such new substance or composition without regard to the mechanism or process by which it has been produced. When the effect produced is no substance or composition of things the patent can only be for the mechanism or for the process."

Ambit of legitimate claim to a new product,

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

It is submitted that a claim to a new product, which under the circumstances of the case is a legitimate one, does not, where it is possible that the product may be produced by some means or method not described by the patentee in his specifi-

(*q*) Blakey *v.* Latham, (1889) 6 R. P. C. 187; see also Thierry *v.* Rickman, (1895) 12 R. P. C. 547–548; judgment of Key, L.J.

(*r*) (1893–6) 10 R. P. C. 205, 350; 13 R. P. C. 24.

(*s*) p. 247 *post*.

(*t*) Boulton *v.* Bull, (1795) Dav. P. C. 208.

Combinations.

cation upon a fair construction, secure to the patentee protection against all such other means or methods of producing the new product. It would appear that, as in the analogous instance of a patent for the application of a new principle,(*u*) a claim to a *new* product, when the claim is legitimate, differs only in its scope from a claim to a new means or method of producing an *old* product in so far as in the former case the Courts look very closely at the acts of one who claims to produce the new product, without licence by a means or method different to those described by the patentee.(*x*)

a new means of producing an old product.

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

Combinations.

A new combination is subject-matter.

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

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

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

Merit depends largely on result produced.

The merit of a new combination very much depends on the result produced. When a very slight alteration turns that

(*u*) p. 44 *ante*.
(*x*) p. 45 *ante*.
(*y*) p. 46 *ante*.
(*z*) Boulton *v.* Bull, (1795) 2 H. & Bl. 487; Dav. P. C. 199; Bovill *v.* Moor, (1815) 2 Coop. App. Cas. 56; Dav. P. C. 361; 2 Marsh, R. 211; Brunton *v.* Hawkes, (1820) 4 B. & Ald. 541; Huddart *v.* Grimshaw, (1803) Dav. P. C. 265; 1 W. P. C. 85; Lister *v.* Leather, (1857) 8 E. & B. 1004; 27 L. J. Q. B. 295; Hill *v.* Thompson, (1817) 1 W. P. C. 237; Lewis *v.* Davis, (1829) C. & P. 502; 1 W. P. C. 488; 1 Carp. P. C. 471; Saunders *v.* Aston, (1832) 1 Carp. P. C. 510; Carpenter *v.* Smith, (1841) 1 W. P. C. 538; Allen *v.* Rawson, (1845) 1 C. B. 551; Bovill *v.* Keyworth, (1857) 7 E. & B. 725; 29 L. T. 194; Spencer *v.* Jack, (1862–1864) 3 De G. J. & S. 346; 11 L. T. N. S. 242; Morton *v.* Middleton, 1 Court of Session, 3rd series, 721; Foxwell *v.* Bostock, (1863) 4 De G. J. & S. 298; Wright *v.* Hitchcock, (1870) L. R. 5 Ex. 37; 39 L. J. Ex. 97; Murray *v.* Clayton, (1872) L. R. 7 Ch. 570; Watling *v.* Stevens, (1886) 3 R. P. C. 37; Moseley *v.* Victoria Rubber Co., (1887) 4 R. P. C. 251.

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which was practically useless into what is useful and important, the Courts consider that, though the invention was apparently small, yet the result being the difference between failure and success, it is fit subject-matter.(*a*) Thus, the mere placing of two flat wicks parallel to each other in an oil lamp, two concentric round wicks having been previously combined, and flat wicks being perfectly well known, has been held sufficient to merit a patent ;(*b*) so also has the substitution of a filament, carbonised before formation, for a thin rod in an incandescent electric lamp ; (*c*) the alteration, in the shape of the handle of a tennis racket ; (*d*) and the combination of a basin and chamber, formerly separated, forming an automatic-flushing water-closet, which was a great improvement on all others known at the date of the patent, since the combination allowed the putting in the chamber of a tipper so large that it protruded into the basin and gave a very strong vertical flow.(*e*)

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

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

In *Crane* v. *Price* (*h*) a patent for a new combination of the use of the known hot-air blast with the use of the known anthracite or stone-coal in the process of smelting iron was declared valid by *Tindal*, C.J.(*i*) *James*, L.J., in the case of *Murray* v. *Clayton*,(*k*) took objection to the use of the word "combination" by *Tindal*, C.J., in *Crane* v. *Price*, but agreed with the principle of the decision of the learned Chief Justice in the following words: "No doubt this case (*Crane* v. *Price*) has been questioned, but, if I may be permitted to say so, with

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

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

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

(*d*) Moss *v.* Malings, (1886) 3 R. P. C. 373.

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

(*f*) Crane *v.* Price, (1842) 4 M. & G. 580 ; 1 W. P. C. 408.

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

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

(*i*) p. 48 *ante*.

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

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all respect to the very powerful tribunal which decided that case, I have never been satisfied with the decision. That, however, is simply because I could not see how the word 'combination' could be properly applied to the introduction of a particular kind of fuel into a machine which had been patented for the use of every kind of fuel in the making of iron; and neither I, nor, so far as I am aware, any other Judge has ever questioned the principle upon which that case was decided."

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

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

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

"It seems to me then that the plaintiff really is an inventor; he has found out something. He makes an article that was not made before. This particular case may be, no doubt, upon the verge, but one cannot help making this remark, that it is very strange, if it is no invention, that it has never been done before.

(*l*) Per Tindal, C.J., Crane *v.* Price, 1 W. P. C. 409.
(*m*) (1879-81) Griff. P. C. 115.

Why has it never been done before? Why, because nobody had found it out, which I take to be equivalent to invention." Combinations.

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

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

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

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

When a thing is old, but has not been used for the particular purpose for which the patentee uses it, a claim may be valid for its use in the particular combination described, Claim to use of an old thing in a particular combination.

(*n*) (1888) 7 R. P. C. 131.
(*o*) (1896) 13 R. P. C. 268, 398.
(*p*) Boyd *v.* Horrocks, (1886-89) 5 R. P. C. 557; 6 R. P. C. 152; 9 R. P. C. 77.
(*q*) Hill *v.* Thompson, (1817) 8 Taunt. 375; 3 Mer. 622; 1 W. P. C. 232; chap. v.
(*r*) Wood *v.* Raphael, (1896) 13 R. P. C. 730.

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

Novelty of parts not necessary.

Each of the parts of which the combination consists may, in itself, be old,(*t*) or some of the parts may be old and some new,(*u*) or the whole of the parts may be new.(*x*)

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

In what a new combination may consist.

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

The parts of which a combination consists may be old or

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

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

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

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

(*y*) p. 228 *post;* Lister *v.* Leather, (1857) 8 El. & Bl. 1004; 27 L. J. Q. B. 295; Foxwell *v.* Bostock, (1863) 12 W. R. 723; 4 De G. J. & S. 298; Harrison *v.* Anderston Foundry Co., (1876) L. R. 1 App. Cas. 574; Clark *v.* Adie, (1873) 2 App. Cas. 328; Westinghouse *v.* Lancashire and Yorkshire Ry. Co., (1884) 1 R. P. C. 239.

(*z*) Russel *v.* Cowley, (1834) 1 W. P. C. 459; 1 Cr. M. & R. 864; Minter *v.* Mower, (1835) 6 A. & E. 735; 1 W. P. C. 142; Booth *v.* Kennard, (1856) 1 H. & N. 527; 2 H. & N. 84.

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

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

new processes, and the combination of such processes will support a patent if the result be new and useful.(*c*) Combinations.

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

A special rearrangement of old parts acted upon as described by the patentee may constitute a new combination, which will support a patent—*e.g.*, *Birch's* sewing machine.(*e*) Special rearrangement of old parts.

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

A combination which differs only from a previous combination in that there is substituted an equivalent part or process in the place of some part or process found in the prior com- Substitution of equivalents in prior combinations.

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

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

(*e*) Birch *v.* Harrop, (1896) 13 R. P. C. 615.

(*f*) Muirhead *v.* Commercial Cable Co., (1894) 12 R. P. C. 54.

(*g*) Herrberger *v.* Squire, (1889) 6 R. P. C. 194.

(*h*) United Horse Shoe and Nail Co. *v.* Swedish Horse Nail Co., (1889) 6 R. P. C. 1.

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

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bination, is good subject-matter when the equivalent part or process was not known to be an equivalent at the date of the prior patent,(*k*) but if the equivalent was known to be an equivalent at the date of the former patent the mere substituting it in the combination would most probably be an infringement, and is not subject-matter for a fresh patent.(*l*)

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

The following may be taken as instances of patents which have been held void on the ground of lack of subject-matter, the novelty being merely the substitution of one equivalent for another in an old combination of parts or processes, and requiring the exercise of no invention. *Rushton's* patent for "improvements in the manufacture of artificial hair," which consisted of the use of Russian tops or similar wool in the manufacture of chignons, which were formerly made from mohair.(*m*) *Amet's* patent for "improved means of distending articles of dress," which consisted in making the hoops of a petticoat of steel instead of whalebone.(*n*) *Horton's* patent for "improvements in the construction of gas-holders," which consisted in forming a joint of double-angle iron instead of two pieces of single-angle iron.(*o*) *Parkes'* patent for "improvements in lamps," which consisted in the substitution of a hinge for a slide in a known glass lamp.(*p*) *Fletcher's* patent for "improvements in apparatus for cooking and heating by means of gas," which consisted merely in the substitution of a hinge for a slide.(*q*) *Jensen's* patent for "improvements in oil boxes or lubricators for revolving and other parts of machinery," which consisted in the alteration of a known combination of an oil-box with a piston actuated by a screw for the purpose of forcing the oil out, by substituting in the place of the piston a screw filling the whole of the box.(*r*). *Murray's* patent for "improvements in machinery for making bricks," which consisted in moving

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

(*l*) Bateman *v.* Gray, (1853) Macr. P. C. 102; Electric Telegraph Co. *v.* Brett, (1851) 10 C. B. 838; 20 L. J. C. P. 123; Ormson *v.* Clarke, (1862) 13 C. B. 339; 14 C. B. 490; Stevens *v.* Keating, (1847) 1 Ex. R. 339; 17 L. J. Ex. 122; Gamble *v.* Kurtz, (1846) 3 C. B. 435; Walton *v.* Potter, (1841) 1 W. P. C. 586; Rassel *v.* Cowley, (1834) 1 W. P. C. 463; Morgan *v.* Seaward, (1836) 1 W. P. C. 171; Bovill *v.* Moore, (1815) Day. P. C. 405; Hill *v.* Thompson, (1818) 1 W. P. 242; R. *v.* Lister, (1826) Webster on Patents, 80; Hancock *v.* Moulton, (1852) Johns. Pat. Man. 6th ed. 254; Cochrane *v.* Braithwaite, 3 Lon. Journ. N. S. 42; Neilson *v.* Harford, (1841) 1 W. P. C. 310.

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

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

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

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

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

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

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the cutting wires against the clay instead of the clay against the cutting wires.(*s*) *Brunton's* patent for "improvements in the manufacture of ship's anchors," &c., which consisted merely in making the two flukes in one with a thickness of metal in the middle sufficient to pierce with a hole for the insertion of the shank instead of joining the flukes by welding them to the shank, as was done formerly.(*t*) *Tickelpenny's* patent for "improvements in, and connected with, the construction and support of fire-proof floors and ceilings," which consisted merely in filling known hollow iron columns with water.(*u*) *Brown's* patent for "improvements in punching nails for shoeing horses and other animals," which consisted merely in the substitution of a pivot for a hinge in a nail-making machine.(*x*) *Winby's* patent for "improvements in points and crossings for tramways," which consisted in the introduction of a spring for a weighted lever in a switch arrangement for a tramway crossing.(*y*) *Nuttall's* patent for a beer barrel tap which substituted a gauze strainer for a metal strainer to keep impurities floating in the beer out of the tap.(*z*)

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Improvement may be subject-matter.

If a man takes an existing and already known manufacture, and by the exercise of invention makes an alteration, which really is novel and an improvement, whether it be the addition to,(*a*) the omission from,(*b*) or only the rearrangement of(*c*) old parts, the alteration so made is a fresh arrangement. It is now established beyond doubt that such an improvement, pro-

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

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

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

(*x*) United Horseshoe and Nail Co. *v.* Swedish Horsenail Co., (1888) 6 R. P. C. 1; see also Deutsche Nähmaschinen Fabrik Vorm Wertheim *v.* Pfaff, (1890) 7 R. P. C. 251.

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

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

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

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

(*c*) p. 63 *ante*.

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vided that it be new and useful, may be the subject-matter of a patent.(*d*)

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

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

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

Argument against legality of patents for improvements.

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

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

(*d*) R. *v.* Arkwright, (1785) Dav. P. C. 61 ; 1 W. P. C. 64 ; Hill *v.* Thompson, (1817) 8 Taunt. 375 ; 2 B. & Mo. 448 ; 1 W. P. C. 232 ; Lewis *v.* Davis, (1829) 3 C. & P. 502 ; Boulton *v.* Bull, (1795) 2 H. Bl. 489 ; Harmar *v.* Playne, (1809) 11 East, 101 ; Crane *v.* Price, (1842) 1 W. P. C. 410.

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

(*f*) *Ex parte* Fox, (1812) 1 V. & B. 67 ; 1 W. P. C. 431 n. ; Fox *v.* Dellestable, (1866) 15 W. R. 195 ; Crane *v.* Price, (1842) 4 M. & G. 580 ; 1 W. P. C. 410 ; 12 L. J. C. P. 81 ; Lister *v.* Leather, (1857) 8 E. & B. 1017.

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

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

Patent for improvement no proof of inutility of original invention.

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

Ambit of patent for improvement.

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

Patentee must claim only the improvement.

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

Invention necessary to support a patent for an improvement.

In order that an improvement may be good subject-matter it is absolutely necessary that there be the presumption of some degree of invention having been required to make the improvement.(*n*) Thus, in the case of a patent granted to *J. White* for "improvements in ladies' mourning bonnet and hat falls," which claimed forming both sides of ladies' mourning bonnet and hat falls alike by applying thereto the fold above the bottom fold on each side thereof, as explained, the patent was held void on the ground of want of invention, *Malins*, V.C., saying: "Whereas formerly the fold was sewn on one side only, now it is sewn on both sides, so that whichever way it is turned it has a good side outwards. There is no invention in it. However meritorious as an im-

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

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

(*k*) p. 222 *post;* Hill *v.* Thompson, (1817) 8 Taunt. 375; 2 B. Mo. 448; 1 W. P. C. 229; Bovill *v.* Moor, (1815) 2 Marsh, 211; Dav. P. C. 361; Minter *v.* Mower, (1835) 1 W. P. C. 142; Williams *v.* Brodie, (1785) Dav. P. C. 26; 1 W. P. C. 75; Hornblower *v.* Bolton, (1799) 8 T. R. 103; Jessop's Case, 1 W. P. C. 42 n.; Dav. P. C. 182, 203; Crane *v.* Price, (1842) 1 W. P. C. 413; (1857) Lister *v.* Leather, 8 E. & B. 1004.

(*l*) Leggott *v.* McGeoch, (1893) 10 R. P. C. 429, 435; p. 222 *post.*

(*m*) See judgment of Lord Watson, Brown *v.* Jackson, (1895) 12 R. P. C. 324.

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

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provement, which might probably have been registered for one or two years, it is not the subject of a patent."(*o*)

Mere working direction though valuable is not subject-matter.

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

Per James, L.J.

> "There is in that no suggestion of any new apparatus—of any new process. There is no device or scheme of any kind. Lime purifiers in succession were in general, almost universal, use wherever lime could be freely used. . . . . What he (the patentee) claims to have discovered is, that if the carbonic acid, which is the first thing taken up by the lime, is not wholly taken up at the beginning, and is allowed to enter the last purifier or purifiers, it in fact poisons the latter, decomposes the sulphide of calcium already formed, disengages the other sulphur absorbed by the sulphide, and of course fills the gas again with the sulphur impurities which had been removed. This is a very valuable working caution and direction, but it is impossible to make anything more of it than a working caution and direction. It really amounts to nothing more than a direction to be sufficiently liberal in the use of the caustic lime in the first stage, and an instruction that the moment it is so far carbonated as not to arrest the carbonic acid it should be removed and a fresh supply of lime got. It may be a direction and an instruction of the greatest possible value and utility, but it is utterly impossible to make such a direction and instruction, however valuable, the subject of a patent."

Per Lord Blackburn.

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

> "The appellant appears, from what he says in his specification, to be of opinion that, if he first discovered the theory and reason of that which had before been done empirically, he is

(*o*) White *v.* Toms, (1867) 37 L. J. Ch. 204.
(*p*) Tetley *v.* Easton, (1857) 2 C. B. N. S. 706.
(*q*) (1875) L. R. 2 Ch. D. 834.

entitled to a patent. I need hardly point out that this is a mistake; if by reason of knowing the theory he is enabled to make some improvements, he may take out a patent for those improvements, but he cannot take out a patent to prevent others using what they had used before, though empirically." (*r*)

Improvements.

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

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

Neither is there invention in a mere adaptation of a well-known idea, in a well-known manner, for a well-known purpose, without ingenuity, though the adaptation effects an improvement, which supplants articles already in the market, and is commercially very successful.(*t*)

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

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

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

When an invention is an improvement on an existing invention the amount of the improvement does not affect the validity of a patent granted in respect of it; if there is an improvement,

Amount of improvement does not affect validity.

(*r*) L. R. 3 App. Cas. 246, p. 49 *ante*.

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

(*t*) Longbottom *v.* Shaw, (1888-91) 5 R. P. C. 497; 6 R. P. C. 143; 8 R. P. C. 333.

(*u*) See p. 237 *post*.

Improvements.

however small, which is the outcome of invention, that is quite sufficient to support the patent.(*x*)

Examples.

In *Sykes* v. *Howarth*,(*y*) a patent for "improvements in fancy rollers of machines for carding wool and other fabrics" was held valid. Before the invention, the machines used for carding wool, &c., consisted of a series of large cylinders on which smaller cylinders revolved, the last of the series of smaller cylinders termed a "fancy roller" was used to raise the fibre on the surface of the larger roller. The rollers were covered with "cards" (strips of leather thickly studded with short wires). These cards were cleaned by means of a hand-scraper, an objectionable method, from the fact that the person using the scraper had to stand at the side of the machine, and was therefore unable to draw the scraper in an exact line with the "gates" of the "cards" (passages between the wires), and other cards were liable to be injured. The improvements for which the patent was granted consisted in the introduction of wide spaces between the cards, which produced an exhaust current of air, and made the rollers operate in their function as fancy rollers. Also the fancy rollers were applicable and employed for cleaning the other card-covered cylinders.

In *Heath* v. *Unwin*,(*z*) the defendant was charged with infringing the plaintiff's patent, which was for "certain improvements in the manufacture of iron and steel," consisting among others in the use of carburet of manganese in any process, whereby iron is converted into cast steel. The alleged infringement consisted in the substitution of the elements of carburet of manganese in the place of the carburet of manganese itself in the plaintiff's process. The evidence showed that the elements combined first in the crucible and formed carburet of manganese, which then acted on the iron in the same way as the ready formed carburet of manganese introduced according to the plaintiff's original process. The Court of Exchequer Chamber, taking this view of the evidence, reversed the decision of the Courts below, and held that the process had been infringed; but the House of Lords, having had the assistance of the opinions of the Judges,(*a*) reversed the decision of the Court of Exchequer Chamber. The process, as carried out by *Unwin*, was a great improvement on that mentioned in the

(*x*) See Alderson, B., in Morgan *v.* Seaward, (1836) 1 W. P. C. 173, 186.

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

(*z*) (1843) 2 W. P. C. 216, 218, 221, 223, 228, 236, 279; 5 H. L. 505.

(*a*) (1854) 2 W. P. C.; 5 H. L. C. 505.

plaintiff's patent, being much neater and effecting a considerable reduction in the cost of the steel; and it was held to be no infringement of the plaintiff's process, and would, therefore, probably have of itself formed the subject of a patent.

New Uses of Old Appliances.

New Uses of Old Appliances.

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

New use of old appliance may be subject-matter.

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

(*b*) See pp. 27–36 *ante*.

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

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

New Uses of Old Appliances.

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

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

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

1. A patent for the mere new use of a known contrivance, without any additional ingenuity in overcoming fresh difficulties, is bad, and cannot be supported. If the new use involves no ingenuity, but is in manner and purpose analogous to the old use, although not quite the same, there is no invention, no manner of new manufacture within the meaning of the Statute of James.

2. On the other hand, a patent for a new use of a known contrivance is good and can be supported if the new use involves practical difficulties which the patentee has been the first to see and overcome by some ingenuity of his own. An improved thing produced by a new and ingenious application of a known contrivance to an old thing is a manner of new manufacture within the meaning of the statute. Under which of these rules any particular case falls depends on its own special circumstances, and is often a question of very great difficulty, giving rise to considerable difference of opinion, as in the well-known bustle case *American Braided Wire Co.* v. *Thompson*, 6 R. P. C. 518. But the rules themselves are intelligible enough. Their application involves a correct estimate of the degree of ingenuity which amounts to invention. The difficulty of saying where invention sufficient to support a patent exists and where it does not is well known to all persons conversant with patent law." (*e*)

No rule possible.

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

There may be an element of novelty in an alleged invention, and yet that novelty may consist only in the new occasion or new use to which an old and well-known thing or method is

(1894) 11 R. P. C. 58; Rose's Patents Co. *v.* Braby, (1894) 11 R. P. C. 198; Singer *v.* Rudge Cycle Co., (1894) 11 R. P. C. 463; Shaw *v.* Barton, (1895) 12 R. P. C. 282; Rickmann *v.* Thierry, (1896) 14 R. P. C. 105; Haws *v.* Harding, (1897) 14 R. P. C. 105.

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

(*f*) See Lister *v.* Norton, (1886) 3 R. P. C. 205; Morgan *v.* Windover, (1887) 4 R. P. C. 426; see also p. 33 *ante*.

New Uses of Old Appliances.

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

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

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

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

Apprehension of a new use may be invention.

In some cases however the apprehension of the new use of the old thing is invention sufficient to support a patent for the new use—*e.g.*, the application of an old thing to remove a defect in an old machine(*h*) or the use of retorts inclined at a particular angle for the purpose of saving labour and expense in gas-making though inclined retorts had been used before for purposes other than gas-making.(*i*)

In the following cases, patents which, in each instance,

(*g*) Tatham *v.* Dania, (1869) Griff. P. C. 213, judgment of Willes, J.
(*h*) Edison-Bell Phonograph Corporation *v.* Smith, (1894) 11 R. P. C. 398, 399.
(*i*) Automatic Coal Gas Retort Co. *v.* Mayor, &c., of Salford, (1897) 14 R. P. C. 450.

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related to some new application of an old thing or method, were declared invalid, on the ground of insufficiency of invention and consequent want of proper subject-matter.

Cases in which patents for new uses were held bad.

Kay *v.* Marshall.

In *Kay* v. *Marshall*, (1836) 2 W. P. C. 36, 39, 47, 48, 69, 71, 77, 79; 8 L. J. C. P. 261, (*k*) it appeared that before the patent flax and other fibrous substances were spun with machines, by which the reach was varied according to the staple or fibre of the article to be spun, and that it had been a fundamental principle of dry spinning, known and used before the granting of the patent; and, further, that the reach used in cotton spinning had been less than two and a half inches. The real question in the case was whether, with public knowledge in the state above indicated, a patent could be upheld for placing the retaining rollers, and the drawing rollers, of a spinning machine, which was known and in use before, within two and a half inches of each other, and the Court of Common Pleas held that it could not. *Tindal*, C.J., in delivering the judgment of the Court, said: (*l*)

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

Losh *v.* Hague.

In *Losh* v. *Hague*, (1837) 1 W. P. C. 200; 5 M. & W. 387, which was an action brought for the alleged infringement of a patent for "improvement in the construction of wheels for carriages *to be used on railways*," it was objected by the defendant that Losh was not the true and first inventor; and it was proved that wheels made on the same principle as that claimed by the patent had been previously known, though they had never been used on railways. The jury by their verdict upheld this objection on the part of the defendant. Lord *Abinger*, C.B., in directing the jury, referred to the case of *Hall* v. *Jarvis*, (1822) 1 W. P. C. 100, and said: "That was the application of a new contrivance to the same purpose; but it is a different thing when you take out a patent for applying a new contrivance to

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

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

an old object, and applying an old contrivance to a new object—that is a very different thing. In the case the learned counsel put, he says, 'If a surgeon goes into a mercer's shop and sees the mercer cutting velvet or silk with a pair of scissors with a knob to them, he, seeing that, would have a right to take out a patent in order to apply the same scissors to cutting a sore or a patient's skin.' I do not quite agree with that law. I think if a surgeon had gone to him and said, 'I see how well your scissors cut,' and he said, 'I can apply them instead of a lancet by putting a knob at the end,' that would be quite a different thing, and he might get a patent for that; but it would be a very extraordinary thing to say that because all mankind have been accustomed to eat soup with a spoon, a man could take out a patent because he says you might eat peas with a spoon. The law on the subject is this: that you cannot have a patent for applying a well-known thing, that might be applied to fifty thousand different purposes, for applying it to an operation which is exactly analogous to what was done before. Suppose a man invents a pair of scissors to cut cloth with, if the scissors were never invented before he could take out a patent for it. If another man found he could cut silk with them, why should he take out a patent for that?"

New Uses of Old Appliances.

Cases in which patents for new uses were held bad.

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

Regina v. Cutler.

In *Bush* v. *Fox*, Macr. P. C. 164; 23 L. J. Ex. 275; 24 L. J. Ex. 251; 5 H. L. Cas. 707, the patent was for "Improvements in the means of, and in the apparatus for, building and working under water," and the patentee claimed "the mode of constructing the interior of a caisson in such manner that the workpeople may be supplied with compressed air, and be able to raise the materials excavated, and to make or construct foundations and buildings, as above described." The defendant proved that the apparatus described in a prior patent was the same in all material respects as the plaintiff's caisson, the mode of working was the same in both cases, and they differed only in their application,

Bush v. Fox.

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Cases in which patents for new uses were held bad.

Bush *v.* Fox.

the prior patent being for excavating and sinking shafts, &c., on land, the plaintiff's for sinking, excavating and constructing foundations under water. In directing the jury, *Pollock*, C.B., said: "I am of opinion, upon the evidence as it now stands, that the said supposed invention in the declaration mentioned was not an invention of a certain manner of new manufacture in processes and forms as the plaintiff has alleged. I think that an invention must be a production of something that can be used or sold or made use of for some purpose, or some method which results in something of the same sort. And I think that a man cannot, if he has applied—supposing this to be a new application—an old invention, or part of an old invention, to a new purpose, obtain a patent for such an application. Now, if the construction of this caisson, or pile, or whatever it is to be called, is to be looked upon as old, and the object of the patent is for applying it to a new purpose, that is not a manufacture: and the application is such an operation (if so it can be called) that nothing new which results from it can, I think, be the subject of a patent. . . . . I think if one man invents a new mode of looking at the moon, somebody else cannot take out a patent for using the same mode to look at the sun, nor for any mere application of it to a different purpose. If a man were to take out a patent for a telescope to be used for making observations on land, I do not think any one could say, 'I will take out another patent for that telescope to be used for making observations on the sea.' I therefore direct you, that, in point of law, in my judgment, the supposed invention was not an invention of any manner of new manufacture in manner and form as the plaintiff has alleged." This ruling was affirmed in the Exchequer Chamber and the House of Lords.

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

New Uses of Old Appliances.

Cases in which patents for new uses were held bad.

In *The Patent Bottle Envelope Company* v. *Seymer*, (1858) 5 C. B. N. S. 164; 28 L. J. C. P. 22, the patent was for "improvements in the manufacture of cases or envelopes for covering bottles." The claim was for "the combination of mechanism, and the making of envelopes for bottles, as herein described." The defendants worked a patent for "improvements in the manufacture of cases or packings for bottles or jars," in which they employed a mould or mandril similar to the plaintiff's, and this was the infringement complained of. In delivering the judgment of the Court of Common Pleas, *Willes*, J., said: "The fact that the mould or mandril constitutes part only of the plaintiff's process does not of itself affect the question. The infringement of any part of a patent process is actionable, if that part is of itself new and useful, so as that it might be the subject-matter of a patent, and is used by the infringer to effect the object, or part of the object, proposed by the patentee. The question, therefore, is, whether the plaintiffs could have taken out a patent simply for applying a model or mandril in the form of a bottle, or, indeed, a bottle itself, in making envelopes for bottles. We are of opinion that they could not. The use of a model or mandril, for producing given forms of pliable materials, was admitted at the trial, and indeed, without such admission, is well known to have been for ages common and usual in various arts. Such use was part of common knowledge, and a model or mandril for purposes similar to that of this patent was an ordinary and well-known tool. It is merely in respect of the sort of material to which it is applied, and the form of the utensil produced by it, that the plaintiff's application of the model possesses any novelty. The application of a well-known tool to work previously untried materials, or to produce new forms, is not, in my opinion, the subject-matter of a patent. The observations of the Court, in giving judgment in the recent case of *Tetley* v. *Easton*, (1857) 26 L. J. C. P. 269, sustained this proposition. Indeed, to hold the contrary might tend to produce oppressive monopolies in the application of old and well-known implements to new materials, without any further novelty or merit than the discovery of the material or the form into which it is to be worked. Such discovery is not, in our opinion, one of a new 'manufacture' within the statute of James, and a patent for it alone cannot be maintained."

Patent Bottle Envelope Co. v. Seymer.

In *Brook* v. *Aston*, (1857) 8 E. & B. 478; 27 L. J. Q. B. 145; 28 L. J. Q. B. 175; affirmed 5 Jur. N. S. 1025, the action was brought for the infringement of a patent for "improvement in finishing yarns of wool or hair, and in the finishing of woven fabrics." The defendant pleaded that it was not the working

Brook v. Aston.

New Uses of Old Appliances.

Cases in which patents for new uses were held bad.

Brook *v.* Aston.

or making of any manufacture for which letters patent could by law be granted. The specification stated: "This invention has for its object an improvement in finishing yarns of wool or hair, and consists in causing *yarns of wool or hair*, whilst distended and kept separate, to be subjected to the action of rotatory beaters, or burnishers, by which such yarns will be burnished or polished on all sides." Then followed a description and drawings of the machinery, showing the manner in which the threads were distended and kept separate, and were passed over a revolving circular brush, on their way to some rapidly revolving beaters or burnishers, which gave smoothness to their surface. The first claim was: "causing yarns of wool or hair, whilst distended and kept separate, to be subjected to the action of rotatory beaters or burnishers, whereby the fibre is closed and strengthened and the surface effectually polished."

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

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

New Uses of Old Appliances.

Cases in which patents for new uses were held bad.

Brook v. Aston.

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

Martin, B., said: "The question is, whether there was any evidence to go to the jury at the end of the plaintiff's case. . . . . I quite concur in the judgment of the Court of Common Pleas in the *Patent Bottle Envelope Company* v. *Seymer*, (1858) 28 L. J. C. P. 22, that the application of a well-known tool to work previously untried materials, or to produce new forms, is not the subject of a patent. When a machine is well known it becomes in fact a tool. I am therefore of opinion that the application of this machinery to woollen yarn is not the subject of a patent."

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

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

Harwood v. Great Northern Railway Company.

In *Harwood* v. *The Great Northern Railway Company*, (1860) 2 B. & S. 194, 222; 11 H. L. Cas. 654; 29 L. J. Q. B. 193; 31 L. J. Q. B. 198; 35 L. J. Q. B. 27, a patent for the purpose of connecting the rails of railways by "fishes" was held void on the ground that similar fishes had been previously used to fasten pieces of timber together in the construction of bridges, and also in various articles of machinery. *Willes*, J., in the Court of Exchequer Chamber, held the invention was the mere application of an old contrivance in the old way to an analogous subject without novelty or invention in the mode of applying such old

New Uses of Old Appliances.

Cases in which patents for new uses were held bad.

contrivance to the new purpose. On the appeal to the House of Lords, Lord *Westbury*, L.C., thus expressed himself: "The question is, whether there can be any invention in taking that thing which was a fish for a bridge and having applied it as a fish to a railway. Upon that I think the law is well and rightly settled, for there would be no end to the interference with trade and with the liberty of adopting any mechanical contrivance if every slight difference in the application of a well-known thing should be held to constitute ground for a patent. There is the familiar contrivance of the button to the button-hole taken from the waistcoat or the coat, which may be applied in some particular mechanical combination in which it has not hitherto been applied. But it would be an idle thing, if it were possible, to take a well-known mechanical contrivance and by applying it to a subject to which it has not hitherto been applied, to constitute that application the subject of a patent to be granted as for a new invention. No sounder or more wholesome doctrine, I think, was ever established than that which was established by the decisions referred to in the opinions of the four learned Judges who concur in the second opinion delivered to your Lordships—namely, that you cannot have a patent for a well-known mechanical contrivance merely when it is applied in a manner, or to a purpose, which is not quite the same, but is analogous to the manner or purpose in or to which it has been hitherto notoriously used."

Jordan v. Moore.

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

Parkes v. Stevens.

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

Horton v. Mabon.

In *Horton* v. *Mabon*, (1862) 12 C. B. N. S. 437; 16 C. B. N. S.

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

New Uses of Old Appliances.

Cases in which patents for new uses were held bad.

In *Ormson* v. *Clarke*, (1862) 13 C. B. N. S. 337; 14 C. B. N. S. 475; 32 L. J. C. P. S. 291, the patent was for "an improvement in the manufacture of cast tubular boilers," and the invention consisted in causing the upright tubes and the lower hollow ring (which connected the tubes together at their lower ends) to be cast at one time, and thus form one casting. It appeared that similar boilers had been previously made in several pieces, which were afterwards fastened together by means of cement. The Court of Common Pleas and, on appeal, the Court of Exchequer Chamber, held that the alleged invention, which was merely the casting in one piece that which used formerly to be cast in several pieces, was not proper subject-matter.

Ormson v. Clarke.

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

Bamlett v. Picksley.

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

Philpot v. Hanbury.

In *Sharp* v. *Brauer*, (1886) 3 R. P. C. 193, the plaintiff's patent was for "a new or improved window screen or blind," and the specification stated that the invention related to screens

Sharp v. Brauer.

New Uses of Old Appliances.

Cases in which patents for new uses were held bad.

or blinds for windows, and the improvement consisted in forming them of cardboard, millboard, &c. The evidence showed that similar screens were old and well known, and all that the patentee had done was to apply them in an obvious way to a window.

Rowcliffe v. Longford Wire Co.

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

Albo-Carbon Light Co. v. Kidd.

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

Calvert v. Ashburn.

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

Herrburger v. Squire.

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

Blakey v. Latham.

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

Longbottom v. Shaw.

In *Longbottom* v. *Shaw*, (1888–1891) 5 R. P. C. 497, 6 R. P. C. 143, 510, 8 R. P. C. 333, a patent which related to reels or frames for holding pile or other fabrics was declared void by the Courts below and the House of Lords under the following circumstances. The invention claimed by the patentee consisted in forming a row of hooks upon a foundation piece of metal, either by stamping the hooks out of the metal, or by soldering the hooks on to the metal in a groove and then attaching the row of hooks so formed to a reel or frame for the purpose of holding the pile. It was admitted

that reels or frames with a row of hooks were well known at the date of the patent, and also that the idea of attaching a row of hooks to a strip of metal so that the strip of metal with the hooks could be applied when required was not new, though it had in fact never been applied to reels or frames. It was proved in evidence that the plaintiff had effected an improvement, and that the article produced by him had supplanted the old article in the market; but there was no evidence that the defects of the old article had been much felt, or had caused a demand for an improved article, or that attention had been called to the removal of those defects.

New Uses of Old Appliances.

Cases in which patents for new uses were held bad.

In *Morgan* v. *Windover*, (1888) 5 R. P. C. 304; 7 R. P. C. 131, the Court of First Instance and the Court of Appeal upheld a patent for turning springs, which had been formerly used at the back of carriages, and inverting them and putting them to the front of carriages in such a manner as not to interfere with the fore wheels and their motion in turning the carriage. The Court thought that there was invention in selecting the proper spring to effect the desired purpose of giving horizontal motion, and in adopting it in the proper way to the carriage. The House of Lords, however, held the patent void on the ground that it was merely the application of a known article to an analogous purpose without any ingenuity, and that it was not patentable, though advantages were produced that were not produced before.

Morgan v. Windover.

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

Tucker v. Kaye.

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

Embossed Metal Plate Co. v. Saupe.

In *Fairfax* v. *Lyons*, (1891) 8 R. P. C. 401, a patent for mechanical means for moving targets was declared void on

Fairfax v. Lyons.

New Uses of Old Appliances.

Cases in which patents for new uses were held bad.

the ground that substantially similar means had been used for the same purpose before.

Wilson v. Union Oil Mills Co.

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

Baker *v.* Kinnell.

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

Nicoll *v.* Swears.

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

Sudbury *v.* Lee.

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

Rose's Patents Co. *v.* Braby.

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

Singer *v.* Rudge Cycle Co.

In *Singer* v. *Rudge Cycle Co.*, (1894) 11 R. P. C. 463, the mere application of an old locking device to the front wheel of a

bicycle for the purpose of locking the steering gear when the bicycle was at rest was held not to be subject-matter in face of the fact that the same locking device had been used formerly for the purpose of locking the steering gear when the bicycle was being ridden.

New Uses of Old Appliances.

Cases in which patents for new uses were held bad.

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

Shaw *v.* Barton.

In *Rickmann* v. *Thierry*, (1896) 14 R. P. C. 105, the coating of an eyelet for boots with celluloid and so producing an eyelet which was very useful and largely adopted, was held by the House of Lords, though not unanimously and differing from both Courts below, not to be subject-matter, having regard to the fact that studs and the upper part of lacing hooks had been treated in the same way, and the patentee made no claim to any particular process, but claimed merely "any eyelet of any metal if covered with celluloid or any similar material."

Rickmann *v.* Thierry.

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

Haws *v.* Harding.

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

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

New Uses of Old Appliances.

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

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

Applications of newly discovered qualities of natural or artificial products.

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

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

It should be carefully borne in mind that in order to support a patent for a new use of a known thing there must be evidence that some invention was required to make the analogous application; and it is not sufficient to point out that advantages are obtained which were never before produced.(*p*)

In this connection, Lord *Watson*, in supporting a motion in the House of Lords that the judgment of the Court of Appeal in *Morgan* v. *Windover* (*q*) should be reversed, referred to the decision of the House in *American Braided Wire Company* v. *Thompson* (*r*) in the following terms: "The learned Judges do not appear to me to have sufficiently considered the principle enunciated by Lord *Westbury*, and accepted by this House in *Harwood* v. *Great Northern Railway Company*, to the effect that there cannot be a patent 'for a well-known mechanical contrivance merely when it is applied in a manner and to a purpose which is not quite the same, but is analogous to, the manner or the purpose in or to which it has hitherto been notoriously

(*m*) See Bamlett *v.* Picksley, (1875) Griff. P. C. 40, 42.

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

(*o*) See pp. 50-51 *ante*.

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

(*q*) (1890) 7 R. P. C. 131.

(*r*) (1889) 6 R. P. C. 518.

applied.' Your Lordships had recent occasion to consider that principle in *Thompson* v. *American Braided Wire Company*.(s) In that case, although your Lordships were not agreed in the result, there was no difference of opinion as to the soundness of the rule which formed the ground of the judgment in *Harwood's Case*. The majority, of whom I happened to be one, rested their judgment upon the fact, which they held to be established, that the particular forms of 'dress improvers' specified and claimed were not *mere* applications of wire braid to an analogous purpose, but that the patentee in his peculiar modes of adapting the old material to its new, though analogous, use had exercised and exhibited a degree of inventive ingenuity *just sufficient to protect him from the incidence of the rule*. It was for that reason only that the patent was sustained."(t)

New Uses of Old Appliances.

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

Cases in which patents for new uses were held good.

In *Muntz* v. *Foster*, (1844) 2 W. P. C. 96, it appeared that at the date of the plaintiff's patent, alloys of zinc and copper were known, but it was not known that an alloy consisting of zinc and copper, in certain definite proportions, by virtue of its oxidating properties, was especially adapted for sheathing the bottoms of ships, which was the object of the invention. The novelty consisted in this, that the patentee by an experiment ascertained that a mixture of the alloy of zinc with copper, in certain definite proportions, has the effect of producing a better sheathing than the copper sheathing previously in use, by reason and by means of its oxidating just in sufficient quantities, and not too much, so as to wear away and impair the sheathing and render the vessel unsafe, but enough at the same time to keep by its wearing the bottom of the vessel clean from the impurities which before attached to it. *Tindal*, C.J., was of opinion that the subject-matter was good, and the jury by their verdict upheld the patent.

Muntz v. Foster.

In *Penn* v. *Bibby*, (1866) L. R. 1 Eq. 548; 2 Ch. 127, the patent related to the construction of hard wood bearings for the shafts of screw propellers. The complete specification described the manner of performing the invention by reference to drawings, and stated (in substance): The inner surfaces of the bearings for a propeller shaft are grooved to receive strips or fillets of wood, which project beyond the inner surfaces of the metal bearings, and allow the water to circulate in the channels

Penn v. Bibby.

(s) (1889) 6 R. P. C. 518.

(t) (1890) 7 R. P. C. 136.

New Uses of Old Appliances.

Cases in which patents for new uses were held good.

Penn *v.* Bibby.

so formed. The wood is by preference *lignum vitæ*, the grain being either longitudinal with the fillets, or at right-angles to the bearing surfaces thereof. In other words, the bearings are not continuous metal surfaces, as previously constructed, but a series of wooden fillets or ridges, having water spaces between them, which support the rubbing action of the shaft. It was further stated that the several pieces of wood employed in a bearing might be inclined to the axis instead of parallel to it as shown. Also, that it was not essential that the fillets of wood should be fitted in the interior of fixed metal bearings, as a like effect would be obtained if they were attached to the shaft and revolved therewith, in metal bearings, in the manner shown in the drawings. The claim was "the employment of wood in the construction of the bearings, and brushes for the shafts of screw and submerged propellers, as herein described." The defendant objected that this was not subject-matter, but without success, because the alleged invention was merely the new application of an old and well-known thing, and alleged, as examples of old use, certain grindstones and water-wheels.

Lord *Chelmsford*, L.C., dismissed an application for a new trial, which was made on the ground (*inter alia*) that the invention was not the subject-matter of a patent, saying, "The criterion given by Lord *Campbell*, in *Brook* v. *Aston*, (1857) 8 E. & B. 485, has been frequently cited (as it was in the present argument), that a patent may be valid for the application of an old invention to a new purpose; but to make it valid there must be some novelty in the application. I cannot help thinking that there must be some inaccuracy in his Lordship's words, because, according to the proposition as he stated it, if the invention be applied to a new purpose there cannot but be some novelty in the application. In every case of this description one main consideration seems to be, whether the new application lies so much out of the track of the former use as not naturally to suggest itself to a person turning his mind to the subject, but to require some application of thought and study. Now, strictly applying this test to the present case, it appears to me impossible to say that the patented invention is merely the application of an old thing to a new purpose. The only examples of old use alleged by the defendant were in grindstones and water-wheels. No doubt these have what may be called bearings; but they are of a totally different character, and for a totally different object from the bearings patented. It is difficult to believe that bearings of this description could ever have suggested the application of wood to bearings of screw propellers in the way described in the patent. It is, to my mind, not merely a different application, but something in itself

essentially different. It has been found that, in the mode of constructing screw propellers by making metal work upon metal they soon wore out, and occasioned a violent, irregular motion on the vessel. Mr. *Penn* devised the plan of placing fillets of wood upon the inner surface of the bearings, so as to prevent the shaft coming into contact with the metal of the bearings, and so as to admit of the water flowing freely between the shaft and the inner surfaces of the metal bearings, thereby keeping the wood constantly lubricated. The success of this invention has been proved in a remarkable manner. It would be an extraordinary fact if an invention of this kind, so long wanted, and of such great utility, should have been lying in everybody's way who knew anything of the construction of water-wheels or grindstones, and yet should never have been discovered."

New Uses of Old Appliances.

Cases in which patents for new uses were held good.

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

Steiner *v.* Heald.

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

Newton *v.* Vaucher.

New Uses of Old Appliances.

Cases in which patents for new uses were held good.

Reynolds *v.* Amos.

that of the defendant, and that the plaintiff's patent was valid.

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

American Braided Wire Co. *v.* Thompson.

In *American Braided Wire Co.* v. *Thompson*, (1887–1889) 4 R. P. C. 316; 5 R. P. C. 113; 6 R. P. C. 518; see 86 *ante*, a patent for "improvements in bustles or dress-improvers" was declared void by the Court of First Instance, but the decision was reversed by the Court of Appeal, and a majority of the House of Lords saw no reason for dissenting from the decision of the Court of Appeal, which was accordingly upheld. The invention consisted substantially in the application of tubular sections of braided hard wire to bustles. A specification was produced which specified certain applications of braided wire to satchel-handles and other articles, and mentioned that the material might be applied to bustles. On the hearing of the appeal fresh evidence was adduced as to the state of public knowledge at the date of the patent, from which it appeared that the application of braided hard wire to cushions and pillows had been specified, and that it was known that hard wire could be braided in the same manner as soft wire—*i.e.*, in a tubular form on a core—but that there had not been any use of tubular sections of braided hard wire within the realm. The majority of the House of Lords held that the invention was not the mere application of a known thing to an analogous use, but that sufficient ingenuity to support the patent was shown by the patentee's combination in the adoption of tubular wire braids (though a known elastic material) and their application in substitution for other known elastic materials in making bustles, the result obtained being a complete article, effective and capable of being manufactured and sold cheaply.

Pirrie *v.* York Street Flax Spinning Co.

In *Pirrie* v. *York Street Flax Spinning Co.*, (1893) 10 R. P. C. 34; 11 R. P. C. 429, it appeared that paper tubes had been

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

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

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

CHAPTER III.

NOVELTY.

NOVELTY AT COMMON LAW.

Novelty an essential at Common Law.

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

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

Primâ facie right of public.

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

Consideration fails if invention is not new.

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

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

Novelty at Common Law.

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

Common Law authorities.

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

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

The power retained to the Crown by the Statute of Monopolies, of granting patents for inventions, is limited to granting patents and grants of privilege "of the sole working or

(*g*) Harmar *v.* Playne, (1807) 14 Ves. 132.
(*h*) Rann *v.* Hughes, (1797) 7 T. R. 350 *n.*; Anson on Contracts, 68.
(*i*) Myddelton *v.* Lord Kenyon, (1794) 2 Ves. Jr. 408.
(*k*) It was laid down in Darcy *v.* Allin, (1602) Noy, R. 178; 1 W. P. C. 6, decided in 1602, that: "where any man, by his own charge and industry, or by his own wit or invention, doth bring any *new* trade into the realm, or any engine tending to the furtherance of a trade *that never was used before*, and that for the good of the realm, that in such cases the King may grant to him a monopoly patent, for some reasonable time, until the subjects may learn the same, *in consideration of the good that he doth bring by his invention to the Commonwealth*, otherwise not."

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

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

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

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

Novelty at Common Law.

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

Novelty requisite by statute as well as Common Law.

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

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

Prior use by others renders patent bad.

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

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

It should be borne in mind that not every novelty which is

(*l*) 21 Jac. I. c. 3, s. 6.
(*m*) pp. 5–18 *ante*.
(*n*) The Househill Co. *v.* Neilson, (1843) 1 W. P. C. 689; Cornish *v.* Keene. (1835) 1 W. P. C. 507.
(*o*) *Ibid.*; see chap. xiii *post*.
(*p*) Young *v.* Rosenthal, (1884) 1 R. P. C. 32.

useful can be the subject-matter of a patent.(*q*) A thing is not patentable merely because it is new and useful and has not been made before; to be patentable the novelty must show invention.(*r*)

Public Knowledge.

Public Knowledge.

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

Meaning of public knowledge.

If some of the public, therefore, not under terms of secrecy or confidence to the inventor, become, at any time before the date of the patent, acquainted with the invention, this will be quite sufficient to render the grant void; and the question in an action upon a patent, the validity of which is put in issue on the ground of previous publication, is: "Is it the fair conclusion from the evidence that some English people, under no obligation of secrecy (*t*) arising from confidence or good faith towards the patentee, knew of the invention at the date when the plaintiff took out his patent." (*u*)

Jessel, M.R., in *Plimpton* v. *Malcolmson*, (*x*) discussing the question, What is meant by a thing being known to the public in England, said:—

Per Jessel, M.R.

> "Here, again, we must have recourse to authority, and also must consider what the principle is that is to be deduced from the authorities. When you say a thing is known to the public, and part of common knowledge, of course you do not mean that

(*q*) See p. 27 *ante*; Ralston *v.* Smith, (1866) 11 H. L. C. 223; Brook *v.* Ashton, (1857) 8 Ell. & B. 472; 27 L. J. Q. B. 145; 28 L. J. Q. B. 175; Longbottom *v.* Shaw, (1888) 8 R. P. C. 333; 6 R. P. C. 143; 5 R. P. C. 497; Rickmann *v.* Thierry, (1896) 14 R. P. C. 185.

(*r*) See p. 26 *ante*; Thierry *v.* Rickmann. (1895) 12 R. P. C. 548.

(*s*) Patterson *v.* The Gas Light and Coke Co., (1875) L. R. 3 App. Cas. 239; Humpherson *v.* Syer, (1887) 4 R. P. C. 414.

(*t*) p. 123 *post*.

(*u*) Per Fry, L.J.; Humpherson *v.* Syer, (1887) 4 R. P. C. 407, 414; Tickelpenny *v.* Army and Navy Co-operative Society, (1888) 5 R. P. C. 405.

(*x*) (1876) L. R. 3 Ch. D. 556.

Public Knowledge.

Meaning of public knowledge.

Per Jessel, M.R.

every individual member of the public knows it. That would be absurd. What is meant is, that if it is a manufacture connected with a particular trade the people in the trade shall know something about it; if it is a thing connected with a chemical invention people conversant with chemistry shall know something about it. And it need not go so far as that. You need not show that the bulk or even a large number of those people know it. If a sufficient number know it or if the communication is such that a sufficient number may be presumed or assumed to know it, that will do. Now, how are they to know it? They are to know it by being told of it, or informed of it in some way. You may show that they know it by showing that the trade had commonly used it. That is the best evidence you can have. You may show the thing was known because it was used and brought into practice, which is a case I have not now to consider. But you may show that they knew it in another way—that it was published or made known to the public. I use the word 'published' in that sense. How made known to the public? It has been held that if it is in a specification, certainly in a modern specification, which has been enrolled in the Patent Office, and not published besides, that will do. And it has also been held that, as a common rule, if the description has been printed in *England*, and published in *England*, in a book which circulates in *England*, that will do. But, after all, it is a question of fact. The Judge must decide, from the evidence brought before him, whether it has, in fact, been sufficiently published to come within the definition of being made known within the realm."

Test of novelty.

It has been shown (*y*) that an invention may be perfectly good subject-matter for a patent, though some or all of the parts of which it consists may be old, if the entire combination is a new manufacture. The proper test as to the novelty of the invention is whether the subject-matter claimed *as a whole is new*, though it may consist of old parts, provided the patentee does not claim them, but only the combination of the old with the new. (*z*)

Per Lord Hatherley, L.C.

Lord *Hatherley*, L.C., in *Cannington* v. *Nuttall*, (*a*) stated the test of novelty in the following words:

"Few things come to be known now in the shape of new principles, but the object of an invention generally is the applying of well-known principles to the achievement of a

(*y*) p. 62 *ante*.

(*z*) Newton *v.* The Grand Junction Railway Co., (1846) 5 Exch. 331; 20 L. J.Ex. 427 n.; Cannington *v.* Nuttall, (1871) L. R. 5 H. L. 205; 40 L. J. Ch. 739.

(*a*) (1871) L. R. 5 H. L. 216.

particular result not yet obtained, and I take it that the test of novelty is this: Is the product which is the result of an apparatus for which the inventor claims letters patent effectively obtained by means of your new apparatus, whereas it had never before been effectively obtained by any of the separate portions of the apparatus which you have combined into one valuable whole for the purpose of effecting the object you have in view?"

Public Knowledge.

Test of novelty.

Lord *Westbury*, L.C., in *Hill* v. *Evans*,(*b*) referring to the principle upon which prior publication will vitiate a subsequent patent for an invention, said:—

Per Lord Westbury, L.C.

> "The invention must be shown to have been before made known. Whatever, therefore, is essential to the invention must be read out of the prior publication. If specific details are necessary for the practical working and real utility of the alleged invention, they must be found substantially in the prior publication. Apparent generality, or a proposition not true to its full extent, will not prejudice a subsequent statement which is limited, accurate, and gives a specific rule of practical application. The reason is manifest, because much further information, and therefore much further discovery, are required before the real truth can be extricated and embodied in a form to serve the uses of mankind. It is the difference between the ore and the refined and pure metal which is extracted from it. . . . . Upon principle, therefore, I conclude that the prior knowledge of an invention to avoid a patent must be a knowledge equal to that required to be given by a patent—viz., such a knowledge as will enable the public to perceive the very discovery and to carry the invention into practical use."

The mere statement of the desirability of achieving an unattained result does not invalidate a patent for an invention which actually achieves that result. (*c*)

Statement that a result is desirable is no anticipation.

Also an alleged anticipation which is merely a scientific curiosity of no practical value for the purpose for which the patentee proves his invention to be practically valuable will not destroy the subsequent patent, *e.g.*, the unguent *œsypus* described by *Dioscorides* was no publication of Lanolin, which formed the subject-matter of a valid and valuable patent.(*d*)

Mere scientific curiosity is no anticipation.

A combination which is, in fact, capable of yielding a result

(*b*) (1862) 31 L. J. Ch. 457.
(*c*) Thomson *v.* Batty,(1889)6 R.P.C. 84.
(*d*) Benno Jaffé und Darmstaedter Lanolin Fabrik *v.* Richardson, (1893) 11 R. P. C. 93, 261; see also Young *v.* Fernie, (1863) 4 Griff. 577, 611.

Want of Novelty in Part.

Combination capable of yielding unobserved result does not anticipate invention which utilises it.

which has never been observed and appreciated by any person using the combination is not a publication which will vitiate the patent of a man who perceives the result, points it out and utilises it. (*e*) Thus, *Hopkinson's* patent for the three-wire system for the economic distribution of electricity was not anticipated by a previous and similar arrangement of three wires, which had only been used for the purpose of working lamps in "wings," as was evident from the fact that the return cable was of thick section. This did not anticipate the patentee's discovery that the three-wire system could be used to effect a great saving, by making the centre and return cable of thin cross section, and using it according to the patentee's plan shown in the specification. (*f*) Again, when the invention of the patentee is a combination which is designed for a particular class of purposes, and is the first combination actually applied with success to carry out such purposes, then prior similar combinations, not identically the same, are not considered publications of the combination which actually does accomplish the patentee's object. The Courts consider that in such a case invention was requisite to make the necessary alterations from the old combinations to enable them to be applied to the object the patentee had in view. (*g*)

A patent for an apparatus, which is suitable for a particular and novel purpose—*e.g.*, disinfecting by steam at high pressure—for which no previous apparatus is suited, and is also stated in the specification to be suited for a purpose for which a previous and very similar apparatus is suited, is not vitiated by that previous apparatus if the claim is confined to the use of the new apparatus for the new purpose. (*h*)

Want of Novelty in Part.

Consideration is entire.

The consideration upon the strength of which a patent is granted is in law said to be "entire," that is, a failure of part of the consideration will have the same effect on the validity of the patent as the failure of the whole consideration would have. Hence it follows that, if the patent includes more than one head of invention, the want of novelty in any one of those heads will invalidate the whole on the ground of failure of part

(*e*) Hopkinson *v.* St. James's and Pall Mall Electric Light Co., (1893) 10 R. P. C. 46. 60.

(*f*) *Ibid.*

(*g*) See Chadburn *v.* Mechan, (1895) 12 R. P. C. 120. 134.

(*h*) Lyon *v.* Goddard, (1893) 10 R. P. C. 121, 334; 11 R. P. C. 354, at p. 362.

of the consideration.(*i*) And that, if, in the case of a single invention, any material part turns out to be old the patent will be rendered entirely void.(*k*)

Want of Novelty in Part.

In either of the above cases the patent would also be void on the ground of false suggestion, for before the grant was made the patentee in his application must have declared himself to be in possession of an invention of which he, or, in the case of a joint application, one of the applicants, was the true and first inventor, and which was not in use by any other person or persons.(*l*) Moreover, the patent contains an express condition avoiding it in the event of the representation as to true and first inventor, and prior use, turning out to be untrue.(*m*) Although the Statute of Monopolies invalidates a patent in the event of there being no novelty in the invention, and consequently the patent would be void so far as related to that which was old, yet the principle on which the patent has been held to be void altogether in the event of a material part turning out to be old is that "the consideration for the grant is the novelty of all, and, the consideration failing, or, in other words, the Crown having been deceived in its grant, the patent is void, and no action maintainable upon it."(*n*)

Consideration is entire.

For example, in *Brunton* v. *Hawkes* (*o*) the patent was for an invention of improvements in the manufacture of ships' anchors, windlasses, and chain cables. At the trial it was proved that the mode of manufacturing anchors described in the plaintiff's specification had never been applied before to ships' anchors. But it had been applied to the adze anchor and the mushroom anchor. These anchors are used only for the purpose of mooring floating lights or vessels intended to be stationary; and are never taken on board. The jury found a verdict for the plaintiff, and the defendant obtained a rule *nisi* for a new trial, which the Court made *absolute*. In delivering judgment, *Abbott*, C.J., said:—

(*i*) Turner *v.* Winter, (1787) 1 W. P. C. 77; 1 T. R. 602: Bloxam *v.* Elsee, (1825) 6 B. & C. 178; 1 Carp. 444; Morgan *v.* Seaward, (1837) 1 W. P. C. 196; Kay *v.* Marshall, (1837) 2 W. P. C. 71; Cropper *v.* Smith, (1884) 1 R. P. C. 87; 2 P. O. R. 61; Fairfax *v.* Lyons, (1891) 8 R. P. C. 401.

(*k*) Crossley *v.* Beverley, (1829) 1 W. P. C. 106; Hill *v.* Thompson (1817) 8 Taunt. 382; 2 B. Moore, 433; Morgan *v.* Seaward, (1837) 1 W. P. C. 192; Manton *v.* Parker, (1815) Dav. P. C. 327; 1 W. P. C. 192 n.; Bloxam *v.* Elsee, (1825) 6 B. & C. 169; 1 Carp. 444; Roberts *v.* Heywood, (1879) 27 W. R. 454; Gibson *v.* Brand, (1842) 1 W. P. C. 636; Hill *v.* Tombs, (1881) Engineer, 51, p. 274. Under the Act of 1883 patents do not usually comprise more than one invention. See pp. 214 and 296 *post*. (*l*) p. 292 *post*.

(*m*) See Form of letters patent in Appendix.

(*n*) Per Parke, B., in Morgan *v.* Seaward, (1837) 2 M. & W. 544; Mur. & H. 55; 1 Jur. 527; 1 W. P. C. 196.

(*o*) (1820) 4 B. & Ald. 541.

Want of Novelty in Part.

Consideration is entire.

Judgment of Abbott, C.J., in Brunton v. Hawkes.

"I think that so much of the plaintiff's invention as respects the anchor is not new, and that the whole patent is therefore void. The mode of joining the shank to the flukes of the anchor is to put the end of the shank, which is in the form of a solid cylinder, through the hollow and conical aperture, and it is then made to fill up the hollow and to unite itself with it. Now that is precisely the mode by which the shank of the mushroom anchor is united to the mushroom top, by which the shank of the adze anchor is united to its other parts. It is indeed the mode by which the different parts of the common hammer and the pickaxe also are united together. Now a patent for a machine each part of which was in use before, but in which the combination of the different parts is new, and a new result produced, is good, because there is a novelty in the combination. But here the case is perfectly different: formerly three pieces were united together; the plaintiff only unites two, and, *if the union of those two had been effected in a mode unknown before, as applied in any degree to similar purposes, I should have thought it a good ground for a patent;* but unfortunately the mode was well known and long practised. I think that a man cannot be entitled to a patent for uniting two things instead of three, *when that union is effected in a mode well known and long practised for a similar purpose.* It seems to me, therefore, that there is no novelty in that part of the patent as affects the anchor, and if the patent had been taken out for that alone I should have had no hesitation in declaring it bad. Then, if there be no novelty in that part of the patent, can the plaintiff sustain his patent for the other part as to the mooring chain? As at present advised, I am inclined to think that the combination of a link of this particular form with the stay of the form which he uses, although the form of the link might have been known before, is so far new and beneficial as to sustain a patent for that part of the invention, if the patent had been taken out for that alone. But inasmuch as one of the things is not new, the question arises whether any part can be sustained. It is quite clear that a patent granted by the Crown cannot extend beyond the consideration of the patent. The King could not, in consideration of a new invention in one article, grant a patent for that article and another. The question then is, whether, if the party applies for a patent, reciting that he has discovered improvements in three things, and obtains a patent for these three things, and in the result it turns out that there is no novelty in one of them, he can sustain his patent. It appears to me that the case of *Hill* v. *Thompson*, which underwent great consideration in the Common Pleas, is decisive upon that question. In that case the patent

was granted to the plaintiff for the invention of certain improvements in the smelting and working of iron; and the Court of Common Pleas appears to have considered that the improvement introduced by the plaintiff into what may properly be called the smelting of iron was the obtaining iron from that cinder and slag which before had been thrown away as refuse, and that may be considered as new. It appeared, however, that the plaintiff claimed further the merit of having discovered that the application of lime in certain stages of the process would cure a disease common to all iron, not merely to that which he was to produce, but to iron originally manufactured from the fresh ore. Now it turned out that that was not a discovery, for the application of lime to iron made from the cinder, originally used in making ore, was known and practised before. No two things can be more distinct in their nature than the obtaining of iron from a material from which it was impracticable to obtain it before, and the cure or prevention of a disease to which all iron was subjected. In that case, however, the Court of Common Pleas held that, admitting there was novelty in the one, yet as there was no novelty in the other, the patent was wholly void. The only difference between that case and this is, that here the plaintiff, instead of saying that he has made certain improvements, states the improvements; but still he claims the merit of having invented improvements in all the three, and that they are new; and the consideration of the patent is the improvement in the three articles, and not in one; for an improvement in only one of them would render the patent bad. The consideration is the entirety of the improvement of the three; and if it turns out there is no novelty in one of the improvements the consideration fails in the whole, and the patentee is not entitled to the benefit of that other part of his invention."

Want of Novelty in Part.

Consideration is entire.

Though want of novelty in an essential part of an invention (*p*) invalidates a patent, if a specification claims an old thing for use only in connection with, and as subsidiary to, something else which is new, want of novelty in the old thing forming the basis of the subsidiary claim does not invalidate the grant.(*q*)

Claim to an old thing is not fatal if subsidiary to something new.

Thus, in *Plimpton* v. *Spiller*,(*r*) a patentee claimed first a mode of applying rollers and runners to the footstand of skates so that they might be cramped or turned so as to cause the skate to run in a curved line by the canting or tilting of the footstand; and secondly, the mode of securing the runners and making them reversible, as described. The Court of Appeal

(*p*) p. 99 *ante*. (*q*) p. 232 *post*. (*r*) (1877) L. R. 6 Ch. D. 412.

Analogous Uses. Novelty and Discovery.

held that, assuming there was nothing novel in the mode of securing the runners to the footstand, yet the want of novelty in the second claim did not invalidate the patent, because the second claim was for a subsidiary invention to be used only in connection with the principal invention.

Analogous Uses.

Prior analogous use may or may not be publication.

A perfectly valid patent may be obtained for an invention which consists in a new application of a thing which was perfectly well known before. Of course the application which is the subject of the subsequent patent must be totally distinct and novel as compared with any application previously made, and it is always a question of evidence as to whether former applications are so analogous to the one claimed by the subsequent patentee as to amount virtually to the same and so render his patent bad as claiming that which is in fact not new.(*s*) The use of a thing for one purpose is not an anticipation of a patent which claims the use of the same thing for a totally different purpose.(*t*)

Novelty and Discovery.

Distinction between novelty and discovery.

There is a great distinction between novelty and discovery; for a thing may have been discovered before, and in that sense not be new, but if the previous discovery has never been made public, or substantially used, it will not be sufficient to upset the patent of a subsequent discoverer on the ground of want of novelty.(*u*)

This will appear from a contrast of *Dollond's Case* (*x*) with *Tennant's Case*,(*y*) and *R.* v. *Arkwright*.(*z*) In *Dollond's Case* the question was, "Who was the true inventor within the meaning of the statute? *Hall* had made the discovery in his closet, but had never made it public; and, on this ground, *Dollond's* patent was confirmed. In *Tennant's Case* the great utility of the invention, which related to bleaching, on the part of persons engaged in the trade was proved in evidence. On the other hand, a bleacher near Nottingham deposed that

(*s*) pp. 71–96 *ante*.

(*t*) *Ibid.*; Westley *v.* Tolly, (1894) 11 R. P. C. 602; Mathews *v.* Parmenter, (1896) 13 R. P. C. 511.

(*u*) Hill *v.* Thompson, (1818) per Dallas, J., Holt, N. P. C. 636; 2 Moore, 429; 8 B. Taunt. 382; 1 W. P. C. 244; see also p. 121 *post*.

(*x*) (1776) 1 W. P. C. 43.

(*y*) (1795) 1 W. P. C. 125 n.

(*z*) (1785) 1 W. P. C. 71.

he had used the same means of preparing bleaching liquor for six years previous to the date of the patent, but that he had kept his method a secret from all but his two partners and his two servants concerned in preparing it. In addition to this, different conversations were proved to have passed between *Tennant* and a chemist of Glasgow, before the patent, and in these conversations the chemist had suggested to *Tennant* the basis of the improvement in question. Under these circumstances, *Tennant* was deemed not to be the inventor, and a nonsuit was obtained. In the case of *Arkwright's* patent, with respect to a particular roller forming part of the machine, the evidence was that Arkwright had been told of it by one *Kay*; that, being satisfied of its value, he took *Kay* as a servant, kept him for two years, employed him to make models, and afterwards claimed it as his own invention, and made it the foundation of a patent. The same fact was proved as to a crank, which had been discovered by a person of the name of *Hargreave*, which also had been adopted by *Arkwright*. And although it had been made use of to some extent before by a few, a general ignorance with respect to it was proved by a great number of persons in the trade. *Buller*, J., was of opinion that, though it might be perfectly true—that is, the general ignorance as to these improvements—it signified nothing; the fact that the witnesses on the part of the defendant had not heard of those improvements was no contradiction of previous knowledge and previous use by others.

Anticipation and Publication. Equivalents.

Anticipation and Publication.

It must also be noticed that there is a great distinction between anticipation and publication. An invention has been anticipated when it has been previously made; and it has been published when it has been previously made and disclosed. In the case of *Dollond's* patent,(*a*) *Hall's* discovery was an anticipation of *Dollond's*, but not a publication of it, whereas in *Tennant's Case*, and *R.* v. *Arkwright*,(*b*) the subject of the patent, in each, had not only been anticipated, but had also been published before.

Distinction between anticipation and publication.

Equivalents.

If an invention differs only from a previous invention in that for one part in the former invention there is substituted an

Prior use of equivalents may or may not be publication.

(*a*) p. 102 *ante*. (*b*) p. 102 *ante*.

Rediscovery of a Lost Art.

equivalent, though somewhat different part in the latter, the mere substitution of the equivalent will not be sufficient to sustain a patent for the second invention, if the analogous parts were known at the date of the first patent to be equivalents ;(*c*) but any person may obtain a patent, valid as regards novelty, for the use of equivalents, which were not taken to be equivalents at the time the patent for the former discovery was granted.(*d*)

Rediscovery of a Lost Art.

Is the rediscovery of a lost art a patentable novelty?

It may be questioned whether if an invention had been formerly used and abandoned many years ago, and the whole thing had been lost sight of, such a state of facts would prevent, on the ground of want of novelty, a person who subsequently rediscovered the invention from obtaining a valid patent in respect of it.

There does not appear to be any judicial decision one way or the other on this point, which was noticed by Lord *Lyndhurst*, L.C., in *The Househill Co.* v. *Neilson*.(*e*) The House of Lords in that case purposely refrained from expressing an opinion on the question, which did not then call for decision. It would appear from an application of the principles in this chapter discussed, that if the invention has ever been the subject of a patent, or has been described in some written document, however long ago, which can be produced, the fact that the invention has been lost sight of, and not been used by the public for a long time, will not enable a later discoverer to obtain a patent for it, as he would clearly not be the true and first inventor.(*f*) A state of facts might, however, be supposed in which the case would be different. For instance,(*g*) an encaustic tile or a particular kind of stained glass might be perfectly well known to exist at the present day, but the mode of producing the tile, or the particular kind of glass, might be a long-lost art. In such a case, if an inventor newly discovers the art of producing the encaustic tile, or the particular kind of glass, there does not appear to be any rule of law depriving the Crown of the right to grant a patent securing to the inventor the monopoly of the art which he has newly discovered. For it must be observed that the

(*c*) Heath *v.* Unwin, (1854) 5 H. L. Cas. 505 ; 2 W. P. C. 279 ; see p. 64 *ante*.
(*d*) Heath *v.* Unwin, (1854) 5 H. L. Cas. 505, 538 ; The Badische Anilin und Soda Fabrik *v.* Levinstein, (1885) 2 R. P. C. 90 ; see p. 63 *ante*.
(*e*) (1843) 1 W. P. C. 717.
(*f*) See p. 5 *ante*.
(*g*) 1 W. P. C. 718 n.

fact of the existence of the result which the newly discovered art produces only proves conclusively that *an art* of producing that result must have been previously known, not that *the art* which the patentee has described was ever before practised. There may be many ways of arriving at a known result, and, as has been pointed out,(*h*) each one of those ways, provided they are all different, may be the subject of a patent.(*i*) If the existing result convey at once to an observer information as to the way in which it was obtained, and that way is an exercise of the art which the patentee has described, then the previous existence of the result would make the patent void, there being no consideration given to the public. In such circumstances the patentee would only have described an invention which the public was already possessed of, as shown by the existence of the result.

Prior User.

Publication by Prior User.

It is evident that a knowledge of an invention cannot possibly be communicated to the public until the invention has been completed either by the patentee or some one else before him, and it therefore follows that any experiment made prior to the date of the patent, which resulted in failure, or only a partial success, cannot, even though published, amount to a disclosure of a perfected discovery. A machine which is useless, and a failure, is not an anticipation of a similar machine effecting the object for which the useless machine was designed, though there may be a degree of similarity in the details of the two.(*k*)

Prior unsuccessful experiment or useless machine is no publication.

Thus, a machine designed by the patentee to be used for the novel process of disinfecting by steam at high pressure, was held not to be anticipated by a very similar machine which was structurally incapable of being used with steam at high pressure.(*l*)

A mere experiment, supposed by the person making it to

(*h*) p. 54 *ante*.

(*i*) See Morgan *v.* Windover, (1888) 5 R. P. C. 306.

(*k*) Cornish *v.* Keene, (1835) 1 W. P. C. 508; Household Co. *v.* Neilson, (1843) 1 W. P. C. 673; Murray *v.* Clayton, (1872) L. R. 7 Ch. 570; 15 Eq. 115; 1 W. R. 498; 42 L. J. Ch. 191; Tangue *v.* Stott, (1865) W. N. 1886, p. 63; Jones *v.* Pearce, (1832) 1 W. P. C. 124; Stead *v.* Williams, (1843) 2 W. P. C. 135; Barlow *v.* Bayliss, (1875) 1 Griff. P. C. 44; Shaw *v.* Jones, (1889) 6 R. P. C. 336; Cannington *v.* Nuttall, (1871) L. R. 5 H. L. 205, is often quoted in support of this proposition, but there the case was decided on the ground that the two machines were not the same.

(*l*) Lyon *v.* Goddard, (1893) 10 R. P. C. 121, 334; 11 R. P. C. 354.

Prior User.

be fruitless, and abandoned because it was not brought to a complete result, will not prevent a more successful investigator, who adds the last link of improvement towards bringing it to a state of perfection, from maintaining a patent for the invention;(*m*) nor does the publication of a method of achieving a particular result vitiate a patent for achieving that result by different means involving the exercise of invention.(*n*)

Law of anticipation by experiments stated by Tindal, C.J.

Tindal, C.J., in *Cornish* v. *Keene*,(*o*) stated the law of anticipation by experiments in the following words:—

> "A man may make experiments in his own closet for the purpose of improving any art or manufacture in public use; if he makes these experiments and never communicates them to the world, and lays them by as forgotten things, another person who has made the same experiments, or has gone a little further, or is satisfied with the experiments, may take out a patent, and protect himself in the privilege of the sole making of the article for fourteen years; and it will be no answer to him to say that another person before him made the same experiments and therefore that he was not the first discoverer of it, because there may be many discoverers starting at the same time, and many rivals that may be running on the same road at the same time, and the first which comes to the Crown and takes out a patent, it not being generally known to the public, is the man who has a right to clothe himself with the authority of the patent and enjoy its benefits."

And again, the same learned Judge directed a jury that a mere experiment, or a mere course of experiments, for the purpose of producing a result, which is not brought to its completion, but begins and ends in uncertain experiments, is not such an invention as should prevent another person, who is more succesful or pursues with greater industry the chain in the line that has been laid out for him by the preceding inventor, from availing himself of it, and having the benefit of it.(*p*)

(*m*) Galloway *v.* Bleaden, (1839) 1 W. P. C. 529; Jones *v.* Pearce, (1832) 1 W. P. C. 124; Tangue *v.* Stott, (1865) W. N. 1886, p. 68; Stead *v.* Williams, (1843) 2 W. P. C. 135; Hill *v.* London Gas Light Co., (1860) 5 H. & N. 312; Otto *v.* Linford, 46 L. T. N. S. 39.

(*n*) pp. 53–55; Hill *v.* London Gas Light Co., (1861) 5 H. & N. 312; Otto *v.* Linford, (1881) 46 L. T. N. S. 39; Hullett *v.* Hague, (1831) 1 Carp. R. 501; 2 B. & A. 370; Minter *v.* Mower, (1835) 1 W. P. C. 140.

(*o*) Cornish *v.* Keene, (1835) 1 W. P. C. 508; but see chap. vii.

(*p*) Galloway *v.* Bleaden, (1839) 1 W. P. C. 525; see also Bereton *v.* Richardson, (1884) 1 R. P. C. 165; Mcseley *v.* Victoria Rubber Co., (1887) 4 R. P. C. 211; Humpherson *v.* Syer, (1887) 4 R. P. C. 184, 188; Morgan *v.* Windover, (1887) 4 R. P. C. 417; 5 R. P. C. 295; 7 R. P. C. 131; Edison *v.* Swan, (1889) 6 R. P. C. 277; Winbey *v.* Manchester Tramways Co., (1889) 6 R. P. C. 359; 7 R. P. C. 30.

Prior User.

Publication by experiment or abandoned user is a question of fact.

An invention abandoned is presumed to have been a failure.

It is a question of fact in each case whether a prior user, which is relied on as a publication of the invention claimed by a subsequent patentee, was a complete publication or only an incomplete experimental user.(*q*)

An invention abandoned must be *primâ facie* presumed not to have been completed, but to have rested in experiment and trial; but if it was completed it does not signify whether it was completely abandoned, or whether it was continued to be used down to the very date of the patent, provided that it was published.(*r*)

Illustrative cases.

The following cases illustrate this point:—

Taylor's patent.

In *Taylor's patent*, (1896) 13 R. P. C. 482, it appeared that the patentee had made certain experimental trials of the patented article (a grate) in his own house, and also had used the complete article in the presence of visitors to whom it had been explained. The Court held that though part of the use relied on to invalidate the patent was merely experimental, yet there had also been public user before the date of the patent, and so made an order for its revocation.

Jones v. Pearce.

In *Jones* v. *Pearce*, (1832) 1 W. P. C. 122, the patent called in question was for "improvements in wheels for carriages," and the defendant proved at the trial that, prior to the date of the plaintiff's patent, wheels similar to those described in the specification had been made by a Mr. *Strutt*. *Patterson*, J., directed the jury that if they were of opinion that Mr. *Strutt's* invention was an experiment, that he found it did not answer, and ceased to use it altogether, and abandoned it as useless, and nobody else followed it up, and that the plaintiff's invention, which came afterwards, was his own invention, and remedied the defects of Mr. *Strutt's* wheel, then there was no reason for saying that the plaintiff's patent was not good.

Carpenter v. Smith.

In *Carpenter* v. *Smith*, (1841) 1 W. P. C. 534, Lord *Abinger*, C.B., expressed the same thing thus: "A man is entitled to a patent for a new invention, and if his invention is new and useful he shall not be prejudiced by any other man having invented that before and not made any use of it; because the mere speculations of ingenious men, which may be fruitful of a great variety of inventions, if they are not brought into actual use, ought not to stand in the way of other men equally ingenious who may afterwards make the same inventions and apply them."

(*q*) Mathews *v.* Parmenter, (1896) 13 R. P. C. 514; Williams *v.* Gowan, (1895) 12 R. P. C. 387; Hagginmacher *v.* Watson, (1897) 14 R. P. C. 349, 631; Dutton *v.* Brierley, (1897) 14 R. P. C. 685.

(*r*) The Household Co. *v.* Neilson, (1843) 1 W. P. C. 709, 713; Galloway *v.* Bleaden, (1839) 1 W. P. C. 525; Morgan *v.* Windover, (1888) 5 R. P. C. 295, 303.

Prior User.

Publication by experiment or abandoned user is a question of fact.

Illustrative cases.

Household Co. v. Neilson.

In *Household Co.* v. *Neilson*, (1843) 1 W. P. C. 673, the Lord Justice-Clerk *Hope* had directed the jury to the effect that a prior abandoned user of the invention was not fatal to the validity of the patent, and, on the finding of the jury, had entered a verdict for the plaintiff. The defendant company thereupon appealed to the House of Lords, and the House held that the direction of the learned Lord Justice-Clerk was bad in law, and that the patent was rendered void by the abandoned prior user proved. The judgment of Lord *Brougham* contains the following passage (1 W. P. C. 713):—

"Now, see how this mistake, with respect to the abandonment and continuance, arose. If an invention has not been completed, but if it all rests in experiment and trial, then it is a most material circumstance as a test whether any given act of a party other than the invention [*sic*, inventor] was trial or complete invention; it is a most salutary and important test to apply with a view to ascertain that, to see whether he abandoned or continued it. If he abandoned it, if he gave it up altogether, and for twenty or thirty years did nothing, it is a very strong presumption that it was only experimental—not an invention completed. But suppose it was complete, and suppose it is admitted not to have been a trial—suppose it is allowed to have been an invention executed, if I may so speak, not merely executory, or not merely in the progress of invention, but an invention completed—then it is one of the greatest errors that can be committed, in point of law, to say that, with respect to such an invention as that, it signifies one rush whether it was completely abandoned or whether it was continued to be used down to the very date of the patent. Provided it was invented and publicly used at the time, twenty or thirty years ago, in this case forty years ago, it is perfectly immaterial, not immaterial to the second question, the second condition—namely, whether it was used or not at the time of the granting of the patent—but totally immaterial to the other question, which is equally necessary to be ascertained in the inventor's favour, whether or not he was the first and true inventor—for he must be the first and true inventor, as well as the only person using it at the time, otherwise he is not entitled to the letters patent. Therein lies the error which has been committed by the learned Judge."

Walton *v.* Bateman.

In *Walton* v. *Bateman*, 1 W. P. C. 619,(*s*) the validity of *Walton's* patent for "improvements in cards for carding wool, cotton, silk, and other fibrous substances," was questioned, on the ground that the improvement consisting in using caoutchouc as a substitute for leather as an elastic bed in which to fix the

(*s*) See also Tangye *v.* Stott, W. N. 1866, p. 68; 14 W. R. 128, 386.

teeth, was not novel. It appeared in evidence that a certain material called "*Hancock's* patent leather," had been manufactured and sold prior to the date of the patent, and it was contended that this "*Hancock's* patent leather" was substantially the same thing as the elastic bed in which the teeth of the plaintiff's cards were fixed, and further, that *Hancock's* material had been supplied to certain manufacturers during a period of about a year and a half, several years before the date of the plaintiff's patent, and that it had been used in the construction of cards, but had not been so used since that time. *Cresswell*, J., said to the jury: "Supposing that the article did embody the principle of the plaintiff so as to present to persons using it the properties, qualities, and advantages in principle of that article which the plaintiff makes, the question for you will be whether that use is not to be considered rather in the nature of an experiment than of any public user of the article, so as to deprive the plaintiff of the fruit of his discovery in respect of this manufacture."

Prior User.

Publication by experiment or abandoned user is a question of fact. Illustrative cases.

And, in *Stead* v. *Williams*, (1843) 2 W. P. C. 135, the same learned Judge observed: "I take it that there is a great difference between the knowledge of an invention as a thing that would answer and was in use, and the knowledge of it as a new experiment that had been found to be a failure, and thrown aside. If a person has had a scheme in his head and has carried it out, but after a trial has thrown it aside, and the thing is forgotten and gone by, then another person re-introducing it may, within the meaning of the Act, be the inventor and the first user of it, so as to justify a patent."

In *Hills* v. *London Gas Light Co.*, (1860) 5 H. & N. 312, the finding of the jury that one *Croll* had by means of the method for which the plaintiff had subsequently obtained a patent, purified many thousand feet of gas, but that this user was by way of experiment only, saved *Hill's* patent from being upset on the ground of want of novelty. And the Court refused to grant a new trial, the judgment containing the following passage: "The word 'experiment,' in the cases referred to, has been used, not as the sole test upon a matter of this sort, but as indicating a class of practice, and for the purpose of showing that if there has been a user of an invention not of a substantial character, but in the character of an experiment, then, although the thing has been done before, it does not preclude a person from taking out a patent for it; so that although what *Croll* did may not have been strictly in the nature of an experiment, still the jury have so found it, and we cannot grant a new trial."(*t*)

Hills v. London Gas Light Co.

(*t*) See also Lewis v. Marling, (1829) 10 B. & C. 22; 4 Car. & P. 57: 1 W. P. C. 493.

Prior User.

Re Adamson's patent.

In *Re Adamson's Patent*, (1856) 6 De G. M. & G. 420; 25 L. J. Ch. 456, on the other hand, where a person invented certain machinery during the fulfilment of a contract for the building of a pier, and used that machinery for four months in a place to which the public had access, before applying for the patent, and, after the utility of the machinery in question had been determined and profit had been derived from the public user, made an application, he was held not to be entitled to a patent.

Experimental user, though pecuniarily profitable, is not necessarily publication.

An inventor may, in certain cases, derive pecuniary profit from an experimental user of his invention before applying for protection, without rendering his patent subsequently obtained deficient on the ground of want of novelty. Thus, in the case of *Newall's* patent for "improvements in apparatus employed in laying down submarine electric telegraph wires," experiments on dry land were necessarily not sufficient to prove the utility of the apparatus for the purpose for which it was designed, and *Newall* accordingly tested the practicability of the invention during the laying of a submarine cable under a Government contract. The Court held that this user, notwithstanding the fact that *Newall* had derived profit from it, was only experimental, and did not prevent him obtaining a valid patent for the invention.(*u*)

Prior user of the invention by the patentee himself.

Apart from experimental user it is to be observed that it is competent for a person himself before the date of a patent to use the invention, the subject of the grant, in either or both of two ways. First, he may use it openly in such a manner that the user will convey to the mind of any one seeing it a knowledge of what the invention consists, *e.g.*, if the alleged invention relate to the particular construction of a lock, any person who has before the date of the patent constructed a lock on the principles claimed by the patentee, and publicly used it in this country, will thereby have published the invention, and any subsequent patent for it could not be sustained.(*x*) Secondly, the inventor may so use his invention that the user will not enable any one seeing it to discover in what the invention really consists, *e.g.*, in the case of a chemical invention, a dye for instance, the dye might be produced and known, but the

(*u*) Newall *v.* Elliott. (1858) 4 C. B. N. S. 269; see also Morgan *v.* Seaward, (1837) 1 W. P. C. 194.

(*x*) Carpenter *v.* Smith. (1841) 1 W. P. C. 530, 534; see also Stead *v.* Williams, 2 W. P. C. 136: Heath *v.* Smith, (1854) 2 W. P. C. 278; Honiball *v.* Bloomer, (1854) 10 Exch. 588; Honiball's Patent, (1855) 2 W. P. C. 209; Young *v.* Fernie, (1863) 4 Griff. 577; Bereton *v.* Richardson, (1884) 1 R. P. C. 177.

existence of it would not demonstrate the method according to which it was prepared, and no person other than the manufacturer in possession of the secret would be able to produce it—in such a case it is submitted, for reasons which will appear hereafter,(*y*) that such a user would not prevent the manufacturer, though it might prevent another person who should discover the secret, from obtaining a patent valid on the ground of novelty for the invention.(*z*) Again, a prior user of an invention may be made in public or in secret. It is well settled law that, if the invention has been used publicly, a subsequent patent would, under section 6 of the Statute of Monopolies, be void,(*a*) whereas if the user has only been secret, the grant *may* be sustained,(*b*) and this whether the user has been by the inventor himself,(*c*) or by a manufacturer for the inventor under terms of secrecy to him,(*d*) or his workmen.(*e*) It may be open to question, however, as to whether if a patentee has made profit by a prior secret user of the invention, he has not thereby rendered his subsequent patent null and void.(*f*)

Prior User.

The public use of only one specimen of a patented article,(*g*) even if by only one person,(*h*) is quite sufficient to invalidate a subsequent patent.

Prior public use of one specimen sufficient to invalidate the patent.

Lord *Abinger*, explaining to a jury what in the patent law sense is meant by the "public use and exercise" of an invention which will render a subsequent patent void on the ground of want of novelty, used the following words:—

Meaning of "public use and exercise," per Lord Abinger.

> "I think that what is meant by 'public use and exercise' is this: a man is entitled to a patent for a new invention, and if his invention is new and useful, he shall not be prejudiced by any other man having invented that before, and not made any use of it; because the mere speculations of ingenious men, which may be fruitful of a great variety of inventions, if they are not

(*y*) pp. 120–123 *post*.

(*z*) See Hancock *v.* Somervell,(1851) 39 Newton, L. J., 158.

(*a*) Cornish *v.* Keen, (1835) 1 W. P. C. 508.

(*b*) Dollond's Case, (1776) 1 W. P. C. 43; but see p. 121 *post*.

(*c*) Smith *v.* Davidson, (1857) 19 C. B. 690; Bentley *v.* Flemming, (1844) 1 Car. & K. 587.

(*d*) Morgan *v.* Seaward, (1837) 1 W. P. C. 187; Useful Patents Co. *v.* Rylands, (1885) 2 R. P. C. 235: Humpherson *v.* Syer, (1887) 4 R. P. C. 407; Kurtz *v.* Spence, (1888) 5 R. P. C. 161.

(*e*) Betts *v.* Menzies, (1857) 1 E. & E. 1008.

(*f*) See pp. 120–122 *post*.

(*g*) Honiball *v.* Bloomer, (1854) 10 Exch. 538; Honiball's Patent, (1855) 2 W. P. C. 201, 209; Carpenter *v.* Smith, (1841) 1 W. P. C. 530, 534; Young *v.* Fernie, (1863) Griff. P. C. 577; Berton *v.* Richardson, (1884) 1 R. P. C. 177.

(*h*) Stead *v.* Williams, (1843) 2 W. P. C. 136; Heath *v.* Smith, (1854) 2 W. P. C. 278.

Prior User.

Meaning of "public use and exercise," per Lord Abinger.

brought into actual use, ought not to stand in the way of other men equally ingenious who may afterwards make the same inventions and apply them. A great many patents have been taken out, for example, upon suggestions made in a celebrated work by the Marquis of *Worcester*, and many patents have been derived from hints and speculations by that ingenious author. But yet, as he never acted upon them, as he never brought out any machines whatsoever, those patents are good. So that the meaning of these words, 'public use' is this: that a man shall not by his own private invention, which he keeps locked up in his own breast, or in his own desk, and never communicates it, take away the right which another man has to a patent for the same invention. Now, 'public use' means this: that the use of it shall not be secret, but public. . . . . If a man invents a thing for his own use, whether he sells it or not—if he invents a lock, and puts it on his own gate, and has used it for a dozen years, that is a public use of it. If it were otherwise, see what the consequences would be. If Mr. *Davies* has a lock which he directed to be made and put on his gate sixteen years ago at least; if that was not a public use which prevented a man from taking out a patent, any man might go and take a model of that lock, and get a patent for it. How can he be the inventor of it? Because, to obtain a patent, a man must be the inventor; and if it has been once in public use (that is, used in a public manner, not used by the public), yet if it has been used by half a dozen individuals or one in a public manner, any man having access to it, how can he be said to be the inventor if by merely gaining access to that he takes out a patent? . . . . A man cannot be said to be the inventor of that which has been exposed to public view, and to which he might have had access if he had thought fit. . . . . If you are of opinion (not that they were generally adopted by the public and used by the public, for that in my opinion is a perfect fallacy) that the use of them is public, and the exercise of the invention was public, and not kept secret so that the public might have no benefit from it, then I think that part of the issue you ought to find for the defendant." (*k*) The jury found for the defendant, and on a motion for a new trial, on the ground of misdirection, the Court of Exchequer approved of the statement of the law made by Lord *Abinger*, *Alderson*, B., adding these words: (*l*) "Public use means a use in public, so as to come to the knowledge of others than the inventor as contradistinguished from the use of it by himself in his chamber." (*m*)

Per Alderson, B.

(*k*) Carpenter *v.* Smith, (1841) 1 W. P. C. 530, 534, 535, 540.

(*l*) 1 W. P. C. 542.

(*m*) See Crossdale *v.* Fisher, (1884) 1 R. P. C. 21.

Prior User.

To rebut the claim of novelty, it is not necessary to show that the invention has been used by the public; it is quite sufficient to establish that it has been used in public as contra-distinguished from being used in secret,(*n*)—*e.g.*, to show that an article has been openly manufactured (*o*) or exhibited in a workshop,(*p*) where all the workmen knew the process of its manufacture, or that a model has been exhibited to persons interested in the subject-matter of the invention without any concealment, secrecy, or confidence,(*q*) or that the article has been used in a private house under such circumstances that visitors thereto could comprehend the invention.(*r*)

Use in public as distinguished from use by the public avoids a patent.

The following are illustrative cases:—

Illustrative cases.

Tennant's case.

In Tennant's Case, (1798) 1 W. P. C. 125, the patent was for a method of using certain calcareous earths instead of alkaline substances, by neutralising the oxygenated muriatic acid used in bleaching, &c. The great utility of the invention, and the general ignorance of bleachers with respect to such bleaching liquor before the date of the patent, were established in evidence. It was, however, proved that a bleacher had used the same means of preparing his bleaching liquor for five or six years prior to the date of the plaintiff's patent, and that he had kept his method a secret from all but his two partners and two servants concerned in preparing it; and a chemist deposed that having, in 1796, had frequent conversations with the plaintiff on the means of improving bleaching liquor, he had in one of them suggested that he would probably attain his end by keeping the lime water constantly agitated; that the plaintiff afterwards had found the method successful and embodied it in his claim. Lord *Ellenborough*, C.J., who tried the case, nonsuited the plaintiff, holding that the above evidence established a prior publication of the invention.

Losh *v.* Hague.

Losh v. *Hague*, (1838) 1 W. P. C. 202, was a case in which damages were sought for the infringement of *Losh's* patent for "certain improvements in the construction of wheels for carriages to be used on railways," and it was established, to the satisfaction of the jury, that wheels made on the same principle as those claimed by *Losh*, had been constructed before the date

(*n*) Carpenter *v.* Smith, (1841) 1 W. P. C. 530; Stead *v.* Williams, (1843) 2 W. P. C. 136; Stead *v.* Anderson, (1846) 2 W. P. C. 149; Hancock *v.* Somervell, 39 Newton, L. J. 158; Honiball *v.* Bloomer, (1854) 2 W. P. C. 199; Young *v.* Rosenthal, (1884) 1 R. P. C. 32.

(*o*) Croysdale *v.* Fisher, (1884) 1 R. P. C. 17; Lister *v.* Norton, (1886) 3 R. P. C. 199; Heath *v.* Smith, (1854) 3 E. & B. 256; Betts *v.* Neilson, (1868) L. R. 3 Ch. 436.

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

(*q*) Winby *v.* The Manchester, &c., Steam Tramways Co., (1891) 8 R. P. C. 61.

(*r*) Taylor's Patent, (1896) 13 R. P. C. 482; Stead *v.* Williams, (1843) 2 W. P. C. 136.

Prior User.

Use in public as distinguished from use by the public avoids a patent.

Illustrative cases.

of his patent, though they had not been previously used on railways. The invention was, under these circumstances, held not to be novel, Lord *Abinger*, C.B., pointing out to the jury that if the wheels had been made and sold to any one individual, it made no difference though the public did not want them, because there were no railways, and they were not adapted to any particular use to which at that time the public could apply them (1 W. P. C. 205).

Muntz v. Foster.

In *Muntz* v. *Foster*, (1844) 2 W. P. C. 96, it was proved that *Muntz* discovered, in a particular combination of metals made before, a hidden virtue or quality which had never before been noticed, and in consequence of this discovery he was enabled to apply the metal to a new and useful purpose, and thereby became entitled to a patent for the application, under the name of "an improved manufacture of metal plates for strengthening the bottoms of ships or other such vessels." *Tindal*, C.J., in summing up to the jury, used these words: "I look upon the invention to consist in this, that *Muntz* has by an experiment ascertained that a certain mixture of the alloy of zinc with copper will have the effect of producing a better sheathing by reason and by means of its oxidating just in sufficient quantities—that is, not too much, so as wear away and impair the sheathing and render the vessel unsafe, but enough at the same time to keep by its wearing the bottom of the vessel clean from those impurities which before attached to it. And if it was shown, as it possibly might be, that sheets had been made of metal before, in the same proportion which he had pointed out, and if this hidden virtue or quality had not been discovered or ascertained, and consequently the application never made, I cannot think the patent will fail on that ground. I look upon it that there is as much merit in discovering the hidden and concealed virtue of a compound alloy of metal as there would be in discovering an unknown quality which a natural earth or stone possessed. We know by the cases that have been determined that where such unknown qualities have, from the result of experiments, been applied to useful purposes of life, that such application has been considered as the ground, and proper ground, of a patent; and therefore when I come to that part of the case in which they seek to show this is not so, because these metal plates have been invented before—that is, persons have used them before—in my judgment it will not go far enough, unless they can show there has been some application of them before to this very useful purpose. . . . . I do not think that the circumstance of showing that the combination of these two materials in a metal plate will of itself destroy this patent, when no attention at the time was paid to the purpose

for which this patent was taken out, and it was made merely in the ordinary course of melters of metal for the various and ordinary purposes of life. I do not think that the circumstances of showing that in the long time that has passed before us in the different, and, I may say, infinitely varying, combinations that must have been made for the various purposes for which brass and other metal was manufactured for ordinary and common purposes of life—to call a workman to show that on some occasion or occasions he had combined them in those proportions for another and different purpose; it does not appear to me that such destroys the patent."

Prior User.

Use in public as distinguished from use by the public avoids a patent.

Illustrative cases.

Muntz v. *Foster*, (1844) 2 W. P. C. 96, is to be distinguished from *Losh* v. *Hague*, (1838) 1 W. P. C. 203, in that in the former case the patent was for a result which had been arrived at casually before, but there was merit in discovering a hidden virtue in the result which made it applicable to a particular purpose and capable of sustaining a patent, whereas, in the latter case, the result was known before, but the application to the particular purpose (which was self-evident) was not made because the occasion had never arisen, and the patent was therefore held void.

Muntz v. Foster and Losh v. Hague distinguished.

In *Lewis* v. *Marling*, (1829) 10 B. & C. 22; 4 Cas. & P. 57; 1 W. P. C. 493, the patent related to a shearing machine in which the novelty consisted in shearing from list to list. It was proved at the trial that a similar machine had been made previously to the patent, which was tried by a person called on behalf of the defendant, but he did not think it answered, and soon discontinued the use of it. It was also proved that a model had been sent over from America and shown to a few persons, but no machine was made from it, and also that a specification had been brought over from America and two persons employed to make a machine from this, which, however, was never completed, so that, before the patentee's, no machine was publicly known or used in this country for shearing from list to list. Lord *Tenterden*, C.J., directed the jury that if it could be shown that the patentees had seen the model or specification, that might answer the claim of invention, but there was no evidence of that kind, and he left it to the jury to say whether the machine had been in public use and operation before the patent was granted, and they found that it had not.

Lewis v. Marling.

On a motion for a rule *nisi* for a new trial this direction of Lord *Tenterden*, C.J., was approved of, *Bayley*, J., saying: "If I make a discovery and am enabled to produce an effect from my own experiments, judgment, and skill, it is no objection that some one else had made a similar discovery by his

Prior User.

mind, unless it has become public. So if I introduce a discovery *bonâ fide* made, I may have a patent for it, though a person might have received previously a communication from abroad which would have enabled him to have made the machine."

Heath v. Smith.

In *Heath* v. *Smith*, (1854) 2 W. P. C. 268, it was proved that the process included in the plaintiff's claim had been practised by five manufacturers in the course of their trade before the date of the patent, and that whilst two of these manufacturers had kept the process a secret and the other three had practised it openly, it was not generally known till the plaintiff stated it in his specification. The Court of Queen's Bench held that there had been a public use of the process and that the patent was consequently invalid.

Abandoned prior user avoids a patent.

It is not necessary to show that the prior use relied on was continued up to the date of the patent, for if there be a complete anticipation, by prior use, the abandonment of it is nothing, yet when it is a question whether there really was a machine perfected in accordance with the alleged invention, the fact that it had never been used for a number of years before the patentee took out his patent is most material, as leading to the conclusion that that which was made many years ago was not a machine in accordance with the invention.(*s*)

Applicant for a patent provisionally protected against public use of the invention.

An inventor who, before applying for a patent, uses his invention in such a manner as to convey to the public a knowledge of it, or allows it to be used by the public, will thereby render his patent just as invalid on the ground of want of novelty as if a prior public use and exercise by persons other than himself were shown to have existed.(*t*) But after the inventor has sent in his application for a patent, and the same has been accepted, and before the patent is sealed, he is justified in using the invention in public, and will not by such use render the grant void, but he is not entitled to use, in connection with the apparatus manufactured according to the invention, the word "patent" until he has obtained the seal of the Patent Office.(*u*)

Fiduciary communications of invention prior to application.

An inventor may, before making application for a patent, entrust his invention to another person, bound to him by terms of confidence and secrecy, for the purpose of making experi-

(*s*) Per Lord Brougham, The Household Co. *v.* Neilson, (1843) 1 W. P. C. 673; Tangue *v.* Stott, (1865) W. N. 1866, p. 68; Morgan *v.* Windover, (1888) 5 R. P. C. 303; King, Brown & Co. *v.* Anglo-American Brush Co., (1889) 6 R. P. C. 414; pp. 105–110 *ante*.

(*t*) p. 110 *ante*.

(*u*) 46 & 47 Vict. c. 57, ss. 14, 15; Row on the prosecution of Crow *v.* Wallis, (1886) 3 R. P. C. 1; R. *v.* Crampton, (1886) 3 R. P. C. 367.

ments, with a view to rendering the invention more perfect and efficient, and such an experimental user, though to a certain extent a user in public, will not necessarily invalidate a subsequent patent.(*x*) Prior User.

The combined effect of Art. 4 of the International Convention of 1883 (*y*) and s. 103 of the Act of 1883, is to protect any person who has duly registered an application for a patent in any of the States of the Union, during a period of seven months from the date of such application, against the ordinary consequences of publication of the invention in this country. Such a person has a right of priority to a British patent at any time before the expiration of such period of seven months from the date of his application in the foreign State, notwithstanding that in the meanwhile the invention may have been published in this country. Foreign applicant protected against publication.

It is submitted that the period of seven months, during which protection from publication is afforded to the inventor, dates from the first application in one of the States of the Union, and not from the last of several applications in different States.

If an inventor desires to exhibit at an industrial or international exhibition an invention for which he has not applied, but intends to apply, for protection by letters patent, he can do so without thereby rendering his subsequent patent, if obtained, null and void, by proceeding under s. 39 of the Patents, &c., Act 1883, and Rule 15 of the Patent Rules 1890. The section of the Act referred to enacts that the exhibition of an invention at an industrial or international exhibition, certified as such by the Board of Trade, or publication of any description of the invention during the period of the holding of the exhibition 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 : Exhibition of invention at industrial or international exhibitions prior to application for a patent.

(*a*) The exhibitor must, before exhibiting the invention, give

(*x*) Bentley *v.* Flemming, (1844) 1 Car. & K. 578 ; Morgan *v.* Seaward, (1837) 1 W. P. C. 193, 195 ; Humpherson *v.* Syer, (1887) 4 R. P. C. 414 : Useful Patents Co. *v.* Rylands, (1885) 2 R. P. C. 262. (*y*) See Appendix.

Prior User.

the Comptroller the prescribed notice of his intention to do so;

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

Rule 15 of the Patent Rules 1890,(*z*) provides that the inventor shall give to the Comptroller notice in writing of his intention to exhibit, publish, or use the invention, as the case may be, and 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.

Delay in applying for a patent is undesirable.

The fact of an inventor having kept his invention secret, after it has been brought to completion, does not, at any rate if there has been no profitable use of it,(*a*) deprive the Crown of its right to grant a patent on the application of such inventor,(*b*) but delay on the part of the applicant is extremely undesirable, because it is always possible that some one else may make an application first, and so get a prior right to a patent.(*c*)

Offering for sale is publication;

If an inventor manufacture and offer for sale an article made in accordance with his invention before the date of his patent, even though no sale actually take place, he will thereby, if the nature of the invention can be understood from an inspection of the article, publish his invention and deprive himself of any right to become a patentee in respect of it.(*d*)

The public sale of a single specimen of a patented article before the date of the patent is sufficient to render the grant null and void,(*e*) though the sale was for export,(*f*) or as an experiment to ascertain whether there would be a demand for the article.(*g*)

but not if the

But if the article does not on the face of it show the manner

(*z*) See Appendix.

(*a*) See p. 120 *post*.

(*b*) Bentley *v.* Fleming, (1844) 1 C. & R. 587; Bowman *v.* Taylor, (1834) 1 W. P. C. 293.

(*c*) Hancock *v.* Somervell, (1851) 39 Newton, L. J. 158.

(*d*) Oxley *v.* Holden, (1860) 8 C. B. N. S. 666; Wood *v.* Zimmer, (1815) 1 Holt, N. P. C. 57; 1 W. P. C. 44; Morgan *v.* Seaward, (1837) 1 W. P. C. 194; Mullins *v.* Hart, (1852) 3 Car. & K. 297; Lister *v.* Norton, (1886) 3 R. P. C. 192, 207; Lifeboat Co. *v.* Chambers, (1891) 8 R. P. C. 418.

(*e*) Horniball *v.* Bloomer, (1885) 2 R. P. C. 199; Germ Milling Co. *v.* Robinson, No. 2, (1886) 3 R. P. C. 399; Hollins *v.* Capper, (1888) 5 R. P. C. 289.

(*f*) Carpenter *v.* Smith, (1842) 1 W. P. C. 541.

(*g*) Lister *v.* Norton, (1886) 3 R. P. C. 207.

in which it was made, it may be doubted whether such a manufacture and offering for sale by the inventor himself would deprive him of his right to a subsequent patent for the process of manufacture,(*h*) and the bare fact of the article having been made before the patent was obtained would not alone render it bad.(*i*)

Prior User.

article sold or offered for sale does not show the manner of its manufacture.

Publication is always a question of fact. In one case the manufacturer of two pairs of paddle-wheels, under an injunction of secrecy, which were sold and shipped, boarded up, abroad, was held to be no publication.(*k*)

It has been held that when delay has arisen in the granting of a patent from causes over which the patentee had no control, the manufacture by him of articles made according to, and before the date of the patent, for sale after the seal of the Patent Office has been obtained, will not vitiate the patent.(*l*)

The loan of an article for the purpose of experiment, before the application for a patent in respect of it, may not amount to publication sufficient to avoid the patent when obtained.

Loan of an article for the purpose of experiment may be publication.

Thus, in *Bentley* v. *Fleming*,(*m*) it appeared that a machine manufactured according to the invention had, before the date of the patent, been lent by the patentee to a friend for the purpose of trial, and that the machine was fixed in a room in a mill to which workpeople had access. *Cresswell*, J., who tried the case, held that the machine having been merely lent for the purpose of testing it, the use of it did not under the circumstances amount to a publication of the invention.

In *Morgan* v. *Seaward*,(*n*) the Court of Exchequer thought that the manufacture of two pieces of machinery for a person connected in business with the patentee, under an injunction of secrecy and their user abroad, might not be such a publication as would vitiate a subsequent grant.

Manufacture by one person confidentially related to another.

When an article has been manufactured and openly sold in England, even though it be manufactured and sold expressly for exportation abroad, the article has been published, and a subsequent patent for it will consequently be bad for want of novelty; but this must not be taken to mean that if a man abroad employ an agent in England to see if he can get an article manufac-

(*h*) See p. 120 *post*; Hancock *v.* Somervell, (1851) 39 Newton, L. J. 158.

(*i*) Bramah *v.* Hardcastle, (1789) Holroyd, 81; Lewis *v.* Marling, (1829) 4 C. & P. 57; Moss *v.* Malings, (1886) 3 R. P. C. 378.

(*k*) Morgan *v.* Seaward, (1837) 1 W. P. C. 187.

(*l*) Betts *v.* Menzies, (1862) 4 Jur. N. S. 477.

(*m*) (1844) 1 C. & R. 587.

(*n*) (1837) 1 W. P. C. 195.

Prior User.

tured according to a particular model, not with a view of making it public at all, but with the object of taking out a patent for it himself, he is thereby disentitled to the invention afterwards, because he employs a workman to assist him in it; or that if he had failed entirely some other man might not make the invention in England.(*o*)

Prior user in colony no legal bar.

It has been held that the prior user of an invention in a colony forms no legal bar to the granting of a patent for the same invention in this country.(*p*)

Prior secret profitable user by the inventor.

We have now to consider the question whether the fact of an inventor having made pecuniary profit by a secret user of his invention before the date of a subsequent grant of letters patent will render the grant invalid.

The question has never been judicially decided, though Lord *Campbell*, C.J., is reported, in *Heath* v. *Smith*,(*q*) to have given expression to the following *obiter dictum*: "If one party only had used the process, and had brought out the article for profit, and kept the method entirely secret, I am not prepared to say that then the patent would have been valid." And in *The Germ Milling Company, Limited*, v. *Robinson*,(*r*) the plaintiff elected to be nonsuited, on his own evidence of prior user of the invention, the validity of which was in contest, and did not take up the position of such prior user being secret.

The above remarks of Lord *Campbell*, C.J., must, from the context, be assumed to refer to a user by a person other than the patentee, and so do not directly bear on the question now under consideration. It is submitted, from the first principles of the patent law, that there does not appear any reason why an inventor should not be capable of receiving a grant of letters patent from the Crown at any time before he has disclosed his invention to the public and enabled them to practise it for themselves. The bargain between the patentee and the Crown(*s*) is, that the former discloses his invention and the manner in which it is to be performed, in exchange for a patent for a limited period from the latter, and it is evident that the patentee is capable of carrying out his part of the bargain, whether or not he has derived profit from what has hitherto been a secret use of the invention.

The argument(*t*) that the patentee, by keeping the invention secret and making profit by its use before applying for a patent,

(*o*) Per Lord Abinger, C.B., in Carpenter *v.* Smith, (1841) 1 W. P. C. 536.
(*p*) Rolls *v.* Isaacs, (1878) L. R. 19 Ch. D. 268.
(*q*) (1854) 2 W. P. C. 278.
(*r*) (1886) 3 R. P. C. 254.
(*s*) p. 93 *ante*.
(*t*) Morgan *v.* Seaward, (1837) 194.

would thereby obtain a monopoly longer than fourteen years, or the usual duration of the grant, is not at all conclusive; for it must be remembered that the Crown offers patent grants as rewards for the disclosure of useful inventions and the means of performing them, for the public good, and it does not go into the past history of the inventor and insist on his having made the discovery within any fixed time prior to his application, but merely requires that it shall be a new manufacture which others shall not use.(*u*) Prior User.

Moreover, the bare fact of an article having been made before a patent for its manufacture is obtained does not alone render the grant void,(*x*) and it would be absurd to hold that profit would render public that which otherwise would have been a secret use, though of course the fact of profit having been derived would no doubt influence the Court against the contention of secrecy.

There is a considerable difference between a prior secret user of the invention, which is subsequently patented, by a person other than the patentee and by the patentee himself. If it be established that a person or persons other than the patentee were in the habit of using the invention, though secretly, for the purposes of trade before the date of the grant, such prior secret user renders the patent void on the ground that the invention does not fulfil the requirements of the sixth section of the Statute of Monopolies,(*y*) as being one "which others at the time of making such letters-patent and grants shall not use." Thus in *Tennant's Case*(*z*) a secret user by persons other than the patentee was held to vitiate the grant. And in the more recent case of *Cheetham* v. *Oldham*(*a*) the prior sale of hats in appearance the same as those treated by the patentee's process, but from which it could not be conclusively inferred that the patentee's process had been used, together with the statements of the defendant's witnesses to the effect that such process had been used in their manufacture, was held to invalidate the patent.(*b*) For some time after the date of the Statute of Monopolies—*i.e.*, until the reign of Queen Anne—*publication* of the invention was not made a condition of the grant of the patent.(*c*) And patents were Distinction between prior secret user by the inventor and by others.

(*u*) 21 Jac. I. c. 3, s. 6.
(*x*) Bramah *v.* Hardcastle, (1789) Holroyd, 81; 1 Carp. P. C. 168; 1 W. P. C. 44 n.
(*y*) p. 3 *ante*.
(*z*) (1798) 1 W. P. C. 125.
(*a*) (1890) 7 R. P. C. 124.
(*b*) See also Hill *v.* Thompson, (1818) 1 W. P. C. 240; Cornish *v.* Keene, (1835) 1 W. P. C. 511.
(*c*) The Small Patents, (1606) 1 W. P. C. 9; Bailey *v.* Roberton, (1878) L. R. 3 App. Cas. 1074.

Prior User.

sometimes granted for the introduction of a *secret* trade or mystery,(*d*) but it may be doubted whether such patents were really valid, for, if there was no publication, the public obtained no benefit in return for the grant.(*e*)

Importation of an article made abroad.

A question closely connected with the above is, will the publication in this country of an article made *abroad* be a publication of the *invention* by the exercise of which the article was made? If the article made abroad shows on the face of it how it was made, its sale in this country is a publication of the invention; (*f*) but there is authority for saying that such will not be the case if the article does not show on the face of it how it was made. In *Hancock* v. *Somervell*(*g*) it was sought to upset *Hancock's* patent for improvements in the preparation of caoutchouc consisting in combining sulphur with it, and thus rendering it elastic at all temperatures. The evidence established the fact that shoes had been imported from America made of caoutchouc which on analysis was found to contain sulphur as well as oxide of lead and other ingredients. Prior to the plaintiff's patent samples of caoutchouc prepared by sulphur were sent to England by one *Goodyear* of New York, and were shown to *Hancock*, but the secret of their manufacture was not communicated to him. It was attempted to negotiate a sale of the invention to *Hancock*, but this was never completed. *Goodyear's* agent left the samples with *Hancock* under the impression that it would not be possible for him to discover the secret of their manufacture. As the result of experiments, *Hancock*, however, discovered that sulphur made caoutchouc elastic at all temperatures, and he then obtained his patent for his method of manufacturing it. *Williams*, J., directed the jury to say whether, supposing the shoes to have been manufactured in England, they could have been made without injuring the plaintiff's patent, and made use of the following words: "The defendants do not deny that *Hancock* is to be considered the inventor, notwithstanding *Goodyear* had previously made the discovery, provided the invention had not been published or in use in this country before the date of the patent. The defence consists of this: not only had *Goodyear* discovered the invention first, but also that the invention had been substantially published and was in use—not in secret use, but in public use—before the date of

(*d*) Mansell's Patent, (1624) 1 W. P. C. 19.

(*e*) See p. 93 *ante*.

(*f*) Jensen *v.* Smith, (1885) 2 R. P. C. 249.

(*g*) (1851) 39 Newton, L. J. 158.

the patent; that the material being in public use, the ready means of performing the invention were also necessarily before the public; because it is said the article presented in itself such means of knowledge to the public as to enable any one of ordinary competence to reproduce the article. If you should be of opinion that the material was in use before the date of the patent, then the question resolves itself into this: What is your opinion as to whether the publication of the material was substantially a publication of the invention? If you should find that the material was in public use, but that notwithstanding the invention remained still a matter to be discovered, in my opinion the plaintiff's case would not be affected by the circumstance of the material being in public use. If, on the other hand, you should think not only that the material was in public use (and I should here say that I do not think it is necessary that the use should be actual sale—if it were in public use it need not be sold; it would be sufficient, for instance, if it were in use, handing about the country for the purpose of attracting customers): if you should think, also, that the material being so in use it was so palpable how you could make it when you got the material, that substantially the disclosure of the material was a disclosure of the means of making it; if you do not think that, then I think the plaintiff's case is unaffected by the circumstance of the material being before the public in the way I have been describing." The jury found a verdict for the plaintiff, and his patent was accordingly upheld.

Personal Communications.

In the recent case of *Sunlight Incandescent Gas Lamp Co.* v. *Incandescent Gas Light Co.*,(*h*) *Wills*, J., held that *Rawson's* patent for stiffening incandescent gas mantles was not anticipated by the prior importation into this country of *Clamond's* magnesium baskets, stiffened by substantially the same process, because an inspection of the baskets did not disclose the process according to which they were stiffened.

Publication by Personal Communications.

When a patentee has communicated his invention to others before applying for a patent, it is always a question of evidence whether the communications were of a fiduciary nature, and whether the persons to whom they were made have kept faith

Prior communications made by the patentee personally.

(*h*) (1897) 14 R. P. C. 757.

Prior Documents.

Prior communications made by the patentee personally.

with the patentee, or whether the communications were made to individuals as members of the public, or such individuals have broken faith with the patentee by publishing the invention to the world at large. In one case(*i*) it was proved that the patentee had, before application for a patent, confidentially communicated the invention to nine separate people, but the Court of First Instance and the Court of Appeal held on the facts there was no publication which vitiated the patent. In another case it appeared that the patentee entrusted his invention—a pince-nez—to an optician in Paris, whose employee showed it to a third party, who wrote a description of it in a French scientific publication, three or four copies of which came over to this country and were in public libraries before the date of the patent. The House of Lords held that under these circumstances the patent was bad for want of novelty.(*k*)

Publication by Documents.

Books and documents as means of publication.

Besides the different ways heretofore indicated, a knowledge of an invention may be made the property of the public, so as to render a subsequent patent for it void on the ground of want of novelty, by a description of it being contained in a printed or written book or document or specification published in this country in such a manner that the public have access to such document or specification, and may, therefore, be presumed or assumed to have a knowledge of its contents.(*l*)

Foreign books.

It has been held that an invention is published if a description of it is contained in a foreign book which has been circulated in England,(*m*) in such a manner that some English people may be fairly supposed to know of it,(*n*) whether the foreign book be in a foreign language or English;(*o*) but it

(*i*) Gadd *v.* Mayor, &c., of Manchester, (1892) 9 R. P. C. 249, 516.

(*k*) Pickard *v.* Prescott, (1892) 9 R. P. C. 195; A. C., (1892) 263; see also Blank *v.* Tortman, (1888) 5 R. P. C. 653, 656.

(*l*) Rex *v.* Arkwright, (1785) 1 W. P. C. 72; Huddart *v.* Grimshaw, (1803) 1 W. P. C. 86; Jones *v.* Berger, (1843) 1 W. P. C. 550; Cornish *v.* Keene, (1835) 1 W. P. C. 507; Heurteloup's Patent, (1836) 1 W. P. C. 553; Dobbs *v.* Penn, (1849) 3 Exch. Rep. 427; The Household Co. *v.* Neilson, (1843) 1 W. P. C. 673; Plimpton *v.* Malcolmson, (1876) L. R. 3 Ch. D. 531; Plimpton *v.* Spiller, (1877) L. R. 6 Ch. D. 412; Lawrence *v.* Perry, (1885) 2 R. P. C. 180; United Horseshoe and Nail Co. *v.* Stewart, (1885) 2 R. P. C. 122, 133; Harris *v.* Rothwell, (1887) L. R. 35 Ch. D. 429.

(*m*) Reg. *v.* Seine, 40 Newton, L. J. 71; The United Telephone Co. *v.* Harrison, (1882) L. R. 21 Ch. D. 720.

(*n*) Harris *v.* Rothwell, (1887) L. R. 35 Ch. D. 429; remarks of Cotton and Lindley, L.JJ.

(*o*) Lang *v.* Gisborne, (1862) 31 Beav. 133; United Telephone Co. *v.* Harrison, (1882) L. R. 21 Ch. D. 720; Otto *v.* Steele, (1884) L. R. 31 Ch. D. 241; Harris *v.* Rothwell, (1887) L. R. 35 Ch. D. 416.

Prior Documents.

would appear that if the foreign book is in a remote language with which very few English people would be acquainted, it might not amount to such a publication as would vitiate a subsequent patent.(*p*)

Publication in a foreign book, only four copies of which were sent over to this country and exposed for sale (only one copy of which was actually sold), has been held sufficient to vitiate a patent.(*q*)

Unnecessary to prove that the patentee ever saw the prior book or document relied on.

In order to invalidate a patent on the ground of prior publication in a book or document, it is not necessary to show that the patentee actually derived his knowledge of the invention from such prior book or document; it is quite sufficient to show that the prior book or document was open to public inspection before the date of the patent.(*r*)

Thus, where an American book was kept in a private room at the Patent Office, and not entered in the donation book or in the catalogue,(*s*) it was held that there was not sufficient publication to upset an English patent.(*t*) Again, the fact that a French book containing a description of an invention was mentioned in catalogues distributed in this country, was held, in the absence of any proof that a single copy of the French book had ever been brought to this country, to be no publication of the invention.(*u*) If, however, the foreign book or document is catalogued and in a library to which the public have access, it will amount to a publication of the invention, though only one person has seen it,(*x*) or it is the only copy accessible to the public.(*y*)

Publication by prior document is always a question of fact.

The question whether a particular document has really become part of the stock of public knowledge, or at any rate part of the knowledge of that portion of the public interested in the invention, is in every case a matter of evidence.(*z*) In the words of *Tindal*, C.J. :—

Per Tindal, C.J.

"The existence of a single copy of a work, though printed, brought from a depository where it has long been kept in a

(*p*) Harris *v.* Rothwell, (1887) L. R. 35 Ch. D. 426.

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

(*r*) Stead *v.* Williams, (1844) 2 W. P. C. 142.

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

(*t*) See Plimpton *v.* Spiller, (1877) L. R. 6 Ch. D. 412.

(*u*) Otto *v.* Steel, (1887) L. R. 31 Ch. D. 241.

(*x*) Harris *v.* Rothwell, (1887) L. R. 35 Ch. D. 426; 3 R. P. C. 383; 4 R. P. C. 225.

(*y*) United Telephone Co. *v.* Harrison, (1882) L. R. 21 Ch. D. 721, 731.

(*z*) The Househill Co. *v.* Neilson, (1843) 1 W. P. C. 673; Stead *v.* Williams, (1844) 2 W. P. C. 137; Stead *v.* Anderson, (1846) 2 W. P. C. 147; Plimpton *v.* Malcolmson, (1876) L. R. 3 Ch. D. 531.

Prior Documents.

state of obscurity, would afford a very different inference from the production of an encyclopædia or other work in general circulation. The question will be whether, on the whole evidence, there has been such a publication as to make the description a part of the public stock of information."(*a*)

Publication by prior document is always a question of fact.

It is idle to lay down any general canon of what will be the result of a given case. The effect, extent, and operation of the document by which the invention is supposed to be communicated to the public in this country, so as to anticipate the invention of the person who first takes out letters patent for the invention, vary infinitely, as the facts must vary. In a great variety of instances it may very well be that the mere fact of an invention being completely disclosed in a written paper and that written paper brought into this country would, notwithstanding those circumstances, not in the smallest degree amount to publication, and would not interfere with a patent afterwards taken out. In other cases the inference, which is simply a question of fact, may be irresistible that the invention was communicated in the strictest sense to the public in such a way as to prevent the operation of letters patent taken out after the date of that publication.(*b*)

In *Plimpton* v. *Malcolmson*,(*c*) the facts proved were that a copy of a book published in America containing a short description of the invention forming the subject of the patent in dispute was sent over to this country before the date of the patent, and placed in the library of the Patent Office, but it was not entered in the catalogue of the library, and was not placed on the shelves of the room to which the public had access, but in a private room; and it was also proved that the book did not come to light till ten years or more after the date of the patent. Under these circumstances, *Jessel*, M.R., held that there had not been such a publication of the invention as would deprive the man who first made it known in this country of that merit—the only merit so far as an importer is concerned—which consists in making known a useful invention to the public. This decision was in a subsequent case(*d*) upheld by the Court of Appeal.

(*a*) Stead *v.* Williams, (1844) 2 W. P. C. 143; see also Plimpton *v.* Malcolmson, (1876) L. R. 3 Ch. D. 531; Judgment of Jessel, M.R., at p. 561, and his explanation of the dictum of Romilly, M.R., in Lang *v.* Gisborne, (1862) 31 Beav. 133; see also Plimpton *v.* Spiller, (1877) L. R. 6 Ch. D. 412; Von Heyden *v.* Neustadt, (1880) 50 L. J. N. S. Ch. 126; United Telephone Co. *v.* Harrison, (1882) L. R. 21 Ch. D. 720.

(*b*) See observations of Halsbury, L.C., in Pickard *v.* Prescott, (1892) 9 R. P. C. 195.

(*c*) L. R., (1876) 3 Ch. D. 531.

(*d*) Plimpton *v.* Spiller, (1877) L. R. 6 Ch. D. 412.

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A document containing a description of an invention may under some circumstances, however, be public property from the moment it is written. For example, where a referee appointed by Act of Parliament to inspect the works of the London Gas Companies, whilst engaged in the prosecution of his duties discovered a process for purifying gas and obtained a patent for the invention, after the report of himself and his co-referees embodying the principle of the process had been drawn up, it was held by the House of Lords that the patent was void for lack of novelty, because the report conveying a knowledge of the invention had become public property from the time it was written.(*e*)

Document is sometimes public property the moment it is written.

It is not always possible to predict of two documents which make use of terms of art *ipsissimis verbis* the same, that they describe the same invention, if they were composed at different periods. For it must not be forgotten that terms of art are liable to constant changes of meaning during the progress and development of any particular department of science, and therefore, in considering whether a description in an earlier published book or document is really the same as that in a later specification, it must be carefully ascertained that the terms of art used in the two denote the same thing. In the words of Lord *Westbury*: "Even if there is identity of language in two specifications, and (remembering that those specifications describe external things) even if the language is *verbatim* the same, yet if there are terms of art found in the one specification, and also terms of art found in the other specification, it is impossible to predict of the two with certainty that they describe the same identical external object, unless you ascertain that the terms of art used in the one have precisely the same signification, and denote the same external objects at the date of the one specification as they do at the date of the other."(*f*)

Terms of art used in different documents may not have the same meaning.

A document which upon its true construction points away from the use of a certain thing, or the use of a certain thing in a particular manner, cannot be successfully pleaded as a publication of an invention which consists in the use of the thing, or in its use in a particular manner.(*g*)

Document which points away from the patentee's claim is no publication.

Provisional specifications which are filed in the Patent

Provisional specifications.

(*e*) Patterson *v.* Gas Light and Coke Co., (1856) L. R. 3 App. Cas. 239.

(*f*) Betts *v.* Menzies, (1862) 10 H. L. Cas. 152.

(*g*) See Nobel's Explosives Co. *v.* Anderson, (1895) 12 R. C. P. 164; Morris *v.* Young, (1895) 12 R. P. C. 461; Monnet *v.* Beck, (1897) 14 R. P. C. 777; Badische Anilin und Soda Fabrik *v.* La Société Chimique des Usines du Rhône, (1897) 14 R. P. C. 875.

Prior Documents.

Office and subsequently abandoned by the applicant, are under the present practice never published. Consequently, an abandonment of a provisional specification will not amount to a publication of the invention, which may form the subject-matter of a subsequent patent.(*h*)

Provisional specifications.

Power of Court to order production of abandoned provisional specifications.

The Courts have power to order the production of an abandoned provisional specification if it is required in the interests of justice—*e.g.*, when in an action on a subsequent patent the defendant pleads invalidity by reason of his own prior user, and states that he has filed but abandoned a provisional specification for the thing which he alleges he used about the date of the abandoned provisional specification, and which he contends was an anticipation of the plaintiff's claim.(*i*)

Effect of publication of a prior abandoned provisional specification and a subsequent application within the period of provisional protection.

If, however, an abandoned provisional specification has been published, as was the former practice, a description of an invention contained in it will invalidate a subsequent patent, though it turns out that the prior patent, in respect of which the provisional specification was filed, is void.(*k*)

In *Lister* v. *Norton*,(*l*) the facts were these: the plaintiff, on 24th July 1880, filed a provisional specification of an invention for "improvements in the manufacture of pile fabrics in imitation of sealskin and other similar fabrics." This specification was abandoned by the plaintiff, and on the 21st January 1881 he filed a second provisional specification of an invention for "improvements in the manufacture of velvets and of pile fabrics in imitation of sealskin and other similar materials." On the 21st July 1881 he obtained a grant of letters patent on his provisional specification of 21st January 1881. The invention claimed consisted in a new combination of materials for use in the manufacture of the fabrics referred to—the employment of a mixture of mohair and silk in the raw state, combined and blended before spinning. It was held that, assuming the invention in the two provisional specifications to be identical, the abandonment of this first provisional specification did not avoid the patent which was granted, *i.e.*, dated, within the period of provisional protection secured by the first provisional specification, even if actual user during such period could be shown.(*m*)

(*h*) 48 & 49 Vict. c. 63, s. 4; Oxley *v.* Holden, (1860) 8 C. B. N. S. 666; Lister *v.* Norton, (1886) 3 R. P. C. 199.

(*i*) Pneumatic Tyre Co. *v.* English Cycle and Tyre Co., (1897) 14 R. P. C. 851.

(*k*) See Kaye *v.* Chubb, (1888) 5 R. P. C. 641, 648.

(*l*) (1886) 3 R. P. C. 199.

(*m*) See also Oxley *v.* Holden, (1860) 8 C. B. N. S. 666; 30 L. J. C. P. 68; Stoner *v.* Todd, (1876) L. R. 4 Ch. D. 58.

Prior Documents.

A prior description, which has become the property of the public, of a machine or combination, though that machine or combination has never been actually made and publicly used, will render a subsequent patent for that machine or combination bad both on the ground that the patentee is not the true and first inventor, and because the invention is not new.(*n*)

Not necessary to prove that a prior published invention has been actually used.

As has been shown, the subject of a patent is really the art of producing the new and useful result,(*o*) and it is not necessary to avoid a patent that the art should have actually been put in practice—*i.e.*, the machine, for instance, made by the exercise of it, need not have been constructed, provided that the public are, at the date of the patent, in possession of full and sufficient information to enable them to produce, without the exercise of further invention, the result claimed by the patentee.(*p*) The question whether a description has really become the property of the public so as to vitiate a subsequent patent is therefore always one of evidence, when that description has not been acted upon and no machine made has been in accordance with it.(*q*)

Lord *Blackburn*, in the House of Lords,(*r*) pointed out that in order to vitiate a patent on the ground of want of novelty it is not necessary that the invention should be used by the public as well as known to the public. If the invention and the mode in which it can be used have been made known to the public by a description in a work which has been publicly circulated (*s*) or a specification duly enrolled,(*t*) it avoids the patent, though there is no proof that the invention was ever actually put in use.

Mere suggestion is not publication.

If the document relied on as a publication contain *merely a suggestion* of the invention, it will be immaterial to the novelty of a subsequent patent, which will only be upset on the ground of prior publication, if the document contain a description which is such that the invention could be easily carried out from it.(*u*)

(*n*) Frearson *v.* Loe, (1878) L. R. 9 Ch. D. 62.

(*o*) p. 21 *ante*. (*p*) p. 95 *ante*.

(*q*) Humpherson *v.* Syer, (1887) 4 R. P. C. 407; Tickelpenny *v.* Army and Navy Co-operative Society, Ld., (1888) 5 R. P. C. 405.

(*r*) Patterson *v.* Gas Light and Coke Co., (1875) L. R. 3 App. Cas. 239.

(*s*) Stead *v.* Williams, (1844) 7 M. & G. 818, 842; 2 W. P. C. 141.

(*t*) Bush *v.* Fox, (1856) 5 H. L. C. 707; Betts *v.* Menzies, (1862) 10 H. L. C. 117.

(*u*) Woodcroft's Patent, (1846) 2 W. P. C. 23; Betts *v.* Menzies, (1862) 10 H. L. Cas. 117; Betts *v.* De Vitre, (1862) 11 L. T. N. S. 445; Von Heyden *v.* Neustadt, (1880) L. R. 14 Ch. D. 230; 50 L. J. N. S. Ch. 126; Stoner *v.* Todd, (1876) L. R. 4 Ch. D. 58; Moseley *v.* Victoria Rubber Co.,

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The law requires the inventor in the specification which he is compelled to lodge at the Patent Office (*x*) to describe his invention and the mode of performing it in language so accurate and explicit as will enable an ordinary and intelligent workman in the trade, to which the invention relates, to put it in practice. The question arises as to whether it is necessary that a document containing an alleged anticipation of a subsequently patented invention should be framed in language equally accurate and explicit as that which is required in the specification itself. In other words, will an alleged anticipating document, which is sufficiently accurate and explicit to enable a highly skilled person to perceive without effort and perform the invention, though it is not intelligible to a less skilled ordinary workman, amount to a prior disclosure of the discovery which will render a subsequent patent void on the ground of want of novelty?

In *Betts* v. *Menzies* (*y*) it was held that an antecedent description must disclose a practicable mode of producing the result of the subsequent discovery if the description is to be held sufficient to invalidate the subsequent patent. In this case *Dobbs'* specification was relied on as an anticipation of *Betts'*, but it was not contended that the former would enable any skilled person to perform the invention. It appeared that proportions and subsidiary processes not disclosed by *Dobbs* were necessary. *Dobbs'* was held not to be an anticipation of *Betts'*. The information given would clearly not enable *any one* without experiments to perform the invention, and the point of it being intelligible to a skilled person was not raised at the Bar.

As was remarked by Lord *Abinger*,(*z*) many patents have been taken out upon suggestions contained in a celebrated work by the Marquis of *Worcester*, and from hints and speculations from the same author, and his Lordship seemed of opinion that these patents would have been good as regards anticipation by the Marquis of *Worcester*. All the Marquis did in his writings was to make suggestions and speculations, not to describe perfected inventions in language which would disclose them, as such,

(1887) 4 R. P. C. 252; Bray *v.* Gardner, 4 P. O. R. 405; Haslam *v.* Hall, (1888) 5 R. P. C. 19; Ehrlich *v.* Ihlee, (1888) 5 R. P. C. 450; Thompson *v.* American Braided Wire Co., (1887) 4 R. P. C. 316: 5 R. P. C. 113; 6 R. P. C. 518: Winby *v.* Manchester, &c., Steam Tramways Co., (1889) 6 R. P. C. 359; Shaw *v.* Jones, (1889) 6 R. P. C. 336.

(*x*) 46 & 47 Vict. c. 57, s. 3; see chap. v.

(*y*) 10 H. L. Cas. 152.

(*z*) Carpenter *v.* Smith, (1841) 1 W. P. C. 530.

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to any one, however skilled he might be. This is a very different thing to a description of an invention in terms that would enable skilled persons, though not the ordinary workman, to perceive and carry it out.

Sufficiency of description necessary in an anticipating document.

The real point to be considered in determining whether a prior description is sufficiently explicit to vitiate a subsequent patent is: will the prior description enable any person, *without the exercise of invention*, to carry out the alleged new discovery? It may be that a given prior description will enable a highly skilled person to perform an invention for which a patent is subsequently taken out, whereas a less skilled ordinary workman in the trade would not be able to carry the invention into effect from the hints and suggestions contained in that prior description. If the highly skilled person has to exercise any ingenuity or invention to enable him to arrive at the result achieved by the patentee it is submitted that the prior description is not one which will vitiate a subsequent patent; otherwise it is.

Rule in Hill v. Evans.

Lord *Westbury*, L.C., in *Hills* v. *Evans*(*a*) first laid down authoritatively the rule on the subject of what must be the nature of an antecedent paper publication in order that it may be held sufficient to anticipate and to vitiate a subsequent patent on the ground of want of novelty. The rule in *Hills* v. *Evans* has been slightly modified and brought up to date by subsequent cases. The following extract from the judgment of *Lindley*, L.J., in *Savage* v. *Harris*,(*b*) contains a clear statement of what the law upon the subject now is:

Statement of the present law by Lindley, L.J.

> "I cannot do better than refer to the well-known judgment of Lord *Westbury* in the case of *Hills* v. *Evans*, which is to be found in 4 De Gex, Fisher, and Jones, at page 289. He says: 'I have therefore to consider and to give my opinion upon the question that has been argued, namely, whether there be or be not anything in these specifications which has rendered the plaintiff's invention matter of public knowledge, and therefore matter of public property, anterior to the granting of the patent. I was extremely desirous to ascertain, in the course of the argument, whether any clear rule has been laid down on the subject of what shall be the nature of the antecedent publication which shall be held sufficient to anticipate and to vitiate a subsequent patent on the ground of want of novelty.' After saying that a specification is not to be distinguished in principle from any other publication, he says: 'The question, then, is—

(*a*) 4 De Gex, Fisher and Jones, 289. (*b*) (1896) 13 R. P. C. 368.

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What must be the nature of the antecedent statement? I apprehend that the principle is correctly thus expressed.' I will show that that has been corrected more recently. 'The antecedent statement must be such that a person of ordinary knowledge of the subject would at once perceive, understand, and be able practically to apply the discovery without the necessity of making further experiments and gaining further information before the invention can be made useful. If something remains to be ascertained which is necessary for the useful application of the discovery, that affords sufficient room for another valid patent.' And after commenting on the statute of James, he goes on: 'The information as to the alleged invention given by the prior publication must for the purposes of practical utility be equal to that given by the subsequent patent. The invention must be shown to have been before made known. Whatever, therefore, is essential to the invention must be read out of the prior publication. If specific details are necessary for the practical working and real utility of the alleged invention, they must be found substantially in the prior publication.' With the exception to which I have called attention—I mean about the ordinary workman—that is the law. Mr. Justice *Grove* was the first to call attention to the fact that there might be prior anticipation by publication, although the specification was defective in the directions given to the workman. His judgment upon that point will be found in *Philpott* v. *Hanbury*, 2 R. P. C. 43, and it has been adopted. I do not know whether expressly or not, but the same criticism and the same observations will be found in the House of Lords cases for 1892, at page 378, in the case of the *Anglo-American Brush Electric Light Corporation* v. *King, Brown & Co.*, 9 R. P. C. 313. The question there was whether a specification of one *Varley* was an anticipation of the plaintiff's patent, and Lord *Watson* says this: 'I do not think it necessary to deal with the conflict of testimony as to the sufficiency of *Varley's* specification for the guidance of a skilled workman. The Lord Ordinary was of opinion that the appellants had failed to prove that part of their case. But I agree with his Lordship and with the learned Judges of the First Division in holding that the sufficiency or insufficiency of the specification for that purpose does not afford a crucial test of prior publication. Every patentee, as a condition of his exclusive privilege, is bound to describe his invention in such detail as to enable a workman of ordinary skill to practise it, and the penalty of non-compliance with that condition is forfeiture of his privilege. His patent right may be invalid by reason of non-compliance, but it certainly does not follow that his invention has not been published. His specification may,

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notwithstanding that defect, be sufficient to convey to a man of science and employers of labour information which will enable them, without any exercise of inventive ingenuity, to understand his invention and to give a workman the specific directions which he failed to communicate. In that case I cannot doubt that his invention is published as completely as if his description had been intelligible to a workman of ordinary skill.' With that correction of Lord *Westbury's* judgment, the judgment stands, and, applying it to this case, I confess I cannot see what on earth there is in the plaintiff's specification which is not to be found in *O'Connor's;* I do not say in actual words, but to anybody who reflects upon it and thinks about it and grasps it." (*c*)

Evidence of a skilled person, with knowledge of the patent, as to anticipations.

When, however, a skilled person with the knowledge of the patentee's specification produces a successful result and says he obtained it by following only the directions of an old and unused paper anticipation, the Courts look very carefully at such evidence before accepting it.(*d*)

Unless all essential features of the invention are disclosed by an anticipating document it will not be a publication.

In *Otto* v. *Linford* (*e*) a prior specification was relied on as a publication of the invention claimed by *Otto*. *Brett*, L.J., said that the question to be considered was whether the prior specification, fairly read by a person conversant with such matters, would give a reasonably clear description of the latter invention. In other words, supposing it to relate to a machine, would it give such a reasonably clear description of a machine that would accomplish what the machine of the later inventor effected.

In *Stoner* v. *Todd*,(*f*) it appeared that a certain provisional specification contained a partial description of a piece of mechanism which was not mentioned in the corresponding complete specification. A subsequent patent was taken out for the piece of mechanism, and this was held not to be invalidated by the incomplete description in the prior provisional specification.

In the words of Lord *Westbury*: "An antecedent specification ought not to be held to be an anticipation of a subsequent discovery, unless you have ascertained that the antecedent specification discloses a practicable mode of producing the result which is the effect of the subsequent discovery ;(*g*) and in the language

(*c*) See also Cassel Gold Extracting Co. *v.* Cyanide Gold Recovery Syndicate, (1895) 12 R. P. C. 256 ; Gadd *v.* Mayor of Manchester, (1892) 9 R. P. C. 532 ; Shrewsbury and Talbot Cab Co. *v.* Stereux, (1896) 13 R. P. C. 53 ; Edison *v.* Holland, (1887) 5 R. P. C. 459 ; 6 R. P. C. 243.

(*d*) Defries *v.* Sherwood, (1897) 14 R. P. C. 313.

(*e*) 46 L. T. N. S. 35.

(*f*) L. R. 4 Ch. D. 58.

(*g*) Betts *v.* Menzies, (1881) 10 H. L. Cas. 154 ; see also Woodcraft's Patent, (1846) 2 W. P. C. 23.

Prior Documents.

of Lord *Wensleydale*, 'the mere production of a notion that a particular article might be made, without any information or means of knowledge communicated to the public, does not prevent a subsequent first inventor of those means from taking out a patent.'"(*h*)

In order that a description in a prior document may invalidate, on the ground of want of novelty, a subsequent patent, it is necessary that *all* the essential features of the alleged invention should be disclosed by the prior document. Thus, a patented process for "improvements in the manufacture of grooved tyres for wheels" consisted in rolling a flat bar of iron so as to get it into a curved form with flanges set up upon each side, and then to roll so as to get the curved form into a flat base, but not so as to get merely rectangular flanges, but to roll (which necessitated rollers of a novel and peculiar kind) so as to get flanges at an acute angle to the flat base; or, if not at an acute angle, by rolling, to get flanges with bead-shaped heads whereby to produce an iron tyre with an undercut dovetailed section which would grip the india-rubber tyre and would have a flat base in order that it might accurately fit on to the felloe of the wooden wheel and that the india-rubber might lie perfectly flat upon it when extended round it. This was held not to be anticipated by a specification which did not disclose the attainment of the undercut dovetailed section, though it did disclose the attainment of the other essential features.(*i*)

Highly scientific inventions.

With reference to the publication of a highly scientific—*e.g.*, a chemical—invention it is to be remembered that there are two distinct forms of literature on the subject: the systematic scientific literature, and the technical literature; and the distinction is one very important to be borne in mind in dealing with such patents, since publications having reference to chemical science will be studied by scientific chemists, but speaking generally such publications are not sought after and studied by the practical working chemists.(*k*)

The existence of a chemical patent wherein the combined effect of two or more chemicals is claimed in order to bring about a desired result does not by any means necessarily constitute an anticipation of a subsequent discovery that by use of any one of the named chemicals the desired result can be

(*h*) Betts *v.* Menzies, (1362) 10 H. L. Cas. 157; see also Muntz *v.* Foster, (1844) 2 W. P. C. 105; Galloway *v.* Bladen, (1839) 1 W. P. C. 521; Thomson *v.* Batty, (1889) 6 R. P. C. 84.

(*i*) Shrewsbury and Talbot Cab Co. *v.* Sterckx, (1895) 12 R. P. C. 336; 13 R. P. C. 44.

(*k*) Anilin und Soda Fabrik *v.* Levinstein, (1885) L. R. 29 Ch. D. 384.

attained, and *a fortiori* when the compound of the two has failed to do so, for there are any number of cases known in chemistry where two things when put together act very differently from what they do apart.(*l*)

Prior Documents.

It does not at all follow that an unused paper anticipation which, if constructed, might be held to be an infringement of a subsequent patent, is an anticipation of the subsequent patent. A clumsy imitation of a patented machine or a patented article may be an infringement, although it is not such as would have been, if prior in date, an anticipation defeating an inventor's right to a patent.(*m*) Thus, in the recent case of *Welch's* patent for holding on bicycle tyres by inextensible wire rings, it was objected that this was anticipated by a prior specification of *Lata*. Two figures in *Welch's* specification, showing extreme cases of the application of his invention, approximated in appearance to a figure in *Lata's* specification. From *Lata's* specification, however, it was clear that he proposed to use the wires—of which he had three—for a different object to *Welch*—viz., to hold on the tyre by means of the pressure of the wires and rubber on the rim; and *Lata* further stated that if any one of his wires were cut the tyre would still be held on. This clearly showed that his object was different to *Welch's*, and as there was no evidence of user of *Lata's* invention the Court held that it did not anticipate *Welch*—though, no doubt, if after *Welch's* patent some one adopted *Lata's* figure and was really intending to use *Welch's* invention, and merely putting in the third wire as a colourable distinction, such conduct would be an infringement of *Welch's* patent.(*n*)

Though an anticipation might be an infringement, it is not necessarily a publication.

Though a documentary publication may not be an anticipation of a subsequent patent, notwithstanding that it describes the main features of the invention, still such a publication may very much narrow the ambit of the patentee's claim; and an alleged infringer may consequently be held not to have infringed, whereas had it not been for the prior publication he might have been an infringer.(*o*)

A document which is not a publication may narrow the ambit of the claim.

(*l*) In judgment of C. A., Cassel Gold Extracting Co. *v.* Cyanide Gold Recovery Syndicate, (1895) 12 R. P. C. 256.

(*m*) Caldwell *v.* Van Vlissengen, (1851) 9 Hare, 421; Murray *v.* Clayton, (1872) L. R. 7 Ch. 585; Daw *v.* Eley, (1865) L. R. 3 Eq. 492, 501 n.; Newton *v.* Grand Junction Ry. Co., (1846) 5 Ex. 334; Pneumatic Tyre Co. *v.* East London Rubber Co., (1896) 14 R. P. C. 103; 14 R. P. C. 573.

(*n*) Pneumatic Tyre Co. *v.* East London Rubber Co., (1896) 14 R. P. C. 77, 102; 14 R. P. C. 573.

(*o*) Automatic Weighing Machine Co. *v.* Knight, (1889) 6 R. P. C. 113; Automatic Machine Co. *v.* Combined Weighing Machine Co., (1889) 6 R. P. C. 120; Automatic Weighing Machine

Prior Documents.

General statement as to a class no publication of selection of a particular member.

A general statement that a class of bodies will effect a certain purpose is no anticipation of an invention which consists in the application of one member of the class which possesses particular advantages not shared by the other members of the class.(*p*) So also the use in a particular way of a limited number of a larger class of bodies mentioned in a prior document may form the subject-matter of a valid patent when the inventor has, by the particular use of the limited suitable members of the class, been enabled to produce a new result.(*q*)

Drawings.

A drawing alone which has been published so as to become the property of the public is quite sufficient to invalidate a subsequent patent, if the drawing is intelligible to machinists and enables them by its aid alone to make the machine indicated;(*r*) and a description that will enable competent workmen to carry out an invention will vitiate a subsequent patent for that invention, even though at the time of the prior description no one did use the machine made according to the description, provided that its use is indicated in such description.(*s*)

Description of a useless machine is no publication of a useful one.

If a prior description when completely carried out results in the production of an impracticable and useless machine, it will be no anticipation and publication of the result arrived at by a subsequent inventor when that result is both practicable and useful.(*t*)

So also if the alleged anticipation describes a machine which has a practical defect, and a subsequent invention removes that defect, the prior description is no publication of the later invention. Thus, in the case of a sewing machine to be used for stitching boots, a prior description of a machine in which a forked looper and an auxiliary looper were used and the thread was presented to the point of the needle, was relied on to defeat the patent of the plaintiff. The auxiliary looper and the presentation of the thread to the point of the needle were shown to be defects, and the plaintiff's invention, according to which he removed the auxiliary looper and presented the thread to the notch of the needle instead of to the point, and

Co. *v.* National Exhibitions Association, (1892) 8 R. P. C. 345; 9 R. P. C. 41; Automatic Weighing Machine Co. *v.* International Hygienic Society, (1889) 6 R. P. C. 475; Voeruk *v.* Evans, (1890) 7 R. P. C. 265.

(*p*) Hills *v.* The London Gas Light Co., (1857) 27 L. J. Ex. 60; 5 H. & N. 312; 29 L. J. Ex. 409; Wylie and Norton's Application, (1896) 13 R. P. C. 97; see p. 35 *ante*.

(*q*) Lancashire Explosives Co. *v.* Roburite Explosives Co., (1895) 12 R. P. C. 470, 478; 13 R. P. C. 429; 14 R. P. C. 303.

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

(*s*) United Telephone Co. *v.* Harrison, (1882) L. R. 21 Ch. D. 720; 51 L. J. Ch. 705, judgment of Fry, J.; see p. 129 *ante*.

(*t*) See p. 133 *ante*.

so removed the defect, was held to be good subject-matter of a valid patent.(*u*)

Prior Documents.

An invention may be anticipated partly by one prior publication and partly by another, so that in the result the whole invention may have been previously published. It is not, however, allowable to take a mosaic construction of previous publications, and thereby deny the want of novelty in an invention, which consists in the construction of a whole, the component parts of which have never before been put together in the manner shown by the subsequent inventor.(*x*)

Invention may be partly published by one document and partly by another.

Two or more documents which are public knowledge, and which indicate discussion, invention, or discovery in the same line may be honestly taken together and form a publication of a subsequent alleged invention; but it is not allowable, for the purpose of showing the publication of a combination which has never in fact existed or been described prior to the time the patentee discloses his invention, to piece together parts of prior documents which describe things now found to be useful, but which were never before intended to be put in combination.(*y*)

Mosaic of extracts from prior documents not a publication.

James, L.J., delivering the judgment of the Court of Appeal in *Von Heyden* v. *Neustadt*,(*z*) and commenting on a number of extracts and papers relied on as evidence of the prior publication of the invention which was the subject of the action, said:

> "We are of opinion that if it requires this mosaic of extracts from annals and treatises spread over a series of years to prove the defendant's contention, that contention stands thereby self-condemned. . . . . And even if it could be shown that a patentee had made his discovery of a constructive process by studying, collating, and applying a number of facts discriminated in the pages of such works, his diligent study of such works would as much entitle him to the character of an inventor as the diligent study of the works of Nature would do."

It is to be remembered that there is no case where a new commercial article consisting of a combination of parts being produced for the first time, a separate description of any one or more of those parts alone, or of some combinations of them,

(*u*) English and American Machinery Co. *v.* Union Boot and Shoe Machinery Co., (1894) 11 R. P. C. 137, 367.

(*x*) Neilson *v.* Betts, (1871) L. R. 5 H. L. 1; 40 L. J. Ch. 317; Von Heyden *v.* Neustadt, (1880) 50 L. J. N. S. Ch. 126; Young *v.* Fernie, (1866) 4 Giff. 577; L. R. 1 H. L. 36.

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

(*z*) (1880) 50 L. J. N. S. Ch. 128.

Prior Documents.

when the whole combination has never before been used,(*a*) has been held to amount to a publication of that article.(*b*) It is no detraction from the merit of an inventor to point out that one detail is to be found in one obscure specification, and another detail in another, and so on, and to say that all he had to do was to put these things together. The getting of the idea, and the putting together of that idea, with the mechanical means of attaining it, may constitute invention.(*c*)

Difference between a prior machine and a prior document as publications.

There is a considerable difference as to the effect on the question of publication of an invention between the production of a machine made prior to the date of the patent and a document published before that date. In the former case the production of a machine made for a particular purpose, which would accomplish, when used, results which were not thought of when it was made, might possibly, without any user, be an anticipation of a patent for the application of the machine to produce such results. It would be a question of evidence as to whether it required invention to make the application. If the machine were used in such a way as to make clear to the public what it would effect, it would be a sufficient publication to defeat any subsequent patent for any such result.(*d*)

In the case of a written document it is not apparent, except from the language thereof, what results the contemplated machine would accomplish. It is not sufficient to defeat a patent to say that, if a machine were made by following the description in a document, something in that machine would anticipate the invention of the patentee, unless that something is apparent from the description itself. When the publication is in writing, and in writing only, it is necessary to show that a person conversant with such matters, on reading it, would find a reasonably clear description of the invention in the writing alone. If it be necessary that the machine should be made in order that the publication may be seen, the subsequent inventor is not obliged, when his attention is called to a mere writing, to make a machine from it in order to see what will be the effect. If the document is to invalidate the subsequent patent, it must contain on the face of it a description of the invention.(*e*)

(*a*) Pneumatic Tyre Co. *v.* Casswell, (1896) 13 R. P. C. 375.

(*b*) Otto *v.* Linford, 46 L. T. N. S. 35; Pneumatic Tyre Co. *v.* Casswell, (1896) 13 R. P. C. 375.

(*c*) Fawcett *v.* Homan, (1896) 13 R. P. C. 410.

(*d*) *Ibid.*

(*e*) Hills *v.* Evans, (1862) 31 L. J. Ch. 457; 4 De G. F. & J. 288; Betts *v.* Menzies, (1862) 10 H. L. Cas. 152-154; Otto *v.* Linford, (1881) 46 L. T. N. S. 44; Gouland *v.* Gibbs, (1888) 5 R. P. C. 535.

CHAPTER IV.

UTILITY.

Utility at Common Law.

Utility is a requisite at Common Law.

There do not appear to be any words in the sixth section of the Statute of Monopolies directly implying that the subject of a patent must be an invention which is useful, but "utility" is a condition imposed by the Common Law quite independently of enactment.

The Crown in exercising any of its prerogatives must do so for the good of the public, otherwise it would be acting contrary to the law.(*a*) The Sovereign has no power to charge its subjects, or abridge any of their liberties, excepting it be for their benefit, or in exchange for a sufficient consideration.(*b*) It is evident that during the continuance of a patent, which grants to the patentee and his nominees the sole use and enjoyment of the invention forming the subject of the grant, the public are not able to exercise the invention without the licence of the owner for the time being of the patent, even though they should, independently of the information contained in the specification,(*c*) make the discovery for themselves, and if they desire to procure articles made according to the invention they are obliged to pay whatever price the owner of the patent right chooses to demand.(*d*) The Sovereign in making the grant really acts on behalf of the public,(*e*) and it is therefore only equitable that they should obtain some consideration in respect of the benefit they confer on the grantee.

The subject-matter of every patent must be an art,(*f*) and if such art is incapable of producing useful results in its application to any of the purposes in respect of which the grantee claims protection, it is clear that the public can get no benefit from its application, and the grant will be therefore void on

(*a*) Bac. Abr. tit. "Prerog." (*b*) 2 Rol. Abr. 172, s. 20.
(*c*) See chap. v. *post.* (*d*) As to compulsory licences, see chap. ix.
(*e*) Per Lord Eldon, L.C., in Harmer *v.* Plane, (1809) 14 Ves. 130, 136.
(*f*) Chap. ii. p. 24.

Utility at Common Law.

the ground that the necessary consideration for its support is wanting.

Utility is requisite at Common Law;

Moreover, every patent contains a recital to the effect that the Sovereign, being willing to give encouragement to all arts and inventions which may be for the public good, is pleased to condescend to the applicant's request. It is the evident intention, therefore, that the patentee should give as a consideration to the public an art or invention which is for their good, whereas one devoid of utility would not be. In this latter case the Crown would have been deceived in its grant, which would be void on the ground of the failure of part of the consideration in respect of which the grant was made,(*g*) that is to say, because there was no utility in the invention.(*h*)

It is, of course, the subject of the patent—*i.e.*, the art by the exercise of which the manufactured articles are produced, which must possess the quality of utility.(*i*) The utility of the articles produced by the exercise of the protected art is necessarily the measure of the utility of the art itself, for an art incapable of yielding useful results cannot possess this quality, which is essential for its protection by letters patent.

It is required by the Common Law, in existence before the Statute of Monopolies, that an invention to be capable of substantiating a patent shall possess the element of utility.(*k*)

(*g*) Vin. Abr. Prerog. M.C. (*h*) p. 146 *post*.

(*i*) See Palmer *v.* Wagstaff, Newton, L.J., vol. xliii. p. 151.

(*k*) It was laid down in Darcy *v.* Allin, (1602) Noy, R. 182, that when a man brings into the realm any new trade, and that for the good of the realm, the King may grant him a monopoly for a reasonable time "in consideration of the good that he doth bring by his invention to the commonwealth, otherwise not."

And again, in Sheppard's Abridgment (Part iii. p. 61), it was stated that the King may for a reasonable time grant a monopoly patent for a new trade or device, or any new engine tending to the furtherance of it, for the good of the realm.

In a *scire facias* to repeal a patent, Buller, J., held that it was a question for the jury to decide whether the only new part of the machinery described in the specification was material or useful, and that if they came to the conclusion that such was not the fact the patent was void. The jury gave their verdict against the patent, and on the motion for a new trial no objection was taken to this direction of the Judge (R. *v.* Arkwright, Dav. P. C. 138).

In Boulton *v.* Bull, (1795) 2 H. Bl. 463; Dav. P. C. 162, Rooke, J., said the public had a right to receive a meritorious consideration in return for the protection which the patent claimed.

In Turner *v.* Winter, (1785) 1 T. R. 602; Dav. P. C. 151, Ashurst, J., stated that a patent would be contrary to law were it not for the advantages which the public derive from the communication of the invention.

In Manton *v.* Parker, (1815) Dav. P. C. 327, Thomson, L.C.B., holding the plaintiff's patent void on the ground of the utility of the invention having failed, nonsuited him.

In Manton *v.* Manton, (1815) Dav. P. C. 333, Gibbs, L.C.J., held that in order to support a right to the exclusive enjoyment of a patent, it is necessary that the party who takes out a patent should show that the invention is useful to the public.

In Bovill *v.* Moore, (1815) Dav. P. C. 399, the same learned Judge held that

Utility at Common Law.

As we have seen,(*l*) the Statute of Monopolies did not confer any new right on the Crown, but only reserved to it the privilege which it had long enjoyed before the statute, of granting monopolies in respect of new inventions, and the concluding words of the reserving clause (*m*) expressly declared that such privileges are not to be "contrary to the law, nor mischievous to the State by raising the prices of commodities at home, or hurt of trade, or generally inconvenient." And the section concludes with a declaration that grants made in virtue of the power thereby reserved to the Crown shall be "of such force as they should be if this Act had never been made, and of none other," clearly indicating that all the provisions imposed by the Common Law were to be preserved, whether expressly mentioned in the Act or not. Thus the element of utility is as much a requisite, since the passing of the statute, as it was before it, for the enactment made no difference in this respect, and every case relative to utility decided since the statute is a fresh declaration of the Common Law on the subject.

and is preserved by the Statute of Monopolies.

Sir *Edward Coke*, commenting on the words "mischievous to the State by raising the prices of commodities at home," in 21 Jac. I. c. 3, s. 6, says: "In every such new manufacture as deserves a privilege there must be *urgens necessitas* and *evidens utilitas*," and that the reason why such a privilege is good in law is "because the inventor bringeth to and for the commonwealth a new manufacture by his invention, costs, and charges, and therefore it is reason that he should have a privilege for his reward (and the encouragement of the like) for a convenient time."

it was necessary that the plaintiff should prove that his invention was useful.

In Huddart *v.* Grimshaw, (1803) Dav. P. C. 265, Ellenborough, C.J., held that in order to support the patent the invention ought to be beneficial to the public.

In Brunton *v.* Hawkes, (1820) 4 B. & Ald. 541, Abbott, C.J., put it to the jury to say whether the invention was useful. And in Russell *v.* Cowley, 1 W. P. C. 459, Lyndhurst, C.B., said that the first question respecting the invention was whether it was new and useful; and the rest of the Court concurred in this statement.

In Hill *v.* Thompson, (1817) 1 W. P. C. 235, Eldon, L.C., concurred in the direction of Dallas, J., to the jury who tried the case in the Court of Common Pleas, that the invention to support a patent must be useful. And in Minter *v.* Wells, 1 W. P. C. 129, Alderson, B., stated the same fact. And again, in Morgan *v.* Seaward, 2 M. & W. 544; Mur. & H. 55; 1 Jur. 527; 1 W. P. C. 170, the same learned Judge said, that if the invention was useful it was a subject to be protected by patent; but if it was of no use then it was not a subject to be protected by patent.

In Neilson *v.* Harford, (1841) 8 M. & W. 806; 1 W. P. C. 331, the Court of Exchequer held that a machine produced according to the invention must be beneficial to the public in order that the patent may be valid.

(*l*) p. 1 *ante*. (*m*) s. 6.

Utility at Common Law.

Parke, B.,(*n*) assigned as the reason why the law requires an invention to be useful in order to merit protection by patent, "that a grant of a monopoly for an invention which is altogether useless may well be considered as 'mischievous to the State, to the hurt of trade, or generally inconvenient,' within the meaning of the Statute of Jac. I., which requires, as a condition of the patent, that it should not be so, for no addition or improvement of such an invention could be made by any one during the continuance of the monopoly without obliging the person making use of it to purchase the useless invention."

Patents only used for purpose of obstructing improvements are void.

On a review of the cases it may be doubted whether the question of utility is anything more than a compendious mode, introduced in comparatively modern times, of deciding the question whether the patent be void under the Statute of Monopolies. So where the evidence showed(*o*) that the patent, the subject of the action, had never been worked, and no attempt had been made to bring the articles, manufactured according to the method stated in the specification, before the public, and that the patent was only being used for the purpose of stopping the defendant from making improvements in the manufacture of candles, *Pollock*, C.B., said that in legal language it is a fraud on the law of patents for any person to take out a patent with a view to the obstruction of improvements. And again, the same learned Judge in another case(*p*) held that a patent for an invention which is merely to obstruct every subsequent improvement, which is to step in and prevent the exercise of the ingenuity of mankind and the introduction of other inventions adapted to the particular subject to which the invention may be applicable, could not in his judgment be supported.

It is to be remembered that not every useful novelty is patentable. To be patentable the novelty, besides being useful, must be the outcome of inventive ingenuity.(*q*)

It is not necessary that the invention should be actually put in practice, and the articles produced by its exercise sold, in order that the requisite utility in the invention to merit protection by letters patent may be established; it is quite sufficient if there is evidence to the effect that the invention, if put in practice, would produce useful results.(*r*)

(*n*) Morgan *v.* Seaward, (1836) 1 W. P. C. 197.

(*o*) Palmer *v.* Wagstaff, (1853) Newton, L.J., vol. xliii. p. 131.

(*p*) Crossley *v.* Potter, (1853) Macr. P. C. 240.

(*q*) Brook *v.* Aston, (1857) 8 Ell. & B. 478; Ralston *v.* Smith, (1865) 11 H. L. C. 223; Rickmann *v.* Thierry, (1896) 14 R. P. C. 185; p. 95 *ante*.

(*r*) Otto *v.* Linford, (1881) 46 L. T. N. S. 39; United Telephone Co. *v.*

Meaning of Utility in Law.

Meaning of Utility in Law.

Utility does not mean abstract utility;

The kind of utility which the law requires that an invention must possess to make it fit subject-matter for a patent is not abstract utility.

In a case in which the validity of a patent for improvements in the manufacture of stays and corsets was questioned, on the ground that the invention was not useful, *Grove*, J., directed the jury that, though they might be of opinion that stays are very bad things in themselves, they ought not to say that the invention was useless for that reason, for utility in law means "an invention better than the preceding knowledge of the trade as to a particular fabric."(*s*)

or necessarily an improvement from all points of view.

This definition given by *Grove*, J., requires some modification, for it may well be that a person might produce a new article not so good as the best of its kind, but still *good* and readily sold because it is cheaper. It is submitted that an article which is *good* and cheaper, by reason of its manufacture, than an intrinsically *better* prior article may be sufficiently useful to support a patent on the ground of utility. Further, it is no objection to a patent on the ground of want of utility, provided the thing is useful for the purpose for which the patentee intends it, to point out that it has not come into general use because something else more recent has been preferred. Comparative utility in this sense has nothing to do with it so long as the thing is useful for the purpose intended.(*t*) It would appear that an "invention" is useful in the eye of the law when the public are thereby enabled to do something which they could not do before, or to do something which they could do before, but in a more advantageous manner; provided always that the thing in question is not contrary to the law, nor mischievous to the State by raising prices of commodities at home, or hurt of trade, or generally inconvenient.

Commercial utility.

When the validity of a patent is put in issue, in an action at law, on the ground of inutility, it is not necessary, for the purpose of supporting the patent, to establish that the invention is *commercially* useful. The reason why it has not been adopted in commerce may be that it has been immediately superseded

Bassano, (1886) 3 R. P. C. 313; Ehrlich *v.* Ihlee, (1888) 5 R. P. C. 450; Edison *v.* Holland, (1889) 6 R. P. C. 277.

(*s*) Young *v.* Rosenthal, (1884) 1 R. P. C. 34, 41; see also Manton *v.* Parker, (1815) Dav. P. C. 327; 1 W. P. C. 192 *n.*; *Manton v. Manton, (1815)* Dav. P. C. 348; 1 W. P. C. 192 n.; 1 Carp. P. C. 278.

(*t*) Fawcett *v.* Horman, (1896) 13 R. P. C. 405.

Invention must be Useful as Specified.

by simpler and better or cheaper constructions, involving the same principle.(*u*) There is in fact no necessary relationship between the commercial pecuniary success of an invention and its utility in patent law.(*x*) The circumstance that an invention has not come into general use merely raises a strong presumption against its utility,(*y*) and commercial success is not necessarily evidence that the subject-matter of the patent, though useful, is the outcome of *invention* sufficient to support the patent.(*z*)

An alleged invention which differs from a prior invention only in that it contains an ingredient which does neither good nor harm does not possess sufficient utility to merit a patent.(*a*)

Invention must be Useful as Specified.

Invention is useless unless it does what the patentee states it will do.

The patent will be void unless the invention be useful exactly as it is specified by the patentee, notwithstanding that it may be useful in a modified form.(*b*) In other words, the question always is, Does the invention really do, when put in practice by a competent man, what it assumes to do? And unless the public are enabled to do what the inventor says they can do by means of his invention—*i.e.*, the invention is useful for the purpose for which the inventor intended it—the patent is void.(*c*)

The fact that one mode of carrying out the invention described by the patentee in his specification is preferable to, and more useful than, other modes described, all being useful, is no objection to the patent.(*d*) When an invention does what it is intended by the patentee to do, and the end attained is itself useful, the invention is a useful one. A patent for such an invention is not to be held bad for want of utility, by comparing it with other known methods or things which may be preferred

(*u*) Galloway's Patent, (1843) 1 W. P. C. 724; Bovill *v.* Moore, (1815) Dav. P. C. 361; Otto *v.* Linford, (1881) 46 L. T. N. S. 41; United Telephone Co. *v.* Bassano, (1886) 3 R. P. C. 313; Ehrlich *v.* Ihlee, (1888) 5 R. P. C. 450; Edison *v.* Holland, (1889) 6 R. P. C. 277; Wilson *v.* Union Oil Mills, (1891) 9 R. P. C. 70.

(*x*) Badische Anilin und Soda Fabrik *v.* Levinstein, (1887) L. R. 12 App. Cas. 712; Ehrlich *v.* Ihlee, (1888) 5 R. P. C. 450; Kurtz *v.* Spence, (1887) 5 R. P. C. 182; Fawcett *v.* Homan, (1896) 13 R. P. C. 274.

(*y*) Morgan *v.* Seaward, (1837) 1 W. P. C. 185; Tetley *v.* Easton, (1852) Macr. P. C. 56.

(*z*) p. 95 *ante:* Fawcett *v.* Howman, (1896) 13 R. P. C. 274.

(*a*) Lawrence *v.* Perry, (1885) 2 R. P. C. 184.

(*b*) Tolson *v.* Speight, (1896) 13 R. P. C. 718.

(*c*) Cornish *v.* Keene, (1835) 1 W. P. C. 507; Morgan *v.* Seaward, (1837) 1 W. P. C. 185; Easterbrook *v.* Great Western Ry. Co., (1885) 2 R. P. C. 210; 3 R. P. C. 94; Badische Anilin und Soda Fabrik *v.* Levinstein, (1887) 4 R. P. C. 462; L. R. 12 App. Cas. 712, 719, 720; Wilson *v.* Union Oil Mills, (1892) 9 R. P. C. 70; Fawcett *v.* Homan, (1896) 13 R. P. C. 268.

(*d*) Miller *v.* Searle, (1893) 10 R. P. C. 106.

to it. An invention may be useful, although, owing to other circumstances, the public will not use it; but if they do use it no better proof of utility can be had,(*e*) and the fact that a defendant has attempted to infringe a patent is most cogent evidence as to its utility.(*f*)

Invention must be Useful as Specified.

Upon the point that an invention must be useful, as specified, and for the purpose for which it is stated by the patentee to be useful, the following passage from the judgment of *Lindley*, L.J., in *Lane Fox* v. *Kensington and Knightsbridge Electric Lighting Co., Ld.*,(*g*) with reference to the facts of that case, may be quoted with advantage:—

Per Lindley, L.J.

> "The utility of the alleged invention depends, not on whether by following the directions in the complete specification all the results necessary for commercial success can be obtained, but on whether by such directions the effects which the patentee professed to produce could be produced, and on the practical utility of those effects. Can it be said that the invention, as described in the amended specification, was, in 1878, a practically useful addition to the then stock of inventions? To judge of utility the directions in the amended specification must be followed, and if the result is that the object sought to be attained by the patentee can be attained, and is practically useful at the time when the patent is granted, the test of utility is satisfied. Utility is often a question of degree, and always has reference to some object. 'Useful for what?' is a question which must be always asked, and the answer must be, 'Useful for the purposes indicated by the patentee.' See, per Lord Chief Justice *Tindal* in *Cornish* v. *Keene*, 1 W. P. C. on p. 507; *Edison* v. *Holland*, 6 R. P. C. 243; *Badische Anilin Fabrik* v. *Levinstein*, 12 App. Cas. on pp. 712, 719, 720. An invention may be useful as indicating the direction in which further progress is to be expected, and yet that same invention may be useless for any other purpose; useless, that is, as an invention without further developments and improvements which have not occurred to the patentee. This is, in my opinion, the real truth with respect to the plaintiff's invention as now claimed by him. He made a distinct and important step in advance. The plaintiff was the pioneer; he showed others the road to be followed, but he did not give the traveller the information necessary to enable him to travel on it. There were difficulties to be overcome which the patentee did not foresee, and against which he naturally made no provision. There is an enormous

(*e*) Fawcett *v.* Homan, (1896) 13 R. P. C. 405.
(*f*) Lucas *v.* Miller, (1885) 2 R. P. C. 155; Miller *v.* Barker, (1893) 10 R. P. C. 111.
(*g*) (1892) 9 R. P. C. 417.

Amount of Utility. Lack of Utility in Essential Part.

mass of conflicting evidence upon the possibility of obtaining practically useful results by following the directions contained in his specification. Much of the evidence adduced against the patentee merely goes to show that by following the directions in the specification you cannot produce such good results as are produced by the defendants. This obviously is wholly immaterial. . . . . I have studied the whole evidence with all the care I can bestow upon it, and have come to the conclusion that the plaintiff had not in 1878 invented what he now says he had —namely, a practical method of keeping the electro-motive force in the mains constant at about 100 volts by means of secondary batteries and dynamos used simultaneously as described."

Amount of Utility.

Slight amount of utility is sufficient to support a patent.

The law does not require that an invention, to be worthy of a patent, must possess any definite amount of utility; but it has been decided, over and over again, that a very slight amount of utility will be sufficient(*h*) provided that the Crown has not been deceived as to the extent of the utility of the invention.(*i*) Thus, when the validity of *Galloway's* patent for improvements in steam-engines came into question, *Alderson*, B., told the jury, with regard to the utility of the invention, that the question for them to decide was, whether the steam-engine was a useful invention, and that he thought, if Galloway's engine was of a different construction from any other steam-engine, and of any use to the public, that was sufficient.(*k*)

Lack of Utility in Essential Part.

Lack of utility in an essential part is fatal.

If any material part of the representation, with regard to utility, upon the strength of which a patent was granted, turns out to be untrue, the patent will be void, because of the partial failure of the consideration,(*l*) and also on the ground that the representation being false, the Crown has been deceived in its grant.(*m*) In the words of *Dallas*, J.: "If any part of the alleged discovery, being a material part, fail (the

(*h*) Philpot *v.* Hanbury, (1895) 2 P. O. R. 37; Plimpton *v.* Malcolmson, (1876) L. R. 3 Ch. D. 582; Otto *v.* Linford, (1881) 46 L. T. N. S. 35; Scott *v.* Hamling & Co., (1897) 14 R. P. C. 123.

(*i*) Pirrie *v.* York Street Flax Spinning Co., (1893) 10 R. P. C. 39; 11 R. P. C. 429.

(*k*) Morgan *v.* Seaward, (1836) 1 W. P. C. 172, 186.

(*l*) Hill *v.* Thompson, (1817) 8 Taunt. 375; 2 B. Moore, 448; 1 W. P. C. 232; Bloxam *v.* Elsee, (1825) 1 Car. & P. 558; 9 Dowl. & Ry. 215; 6 B. & C. 169; 3 L. J. (O. S.) Q. B. 93; United Horseshoe and Nail Co. *v.* Swedish Horsenail Co., (1889) 6 R. P. C. 8.

(*m*) Morgan *v.* Seaward, (1836) 2 M. & W. 561; 1 W. P. C. 172.

discovery in its entirety forming one entire consideration) the patent is altogether void."(*n*)

Lack of Utility in Essential Part.

Illustrations.

Thus, in the case of *Manton* v. *Parker*, 1815,(*o*) the whole purpose for which the invention, in the specification, was said to be useful, failed, and the patent was declared to be consequently void. The invention was "for a hammer on an improved construction, for the locks of all kinds of fowling-pieces and small arms," and a material part of the invention consisted in a means of letting out the air from the barrel and causing a communication between the powder in the pan and in the barrel. The evidence, however, showed that the powder passed through the same hole as the air; and *Thomson*, L.C.B., held that the utility of the invention, and the purpose of the hole, as described in the specification, wholly failed; for the purpose of the hole as described was to let the air pass through, and, at the same time, secure the powder from passing through.

Again, in *Easterbrook* v. *The Great Western Railway Company*,(*p*) the main object of an invention of "improvements in machinery and apparatus for actuating and controlling railway points and signals" was to prevent points and signals being set antagonistic to each other. The defendants, who set up the invalidity of the patent, upon the ground (*inter alia*) of absence of utility in the invention, proved at the trial that the apparatus could be so worked as to give conflicting signals, or signals conflicting with the points. The Court held that the patent was bad, because the invention was not only not useful, but dangerous.

If a patentee claims several inventions under different heads, and it turns out that any one of them, which is essential, is useless, the patent is void.(*q*)

In *Turner* v. *Winter*(*r*) the plaintiff's patent was declared void, on the ground that it claimed to produce three different things by one and the same process; and the evidence distinctly showed that the process would not produce one of them (white lead) at all. On a motion for a new trial, made in the Court of King's Bench, *Ashurst*, J., laid down that: "If the process, as directed by the specification, does not produce that which the patent professes to do, the patent is void." And *Buller*, J.: "If the patentee says that by one process he can produce three

(*n*) Hill *v.* Thompson, (1817) 8 Taunt. 375; 2 B. Moore, 448.

(*o*) Dav. P. C. 327; 1 W. P. C. 192 n., 484 n.

(*p*) (1885) 2 R. P. C. 201.

(*q*) Morgan *v.* Seaward, (1836) 1 W. P. C. 171; 2 M. & W. 558; Simpson *v.* Holliday, (1866) L. R. 1 H. L. 315; Templeton *v.* Macfarlane, (1848) 1 H. L. C. 595; United Horsenail Co. *v.* Stewart, (1885) 2 R. P. C. 122, 132.

(*r*) (1787) 1 T. R. 602; 1 W. P. C. 77.

Lack of Utility in Essential Part.

Illustrations.

things, and he fails in any one, the consideration of his merit, and for which the patent was granted, fails, and the Crown has been deceived in the grant."

Bloxam v. *Elsee*(*s*) was an action brought for the infringement of two patents belonging to the plaintiff. Both patents were, however, held void on the ground that the second depended on the first, which was bad for want of utility. The judgment of *Abbott*, C.J., who tried the case, was to the effect that by the patent (the first patent) it appeared that the patentee had represented to the Crown that he was in possession of *a machine* for making paper in single sheets, without seam or joining, from one to twelve feet and upwards wide, and from one to forty-five feet and upwards in length. Upon this representation the patent was granted. The consideration for the grant was the invention of a machine for making paper in sheets of width and length varying within the limits designated. If any material part of the representation was not true, the consideration had failed in part, and the grant was consequently void, and a defendant in an action for infringement had a right to say that it was so. If the representation was (as the learned Chief Justice thought it was) that paper of various widths might be obtained from one and the same machine, the evidence must be looked to to discover whether the patentee was possessed of a machine, or of the invention of a machine, capable of accomplishing that object, and, unfortunately, the evidence showed that he was not. The patentee was at the time possessed of one machine and one only, and that adapted to one degree of width and one degree only. And he was not then possessed of any method by which different degrees of width might be manufactured by that machine or by any other.

A patent, the title of which was "improvements in steam engines, and in machinery for propelling vessels, which improvements are applicable to other purposes" was declared void by the Court of Exchequer on the ground that, upon the face of the patent as set out in the record, it appeared that an improvement in steam-engines was suggested by the patentee, and that the jury having found that the invention was not an improvement in steam-engines, though it was an improvement in machinery for propelling vessels, the grant was void for false suggestion.(*t*)

(*s*) (1825) 1 Car. & P. 558; 9 Dowl. & Ry. 215; 6 B. & C. 169; 3 L. J. (O. S.) Q. B. 93.

(*t*) Morgan *v.* Seaward, (1837) 2 M. & W. 544; Mur. & H. 55; 1 Jur. 527; 1 W. P. C. 187.

Lack of Utility in Essential Part.

Again, in another case in the Court of Exchequer, Lord *Abinger*, C.B., directed the jury to consider whether an invention of improvements in wheels for railway carriages was worth a patent or not, or whether the improvements were, as the defendant alleged, only trifling and insignificant alterations. The jury found that there were substantial improvements in the invention, but, had they come to the opposite conclusion, the Court would no doubt have declared the patent bad on the ground of false suggestion.

If invention is useful for most purposes stated, the *fact that it* fails for one purpose within the statement is not necessarily fatal.

If an invention is useful for the generality of purposes for which it is stated in the specification so to be, the fact that it is altogether useless for one purpose falling within the statement will not necessarily vitiate the patent.

Thus, in *Haworth* v. *Hardcastle* (*u*) the patent was for "certain machinery, or apparatus adapted to facilitate the operation of drying calicoes, linens, or other similar fabrics," and on a motion for a nonsuit and to set aside a verdict given for the plaintiff on the finding of a jury that the invention was new and useful on the whole, but that the machine was not useful in some cases for taking off goods, the Court, consisting of *Tindal*, C.J., *Parke*, *Gaselee*, and *Bosanquet*, JJ., held that they would not be justified in setting aside a verdict given on such a finding, and in holding that the patent was void on the ground that the machine was altogether useless for one of the purposes described in the specification.

Lack of utility in non-essential part is no bar.

If an entire machine or subject is, as a whole, useful, a want of utility in a part or parts, provided that the useless part or parts form no part of the consideration in respect of which the patent was granted, will not vitiate a patent in respect of such machine or subject,(*x*) and a minor claim the subject of which is found not to be useful will not be fatal, provided there is no concealment.(*y*)

Each essential part is not required to be equally useful.

If an invention as a whole is useful, it is not necessary that each part of it should possess the same amount of utility.(*z*)

A patent is void if an essential part of the invention is impracticable and useless,(*a*) but if part of an invention, as described in a specification, turn out not to be necessary, the

(*u*) (1834) 4 M. & Sc. 720; 1 Bing. N. S. 182; 1 W. C. P. 480.

(*x*) Morgan *v.* Seaward, (1837) 2 M. & W. 544; Mur. & H. 55; 1 Jur. 527; 1 W. P. C. 187; Lewis *v.* Marling, (1829) 1 W. P. C. 490; United Horsenail Co. *v.* Stewart, (1885) 2 R. P. C. 122, 131.

(*y*) United Horseshoe Co. *v.* Swedish Horsenail Co., (1888) 6 R. P. C. 1; Ehrlich *v.* Ihlee, (1888) 5 R. P. C. 450.

(*z*) Ehrlich *v.* Ihlee, (1888) 5 R. P. C. 103.

(*a*) United Horsenail Co. *v.* Stewart, (1885) 2 R. P. C. 122, 132.

Utility of Improvements.

inutility of that part will not vitiate the patent unless it is claimed as *essential*.(*b*)

In *Lewis* v. *Marling*,(*c*) the patent was for improvements in shearing machines, for shearing or cropping woollen and other cloths. And it appeared in evidence that a brush, described in the specification, and intended to raise the wool, was unnecessary and useless. The Court of King's Bench held that the inutility of this brush, which was not claimed as *essential*, did not render the patent bad. *Tenterden*, C.J., saying: "As to the objection on the ground that the application of a brush was claimed as part of the invention, adverting to the specification, it does not appear that the patentee says the brush is an essential part of the machine, although he claims it as an invention. When the plaintiffs applied for the patent they had made a machine to which the brush was affixed, but before any machine was made for sale they discovered it to be unnecessary. I agree, that if the patentee mentions that as an essential ingredient in the patent article, which is not so, nor even useful, and thereby misleads the public, his patent may be void; but it would be very hard to say that this patent should be void because the plaintiffs claim to be the inventors of a certain part of the machine not described as essential, and which turns out not to be useful." *Bayley*, J., saying: "Now, at the period when this specification was made, the brush was in use, and there is no reason to believe that this patentee did not think it was a useful part of the machine. His patent is for an instrument where something of that kind was always thought material; and I am of opinion that the subsequent discovery that the brush was unnecessary is no objection to the validity of the patent. If the party knew that it was unnecessary, the patent would be bad, on the ground that this was deception, but if he thought it was proper, and only by a subsequent discovery finds out that it is not necessary, I think that it forms no ground of objection."

Utility of Improvements.

Lack of utility in a prior invention is no bar to a patent for an improvement upon it.

In the case of a patent for an invention which is an improvement on a former invention, the want of utility in the

(*b*) Lewis *v.* Marling, (1829) 10 B. & C. 22; 1 W. P. C. 493; Morgan *v.* Seaward, (1837) 2 M. & W. 544; 1 W. P. C. 167; 6 L. J. Ex. 153; United Horsenail Co. *v.* Stewart, (1885) 2 R. P. C. 132.

(*c*) (1829) 10 B. & C. 22; 4 Car. & P. 57; 1 W. P. C. 493.

Utility of Improvements.

former invention will not vitiate the patent for the improvement, which will be perfectly valid as regards utility, if the machine manufactured according to it is useful.(*d*)

Bloxam v. *Elsee* (*e*) at first sight appears to be a decision contrary to the above proposition, but it must be observed that *Bloxam* v. *Elsee* was decided on the ground that the subsequent patent was granted on the strength of the suggestion contained in the prior patent, which turned out to be false.

In the case of a patent for an invention which is an improvement on a former patented invention, the question always is, What is the representation on the strength of which the second patent was granted? If the second patent was granted on the same representation as rendered the first void it is bad also; but if the second patent was granted on a true representation the fact that the first patent was bad will not vitiate the second.

(*d*) Lewis *v.* Davies, (1829) 3 Car. & P. 502; 1 W. P. C. 488; per Lord Tenterden, C.J.; Tetley *v.* Easton, (1852) Macr. P. C. 56; Murray *v.* Clayton, (1877) L. R. 7 Ch. 581; Morgan *v.* Windover, (1888) 5 R. P. C. 303; Jones *v.* Pearce, (1832) 1 W. P. C. 121, 122; Shaw *v.* Jones, 6 P. O. R. 336.

(*e*) (1825) 1 Car. & P. 558; 9 Dowl. & Ry. 215; 6 B. & C. 169; 3 L. J. (O. S.) Q. B. 93; see p. 148 *ante*.

CHAPTER V.

THE SPECIFICATIONS.

ORIGIN AND DEVELOPMENT.

Historical.

WHEN a person becomes the recipient of the exclusive privilege of exercising any particular art under a grant of letters patent from the Crown, it is of the utmost importance, in the interests of the rest of the community, that definite information should be given as to what it is they are, without the sanction of the patentee, prohibited from doing during the existence of the monopoly. It is also very essential in the interests both of the patentee himself and the public that the exact invention which forms the subject of the grant of letters patent and the best means of performing it should be clearly defined. An invention without the knowledge of the means of putting it into practical operation is of no use to its possessor; and the patent may be considered substantially as amounting to a bargain between the patentee and the Crown, according to which the former shall disclose the means of putting the invention into practice for the benefit of the public, so that after the expiration of the time for which the monopoly is granted all may alike enjoy the benefits of the discovery, if minded to do so.(*a*)

It was formerly the practice to insert in the letters patent a recital, amounting to a description of the invention, which was the subject of the grant, and this recital, which was usually very meagre, was the only source of information as to what the invention really was and how it was to be performed.

Great inconvenience was found to arise from this practice, and during the reign of Queen Anne the Attorney-General devised a plan to obviate this objection. This plan consisted in making it a condition that the patentee should, within six months, "particularly describe and ascertain the invention, and the manner in which it is to be performed," and in inserting in the letters patent a declaration that an omission to do this

(*a*) p. 93 *ante*.

would render the grant null and void. This was the origin of the modern instruments known as specifications. Before this period of six months had elapsed, there being no provisional specification, it must have been a question of evidence as to what was the invention for which the patentee went to the Crown, and for which the Crown granted a monopoly.(*b*)

Origin and Development.

The Patent Act of 1852 introduced a further improvement by providing that would-be patentees should, at the time of application for letters patent, deposit a provisional specification, which is a very different instrument to that required after the grant under the earlier practice. Instead of requiring that the patentee should, in the provisional specification, "particularly describe and ascertain the nature of the invention, and in what manner the same shall be performed," the Act of 1852 only insisted that in the provisional specification, which the applicant was to leave with the law officer of the Crown when he applied for a patent, he should state the nature of the invention; and the Act further provided that when the law officer of the Crown had looked at the specification, if he were of opinion that it did not state the nature of the invention, he should be competent to require the document to be amended in that particular, but if he thought it properly stated the nature of the invention he could grant a certificate authorising the applicant to use the invention publicly without thereby making a publication which would render the patent, if granted afterwards, invalid.

The provisional specification was introduced for the benefit of the patentee, who, during the period of protection from the effects of publication which the certificate of the law officer of the Crown secured, was enabled to make further experiments and improve the means of carrying out his invention before filing his second and complete specification, in which he was required not only to "describe the nature of the invention," but to "state in what manner the same shall be performed." It was, moreover, under the Act of 1852, competent for the applicant, if he thought fit, to file his complete and final specification on making application for the grant of letters patent, instead of putting in a provisional specification; but it would clearly not be his interest as a rule to do so, for he would thereby deprive himself of the right to make further legitimate improvements before obtaining the great seal.

The practice in this matter under the Patents, Designs, and Trade Marks Act, 1883, is practically the same as that under

(*b*) Bailey *v.* Roberton, (1878) 3 App. Cas. 1074, per Lord Blackburn.

The Title.

the Act of 1852, excepting that the leaving of a complete specification is now always a condition precedent to the grant of a patent; and it is enacted that an application for a patent must be accompanied by either a provisional or a complete specification, and that a provisional specification must describe the nature of the invention, whilst a complete specification, whether left on application or subsequently, must particularly describe and ascertain the nature of the invention, and in what manner it is to be performed; and a provisional or complete specification must, if required, be accompanied by drawings.(*c*)

The Title.

Titles should be drafted in conformity with certain rules.

A specification, whether provisional or complete, must commence with the title,(*d*) which is virtually a short and concise statement of the invention.(*e*) Before the days of provisional specifications the title was of far greater importance than it is now. In those days its functions were largely those of the provisional specifications now, and a discrepancy between the title and the specification subsequently enrolled was a matter of vital importance, as it rendered the patent utterly void.

Since the passing of the Act of 1883, defective titles have not been, nor are they likely to be, so frequent as they were formerly, for it is expressly provided by the sixth sec. of that Act that the Comptroller shall refer every application to an examiner, who is required to examine the specification and to ascertain that the title sufficiently indicates the subject-matter of the invention. There is, in fact, no reported case since the Act of 1883 in which a patent has been declared void on the ground of a defective title, and there appears to be only one(*f*) in which the question has been raised. Still, if the title after it has passed the examiner, or after amendment, remains defective, it may be an objection to the validity of the patent; and it must not be forgotten that under the practice before the Act of 1883 an examination of the title was supposed to be made by the patent clerks of the law officers of the Crown before the great seal was obtained, and that, notwithstanding this precaution, it was not uncommon for patents to be vitiated through defects in their titles.

(*c*) 46 & 47 Vict. c. 57, s. 5, sub-s. 2, 3, 4; P. R. 1890, rr. 26–33, see Appendix.

(*d*) 46 & 47 Vict. c. 57, s. 5, sub-s. 5.

(*e*) Household Co. *v.* Neilson, (1843) 1 W. P. C. 678.

(*f*) Pirrie *v.* York Street Spinning Co., (1892) 10 R. P. C. 34.

The Title.

The specification is to be construed as a whole, and a defect in the title may consequently be remedied in the body of the specification.(*g*) Further, a patentee is entitled to frame the title in his own way, provided he does not infringe the rules of the statute.(*h*)

It is not uncommon for the Comptroller-General, or, on appeal from him, the law officer, to make the amendment of titles as originally drafted a condition of the grant of letters patent.(*i*)

Rules in conformity with which titles should be drafted.

Titles should be drafted in conformity with the following rules. As inferred above, the cases quoted in support of the rules were all decided before the Act of 1883, but under the present practice, assuming that the provision in the Act of 1883 for reference to an examiner has not removed the objection of defective title against a patent which has been accepted by the examiner,(*k*) in the event of a title being defective, the principles of these cases would still apply; and the authorities at the Patent Office require titles to conform to the rules hereafter stated. Of course it is a question of fact in each instance whether the title is at variance with any one or more of the rules under consideration.

I. *The title must not be too extensive so as to embrace more than the patentee has really discovered, for this will make the patent void on the ground that it has been granted for more than the patentee is entitled to.*

Thus, in *Cochrane* v. *Smethurst*,(*l*) where a man had invented a glazed street lamp, and obtained a patent for it under the title "an invented method of more completely lighting cities, towns and villages," he was nonsuited in an action for infringement of his patent, on the ground that he had obtained it, not for an improved street lamp, but for an improved method of lighting streets, towns, and villages.(*m*) And in *Felton* v. *Greaves*,(*n*) where a man took out a patent under the title "a machine for an expeditious and correct mode of giving a fine edge to knives, razors, scissors, and other cutting instruments," and the machine, as described in the specification, was not capable of giving an

(*g*) p. 247 *post*.
(*h*) Brown's Patent, (1887) Griff. L. O. C. 1.
(*i*) p. 294 *post*.
(*k*) See p. 154 *ante*; *cf.* 260 *post*.
(*l*) (1816) 2 Coop. Ch. Cas. 57; 1 Stark. R. 205.
(*m*) See remarks of Tindal, C.J., Cook *v.* Pearce, (1844) 8 Q. B. 1054, 1062; 13 L. J. Q. B. 189.
(*n*) (1829) 3 Car. & P. 611.

The Title.

Rules in conformity with which titles should be drafted.

edge to scissors, the patent was held to be bad for want of sufficiency.

In *Campion* v. *Benyon* (*o*) a rule *nisi* to set aside the verdict for the plaintiff, and to enter a nonsuit, was made absolute by the Court of Common Pleas. The title of the patent in question was "an improved method of making and manufacturing double canvas and sailcloth with hemp and flax, or either of them, *without any starch whatever*." It was sought, on the part of the plaintiff to show from the specification that the omission of the use of starch (which was old) was no part of what the plaintiff claimed. *Dallas*, C.J., delivering his judgment, said:—

> "With respect to patents, every patent being a monopoly, that is, an infringement of public right, and having for its object to give public warning of the precise extent of the privilege conferred on the patentee, the Court (without going into the controversy whether it is politic that such privileges should be conferred or not) is bound to require that such warning should be clear, and accurately describe what the inventor claims as his own. If the instrument contain an ambiguity on a material point that is a ground on which it may be avoided altogether. From the first time I read this patent down to the present day, I thought that the object of the patent was to make cloth without starch. Then, as to the specification, if that be different from the patent, the whole is void; if it coincides it is open to the same objection as the patent. Whether we look to the patent or the specification, I have no doubt that the claim of the plaintiff is too extensive; it is not confined to an improved method of weaving the cloth, or twisting the threads, but also comprehends another mode of proceeding, which is not a new discovery."

It has been held, on the other hand, that where the title was "improvements in the manufacture of plaited fabrics," the objection that only one improvement was disclosed by the specification was not sufficient to upset the patent, *Tindal*, C.J., remarking:—

> "This is, certainly, a most subtle objection; if the term 'improvement' had been used, it would have been *nomen collectivum*, and would have covered any number of improvements. I cannot see why the variance, if it be one, should vitiate the

(*o*) (1821) 6 B. Moo. 71: 3 Brod. & Bing. 5.

patent, the objection being merely to the title of the patent, without fraud upon the Crown or detriment to the public." (*p*)

The Title.

Rules in conformity with which titles should be drafted.

And, again, where the word "improvements," being in the plural number, was relied on as an objection to the patent in question, Lord *Abinger*, C.B., thought that it was of no consequence, because the plaintiff might mean every part of his process to be treated as an improvement, forming, together, a series.(*q*)

II. *The title should not be too narrow, so as to exclude something which the patentee has invented, for, if it be so, he may not obtain protection in respect of that to which he may be justly entitled.*

Thus, in *Croll* v. *Edge*,(*r*) a patent was granted under the title "improvements in the manufacture of gas for the purpose of illumination, and in apparatus used when transmitting and measuring gas." From the specification it appeared that the patentee had invented an improved method of making retorts. In that instrument it was stated that the invention consisted in "improvements in the manufacture of gas for the purpose of illumination, and apparatus used therein, and when transmitting and measuring gas," but the Court held that the patentee was not entitled to protection in respect of the retorts, as the title did not profess to comprehend improvements in any apparatus used in making gas, and that the insertion of the words "therein and" amounted to a substantial extension of the grant of the Crown.

In *Oxley* v. *Holden*,(*s*) in which the title of the patent was "improvements in the doors and sashes of carriages," the specification stated that the patentee had shown the invention, as applied to railway carriage doors and window fittings, although it was equally applicable to the doors and windows of any other description of carriage, or in any case where windows and doors are subject to jar and vibration. The Court held that the invention claimed was not larger than the title, and the judgment of *Erle*, C.J., contained the following passage :—

"The invention specified and claimed is truly an improvement in the doors and windows of carriages, not the less

(*p*) Nickels *v.* Haslam, (1844) 7 M. & G. 378; 8 Scott, N. R. 97; 13 L. J. C. P. 146.

(*q*) Derosne *v.* Fairie, (1835) 5 Tyr. 393; 2 Cr. M. & R. 476; 1 W.P. C. 154.

(*r*) (1847) 9 C. B. 479; 19 L. J. C. P. 261.

(*s*) (1860) 8 C. B. N. S. 666; 30 L. J. C. P. 68.

The Title.

Rules in conformity with which titles should be drafted.

because it is also applicable to other doors and windows. It seems to us reasonable that the claim should be construed with reference to the title, and confined, accordingly, to the doors and windows of carriages. The present case has no analogy to the decision of this Court in *Croll* v. *Edge*, (1847) 9 C. B. 479; 19 L. J. C. P. 261, where the patent was, in effect, for improvements in the apparatus for the manufacture, and also in that of the transmission, of gas. The specification, therefore, related to an apparatus additional to and beyond that referred to in the title. Here the title and the specification relate to one and the same apparatus."

III. *The title should not be vague or ambiguous.*

There is authority for saying that the mere vagueness or ambiguity of the title is an objection which may well be taken on the part of the Crown—that is to say, by the Comptroller-General,(*t*) before a patent is granted, but it affords no ground for avoiding the patent after it has been granted, provided that the ambiguity is explained by the specification, and the title is not at variance with it.(*u*)

Thus, in *Sturz* v. *De la Rue* (*x*) a patent for a method of fixing folding shutters in carriages in which *German* shutters were used was upheld, notwithstanding the objection that the title "improvements in carriages" was too vague.

And in *Neilson* v. *Harford* (*y*) a patent for the application of the *hot blast* in the smelting of iron, under the title "an improved application of air," was upheld.

IV. *The title should not contain a misdescription of the invention, for this may be a fatal objection if not corrected in the body of the specification.*

In *Rex* v. *Metcalf*,(*z*) a patent under the title "a tapered hair or head brush" was upset, on the ground that from the description in the specification it appeared that the brush invented by the patentee did not taper, but was only unequal.(*a*)

In *Bainbridge* v. *Wrigley*,(*b*) Lord *Ellenborough* held a patent void which was for "certain improvements in the flageolet or

(*t*) Chap. vii.

(*u*) Cook *v.* Pearce, (1844) 8 Q. B. 1044; 13 L. J. Q. B. 189.

(*x*) (1828) 5 Russ. 322; 7 L. J. (O. S.) Ch. 47.

(*y*) (1841) 1 W. P. C. 295; 8 M. & W. 806; 2 Coop. Ch. Cas. 61; 11 L. J. Ex. 20.

(*z*) (1817) 2 Stark. R. 249.

(*a*) See also Neilson *v.* Harford, (1841) 1 W. P. C. 333.

(*b*) (1810) Parl. Rep. 197.

English flute, whereby the fingering will be rendered more easy, and notes produced that were never before produced," on the ground that the instrument described, as a matter of fact, produced only one new note.

The Title.

Rules in conformity with which titles should be drafted.

In *Fisher* v. *Dewick* (*c*) the title of the patent in question was "improvements in machinery for the manufacture of bobbin net lace," and the defendant objected that the title misdescribed the subject-matter, the invention being only for making a spot during a particular part of the process, and being useless when that addition was not wanted, and that the title should have been "for a mode of making spots in bobbin net lace." *Coltman*, J., ruled that the invention was inapplicable to anything but the making of bobbin net lace, and that it was an improvement. The Court of Common Pleas supported the ruling of the Court below, *Tindal*, C.J., observing that it could not, without great refinement, be said that the invention was not an improvement in the manufacture of bobbin net lace.

V. *A false suggestion in the title may be fatal to the validity of the patent, for the Crown may have been deceived in its grant.*

Thus, in *Morgan* v. *Seaward*,(*d*) the case of *Galloway*'s patent for "improvements in steam-engines and in machinery for propelling vessels," the defendants in an action for infringement obtained a verdict on the issue that the invention was not an improvement in steam-engines.

In *Bloxam* v. *Elsee* (*e*) the patent was held void on the ground of false suggestion, it appearing that the patentee had by the title represented that he was in possession of "an invention of making paper in single sheets, without seam or joining, from one to twelve feet and upwards wide, and from one to forty-five feet and upwards in length," whereas from the evidence it appeared that the machine he claimed to have invented would only make paper of one particular degree of width and length.

It is not uncommon to find the titles of patents commencing with the words "a new or improved method or process," and it would appear that if the method or process be partly new, so as to produce a result which as a whole is new, or if the

(*c*) (1838) 4 Bing. N. C. 706.
(*d*) (1835) 2 M. & W. 544; 1 W. P. C. 167; 6 L. J. Ex. 153.
(*e*) (1825) 1 Car. & P. 558; 9 Dowl. & Ry. 215; 6 B. & C. 169; 3 L. J. (O. S.) Q. B. 93.

The Title.

Rules in conformity with which titles should be drafted.

method or process be entirely new, it may properly be called a new or improved method or process ; (*f*) whereas, if the method or process be not new, but improved, the patent with such a title will be bad.(*g*)

VI. *If the title insufficiently or inaccurately describe what is really the invention, it will not render the patent void, if it is comprehensive enough to include the actual invention.*

In *Hill* v. *The London Gas Light Company*,(*h*) the title as amended was "an improved method of purifying coal-gas," and it appeared from the specification that the invention really consisted in a method of removing the sulphuretted hydrogen which occurs as an impurity in coal-gas. The Court of Exchequer overruled the objection that the invention specified was different from that for which the patent was granted, *Watson*, B., saying :—

"The patentee made a mistake in stating for what he wanted his patent, but in reality he wanted a patent for his invention ; it has been granted to him for that and the title comprehends it. If, indeed, the jury had found either that when he applied for the patent he had not invented the thing specified, or that, in truth, he did not apply for it, a different question might have arisen ; but the jury must be taken to have found that, although he has inaccurately or insufficiently described what he was asking for, in reality he was asking for a patent for this invention." (*i*)

In *The Electric Telegraph Company* v. *Brett*,(*k*) the defendant objected that the plaintiffs' patent being described in the title as an "Invention of improvements in giving signals and sounding alarums in distant places, *by means of electric currents transmitted through metallic circuits*," it was impossible for them, the defendants, to infringe as long as the circuit they used was not metallic throughout, but to a substantial extent *non-metallic*. The jury, however, found a verdict for the plaintiffs, which was upheld by the Court of Common Pleas, *Creswell*, J., saying :

(*f*) Beard *v.* Egerton, (1846) 2 Car. & K. 667 ; 3 C. B. 97 ; 8 C. B. 165 ; 15 L. J. C. P. 270 ; 19 L. J. C. P. 36.

(*g*) Gibson *v.* Brand, (1842) 1 W. P. C. 634.

(*h*) (1860) 29 L. J. Ex. 409 ; 5 H. & N. 312.

(*i*) See also Regina *v.* Mill, (1851) 10 C. B. 389 ; 14 Beav. 312 ; 20 L. J. C. P. 16.

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

Provisional Specification.

"Now, the patentees, by their specification, do not make any claim to metallic circuits. What they claim, is improvements in giving signals by means of electric currents transmitted through metallic circuits, and the improvements, as appears by the specification, consist entirely in the methods and instruments for using the electric current. The circuit used by the defendant is metallic in all that part which operates in giving signals, and it is no condition necessary to the existence of the improvements that the circuit should be metallic in any other part than that which contains the coils and operates on the needles. It appears to us reasonable to hold that a claim for a patent for improvement in the mode of doing something by a known process is sufficient to entitle the claimant to a patent for his improvements when applied either to the process as known at the time of the claim or to the same process altered and improved by discoveries not known at the time of the claim, so long as it remains identical with regard to improvements claimed and their application."

The Provisional Specification.

Provisional specification is optional.

An applicant for a patent is required to accompany his application by a specification, but it is optional whether this shall be provisional or complete.(*l*) It is, however, in virtue of the difference between the requisites of the provisional and complete specifications, very rarely to the interests and advantage of a would-be patentee to depart from the general practice of accompanying his application by a provisional specification, and availing himself of the time allowed him under the Act wherein to consider and fulfil the obligations which the necessity of ultimately filing a complete specification imposes upon him.

Differences between provisional and complete specifications.

Functions of Provisional Specifications.—The provisional differs from the complete specification in that the former must describe the nature of the invention, and the latter must *particularly* describe and ascertain the nature of the invention and *in what manner it is to be performed.*(*m*) It thus appears that, as regards the description of the invention, there is a difference in the accuracy with which this is required to be given by the two specifications. The provisional specification need not enter in detail into all the means by which the

(*l*) 46 & 47 Vict. c. 57, s. 5, sub-s. 2; for forms of provisional and complete specification, see P. R. 1890, Form B. and Form C; p. 292 *post*.
(*m*) 46 & 47 Vict. c. 57, s. 5, sub-s. 3, 4.

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invention is to be carried out,(*n*) and it was never intended to be more than a mode of protecting an inventor until the time for filing the complete specification; nor was it intended to contain a complete description of the discovery such as would enable a skilled person, and, therefore, much less a workman of mere ordinary skill, to carry it out.(*o*) It is quite sufficient if the provisional specification inform the Comptroller-General roughly what the invention is for which protection is sought; but it must do this fairly and honestly, and must indicate the whole invention of which the would-be patentee is in possession at the date of his application, and for which he desires to obtain protection.(*p*)

Object of provisional specification is to avoid disputes thereafter as to what the invention is for which the monopoly was granted.

The object of this is to show that the invention subsequently fully specified is the same as that which is presented to the Comptroller in the first instance.(*q*)

In cases of subsequent dispute the question is not whether the provisional specification is defective, but whether the complete specification is excessive.(*r*) The provisional may go beyond the complete, and anything contained in the provisional may be dropped in the complete, provided the omission does not alter the nature of the invention.(*s*)

There is the authority of Lord *Chelmsford*, L.C.,(*t*) for the statement that "it is clear that the office of the provisional specification is to describe the nature of the invention, not with minute particularity, but with sufficient precision and accuracy to inform the law officers" (now the Comptroller-General) "what is to be the subject-matter of the patent. It is not at all necessary that the provisional specification should describe the mode or modes carried out. That is left to the complete specification."

Further, as pointed out by *Lopes*, L.J.,(*u*) a provisional

(*n*) *Re* Newall & Elliott, (1858) 4 C. B. N. S. 269; 1 H. & C. 797; 32 L. J. Ex. 120; 10 Jur. N. S. 954; Penn *v.* Bibby, (1875) L. R. 2 Ch. 127, 132; Lucas *v.* Miller, (1885) 2 R. P. C. 155; Moseley *v.* Victoria Rubber Co., (1887) 4 R. P. C. 241; Morgan *v.* Windover, (1887) 4 R. P. C. 422; 5 R. P. C. 295.

(*o*) Stoner *v.* Todd, (1874) L. R. 4 Ch. D. 58; United Telephone Co. *v.* Harrison, (1882) L. R. 21 Ch. D. 720; 51 L. J. Ch. 705; Nuttall *v.* Hargreaves, (1892) 8 R. P. C. 450; L. R. 1 Ch. 94; 61 L. J. Ch. 94.

(*p*) Stoner *v.* Todd, (1874) L. R. 4 Ch. D. 58; United Telephone Co. *v.* Harrison, (1882) L. R. 21 Ch. D. 718, 747; Woodward *v.* Sansum, (1887) 4 R. P. C. 166, 174; Siddell *v.* Vickers, (1888) L. R. 39 Ch. D. 92.

(*q*) Newall *v.* Elliot, (1863) 1 H. & C. 797; 32 L. J. Ex. 120; 10 Jur. N. S. 954; 4 C. B. N. S. 269.

(*r*) Siddell *v.* Vickers, (1888) L. R. 39 Ch. D. 92, 97; Curtis *v.* Platt, (1888) Griff. L. O. C. 53; 5 R. P. C. 87 n.

(*s*) Penn *v.* Bibby, (1866) L. R. 2 Ch. 127; 36 L. J. Ch. 455; p. 166, *post*.

(*t*) Penn *v.* Bibby, (1875) L. R. 2 Ch. 127.

(*u*) Woodward *v.* Sansum, (1887) 4 R. P. C. 166.

Provisional Specification.

specification was never intended to contain a complete and exhaustive description of the invention; it was intended to be sufficiently specific to disclose the nature of the invention, so as to protect the inventor till the time for filing the final or complete specification, but permitting him in the meantime to perfect any details, to modify, supplement, and develop his invention, always keeping within what may be called the ambit of his invention as disclosed in his provisional specification.

And as observed by *Smith*, L.J.,(*x*) "In a provisional specification no claim is ever made by the patentee, he has not to state therein what he claims, or how he carries out the invention; but he must state its nature in such a way that the law officers may see what it is, and so that the identity of its subject-matter with that of the complete specification which is to come thereafter may be ascertained."

Thus, one of the objects of the provisional specification is to determine that the invention described and claimed by the final is really one and the same as that described by the provisional specification. The patent is altogether void if the final comprise an invention which is not comprehended by the provisional specification.(*y*)

Details stated in the complete may differ from those stated in the provisional,

It is not, however, necessary that all the details of the invention described in the final should be identical with those indicated in the provisional specification, provided that the invention remain substantially the same. The complete specification is, in a sense, supplemental to the provisional, not going beyond, nor varying from it as to the nature of the invention, but conveying additional information, which may have been acquired during the period of provisional protection, as to the manner in which the invention is to be performed.(*z*)

or subordinate matters may be abandoned;

Any subordinate matter, or point, or detail, may be abandoned in the final specification without affecting the validity of the patent, provided always that such abandonment does not change the nature of the invention, and make it really a different one to that described in the provisional; and such an abandonment is a notification to the public that the inventor could not work it, or thought it useless, and consequently omitted it altogether.(*a*)

(*x*) The Cassel Gold Extracting Co. *v.* The Cyanide Gold Recovery Syndicate, (1895) 12 R. P. C. 257.

(*y*) Bailey *v.* Roberton, (1878) L. R. 3 App. Cas. 1055; Crossley *v.* Potter, (1853) Macr. P. C. 240.

(*z*) Per Chelmsford, L.C., Penn *v.* Bibby, (1875) L. R. 2 Ch. 127.

(*a*) Stoner *v.* Todd, (1876) L. R. 4 Ch. D. 58; 46 L. J. Ch. 32; Hutchison *v.* Pattullo, (1888) 5 R. P. C. 351; Thomas *v.* Welch, (1866) L. R. 1 C. P. 192; Penn *v.* Bibby, (1875) L. R. 2 Ch. 127, 134; Everitt's Patent, (1888) Griff. L. O. C. 27; Pneumatic Tyre Co. *v.* East London Rubber Co., (1896) 14 R. P. C. 77, 573.

Provisional Specification.

In *Thomas* v. *Welch* (*b*) the defendant contested the validity of the plaintiff's patent for a sewing machine on the ground that the complete specification omitted some of the inventions put forward in the provisional specification. It appeared that the provisional specification described a certain instrument, and then went on to say that "this, *or another acting therewith*, acts to hold the work during the insertion of the needle." It was contended that the complete specification contained nothing corresponding to this second alternative. The Court of Common Pleas overruled this objection, and *Erle*, C.J., in his judgment said :—

> "Assuming that this is so, I do not think the objection ought to prevail. The difference is a slight one, and injured nobody; and it may be that the patentee had something in his mind when he filed his provisional specification, which he found afterwards would be useless. As he could not disclaim, formally, part of the provisional specification, he might, I think, in such a case as the present, have omitted it from his complete specification. It may be, however, that one form, if mentioned in the complete specification, which is in two parts, is what was referred to in the expression, '*and another acting therewith.*'"

but the provisional cannot be read to supply an omission in the complete specification.

If, however, the patentee omits in the complete specification anything which is described in the provisional specification, he cannot afterwards read the provisional to supply a defect in the final specification.

Thus, in *Mackelcan* v. *Rennie*,(*c*) the patent related to "improvements in floating docks"; and the provisional specification stated: "I construct a pontoon or vessel of iron-framing, sheeted over entirely with *plate-iron*, so as to form an air-tight chamber subdivided into compartments." And the complete specification stated: "Having in a provisional specification described the nature of my invention, I will now proceed particularly to describe the same," and went on to explain the arrangement of parts, and the method of employing the dock, but said nothing about its being constructed of iron. The claim was "the arrangement and combination of all the parts of any floating dock as represented and described." It appeared at the trial that floating docks, constructed of timber, were well known before the patent, and that the plaintiff's invention consisted in constructing such docks of iron. There being, however, no

(*b*) (1866) L. R. 1 C. P. 192; 35 L. J. C. P. 200.
(*c*) (1862) 13 C. B. N. S. 52.

mention of iron in the complete specification, *Erle*, C.J., held that the provisional specification could not be produced in aid for the purpose of supplying a defect in the complete specification, and the plaintiff was nonsuited. The Court of Common Pleas refused a motion for a new trial, and approved the course the learned Chief Justice had taken in the Court below; and indicated an opinion that, even if the defect had been supplied, the alleged invention could not properly be the subject of a patent.

Provisional Protection.

It must not be forgotten that a provisional, like a complete, specification, must be accompanied by drawings, if required;(*d*) and from a consideration of the foregoing pages it will be apparent that great skill and care must be expended in the preparation of the instrument, so as to make it comprehensive enough to cover all that the patentee, after developing the discovery, may possibly wish to include and claim in the final and complete specification.

Drawings may be necessary.

Provisional Protection.—The Act of 1883 especially provides that where an application for a patent in respect of an invention has been accepted the invention may, during the period between the date of the application and the date of sealing such patent, be used and published without prejudice to the patent to be granted for the same; and such protection from the consequences of use and publication is in the Act referred to as provisional protection.(*e*)

Provisional protection is limited to consequences of publication.

This provisional protection only protects the patentee against the consequences of his own publication of the invention, and thus enables him to employ workmen and assistants in helping him to perform experiments and exercise the invention with a view to bringing it to a state of perfection before filing the complete specification.(*f*) It does not confer on the patentee any rights against the public, and it is expressly provided that he shall not institute any legal proceedings for infringements committed before the publication of the complete specification.(*g*)

The effect of filing the provisional specification is therefore to secure nine months provisional protection,(*h*) and the object of this protection evidently is to enable the patentee to perfect his invention by experiments which, although open and known, will not be a use and publication to the prejudice of letters

(*d*) 46 & 47 Vict. c. 57, s. 5, sub-s. 3. (*e*) 46 & 47 Vict. c. 57, s. 14.
(*f*) *Ex parte* Bates and Redgate, (1876) L. R. 4 Ch. 577.
(*g*) 46 & 47 Vict. c. 57, s. 13. (*h*) 46 & 47 Vict. c. 57, s. 8.

Variations between the Specifications.

patent to be afterwards granted, so that he may be in a condition to describe in the complete specification, as the result of experience, the best manner of performing the invention. It clearly appears, therefore, that the complete is in a sense supplemental to the provisional specification, not going beyond nor varying from it as to the nature of the invention, but conveying additional information, which may have been acquired during the currency of the provisional protection, as to the manner in which the invention is to be performed.(*i*)

The letters patent when granted bear date as of the day of application—*i.e.*, the date of the provisional specification in cases where the applicant avails himself of the advantages of filing a provisional specification.(*k*)

Variations between the Specifications.

What are legitimate developments.

Legitimate Developments of the Invention.—If the complete specification, filed as it must be after the provisional, describe and claim any invention different from that described in the provisional specification, it is evident that the patentee has never applied for a patent or received provisional protection in respect of that different invention, and the whole grant is void, because the specification claims that which has never been granted, and consequently that to which the patentee has no right—viz., the monopoly of the invention which differs from that described in the provisional specification.(*l*)

Lord *Blackburn*,(*m*) commenting on the effect of experiments and developments made during the period of provisional protection, pointed out that the proper process is to say: "Look at the nature of the invention described in the provisional specification, and say whether this which you have been doing, and which you say was a part of the patent, is fairly within the nature of the invention you have described, in that case you are protected; but if it is a new and separate invention and a different one, then you are not protected." The learned Lord also pointed out that it becomes pretty clear, when the nature of an invention has been described in the provisional specification, if something were found out during the period of pro-

(*i*) 46 & 47 Vict. c. 57, s. 8; p. 153 *ante*.
(*k*) See p. 331 *post*.
(*l*) Watling *v.* Stevens, (1886) 3 R. P. C. 151; Newall *v.* Elliott, (1863) 10 Jur. N. S. 955; 4 C. B. N. S. 269; Foxwell *v.* Bostock, (1863) 4 De G. J. & S. 298; Siddell *v.* Vickers, (1888) L. R. 39 Ch. D. 92; 5 P. O. R. 81, 416.
(*m*) Bailey *v.* Roberton, (1878) L. R. 3 App. Cas. 1074.

visional protection to make the invention work better, or with respect to the mode in which the operation may be performed —a thing which is very likely to happen when, in carrying out his invention, the inventor finds that some particular will not work as smoothly as he expected, and that it is necessary to supplement it—still the nature of his invention remaining the same, it is no objection that in the complete specification which comes afterwards the invention or application is described more particularly and in more detail, or even if it be shown that there has been more discovery made, so as to make the invention which he has described in the provisional specification really workable. If there is nothing more done than that, in the opinion of the learned Lord the patent is good, but as soon as it comes to be more than that, and the patentee says in the provisional specification "I describe my invention as A.," and in the complete specification "I hereby describe A. and also B.," then as far as regards B. it is void, because the patent was granted for the invention that was described in the provisional specification and does not cover the [*sic*, further] invention that is described in the other.(*n*)

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It will be seen hereafter (*o*) that, in such a case, so long as B. remains in the complete specification it renders the whole grant bad, but the defect is one which may be amended by excision, so as to secure to the patentee protection in respect of A.

Improvements in the arrangement of the machinery, of the relative position and adaptation of the different parts with a view of producing the same results, the substitution of mechanical equivalents and modifications and developments within the scope of the invention set out in the provisional specification, are allowable, and cannot be successfully relied on for the purpose of invalidating a patent on the ground of disconformity.(*p*)

Improvements in details.

If the provisional specification describe a method of carrying the invention into effect, and a totally different method is described in the complete specification, the latter document will not be void for disconformity, if the two methods are within the invention described in the two specifications.(*q*) The reason of this is that the patentee is bound to describe the

Better and different methods.

(*n*) See also Crampton *v.* Patents Investments Co., (1888) 5 R. P. C. 382, 393; Siddell *v.* Vickers, (1888) 5 R. P. C. 81, 426; Woodward *v.* Sansum, (1887) 4 R. P. C. 178.

(*o*) Chap. vi.

(*p*) Per Lopes, L.J., Woodward *v.* Sansum, (1877) 4 R. P. C. 178.

(*q*) Woodward *v.* Sansum, (1887) 4 R. P. C. 175; Lucas *v.* Miller, (1885) 2 R. P. C. 155; Moseley *v.* Victoria Rubber Co., (1887) 4 R. P. C. 241; Morgan *v.* Windover, (1887) 4 R. P. C. 422; 5 R. P. C. 295.

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best and latest method known to him of carrying out the invention.(*r*) It is not only his privilege, but his duty to do this, for the object of the complete specification, whether filed with the application or subsequently, is to tell the public how the invention is to be best carried out. "That is the price which the man who wants to be a patentee has to pay to the public for it."(*s*)

Legitimate development always a pure question of fact.

It is always a question of fact, to be determined with reference to the peculiar circumstances of each case, whether, when the complete specification differs from the provisional, the difference is merely a legitimate development and improvement made during the period of provisional protection, upon the invention foreshadowed by the provisional. Therefore, one case, though it may be a guide, is no authority for the decision of another case. In the note (*t*) at the foot of the page reference will be found to some important cases in which variations between the complete and provisional specifications have been held, upon the facts, to be merely legitimate developments and improvements.

Disconformity is a fatal objection to validity.

Disconformity.—The provisional specification, as appears from the foregoing pages, must contain a description of the invention for which the patentee desires protection, and though his description may be a mere rough outline, it is absolutely essential that it shall be honest, fair, explicit, and wide enough to comprise all that is described and claimed in the final specification when that instrument is filed, and, speaking generally, the two specifications ought not so to differ that the nature of the invention described in the one is materially different from that described in the other.(*u*)

This is expressed in the phraseology of modern practitioners

(*r*) p. 208 *post*.

(*s*) Per Lord Field, then Field, J., Crampton *v.* The Patents Investment Co., (1888) 5 R. P. C. 382; see 6 R. P. C. 287.

(*t*) Newall *v.* Elliott, (1858) 4 C. B. N. S. 269; 27 L. J. Ch. 337; Wright *v.* Hitchcock, (1870) L. R. 5 Ex. 37; 39 L. J. Ex. 97; Penn *v.* Bibby, (1866) L. R. 2 Ch. 127, 135; 36 L. J. Ch. 455; Lucas *v.* Miller, (1885) 2 R. P. C. 155; Watling *v.* Stevens, (1886) 3 R. P. C. 37; Horrocks *v.* Stubbs, (1886) 3 R. P. C. 221; Moseley *v.* Victoria Rubber Co., (1887) 4 R. P. C. 241; Garland and Gibbs' Patent, (1888) 5 R. P. C. 533; Crampton *v.* The Patent Investments Co., (1889) 6 R. P. C. 294; King, Brodie & Co. *v.* Anglo-American Brush Corporation, (1889) 6 R. P. C. 414; 9 R. P. C. 313; Gadd *v.* Mayor of Manchester, (1892) 9 R. P. C. 516; Miller *v.* Searle, (1893) 10 R. P. C. 106; Cassel Gold Extracting Co. *v.* Cyanide Gold Recovery Syndicate, (1895) 12 R. P. C. 232, 257; Pneumatic Tyre Co. *v.* East London Rubber Co., (1896) 14 R. P. C. 77; Automatic Coal Gas Retort Co. *v.* The Mayor, &c., of Salford, (1897) 14 R. P. C. 450; Pneumatic Tyre Co. *v.* Ixion Patent Pneumatic Tyre Co., (1897) 14 R. P. C. 853.

(*u*) Foxwell *v.* Bostock, (1863) 4 De G. J. & S. 298.

by saying that there must not be a disconformity between the specifications.

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Ever since the Patent Act of 1852, which first introduced provisional specifications, disconformity has been held to be a fatal objection to the validity of a patent. It was at one time urged by some that the operation of sec. 9 of the Act of 1883(*x*) which casts upon the Comptroller-General the duty of ascertaining whether the invention particularly described in the complete specification is substantially the same as that described in the provisional, was to render disconformity no longer an objection to the validity of the patent. This, however, is not so, for sec. 26 of the Act of 1883, which abolishes the proceeding by *scire facias* to repeal a patent, provides that "every ground on which a patent might, at the commencement of this Act, be repealed by *scire facias*, shall be available by way of defence to an action of infringement, and shall be a ground of revocation." Disconformity was one of the grounds on which a patent could be repealed by *scire facias* before the Act of 1883,(*y*) and therefore it is still fatal to the validity of a patent, and, as such, a defence to an action for infringement, and a ground on which a patent may be revoked on petition for revocation.(*z*)

The point has been decided substantially as above stated by the Court of Appeal, but it has not yet called for a direct decision of the House of Lords, though a dictum of Lord *Halsbury*, L.C., supports the conclusion of the Court of Appeal.(*a*)

Disconformity between an amended complete and a provisional specification.

If a specification is amended (*b*) and there is a disconformity between the complete and provisional specifications as they stand after amendment, the objection is still fatal.(*c*) An amended claim, however, when once allowed, even if it is for an invention substantially larger than or different to the invention originally claimed by the complete specification, will not vitiate the patent, provided that the invention comprised by the amended claim is to be found fairly foreshadowed and described within the provisional specification.(*d*)

In arriving at a conclusion as to the question of fact, Method of

(*x*) 46 & 47 Vict. c. 57, s. 9.

(*y*) Bailey *v.* Roberton, (1878) L. R. 3 App. Cas. 1055.

(*z*) See Nuttall *v.* Hargreaves, (1891) 8 R. P. C. 450; Vickers *v.* Siddell, (1890) 7 R. P. C. 292.

(*a*) See Vickers *v.* Siddell, (1890) 7 R. P. C. 292.

(*b*) See chap. vi. *post*.

(*c*) Lane Fox *v.* Kensington and Knightsbridge Electric Lighting Company, (1892) 9 R. P. C. 221, 413.

(*d*) See Moser *v.* Marsden, (1895) 13 R. P. C. 24; p. 260 *post*.

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deciding questions of fact as to disconformity.

whether in any particular instance there is a disconformity between two specifications, or is the alleged excess in the complete merely a legitimate development of the invention described in the provisional, it is well to consider separately the two questions: (1) What is the nature of the invention for which the patentee has obtained provisional protection—*i.e.*, what is the nature of the invention described in the provisional specification? (2) Is what is described in the complete specification an invention of a different nature from that described in the provisional? (*e*)

Thus, in a case where the proportions of the ingredients used in a process was not of the essence of the invention, and the complete specification stated and made a separate claim to definite suitable proportions, but the provisional did not refer to any specific proportion of the ingredients, the Court of Appeal held that there was no disconformity, since the proportions used in the process were not of the essence of the invention, and the real invention described in each specification was the same.(*f*)

The Acts of 1883 and 1888 (*g*) provide for the comparison of the complete specification with the provisional by an examiner at the Patent Office, and having regard to this fact the Courts do not decide against the validity of a patent on the ground of disconformity, unless the invention claimed by the complete specification is unmistakably different to that described in the provisional specification. "If a case is on the border line, the patent ought to be held good rather than bad."(*h*)

Effect of detailing advantages of the invention in the provisional specification.

The patentee is not bound in the provisional specification to detail the advantages of his invention. If he does detail advantages, all of which are present when the invention is used for one purpose which is principally referred to in the provisional specification, the fact that only some of those advantages are present when the invention is applied to another purpose mentioned in the complete specification, is not a sound argument to support the proposition that the second purpose is an illegitimate extension, and so renders the

(*e*) See Gadd *v.* Mayor of Manchester, (1892) 9 R. P. C. 526, 529; Cassel Gold Extracting Co. *v.* Cyanide Gold Recovery Syndicate, (1895) 12 R. P. C. 257.

(*f*) Cassel Gold Extracting Co. *v.* Cyanide Gold Recovery Syndicate, (1895) 12 R. P. C. 232, 257.

(*g*) 46 & 47 Vict. c. 57, s. 9; and 51 & 52 Vict. c. 50, s. 4.

(*h*) Per Lindley, L.J., Gadd *v.* Mayor of Manchester, (1892) 9 R. P. C. 527; in Chaburn *v.* Mechan, (1895) 12 R. P. C. 121. Romer, J., applied this principle to the facts of that case.

Variations between the Specifications.

patent bad on the ground of disconformity.(*i*) In the words of *Romer*, J., "A patented invention may, owing to subsequent discoveries of others, prove more valuable and have a wider field of usefulness than what was contemplated by the patentee at the time of his invention; and yet the patentee is entitled to the full benefit of the use of his invention if taken and applied for the purpose of those subsequent discoveries, and if the subsequent discoveries have taken place after the provisional and before the final specification, there would be nothing improper in the patentee referring to them in the final, and there showing the manner in which his invention could be best applied to them."(*k*)

And as pointed out by *Wills*, J., it is settled law that "so far as the objection of want of conformity is concerned, the patentee, merely by condescending to particulars in respect of the things which he has thought out, never loses the benefit of general expressions in the provisional specification as to matters which he has not thought out. Of course he may use words which may tie his hands afterwards to detail. But that is merely saying that his language may be such as to exclude an area which might otherwise be within more general phraseology."(*l*)

Illustrative cases in which patents were held bad for disconformity.

There are many instances in which patents have been rendered void because the patentee has in his final specification described and claimed inventions which the Courts have held were not included in the description given in the provisional specification.(*m*) The following two cases may be taken as illustrations of patents which have been so vitiated.

Bailey v. Roberton.

In *Bailey* v. *Roberton*, (1878) L. R. 3 App. Cas. 1055, the patent related to a method of preserving meat. The patentees in the provisional specification stated: "We dissolve the ordinary commercial gelatine in boiling water, using about 2 lbs. of gelatine to 10 lbs. of water. We then add, while hot, a volume equal to the volume of solution of gelatine of a solution of bisulphite of lime (CaO_2SO_2) in water of about the specific

(*i*) Pneumatic Tyre Co. *v.* East London Rubber Co., (1896) 14 R. P. C. 77, 99.

(*k*) Pneumatic Tyre Co. *v.* East London Rubber Co., (1896) 14 R. P. C. 101.

(*l*) Pneumatic Tyre Co. *v.* Ixion Patent Pneumatic Tyre Co., (1897) 14 R. P. C. 869.

(*m*) See Bailey *v.* Roberton, (1878) L. R. 3 App. Cas. 1055; United Telephone Co. *v.* Harrison, (1882) L. R. 21 Ch. D. 743; Horrocks *v.* Stubbs, (1885) 3 R. P. C. 233, 236; Hutchison *v.* Patullo, (1888) 5 R. P. C. 351; King, Brown & Co. *v.* Anglo-American Brush Corporation, (1889) 6 R. P. C. 414; Lane Fox *v.* Kensigton Electric Lighting Co., (1892) 9 R. P. C. 221, 413; Cera Light Co. *v.* Dobbie, (1892) 11 R. P. C. 10; Magee *v.* Tangyes, (1897) 14 R. P. C. 255; Brooks *v.* Lamplugh, (1897) 15 R. P. C. 33.

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gravity ·1070. While the solution of gelatine and bisulphite of lime is still warm and liquid, we coat the substance to be preserved with it, either by dipping the substance in it, or by brushing it over with two or three coats of the solution." The complete specification described a solution consisting of bisulphite of lime alone, and laid claim to the use of this solution by itself for preserving animal substances. The House of Lords held that the patent was invalid on the ground that the claim to the use of bisulphite of lime alone was not foreshadowed by the provisional specification. Lord *Cairns*, L.C., pointed out that it could not be doubted that the invention, which those who wrote out the provisional specification conceived, was not an invention merely of the chemical application of bisulphite of lime to animal substances, such as meat and fish, but was a mode of applying a coating or film to the outside of animal substances, which coating or film was to consist of gelatine, or some substance of the same kind mixed with a solution of bisulphite of lime. The patentees could only claim the use of the solution of bisulphite of lime separately by claiming an invention through the medium of the complete specification which was not mentioned in the provisional specification, and as to the mode of exercising or applying which they could not, in that specification, point out any claim, or any information given to the public.

United Telephone Co. *v.* Harrison.

In *United Telephone Co.* v. *Harrison*, (1882) L. R. 21 Ch. D. 743, *Edison's* patent for the telephone under the title "improvements in instruments for controlling by sound the transmission of electric currents, and the reproduction of corresponding sounds at a distance," was held invalid by *Fry*, J., and afterwards by the Court of Appeal. One of the grounds for so holding was the fact that the final specification described and claimed the phonograph whilst it was not disclosed in the provisional specification, although it was admitted that portions of the provisional specification explained, or might be held to refer to, an instrument like the phonograph. *Fry*, J., after stating the fact that *Edison* had discovered an instrument of the highest ingenuity, the phonograph, which is purely mechanical, and has nothing to do with electric or magnetic science, and nothing necessarily to do with the transmission of sound to a distance, observed: "Has that remarkable invention so made by *Edison* been in any manner described in the provisional specification? . . . . Now, no doubt some of these words do explain or might be held to refer to an instrument like the phonograph, but when I ask myself whether they in any manner describe the nature of the invention, I am bound to say that they do not. . . . . I agree that the provisional specification need not

describe the manner in which an invention is to be carried into effect—I agree that it need not describe the nature of the invention otherwise than roughly; but it ought to do so fairly and honestly; and if Mr. *Edison* was at the time at which these letters patent were granted in possession of that very remarkable mechanical invention by which speech could be reproduced, not necessarily at a distance, but in the same room as that in which it was uttered, I do not think the provisional specification was an honest statement of the nature of the discovery. On that ground I come to the conclusion that Mr. *Edison's* patent cannot be upheld."

Variations between the Specifications.

The following cases may be taken as instances among many reported cases(*n*) in which the objection of disconformity was not sustained.

Illustrative cases in which the objection of disconformity failed.

Newall v. *Elliott*, (1858) 4 C. B. N. S. 269; 27 L. J. C. P. 337, was a case in which the validity of *Newall's* patent for "improvements in apparatus for laying down submarine telegraph wires" was questioned on the ground of disconformity. The provisional specification described the nature of the invention in the following words: "The cable or rope containing this insulated wire or wires is passed round a cone, so that the cable, in being drawn off the coil, is prevented from kinking by means of the cone, and there is a cylinder on the outside which prevents the coil from shifting in its place." The complete specification, besides containing words to the above effect, continued the description in the following terms: "When the cable is to be laid down I place over the cone an *apex* or top which is conoidal, as shown (the drawing showed a short conoidal head placed on the flat top of the truncated cone) and around this I suspend *several rings* of iron by means of cords, so as to admit of adjustment at various heights over the cone. The use of these rings is to prevent the bight of the rope from flying out when going at a rapid speed. The two rings nearest the coil are lowered to about six and twelve inches respectively from the coil (the drawing showed four rings arranged in gradations

Newall v. Elliott.

(*n*) See Newall *v.* Elliott, (1858) 4 C. B. N. S. 269; 27 L. J. C. 337; Wright *v.* Hitchcock, (1870) L. R. 5 Ex. 37; 39 L. J. Ex. 97; Penn *v.* Bibby, (1875) L. R. 2 Ch. 127, 135; Lucas *v.* Millar, (1885) 2 R. P. C. 155; Watling *v.* Stevens, (1886) 3 R. P. C. 42; Moseley *v.* Victoria Rubber Co., (1887) 4 R. P. C. 241; Gaulard and Gibbs' Patent, (1888) 5 R. P. C. 533; Horrocks *v.* Stubbs, (1886) 3 R. P. C. 221; King, Brown & Co. *v.* Anglo-American Brush Corporation, (1889) 6 R. P. C. 414; Crampton *v.* The Patent Investment Co., (1889) 6 R. P. C. 294; Gadd *v.* Mayor of Manchester, (1892) 9 R. P. C. 249, 516; Miller *v.* Searle, (1893) 10 R. P. C. 106; Cassel Gold Extracting Recovery Co., (1895) 12 R. P. C. 232, 257; Pneumatic Tyre Co. *v.* East London Rubber Co., (1896) 14 R. P. C. 77; Pneumatic Tyre Co. *v.* Ixion Patent Pneumatic Tyre Co., (1897) 14 R. P. C. 853.

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of size, the smallest being at the top, and acting as a mouthpiece, for the exit of the cable which was thus carried close over the conoidal top of the cone)." The claims included one for the use of rings in combination with a cone as described. The matters in dispute were referred to an arbitrator, who made an award, and stated a special case for the opinion of the Court, in which one of the questions for decision was: "Whether there was a fatal variance between the provisional and complete specification, in that the former omitted all mention of the rings claimed by the latter document." The Court gave judgment for the plaintiff, and the judgment of *Byles*, J., contained the following passage: "The second objection was, that the provisional specification contained no mention of the rings claimed in the full specification. But the office of the provisional specification is only to describe generally and fairly the *nature* of the invention, and not to enter into all the minute details as to the manner in which the invention is to be carried out; otherwise the provisional specification must be as full as the complete specification, and drawn with as much care and deliberation. Indeed, the statute itself (*o*) indicates this distinction between the provisional and the final specification; for it calls the latter the *complete* specification, implying that the former is, or legally may be, in some respects executory and incomplete. Moreover, it enacts (sec. 6) that the provisional specification is to describe the *nature* of the invention and no more; but when the statute comes to speak of the complete specification its language is altogether different; it enacts (sec. 9) that the complete specification shall describe not only the nature of the invention, but also the manner in which it shall be performed, and not describe but particularly ascertain it. We, therefore, think that this provisional specification in the case under consideration sufficiently describes the nature of the invention, though it does not enter into a detail of all the means by which it is to be accomplished."

Wright *v.* Hitchcock.

In *Wright* v. *Hitchcock*, (1870) L. R. 5 Ex. 37; 39 L. J. Ex. 97, the patent was for "improvements in the manufacture of frills or ruffles, and in the machinery or apparatus employed therein." The provisional specification stated: "The invention relates to a peculiar manufacture of frills and ruffles, and to a peculiar combination of mechanism," &c., whilst the complete specification stated: "The invention relates to a peculiar manufacture of frills, ruffles, or *trimmings*, and to a peculiar combination of mechanism to be applied to a sewing machine for producing the same." It was objected on behalf of the defendants that there was an inconsistency between the provisional

(*o*) 15 & 16 Vict. c. 83; *cf.* 46 & 47 Vict. c. 57, s. 5.

Complete Specification.

and final specification, the word *trimming* being added in the latter. *Kelly*, C.B., overruled this objection, and held that by whatever name it was described the thing was in substance identical.

Pneumatic Tyre Co. v. East London Rubber Co.

In *Pneumatic Tyre Co.* v. *East London Rubber Co.*, (1896) 14 R. P. C. 77, 573, which related to an infringement of *Welch's* invention of the method of securing a tyre to a bicycle rim by means of inextensible rings or rims, it was objected that the provisional specification did not describe that the invention was intended to relate to a pneumatic tyre, or a cover for a pneumatic tube or tyre, or for affixing a pneumatic tube or its cover to a wheel rim. It was also alleged that the inventions set out and claimed in certain claiming clauses, which related to pneumatic tyres, were inventions none of which were disclosed or hinted at in the provisional and were not legitimate developments of anything disclosed in the provisional.

These objections were overruled, both by the Court of first instance and the Court of Appeal on the ground that the real nature of the invention was sufficiently described in the provisional, and the use of it with pneumatic tyres as claimed in the complete specification was a legitimate development sufficiently hinted at in the provisional. As was pointed out by *Lindley*, L.J., (14 R. P. C. 581) it is easier to ascertain the nature of an invention from a complete specification, which shows how it is to be applied, than from a provisional specification which describes the nature of an invention in general language, but which seldom shows how it is to be performed.

The Complete Specification.

Object of complete specifications.

The Patents, &c., Act 1883, like the previous Act of 1852, enacts that the patentee shall in the complete specification *particularly* describe and ascertain the nature of the invention, and in what manner it is to be performed, and further requires that this instrument shall be accompanied by drawings if necessary.(*p*)

The patentee is required to *particularly* describe and ascertain the nature of his invention, so that the public may know what they are prohibited from doing without his leave or licence, during the continuance of the patent; and he is required to state in what manner the invention is to be performed, in order that the rest of the public may, when the patent expires, be

(*p*) s. 5, sub-s. 41; see P. R. 1890.

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able to put the invention into practice, and thus enjoy the benefit of the discovery.(*q*)

In fact, upon the view that letters patent are virtually a bargain between the Crown and the public, the price which the patentee pays for his monopoly is the fulfilment of the obligation he is under of lodging such an account of his discovery as will enable the public at the expiration of the time for which the grant is made to have as free and unreserved use of the invention as he himself.(*r*)

The title and provisional specification(*s*) are sufficient if they give a mere rough and incomplete description of the invention; from them the public, except in the case of very simple inventions, obtain but little information of the real nature of the manufacture they are prohibited from using, and unless some specific and detailed information were given respecting what they are commanded by the terms of the grant to refrain from doing, during the continuance of the monopoly, it would be unfair to punish them for any violation of the patent right committed without the means of ascertaining its nature and extent.

It is apparent that, in every case in which an action for infringement is brought against a member of the public in respect of a particular patent, it is necessary to ascertain whether the act complained of is described in the complete specification, and claimed by implication, or otherwise, and whether the exclusive privilege of carrying out that particular operation is conferred upon the patentee.

If the specification does not sufficiently describe some art of manufacture which is substantially the same as that used by the alleged infringer, no action lies against him.

Complete specification is generally a difficult document to draft.

The complete specification requires the exercise of the greatest skill and care in drafting it, and is by no means easy to draw. The reason of this is that the conditions and tests which the law requires the document to satisfy are very numerous, and a failure in any one of them will not only make the specification bad, but will render the whole grant void.

It must be borne in mind that the object for which the complete specification exists is to give sufficient and complete information to the public of what they are prohibited from doing,

(*q*) Young *v.* Rosenthal, (1884) 1 R. P. C. 31; Macfarlane *v.* Price, (1816) 1 Stark. N. P. 201; Allen *v.* Durkett, (1893) 10 R. P. C. 397.

(*r*) Gibson *v.* Brand, (1842) 1 W.P.C. 627; 4 M. & G. 179; 4 Scott, N. R. 844; 11 L. J. C. P. 177; Wood *v.* Zimmer, (1815) Holt, N. P. 58; 1 W. P. C. 82 n.

(*s*) p. 161 *ante*.

without the sanction of the patentee, during the continuance of the patent, and what they will be able to do after it has expired.

Complete Specification.

The conditions which the law requires the complete specification to satisfy may be conveniently considered under the following heads:—

Requisites of complete specification.

I. The complete specification must be framed with the utmost good faith, and must not contain any false representation or misdescription of the invention or any material part of it, or otherwise mislead the public.

II. The complete specification must not be framed in ambiguous language, but must be as clear and concise as the nature of the subject will admit.

III. The complete specification must be intelligible to an ordinary workman, possessing the ordinary skill and knowledge of that branch of the useful arts to which the invention relates. It is not required to describe the invention and the manner in which it is to be performed so fully as to instruct persons wholly ignorant of the subject-matter.

IV. The complete specification must particularly describe and ascertain the nature of the invention and how the same is to be performed.

V. The complete specification need not describe any step or process which is necessarily implied.

VI. The complete specification need not describe minutely any known thing to which it refers.

VII. The complete specification need not describe the particular shape of any article or part, if the form thereof is not of the essence of the invention.

VIII. The complete specification must describe the best method known to the patentee of performing the invention and all his knowledge relating thereto, including that which he may have acquired during the period of provisional protection prior to the date of filing the complete specification.

IX. The complete specification need not mention everything which will produce the desired result, or every mode of performing or applying the invention.

X. If the complete specification describe anything which is not new, it must clearly distinguish that which is old from that which is new, and claim only the latter.

Complete Specification.

I. *The complete specification must be framed with the utmost good faith, and must not contain any false representation or misdescription of the invention, or any material part of it, or otherwise mislead the public.*

Patent a bargain with the public.

A patent may be considered as a bargain with the public, and the specification ought to be construed on the same principle of good faith as that which regulates all other contracts.(*t*) If any statement in the specification turn out to be untrue, or of a nature calculated to mislead or puzzle the public, the grant of the letters patent will thereby be rendered void, either on the ground that the untruth is part of the representation on the strength of which the grant was made, or that the patentee has not properly described and ascertained the nature of the invention and in what manner the same is to be performed.

Must not mislead by commission.

As stated by *Buller*, J., in *R.* v. *Arkwright*,(*u*) and acted upon by many Judges since, if the specification, in any part of it, be materially false and defective, the patent is against law and cannot be supported. Further, if certain things mentioned in the specification are of no use, and merely thrown in to puzzle, the patent is equally void.

If there is anything introduced into the specification which tends to mislead the public, or if the process as directed by the specification does not produce that which the patent professes to do, the patent itself is void.(*x*) Also if the patentee can make the article, which is the subject of the patent, with two or three of the ingredients specified, and he insert others which will not produce the effects stated, the patent will be void.(*y*)

or omission.

Further, if the patentee suppress anything, or mislead, his specification is bad—*e.g.*, if he say there are many modes of doing a thing, when in fact there is only one, this will avoid the patent. If he maintain that as an essential ingredient in the patent article which is not so, nor even useful, and thereby misleads the public, his patent may be void.(*z*)

Must not describe methods which will not answer.

Again, if the specification describes and claims two ways of doing a thing, and it turns out that by one of the ways specified

(*t*) Per Lord Eldon, Cartwright *v.* Eamer, (1890) 14 Ves. 131, 136; Sturz *v.* De la Rue, (1828) 5 Russ. 322; 7 L. J. O. S. Ch. 47.

(*u*) (1785) Dav. P. C. 61; 1 W. P. C. 64.

(*x*) Turner *v.* Winter, (1787) 1 T. R. 602; 1 W. P. C. 77; Palmer *v.* Wagstaff, (1853) Newtens' L. J. vol. xliii. p. 131.

(*y*) *Ibid*; see Bickford *v.* Skewes, (1838) 1 W. P. C. 211.

(*z*) Lewis *v.* Marling, (1829) 1 W. P. C. 493.

Complete Specification.

it cannot be done,(*a*) or that one of the alternatives is not new,(*b*) the specification is bad and the patent void. So also if the patentee, misled by theory, describes and claims as an essential step in a process—*e.g.*, a chemical process—the production of something which is in fact an impossibility, the patent is void.(*c*)

Distinction between a false description; and a claim to something useless.

A false description of a method of performing the invention, or a part of it, must not be confused with a claim to something which turns out to be useless. In the latter case, if the useless part is a non-essential, the patent may be perfectly good, notwithstanding the claim ;(*d*) but in the former the patent cannot be sustained.

Thus in *Neilson* v. *Harford*,(*e*) *Parke*, B., at the trial, said that his strong opinion, as then advised, was that a certain statement in the specification was incorrect and untrue, and that it being clearly untrue, it vitiated the specification, and prevented the patent from being a good patent. The jury, by their verdict, agreed with the view the learned Baron took of the statement in question; but the Court of Exchequer, of which he was also a member, construed it differently, and *Parke*, B., is reported to have said :—(*f*)

> "At the trial, I construed this passage as meaning that the shape was immaterial to the degree of effect in making the blast; and, if this were so, the jury having by their finding negatived the truth and accuracy of this statement, the specification would be bad, as containing a false statement in a material circumstance of a nature that, if literally acted upon by a competent workman, would mislead him, and cause the experiment to fail. . . . . But my Lords and my brothers, after considerable hesitation, are of opinion that a construction may be reasonably put upon this clause which will support the patent; and though I myself still entertain great doubt whether such is the true construction, I am not prepared to say that it is not."

In *Savory* v. *Price* (*g*) the patent was for the "invention of a neutral salt, under the name of *Seidlitz* powder," and the

(*a*) Beard *v.* Egerton, (1846) 2 Car. & K. 667 ; 3 C. B. 97 ; 8 C. B. 165 ; 15 L. J. C. P. 270 ; 19 L. J. C. P. 36 ; R. *v.* Cutler, Macr. P. C. 137 ; Savory *v.* Price, (1823) Ry. & M. 1 ; 1 W. P. C. 83 ; Kurtz *v.* Spence, (1888) 5 R. P. C. 161, 184.

(*b*) Pether *v.* Shaw, (1893) 10 R. P. C. 293.

(*c*) Monnet *v.* Beck, (1897) 14 R.P.C. 777.

(*d*) R. *v.* Cutler, (1816) Macr. P. C. 137 ; Lewis *v.* Marling, (1829) 10 B. & C. 22 ; 1 W. P. C. 493.

(*e*) (1841) 1 W. P. C. 313 ; 8 M. & W. 806.

(*f*) (1841) 1 W. P. C. 371.

(*g*) (1823) Ry. & M. 1 ; 1 W. P. C. 83.

Complete Specification.

specification, to the misleading of the public, set out three distinct recipes for making the ingredients of the powder—viz., (1) Rochelle salt (*i.e.*, a double tartrate of potash and soda); (2) carbonate of soda; (3) tartaric acid—all of which were well-known substances before the date of the patent and readily procurable. The specification further and properly stated the proportions in which these ingredients were to be mixed for compounding the *Seidlitz* powder. The plaintiff was nevertheless nonsuited, *Abbott*, C.J., saying:—

> "It is the duty of any one to whom a patent is granted to point out the plainest and most easy way of producing that for which he claims a monopoly, and to make the public acquainted with the mode which he himself adopts. If a person, on reading the specification, would be led to suppose a laborious process necessary to the production of any one of the ingredients, when in fact he might go to a chemist's shop and buy the same thing as a separate simple part of the compound, the public are misled. If the results of the recipes, or of any of them, may be bought in shops, this specification, tending to make people believe an elaborate process essential to the invention, cannot be supported."

Must not give problems.

As has been said by *Jessel*, M.R.: "You must not mislead people by telling them to do something wrong, and leaving them to find out the mistake. . . . You must not give people mechanical problems and call them specifications."(*h*)

It is to be observed that the patent might also have been declared void on the further ground that the patentee had not disclosed the best and most economical method of performing the invention with which he was acquainted.(*i*)

The invention described must be useful for the object stated.

It is also a fatal defect if the invention is not useful for the purpose for which the patentee says it is useful. The question always is, Does the invention really do when put in practice by a competent man what the patentee states it will do?(*k*)

If the specification contain what amounts to a false suggestion on the part of patentee—*e.g.*, if the title be "a machine for sharpening knives, scissors, and razors," and the body of the specification disclose only a machine which will sharpen knives;(*l*) or if the specification give only an insufficient

(*h*) Plimpton *v.* Malcolmson, (1875) L. R. 3 Ch. D. 576; see also Lewis *v.* Stirckler's Patent, (1897) 14 R. P. C. 24, 36.

(*i*) See p. 205 *post*.

(*k*) Morgan *v.* Seaward, (1836) 1 W. P. C. 185; Badische Anilin und Soda Fabrik *v.* Levinstein, (1887) 4 R. P. C. 462; Easterbrook *v.* Great Western Railway Co., (1885) 2 R. P. C. 210; 3 R. P. C. 94; Fawcett *v.* Horman, (1896) 13 R. P. C. 268, and cases following in the text; pp. 181–182 *post*.

(*l*) Felton *v.* Greaves, (1829) 3 C. & P. 611.

description of the invention and the manner of performing it, the patent will in each case be equally bad. In the former it will be void on the same principle that an ordinary grant of lands or tenements from the Crown is by a false suggestion of the grantee rendered inoperative, not merely against the Crown, but in a suit against a third person ;(*m*) and in the latter it will be bad, because the statutory requirements have not been complied with.(*n*) But a statement in a specification to the effect that an invention is applicable to other purposes than that specified will not vitiate the patent, as there is no objection to a patentee stating that what he has invented with reference to one particular machine may be applicable to other machines.(*o*) A statement in a specification to the effect that a certain thing is important which is in fact not so,(*p*) or that something is immaterial which is in reality material,(*q*) will, it is submitted, amount to an attempt to deceive, and so render the patent void. Complete Specification.

The following cases illustrate the application of the principles stated in the last paragraph. Illustrative cases.

Bloxam v. *Elsee*, (1825) 6 B. & C. 169; 1 C. & P. 558, is an instance of a specification which was rendered void, because the patentee thereby represented that the machine described was capable of doing more than it really could do—viz., making paper of different widths, whereas it was in reality only suited to paper of one definite width. And in *Crossley* v. *Potter*, (1825) Macr. P. C. 240, a patent was declared bad on the ground that the specification represented that the machine as described was applicable to the weaving of carpets as well as of coach lace, whereas such was not in reality the case. The direction of *Pollock*, C.B., to the jury contained the following instructive passage: "In my mind, the safest course for patentees to adopt in framing their specifications is, instead of including everything, to confine themselves specifically to one good thing; and a jury will always take care that, if it be a real invention, no man, under colour of improvement, shall be allowed to interfere with that which is the offspring of their genius." Bloxam v. Elsee.

In *R.* v. *Metcalf*, (1817) 3 Car. & P. 611, the patentee, both in the title and body of the specification, described the object for which the patent was obtained to be the manufacture of "a R. v. Metcalf.

(*m*) Travell *v.* Carteret, 3 Lev. 135; Alcock *v.* Cooke, 5 Bing. 340; Morgan *v.* Seaward, (1837) 2 M. & W. 544.

(*n*) See 1 W. P. C., and cases there referred to.

(*o*) Cole *v.* Saqui, (1888) 5 R. P. C. 494, *cf.* p. 236 *post*.

(*p*) Huddart *v.* Grimshaw, (1803) 1 W. P. C. 85.

(*q*) Neilson *v.* Harford, (1841), 1 W. P. C. 313.

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tapered hair or head brush," and the method of manufacture to consist in cutting hair in lengths of about one inch and a quarter, and then mixing it by hand and shaking it together as unevenly as possible, and finally attaching the hairs so cut and mixed to the stock by means of wires. At the trial it appeared that the patented brushes had bristles of unequal length mixed indiscriminately together. Lord *Ellenborough*, C.J., held that the invention was improperly described, and said: "Tapering means gradually converging to a point. According to the specification the bristles would be of an unequal length, but there would be no tapering to a point which the description assumes. If the word 'tapering' be used in its general sense, the description is defective—there is no converging to a point. If the term has had a different meaning annexed to it by the usage of trade, it may be received in its perverted sense. At present, however, I cannot hold out any prospect that the difficulty arising from the grammatical consideration can be removed." After further evidence his Lordship advised the jury to find that it was not a *tapering*, but only an unequal brush, which they accordingly did. A rule for a new trial was refused.

Felton *v.* Greaves.

In *Felton* v. *Greaves*, (1829) 2 Stark. N. P. 249, the plaintiff had obtained his patent for "a machine for an expeditious and correct mode of giving a fine edge to knives, razors, scissors, and other cutting instruments," and it appeared that the invention, which was stated in the specification to consist in a machine for sharpening various cutting instruments by passing their cutting edges backward and forward in the angle formed by the intersection of two or more circular files in the manner explained, was suitable for sharpening knives, but it would not do for sharpening scissors. The files were stated to be in the form of cylinders, and at the trial it appeared in evidence that in order to adapt the instrument to the sharpening of scissors it was necessary to have one of them smooth, which the specification did not describe, and Lord *Tenterden*, C.J., on this ground directed a nonsuit.

Bainbridge *v.* Wigley.

In *Bainbridge* v. *Wigley*, (1810) Parl. Rep. 192; 1 Carp. P. C. 270, the specification stated that the invention consisted in certain improvements in the English flute, whereby the fingering was rendered more easy and certain notes produced that were never before produced, whilst it appeared in evidence that, as a matter of fact, only one new note was produced. Lord *Ellenborough* held that this was fatal to the patent, the consideration on which it was granted not being truly set forth. The patentee had stated that, by his improvement, he gave new notes, when in fact he had given but one new note.

Complete Specification.

II. *The complete specification must not be framed in ambiguous language, but must be as clear and concise as the nature of the subject will admit.*

Must be clear and unequivocal.

It is incumbent on the patentee to give a specification of the invention in the clearest and most unequivocal terms of which the subject is capable, and if it appears that there is any unnecessary ambiguity affectedly introduced into the specification, or anything which tends to mislead the public, in that case the patent is void. . . . . It is certainly of consequence that the terms of a specification should express the invention in the clearest and most specific manner; so that the persons to whom it is addressed may be able to produce the thing intended, without the necessity of trying experiments,(*r*) and, as was pointed out by *Dallas*, L.C.J.,(*s*) if the instrument contains an ambiguity in a material point that is a ground on which it may be avoided altogether.

Perfect precision in language is not possible.

Absolute or perfect precision in the language of the specification is impossible, and cannot therefore be required. It will be quite sufficient if the document is comprehensible to the ordinary workman in the trade to which the invention relates.

The following remarks of *Grove*, J., are instructive upon this point:—

> "Every word I give will be open to exception, and no human being probably could criticise my language more than I could myself, if I were to sit upon it, because I am one of those who believe that there is no form of words which can be used with such accuracy as to exclude every other conclusion but the one which the speaker or the writer intends to express. I have never yet seen any form of words, even of moderate length, upon which a person reading it in an adverse spirit might not put a different conclusion from that which the author intends, and those who have written books, or have had to deal with drawing legal documents, or other matters of that sort, know how impossible it is to give any definition, or use any form of words, which may not be excepted to." (*t*)

If there is a want of clearness in the specification, so that the public cannot afterwards avail themselves of the invention,

(*r*) Per Ashurst, J., Turner *v.* Winter, (1787) 1 T. R. 602; 1 W. P. C. 77; but see p. 189.

(*s*) Campion *v.* Benyon, (1821) 6 B. Moo. 71; 3 Brod. & B. 5.

(*t*) Philpot *v.* Hanbury, (1885) 2 R. P. C. 38; see also Boulton *v.* Bull (1795) Dav. P. C. 216; Arkwright *v.* Nightingale, (1785) Dav. P. C. 37.

Complete Specification.

and if there is any studied ambiguity in it, so as to conceal from the public that of which the patentee is, for a term, enjoying the exclusive benefit, the patent itself will be completely void.(*u*)

Must not include what will not as well as what will answer.

Again, if the specification, in describing any materials or ingredients which are necessary for the purpose of carrying out the invention, uses language wide enough to include what is unsuitable as well as what is suitable for the purpose, the ambiguity will be fatal.(*x*)

It must not, however, be forgotten that the meaning of words is liable to change with the progress of science and discovery, and a term which, for the purpose of the specification, is sufficiently accurate, may, in future years, include that which will not answer the purpose the patentee has in view. In such a case the specification will be read with reference to the state of knowledge at the time it was prepared, and if the term used include nothing *then* known that would not answer, it will not be held to be ambiguous, though the use of the same term subsequently might be.(*y*) This is only equitable, for a patentee is not entitled to a monopoly of ingredients and materials unknown at the date of the specification, even though the language used be sufficiently wide to include them.(*z*) It would be manifestly unfair to hold that language which, by the advance of knowledge, has come to include more than the patentee contemplated should vitiate the grant.

Thus, for instance, when the directions given in a specification for the preparation of the article, which is the subject-matter of the patent, necessitate the use of a practically chemically pure substance, and, at the date of the patent, the person to whom the specification is addressed would, by using the knowledge of the period, obtain the substance sufficiently pure and would succeed, it is no valid objection to the utility of the invention and the sufficiency of the specification that, at a subsequent date, the same person using the *then* commercial

(*u*) Per Tindal, C.J., Galloway *v.* Bleaden, (1839) 1 W. P. C. 521.

(*x*) Ralston *v.* Smith, (1865) 9 C. B. N. S. 117; 11 C. B. N. S. 471; 11 H. L. Cas. 223; Booth *v.* Kennard, (1857) 2 H. & N. 84; Haworth *v.* Hardcastle, (1834) 1 W. P. C. 484; Saunders *v.* Aston, (1832) 3 B. & Ad. 881, 886; 1 W. P. C. 75 n.; Kurtz *v.* Spence, (1888) 5 R. P. C. 161; Stevens *v.* Keating, (1848) 2 W. P. C. 194; Muntz *v.* Foster, (1844) 2 W. P. C. 109; Hills *v.* London Gas Light Co., (1857) 5 H. & N. 312; 27 L. J. Ex. 60; 29 L. J. Ex. 409; Bailey *v.* Roberton, (1878) L. R. 3 App. Cas. 1070.

(*y*) Badische Anilin und Soda Fabrik *v.* Levinstein, (1883) L. R. 24 Ch. D. 156; 12 App. Cas. 410; 4 R. P. C. 449; Crossley *v.* Beverley, (1829) 3 Car. & P. 513; 1 W. P. C. 112.

(*z*) Tetley *v.* Easton, (1852) Macr. P. C. 77; 18 C. B. 643; 25 L. J. C. & P. 293.

article (*which has only come into existence as a commercial product after the date of the patent*) would fail.(*a*)

In *Wegmann* v. *Corcoran* (*b*) the Court of Appeal upheld a decision of the Court below, which declared a patent for an improved machine or apparatus for treating or preparing meal void on the ground of the ambiguity of the language used by the specification. The patentee stated that the squeezing rollers of the improved machine were to have "a surface consisting of a material containing so much silica as not to colour the meal or flour," and went on to say that he preferred to make them of "iron coated with china, and finely turned with diamond tools." It was proved in evidence that there are two kinds of china—Oriental or Chinese china, containing 73 per cent. of silica, and very hard, and the china usually made in this country, containing only about 40 per cent. of silica, and much softer. The evidence also established that the first kind of china would answer the purpose, but the second would not, and that the invention was useful in milling operations. The Courts held that the specification was bad, as being ambiguous and inadequate, in so far as it did not state what kind of china was to be employed.

It is always a question for the jury, or the Court acting as a jury, to say whether or not the specification describes with sufficient accuracy the ingredients or materials which the patentee directs to be used,(*c*) but a patentee is not obliged, in referring to materials and ingredients, to enter into minute details as to them if they are known in commerce and can be readily procured under the names which he gives them.(*d*) The names of articles mentioned must be taken to be used in their ordinary commercial sense.(*e*)

The specification of *Medlock's* patent for improvements in the preparation of red and purple dyes directed the use of *dry* arsenic acid in a part of the process, and this was held by Lord *Westbury*, L.C., to refer to the ordinary arsenic acid of commerce (which is dry to the touch, although it contains water of

(*a*) Incandescent Gas Light Co. *v.* De Mare Incandescent Gas Light System, (1896) 13 R. P. C. 324, 326.

(*b*) (1879) L. R. 13 Ch. D. 66.

(*c*) Bickford *v.* Skewes, (1837) 1 W. P. C. 214; Derosne *v.* Fairie, (1835) 1 W. P. C. 154; Elliott *v.* Turner, (1845) 2 C. B. 446; Wallington *v.* Dale, (1852) 7 Exch. 888.

(*d*) MacIntosh *v.* Everington, 2 Carp. R. 180, 191.

(*e*) Simpson *v.* Holliday, (1864) 2 Newton, L. J. 118; 5 N. R. 340; L. R. 1 H. L. 315; 35 L. J. Ch. 811; Stevens *v.* Keating, (1847) 2 W. P. C. 183, 187; 19 L. J. Ex. 57; Muntz *v.* Foster, (1844) 2 W. P. C. 104; Sturz *v.* De la Rue, (1828) 1 W. P. C. 83; 5 Russ. 327; Badische Anilin und Soda Fabrik *v.* Levinstein, (1883) L. R. 24 Ch. D. 156; 12 App. Cas. 710; (1887), 4 R. P. C. 449.

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hydration), which would answer, and not to the anhydrous form, which would not answer;(*f*) but in a case where the specification directed the use of "the finest and purest chemical white lead," and it appeared in evidence that there was no substance known in the trade by that name, but that white lead only was known, the specification was held to be defective on the ground of ambiguity.(*g*)

E.g., proportions.

In the case of an invention of a new use of known substances in new proportions,(*h*) the patentee in his complete specification is bound to state the most suitable proportions within his knowledge,(*i*) but he is not obliged to limit his claim to the precise proportions mentioned.(*k*) Though proportions of substances used may be of importance, yet if the proportions specified as an instance yield good and satisfactory results, the fact that different proportions yield results differing in utility is not a fatal objection to the sufficiency of the specification.(*l*) If on the true construction proportions are claimed which will not yield without further experiment and discovery the result aimed at by the patentee, the patent is bad for insufficiency of the specification.(*m*) On the other hand, if the specification on its true construction is limited to certain definite proportions of the ingredients used, then, no doubt, it is no infringement to use proportions outside the limits stated.(*n*)

In *The Patent Type Founding Co.* v. *Richards*(*o*) the patent was for "improvements in the manufacture of type," and the specification stated "the object of the invention is to make type harder, tougher, and more enduring, by employing tin in large proportions with antimony, and to greatly reduce or omit the use of lead. The best proportions I am acquainted with are seventy-five of tin and twenty-five of antimony, but this may be to some extent varied; and when lead is also used I find that it must not exceed fifty parts in one-hundred of the combined metals employed."

Wood, V.C., overruled a demurrer on the ground that this specification was bad for uncertainty, and said:—

> "What I have to determine is whether this specification is so clearly and manifestly bad that no explanation by workmen or

(*f*) Simpson *v.* Holliday, (1866) 5 N. R. 340; L. R. 1 H. L. 315.

(*g*) Sturz *v.* De la Rue, (1828) 1 W. P. C. 83; 5 Russ. 327.

(*h*) p. 71 *ante*.

(*i*) See p. 205 *post*.

(*k*) The Patent Type Foundry Co. *v.* Richards, (1860) 6 Jur. N. S. 39.

(*l*) Incandescent Gas Light Co. *v.* De Mare Incandescent Gas Light System, (1896) 13 R. P. C. 326.

(*m*) Maxim-Nordenfelt Guns and Ammunition Co. *v.* Anderson, (1897) 14 R. P. C. 371, 671.

(*n*) *Ibid.*

(*o*) (1860), 6 Jur. N. S. 39; 1 Johns. 381; 2 L. T. N. S. 359.

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other experts . . . . could induce the Court to hold that this is a new invention set forth with sufficient clearness and precision. . . . . A person who takes out a patent for an invention which consists in the use of certain proportions is not, in my opinion, bound to say 'I limit my claim to these precise proportions.' Even if the patentee had in terms absolutely tied himself down to 25 per cent. as a minimum in the place of 1 or 2 per cent., supposing that to be the proportion previously used, a stranger would not be allowed to evade the patent by throwing in 23 or 24 per cent. It will be for experts in the trade to say whether the production of a tough metal by using a large proportion of tin is a useful practice, whether anything of the kind was ever done before, and whether a variation from the given proportion to others slightly different would not be a colourable evasion. These are all questions for a jury. The only opinion I express is that the specification is not void on the face of it."

In *British Dynamite Co.* v. *Krebs*,(*p*) the patent the validity of which was in question was for "improvements in explosive compounds and in the means of igniting the same." The specification stated: "This invention relates to the use of nitro-glycerine in an altered condition, which renders it far more practical and safe to use. The altered condition of the nitro-glycerine is effected by causing it to be absorbed in porous unexplosive substances, such as charcoal, silica, paper, or similar materials, whereby it is converted into powder, which I call dynamite or *Nobel's* safety powder." Objection was taken at the trial to the specification, on the ground that the above statement was not a sufficient statement of the quantity of the nitro-glycerine to be used. The Judge of First Instance overruled the objection, but the Court of Appeal held it fatal to the validity of the patent. The House of Lords, however, held that, under the circumstances, the specification was sufficient upon the ground stated by Lord *Cairns*, L.C., thus(*q*):—

"Where you speak of a porous substance absorbing a fluid, if the porous substance is in one piece you naturally expect that the absorption will continue up to the point where the porous substance can hold no more; and when the absorbing substance is, and is to continue, a powder, the act of absorption itself will show the point at which the absorption must stop, lest the absorbing substance should become, not a powder but a paste."

(*p*) (1875-1879). S. P. C. 88; 13 R. P. C. 190; *cf.* Otto *v.* Linford, (1881-82) per Jessel, M.R., 46 L. T. 40.

(*q*) 13 R. P. C. 192.

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It is settled law that a person, to be entitled to the benefit of a patent, must disclose his secret and specify his invention in such a way that others of the same trade may be taught to do that for which the patent is granted, by following the directions in the specification, without any new invention or addition of their own.(*r*) And the specification ought to be framed so as not to call on a person to have recourse to more than those ordinary means of knowledge (not invention) which a workman of competent skill in his art and trade may be presumed to have.

Test of sufficiency.

In judging of the sufficiency of the specification, the proper criterion is whether a person to whom the specification is addressed, by using only the existing knowledge common to the trade at the date of the patent, would be able to exercise the invention without using information derived from any other source.(*s*) *Tindal*, C.J., directing the jury in *Muntz* v. *Foster*(*t*) as to the sufficiency of the specification, used the following words: "People are not to go on and make experiments, at a great expense to themselves, which shall turn out to be bootless and fruitless; but they rely on an honest and open and candid exposition by the patentee of everything that is necessary for the easy and certain procurement of the commodity for which the patent was granted; that is a question upon the evidence." And, in the language of *Jessel*, M.R., "you are not to tell a man to make an experiment, but to tell him how to do the thing.(*u*)

A statement, or claiming clause, which is so indefinite as to include what will not answer the purpose in view as well as what will is, in accordance with the principles above stated, fatal to the validity of the grant.

Example of a specification held bad as including something which would not answer.

For example, in *Stevens* v. *Keating*(*x*) the Court of Exchequer upheld a verdict, given in the Court below for the defendant, on the question of the sufficiency of the plaintiff's specification. One of the patents in question in the action related to a method of making cement, by mixing gypsum, limestone, or chalk, each in a state of powder, with a strong solution of pearlash in water, and then adding sulphuric acid in sufficient quantity to neutralise the alkali. A stated quantity of water and of the

(*r*) Per Buller, J., R. *v.* Arkwright, (1785) Dav. P. C. 106; 1 W. P. C. 66, and note.

(*s*) Per Alderson, B., Morgan *v.* Seaward, (1836) 1 W. P. C. 173, 174; Badische Anilin und Soda Fabrik *v.* Levinstein, (1887) L. R. 12 App. Cas. 710; 4 R. P. C. 463; British Dynamite Co. *v.* Krebs, (1875) G. P. C. 88; 13 R. P. C. 190; Neilson *v.* Harford, (1841) 1 W. P. C. 371; Rex *v.* Arkwright, (1785) 1 W. P. C. 66.

(*t*) (1844) 2 W. P. C. 109.

(*u*) British Dynamite Co. *v.* Krebs, (1875-9) G. P. C. 90.

(*x*) 2 W. P. C. 175; 19 L. J. Ex. 57.

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powdered material was next added, and the product was dried and heated to a red heat. The specification stated: "Other alkalis and acids, besides those hereinbefore mentioned, will answer the purpose of my invention, though none that I have tried answer as well as the alkali and acid hereinbefore set forth;" and concluded with a claim for the process of mixing the powdered materials, alkalis, and acids, as described, and subsequently burning, heating, or calcining the same, for the purposes set forth. *Pollock*, C.B., in the Court of Exchequer, upholding the verdict below, pointed out in his judgment that only one alkali (potash) and one acid (sulphuric) were mentioned in the specification, but manifestly the inventor did not confine himself to them; if he did, the defendant would be entitled to a verdict, on the plea of no infringement, for he used neither. The learned Chief Baron continued thus:—

> "To what extent, then, does the claim go beyond the alkali and acid named? If it be a claim of all acids and alkalis, it is clearly bad, as there are some that will not answer the purpose. If it be a claim of those only which will answer the purpose, it is *clearly bad, in consequence of not stating those which will* answer the purpose and distinguishing them from those which will not, and so preventing the public from being under the necessity of making experiments to ascertain which of them will succeed and which will not; and this was expressly so determined by the Court of Queen's Bench in *R. v. Wheeler*, (1819) 2 B. & Ald. 345, where they say that a specification which casts on the public the expense and labour of experiment and trial is bad. In my view, therefore, this specification is defective."

When necessity for experiments renders a specification bad, and when not.

If the specification be such that the persons to whom it is addressed are not able, by following its directions, to produce *any* beneficial result without the further necessity of performing experiments and trials involving invention, it is bad. It may not, however, be bad if *a* beneficial result can be obtained by strictly carrying out the directions given, though further experiments may be necessary to obtain the result in a higher degree,(*y*) provided that the patentee has given the best means known to him of carrying out the invention.(*z*)

If the specification contain language which is calculated to mislead the public into performing experiments which the patentee knows must fail, such language will be a fatal defect

(*y*) Neilson *v.* Harford, (1841) 1 W. P. C. 295, 318; Macnamara *v.* Hulse, (1842) Car. & M. 471; 2 W. P. C. 128 n.; Otto *v.* Linford, (1881) 46 L. T. N. S. 39; Edison *v.* Holland, (1889) 6 R. P. C. 243. (*z*) p. 205 *post*.

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in the specification. Thus, in *Crompton* v. *Ibbotson*(*a*) a patent for "improvements in dyeing and finishing paper" was held bad on this ground. The specification stated: "My invention consists in conducting paper by means of a cloth against a heated cylinder, which cloth may be of *any suitable* material, but I *prefer* it to be made of linen warp and woollen weft." One of the witnesses for the plaintiff admitted that as to the conducting medium he had tried several things, but he was not aware that anything would answer the purpose except the material which the patentee said he preferred, and the plaintiff was non-suited. The Court of King's Bench refused to set the nonsuit aside, Lord *Tenterden*, C.J., pointing out that the patent was obtained for the discovery of a proper conducting medium and that the plaintiff found, after repeated trials, that nothing would serve the purpose except the cloth described in the specification, whilst he said that the cloth might be of any suitable material, and merely that he preferred the particular kind in the specification mentioned. Other persons, misled by this statement, might be induced to make experiments, which the patentee knew would fail. The public, therefore, had not the full and entire benefit of the invention. In *Winter* v. *Turner*(*b*) a patent was held void on the ground of a similar ambiguity in the specification.

Leonhardt v. *Kallé*(*c*) indicates that the above two old cases would be differently decided by the Courts now. The invention consisted in the production of various colouring matters fast to alkali by the action of suitable oxidisable substances and free alkalies upon a certain substance under heat. It was objected that the specification was ambiguous and misleading on four points, viz.: (a) because it showed no means of ascertaining which oxidisable substances were not suitable; (b) because the proportions in which the various alternative oxidisable substances were to be used were not stated; (c) nor how the process could be varied to produce the several shades of colour mentioned; (d) the specification entirely failed to state the chemical nature of the compound, the product of the process. *Romer*, J., who tried the case, held that upon the facts all these objections failed, and as to some of them remarked that if they were held valid they would render it practically impossible to draw a specification for an invention like that of the patentee that could be free from objec-

(*a*) Dan. & L., (1828) 33; 6 L. J. O. S. K. B. 214.

(*b*) (1787) 1 T. R. 602; 1 W. P. C. 77.

(*c*) (1895) 12 R. P. C. 103.

tion. The reasons for holding the objections invalid were, shortly:— Complete Specification.

As to (a), It was unreasonable to suppose that the patentee ought to set himself down as a sort of dictionary to specify every known oxidisable substance, and to point out what could not give very useful results, or which might be disregarded. Having given numerous examples of different classes of oxidisable substances that could be used, he was entitled to say, as was true, that there were others which could be used. Following the directions of the specification and with such precautions as chemists would know how to use, oxidisable substances not expressly mentioned in the specification could be successfully used. As to (b), the patentee had given directions as to how to obtain the best results, in fact, with the different oxidisable substances specially mentioned which necessitated the use of the right proportions. He was not bound to enunciate any general theory. With regard to oxidisable substances not specifically mentioned, chemists would have no difficulty in ascertaining into which example or examples given any such unmentioned oxidisable substance fell, and in applying the directions given as regards the said example or examples. As to (c), the patentee had pointed out which colours his dyes produced; and also the colours that were produced from his process were rightly stated by the limits given in the specification. A person wanting to use the dyes could test the examples given without difficulty. Shades of colour vary infinitely, and are almost impossible to describe. The patentee was not bound to take every oxidisable substance and define what shade of colour it would produce. As to (d), this was an unfair objection, and the patentee was not bound to state anything of the kind, which, as a matter of fact, having regard to the state of chemical knowledge, it would have been impossible for him to do with any certainty.

III. *The complete specification must be intelligible to ordinary workmen possessing the ordinary skill and knowledge of that branch of the useful arts to which the invention relates. It is not required to describe the invention and the manner in which it is to be performed so fully as to instruct persons wholly ignorant of the subject-matter.*

The often used statement to the effect that the specification is insufficient unless it be comprehensible to the "ordinary workmen" in the trade to which the invention relates is apt Meaning of "ordinary workman."

Complete Specification.

to lead to great confusion if it be not clearly borne in mind that the "ordinary workman" is to be regarded as a person of very different knowledge and skill according to the nature of the field of invention with which the patentee in a particular case is dealing. Thus, if the invention is merely the construction of a mechanical combination of parts for a purpose readily understood—*e.g.*, a bicycle—then the "ordinary workman" is, no doubt, a mechanic used to the construction of machines; but if the invention is the production of something by a process, or series of processes, to understand which the highest scientific knowledge and attainments are requisite, the "ordinary workman" then becomes a highly trained scientific person who may be called upon to give the necessary instructions to his less highly instructed and skilful subordinates to enable the process to be carried out by them—*e.g.*, if the invention relates to the production of a chemical product by a process or series of processes to the understanding of which a knowledge of the most recent developments of chemical theories and ascertained facts is indispensable, then the "ordinary workman" becomes a highly trained chemist who may be properly called upon to bring his special knowledge of the particular branch to which the invention relates into play for the purpose of giving minute directions to his less skilful subordinates so as to enable them to perform the operations necessary to the carrying out of the process which they by their lack of knowledge may not be able to fully appreciate.

If the above remarks be borne in mind, some of the statements of the law in the following pages, which might otherwise be considered conflicting, will at once appear in perfect harmony.

In *Morgan* v. *Seaward*,(*d*) *Alderson*, B., told the jury that a specification is addressed to all the world: and therefore all those possessed of a competent skill ought to be able to construct the machine by following the specification, and the specification should be such as to enable a workman of *ordinary* skill to make the machine.(*e*) *Parke*, B., in *Neilson* v. *Harford*,(*f*) alluding to an invention relating to a machine, laid down the law in the following terms:—

Statement of the law as to "ordinary workman" in a particular case by Parke, B.

> "You are not to ask yourselves the question whether persons of great skill—a first-rate engineer or a second-class engineer—

(*d*) (1835) 2 M. & W. 544; 1 W. P. C. 167; 6 L. J. Ex. 153.

(*e*) See also Gibson *v.* Brand, (1842) 1 W. P. C. 631; Sturz *v.* De la Rue, (1828) 1 W. P. C. 83; 5 Russ. 327; Beard *v.* Egerton, (1849) 8 C. B. 165; Bickford *v.* Skewes, (1839) 1 W. P. C. 218.

(*f*) (1841) 1 W. P. C. 295; 8 M. & W. 806; 11 L. J. Ex. 20.

Complete Specification.

whether they would do it; because generally those persons are men of great science and philosophical knowledge, and they would, upon a mere hint in the specification, probably invent a machine which would answer the purpose extremely well; but that is not the description of persons to whom this specification may be supposed to be addressed—it is supposed to be addressed to a practical workman, who brings the ordinary degree of knowledge and the ordinary degree of capacity on the subject; and if such a person would construct an apparatus that would answer some beneficial purpose, whatever its shape was, according to the terms of this specification, then I think that this specification is good, and that the patent may be supported so far as it relates to that."

The same by Jessel, M.R.

The following passage, from the judgment of *Jessel*, M.R., in *Plimpton* v. *Malcolmson*,(*g*) in reference to patents for mechanical inventions, has been approved of in subsequent cases as a correct statement of the law as to whom a complete specification must be intelligible (*h*) :—

"It is plain that the specification is not addressed to people who are ignorant of the subject-matter. It is addressed to people who know something about it. But there are various kinds of people who know something about it. If it is a mechanical invention you have first of all scientific mechanicians of the first-class, eminent engineers; then you have scientific mechanicians of the second-class, managers of great factories, great employers of labour, persons who have studied mechanics. . . . . and in this class I should include foremen, being men of superior intelligence, who, like their masters, would be capable of invention, and, like the scientific engineers, would be able to find out what was meant even from slight hints and, still more, from imperfect descriptions, and would be able to supplement so as to succeed even from a defective description, and even more than that, would be able to correct an erroneous description. That is what I would say of the two first classes, which I call the scientific classes. The other class consists of the ordinary workman, using that amount of skill and intelligence which is fairly to be expected from him—not a careless man, but a careful man, though not possessing that great scientific knowledge or power of invention which would enable him by himself, unaided, to supplement a defective description, or correct an erroneous description. . . . . It will be a bad specification if

(*g*) (1875) L. R. 3 Ch. D. 531, 568; 44 L. J. Ch. 257.

(*h*) Edison *v.* Woodhouse, (1887) 4 R. P. C. 79; Moseley *v.* Victoria Rubber Co., (1887) 4 R. P. C. 242; Bray *v.* Gardner, (1887) 4 R. P. C. 400, 406; Edison *v.* Holland, (1889) 6 R. P. C. 243.

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the first two classes only understand it, and if the third class do not." (*i*)

The same by Maule, J.

It is sufficient if the complete specification define the invention so that an ordinarily skilful workman can carry it out.(*k*) Thus, *Maule*, J., in reference to the specification of an invention relating to photography, said:—

"If so much nicety of description is required it would be impossible to draw a specification at all. It is enough if it be so explicit as to enable a man of ordinary, competent skill, and willing to learn, to perform the operation. A competent workman must be taken to know the known properties of iodine, of silver, and of nitric acid, or else the specification should have included a statement of the properties of each of these substances." (*l*)

Sufficiency of specification when the invention can only be appreciated by persons of great skill and knowledge.

Every inventor capable of sustaining a patent for his invention adds, it is clear, something to what was known before, and it is submitted that the ordinary skilled workman, to whom it may be supposed that his specification is addressed, must in most cases be interpreted to mean a person having a reasonably competent knowledge of what was known before on the subject to which the patent relates, and a reasonably competent skill in the practical mode of doing what was then known :(*m*)but in cases where the invention relates to a subject which only appeals to and can only be appreciated by persons of great skill and knowledge in some particular department of science, then the ordinary skilled workmen must be interpreted to mean a person possessed of the greatest skill and knowledge.(*n*)

If it appear in evidence that a person possessed of the highest scientific knowledge might be left in doubt as to the exact meaning of a direction contained in the complete specification, whereas a person possessing merely ordinary knowledge on the subject has no difficulty in interpreting the invention, the patent will be upheld with respect to the sufficiency of the specification.(*o*)

(*i*) See also Neilson *v.* Harford, (1841) 1 W. P. C. 314.

(*k*) Wallington *v.* Dale, (1852) 7 Exch. 888; 23 L. J. Ex. 49.

(*l*) Beard *v.* Egerton, (1846) 2 Car. & K. 667; 3 C. B. 97; 8 C. B. 165; 15 L. J. C. P. 270; 19 L. J. C. P. 30; see also Otto *v.* Linford, (1881) 46 L. T. N. S. 35; Badische Anilin und Soda Fabrik *v.* Levinstein, (1887) L. R. 12 App. Cas. 710, 713; 4 R. P. C. 449; Moseley *v.* Victoria Rubber Co., (1887) 4 R. P. C. 241, 253.

(*m*) See Edison *v.* Holland, (1889) 6 R. P.C. 243, 280.

(*n*) See pp. 191–2 *ante*; Badische Anilin und Soda Fabrik *v.* La Société Chimique des Usines du Rhône, (1897) 14 R. P. C. 875, judgment of Willes, J.

(*o*) Badische Anilin und Soda Fabrik *v.* Levinstein, (1887) 12 App. Cas. 710; 4 R. P. C. 449.

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The specification, in fact, is addressed, not to persons entirely ignorant of the subject-matter, but to artists of competent skill in that branch of manufacture to which it relates.(*p*)

Specifications are not addressed to persons ignorant of the subject-matter.

Thus, Lord *Loughborough*, in *Arkwright* v. *Nightingale*,(*q*) stated that a specification is addressed to persons having skill in the subject, and not to men of ignorance, and if it be understood by those whose business leads them to be conversant in such subjects it is sufficient. And in *Rex* v. *Arkwright*,(*r*) a case in which the patent called in question related to a mechanical invention, *Buller*, J., said, that if the specification be such that mechanical men of common understanding can comprehend it, so as to make a machine by it, it is sufficient; but then it must be such that mechanics may be able to make the machine by following the directions of the specification without any new inventions or additions of their own.

When it is said that the meaning of the specification is that others may be taught to do the thing for which the patent is granted, it must be understood to enable persons of reasonably competent skill in such matters to make it; for no sort of specification would, probably, enable a ploughman, utterly ignorant of the whole art, to make a watch; and a person must carry a reasonable knowledge of the subject-matter with him, in order clearly to comprehend specifications of inventions.(*s*)

Person to whom the specification is addressed is presumed to possess all the existing knowledge common to the trade, but not more.

The patentee must not leave the description of the way in which the invention is to be performed in such a state that persons desirous of carrying it out would find that they had virtually to solve a problem before they could do so. The person reading the specification is called upon to bring to bear, in interpreting the specification, all the existing knowledge common to the trade; and he must not be called upon to exercise anything more. The specification must be drawn in such a manner as not to call on a person reading it to have recourse to more than those ordinary means of knowledge (not invention) which a workman of competent skill in his art and trade may be presumed to have.(*t*)

In *Turner* v. *Winter*,(*u*) it appeared that in carrying out the

(*p*) Huddart *v*, Grimshaw, (1803) 1 W. P. C. 85, 87; Bickford *v*. Skewes, (1837) 1 W. P. C. 218; Hornblower *v*. Boulton, (1799) Dav. P. C. 221, 228; Edison *v*. Holland, (1889) 6 R. P. C. 243, 277, 278, 280; Badische Anilin und Soda Fabrik *v*. La Société Chimique des Usines du Rhône, (1897) 14 R. P. C. 875.

(*q*) (1785) Dav.P.C. 39; 1 W.P.C.60.

(*r*) (1785) Dav. P. C. 61; 1 W. P. C. 64.

(*s*) Per Lord Ellenborough, C.J., in Harmar *v*. Playne, (1809) Dav. P. C. 318; 11 East, 181.

(*t*) Morgan *v*. Seaward, (1837) 1 W. P. C. 174.

(*u*) (1787) 1 T. R. 602; 1 W. P. C. 77.

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invention in dispute it was necessary that during the process the materials used should be fused, though the specification only alluded to calcination. The specification mentioned the use, as an alternative for other substances, of *fossil salt*, but it appeared at the trial that *fossil salt* was a generic term, including several species, and that *sal gem* was the only species of it which would answer the purpose. The patent was declared void, the specification not being intelligible, in so far as it did not state the degree of heat necessary, and the particular species of fossil salt which would answer the purpose.

So also in the recent case of *Badische Anilin und Soda Fabrik* v. *La Société Chimique des Usines du Rhône*,(*x*) where the patentee directed that a certain process was to be carried out in "an autoclave," and it appeared that it was essential that the vessel in question should be of iron unenamelled, and it also appeared that at the date of the specification both unenamelled and enamelled autoclaves were in general use, the specification was held to be fatally insufficient on the ground that it did not point out that the use of an unenamelled iron autoclave was an essential element of success.

If the specification be not intelligible to the public to whom it is addressed, the patentee will not have fulfilled the obligation which the law imposes upon him of telling the public for what it is that he claims the invention.(*y*) And in the words of Lord *Eldon*, L.C., "in order to support a patent, the specification should be so clear as to enable all the world to use the invention as soon as the time for which it was granted is at an end."(*z*)

If the specification is not sufficiently explicit to enable others to practise the invention, then it defeats one of the objects for which it was required—viz., "that useful novelties may be given to the public, of which, at the end of the term granted to the patentee, they shall have the full benefit."(*a*)

If the patentee use a word inaccurately, but from the context it is perfectly clear in what sense he intends it to be understood, such an inaccuracy will not be an objection which could be successfully urged against the validity of the specification.(*b*)

(*x*) (1897) 14 R. P. C. 875.

(*y*) Neilson *v.* Thompson, (1841) 1 W. P. C. 283.

(*z*) Newbury *v.* James, 2 Mer. 446, 451; 1 Carp. P. C. 367.

(*a*) Holmes *v.* London and North Western Ry. Co., (1852) Macr. P. C. 13, 16; Hills *v.* London Gas Light Co., (1857) 5 H. & N. 312, 340.

(*b*) Derosne *v.* Fairie, (1835) 1 W. P. C. 154, 157; Minter *v.* Mower, (1835) 1 W. P. C. 141; see also R. *v.* Metcalf, (1817) 1 W. P. C. 141 n.; 3 Car. & P. 611.

Complete Specification.

A specification which discloses in one set of words both the nature of the invention and the mode of performing it is sufficient.(*c*)

Errors in the specification and their effect.

All that is necessary is that the specification shall be intelligible to the persons to whom it is addressed, and enable them to perform the invention; and a specification so intelligible will not be vitiated by the fact that it contains slight mistakes and errors which any workman of ordinary skill and experience would perceive and correct.(*d*)

But this last statement must be understood as referring only to errors which appear on the face of the specification, or the drawings therein referred to, or which would be at once discovered and corrected in following out the instructions given, for such errors cannot possibly mislead;(*e*) and it must not be understood as a correct statement of the law where errors are discoverable only by experiment and further inquiry. The proposition, moreover, is not true of an erroneous statement in a specification amounting to a false suggestion, even though the error would be at once observed by a workman possessed of ordinary knowledge of the subject. For example, if a specification describe several processes or several combinations of machinery, and affirm that they will all produce a certain result which is the object of the patent, and some one of the processes or combinations is wholly ineffectual and useless, the patent will be bad, although the mistake committed by the patentee may be such as would at once be observed by an ordinary workman.(*f*)

A workman is not to be called upon to correct any error unless there is something to correct it by.(*g*) Thus, in the case of *Hinks'* patent for the paraffin lamp the drawing did not show, and the letterpress did not describe, a certain small opening in the second burner which was necessary to the effective working of the lamp. *Jessel*, M.R., held this to be a fatal defect which a workman could not be called on to remedy. In the

(*c*) Edison *v.* Holland, (1889) 6 R. P. C. 280.

(*d*) Simpson *v.* Holliday, (1864) 5 N. R. 340; L. R. 1 H. L. 315; 35 L. J. Ch. 811; Otto *v.* Linford, (1881) 46 L. T. N. S. 35; Morgan *v.* Seaward, (1836) 1 W. P. C. 176; Derosne *v.* Fairie, (1835) 1 W. P. C. 157; 1 W. P. C. 42 n. 41; Gandy *v.* Reddaway, (1883) 2 R. P. C. 52; Edison *v.* Woodhouse, (1887) 4 R. P. C. 107; Hopkinson *v.* St. James's Electric Light Company, (1892) 10 R. P. C. 46; Miller *v.* Searle, (1893) 10 R. P. C. 106.

(*e*) p. 178 *ante*.

(*f*) See remarks by Lord Westbury, L.C., in Simpson *v.* Holliday, (1864) 13 W. R. 577; 5 N. R. 340; 35 L. J. Ch. 811; L. R. 1 H. L. 315; p. 178 *ante*.

(*g*) British Dynamite Co. *v.* Krebs, (1875) G. P. C. 190; 13 R. P. C. 190; Hinks *v.* Safety Lighting Co., (1876) 4 Ch. D. 615; United Telephone Co. *v.* Harrison, (1882) L. R. 21 Ch. D. 720.

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case of an invention the whole merit of which is very small indeed, if people are told how to do things better they must be told properly, without the necessity for invention or much trouble.(*h*)

Objections to the working of a patent are not usually allowed when a patent has stood for a long time the test of inquiry.(*i*)

The objection to the sufficiency of a specification, on the ground that it made use of *French* expressions, such as *vis de pression*, *vis de répulsion*, and *vis de réaction*, for different screws, and *centimètres* for inches, was taken in *Bloxam* v. *Elsee*,(*k*) but was not sustained, as it appeared that, although these terms would not be understood by *English* mechanics, yet a skilful workman could construct the machine by the aid of the drawings annexed to the specification, *Abbott*, C.J., saying: "An inventor of a machine is not tied down to make such a specification as by words only would enable a skilful mechanic to make the machine, but he is allowed to call in aid the drawings which he annexes to the specification; and if by a comparison of the words and drawing the one will explain the other sufficiently to enable a skilful mechanic to perform the work, such a specification is sufficient."

The use of the word "discolour," as meaning "discharge the colour," being a bad translation of the French word "discoleur," has been held not to be of sufficient importance to upset a specification.(*l*)

Effect of statements rendering experiments necessary.

A specification will be sufficient which contains directions enabling a person having a reasonably competent knowledge and skill of the subject to make the article described without further invention, though it may be necessary for him to make some trial and experiment before succeeding,(*m*) but a specification which does not contain sufficient information to enable this to be done without the necessity for experiments, involving the exercise of the inventive faculty of the experimenter, is absolutely fatal to the validity of the patent.(*n*)

(*h*) Hinks *v.* Safety Lighting Co., (1876) L. R. 4 Ch. D. 615; 46 L. J. Ch. 185.

(*i*) Betts *v.* Neilson, (1871) L. R. 5 H. L. 121; per Lord Westbury, L.C.

(*k*) (1825) 1 Car. & P. 558; 6 B. & C. 169.

(*l*) Tetley *v.* Easton, (1852) Newton, L.J., vol. xlii. p. 58; 18 C. B. 643; 25 L. J. C. P. 293.

(*m*) Edison *v.* Holland, (1889) 6 R. P. C. 243.

(*n*) Liardet *v.* Johnson, (1778) 1 W. P. C. 53; R. *v.* Arkwright, (1785) 1 W. P. C. 70; Neilson *v.* Harford, (1845) 1 W. P. C. 317; Hinks *v.* Safety Lighting Co., (1876) L. R. 4 Ch. D. 607; Bailey *v.* Roberton, (1878) L. R. 3 App. Cas. 1055; Pooley *v.* Pointon, (1885) 2 R. P. C. 167; Hutchison *v.* Patullo, (1888) 5 R. P. C. 351; Elkington *v.* Clark, (1888), 5 R. P. C. 327; Goulard *v.* Gibbs, (1888) 5 R. P. C. 535; Plimpton *v.* Malcolmson, (1876) L. R. 3 Ch. D. 531; 45 L. J. Ch. 505; Simpson *v.* Holliday, (1886) L. R. 1 H. L. 315; The Lifeboat Co. *v.* Chambers, (1891) 8 R. P. C. 418.

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It is to be observed that what in one particular case, having regard to the nature of the invention and the public to whom the specification may rightly be supposed to be addressed, is a mere affair of practice before being able to succeed, ought in another particular case to be regarded by the Court as a matter of experiment, the necessity for which is fatal to the patent on the ground of insufficiency of the specification. Thus *Willes*, J., has stated that in his opinion a chemical patent dealing with very subtle and delicate reactions is entitled to the benefit of being tested by the results of its working in the hands of persons not merely practised in chemistry generally, but having acquired the necessary familiarity with the processes.(*o*)

The following passage from the judgment of *Lindley*, L.J., in *Edison* v. *Holland*,(*p*) illustrates the point that, though trial may be necessary before success is attained, yet the specification may be sufficient:—

"If a person is told to carbonise a thread, and for want of thought or practice he takes a porous crucible for the purpose, and does not protect his thread, and fails, when, if he had packed this crucible, or had taken a non-porous crucible, he would have succeeded, his failure can hardly be said to be the fault of his instructor, if a little thought and consideration would have shown that a packed crucible, or a non-porous crucible, was the right one to employ. The fact that a workman may use a wrong tool when he has a right one, which a little thought will lead him to see ought to be used, does not warrant the inference that a specification is bad if it does not tell him which tool to use. . . . . If a patentee says that something must be done which a reasonably competent man would know how to do, the patentee need not tell him how to do it, nor warn him to be careful and to exercise such forethought and attention as the delicacy of the process to be used, or the material to be employed, plainly demand."

IV. *The complete specification must particularly describe and ascertain the nature of the invention and how the same is to be performed.*

Now a statutory as well as a common law requisite.

This was specially enacted by the Act of 1883, s. 114; but before that statute the public had a Common Law right to a fair, full, and true description;(*q*) and it was laid down by

(*o*) Badische Anilin und Soda Fabrik *v.* La Société Chimique des Usines du Rhône, (1897) 14 R. P. C. 891.

(*p*) (1889) 6 R. P. C. 281.

(*q*) R. *v.* Arkwright, (1785) Dav. P. C. 61; Macfarlane *v.* Price, (1816) 1 Stark. N. P. 199; 1 W. P. C. 74 n.; Gibson *v.* Brand, (1842) 1 W. P. C. 649.

Complete Specification.

Ashurst, J.,(*r*) that it is incumbent on the patentee to give a specification of the invention in the clearest and most unequivocal terms of which the subject is capable, and that it is of consequence that the terms used should express the invention in the clearest and most specific manner. *Buller*, J.,(*s*) declared that where attempts were made to evade a fair patent he was strongly inclined in favour of the patent, but when the discovery is not fully made the Court ought to look with a very watchful eye to prevent any imposition on the public.

In *Hastings* v. *Brown*,(*t*) a patent granted for "certain improved arrangements for raising ships' anchors and other purposes" was upset on the ground that the language used in the specification was ambiguous. The patent related to a windlass, the drum of which was grooved in a V form, the sides of the V groove being scalloped or recessed into a series of shell-like indentations, which formed a hold for the links of a chain cable, and the words used in the specification to describe the object of the invention were, "the scallop shell is upon a new plan, intended to hold, without slipping, *a chain cable of any size*, as shown by the opening form of the scallop at the top and bottom of Figure 2." The drawing referred to (*u*) merely showed an indented V groove. It was established in evidence that before the date of the patent no cable-holder was known which would hold chains of different sizes, and the invention claimed by the pleadings as a novelty was the application of a single windlass to different sizes of chain cable. It was also established that a windlass, capable of holding a chain cable of a given size, was no novelty. The defendant's case was that the patent was void because the language used in the specification left it doubtful whether the claim was for holding a chain of a given size or for holding chains of different sizes. The jury gave a verdict in favour of the patent. The Court of Queen's Bench subsequently, however, directed a nonsuit to be entered, on the ground that the specification was bad, Lord *Campbell*, C.J., saying:—

> "It is clear that the patentee ought to state distinctly what it is for which he claims the patent, and describe the limits of the monopoly. This is not done by this specification. The claim is for an invention by which a single windlass may raise cables of different diameter, which is allowed to be a great

(*r*) Turner *v.* Winter, (1787) 1 W. P. C. 77; 1 T. R. 602.
(*s*) *Ibid.*
(*t*) (1853) 1 Ex. B. 450; 22 L. J. Q. B. 161.
(*u*) Fig. 2.

improvement. But is that pointed out by the specification? The words are at best equivocal. If he claims for a windlass that is fitted for one cable only, of whatever size, there is no novelty; and the vice of the specification is that it does not assert that more can be done by the invention. The title tells us nothing. The words of the specification are, 'a chain cable of any size.' 'A' applies to one only. At all events, the phrase is capable of that meaning; and the specification, if it be equivocal, is bad. I see nothing in the words, or in the drawing, that necessarily indicates the contrivance to be for fitting more than one cable. You might make a windlass according to the drawing, which would do no more than that."

It is a fatal defect if the specification does not disclose the object of the invention, and also how the same is to be effected.(*x*)

Lyon v. *Goddard* (*y*) is a case which illustrates the importance of clearly stating on the face of the specification the purpose for which a combination, which is the subject-matter of the patent, is designed and claimed. In that case, after a great deal of argument, which might have been rendered unnecessary by a more clearly drawn specification, it was finally decided by the House of Lords that upon the true construction of the specification the machine which was the subject of the patent was specially designed for use with high-pressure steam, and the claim was limited to its use with high-pressure steam for the purpose of disinfecting. The consequence was that a certain prior machine which could be used with low-pressure steam only was no anticipation of the plaintiff's invention, and so this ground of attack upon his patent failed.

Disclosure of nature and object of invention and how it is to be performed as far as patentee's knowledge at the time extends is sufficient.

Whilst, in order to support a patent, it is necessary that the patentee should fully disclose to the public what is the nature and object of the invention, and how the same is to be carried out,(*z*) yet, if he make a full and fair disclosure *as far as his knowledge at the time extends*, he has done all that is required.(*a*)

Cresswell, J., stated, as the reason why a full disclosure is required, that a party who obtains a patent is bound clearly to define in his specification what it is he claims as his invention, in order that the public may know with certainty what they may, or may not, do without incurring the risk of an action for

(*x*) p. 199 *ante*; Allen *v.* Duckett, (1893) 10 R. P. C. 397.
(*y*) (1893) 11 P. O. R. 360.
(*z*) Allen *v.* Duckett, (1893) 10 R. P. C. 397; p. 199 *ante*.
(*a*) Lewis *v.* Marling, (1829) 10 B. & C. 22; 1 W. P. C. 496.

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infringement of the patent,(*b*) and *Alderson*, B.,(*c*) laid it down that the public have a right to expect and require that the specification shall be fair, honest, open, and sufficient, and contain a full description of the way in which the invention is to be carried into effect.

It is a condition, without the fulfilment of which the patent is void, that the patentee shall state the nature of his invention, in order that persons reading his specification shall know, and shall know with reasonable clearness and facility, what they are prohibited from using by the letters patent without permission or licence.(*d*)

In the case of patents for improvements on existing inventions the patentee must be specially careful to claim only the improvement and not the old invention.(*e*)

Sufficiency of description necessary when invention consists of several parts.

If the invention consists of more than one part, the specification must contain a full, accurate, and intelligible description of every such part, and the means of carrying it into effect.

Thus in *Morgan* v. *Seaward*,(*f*) *Alderson*, B., charging the jury in terms which have never been questioned, told them that the patentee had in his specification described two inventions, and that the patent would fail if either of them were insufficiently specified; for if a person run the hazard of putting two inventions into one patent, he cannot hold his patent, unless each can be supported separately. He told the jury this after having previously directed them that, in law, the patentee is required to state fairly to the public what the invention really is, in order that other persons may know what is the prohibited ground, and that the public may be made acquainted with the means by which the invention is to be carried into effect. The learned Baron also pointed out that it is of great importance to the public, and by law absolutely necessary, that the patentee should state in his specification not only the nature of his invention, but how that invention may be carried into effect. Unless he be required to do this, monopolies would be given for a term of years to persons who would not on their

(*b*) Gibson *v.* Brand, (1841) 1 W. P. C. 627.

(*c*) Morgan *v.* Seaward, (1836) 1 W. P. C. 174, 179.

(*d*) Philpot *v.* Hanbnry, per Grove, J., (1885) 2 R. P. C. 33; see also Fairburn *v.* Household, (1886) 3 R. P. C. 128, 263; Rowcliffe *v.* Morris, (1886) 3 R. P. C. 17.

(*e*) Eades *v.* Starbuck Waggon Co., W. N. 1881, p. 160; p. 67 *ante*.

(*f*) (1836) 2 M. & W. 544; 1 W. P. C. 170; 6 L. J. Ex. 153; see also Reg. *v.* Wheeler, (1819) 2 B. & Ald. 345: Macnamara *v.* Hulse, (1842) Car. & M. 471; Stevens *v.* Keating, (1847) 2 W. P. C. 175; 19 L. J. Ex. 57.

part do what in justice and in law they ought to do, state fairly to the public what their invention is, in order that other persons may know what is the prohibited ground, and in order that the public may be made acquainted with the means by which the invention is to be carried into effect. Complete Specification.

V. *The complete specification need not describe any step or process which is necessarily implied.*

Things necessarily implied need not be specifically described.

For instance, in the case of a specification of a newly invented chemical process, which directed that some particular chemical substance should be poured upon gold in a state of fusion, it would not be necessary that the specification should describe the obvious fact that, in order to carry out this direction, the gold would have to be put into a crucible and melted; nor would it be necessary to specify the manner in, nor the utensils with which the operation of putting gold into a state of fusion was to be performed, these being mere incidents with which every man acquainted with the subject must be familiar.(*g*)

In *Crossley* v. *Beverley* (*h*) it was sought to upset a patent for an "improved gas apparatus," on the ground that the specification did not specify the use of a condenser, without which the apparatus would not work satisfactorily. Lord *Tenterden*, C.J., however, overruled this objection, holding that any workman capable of making a gas apparatus would know that he must put in a condenser, and the specification did not direct that the condenser should be left out.

In *Russell* v. *Cowley* (*i*) the specification of an invention for the manufacture of iron tubes without the use of a mandril was held sufficient, though it did not specifically state that the mandril was to be left out. The ground of the decision was that an ordinarily intelligent workman would, from the general purport of the specification, sufficiently understand that the mandril was to be omitted.(*k*)

VI. *The complete specification need not necessarily describe minutely any known thing to which it refers.*

Not necessary to describe a known thing referred to.

For example, in the case of an invention which consists of an improvement on an existing machine, it would not be necessary

(*g*) Boulton *v.* Bull, (1795) Dav. P. C. 162; 2 H. Bl. 498.
(*h*) (1829) 3 Car. & P. 513; 1 W. P. C. 106.
(*i*) (1832) 1 W. P. C. 459.
(*k*) See also Beard *v.* Egerton, (1846) 8 C. B. 165; 15 L. J. C. P. 270; 19 L. J. C. P. 36.

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for the patentee in the specification to enter into a minute description of the old machine, but it must not be forgotten that the language used must be such as will distinguish the invention from that which is old.(*l*)

In *Harmar* v. *Playne* (*m*) the patent related to improvements in machinery secured by previous letters patent. It was admitted by the defendant that the improvements for which the second patent was granted were included in the second specification, which gave a full and proper description of the whole machine in its improved state. It was objected, on the other hand, that the second specification did not, in any manner, point out or explain the improvements upon the former patented machine for which the second patent was granted, and, therefore, that it was insufficient. The Court of King's Bench, however, held the specification sufficient, Lord *Ellenborough*, C.J., remarking that the difficulty which pressed most was, whether this mode of making the specification was not calculated to mislead a person looking at it, and induce him to suppose that the term for which the patent was granted might extend to preclude the imitation of other parts of the machine than those for which the new patent was granted, when he could only tell, by comparing it with some other patent, what were the new and what were the old parts; and if that might be done with reference to one, why not with reference to many other patents, so as to render the investigation very complicated?

It may not be necessary, in drafting a specification of a patent for an improvement, to state precisely all the former known parts of the machine, and to apply to those the improvements, but it may be sufficient to refer generally to them; *e.g.*, in the instance of a common watch, it may be sufficient for the patentee to say, take a common watch, and add or alter such and such parts, describing them.

VII. *The complete specification need not describe the particular shape of any article or part, if the form thereof is not of the essence of the invention.*

Thus, in *Neilson's* specification of his invention of an improved application of air in furnaces, the patentee stated that the form of the vessel in which the air was heated was quite immaterial,

(*l*) See 214 *post*.
(*m*) (1809) 14 Ves. 130; 11 East, 101; Dav. P. C. 311.

and the Court of Exchequer ruled that, on the evidence, the specification was sufficient in that particular.(*n*)

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VIII. *The complete specification must describe the best method known to the patentee of performing the invention, and all his knowledge relating thereto, including that which he may have acquired during the period of provisional protection, prior to the date of filing the complete specification.*

Specification must extend to the best of the patentee's knowledge.

It is expressly enacted that the patentee must, in the complete specification, describe the manner in which the invention is to be performed,(*o*) and the description will not be sufficient unless it include the best means known to him at the time of filing the document. In fact, a man has no right to patent an invention and give the public only the humblest means that can be devised for carrying it into effect, and reserve to himself all the better part of it, and to box up his improvements, and to say to the world, "You are at liberty to perform my invention in this way, but it will be of very little use."(*p*) He must, on the other hand, put the public in possession of the discovery in as ample and beneficial a way as he himself uses it,(*q*) and place them in a position to derive the same benefit from it which he himself does.(*r*)

To use the words of *Gibbs*, C.J.: "There is another consideration respecting the specification which is also a material one, and that is, whether the patentee has given a full specification of his invention; not only one that will enable a workman to construct a machine answering to the patent, but one that will enable a workman to construct a machine answerable to the patent to the extent most beneficial within the knowledge of the patentee at the time; for a patentee who has invented a machine useful to the public, and can construct it in one way more extensive in its benefits than another, and states in his specification only that mode which would be least beneficial, reserving to himself the more beneficial mode of practising it,

(*n*) (1841) 1 W. P. C. 295, 328.
(*o*) 46 & 47 Vict. c. 57, s. 5, sub-s. 4.
(*p*) Tetley *v.* Easton, (1852) Mac. P. C. 48.
(*q*) R. *v.* Arkwright, (1785) Dav. P. C. 61; 1 W. P. C. 64.
(*r*) Turner *v.* Winter, (1787) 1 T. R. 602; 1 W. P. C. 77; Bovill *v.* Moore, (1815) 2 Coop. Ch. Cas. 56; Dav. P. C. 361; 2 Marsh, R. 211; Wood *v.* Zimmer, (1815) Holt, N. P. 57; Tetley *v.* Easton, (1852) Mac. P. C. 48; Savory *v.* Price, (1823) 1 Ry. & Mo. 1; 1 W. P. C. 83; Walton *v.* Bateman, (1842) 1 W. P. C. 613; Heath *v.* Unwin, (1852) 2 W. P. C. 243; Plimpton *v.* Malcolmson, (1875) L. R. 3 Ch. D. 531, 582.

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although he will have so far answered the patent as to describe in his specification a machine to which the patent extends, yet he will not have satisfied the law by communicating to the public the most beneficial mode he was then possessed of for exercising the privilege granted to him."(*s*) And in the language of *Alderson*, B., "if a patentee is acquainted with any particular mode by which his invention may most conveniently be carried into effect he ought to state it in his specification."(*t*)

Patentee need not necessarily state the best way of carrying out the invention, but must state the best way known to him.

It is evident that the patentee may not be in possession of the very best possible way of carrying out the invention. In that case the specification will not be bad if it turn out afterwards that it does not describe the best possible way of performing the invention; all that is necessary is that it should give the best method known to the patentee.(*u*) Neither is it incumbent on the patentee to describe all the possible advantages which may in future accrue from the improved use of his invention. He is only bound, under the statute and the patent law, to give the world the benefit of such information as he actually possesses.(*x*)

In the case of an invention made abroad it is the usual practice for the foreign inventor who is desirous of protection in this country to employ an agent to take out the patent for him, and the grant is made to the agent, who is therefore in law the patentee.(*y*) Under such circumstances the fact that the foreign inventor was possessed of knowledge not in the specification will not render that instrument bad if it appear that the agent did not possess such knowledge, for the agent is the patentee, and it is only necessary that the specification should contain a description of the best means known to him of carrying out the invention.(*z*) On the other hand, if the agent, the actual patentee, be possessed of knowledge not in the specification, it is no answer to an objection on the ground of insufficiency to say that the specification contains all

(*s*) Bovill *v.* Moore, (1815) 2 Coop. Ch. Cas. 56; Dav. P. C. 361; 2 Marsh, R, 211.

(*t*) Morgan *v.* Seaward, (1836) 1 W. P. C. 174.

(*u*) Neilson *v.* Harford, (1841) 1 W. P. C. 317, 356; The Househill Co. *v.* Neilson, (1843) 1 W. P. C. 693; Wood *v.* Zimmer, (1815) Holt, N. P. 57; 1 W. P. C. 82 n.; Savory *v.* Price, (1823) 1 Ry. & Mo. 1; 1 W. P. C. 83; Turner *v.* Winter, (1787) 1 W. P. C. 81; Morgan *v.* Seaward, (1836) 1 W. P. C. 170; Sturtz *v.* De la Rue, (1828) 1 Carp. Rep. 463; 5 Russ. 322; 1 W. P. C. 83; Tetley *v.* Easton, (1852) Mac. P. C. 76; Derosne *v.* Fairie, (1835) 1 W. P. C. 158; Walton *v.* Bateman, (1842) 1 W. P. C. 622; Heath *v.* Unwin, (1852) 2 W. P. C. 243.

(*x*) Lyon *v.* Goddard, (1893) 10 R. P. C. 345, judgment of Bowen, L.J.

(*y*) pp. 15–18 *ante*.

(*z*) Plimpton *v.* Malcolmson, (1875) 3 Ch. D. 531, 582.

the information which the agent received from the foreign inventor.(*a*) Complete Specification.

If the specification do not describe everything which is necessary to the working of the invention to the best of the patentee's ability, it will not "particularly describe and ascertain the manner in which the invention is to be performed," as required by the Act of 1883. Hence the patentee must give the public every information which is necessary to enable them completely to perform every part of the invention, although it may be sufficient merely to refer in general terms to such things and processes as are old. And it also follows that if a material part, or anything which the patentee knows to be useful, is omitted, the specification will be insufficient.

In a patent for trusses for ruptures, the patentee omitted what was very material for tempering steel, which was rubbing it with tallow, and for want of that Lord *Mansfield* held it void.(*b*)

In the case of *Galloway's* patent for improvements in steam engines and machinery for propelling vessels it appeared that a slight difference in the length of certain rods was a necessary feature in the successful working of the invention, and the specification did not state this fact. At the trial of an action (*c*) relating to this patent, *Alderson*, B., told the jury that the small necessary difference in the lengths of the rods ought to have been specified; and if it could not have been ascertained fully it should have been so stated. The small adjustment of the different lengths might have been made for the purpose of making the machine work more smoothly, and, if so, it was just as necessary that it should be so stated in the specification as it was that the tallow should be mentioned in *Liardet* v. *Johnson*. The true criterion is this: "Has the specification substantially complied with that which the public has a right to require? Has the patentee communicated to the public the manner of carrying his invention into effect? If he has, and if he has given to the public all the knowledge he had himself, he has done that which he ought to have done, and which the public has a right to require from him."

It has been previously shown that a patentee suppressing anything, or misleading, thereby renders his specification bad,(*d*) and must not suppress anything essential thereto.

(*a*) Wegmann *v.* Corcoran, (1879) 13 Ch. D. 66; 41 L. T. N. S. 358.
(*b*) Liardet *v.* Johnson, (1778) 1 W. P. C. 53.
(*c*) Morgan *v.* Seaward, (1836) 1 W. P. C. 182.
(*d*) Lewis *v.* Marling, (1829) 10 B. & C. 22; 4 Car. & P. 56; 1 W. P. C. 496; Savory *v.* Price, (1823) Ry. & M. 1; 1 W. P. C. 83; p. 178 *ante*.

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for it is the duty of a patentee, possessed of a mode of carrying on his invention in a beneficial manner, to disclose the means of producing it in equal perfection and with as little expense and labour as he himself incurred. To enable the public, at the expiration of the monopoly, to perform the invention in the same way, and with the same advantages as himself, is the price which the grantee pays for the patent, and the specification is void if anything which gives an advantageous operation to the invention be concealed. Thus, in the case of *Wood* v. *Zimmer*,(*e*) a patent for a method of manufacturing verdigris was held void on the ground of the insufficiency of the specification, which did not disclose the fact that the patentee was accustomed to use *aqua fortis* in a boiler to facilitate the solution of copper, the evidence having established that the use of *aqua fortis* enabled the operation to be carried on in a much more satisfactory manner than the method described by the patentee.

Examples.

In the case of the *Hinks* patent for the duplex lamp, the drawing attached to the specification did not show, and the letterpress did not describe, a certain aperture through which air was admitted to the second burner, and without which the lamp would not work. *Jessel*, M.R., on this ground, held that the specification was bad.(*f*)

In the case of *Mackelcan's* patent for improvements in floating docks, the patentee was unable to support his contention that his invention consisted in the use of *iron* for the construction of the floating dock described by the complete specification, because that document omitted all mention of the material of which the dock was to be constructed, and the patent was accordingly declared void, as it appeared that floating docks constructed of *wood* and of design similar to that described by the patentee were old.(*g*)

In *Derosne* v. *Fairie* (*h*) it appeared that it was desirable and necessary for the most beneficial working of the plaintiff's patented process for extracting sugar or syrup from cane juice and other substances containing sugar, and for refining sugar and other syrups, to remove all iron from the bituminous schistus used in the operation, and the complete specification did not state how this was to be done. The Court of Exchequer

(*e*) (1815) Holt, N. P. 58; 1 W. P. C. 82 n.

(*f*) Hinks *v.* Safety Lighting Co., (1876) L. R. 4 Ch. D. 607; 46 L. J. Ch. 185.

(*g*) Mackelcan *v.* Rennie, (1862) 13 C. B. N. S. 52.

(*h*) (1835) 5 Tyr. 393; 1 W. P. C. 154.

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set aside the verdict given for the plaintiff, and directed a new trial, on the ground that there was no evidence to show that the process carried on with bituminous schistus in combination with any iron whatsoever would answer at all. The plaintiff had himself declared that in the bituminous schistus which he himself furnished the whole iron was extracted, and it appeared that it was admitted by counsel that the presence of iron would not only be disadvantageous but injurious. Further, without considering whether or not the patent would be avoided by the patentee keeping secret the means requisite to extract the iron from the bituminous schistus, it was clear that the patentee had not shown that what he had described in the patent could be used as so described without injury to the material going through the process. Under all the circumstances, the Court thought the plaintiff ought to have given some evidence to show that bituminous schistus, in the state in which it is found and known in *England*, could be used in the process with advantage; and, as he had not done that, the defendant was entitled to a nonsuit; but, at the same time, as it was alleged that the plaintiff might, on a new trial, supply the defect of proof as to the schistus by other evidence, the Court was desirous that the patent, if a good one, should not be affected by their judgment, and therefore they granted the new trial.

It was laid down by *Parke*, B., to the jury in *Neilson* v. *Harford*,(*i*) that if the patentee knew that internal partitions in a certain cylinder, interposed between a blowing apparatus and a furnace, were useful, the omission to state that fact in the specification would be a fatal defect.(*k*) And in *Rex* v. *Arkwright* (*l*) it was proved that for the successful working of the defendant's spinning machinery it was necessary that the difference in the velocity of certain rollers should be adjusted, and the specification was silent on this point. *Buller*, J., commenting on the evidence which the defendant adduced to show what his invention really was, used the following words: "The man that comes to give an account of the invention says, 'I had calculated it, and the difference of the velocity was to be as five to one; this is the way I made my rollers.' Now the defendant has not said a word of that in his specification. In that he has kept back the knowledge he had as to the size of the rollers and velocity, and it is left to people to find it out as

(*i*) (1841) 1 W. P. C. 317, 321.
(*k*) See also Macnamara *v.* Hulse, (1842) Car. & M. 471; 2 W. P. C. 128 n.
(*l*) (1785) 1 W. P. C. 70.

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chance may direct." The jury gave a verdict against the patentee, the sufficiency of the specification being one of the issues.

It is not requisite that all processes claimed shall be equally successful.

Though it is essential that all the processes described and claimed should be successful,(*m*) it is not necessary that all the processes described in a specification should prove equally successful, or of equal commercial value. The fact that persons to whom the specification is addressed have to try them to determine which is the best commercially, or that even the patentee himself does not know which is the best at the time, will not invalidate the patent.(*n*)

Lord *Herschell*, in his judgment in the House of Lords in *The Badische Anilin und Soda Fabrik* v. *Levinstein*,(*o*) after having pointed out the causes which may give a different commercial value to a given product at given times, continued :—

> "It was urged by the learned counsel for the respondents that a patentee is bound to disclose the means by which his invention may be carried into effect, and that, if he leaves this to be ascertained by experiments, his patent cannot be supported. This is, no doubt, correct. But I think the patent under consideration does show how the colouring matters are to be produced, and that what it leaves a skilled person of the class to whom the specification is addressed to discover, is, only, which of these colouring matters will best answer his purpose at any particular time. There is, in my opinion, no warrant for asserting that this invalidates the patent."

When an improved method discovered during the period of provisional protection should be included, and when it should not be included.

The question may arise as to whether, if an inventor, after having lodged a provisional, but before filing a complete specification, discover an improvement on the invention covered by such provisional specification, he must include a description of the improvement in his final specification (on the ground that the document would be insufficient without it, the improvement being the best means known to the patentee of performing the invention), or whether the improvement may form the subject-matter of a separate and further patent. In such a case it would appear that the real point to decide would be the nature of the improvement in question. It is submitted that, if the evidence establish this to be only a method of carrying out the

(*m*) Beard *v.* Egerton, (1846–9) 19 L. J. C. P. 39 ; Derosne *v.* Fairie, (1835) 1 W. P. C. 165 ; Cole *v.* Saqui, (1888) 5 R. P. C. 494.

(*n*) Otto *v.* Linford, (1881) 46 L. T. N. S. 35 ; Badische Anilin und Soda Fabrik *v.* Levinstein, (1887) 4 R. P. C. 449 ; L. R. 12 App. Cas. 710 ; Thomson *v.* Batty, (1889) 6 R. P. C. 84, 97.

(*o*) (1887) 4 R. P. C. 466 ; L. R. 12 App. Cas. 710.

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invention covered by the provisional specification, the omission of a description of it would render the final specification bad on the ground that the document did not contain the best method known to the patentee of performing the invention. It is further submitted that if the patentee were to obtain a second patent in respect of such an improvement, he would thereby obtain an extension of the monopoly and impose on the public the necessity of taking out two licences if they desired to use the improvement, whereas they ought to have the benefit of it under a licence to use the first patent. If, however, the improvement consist in an invention which is really distinct from that comprised by the provisional specification, it may be capable of forming the subject of a separate patent,(*o*) and the insertion of it in the final specification would be a fatal defect; for the claim to the improvement in that case would be a claim to an invention in respect of which the provisional specification gave no protection, and the patent therefore could not include it.(*q*)

Provisional protection is granted to the patentee for the express purpose of enabling him to bring the invention to a state of perfection, and it is only equitable that he should be compelled to disclose the latest and best information he possesses, so that the public may profit by it when the patent expires.

If the improvements made during the period of provisional protection be of such a nature as not to fall within the limits of the provisional, they must not be inserted in the final specification, as a claim to them would probably render the patent void; (*r*) moreover, the patentee, by a general claim, cannot include in his patent improvements of which he was ignorant at the date of the patent.(*s*)

Bailey, J., speaking at a time when the patent was granted before, and subject to, the filing of a final specification, said: "It is the duty of the inventor, if between the period of taking out the patent and enrolling the specification he makes discoveries which will enable it better to effectuate the thing for which the patent was obtained, not only that he is at liberty to introduce them into his patent, but that it is his bounden duty so to do, and that it is not sufficient for him to communicate to

(*p*) Edison *v.* Woodhouse, (1887) L. R. 32 Ch. D. 520.

(*q*) Edison *v.* Woodhouse, (1887) L. R. 32 Ch. D. 520; Crossley *v.* Potter, (1853) Mac. P. C. 240; Bailey *v.* Roberton, (1878) L. R. 3 & 5 App. Cas. 1055; Penn *v.* Bibby, (1866) L. R. 2 Ch. 27; Siddell *v.* Vickers, (1888) 39 Ch. D. 105.

(*r*) pp. 168–175 *ante*.

(*s*) Tetley *v.* Easton, (1852) Macr. P. C. 77.

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the public the knowledge which he had at the time he obtained the patent, but he ought to communicate to the public the knowledge he has obtained before the specification.(*t*)

And *Tindal*, C.J., speaking at a like period, declared that a patentee is bound to give in his specification the most improved state of his invention up to the time of enrolling his specification.(*u*)

A patentee filing a provisional specification which shows the nature of his invention is not bound to describe therein any mode of carrying it into effect; but if he does so, and before filing his complete specification discovers an improvement in such mode, he is bound to give to the public in his complete specification the benefit of what he has discovered as to the mode of carrying the invention into effect; and a statement in the complete specification of improvements in the arrangement of the mechanism, in the relative position and adaptation of the different parts with a view to producing the same results, the substitution of mechanical equivalents, modifications and developments within the scope of the invention set out in the provisional specification will not invalidate a patent on the ground of disconformity between the provisional and complete specification.(*x*)

When a patentee explained the objection to his specification, that it did not contain all the knowledge he possessed relative to carrying out the invention, by saying that, at the date of the patent, he did not think a certain substitute for a method given equally good to that described, and that, though since the date of the patent he had actually patented the new method he had in fact returned to the original, the Court held that the patent was not invalidated.(*y*)

And when, during the interval between the filing of the provisional and complete specifications of an invention of an electric lamp with a carbon filament made in a particular manner, the patentee lodged a provisional specification of an invention for another method of making the carbon filament, the Court held that it was no objection to the validity of the patent for the

(*t*) Crossley *v.* Beverley, (1829) 1 W. P. C. 117; 3 C. & P. 513.

(*u*) Jones *v.* Heaton, 1 W. P. C. 404 n.; see also Crossley *v.* Beverley, (1829) 1 W.P. C. 117; Woodward *v.* Sansum, (1887) 4 R. P. C. 166; Crampton *v.* Patents Investments Co., (1888) 5 R. P. C. 397.

(*x*) Woodward *v.* Sansum, (1887) 4 R. P. C. 166; Siddell *v.* Vickers, (1888) L. R. 39 Ch. D. 92, 103; Plimpton *v.* Malcolmson, (1875) L. R. 3 Ch. D. 531, 580; Moseley *v.* Victoria Rubber Co., (1887) 4 R. P.C. 241; Crampton *v.* Patents Investments Co., (1888) 5 R.P.C. 382, 397; see pp. 166–175 *ante*.

(*y*) Thomson *v.* Batty, (1889) 6 R. P. C. 84, 100.

first invention that the patentee did not in the complete specification filed in respect of it, disclose the method of making the filament which formed the subject of the invention disclosed by the second provisional specification.(*z*)

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IX. *The complete specification need not mention everything which will produce the desired result, or every mode of performing or applying the invention.*

No necessity to state every means of producing a desired result.

It is not necessary that the specification should state precisely every means that will produce a given effect. Thus the specification of *Bickford's* miners' safety fuse, which was formed of several strands of flax, hemp, &c., enclosing within the interior a small core of fine powder, stated: "I manufacture flax, hemp, cotton, or other suitable materials, spun, twisted, and countered, and otherwise treated in the manner of twine spinning and cord-making, by means whereof I embrace in the centre of my fuse a small portion or compressed cylinder or rod of gunpowder or *other proper combustible matter*, prepared in the usual pyrotechnical manner of firework for the discharging of ordnance." It appeared in the evidence, at a trial in which the sufficiency of the specification was in issue, that gunpowder was, in fact, the material used by the patentee, but, in the opinion of one witness, detonating powder would answer the purpose, but less effectively. The jury gave a verdict for the patentee on the issue of sufficiency, and a rule *nisi* for a new trial was discharged by the Court of Queen's Bench, who were of opinion that it was immaterial if other materials, not specified, but within the description given, would answer the purpose, and that it was certainly not necessary to specify all.(*a*)

If the specification state the best method known to the patentee of carrying the invention into effect,(*b*) it is not necessary to give every means of so doing, though a general claim will not entitle the patentee to improvements of which he was ignorant at the date of the patent.(*c*)

(*z*) Edison *v.* Woodhouse, (1887) L. R. 32 Ch. D. 520.

(*a*) Bickford *v.* Skewes, (1838) 1 W. P. C. 211, 218.

(*b*) pp. 205–213 *ante*.

(*c*) Neilson *v.* Harford, (1841) 1 W. P. C. 356; Badische Anilin und Soda Fabrik *v.* Levinstein, (1887) L. R. 24 Ch. D. 156; 4 R. P. C. 449; 12 App. Cas. 710.

Complete Specification.

X. *If the complete specification describes anything which is not new, it must clearly distinguish that which is old from that which is new, and claim only the latter.*

Distinct claim to something old is fatal.

The Act of 1883 (*d*) requires that the complete specification shall particularly describe and ascertain the invention; it is impossible to contend that a specification does this, if it describes things which are old as well as the novelty, which is the real invention, without distinguishing the one from the other. The point to be carefully borne in mind in considering this question is whether or not the claim amounts to a claim to anything which is old, in which case the specification will be bad, and the patent void, on the ground that the patentee has claimed something which lacks the essential feature of novelty.(*e*)

Claim may be only apparently for something old.

It is, however, to be observed that sometimes a claim may appear to include something which is old, whereas on the true construction of the specification it does not really amount to more than a statement that the invention is equally as useful for some purpose for which an alleged anticipation was useful as it is for the purpose which is the subject of the claim, and for which the alleged anticipation is wholly useless. Such a claim will not vitiate the patent, though it may be objectionable from the draughtsman's point of view as not being as clearly drawn as it might be.(*f*)

Claim to improvements on old things, and combinations of old parts.

In the case of a patent for a combination which consists of new and old parts, if the combination is only claimed as a whole, it is not necessary to specify which of the parts are new and which old.(*g*)

An improvement on an existing machine may be the subject-matter of a new patent;(*h*) but if the specification does not distinguish clearly the improvement from the old parts, and claim only the new improvement, the patent will be void, for it cannot include both the addition and the old machine.(*i*)

(*d*) 46 & 47 Vict. c. 57, s. 5, sub-s. 4.

(*e*) Chap. iii. *ante*, p. 222 *post*.

(*f*) See Lyon *v.* Goddard, (1894) 11 R. P. C. 361.

(*g*) Moore *v.* Bennett, (1884) 1 R. P. C. 129, 142; Foxwell *v.* Bostock, (1864) 4 De G. J. & S. 298; Harrison *v.* Anderston Foundry Co., (1876) L. R. 1 App. Cas. 574; Watling *v.* Stevens, (1886) 3 R. P. C. 37; Proctor *v.* Bennis, (1887) 4 R. P. C. 333, 358; Kaye *v.* Chubb, (1888) 5 R. P. C. 641; Clark *v.* Adie, (1873) L. R. 2 App. Cas. 315, 328.

(*h*) p. 65 *ante*.

(*i*) Rex *v.* Else, (1785) 1 W. P. C. 76; Bovill *v.* Moore, (1815) 2 Coop. Ch. Cas. 56; Dav. P. C. 361; Potter *v.* Parr, (1815) 2 B. & S. 216 n.; Moore *v.* Bennett, (1884) 1 R. P. C. 129, 143; Harrison *v.* Anderston Foundry Co., (1876) L. R. 1 App. Cas. 574; Parkes *v.* Stevens, (1869) L. R. 8 Eq. 358, 366.

Complete Specification.

And if, in the case of a combination patent, the combination as a whole is not new, but there is some particular improvement in some particular part, the specification will be insufficient if it claims the whole combination as new. It must condescend upon that which is improved, and specifically lay claim to that and that only.(*k*)

Thus, if a compensation pendulum were now for the first time invented, it would not do to patent improvements in clocks in general terms, introducing somewhere in the course of the description the mode of making a compensation pendulum, and then end by claiming the arrangement and combination. The patentee ought to say expressly : "I claim the invention of a compensation pendulum, and make it thus."(*l*)

A new combination of old parts, or partly old and partly new parts, may form the subject-matter of a valid patent.(*m*) If a combination of a certain number of these parts existed before the date of the patent, and if the patentee's invention sprung from that point, and added other combinations to it, then the specification will be bad if it state the whole machine as the invention.(*n*) If, on the other hand, all the parts are old, the specification will be bad unless it claim only the new combination.(*o*) A patentee is required to set forth in the complete specification a true account and description of his invention, and it is necessary that he should state what his invention is—what he claims to be new, and what he admits to be old ; for, if the specification states simply the whole machinery which he uses, and which he wishes to introduce into use, and claims the whole of that as new, and does not state that he claims either any particular part, or the combination of the whole, as new, then his patent must be taken to be a patent for the whole and for each particular part, and his patent will be void if any particular part turn out to be old, or the combination itself not new.(*p*)

Again, if the specification describe both old and new parts without clearly making it appear that that which is old is not claimed, the patentee must be taken to lay claim to all, and the

(*k*) Moore *v.* Bennett, (1884) 1 R. P. C. 129, 143 ; Philpot *v.* Hanbury, (1885) 2 R. P. C. 33, 39.

(*l*) Per James, V.C., Parkes *v.* Stevens, (1869) L. R. 8 Eq. 358, 365.

(*m*) p. 58 *ante*.

(*n*) Bovill *v.* Moore, (1815) per Gibbs, L.C.J., Dav. P. C. 404.

(*o*) Lister *v.* Leather, (1857) 3 Jur. N. S. 811 ; 8 E. & B. 1004 ; Seed *v.* Higgins, (1860) 8 H. L. Cas. 550 ; Potter *v.* Parr, 2 B. & S. 216 n. : Kay *v.* Marshall, (1837) 2 W. P. C. 71 ; Moore *v.* Bennett, (1884) 1 R. P. C. 129 ; Proctor *v.* Binnis, (1887) 4 R. P. C. 333, 358 ; Clark *v.* Adie, (1873) L. R. 2 App. Cas. 315, 328.

(*p*) Per Abinger, C.B., Carpenter *v.* Smith, (1841) 1 W. P. C. 530.

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specification will be consequently bad.(*q*) But this rule may, perhaps, admit of some modification in favour of the patentee, in respect of things incidentally mentioned, which are old and universally known to be so; for, if he had occasion to introduce a hinge into his machinery, it would be absurd to expect that he should point out that the hinge was not new.(*r*)

In the case of an invention which is alleged to be an improvement on something which has been done before, it is necessary that the complete specification should state in what the improvement consists. If the invention be claimed as an improvement, and nothing is said of any previous use of which the thing proposed is an improvement, the patent may incur the risk of being construed as a claim of entire and original discovery.(*s*)

In *Holmes* v. *The London and North-Western Railway Co.*(*t*) it appeared that the plaintiff had obtained a patent for "an improved turning-table," all the component parts of which, except one, were comprised in a prior patent, the specification of which was not enrolled until after the date of the plaintiff's patent. The plaintiff, in his specification, claimed "the improved turning-table hereinbefore described," without showing that any part of it was old. The jury found that the introduction of certain suspending rods made the table a new instrument, and gave a verdict for the plaintiff, which was, however, ordered by the Court of Common Pleas to be entered for the defendant, on the ground that the specification was bad, as not distinguishing between the new and the old.

So in *Macfarlane* v. *Price* (*u*) the omission of a distinction between the new and old matters mentioned in the specification proved a fatal defect to the plaintiff's patent for "improvements in umbrellas," and in *Saunders* v. *Aston* (*x*) a patent for "improvements in making buttons" was declared void on account of a like omission in the specification.(*y*)

Rule in Foxwell *v.* Bostock.

Lord *Westbury*, L.C., in *Foxwell* v. *Bostock*,(*z*) laid down the rule, as following from the decided cases, that in a patent for an improved arrangement or new combination of machinery, the specification must describe the improvement and define the novelty, otherwise, and in a more specific form, than by the

(*q*) Tetley *v.* Easton, (1852) Macr. P. C. 48.

(*r*) Per Coleridge, J., Macr. P. C. 87.

(*s*) Hill *v.* Thompson, (1818) 1 W. P. C. 247; Leggott *v.* McGeort, (1893) 10 R. P. C. 429, 435.

(*t*) (1852) Macr. P. C. 4; 12 C. B. 831; 22 L J. C. P. 57.

(*u*) (1816) 1 Stark. R. 199.

(*x*) (1832) 1 W. P. C. 75.

(*y*) See also Mackelcan *v.* Rennie, (1862) 13 C. B. N. S. 52.

(*z*) (1864) 4 De G. J. & S. 298, 313.

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general description of the entire machine; it must assign the *differentia* of the new combination.

If an improved machine is the result of several combinations, the claims may be so framed that the several combinations leading up to the one principal combination may be themselves divided into several parts in which each specific combination, A, B, and C, may be considered as a separate integer, and each such integer may in itself be the subject of a claim or separate letters patent, and also in their combination the several inventions, A, B, and C, may produce a total result which may also be the subject of a claim or separate letters patent.(*a*)

In *Lister* v. *Leather* (*b*) it was stated by Lord *Campbell*, C.J., and approved by the Court of Exchequer, that if the combination, the subject of the patent, was new and useful, though each of the parts which entered into it were old, still the combination might be the subject of a valid patent, and a patent for a combination is not a claim that each part thereof is new. On the contrary, each part may be old, and yet a new and useful combination of such old parts may be valid, as has often been decided. Further, a valid patent for an entire combination for a process gives protection to each part thereof that is new and material *for that process*, without any express claim of particular parts, and notwithstanding that parts of the combination are old.

Explanation of the rule in Foxwell *v.* Bostock.

The decisions in *Foxwell* v. *Bostock*, and *Lister* v. *Leather*, deserve careful consideration, and have formed the subject of judicial explanation and comment. First, *Foxwell* v. *Bostock* must not be taken as deciding that where there is a patent for a combination there must be a discovery or explanation of the novelty of each respective part, and that the specification must also show what is the novelty and what the merit of the invention. On the contrary, in the case of a patent for a combination the combination itself is, *ex necessitate*, the novelty, and the combination is also the merit, if it be a merit, which must be proved by evidence. And the claim to it is a sufficient description.(*c*) The rule in *Foxwell* v. *Bostock*, when properly explained, really only means that when a claim is made to a general combination and arrangement of the different parts of a machine, if the combination is not new, but there is some particular improvement in some particular part, it will not

(*a*) Clark *v.* Adie, (1873) L. R. 2 App. Cas. 315. 327.

(*b*) (1857) 8 E. & B. 1031; 27 L. J. Q. B. 295; 4 Jur. N. S. 947.

(*c*) Harrison *v.* Anderston Foundry Co., (1876) L. R. 1 App. Cas. 576, 580; Proctor *v.* Bennis, (1887) L. R. 36 Ch. D. 740; 4 R. P. C. 333.

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do to claim the whole combination as new, but the patentee must condescend upon that which is improved. For example, if a machine exactly similar to another had been in long use in a particular trade, and some particular improvement, say, in the arrangement of a cog, or in the arrangement of some other portion of an old combination, which was new and useful, had been made, the general combination remaining the same, then it would be a misdescription to describe it as a new combination, because the thing discovered would be a particular improvement *upon* a particular part or element of that combination.(*d*)

If it is clear that the claim is for a combination, and nothing but a combination, there can be no infringement of the patent unless the whole combination, or such combination of some or all other parts as amounts only to a colourable imitation, be used;(*e*) and it is in that way immaterial whether any or which of the parts are new. It might, however, be left open on the specification for the patentee to claim not merely the combination of all the parts as a whole, but also certain subordinate or subsidiary parts of the combination, on the ground that such subordinate or subsidiary parts are new and material, as it was held a patentee might do in *Lister* v. *Leather*; in such a case, in accordance with the true meaning of the rule in *Foxwell* v. *Bostock*, it would appear that the specification would be defective if, by merely giving a general description of the whole combination, it left in doubt what claim to parts in addition to the claim to the combination the patentee meant to assert. The specification must not mix up the real novelty with the old parts mentioned, and so render it necessary for a person reading it to get rid of a large portion by eliminating all that is old and commonplace, all that has formed the subjects of other patents and other improvements, before he is able to discover in what the new invention made by the patentee really consists.(*f*)

Bowen, L.J., commenting on the decision in *Foxwell* v. *Bostock*, in a subsequent case, said :—

> "When a combination and nothing more is claimed, the combination being the novelty, it is immaterial that the patentee should point out how far he claims for particular portions

(*d*) Moore *v.* Bennett, (1884) 1 R. P. C. 129, 143 ; see pp. 65–71 *ante*.

(*e*) Clark *v.* Adie, (1873) 2 App. Cas. 315, 320 ; p. 476 *post*.

(*f*) Harrison *v.* The Anderston Foundry Co., (1876) L. R. 1 App. Cas. 574, 579 ; Parkes *v.* Stevens, (1869) L. R. 8 Eq. 358, 365 ; Clark *v.* Adie, (1873) L. R. 2 App. Cas. 315, 328 ; Proctor *v.* Bennis, (1887) 4 R. P. C. 333, 350 ; Moore *v.* Bennett, (1884) 1 R. P. C. 129.

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which go to make up the combination. Those portions are not his claim, but it is the putting them together and combining them that constitutes his claim. That seems to be the true law as laid down in *Harrison* v. *The Anderston Foundry Co.*, without a reference to which case *Foxwell* v. *Bostock* ought not to be read, because it is possible to misread *Foxwell* v. *Bostock*, unless you correct your impression of it afterwards by the judgment of the House of Lords, *Harrison* v. *The Anderston Foundry Co.*" (*g*)

An apparent but not real exception to the rule in Foxwell v. Bostock.

Harmar v. *Playne* (*h*) at first sight appears an exception to the rule in *Foxwell* v. *Bostock*, but it is not so. It there appeared that a patent was taken out for a machine, and that the inventor afterwards discovered an improvement and obtained a second patent for the improved machine, describing in the specification the whole machine without distinguishing the improvement. The Court overruled the objection that the specification was bad, saying that the patentee had, in the second specification, recited the first, and that recital being in immediate comparison with the new specification, furnished *in gremis* of the new patent, the means of distinguishing the new from the old.

Claim to an entire combination for a process protects all parts new and material for that process.

The marginal note in *Lister* v. *Leather*, if hastily read, is calculated to give colour to the erroneous conclusion that it decided that a patent for a combination or arrangement is a distinct patent for everything that is new and material, and goes to make up the combination. A careful consideration of the judgment, however, shows that there is really no warrant for this notion. What the decision really amounts to is a declaration that a valid patent, for an entire combination for a process, gives protection to each part thereof that is new and material *for that process*; which is really nothing more than saying, in other words, that you not only have no right to steal the whole, but you have no right to steal any part of a man's invention; and the question is in every case a question of fact —is it really and substantially a part of the invention? (*i*) If a man is desirous of securing to himself protection by letters patent, in respect of not only the whole, but something less than the whole, of a new arrangement, construction, or combination of parts, he must clearly show that he claims that some-

(*g*) Proctor *v.* Bennis, (1887) 4 R. P. C. 358; see also Watling *v.* Stevens, (1886) 3 R. P. C. 153; Keely *v.* Heathman, (1890) 7 R. P. C. 343; Peckover *v.* Rowland, (1893) 10 R. P. C. 118, 234.

(*h*) (1809) 11 East, 101; 14 Ves. 130; Dav. P. C. 311.

(*i*) Per James, V.C., Parkes *v.* Stevens, (1869) L. R. 8 Eq. 365; Clark *v.* Adie, (1873) L. R. 10 Ch. 674; L. R. 2 App. Cas. 315.

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thing less more specifically than by merely describing and claiming the whole.(*k*) If, on the other hand, the invention is for the combination only, and not any of the specific parts, the specification must make it clear that it is the combination, and not any of the specific parts, which is claimed.(*l*)

The Claiming Clauses.

Distinct claiming clauses are in practice required, but are not absolutely necessary.

Previous to the passing of the Patents Designs and Trade Marks Act 1883, a distinct claim was not a necessary part of the complete specification, but it had long been the practice to insert one, in spite of the fact that it had been held that neither a claim nor a disclaimer was essential; and further, that that which appeared to be the invention, or part of it, would be protected though there were no distinct claim, and those matters which manifestly formed no part of the invention need not be disclaimed.(*m*)

The Act of 1883, however, expressly provides (*n*) that the complete specification must, in every case, end with a distinct statement of the invention claimed, but this provision is only in the nature of a direction, and a failure to comply with it will not invalidate the patent.(*o*) Consequently, it is no more necessary since the Act of 1883 than before it that the complete specification should end with a distinct claim, if what the patentee claims can be gathered from the specification; though it must not be forgotten that, independently of the provisions of s. 5, sub-s. 5, of the Act of 1883, the specification may be so indefinite as to be bad, on the ground that the patentee has not fulfilled the obligation of properly describing the invention for which he claims the protection of the law.(*p*)

A "distinct statement" means something more than a separate paragraph. It should be a concise statement of the main features of the invention, something to which the reader may readily refer, and learn therefrom, without referring to the body of the specification, what are the characteristic features of the invention claimed.(*q*)

(*k*) Clark *v.* Adie, (1873) L. R. 10 Ch. 667; L. R. 2 App. Cas. 315.

(*l*) Rowcliffe *v.* Morris, (1886) 3 R. P. C. 17; Murray *v.* Clayton, (1872) L. R. 7 Ch. 570, 578; Westinghouse *v.* Lancashire and Yorkshire Ry. Co., (1884) 1 R. P. C. 229, 241; Watling *v.* Stevens, (1886) 3 R. P. C. 37.

(*m*) Lister *v.* Leather, (1857) 8 E. & B. 1004: Dudgeon *v.* Thomson, (1877) L. R. 3 App. Cas. 34, 54; Plimpton *v.* Spiller, (1877) L. R. 6 Ch. D. 426.

(*n*) S. 4, sub-s. 5.

(*o*) Siddell *v.* Vickers, (1888) 5 R. P. C. 431–3; L. R. 39 Ch. D. 92.

(*p*) *Ibid.*

(*q*) Siddell *v.* Vickers, (1888) 5 R. P. C.; L. R. 39 Ch. D. 109; but see Smith's Patent, Griff. P. C. 268.

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The claim is not to be considered as a description of the means of performing the invention, but it is introduced as a security for the patentee. It is evident that the patentee may in the specification have alluded to things which are not new, in his endeavour to describe the invention and the manner of performing it; in such a case, the claim is introduced, not with the object of aiding the description, but so that the patentee may limit his claim to protection only to such matters as he can prove are his invention and new.(*r*) The real object is not to claim anything which is not mentioned by the specification, but to limit the claim, and, in the language of *James*, L.J.,

Claims operate as a security for the patentee.

> "A man who has invented something gives in detail the whole of the machine in his specification. In doing that he is of necessity very frequently obliged to give details of things which are perfectly known and in common use. He describes new combinations of old things to produce a new result, or something of that kind. Therefore, having described his invention, and the mode of carrying that invention into effect, by way of security, he says, 'But take notice, I do not claim the whole of that machine: I do not claim the whole of that *modus operandi*, but that which I claim is that which I am now about to state.' That surely is the legitimate object of a claim, and you must always construe a claim with reference to the whole of a specification." (*s*)

A claim is by implication a disclaimer.

It is a frequent practice for a patentee in his specification to state that he does not claim such and such a thing described; but this is not necessary, for when a distinct claim is made the patentee is not bound further to distinguish between what is claimed and what is disclaimed, for everything which is not included in the claim is thereby disclaimed.(*t*) And, consequently, if a patentee has described in his specification a number of distinct inventions which are all new and useful, but so related as probably to come within one patent,(*u*) and he has chosen to claim only one, he has thereby made a present of the rest to the public, and he can only be protected in respect of the one

(*r*) Kay *v.* Marshall, (1836) 2 W. P. C. 39.

(*s*) Plimpton *v.* Spiller, (1877) L. R. 6 Ch. D. 426; see Edison *v.* Woodhouse, (1886) 32 Ch. D. 520; Daw *v.* Eley, (1867) 14 W. R. 126; L. R. 3 Eq. 496; Russell *v.* Cowley, (1835) 1 W. P. C. 465; Thomas *v.* Welch, (1866) L. R. 1 C. P. 192; Edison Bell Phonograph Corporation *v.* Smith, (1894) 11 R. P. C. 401.

(*t*) Harrison *v.* The Anderston Foundry Co., (1876) 1 App. Cas. 574, 579; Easterbrook *v.* Great Western Ry. Co., (1885) 2 R. P. C. 201, 208; Lucas *v.* Miller, (1885) 2 R. P. C. 159; Hinks *v.* Safety Lighting Co., (1876) L. R. 4 Ch. D. 607, 612; United Telephone Co. *v.* Harrison, (1882) L. R. 21 Ch. D. 721, 741.

(*u*) See p. 296 *post*.

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he has claimed.(*x*) Thus, where a patentee claimed a general combination, and also certain subsidiary parts, the House of Lords held that the claim to those specified subsidiary parts excluded the possibility of a claim for any other parts.(*y*) Again the omission to include an essential part in a combination claim may be fatal on the ground that the combination actually claimed is not useful, and is not subject-matter.(*z*)

Rules to be observed in drafting claiming clauses.

The following are the chief features to be observed in drafting claiming claims:—

I. The claim must not be too extensive, so as to embrace more than the patentee has invented.

II. The claim must be specific, and not of a vague, ambiguous, speculative, or hypothetical nature.

III. If the invention comprise one or more subordinate parts, the patentee will not be entitled to protection in respect of those subordinate parts unless he claim them specifically.

IV. A claim to something old, when that claim is not made *in gross*, but only as *appendant* to something new, will not vitiate the patent.

V. A patent for the production of a new and useful material will not be vitiated by a claim to a particular use of that material, though that use could not itself form the subject-matter of letters patent.

I. *The claim must not be too extensive, so as to embrace more than the patentee has invented.*

Claim which extends to what patentee has not invented or described is fatal.

If the patentee lay claim to anything he has in fact not invented,(*a*) or not described,(*b*) he will thereby render his patent bad, notwithstanding that the specification may describe and

(*x*) Hinks *v.* Safety Lighting Co., (1876) L. R. 4 Ch. D. 607, 612; Jackson *v.* Wolstenhulmes, (1884) 1 R. P. C. 105; Fairburn *v.* Household, (1886) 3 R. P. C. 263; Parkinson *v.* Simon, (1895) 12 R. P. C. 406.

(*y*) Harrison *v.* Anderston Foundry Co., (1876) L. R. 1 App. Cas. 574, 578.

(*z*) Weir *v.* Denny, (1894) 11 R. P. C. 657.

(*a*) Chap. iii.; R. *v.* Else, (1785) 1 W. P. C. 76; Thomas *v.* Foxwell, (1858) 5 Jur. N. S. 37; 6 Jur. N. S. 271; Crossley *v.* Potter, (1853) Macr. P. C. 240; Ralston *v.* Smith, (1860) 9 C. B. N. S. 117; 11 C. B. N. S. 471; 11 H. L. Cas. 223; Booth *v* Kennard, (1856) 2 H. & N. 84; Saunders *v.* Aston, (1832) 3 B. & Ad. 881; 1 W. P. C. 75; Haworth *v.* Hardcastle, (1834) 1 W. P. C. 484; Jordan *v.* Moore, (1866) L. R. 1 C. P. 624; Patterson *v.* Gaslight and Coke Co., (1875) L. R. 2 Ch. D. 812; 3 App. Cas. 239; Bailey *v.* Roberton, (1876) L. R. 3 App. Cas. 1055; Cropper *v.* Smith, (1884) 1 R. P. C. 81; Gandy *v.* Reddaway, (1885) 2 R. P. C. 49; Leadbeater *v.* Kitchin, (1890) 7 R. P. C. 235.

(*b*) Monnet *v.* Beck, (1897) 14 R. P. C. 777.

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claim things which are new and of which he was the undoubted discoverer. Thus, if the specification describe both a machine and a method of using it, and the evidence establish that the machine was old, but that the method was new, the patent cannot be supported, unless the claim is strictly limited to the method of using the machine.(*c*) So also a patent is void when upon the true construction of the specification the claim includes both a process and an apparatus for carrying it out, and the latter is old.(*d*) If the claim was for the process combined with the apparatus the lack of novelty in the apparatus would no doubt be no objection to the validity of the patent, for there would then be no separate claim to it.(*e*)

The patentee must not lay claim to every mode of carrying a principle into effect, for such a claim amounts to a claim to the principle itself,(*f*) and a principle alone cannot form the subject-matter of a valid patent;(*g*) moreover, if a claim be so wide in its terms as to amount to the enumeration of a known truth, it cannot be supported.(*h*)

Hill's patent, for an invention of improvements in the smelting of iron, was rendered void because in the specification he claimed both the usefulness of lime in the process, and the use of a certain specified quantity, whereas it appeared in evidence that the use of lime for the purpose was not new. The patent was therefore declared void, although it might possibly have been good if the claim had been limited to the use of the specified quantity.(*i*)

Minter's patent for an improvement in the construction of chairs suffered from a like defect in the specification, and was consequently declared void by the Court when its validity was questioned. It appeared that a chair on the same principle as *Minter's* had been invented before the patent, but encumbered with additional parts, and, unfortunately for *Minter*, the claim in his specification included not only the chair as made by him, but also the former one, and covered, therefore, more than he had invented. In fact, it would, if upheld, have prevented the former inventor from continuing to make the same chair that he had made before *Minter's* discovery.

(*c*) Hill *v.* Thompson, (1817) 1 W. P. C. 232; Tetley *v.* Easton, (1852) 2 E. & B. 956; but see pp. 62–84 *ante*.

(*d*) Tolson *v.* Speight, (1896) 13 R. P. C. 718.

(*e*) See *ibid.* 721; p. 232 *post*.

(*f*) Neilson *v.* Harford, (1841) 1 W. P. C. 355.

(*g*) p. 37 *ante*.

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

(*i*) Hill *v.* Thompson, (1817) 1 W. P. C. 232.

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Claim to something useless for purpose in view is fatal,

A claim to something which is useless for the purpose the patentee has in view is fatal. Thus a patent for extracting gold from ore by cyanide of potassium was held bad because the patentee claimed the use of all strengths of solution of cyanide, whereas the evidence established that a weak solution alone would do, and a strong solution was utterly useless for the purpose the patentee had in view.(*k*)

but not so a claim to something of only small utility.

On the other hand, a patentee who discovers a valuable invention does not invalidate his patent by a claim for a second purpose less valuable than the main purpose, unless the second purpose has absolutely no utility, or has been anticipated, or required no invention.(*l*)

A claim may be so extensive, as of itself, quite independently of evidence, to vitiate a patent;(*m*) but a claim must be very extensive indeed to justify the Court in saying, without evidence, that it is impossible to sustain a patent based upon it.(*n*)

Claims are construed with reference to the body of the specification, and after a consideration of it.

The claims are not to be read as isolated sentences, but they must be interpreted by a reference to the body of the specification of which they form a part.(*o*) Consequently, a claim which, isolated, would be bad as being too extensive, may, when explained and narrowed down by a reference to the specification, be perfectly valid.(*p*)

It is not right for the Court which has to construe the claim to look first at the claim and then at the full description of the invention; but the proper course is for the Court first to read the description of the invention in the body of the specification, so as to be prepared to understand what the inventor is about to claim, and then determine whether the claim really goes further than what is described.(*q*)

Thus in *Leonardt* v. *Kallé*,(*r*) the subject-matter of the patent was the production of various colouring-matters fast to

(*k*) Cassel Gold Extracting Co. *v.* Cyanide Gold Recovery Syndicate, (1894) 11 R. P. C. 638; 12 R. P. C. 232, 256; see also p. 144 *ante*.

(*l*) See Adamant Stone and Paving Co. *v.* Corporation of Liverpool, (1896) 14 R. P. C. 11.

(*m*) Neilson *v.* Harford, (1871) 1 W. P. C. 355; Arnold *v.* Bradbury, (1871) L. R. 6 Ch. 706.

(*n*) Arnold *v.* Bradbury, (1871) L. R. 6 Ch. 706; Wyeth *v.* Stone, 1 Story, 273.

(*o*) Edison *v.* Woodhouse, (1887) 4 R. P. C. 107; Parkinson *v.* Simon, (1894) 11 R. P. C. 238, 493; 12 R. P. C. 403; p. 247 *post*.

(*p*) Arnold *v.* Bradbury, (1871) L. R. 6 Ch. 706; Edison v. Woodhouse, (1887) 4 R. P. C. 107; Kay *v.* Marshall, (1835) 2 W. P. C. 36; Beard *v.* Egerton, (1849) 3 C. B. 165, 215.

(*q*) Arnold *v.* Bradbury, (1871) L. R. 6 App. Cas., judgment of Lord Hatherley, L.C., p. 712; Edison-Bell Phonograph Corporation *v.* Smith, (1894) 11 R. P. C. 389, judgment of Esher, M.R., pp. 395–396.

(*r*) (1895) 12 R. P. C. 103.

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alkali by the action of suitable oxidisable substances, and for alkalies upon a certain substance under heat. It was objected that the claim was too general, as it stated that oxidisable substances other than those specifically mentioned could be used, and this would include zinc dust, the action of which on the certain substance was already known, and further, because whilst claiming colouring matters the specification did not indicate the processes necessary to produce particular shades. But *Romer*, J., who tried the case, held that this objection failed because the claim, read with the body of the specification, was limited to an oxidation by the zinc dust further—*i.e.*, more complete—than that already known; and the patentee having pointed out the limits of colours his process could produce, it was not incumbent on him to attempt the almost impossible task of defining shades of colour. A chemist would have no difficulty in selecting any shade he might require.

So if the claim is for the use of a whole class of articles, and only one kind will do, but the evidence shows that although the words of the claim do on the face of them claim the whole class, yet no ordinary workman of ordinary skill and knowledge would think of taking any more than one part of that class, then the claim might be construed as being for that part which an ordinary workman would take, and not for that part which an ordinary workman would not take.(*s*)

If the patentee claims more than he has invented, he by so doing makes his patent null and void. But if he thinks he has invented more than he has in fact invented, and describes advantages arising from what is not, as well as what is, his own invention, it does not follow that the patent may not be a good one; for it can be sustained if the invention, as claimed, is so limited as not to cover things in prior use, though it does refer to advantages common to the use of old things and what the patentee has invented.(*t*)

Also an inventor is entitled to claim not only the use of an improved apparatus for the purpose for which he primarily designed it, but also its use for analogous purposes; and it is no objection to such a claim that there are some analogous purposes to which the patentee's invention would not be applicable.(*u*)

If the complete specification describe any method of carrying out the invention which will not answer, and so lead the

(*s*) Gandy *v.* Reddaway, (1885) 2 R. P. C. 52; Edison *v.* Woodhouse, (1887) 4 R. P. C. 107.
(*t*) Frearson *v.* Loe, (1878) L. R. 9 Ch. D. 48, 58.
(*u*) Chadburn *v.* Mechan, (1895) 12 R. P. C. 120, 134.

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public to perform operations which must necessarily fail, the patent will be bad;(*x*) much more, then, if a distinct claim is made to any such useless method must the patent be void. If the specification claims a number of methods, and any one of them turns out to be bad, the whole patent will be void.(*y*)

II. *The claim must be specific, and not of a vague, ambiguous, speculative, or hypothetical nature.*

Purely speculative claims may prove fatal.

The law will allow a patentee to claim that which he has invented by means of successful experiments or otherwise, and which he has given to the public, but it will not allow him to claim that which is the mere subject of his speculation and imagination, or of his endeavouring to possess more than he is entitled to; and while the Court is bound to give as far as possible the fullest effect to an invention, it is also equally bound to oppose endeavours to make a patent embrace matters that were never in the head of the inventor.(*z*) Moreover, a claim which is general will not entitle a man to improvements of which he was ignorant at the date of the patent.(*a*)

In the language of *Pollock*, C.B., the safest course for patentees to adopt in framing their specifications is, instead of including everything, to confine themselves especially to one good thing, and a jury will always take care that if that be the real invention no man under colour of improvement shall be allowed to interfere with that which is the offspring of their genius.(*b*)

Pollock, C.B., also, in a case where a patentee in his specification had described the use of atmospheric air in a particular way to charge a certain portion of his machinery, and stated: "If any gases or elastic media, other than atmospheric air, are used, with which to charge the case, I claim the sole right to do so," directed a jury that the patentee had, in point of law, no right to make such a claim, and that the law would not permit a patentee to claim more than he had invented. The learned Baron also, in the same case, told the jury that a statement made by the patentee in the specification to the effect that he proposed to construct a certain wheel of every variety of configuration, so long as it was constructed with a channel in the interior,

(*x*) p. 189 *ante*.

(*y*) Patterson *v.* Gas Light and Coke Co., (1875) L. R. 2 Ch. D. 812, 833; L. R. 3 App. Cas. 239.

(*z*) Tetley *v.* Easton, (1852) Macr. P. C. 48, 76.

(*a*) *Ibid.*

(*b*) Crossley *v.* Potter, (1853) Macr. P. C. 256.

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would not do. It appeared that the defendant had used a wheel with *curved* hollow arms, and the patentee desired to treat this as an infringement of his wheel, in which the arms were not curved, but, as the curving of the arms was a further invention and improvement, the patentee's claim failed. To hold that it was good would be to reward a man who had rashly and ignorantly taken out a patent on a subject he had not appreciated.(*c*)

A claim which is so ambiguous that it may be read as including what will not answer the purpose in view as well as what will, is fatal.

If the patentee claims to perform an operation by the use of one or more of several substances, some of which will not answer, and the claim is so ambiguous that it may be read as including those which will not do as well as those which will do, the patent will be void.(*d*)

The following important cases may be given as illustrating this point (*e*) :—

Examples.

Stevens *v.* Keating.

Stevens v. *Keating*, (1847) 2 W. P. C. 181, was an action brought to restrain the infringement of two patents belonging to the plaintiff, one of which related to a method of making cement by mixing gypsum, limestone, or chalk, each in a state of powder, with a strong solution of pearlash in water, and then adding sulphuric acid in sufficient quantity to neutralise the alkali. A stated quantity of water and of the powdered material was next added, and the product was dried and heated to a red heat. The specification stated that "other alkalis and acids, besides those hereinbefore mentioned, will answer the purposes of my invention, though none that I have tried answer so well as the alkali and acid hereinbefore set forth;" and then claimed "the process of mixing the powdered materials, alkalis, and acids, as hereinbefore described, and subsequently burning or calcining the same for the purposes hereinbefore set forth." It was proved at the trial that, though there were certain acids other than sulphuric that would answer, there were other acids that would not answer the purpose of the patentee at all; and *Pollock*, C.B., directed the jury that if the construction was that every acid was claimed, then all acids would not do, and the specification was bad; and if the construction was that some acids were claimed beyond sulphuric acid the patentee did not say whether that was claimed which would do or that which

(*c*) Tetley *v.* Easton, (1852) Macr. P. C. 48.

(*d*) Stevens *v.* Keating, (1847) 2 W. P. C. 181; Tetley *v.* Easton, (1852) Macr. P. C. 48; Hills *v.* London Gas Light Co., (1857) 5 H. & N. 312; Ralston *v.* Smith, (1860) 9 C. B. N. S. 117; 11 C. B. N. S. 471; 11 H. L. Cas. 223; Booth *v.* Kennard, (1857) 2 H. & N. 84; Haworth *v.* Hardcastle, (1834) 1 W. P. C. 480; Saunders *v.* Aston, (1832) 13 B. & Ad. 881; 1 W. P. C. 75 n.; Kurtz *v.* Spence, (1883) 5 R. P. C. 161; Maxim-Nordenfelt Guns and Ammunition Co. *v.* Anderson, (1897) 14 R. P. C. 371, 671.

(*e*) See also other cases *ibid.*

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would not do, and to take it, as he in his second specification explained, he said, "I claim all that will succeed." No person can be allowed to take that course, and to say, "Whereas other substances will succeed, I claim all those substances that may succeed."(*f*) And his Lordship directed a verdict for the defendant on the issue of the sufficiency of the specification, which was upheld by the Court of Exchequer.

Hills *v.* London Gas Light Co.

In *Hills* v. *London Gas Light Co.*, (1857) 5 H. & N. 312; 27 L. J. Ex. 60; 29 L. J. Ex. 409, the plaintiff in his specification claimed the use of "hydrated *or* precipitated oxide of iron" for the purification of gas. It was proved that some of the hydrated oxides of iron would not effect the purpose the patentee had in view. It was objected on behalf of the defendant that the claim included all hydrated oxides of iron, and was therefore bad. The Court of Exchequer, however, admitted that the language was not accurate, but, in its desire to uphold the patent, decided that the patentee meant to refer to such hydrated oxides as were precipitated.

In *Bailey* v. *Roberton*, (1878) L. R. 3 App. Cas. 1055, 1078, a claim to the use of "the alkaline and earthy sulphites" in a specification under a patent for improvements in preserving animal substances was held by the House of Lords to be bad, on the ground of ambiguity. It appeared that some of the earthy sulphites are poisonous, and that some of the alkaline sulphites possess properties which render them unsuitable for the purpose the patentee had in view. It was held that the claim was too wide and vague, and that the specification ought to have defined more precisely the materials to be used.

In *Booth* v. *Kennard*, (1856) 2 H. & N. 84; 26 L. J. N. S. Ex. 23, 305, Booth's patent for "improvements in the manufacture of gas" was declared to be invalid, on the ground that the claim was a claim, not to any particular mode of manufacturing gas from seeds, but to the manufacture of gas from seeds however carried out.

III. *If the invention comprise one or more subordinate parts, the patentee will not be entitled to protection in respect of those subordinate parts unless he claim them specifically.*

If protection is desired for subordinate parts alone, they must be claimed separately.

It is evident that an invention may consist of any number of different parts—A, B C, and D—of which A may be a totally new thing, and B may be a combination of things which in themselves are perfectly old, but which have never been combined in that particular way before, and C and D may be old

(*f*) (1847) 2 W. P. C. 181.

parts. Now, in such a case, the inventor would in law be entitled to protection, both in respect of the whole invention, consisting of the combination A, B, C, and D, and also in respect of the subordinate inventions A and B; but he would not obtain such protection in respect of the subordinate parts alone by laying claim to the combination of the four elements. He must, if he desire it, specifically claim protection in respect of the new subordinate integers of the larger invention.(*g*) Claims.

In considering the above paragraph, the reader must be careful to notice that the integers of the supposed invention are perfectly distinct and separate from the combination A, B, C, D, as a whole. A claim to a combination will no doubt protect the patentee against the use of any of the elements of that combination, if the use of such elements, either alone or together with others, would amount to only a colourable departure from the patentee's specified combination; (*h*) and very little merit will do to support a claim to a subsidiary part of a great invention.(*i*)

Clark v. *Adie* is the leading case which illustrates the fact that a patentee who does not properly claim all he may be entitled to claim thereby loses protection in respect of subordinate parts which he might legitimately have claimed. The case may be epitomised from this point of view as follows:— Patentee is protected only in respect of what he *actually claims*— not in respect of what he might have claimed.

In *Clark* v. *Adie*, (1873) L. R. 10 Ch. 667; 2 App. Cas. 315, it was alleged that the defendant had infringed a patent for "improvements in apparatus for clipping or shearing horses," granted to one *Grayson*, but at the date of the action the property of the plaintiff, *Clark*, by purchase. The specification described the instrument or clipper by reference to drawings, and showed a fluted guide or comb-plate, with a straight edge, like a musical-box comb, the points of the teeth being tapered so as to be raised a little above the surface. A thin plate of steel, with V-shaped cutters, traversed to and fro over the comb, being guided by steerers working in rectangular slots, cut parallel to its edge. The drawings showed the cutter-bar in plan and section, the latter view representing it as somewhat arched or convex in the middle, so as to take its bearing only at the edges. The specification, however, did not allude by any words of description to this peculiarity of form. The two handles were pivoted on a strong stem, set in a square hole in the comb-plate, Clark *v.* Adie is the leading case on this point.

(*g*) Clark *v.* Adie, (1873) L. R. 2 App. Cas. 320, 321; Cropper *v.* Smith, (1884) 1 R. P. C. 87.
(*h*) Clark *v.* Adie, (1873) L. R. 2 App. Cas. 320; p. 218 *ante*.
(*i*) United Telephone Co. *v.* Harrison, (1882) L. R. 21 Ch. D. 720.

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and secured by a nut on the screwed end of the stud. One of these handles worked the cutter, and the other took its bearing at the rear of the comb-plate, and was capable of being set and clamped in different positions, to suit the convenience of the operator. At the end of the working handle a sliding block was pivoted, having slots corresponding with those on the cutter, and the comb could be regulated by means of nuts and washers. By the removal of the nuts on the stems and stud, the instrument could be readily taken to pieces.

The claim was in the following terms: "The general arrangement, construction, and combination of parts, whereby I am enabled to construct an apparatus for clipping and shearing horses and other animals, in such a manner that the apparatus may be adjusted to numerous angles or positions to suit the varying surface of the animals: and whereby the shearing or clipping may be regulated to the exact extent required, without shaving the hair too closely, and, without injuring the animal, leaving a smooth surface without marks, the apparatus being capable of being taken to pieces and adjusted for sharpening or renewing the cutter-bar, or for other purposes, all substantially as herein specified and shown."

It appeared that the plaintiff had bought *Grayson's* patent in order to free himself from any interference in respect of a horse-clipper, made by himself but not patented, which incorporated the arched cutter-bar, the movement thereof parallel to the line of the comb, and the substitution of strong stems secured by nuts and washers instead of being screwed into the comb-plate, but which did not resemble *Grayson's* instrument in other respects.

The alleged infringement consisted in the making of horse-clippers in exact imitation of those brought out by *Clark*, as above stated, and it was contended that there had been infringement of *Grayson's* patent in four particulars—viz., (1) In the use of fixed stems which could not be shaken loose; (2) In applying nuts and washers to the top of the fixed stems above the cutting plate so as to adjust the friction; (3) In forming the cutter-plate in an arch and thereby rendering it elastic; (4) In the mode of communicating motion to the upper or cutting plate, so as to bring it to the true line of cutting. It was argued that, although the defendant had not copied the whole of the apparatus patented, yet he had taken so much of that which was the pith and marrow of it as to make up a subordinate integral part of the invention, and that by taking such subordinate integer, which was in itself matter of protection, he had infringed the patent.

Bacon, V.C., decided the case in favour of the plaintiff, but the

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Court of Appeal and the House of Lords both decided that the defendant, not having taken anything claimed by the patent, had committed no infringement.

Lord *Cairns*, L.C., pointed out that the subordinate integer which was said to be protected, and which the respondent was alleged to have taken, was described as consisting of four different matters—viz., in the first place, what was called the fixed stems, springing from the under or comb-plate, which could not be shaken loose; in the second place, the nuts and washers applied to the top of those fixed stems, above the cutting plate, so as to adjust the friction; in the third place, the shape of the cutter-plate made in an arch, by which the bearing of the cutter-plate upon the comb-plate was better adjusted; and fourthly, the mode of communicating the motion to the upper or cutting plate, so as to bring it to the true line of cutting. In reference to the third of these items, his Lordship said that he had read with great care the specification of *Grayson*, and there was not a word in the letterpress of that specification, from beginning to end, which referred in any shape or form to the arching of the cutter-plate or to the advantage to be derived from that arching; and in answer to a suggestion of the appellant's counsel that the arch form of the cutter-plate was designed in order to bring into play elasticity as produced by the arching, his Lordship pointed out that the cutter-plate was adjusted and fitted to a solid rigid bolt at the back thereof, which restrained any elastic yielding, and stated that he was compelled in the first place to put aside altogether the idea of the advantage of the elasticity of the cutter-plate as an after-thought, which was in no way present to the mind of the patentee. It might be an advantage, but if it was an advantage it was an advantage which subsequent practice and experiment had brought to light, and it was not an advantage which appeared to suggest itself to the mind of the patentee when he made the specification.

In reference to the remaining three items which were alleged to produce the combination, his Lordship remarked that each of them was not, in itself, a new invention, but an old step well known in the making of a clipper, and said: "I have read and re-read, with the greatest anxiety, the specification in the present case. I cannot find from beginning to end of it any sentence or any number of sentences as to which, by any reasonable interpretation, you can say that they make a claim to a subordinate combination of these particular items as constituting in itself a novelty, a new manufacture, a thing to be protected by the patent." The House agreed with the conclusions arrived at by the *Lord Chancellor*, and decided in favour of the respondent.

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IV. *A claim to something old, when that claim is not made in gross, but only as appendant to something new, will not vitiate the patent.*

Subsidiary claims to old things.

A claim which is only subsidiary, even though the thing claimed is old, will not vitiate a patent if it is within the main claim or is only for one of the merits and advantages of the entire construction which the patentee has described, and does not enlarge the monopoly; but if the alleged subsidiary claim really enlarges the main claim and is for something old, then it will be fatal.(*k*)

A claim which is subsidiary to the main claim may be really surplusage as being consequentially protected by the main claim. The patentee should avoid the objection of surplusage in drafting the specification, as he may thereby place himself in an unnecessary position of difficulty should he be called upon to support his patent in a court of law. This will appear from the judgment of Lord *Hatherley* in *British Dynamite Co. v. Krebs* (*l*) quoted below.(*m*)

Leading cases.

The above stated principles, which are often of vital importance, are illustrated by the leading cases given in epitome as follows:—

British Dynamite Co. *v.* Krebs.

In *The British Dynamite Co.* v. *Krebs*, (1875) G. P. C. 88; 13 R. P. C. 190,(*n*) it was sought to upset a patent for "improvements in explosive compounds, and in the means of igniting the same." The specification stated: "This invention relates to the use of nitro-glycerine in an altered condition, which renders it far more practical and safe for use. The altered condition of the nitro-glycerine is effected by causing it to be absorbed in porous unexplosive substances, such as charcoal, silica, paper, or similar materials, whereby it is converted into a powder which I call *dynamite* or *Nobel's* safety powder. By this absorption of the nitro-glycerine in some porous substances it acquires the property of being in a higher degree insensible to shocks, and it can also be burned over fire without exploding. The aforesaid safety powder or dynamite is exploded: *First*, when under close or resisting confinement, by means of a spark or any mode of ignition used for firing ordinary gun-

(*k*) Neilson *v.* Betts, (1871) L. R. 5 H. L. 21; 40 L. J. Ch. 317; Plimpton *v.* Spiller, (1876) L. R. 4 Ch. D. 286; 6 Ch. D. 412; British Dynamite Co. *v.* Krebs, (1875) G. P. C. 94; 13 R. P. C. 190; Ehrlich *v.* Ihlee, (1888) 5 R. P. C. 437.

(*l*) 13 R. P. C. 196; see also Pneumatic Tyre Co. *v.* Casswell, (1896) 13 R. P. C. 180.

(*m*) p. 234 *post*.

(*n*) See also Thompson *v.* American Braided Wire Co., (1889) 6 R. P. C. 528; Fawcett *v.* Horman, (1896) 13 R. P. C. 398, in judgment of Rigby, L.J., p. 410.

powder. *Secondly*, without or during confinement by means of a special fulminating cap, containing a strong charge of fulminate, which is adapted to the end of a fuse and is strongly squeezed to the latter for the purpose of more effectually confining the charge, so as thereby to heighten the effect of the detonation. *Thirdly*, by means of an additional charge of ordinary gunpowder, the explosion of the latter will cause the dynamite to go off even when it is only partially confined. Claims.

"*Claim:* I claim, as the invention secured to me by letters patent as aforesaid, the mode herein set forth of manufacturing the safety powder or dynamite herein described, and also the mode of firing the same by special ignition as herein set forth."

Fry, J., on trying the case, gave judgment for the plaintiff, with costs, but the Court of Appeal (*Jessel*, M.R., *James* and *Thesiger*, L.JJ.) reversed the order and dismissed the action, with costs, on the ground of the insufficiency of the specification and that the claim, in so far as it claimed the modes of firing the dynamite by special ignition set forth, claimed that which was not new. On appeal, however, to the House of Lords, the order of the Court of Appeal was reversed, and the order of *Fry*, J., was restored, with costs to the appellants, on the ground that the specification was sufficient, and that the patentee did not claim the means of explosion *in gross*, but only as *appendant* to dynamite.

Earl *Cairns*, L.C., speaking on the question of the extent of the claim, made the following instructive observations (13 R. P. C. 193): "I will assume that the modes of firing by special ignition, or some of them, were known before the date of the patent, and therefore that if the patentee claimed them as independent inventions (inventions, if I may use the expression, *in gross*), his claim would be too large and his patent void. But is that what he here does or means to do? It is to be observed that the mere manufacture of an explosive substance, such as dynamite, would not, *per se*, have constituted an invention, or, at all events, a useful and practical invention, which could be protected by a patent. An explosive substance like dynamite would be of little or no utility unless there were the means of bringing to bear upon it a method of detonating explosion which would be at once economical and easily applied. . . . . I look upon the means of explosion, even assuming them to be known as applicable to the other substances, to be part and parcel of the invention, which the patentee was bound to give to the public as a complete invention, and I understand him to claim these means of explosion only as part and parcel of this invention. He does not, as it seems to me, claim the means of explosion *in gross*, but only as *appendant* to dynamite, and he

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would not be allowed, under this patent, to claim them for any other purpose. In other words, he claims, in the first claim, the dynamite, the substance itself; and in the second claim the only mode of using the dynamite with which he was at the time acquainted. It is possible that, having stated the means by which the dynamite could be exploded, he might have omitted his second claim, and contented himself with the first. But the second being, as it seems to me, merely a claim to the use of that which is included in the first, I cannot think that the patent should be avoided by the introduction of that which is merely useless."

Lord *Hatherley* upon the same point spoke as follows (13 R. P. C. 196):

"The patentee having, as I have said, discovered a material which will not go off at a moment's notice, it is necessary to show that it will go off somehow or other. And in order that you may know how it will go off the patentee must tell you how to set it off. If he has discovered it he is bound to tell you the best way of doing it. Mr. *Nobel* accordingly tells you that one mode, amongst other modes, is by a percussion cap. That is a mode which has been used for exploding gunpowder and other things, but which, he said, he found would explode this new material called 'dynamite.' Having described his invention, he says in his claim at the end: 'I claim as the invention secured to me by Letters Patent as aforesaid the mode herein set forth of manufacturing the safety powder or dynamite herein described, and also the mode of firing the same by special ignition as herein set forth.' It is a mode of 'special ignition.' He claims the mode of manufacturing safety powder or dynamite and the 'modes of firing the same,' that is the dynamite. The worst that can be said in the way of objection to this is that there is surplusage. The objection of surplusage must be admitted to be one which ought, no doubt, to be very carefully avoided by a patentee. The most that can be said adverse to the patent here is that the patentee might have been quite content to sit still and say: 'Now I have shown you how to make the dynamite. I have shown you what the dynamite is, and I have shown you how to set it off; that is the invention,' without mentioning the firing in the claim. But then, as was well urged by the learned counsel in argument, it cannot be said that this claim deprives any human being, past, present, or to come, of any possible right they might otherwise acquire, because they could not acquire any right in the dynamite without laying themselves open to an infringement of the letters patent in respect of the use of the dynamite. It is the firing of the dynamite, and only dynamite,

in this peculiar mode that is claimed; and you must make use of the patentee's dynamite before you can explode it. He says, 'I am not going to tell you a useless thing. If I did not tell you how to ignite it, you might say that my dynamite is useless, because when it is put in a quarry it will not go off at all, and so I tell you here is my dynamite, and here is my means of igniting it; if you are willing to pay me for it I will hand over to you the full benefit of my invention, first the mode of making the material itself, and then the mode of setting it off.'" Claims.

In *Plimpton* v. *Spiller*, (1875) 4 Ch. D. 286; 6 Ch. D. 412, it appeared that *Plimpton's* specification for the roller skate stated that the invention related to an improvement in attaching the rollers or runners to the stock or footstand of a skate, whereby the rollers or runners were made to turn or cant by the rocking of the stock or footstand so as to assume radii of a circle, and facilitate the performing with ease gyrations or evolutions without taxing unduly the muscles of the foot or ankles. The specification then went on to describe the construction of the skate as a whole, including a description of a mode of attaching the runners and making them reversible, and the two claims were: (1) Applying rollers or runners to the stock or footstand of a skate, as described, so that the said rollers or runners may be cramped or turned, so as to cause the skate to run in a curved line, either to the right or left, by the turning, canting, or tilting of the stock or footstand. (2) The mode of securing the runners and making them reversible as above described. It was held by the Court of Appeal that the want of novelty in the method included in the second claim would not vitiate the patent, as this only amounted to a claim to one of the merits and advantages of the entire construction which the patentee had described, and not in any way to a claim which would enlarge the monopoly secured under the first claim. Plimpton *v.* Spiller.

In *The United Telephone Co.* v. *Harrison*, (1882) L. R. 21 Ch. D. 720; 51 L. J. Ch. 705, one of the questions in issue was whether the claim in the plaintiff's patent, which was in the words, "In an instrument for transmitting electric impulses by sound, a diaphragm or tympan of mica, substantially as set forth," amounted to a claim for the mica diaphragm or tympan in all instruments for transmitting electrical impulses by sound, in which case it would be bad, as being merely a claim to the application of an old thing to a particular purpose, without the use of any ingenuity in that application; or whether it was a claim only to the mica diaphragm or tympan in the particular instrument for transmitting electrical impulses by sound described in the specification. *Fry*, J., was of opinion that the United Telephone Co. *v.* Harrison.

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claim related only to the mica diaphragm in combination with the rest of the instrument, and that the specification was good in regard to that objection. This ruling was upheld by the Court of Appeal, consisting of *Jessel*, M.R., *Lindley* and *Bowen*, L.JJ.

Some subordinate claims are fatal.

It is important to bear in mind that the above statements of the law merely relate to the construction of the specifications in certain particular cases. When there are separate claims for different combinations, the first being for a general combination and the others for combinations of some of the integers which constitute the general combination, it is not right to say that the smaller claims are only to be considered as pointing out what the patentee considers material. On the contrary, when there are more than one separate claim, the first of which is for a general combination, the others may be separate and independent claims for subordinate combinations which will render the patent void if those subordinate parts or combinations are old.(*o*)

V. *A patent for the production of a new and useful material will not be vitiated by a further claim to a particular use of that material, though that use could not itself form the subject-matter of letters patent.*

Claim to a use of a new thing may be good though the use in itself is not subject-matter.

Thus, in *Betts* v. *Neilson*,(*p*) it was objected (*inter alia*) to *Betts'* patent for "a new manufacture of capsules, and of a material to be employed therein, and for other purposes," that the manufacture of capsules from the patented material was not the subject-matter of a patent.(*q*)

The specification claimed, *First*: "The manufacture of the new material, lead combined with tin on one or both of its surfaces, by rolling or mechanical pressure, as herein described. *Secondly*: The manufacture of capsules of the new material of lead and tin combined by mechanical pressure as herein described."

Wood, V.C., the Lords Justices, Lord Chancellor *Chelmsford*, and the House of Lords, all separately held that the objection to the validity of the patent on the ground of the second claim was invalid, and awarded the plaintiff damages in respect of infringements committed by the defendant.

(*o*) Cropper *v.* Smith, (1884) 1 R. P. C. 88, 90, 91; Murchland *v.* Nicholson, (1893) 10 R. P. C. 417.

(*p*) (1868) L. R. 3 Ch. 429; 5 H. L. 1.

(*q*) See p. 71 *ante*.

Lord *Westbury*, addressing the House of Lords, said:— Construction.

"The last objection to the patent is one of a very material character; it is this: that after having described the process and the material, and claiming the material as the result of the process, so that the material is not claimed independently of the process, nor the process independently of the product, the specification concludes with a claim of the manufacture of capsules out of the material. But the manufactures of capsules out of the material would be one purpose only to which the material could be applied; and if a claim to the material can be substantiated by the patent the specification of a particular use of it, comprehended in the general uses claimed, cannot for a moment be accepted as a ground for vitiating the patent."

Construction of the Specifications.

Construction of the specifications is usually necessary in legal proceedings.

During the course of proceedings in which the validity of a patent is contested, it usually becomes necessary to decide, first, whether or not the specification is sufficiently explicit in its directions to enable a person to whom it is addressed to perceive what is the exact invention covered by the patent, and how to carry that invention into practical operation; and, secondly, what is the true construction to be put on the language of the specification when its meaning is dubious, and more than one interpretation is possible. The determination of the first question, which is one of fact, is for the jury, if there be one, otherwise for the Judge acting as a jury.(*r*) The determination of the second question is one of law, and is in all cases for the Court alone.(*s*) The Judge is to state what the specification orders to be done, and the jury are to say whether it would produce the result.(*t*)

Sufficiency is a question for the jury: construction is for the Court.

Interpretation of language used in specifications.

The Court in construing specifications gives to their language the ordinary meaning, unless there are circumstances to show that any word or expression is a term of art, and would be understood by the person to whom the specification may be

(*r*) Walton *v.* Bateman, (1842) 1 W. P. C. 621; Beard *v.* Egerton, (1846) 8 C. B. 165; 19 L. J. N. S. C. P. 36; Hill *v.* Thompson, (1817) 1 Web. P. C. 237; Bickford *v.* Skewes, (1837) 1 Q. B. 938; Neilson *v.* Harford, (1841) 1 W. P. C. 370; Wallington *v.* Dale, (1852) 7 Exch. 888; Parkes *v.* Stevens, (1869) L. R. 8 Eq. 358; L. R. 5 Ch. App. Cas. 36.

(*s*) Hill *v.* Evans, (1862) 31 L. J. Ch. 460: Neilson *v.* Harford, (1841) 1 W. P. C. 370; British Dynamite Co. *v.* Krebs, (1875) G. P. C. 91; 13 R. P. C. 190; R. *v.* Wheeler, (1850) 2 B. & Ald. 345; Seed *v.* Higgins, (1860) 8 H. L. Cas. 561; Bovill *v.* Pimm, (1856) 11 Ex. 740.

(*t*) Per Cresswell, J., Beard *v.* Egerton, (1849) 19 L. J. N. S. C. P. 38; see also Neilson *v.* Harford, (1841) 1 W. P. C. 370.

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supposed to be addressed in a particular sense. It is a well-established rule that the Court will receive and consider evidence as to the exact sense in which the patentee intended a word or expression to be understood, and will give full effect to such meaning in the construction of the specification.(*u*)

The Court will not violate the obvious meaning of the language, unless it is quite clear that the patentee intended something different from that which the expressions indicate.(*x*)

Technical terms.

It is undoubtedly true, as a proposition of law, that the construction of a specification, as the construction of all other written instruments, belongs to the Court; but a specification of an invention contains most generally, if not always, some technical terms, some phrases of art, some processes requiring the aid of the light derived from surrounding circumstances. It is, therefore, an admitted rule of law that the explanation of the words in technical terms of art, the phrases used in commerce, and the proofs and results of the processes which are described, are all matters of fact, upon which evidence may be given, and contradictory testimony may be adduced, between which it is for a jury to decide.(*y*)

The Court ought to construe the specification like all written instruments, taking the words, and seeing what is the meaning of those words when applied to the subject-matter; and in the case of a specification which is addressed, not to the world at large, but to a particular class—for instance, skilled mechanicians, possessing a certain amount of knowledge—it is material for the tribunal to put itself in the position of such a class, namely, skilled mechanicians, and to see what the words of the specification mean when applied to such a subject as skilled mechanicians would know, and then to say what the words of the specification mean when applied to such a subject-matter.(*z*)

The patent for the preparation of Lanolin (*a*) affords a good instance of the application of this principle. In that case one of the alternative processes for the further purification of raw Lanolin described was dissolution by a *solvent*, and amongst

(*u*) British Dynamite Co. *v.* Krebs, (1875) G. P. C. 91; 13 R. P. C. 190; Clark *v.* Adie, (1873) L. R. 2 App. Cas. 436; Neilson *v.* Harford, (1841) 1 W. P. C. 313; Elliot *v.* Turner, (1845) 2 C. B. 446; Walton *v.* Potter, (1841) 1 W. P. C. 595; Harrison *v.* The Anderston Foundry Co., (1876) L. R. 1 App. Cas. 581.

(*x*) Per Pollock, B., Kaye *v.* Chubb, (1887) 4 R. P. C. 299.

(*y*) Hill *v.* Evans, (1862) 31 L. J. Ch. 460.

(*z*) Per Lord Blackburn, Clark *v.* Adie, (1873) L. R. 2 App. Cas. 436; see also Betts *v.* Menzies, (1862) 10 H. L. Cas. 117; Simpson *v.* Holliday, (1866) 13 W. R. 577; L. R. 1 H. L. 315; Edison *v.* Holland, (1888) 5 R. P. C. 474.

(*a*) Benno Jaffé und Darmstaedter Lanolin Fabrik *v.* Richardson, (1894) 11 R. P. C. 93, 261.

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other solvents specifically mentioned was methylated spirit. The defendants contended that this was not a useful solvent, as, though it might dissolve impurities and so be useful as a purifier, it did not dissolve except with difficulty the pure cholestrine fats, and they said that according to the strict wording of the specification a person would gather that all the raw Lanolin was to be dissolved. *Romer*, J., decided at the trial that, upon the evidence adduced as to the scientific meaning of the word *solvent* and upon the true construction of the specification, the solvent referred to was to be used as a purifier according to its known properties, and no one would imagine that in every case it was essential to dissolve the whole of the raw Lanolin, and the Judge being satisfied that it could be used usefully as a purifier, though not so efficaciously as some of the other solvents specifically mentioned, the objection against the validity of the patent therefore failed. The patent was also upheld by the Court of Appeal.

Even in cases where it is sought to establish that an invention described in a specification is not new by reason of the existence of a prior specification, which, it is alleged, describes the same invention, the Court will not, without evidence, assume that words or terms of art, which are common to the two specifications, bear in each the same meaning, but will receive and consider evidence on the point.(*b*)

Variations in meaning.

It is impossible to predict, of two documents framed at different periods, that the terms of art common to the two had the same signification, and indicated the same identical thing at the date of each respectively, for terms of art are liable to constant change of meaning with the progress of science and invention; and the cases establish that the identity of signification between two written documents containing the same description must belong to the province of evidence, and not to the province of construction.(*c*)

The former practice of construing specifications very strictly against the patentee and in favour of the Crown, which was indulged in by Judges who had not freed themselves from the general prejudice against monopolies of all kinds and did not accept the view that patents for useful inventions are to be

(*b*) Thomas *v.* Foxwell, (1858) 5 Jur. N. S. 37; Robertson *v.* French, (1803) 4 East. 135, 136; Betts *v.* Menzies, (1862) 10 H. L. Cas. 117, 152; Hill *v.* Evans, (1862) 6 L. T. N. S. 70; Neilson *v.* Harford, (1841) 8 M. & W. 806; 1 W. P. C. 331; Hills *v.* The London Gas Light Co., (1857) 5 H. & N. 312; Jupe *v.* Pratt, (1837) 1 W. P. C. 144; Walton *v.* Potter, (1841) 1 W. P. C. 585; Steiner *v.* Heald, 6 Exch. 607.

(*c*) Betts *v.* Menzies, (1862) 10 H. L. Cas. 152.

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encouraged on the ground of public policy, drew from Lord *Tenterden*, C.J.,(*d*) the remark: "I cannot forbear saying that I think a great deal too much critical acumen has been applied to the construction of patents, as if the object was to defeat, and not to sustain them."

Nothing is to be intended either in favour of a specification or against it.

It is now a rule of construction accepted by the Courts that nothing is to be intended either in favour of a specification or against it, but that it is to be dealt with just as it appears, and a true and right and fair construction is to be put upon every allegation and every fact connected with it, such construction being neither a benign nor a strict one.(*e*)

It may at one time be the interest of the patentee to endeavour to induce the Court to put a wide construction on the specification, so that it may be held to include and claim a particular thing, which an alleged infringer uses, and at another time it may be to the advantage of the patentee to obtain a narrow construction, so that the specification may be held not to include something which is old.(*f*) Whether it is for the interest of one side or the other, it is the duty of the Court to fairly construe the specification, neither favouring the one side nor the other: neither putting an unfair gloss or construction upon the specification for the purpose of saving a patent, if it is said that the patent is void, nor putting an unfair gloss or construction upon it in order to extend the patent, and make it take in something which might be thought to be an unhandsome taking of the fruits of his invention from the patentee, if it is not really an infringement of the patent.(*g*) The Courts endeavour to hold a fair hand between the patentee and the public, being willing to grant to the patentee on his part the reward of a valuable patent, but taking care to secure to the public, on the other hand, the benefit of the provision that the patentee must clearly define both the invention and the method of performing it.(*h*)

Construction must be logical, fair, and impartial.

The construction of the specification must be logical, fair, and

(*d*) Huddart *v.* Grimshaw, (1803) 2 B. & Ald. 377.

(*e*) Stevens *v.* Keating, (1847) 2 W. P. C. 177; Russell *v.* Cowley, (1832) 1 W. P. C. 465; 1 Cr. M. & R. 864; Harrison *v.* The Anderston Foundry Co., (1876) L. R. 1 App. Cas. 574; Young *v.* Rosenthal, (1884) 1 R. P. C. 33; Westinghouse *v.* The Lancashire and Yorkshire Ry. Co., (1884) 1 R. P. C. 229.

(*f*) Stevens *v.* Keating, (1847) 2 W. P. C. 194; Downes *v.* Falcon Works, (1886) 3 R. P. C. 70; Kaye *v.* Chubb, (1887) 4 R. P. C. 289; Hutchinson *v.* Patullo, (1887) 4 R. P. C. 329; Gosnell *v.* Bishop, (1888) 5 R. P. C. 151, 158; Ellington *v.* Clark, (1888) 5 R. P. C. 319, 327.

(*g*) Per Lord Blackburn, Dudgeon *v.* Thompson, (1877) L. R. 3 App. Cas. 53; see remarks of Tindal, C.J., Haworth *v.* Hardcastle, (1834) 1 W. P. C. 480; 1 Bing. N. C. 182, 190.

(*h*) Neilson *v.* Harford, (1841) 1 W. P. C. 310.

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impartial. It is proper for the Courts, seeing that patents for a limited period operate as an encouragement to the production of useful inventions, of which the public get the benefit after the monopoly is expired, to endeavour, if it can fairly and honestly be done, to support the patent, and to adopt a construction of the specification which will give it validity when it can fairly be interpreted so as to achieve this result.(*i*)

The adoption of such a construction, though it supports the validity of the patent, not unfrequently tells against the plaintiff on the question of infringement.(*k*)

Doctrine that patentee would not intend to claim anything which would render the patent void.

It is a proper assumption to make that a patentee would not be so absurd as to claim anything which would render his grant void; for instance, anything which he knew, or which he was aware everybody else knew, to be old; and the Court will avoid such an absurdity if by any legitimate construction of the words used it can do so.(*l*)

Thus in *Neilson* v. *Harford*,(*m*) on a motion being made to the Court of Exchequer to enter a verdict for the plaintiff on the issue of sufficiency of the specification, the question arose as to the proper construction to put on the statement that "the shape of the receptacle is immaterial to the effect, and may be adapted to the local circumstances." The invention consisted in the application of hot air to the blast furnace, and the receptacle above referred to was the chamber in which the air was to be heated before being passed into the furnace. The jury in the Court below had found that the shape and form was material to the effect—*i.e.*, to the extent of beneficial effect—produced, not to producing some effect, for some beneficial result would be produced from any shape, but as to producing the extent of beneficial effect the form and shape was material. If the proper construction of the patentee's statement was that the shape of the receptacle was immaterial to the degree of effect in heating the blast, in the face of the finding of the jury, the specification would be bad as containing a false statement in a material circumstance, of such a nature that, if literally acted upon by a competent workman, it would mislead him and cause the experiments to fail. *Parke*, B., who tried the case in the Court below, was at first of opinion that this was the

(*i*) Hinks *v.* Safety Lighting Co., (1876) L. R. 4 Ch. D. 612; 46 L. J. Ch. 185; Plimpton *v.* Spiller, (1876) L. R. 6 Ch. D. 422; Russell *v.* Cowley, (1832) 1 Cr. M. & R. 864; 1 W. P. C. 460; Automatic Weighing Machine Co. *v.* Knight, (1889) 6 R. P. C. 297, 307; Morris *v.* Young, (1895) 12 R.P.C. 463.

(*k*) Maxim-Nordenfelt Guns and Ammunition Co. *v.* Anderson, (1897) 14 R. P. C. 371, 671.

(*l*) Clark *v.* Adie, (1873) L. R. 3 Ch.D. 142.

(*m*) (1841) 1 W. P. C. 331.

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proper construction, but in the Court of Exchequer he concurred in the opinion of the other Judges, that from the context of the specification, taken as a whole, the word "effect" might reasonably be construed to mean "beneficial effect," and that such meaning ought to be adopted, as it would support the patent. This latter being the proper construction, and the jury having found as a matter of fact that any shape in which the air-vessel could reasonably be expected to be made by a competent workman would produce a beneficial effect, and be a valuable discovery, the Court was of opinion that the verdict ought to be entered for the plaintiff on the issue of sufficiency, and consequently the patent was upheld on this point.

Again, in *Oxley* v. *Holden* (*n*) the question was as to the true meaning in the specification of the words, "I claim the metal fittings and the mode of applying the same described herein as the second part of my invention." If these words meant that the patentee claimed separately the metal fittings themselves and the mode of applying them, the evidence showed that the metal fittings had been anticipated and published; but if the true construction was that the claim was for the metal fittings and the mode of applying them, as one part of the invention, then the patent would be good as regarded novelty. The Court of Common Pleas thought that from the context of the specification the patentee intended the latter construction, and he must have intended the patent to be valid. This construction was the more probable, and to support the first construction it would have been necessary to assume on the part of the patentee extreme ignorance in respect of the metal fittings, or extreme confusion in describing particular metal fittings.

Limit to doctrine of construction according to patentee's intention.

The doctrine that the patentee intends his patent to be a good one must not be pushed too far in construing the specification. In the above case what the patentee was held to have intended turned out to be favourable to the validity of the patent, and the Court took into consideration the fact that he must have intended it to be valid, though that did not alone decide the Judges in adopting the construction they did. Independently of this fact it was the more probable. The specification should be construed rather by trying to see what it says than by what the draughtsman meant, for frequently the draughtsman's object is to be as vague as possible without endangering the patent,(*o*) and what

(*n*) (1860) 8 C. B. N. S. 666; 30 L. J. C. P. 68.
(*o*) Incandescent Gas Light Co. *v.* De Mare Incandescent Gas Light System, (1896) 13 R. P. C. 320.

is put in the form of a claiming clause may in reality only be the statement of a method of carrying out the invention and not a claim at all. When this is so, the patentee will be protected against his own folly in not putting the description into the body of the specification instead of in the form of a claiming clause.(*p*) Construction.

Thus the argument of absurdity cannot be used in favour of the patentee if the wording of the specification is perfectly clear.(*q*)

It will not do to argue that a great part of that which is covered by the patent is old and therefore bad, but some little part is new and therefore good, and that the Court ought consequently to confine the patent to that which is good.(*r*) The utmost extent to which the doctrine can be pushed in favour of the patentee is the conclusion that when two or more constructions are equally tenable the Court will adopt the one which will give validity to the patent, in preference to all others.(*s*)

The Court will construe the specification so as to support the patent, if it can be fairly done,(*t*) and will not be astute to find flaws in small matters in a specification with a view to overthrow it.(*u*) Where any expression is ambiguous, the Court will endeavour to give effect to the intentions of the patentee.(*x*) Court is not astute to find flaws.

In *Palmer* v. *Wagstaffe* (*y*) the plaintiff obtained an injunction against the defendant, restraining the infringement of a patent for "improvements in the manufacture of candles." The second claim was, "the mode of manufacturing candles by the application of two or more plaited wicks as herein described." The evidence of infringement was the production of a candle purchased by the plaintiff at the defendant's manufactory which was identical with those made by the plaintiff according to his process. It was not proved, however, that the defendant's candle had been made according to the patented process, and therefore, in order to support the verdict in the

(*p*) Per Kekewich, J., Pneumatic Tyre Co. *v.* Casswell, (1896) 13 R. P. C. 164, 181.

(*q*) Cropper *v.* Smith, (1884) 1 R. P. C. 90; Clark *v.* Adie, (1873) L. R. 2 App. Cas. 423, 437.

(*r*) Clark *v.* Adie, (1873) L. R. 3 Ch. D. 142.

(*s*) Automatic Weighing Machine Co. *v.* Knight, (1889) 6 R. P. C. 307; Needham *v.* Johnson, (1884) 1 R. P. C. 58: Vorwerk *v.* Evans, (1890) 7 R. P. C. 167, 265.

(*t*) p. 241 *ante;* Russell *v.* Cowley, (1832) 1 W. P. C. 457; 1 Cr. M. & R. 864.

(*u*) Otto *v.* Linford, (1881) 46 L. T. N. S. 35, 39; Plimpton *v.* Spiller, (1876) L. R. 6 Ch. D. 422.

(*x*) Russell *v.* Cowley, (1832) 1 W. P. C. 470; Palmer *v.* Wagstaffe, (1854) 9 Exch. 494, 501. The above paragraph was referred to with approval by Kay, L.J., in Edison-Bell Phonograph Corporation *v.* Smith, (1894) 11 R. P. C. 400, and the principles therein involved were applied in that case.

(*y*) (1853) 8 Exch. 840; 22 L. J. Ex. 295; 9 Exch. 494; 23 L. J. Ex. 217.

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court below, it became necessary for him to contend that his patent was for the candle, and not merely the process of producing it. The Court of Exchequer, however, made absolute a rule *nisi* to enter a verdict for the defendant, on the ground that the patent was for the method and not the candle, and consequently infringement had not been proved. *Pollock*, C.B., and *Parke*, B., both agreed that a specification should be construed as the patentee intended, and that, if any expressions were ambiguous, the Court should give effect to the intention; but the Court must not violate the obvious meaning of the language, unless it is quite clear that the patentee intended something different from that which the expressions indicate.

Doctrine of benevolent construction.

It is sometimes contended that Judges should put a benevolent construction on the specification, so as to support the patent for the encouragement of inventors; but the true rule of construction is that the language of the specification should not be subjected either to a benign interpretation or to a strict one,(*z*) but should be construed like all written instruments impartially according to its true meaning,(*a*) unless the language is ambiguous,(*b*) the Courts adopting a construction which will support the patent in preference to one which will not.(*c*)

In *Boulton* v. *Bull* (*d*) it was attempted, in the Court of Common Pleas, to upset a patent, on the ground that a certain Act of Parliament, by which the original period of the duration of the monopoly was extended, purported to deal with a different kind of invention to that comprised by the patent. The Court was equally divided, so no judgment was given. But *Eyre*, C.J., was of opinion that the patent could be supported, on the ground that—(1) it was not for an abstract principle, but for a practical embodiment of a principle; (2) the Act and specification were referable to the same thing; and, when taken with their correlation, they were perfectly intelligible; and in his desire to reward the patentee he declared that he would, if necessary, resort to the exposition of the word "engine" in the body of the Act to mean a "method," in order to support the patent,

(*z*) Harrison *v.* The Anderston Foundry Co., (1876) L. R. 1 App. Cas. 574; Needham *v.* Johnson, (1884) 1 R. P. C. 58; see p. 104; Automatic Weighing Machine Co. *v.* Knight, (1889) 6 R. P. C. 307.

(*a*) Clark *v.* Adie, (1875) L. R. 2 App. Cas. 436; Betts *v.* Menzies, (1862) 10 H. L. Cas. 117; Simpson *v.* Holliday, (1864) 13 W. R. 577; L. R. 1 H. L. 315; Edison *v.* Holland, (1888) 5 R. P. C. 474.

(*b*) Parkinson *v.* Simon, (1895) 12 R. P. C. 406–407.

(*c*) pp. 240–241 *ante*.

(*d*) (1795) D. P. C. 162; 2 H. Bl. 463; 3 Ves. 143.

"*ut res magis valeat quam pereat.*" *Pollock*, C.B., in another case,(*e*) said: "I agree that we are to construe the specification '*ut res magis valeat quam pereat*,' but still we are bound to ascertain what is the true and sound construction of the instrument, construing the language used with reference to the subject-matter, which may very much control the judgment to be given." Construction.

The true limits within which the doctrine of benevolent construction may be applied in favour of the patentee are, it is submitted, clearly defined in the two following extracts from judgments of Sir *George Jessel*, M.R., and the late Lord *Bowen* respectively:— True limits to the doctrine.

In *Hinks* v. *Safety Lighting Co.*, (1876) L.R. 4 Ch.D. 607, 612, *Jessel*, M.R., said: "I am anxious, as I believe every Judge is, to support honest *bonâ fide* inventors who have actually invented something novel and useful, and to prevent their patents from being overturned on mere technical objections or on mere cavillings with the language of their specification, so as to deprive the inventor of the benefit of his invention. This is sometimes called a 'benevolent' mode of construction. Perhaps that is not the best term to use; but it may be described as construing a specification fairly, with a judicial anxiety to support a really useful invention, if it can be supported on a reasonable construction of the patent. Beyond that the 'benevolent' construction does not go. It was never intended to make use of ambiguous expressions with a view of protecting that which was not intended to be protected by the patentee, and which has not been claimed to be so protected by him, whether or not it was an invention unknown to himself." (*f*)

In *Cropper* v. *Smith*, (1884) 1 R. P. C. 89, *Bowen*, L.J., stated the duty of the Court in the following terms, which were quoted with approval by *Lindley*, L.J., in the subsequent case of *Benno Jaffé und Darmstaedter Lanolin Fabrik* v. *Richardson & Co.*, (1894) 11 R. P. C. 271:—

"We were pressed very earnestly to give this document what has been called a benevolent construction. It seems to me that that prayer for grace is very often addressed to Courts under circumstances which preclude the propriety of their entertaining it for a moment. It is quite true that in old times a great many Judges were supposed to be astute to defeat patents, and as a corrective, so to speak, to that inclination of the Courts it became necessary for the tribunal to warn itself that patentees

(*e*) Thomas *v.* Foxwell, (1859) 6 Jur. N. S. 272.

(*f*) See also Plimpton *v.* Spiller, (1877) L. R. 6 Ch. D. 422; Otto *v.* Linford, (1881) 46 L. T. N. S. 39; Cropper *v.* Smith, (1884) 1 R. P. C. 89.

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must be fairly dealt with as between themselves and the public, and as a canon of construction accordingly reference has been from time to time, in various cases, made to the idea that a benignant or benevolent construction was one that ought to be invoked, that is to say, reference has been made to an old principle of construction, which is not at all special to the subject-matter of patents, but appplies 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 debeat intelligi cum effectu ut res magis valeat quam pereat.* Now that is only a caution against excessive formalism, it only means that when you can see what the true construction of the document is, or, in other words, what the true intention of the parties is, as expressed in their language, you must not allow yourself to be drawn away from the true view of the document by over-nicety in criticism of expression. That is what seems to me to be meant. You must remember that the parties meant to do something by their deed, and you must not defeat it, if effect can be given to their intention by a fair construction of the whole document. It is almost always coupled with another maxim, which seems to be nearly the same thing in another shape: *Verba intentioni debeat inservire.* You must construe particular words so as not to defeat the clear intention of the whole. That is what seems to me to be the meaning of the maxim, that the interpretation of documents ought to be benevolent or benign; but having said that, it follows that although there may be cases in which you use it when the validity of a patent is in question, it certainly can never be used when the construction of a document is clear; that is to say, it is a guide to help you to construe a document, it is not an excuse to justify you in misconstruing a document."

If a claim can be read in two ways—one claiming something that has the merit of novelty, and the other claiming something which would show the patentee to be ignorant of all the ordinary appliances used to effect a particular purpose, it is the duty of the Judge to adopt the construction which makes the patent reasonable and sensible, rather than that construction which makes the patent utterly absurd;(*g*) but if it is established by the evidence before the Court that certain matters, which the specification upon a fair construction claims, were

(*g*) Plimpton *v.* Spiller, (1877) L. R. 6 Ch. D. 422; Westinghouse *v.* Lancashire and Yorkshire Ry. Co., (1884) 1 R. P. C. 98; Cropper *v.* Smith, (1884) 1 R. P. C. 81; Haworth *v.* Hardcastle, (1834) 1 W. P. C. 484; Needham *v.* Johnson, (1884) 1 R. P. C. 58; Morris *v.* Young, (1895) 12 R. P. C. 463.

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not new at the date of the patent, and were generally thought to be old, the Court is not, therefore, to narrow down the claim so as to exclude the old matters. Such a proceeding would be contrary to the decisions, and would afford a very simple precedent for saying that no patent is to be upset on the grounds of novelty.(*h*) In the words of Lord *Hatherley*, "the Courts will not alter the construction in order to save a patent where the patentee has himself explained his meaning in the claiming clauses."(*i*)

In construing a claim, however, if there is nothing else in the matter, it is the duty of the Judge to adopt that construction which makes sense of the patent instead of that which makes it useless.(*k*) And there is, as there ought to be, a bias between different constructions in favour of the real improvement and genuine invention to adopt that construction which supports an invention.(*l*)

Word used in a popular sense is not construed according to its exact meaning.

It may be pointed out that the considerations above discussed affect the question of the benevolent construction of the specification, a document prepared by the patentee himself, and that this is a different question to that of the benevolent construction of the grant contained in the actual letters patent.

Where a word is used in a specification in a popular sense, it is not to bear its strict mathematical meaning—*e.g.*, a patentee in his specification referred to a certain comb-plate "being cut with teeth pointed like a comb, and in parallel portions." It was objected that the teeth, if pointed, could not be parallel, but the House of Lords adopted the view of Lord *Cairns*, that the patentee explained in the clearest way that he used the word in a popular and not in a mathematical sense, and that the word must be construed in that sense.(*m*)

Claims are construed with reference to the whole specification.

The claiming clauses of the specification are construed with reference to the title,(*n*) and with reference to the whole of the specification.(*o*)

Thus, in the case of *Newton* v. *Vaucher* (*p*) it was material to

(*h*) Clark *v.* Adie, (1877) L. R. 2 App. Cas. 433, 437.

(*i*) Clark *v.* Adie, (1877) 2 App. Cas. 431.

(*k*) Per Jessel, M.R., Plimpton *v.* Spiller, (1877) L. R. 6 Ch. D. 422.

(*l*) Per Jessel, M.R., Otto *v.* Linford, (1881) 46 L. T. N. S. 39.

(*m*) Clark *v.* Adie, (1877) L. R. 2 App. Cas. 426.

(*n*) Oxley *v.* Holden, (1860) 8 C. B. N. S. 666 ; 30 L. J. C. P. 68 ; Newton *v.* Vaucher, (1851) 6 Exch. 859 ; 21 L. J. Ex. 305.

(*o*) Neilson *v.* Harford, (1841) 1 W. P. C. 312, 373 ; Lister *v.* Norton, (1886) 3 R. P. C. 203 ; Plimpton *v.* Spiller, (1877) L. R. 6 Ch. D. 426 ; Wegmann *v.* Corcoran, (1876) L. R. 13 Ch. D. 65, 77 ; Edison *v.* Woodhouse, (1887) 4 R. P. C. 107 ; Kaye *v.* Chubb, (1888) 5 R. P. C. 641 ; Parkinson *v.* Simon, (1894) 11 R. P. C. 238, 493 ; 12 R. P. C. 403.

(*p*) (1851) 6 Exch. 859; 21 L.J.Ex. 305.

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decide whether the patentee claimed the application of soft metal for the purpose of preventing friction where there is pressure and motion, or whether he did not also claim the application of soft metal in the case of stuffing-rods for the purpose of excluding air, water, or other fluid. On reading the title and specification with reference to each other, the Court was convinced that the claim was confined to bearings in cases where there is pressure with motion, and adopted that construction accordingly.

Again, in *Montgomerie* v. *Peterson*,(*q*) the patent was for the discovery and preparation of a diastasic mixture and its application to or mixture with a batch of bread or other food, so as with the aid of heat to convert flour into maltose and predigest the food. The claim was "the mode and means and combination of mixtures with the special preparation of malt extract herein distinguished for manufacturing or making bread and biscuits substantially in the new or improved manner herein described." The defendant contended that this claim was wholly unintelligible, but that, construed in the most favourable sense, it amounted merely to a claim for the combining, or for the mode of combining (1) the described special mixture with (2) certain other described mixtures forming the bulk of the batch; and further, that if this combination involved no difficulty it had no merit, and was therefore not patentable, and if it did involve difficulty the mode of performing the operation was not described sufficiently to enable it to be successfully performed. The Courts, however, held that, looking at the specification as a whole, it could be gathered what the patentee meant—*i.e.*, he did not claim the mere combining of his special mixture (*i.e.*, the separate mixture in which the diastase was produced) with the various mixtures which he suggested as suitable for the dough forming the rest of the batch. What he did claim was the mode described of preparing the various mixtures forming the dough or bulk of the batch (a mode perfectly well described) and then the combining of those mixtures with his special or separate mixture, the mode of preparing which latter was also well described. The claim so read possessing novelty and utility, the patent was upheld.

Distinct effective meaning is, if possible, to be given to each claim.

When there are several claims, a distinct effective meaning must, if possible, be given to each, for the rule is that each part of the specification should be effectively construed, and if

(*q*) (1894) 11 R. P. C. 221, 633.

several claims mean the same thing they cannot be said to be effective.(*r*) If, however, it is not possible to give a distinct effective meaning to all the claims, the fact that some are redundant does not invalidate the patent.(*s*) Construction.

The claims should specifically refer to all that is of the essence of the invention in respect of which the patentee desires to be protected. If, however, some essential feature is not directly mentioned in the claims, though the thing described *necessarily* possesses that essential feature, the claim is sufficient and the use of the essential feature in question would be an infringement.(*t*) Thus, in *Tweeddale* v. *Ashworth*,(*u*) one essential element in the success of the patentee's contrivance for an improved flat and fastener for securing carding cloth thereon, was that the material should be stretched, at the same time and by the same operation as completed the machine. Though this was not directly mentioned in the claim, it followed as a consequence from the thing claimed and described. The House of Lords held the patent valid, but that the defendant had not infringed, as he had not taken this essential feature in question. Lord *Halsbury*, L.C., said: "Now, my Lords, looking to the patent itself and the specification, I am unable to give any other construction to the patent here than that which involves the particular thing, with its own particular incidents, which is therein described; and I think that the fallacy of the argument which has been ingeniously suggested to us is this: It is said that there is no claim for the stretching. If by that is meant that there is in the claim no such word as 'stretching,' I agree the word 'stretching' does not occur; but what there is in the claim is this—there is a claim for a thing which is described and illustrated by the description in the letterpress and by the illustration which is given in the drawing, and both the letterpress and the drawing describe a machine, and describe the mode of manufacturing the machine, which, of itself, necessarily involves, as one of the merits of the invention, the power of stretching the material at the same time and by the same operation as completing the machine. That, I believe, is the merit of the invention, and a very material merit of the invention, and it appears to me that, that being one of the

Essence of an invention may be protected though the claim does not specifically mention it.

(*r*) Parkinson *v.* Simon, (1894) 11 R. P. C. 502; Jordan *v.* Moore, (1866) L. R. 1 C. P. 624.

(*s*) Wenham Gas Co. *v.* Champion Gas Lamp Co., (1892) 9 R. P. C. 55.

(*t*) See pp. 468-493 *post*.

(*u*) (1892) 9 R. P. C. 127.

Construction.

important elements forming the substance of the invention, it is one which the defendants have in no way invaded."

Again, in *Boyd* v. *Horrocks*,(*x*) the House of Lords, upon the same principle, held that, though a claim in question was for an arrangement which attained an old result in a similar way to an alleged anticipation, it was not limited to the particular form of parts specified, but involved the possession of a certain essential and novel feature, by the taking of which the defendant had infringed the patent.

Principle of introducing claim by implication is employed with great caution.

It must be remembered that the Courts, in all cases, only apply this principle of introducing, by implication, a claim not expressly contained in a specification with the greatest possible caution.(*y*)

Frequently claiming clauses end with such words as "*substantially as described*," or "*substantially as and for the purpose hereinbefore described*," which are usually introduced with the object of limitation. Whether such words have any or what effect depends in each case upon the construction of the specification as a whole.(*z*)

Provisional cannot be called in aid to construe complete specification.

The complete specification must be construed without calling in the aid of the provisional to explain or enlarge its meaning; (*a*) though the Court may look at the provisional specification for the purpose of ascertaining the real object of the invention claimed in the complete.(*b*)

Specification is construed with reference to

The specification is always construed by the Courts, with regard both to accuracy of definition and sufficiency of descrip-

(*x*) (1892) 9 R. P. C. 77; see also Moore *v.* Thompson. (1890) 7 R. P. C. 325.
(*y*) Muirhead *v.* Commercial Cable Co., (1895) 12 R. P. C. 39, 56.
(*z*) For instances see Young *v.* Rosenthal, (1883) 1 R. P. C. 33; Westinghouse *v.* Lancashire and Yorkshire Ry. Co., (1884) 1 R. P. C. 241; Lawrence *v.* Perry, (1885) 2 R. P. C. 183; Easterbrook *v.* Great Western Ry. Co., (1885) 2 R. P. C. 208; United Telephone Co. *v.* Bassano, (1888) 3 R. P. C. 295; Cassel Gold Extracting Co. *v.* Cyanide Gold Recovery Syndicate, (1895) 12 R. P. C. 232; Parkinson *v.* Simon, (1895) 12 R. P. C. 403.
In the following cases the words printed in italics were interpreted with reference to the rest of the specification in each case:—
As above described.—Plating Co. *v.* Farquharson, (1879) Griff. 191; Barber *v.* Grace, (1847) 1 Ex. 122.
As above set forth.—Bray *v.* Gardner, (1887) 4 R. P. C. 403.
Substantially as set forth.—United Telephone Co. *v.* Bassano, (1886) 3 R. P. C 315.
As described and illustrated.—Fairburn *v.* Household, (1886) 3 R. P. C. 267.
Other substances.—Crossley *v.* Beverley, (1829) 9 B. & C. 63; Bickford *v.* Skewes, (1841) 1 Q. B. 948; 1 W. P. C. 218.
Any mechanical equivalent.—Curtis *v.* Platt, (1863) L. R. 3 Ch. D. 137 n.
Analogous.—Brown's Patent, Griff. L. O. C. 1.
More or less.—Plating Co. *v.* Farquharson (1879–1883); Griff. P. C. 187, 190.
Or.—Simpson *v.* Holliday, (1864) 20 Newton's Lond. Journal N. S. 108; Elliot *v.* Turner, (1845) 2 C. B. 446; 15 L. J. C. P. 49; Hills *v.* London Gas Light Co., (1860) 5 H. & N. 312; 27 L. J. Ex. 60; 29 L. J. Ex. 409.
(*a*) Mackelcan *v.* Rennie, (1862) 13 C. B. N. S. 52.
(*b*) Parkinson *v.* Simon, (1894) 11 R. P. C. 502.

Construction.

tion, by reference to the knowledge of the world existing at the date of the patent; and the Court, for purposes of construction, will not take notice of any subsequently acquired information, but will endeavour to divest itself of such knowledge, and place itself in the position of the person to whom the specification may have been supposed to be addressed at the date of the patent.(*c*)

public knowledge at the date of the patent,

Thus in *Nobel's Explosives Company* v. *Anderson* (*d*) the question was whether the term "soluble" nitro-cellulose as used in the specification included a form of nitro-cellulose which the defendant at a later date claimed to use in the manufacture of an explosive as "insoluble" nitro-cellulose. The evidence was conflicting, but it was decided that the term "soluble" nitro-cellulose at the date of the plaintiff's patent did not, according to the meaning attributed to it then by chemists, include the form of nitro-cellulose used by the defendant and described by him as "insoluble," and so there was no infringement.

and with reference to what it would lead the person to whom it is addressed to do.

Moreover, in determining the sufficiency of the specification, the Court will not take cognisance of what the patentee says he intended, but only of what the ordinary intelligent workman, to whom the specification may be supposed to be addressed, says it would lead him to do.(*e*)

In *Badische Anilin und Soda Fabrik* v. *Levinstein*,(*f*) a question arose as to the meaning of the term "*Naphthylamine*," in the specification of the plaintiff's patent for "improvements in the production of colouring matters suitable for dyeing and printing," taken out in 1878. All the amines are capable of existing in three different isomeric modifications. At the date of the action, which was 1883, two of the isomeric naphthylamines known as alpha- and beta-naphthylamine respectively, were generally known. It was also established in evidence that, though these two isomers were known at the date of the patent, the beta-naphthylamine was only known to the highly trained organic chemists acquainted with the latest discoveries of the day, and it had not found its way into use in the arts. The question really was, would the direction to use "*Naphthylamine*,"

(*c*) Badische Anilin und Soda Fabrik *v.* Levinstein, (1887) L. R. 12 App. Cas. 710; 14 R. P. C. 449; Edison *v.* Woodhouse, (1887) 4 R. R. P. 94; Boyd *v.* Horrocks, (1892) 9 R. P. C. 295; King Brown *v.* Anglo-American Brush Corporation, (1892) 9 R. P. C. 313, 317, 319, 321; Nobel's Explosives Co. *v.* Anderson, (1894) 11 R. P. C. 523.

(*d*) (1894) 11 R. P. C. 115, 519; 12 R. P. C. 164.

(*e*) Kaye *v.* Chubb, (1887) 4 R. P. C. 289. See p. 191 *ante*.

(*f*) (1883) L. R. 24 Ch. D. 156; L. R. 29 Ch. D. 366; L. R. 12 App. Cas. 710; 2 R. P. C. 73; 4 R. P. C. 449.

Construction.

taking into account only the state of public knowledge at the date of the patent, lead the public to use the alpha isomer which would answer, and not the beta isomer which would not answer.

Pearson, J., in the Chancery Division,(*g*) upheld the patent, but in the Court of Appeal it was declared void on the ground of insufficiency of the specification. *Bowen* and *Fry*, L.JJ., thought that the specification being addressed to highly skilled experts—"advanced students of organic chemistry"—the term "*naphthylamine*" would include both isomers, and therefore be bad for ambiguity. Whilst *Baggallay*, L.J., drew a distinction between different classes of literature, and concluded that in the knowledge of practical men at the date of the patent the term "*naphthylamine*" would mean only the *alpha-naphthylamine*, and this view was finally adopted by the House of Lords,(*h*) who supported the patent, thus upholding the decision of *Pearson*, J., and reversing that of the Court of Appeal.(*i*)

Limit to the latter canon of construction.

The doctrine that the specification is to be construed to mean what an ordinary workman would understand it to mean must not be pushed too far. It is only applicable when there appears to be an ambiguity. If the Court is clear as to the meaning of a specification it will not accept the evidence of a workman, or anybody else, on the point, but will construe it as it is bound to do according to its own view. In the words of *Esher*, M.R., the doctrine is applicable "only when a particular description of work mentioned in the specification, or something to be done, appears to be ambiguous. If you read it without knowledge it appears to be ambiguous, but then it is said: 'It appears to you to be ambiguous, but any workman of ordinary skill in the trade who would have to apply that description would understand it only in one way, and would be able to act upon it.' If that is true, then it is said that, although grammatically or with literary accuracy there might be a doubt about it, there is no real business doubt about it, and the one meaning and the only meaning which could attach to it is that which would strike an ordinary workman in the trade who would have to deal with it, and would strike him as the only way in which the work could be done. That does not apply to this case, for it is not suggested that any one of the many things which have been added to this instrument by this invention is described in any ambiguous way whatever."

(*g*) L. R. 24 Ch. D. 156; 29 Ch. D. 384, 406, 411.
(*h*) L. R. 12 App. Cas. 710.
(*i*) See opinion of Lord Halsbury, L.C., L. R. 12 App. Cas. 714.

Construction.

Effect of prior publications on construction of specifications.

In *Clarke* v. *Adie*,(*k*) the question arose as to how far the Court is justified in looking at antecedent publications for the purpose of construing a specification in dispute, but the House of Lords refused to lay down any general rule, and so far none has been stated. Lord *Cairns*, L.C., however, pointed out that it might be open to the patentee or licensee to refer, in launching his case, to the state of manufacture up to, and at the time, when the patent was granted.

There are reported cases in which various Judges have acted differently in this matter. Thus in *Westinghouse* v. *Lancashire and Yorkshire Railway Co.*,(*l*) *Denman*, J., held that it was necessary to look at the state of knowledge at the time of the publication of the specification in order to decide whether a particular claim was a claim to a combination, or a claim to several distinct inventions.(*m*) And in *Couchman* v. *Greener*,(*n*) Lord *Esher*, M.R., said that if there be any doubt on the construction of the plaintiff's patent you may look at former patents for the purpose of seeing what is the proper construction of the plaintiff's patent. On the other hand, *Manisty*, J., in a case between licensor and licensee, refused to admit evidence of the state of public knowledge at the date of the plaintiff's patent.(*o*)

Prior public knowledge as disclosed by antecedent specifications, or otherwise, does undoubtedly in one sense affect the question of construction. Thus it is a well-established canon that, if two constructions are possible, the Court will adopt that which will support the patent in preference to one which will not,(*p*) and with this object in view the Courts do consider the state of public knowledge at the date of the patent.(*q*)

Drawings in relation to construction.

The law provides that both the provisional and complete specifications are to be accompanied by explanatory drawings, if required.(*r*) Such drawings are part of, and are to be read with, the specification to which they are attached, and of which they form a part as much as the letterpress. In the words of *Abbott*, C.J.:(*s*) "An inventor of a machine is not tied down to make such a specification as by words only would enable a skilful mechanic to make the machine, but he is allowed to call in aid the drawings which he annexes to the specification; and

(*k*) (1873) L. R. 2 App. Cas. 423, 431.
(*l*) (1884) 1 R. P. C. 98, 101.
(*m*) See also Ellington *v.* Clark, (1888) 5 R. P. C. 325.
(*n*) (1884) 1 R. P. C. 197, 199.
(*o*) Crosthwaite *v.* Steel, (1889) 6 R. P. C. 190.
(*p*) p. 241 *ante*.
(*q*) See pp. 241–243 *ante*.
(*r*) 46 & 47 Vict. c. 51, s. 5, sub-s. 3 and 4.
(*s*) Bloxam *v.* Elsee, (1825) 1 Car. & P. 558; 9 Dowl. & Ry. 215; 6 B. & C. 169; 3 L. T. O. S. Q. B. 93; see also Milles *v.* Searle, (1893) 10 R. P. C. 106.

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if, by a comparison of the words and the drawings, the one will explain the other sufficiently to enable a skilful mechanic to perform the work, such a specification is sufficient."

Drawings are subsidiary to the verbal part of the specification, and not the verbal part to them, and a patentee is not allowed to rely on a drawing as being a description of a material part of his invention when there is no reference whatever to such material part in the body of the specification.(*t*) Moreover, the Act of 1883 only says the specification must be accompanied by drawings, if required, not that it must have them in every case; and it is no objection to a specification that it has no drawings annexed to it, if it sufficiently describes the invention.(*u*) Nor is it an objection that the drawings are roughly executed, if they are sufficient with the verbal part of the specification to enable a competent person to use the invention.(*x*)

On the point as to how far the drawings may aid the description in the specification, the following observations of Lord *Blackburn* are instructive:(*y*) "The next thing as to which there is said to be an infringement is the plate being made with a curve, so that it is elastic. . . . . Now we have to look at *Grayson's* patent in order to see whether that merit is claimed in any part. It is admitted that throughout the whole of the letterpress there is never an allusion to any curved or elastic plate at all; but in one of the figures, No. 2, in profile, there does appear a curved plate, and it is said that the fact that there appears a curved plate upon that figure is enough to indicate that in the description of his invention *Grayson* described that curved plate, and claimed it as part of his invention. Now, I will not stop to inquire how far a mere picture may be a description of an invention and help the letterpress. It may be so to some extent—how far, I do not stop to inquire. But upon that drawing there is represented a curved plate with a curved bolt attached to it in a way which, if it were carried out according to the drawing, would prevent the elasticity. . . . . Whatever you may say about the picture being part of the description, and so bringing the curved plate within your invention, when the only drawing which shows a curved plate shows that curved plate in a position in which it would not give elasticity, it seems to me to be quite plain that you cannot say that the advantage result-

(*t*) Clark *v.* Adie, (1877) L. R. 2 App. Cas. 315; P. O. R.

(*u*) Per Rook, J., in Boulton *v.* Bull, (1795) D. P. C. 188, 189.

(*x*) Per Gibbs, C.J., in Bovill *v.* Moore, (1815) D. P. C. 369; see also Hinks *v.* Safety Lighting Co., (1876) L. R. 4 Ch. D. 607; 46 L. J. Ch. 185.

(*y*) Clarke *v.* Adie, (1877) L. R. 2 App. Cas. 338.

ing from a curved plate was contemplated as being included in the invention at all."(z)

Construction.

Correction of errors by other parts of the specification.

The specification is to be read as a whole, and if one part corrects what is evidently a slight error contained in another part, it is proper to make the correction, and the presence of such an error will not vitiate the specification;(a) but the provisional and complete specifications cannot be read together in order that the provisional shall supply an omission from the complete specification of a statement which is material to the validity of that document;(b) in other words, the complete specification must itself completely describe the nature of the invention, and in what manner it is to be performed, and if it omits to do either the one or the other, or does the one or the other erroneously, it will be no answer to say that the omission may be supplied by a reference to the provisional.

An error in the drawings or on the face of the specification which a competent workman would at once perceive and correct will form no substantial objection;(c) but the public, to whom the specification is addressed, are not to be called upon to exercise any invention in supplying its defects, and unless there is something in the document itself by which the error can be corrected it will be fatal.(d)

It cannot be contended that errors on the face of the specification or in the drawings which would at once be made apparent and corrected in following out the directions given, tend in any way to mislead; on the other hand, errors which are discoverable only by experiment and further inquiry are absolutely fatal to the specification, on the ground that the public are not to be misled into performing experiments which must fail. It is, moreover, a fatal defect if the specification contain any erroneous statements, amounting to a false suggestion, even though such error would be at once observed by a workman possessed of ordinary knowledge of the subject.(e)

(z) See also Otto *v.* Linford, (1881) 46 L. T. N. S. 40.

(a) Tetley *v.* Easton, (1852) Macr. P. C. 47; Wegmann *v.* Corcoran, (1879) L. R. 13 Ch. D. 65.

(b) Mackelcan *v.* Rennie, (1862) 13 C. B. N. S. 52; p. 164 *ante*.

(c) Otto *v.* Linford, (1861) 46 L. T. N. S. 40; Morgan *v.* Seaward, (1836) 1 W. P. C. 174; Simpson *v.* Holliday, (1865) 13 W. R. 578; 12 L. T. N. S. 99; Derosne *v.* Fairie, (1835) 1 W. P. C. 157; Gandy *v.* Reddaway, (1883) 2 R. P. C. 52; Edison *v.* Woodhouse, (1887) 4 R. P. C. 107; Hopkinson *v.* St. James's Electric Light Co., (1892) 10 R. P. C. 46; Miller *v.* Searle, (1893) 10 R. P. C. 106.

(d) British Dynamite Co. *v.* Krebs, (1875) G. P. C. 90; 13 R. P. C. 190; Hinks *v.* Safety Lighting Co., (1876) L. R. 4 Ch. D. 616; United Telephone Co. *v.* Harrison, (1882) L. R. 21 Ch. D. 720; 51 L. J. Ch. 705; Muntz *v.* Foster, (1844) 2 W. P. C. 108.

(e) Simpson *v.* Holliday, (1864) 5 N. R. 340; see also p. 178 *ante*.

CHAPTER VI.

AMENDMENT OF THE SPECIFICATIONS.

PART I.—GENERAL.

Certain amendments are allowable.

A PATENT is void and of no effect so long as there is a defect in the specification, but the law, in the interests and for the protection of patentees, allows certain amendments to be made in those documents from time to time; so a patent, otherwise void, owing to the carelessness or ignorance of the patentee in fulfilling his obligation of specifying the invention and the mode of carrying it into practical operation, may, by amendment of the specification, or specifications, as the case may require, be made perfectly valid.(*a*)

It is not the practice of the Patent Office however to allow the amendment of the provisional specification further than by the correction of mere clerical errors.(*b*)

Necessity for amendments should be avoided.

It will appear that it is greatly to the interest of the patentee to draft the specifications in the first instance with such care as will render subsequent amendments unnecessary. The consequences of an amendment may be, not only the incurring of expense, but the possible inability to recover damages in respect of infringements of the patent committed before the amendment.

Procedure when specification is published.

The procedure relative to the amendment of specifications which have become public property is regulated by s. 18 (as amended by s. 5 of the Act of 1885) and s. 19 of the Act of 1883, together with the Patents Rules 1890 made under the powers conferred by the Act of 1883. Where this procedure applies it is immaterial whether the Patent Office has, or has not, advertised its acceptance of the complete specification.(*c*) Consequently, when a complete specification has been accepted,

(*a*) 46 & 47 Vict. c. 57, s. 20. The present chapter deals only with the amendment of specifications which have been accepted and become open to public inspection (46 & 47 Vict. c. 57, s. 10); questions relating to the amendment of the specifications before they have become public property are treated of in chap. vii.

(*b*) Patent Office Circular of Information (1897).

(*c*) Jones' Patent, Griff. P. C. 313.

Allowable Amendments.

though the Patent Office has not by advertisement (*d*) signified its acceptance, it is not a valid objection to an amendment, once it is allowed, that the request for and the nature of the amendment were not advertised in the prescribed manner.(*e*)

The hearing of an opposition to the grant of a patent will be postponed to the hearing of an opposition to an application for leave to apply at the Patent Office for leave to amend the specification.(*f*)

Defects which are fatal.

If the specification describe and claim anything which is not subject-matter (*g*) or which is useless (*h*) or which is not new (*i*) at the date of the patent, the patent is void. Again, if the title of the invention is inaccurate and misdescribes the invention in any respect, the patent may be void on the ground of misrepresentation, though there may have been no intention to deceive either the Crown or the public; (*k*) and if the specification be insufficient as to any part of the invention described, or if it contain any misstatement respecting any material particular relating to the invention, whether inadvertently inserted or not, the patent is wholly void so long as the specifications remain tainted with any of the above defects.(*l*)

History of power of amendment.

Nature of Allowable Amendments.—Before 1834, the date of the statute 5 & 6 Will. IV. c. 83, it was impossible to cure any defects such as the above, and persons not unfrequently lost the benefit of useful and meritorious inventions in consequence. The passing of the above statute, however, to a great extent removed this reproach to our Patent Laws, and though it was repealed by the Act of 1883,(*m*) its provisions and the benefits which it extended to patentees, were, with further additions, re-enacted by that Act.

From 1834 to the passing of the Act of 1883 patentees could only amend their specifications by way of disclaimer,(*n*) that is to say, they could only cut matter out which they considered to be superfluous as lacking utility or novelty, or as not being subject-matter.

If what was left of the specification would satisfy the requirements of the law, then the patent would be saved; but there was no provision for making a bad or incomplete descrip-

(*d*) 46 & 47 Vict. c. 57, s. 10.
(*e*) *Ibid.*; 46 & 47 Vict. c. 57, s. 18; p. 277 *post*.
(*f*) Cochrane's Patent, (1885) Griff. P. C. 304.
(*g*) Chap. ii. *ante*.
(*h*) Chap. iv. *ante*.
(*i*) Chap. iii. *ante*.
(*k*) Chap. v. *ante*.
(*l*) Chap. v. *ante*.
(*m*) 46 & 47 Vict. c. 57.
(*n*) Foxwell *v.* Bostock, (1864) 4 De G. J. & S. 298, 306.

Allowable Amendments.

tion into a good or complete one, neither was it allowable to explain any ambiguity. It, consequently, very frequently happened that patentees found their specifications construed by Judges in a manner which they never intended, and were, sometimes, to their mortification told that, though their inventions were good and valuable, yet their specifications were so defective, and so hopelessly beyond the power of amendment by any means known to the law, as to make it impossible to maintain protection in respect of such inventions.

Very slight additions, however, were formerly allowed when they were necessary to render what remained after disclaimer intelligible,(*o*) as, for example, the addition or transfer of the words "herein described." (*p*)

Amendments allowed under Act of 1883.

The Act of 1883 not only provides that patentees may disclaim any portion of their specifications, but extends to them the right, with the sanction of the Comptroller-General, and the law officer on appeal, to correct or explain any defective passage on condition that such disclaimer, correction, or explanation does not make the specification as amended claim an invention substantially larger or substantially different from the invention claimed by the specification as it stood originally.(*q*)

If there be no action for infringement or proceeding for the revocation of the patent pending at the time the patentee wishes to make an amendment in the specification, or if there be an action for infringement, or petition for revocation pending, and the patentee has obtained the necessary permission of the Court or a Judge,(*r*) all that it is necessary for him to do is to obtain the sanction of the Comptroller-General, or law officer, in the prescribed manner, when he will be allowed to make the amendment as a matter of course.(*s*)

An amendment, when there is no pending action or petition for revocation, may consist of a *disclaimer*, *correction*, *or explanation*; but it would appear that when a patentee desires to amend his specification pending an action for infringement, or petition for the revocation of the patent, he will only be allowed to do so by way of *disclaimer*, and not by correction or explanation, and he must first obtain the sanction of the Court or a Judge,(*t*)

(*o*) Ralston *v.* Smith, (1865) 11 H. L. C. 223, 245.

(*p*) Thomas *v.* Welch, (1866) L. R. 1 C. P. 192, 195.

(*q*) 46 & 47 Vict. c. 57, s. 18, sub-s. 8.

(*r*) 46 & 47 Vict. c. 57, s. 19; Hall's Patent, (1888) 5 R. P. C. 306.

(*s*) 46 & 47 Vict. c. 57, s. 18, sub-s. 9.

(*t*) 46 & 47 Vict. c. 57, s. 19; 51 & 52 Vict. c. 50, s. 5.

after which the procedure is the same as if no such action or proceeding for revocation were pending.(*u*)

Allowable Amendments.

The Comptroller-General and law officer have an absolute discretion as to granting or refusing leave to amend, and not being a "Court" prohibition does not lie to them.(*x*)

Discretion of Comptroller and law officer.

Leave to apply is no guarantee that the specification, when amended, will not still invalidate the patent. The patentee, it must be remembered, makes the amendment at his own peril.(*y*) Thus, in the case of *Deeley's Patent* (*z*) it appeared that three claims were, in an infringement action, held to have been anticipated, and the patentee then amended by striking out the three claims and entering a disclaiming clause. The defendant in the action thereupon petitioned for the revocation of the patent, and succeeded on the ground that one of the remaining claims was bad for want of subject-matter.

Leave to amend no guarantee of validity.

It is not to be inferred from the circumstance that a patentee has entered a disclaimer, or made any other amendment of the specification, that the patent was necessarily bad before the amendment, for it may well be that the alteration was in fact not requisite, and only made to obviate any doubt that might arise on the specification as originally filed.(*a*)

Amendment no evidence of prior invalidity.

The Act of 1883, which provides that "an amendment shall, in all courts and for all purposes, be deemed to form part of the specification," (*b*) expressly states (*c*) that "no amendment shall be allowed that would make the specification, as amended, claim an invention larger than, or different from, the invention claimed by the specification as it stood before amendment."

Proposed amendments which extend the claim.

A disconformity between an amended complete specification and a provisional specification is just as fatal to the validity of the patent as a disconformity between the original specifications before amendment.(*d*)

Disconformity after amendment.

A patentee is not allowed to amend his specification in such a way as to make the amendment amount to an imputation that certain disadvantages exist in the method of carrying out an invention described and claimed by the specification of a prior patent, when, as matter of fact, there is no evidence before the

(*u*) Hall's Patent, (1888) 5 R. P. C. 305.

(*x*) Van Gelder's Patent, (1889) 6 R. P. C. 22; *Ex parte* Simon, 4 Times Reports 754.

(*y*) Lake, (1887) Griff. L. O. C. 16; 5 R. P. C. 415.

(*z*) (1895) 12 R. P. C. 65, 192.

(*a*) Stocker *v.* Warner, (1845) 1 C. B. 148, 165; 9 Jur. 136, 138.

(*b*) s. 18, sub-s. 9. (*c*) s. 18, sub-s. 8.

(*d*) Gaulard and Gibbs, (1889) 6 R. P. C. 215; Lane Fox *v.* Kensington Knightsbridge Electric Lighting Co., (1892) 9 R. P. C. 221, 413; see also pp. 168–175 *ante*.

Allowable Amendments.

Comptroller or law officer of the actual existence of such alleged disadvantages, though such allegation would not be an objection to filing the specification in the first instance.(*e*)

Amended specification takes the place of the original.

The Act of 1883 further provides (*f*) that, after an amendment has been allowed, "the amendment shall, in all Courts and for all purposes, be deemed to form part of the specification." The authorities warrant the statement that these words mean (*inter alia*) that the amended specification shall, in all Courts and for all purposes, have the same effect as if it had been filed, in the amended form, on the date of the original, so that a patentee may sue for, and recover, on his amended specification, damages in respect of infringements committed before the amendment; but this statement is subject to the qualification that the patentee must establish, to the satisfaction of the Court, that his original specification was framed in good faith and with reasonable skill and knowledge.(*g*) If a successful plaintiff in an action for infringement is able to satisfy the Court on this point, the account or damages, as the case may be, will be ordered as from the date of the patent. (*h*)

Law officer's decision is final as to fact of the extension of a claim by amendment.

It would also appear, on the authority of *Moser* v. *Marsden*,(*i*) a case decided by the House of Lords, that, though it is open to an opposer before the Comptroller and law officer to raise the question that the proposed amendment would make the claims, as amended, larger than the original claim, yet the decision of the law officer is final on this point, and the Courts will not review it. It is submitted, on the other hand, that in a subsequent action on the patent the amendment is not conclusive and may be questioned on the point as to whether the amended claim embraces something which is not to be found fairly described in the original provisional specification, and so creates a fatal disconformity between the amended complete specification and the former document.(*k*) That is to say, the decision of the law officer upon the question of amendment is only unreviewable so long as the amendment allowed is within the limits of the provisional specification as originally filed; if the amendment goes outside that, it would create a fatal disconformity to which the Courts would give effect. The older cases usually cited in favour of the proposition that an amendment which widens or alters the scope of the claims is fatal to

(*e*) Hampton and Facer, (1887) Griff. L. O. C. 13.
(*f*) 46 & 47 Vict. c. 57, s. 18, sub-s. 9.
(*g*) 46 & 47 Vict. c. 57, s. 20.
(*h*) Wenham *v.* Carpenter, (1887) 5 R. P. C. 68; Hopkinson *v.* St. James's and Pall Mall Electric Light Co., (1892) 10 R. P. C. 62.
(*i*) (1895) 13 R. P. C. 24.
(*k*) See p. 169 *ante*.

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the validity of the patent must, in so far as they were decided upon the former Acts, be considered as not applicable to the Act of 1883, and in so far as those decided since the Act of 1883 are concerned must be considered as overruled on this point.(*l*)

It is to be noticed that the question of the legality of a disclaimer or other amendment once allowed by the law officer was not argued in *Moser* v. *Marsden*,(*m*) and it may be that upon argument the House of Lords might review their decision in that case so far as it affects the point under discussion, but it is submitted that the above statements embrace a true exposition of the law on the subject. In *Perry* v. *Société de Lunetiers* (*n*) the objection was taken that an amendment allowed by the law officer had enlarged the claims originally made. The objection however failed, and it was consequently not necessary for the Court to decide whether having regard to *Moser* v. *Marsden* the objection could be made at all. It is submitted that it could not; but, if in fact there had been an enlargement of the claim which went beyond the limits of the provisional specification, the patent might have been declared void on the ground of disconformity between the specifications.(*o*)

Practice when an amendment is objected to on the ground that it extends the claim.

Before the decision in *Moser* v. *Marsden*,(*p*) the Comptroller-General and the law officers used to be guided in the matter of allowing amendments, which were said by opponents to make the specification, contrary to the provisions of s. 18, sub-s. 8 of the Act of 1883, as amended, claim an invention substantially larger than or substantially different from the invention claimed by the specification as it stood before amendment, by the rule that in the event of doubt the patentee was to have the benefit of the doubt. This rule was based upon the then prevailing notion that the law officer's decision was not conclusive, and consequently if it was wrongly exercised in favour of the applicant it could be set right by the Courts, but, if it was wrongly exercised against the applicant, it was final and not open to review.(*q*) When this ground of opposition is taken against a

(*l*) The cases referred to are Ralston *v.* Smith, (1865) 11 H. L. C. 550; Dudgeon *v.* Thompson, (1877) L. R. 3 App. Cas. 55; *Re* Gaulard *v.* Gibbs' Patent, (1888) 5 R. P. C. 189; 6 R. P. C. 225; 7 R. P. C. 367; Van Gelder's Patent, (1889) 6 R. P. C. 22; Farber Fabrik *v.* Bowker, (1891) 8 R. P. C. 391; Lane-Fox *v.* Kensington and Knightsbridge Electric Lighting Co., (1892) 9 R. P. C. 221, 413.

(*m*) See Dellwick's Patent, (1896) 13 R. P. C. 596.

(*n*) (1896) 13 R. P. C. 664.

(*o*) See p. 169 *ante*.

(*p*) (1895) 13 R. P. C. 24.

(*q*) Bateman and Moore's Patent, (1854) Macr. P. C. 116; Lake, (1886) Griff. L. O. C. 16,

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proposed amendment in future the law officers will probably not be so ready to allow the amendment as formerly, but will require to be satisfied that the amendment will not infect the specification with the vice referred to in sub-s. 8 of s. 18 of the Act of 1883, before they will grant leave to apply at the Patent Office to make the amendment desired.(*r*)

Example of a proposed amendment which extends the claim.

Walker's Application,(*s*) selected from amongst other cases, furnishes a good illustration of an amendment being refused on the ground that no amendment can be allowed which would make the amended specification claim an invention substantially larger than, or substantially different from, the invention as claimed by the specification as it stood before amendment.(*t*)

In *Walker's Application*, (Griff. L. O. C. 22) it appeared that *Walker's* patent was for "improvements in machinery employed for preparing and spinning cotton and other fibrous materials." The complete specification stated that the object of the invention was to support the top clearing rollers, so as to prevent them from rolling off the front rollers, and to keep them always in equal contact with both rollers. The invention consisted principally in an inclined bearer or bearers (slotted or otherwise) on or against which the pivots projecting from the centre of the clearers rested. In one part of the specification it was stated that "the said bearers may either be fixed to any hook, or they may be attached to any other fixing or part of the frame, in which case they form adjustable inclined planes." The claim was for the construction and application to the class of machinery referred to of an inclined bearer or bearers to support the top clearing rollers substantially as set forth. The patentee sought by his amendment (*inter alia*) to insert the word "*adjustable*" before the term "bearer or bearers" wherever the same occurred in the description and in the claim. The Comptroller, however, refused to allow this, holding that the insertion of the word "*adjustable*," as desired, would make the specification claim an invention substantially larger than, or substantially different from, the original specification.(*u*)

Other examples of allowable and non-allowable amendments.

It is competent for a patentee to claim a combination as a whole, and also a subordinate part or parts separately.(*x*) When,

(*r*) See Parkinson's Patent, (1896) 13 R. P. C. 512.

(*s*) Griff. L. O. C. 22; see also Parkinson's Patent, (1896) 13 R. P. C. 509.

(*t*) 46 & 47 Vict. c. 57, s. 18, sub-s. 8.

(*u*) See also Ralston *v.* Smith, (1865) 11 H. L. C. 223, 254; Lucas' Patent, (1854) Macr. P. C. 235; Gaulard and Gibbs' Patent, (1889) 6 R. P. C. 215; Heath and Frost's Patent, (1886) Griff. P. C. 311; Parkinson's Patent, (1896) 13 R. P. C. 509; Johnson's Patent, (1896) 13 R. P. C. 659.

(*x*) See p. 228 *ante*.

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however, there is a distinct claim to the whole, it is not allowable for the patentee to amend his specification by striking out that claim and inserting one for a subordinate part alone, since such an alteration would make the amended specification claim an invention substantially different to that claimed by the original.(*y*)

In a case where certain patentees in their specification described and claimed several parts of an apparatus, and it appeared on the face of it that the intention was to claim the several parts conjointly, an alteration was allowed whereby the words "firstly," "secondly," and "thirdly" were struck out, and the word "or" was substituted for "secondly" and "and" for "thirdly," but the insertion of the words "in combination with" between the second and third claiming clauses was not allowed.(*z*)

A defect can not be amended unless it is consistent with the patentee intending to fully specify the invention and mode of carrying it out.

When an amendment is required it is because there is some defect in the specification, but that defect must be one which is consistent with the patentee intending to fulfil the condition of the grant by properly describing his invention and the mode of carrying it into effect; and if that condition has been fulfilled no amendment is required or will be allowed.(*a*)

Leave to apply to amend may be refused on the ground that the ambiguity of the proposed amendment, if such be the case, would lead to litigation and be calculated to create uncertainty among persons interested in the patent.(*b*)

Reasons for requiring amendments are to be stated in writing.

A patentee desirous of amending his specification is required to state in writing his reasons for the same,(*c*) but such reasons form no part of the specification when amended;(*d*) nor will leave to amend be refused merely on the ground that the reasons given by the applicant in his application are insufficient.(*e*) It is to be noticed that s. 18, sub-s. 2, of the Act of 1883 does not in terms say that the reasons on the strength of which the applicant or patentee desires to be allowed to amend the specification are to be advertised, but probably the reasons are part of the request,(*f*) and therefore should be advertised.

It will now be convenient to consider separately the different forms of amendment which the law allows.

(*y*) Serrell's Patent, (1889) 6 R. P. C. 101.

(*z*) Bateman and Moore's Disclaimer, (1852) Macr. P. C. 116.

(*a*) See Nordenfelt, (1885) No. 8269, Griff. L. O. C. 18, 21.

(*b*) Parkinson's Patent, (1896) 13 R. P. C. 509, 514.

(*c*) 46 & 47 Vict. c. 57, s. 18, sub-s. 1.

(*d*) Cannington *v.* Nuthall (1871) L. R. 5 H. L. App. 205, 208.

(*e*) Ashworth, (1878) No. 3513, Griff. L. O. C. 6, 7.

(*f*) *Ibid.*

Disclaimer.

Disclaimer.—The following remarks of Lord *Westbury* with reference to a disclaimer under the Act of 1835 are applicable to a disclaimer under the Act of 1883:—

> "The object of the Act authorising disclaimers was plainly this, that when you have in your specification a sufficient and good description of a useful invention, but that description is imperilled or hazarded by something being annexed to it which is capable of being severed, leaving the original description in its integrity good and sufficient . . . . then you might, by the operation of a disclaimer, lop off the vicious matter, and leave the original invention as described in the specification, untainted and uninjured by that vicious excess.(*g*) But it never was intended that you should convert a bad specification, in the sense of its not containing the description of any useful invention at all, into a good specification by adding words which would convert what has been properly called in the Court below 'a barren and unprofitable generality' into a specific and definite and practical description. . . . . The statute never contemplated that a patentee should have the power, under the form of a disclaimer, of making material additions to the original specification, so as, by the aid of the corrected form of words and the additions so made, to introduce into the specification an accurate and perfect description of an invention which you seek for in vain in the original specification."(*h*)

Disclaimers which extend the claim.

A disclaimer which extends the ambit of the claims, or makes the specification claim an invention substantially different to that originally claimed, should not be allowed by the Comptroller or law officer,(*i*) though the law officer's decision must now be regarded as final.(*j*)

When it is said by the opponent that a disclaimer or other amendment will extend the claim, the real question to be decided always is, not whether any particular claim is extended by the amendment, but whether the total grant is extended. Though one particular claim may be extended it may be that it is only made to include something which was originally included in another claim. In such a case the law officer does not refuse leave to apply to make the amendment desired,(*k*)

(*g*) *E.g.*, Cochrane's Patent, (1885) Griff. P. C. 304; Rylands' Patent, (1888) 5 R. P. C. 665; Nordenfelt's Patent, (1887) Griff. L. O. C. 18; Allen's Patent, (1887) Griff. L. O. C. 3.

(*h*) Ralston *v.* Smith, (1865) 11 H. L. C. 223, 243.

(*i*) 46 & 47 Vict. c. 57, s. 18, sub-s. 8.

(*j*) p. 260 *ante*.

(*k*) See Cochrane's Patent, (1885) Griff. P. C. 384; Ashworth's Patent, (1886) Griff. L. O. C. 6; Rylands' Patent, (1888) 5 R. P. C. 665; Nordenfelt's Patent, (1887) Griff. R. P. C. 18; Lake's Patent, (1887) Griff. R. P. C. 16; Morgan's Patent, (1886) Griff. R. P. C. 17.

for the object of amendment must be merely to take out and remove part of, or to further explain, what had been claimed before, and the Act did not intend that, by striking out or altering part of the specification, the patentee should be able to give an extended and larger sense to what is left, so as to make it embrace something which it did not embrace before.(*l*) Disclaimer.

The words of sub-s. 1 of s. 18 of the Act of 1883, "by way of disclaimer, correction, or explanation," were meant to refer to disclaiming something which was originally wrongly inserted, or to explaining something which requires explanation, having regard to the statement made in the first instance by the patentee.(*m*)

If there is a claim for A, B, C, D, E, and F, and the patentee by amendment confines it to F, the amended claim is narrower than the original, but it is not different, for it is included in it.(*n*)

A disclaimer which turns an ambiguous specification into a clear specification is allowable.(*o*) Disclaimer which turns an ambiguous into a clear specification is allowable, but not so a disclaimer which turns an insufficient into a sufficient description.

A disclaimer which, on the other hand, turns an insufficient description into a sufficient one will not be allowed when the patent was obtained on the personal application of the real inventor himself, though it might be allowed if the invention was one communicated from abroad, and the foreign real inventor came and satisfied the Comptroller or law officer that the actual applicant had made a mistake in writing out or translating the description furnished to him by the foreign real inventor.(*p*)

In *Ralston* v. *Smith*,(*q*) a case decided by the House of Lords under the repealed Acts, which is not an authority now upon the effect of the law officer's decision with reference to allowing an amendment, but which may be quoted as an instance of a so-called disclaimer really amounting to an extension, a patentee of "improvements in embossing fabrics" claimed the use of grooved, fluted, or indented rollers of metal, wood, or other suitable material, driven at a greater speed than the bowl or bowls connected with them, so as to exert a rubbing action on the fabric, and thereby produce an indefinite variety of patterns. Subsequently he disclaimed the use of any pattern

(*l*) See remarks of Blackburn, J., on the repealed statute, Dudgeon *v.* Thomson, (1877) L. R. 3 App. Cas. 55.

(*m*) Per Webster, A.G., Johnson's Patent, (1896) 13 R. R. C. 660.

(*n*) Cochrane's Patent, (1885) Griff. P. C. 305.

(*o*) Johnson's Patent, (1896) 13 R. P. C. 661-2.

(*p*) *Ibid.*

(*q*) (1865) 11 H. L. C. 223; see also cases referred to in the footnote (*u*) p. 262 *ante*.

Disclaimer.

rollers with the exception of metal rollers with circular grooves. It appeared in evidence that only circular grooves would produce the effect required, and further that the making the roller and bowl revolve at different speeds was not new at the date of the patent. As Lord *Chelmsford* observed, the rollers were not specifically described in the original specification, but were merely involved in the general terms which were used, and the plaintiff had consequently not complied with the condition of the letters patent in particularly describing and ascertaining the nature of the invention. When, therefore, by his disclaimer, he confined his claim to circular grooved rollers as his sole invention, though in one sense he might be said to narrow a right, yet he really extended it, because he thereby enlarged his alleged invention sufficiently to enable him to assert a right under the patent which he never could have successfully maintained upon the original specification.(*r*)

Ralston v. *Smith* may be contrasted with *Seed* v. *Higgins*,(*s*) where a patentee obtained a patent for an improvement in machinery used for sewing-cotton, and his specification appearing to claim the discovery of the application of the principle of centrifugal force for such purpose, he filed a disclaimer, declaring that he intended to claim only the application of centrifugal force in the particular manner described in the specification, and the House of Lords held that the disclaimer was legitimate and saved the patent.

Rule in Seed *v.* Higgins.

The rule involved in *Seed* v. *Higgins* is that approved of by the Attorney-General in giving his judgment in an appeal from the decision of the Comptroller, in a case (*t*) decided upon the Act of 1883—viz., if on its face the specification is clearly capable of two or more constructions, it is open to a person, applying to amend, to satisfy the law officer or the Comptroller that he desires to limit the claim to one, or more, of two or more constructions to which the specification is open.

Thus in the case of *Rylands' Patent*, (1888) 5 R. P. C. 665, the essence of *Rylands'* invention was two modifications in which forms of boxes were constructed, wherein, instead of there being the ordinary hoop-iron, nailed on the flat or side, and so forming an angle with the corner, a groove was cut in the surface of the two sides of the right angle, and in this

(*r*) Ralston *v.* Smith, (1869) 11 H. L. C. 255.
(*s*) (1860) 8 H. L. C. 550.
(*t*) In the Matter of Rylands' Patent, (1888) 5 R. P. C. 665.

groove wire or hoop-iron of some kind was placed, and fastened in, the object being to prevent the edges of the wire catching any obstruction, or being caught by any obstruction in the course of transit, and thereby being torn off or injuring other property. It was agreed on both sides that the patentee contemplated fastening the iron by either *nails* or *loops*, but the opposer alleged that to limit the claim, as the applicant desired to do, to fastening the hoop-irons in the grooves by means of *loops* would be to make the amended specification claim an invention larger than, and different to, that described and claimed by the specification before amendment. The Attorney-General, however, did not take this view of the case, and, applying the above-stated principle, granted leave to apply at the Patent Office to make the amendment proposed. So again, in *Ashworth's Application*, (1886) Griff. L. O. C. 6, it was objected that the proposed amendment would make the specification claim an invention different to that claimed by the original specification, but the Comptroller allowed the amendment. The Solicitor-General, in dismissing an appeal from the Comptroller's decision, expressed himself to be of opinion that the amendment only amounted to an explanation as to which of two possible constructions the patentee wished put on his claim, and that the specification, as a whole, before the amendment, indicated that the patentee really intended the construction to which by the alteration he desired to limit his claim.

Disclaimer.

During proceedings for the repeal of a patent for "improvements in instruments used for writing and marking, and in the construction of inkstands," the patentee filed a disclaimer of three of the claims of his specification. These claims related to pens, and to instruments used for marking with a stamp. Those which remained untouched by the disclaimer were for improvements in pen-holders and pencil-cases, and for the construction of inkstands. It was held by the Court of Common Pleas that the title of the letters patent was satisfied by the specification as amended by the disclaimer.(*u*)

Disclaimer does not operate as a claim to residue.

Prior to the Act of 1883 all the claiming clauses of a specification might be struck out by disclaimer, if there remained in the body of the specification words sufficient to distinguish what the invention was which the patentee claimed. The explanation given by the Court of Appeal (*x*) of the concluding words of s. 5, sub-s. 8 of the Act of 1883 supports the statement that the law in this particular remains unaltered. It must, however, be remembered that the effect of a dis-

(*u*) R. *v.* Mill, (1850) 10 C. B. 379.
(*x*) Siddel *v.* Vickers, (1888) L. R. 39 Ch. D. 92; 5 R. P. C. 416.

Correction and Explanation.

claimer is merely to strike out from the specification those parts which are disclaimed, and it cannot operate by way of a claim to the residue, nor can what remains of the specification be construed by the disclaimer; (*y*) nor does the reason for a disclaimer form any part of the specification, by virtue of the disclaimer, so as to influence the construction to be put upon it.(*z*)

Corrections and explanations are allowable when they do not exceed

Correction and Explanation.—A mistaken method or description of a process may be corrected by amendment—*e.g.*, where a patentee directed that "the last traces" of a substance should be removed from solution by cooling by ice, and the evidence showed that *all* the substance could not be removed by ice cooling, he was allowed to substitute the words "as much as possible" for the words "the last traces." Had the specification directed the removal of "the last traces" by "any well-known means," or "by any means," or "by the best means," the amendment would not have been allowed, as it would then have made an original insufficient into a sufficient description.(*a*)

The patentee must in all cases show that there is a real reason for requiring a correction or explanation before he will be permitted to make one. Thus, where an applicant asked for leave to amend his specification by inserting an explanatory statement of the principle on which the invention was based, the law officer, on appeal, refused to allow the amendment, because he thought the principle of the invention was amply described in the original specification, and he was of opinion that no ground had been shown on which the amendment ought to be allowed.(*b*)

Morgan's Patent (*c*) furnishes an instance of an amendment by way of explanation and correction. It appeared that one of the figures in the drawings had been misdescribed, and the figure was clearly included in the provisional specification and covered by the claim of the complete specification. The patentee was allowed to amend by inserting a proper description of the figure, but he was not allowed to add anything to his claim.

the legitimate function of a correction or explanation.

The function of a correction or explanation within s. 18 of the Act of 1883 is to explain more clearly what was the meaning of the patentee at the time he patented the invention;

(*y*) Per Cresswell, J., Tetley *v.* Easton, (1852) 2 C. B. N. S. 706, 730.

(*z*) Cannington *v.* Nuttall, (1871) L. R. 5 E. & I. App. 205, 228.

(*a*) Johnson's Patent, (1896) 13 R. P. C. 663; p. 265 *ante*.

(*b*) Nordenfelt's Patent, (1887) Griff. L. O. C. 18.

(*c*) (1886) Griff. L. O. C. 17.

Correction and Explanation.

it is not intended that he should put in subsequently ascertained knowledge, and such an insertion will not be allowed.(*d*)

An explanation which is requisite to remove an ambiguity as to the real meaning of the patentee is justifiable,(*e*) but an extensive amendment which amounts to a rewriting of the specification will not be permitted.(*f*)

Clerical errors: jurisdiction of the Master of the Rolls.

The Master of the Rolls, as keeper of the records, had, prior to the Act of 1883, an original jurisdiction, in cases where he was satisfied that a specification as filed contained clerical errors, to order that such errors should be rectified.(*g*)

Corrections were made, on the authority of the Master of the Rolls, where "October" was writen by mistake for "November;"(*h*) where "Charles" was written for "George"(*i*) where reference numbers were transposed;(*k*) where "recovery" had been written for "covering;"(*l*) where "wire" was inserted for "fire," and the mistake was not discovered for five years; and where there was an apparent error in the drawings attached to the specification.(*m*)

The Master of the Rolls had never authority to permit or order an erroneous claim or statement to be expunged or amended merely in his capacity of keeper of the records, his authority in such capacity to allow corrections being strictly limited to verbal or clerical errors.

But in *Re Berdan's Patent*,(*n*) where a disclaimer had been filed without the consent of the patentee, it was held that the Master of the Rolls had jurisdiction, without bill filed, to order it to be taken off the file. The case was distinguished from *In re Sharp's Patent*,(*o*) on the ground that in the latter the application was not to take an improperly filed document off the file, but to alter an enrolment.

The Act of 1883 does not appear to have taken away this jurisdiction of the Master of the Rolls to allow an amendment of merely verbal or clerical errors in a specification, both before and after it has been placed on the file.(*p*)

(*d*) Beck and Justice, (1877) No. 4114, Griff. L. O. C. 10.

(*e*) Ashworth's Patent, (1886) Griff. L. O. C. 6.

(*f*) Nairn's Patent, (1891) 8 R. P. C. 444.

(*g*) Sharp's Patent, (1840) 1 W. P. C. 641, 646; 3 Beav. 245; Johnson's Patent, (1877) L. R. 5 Ch. D. 503.

(*h*) Rubery's Patent, (1837) 1 W. P. C. 649 n.

(*i*) Dismore's Patent, (1853) 18 Beav. 538.

(*k*) Redmond's Patent, (1828) 1 W. P. C. 649 n; 5 Russ. 44.

(*l*) Nickell's Patent, (1841) 1 W. P. C. 650; 4 Beav. 563.

(*m*) Abel's, (1874) No. 2081.

(*n*) (1875) L. R. 20 Eq. 346.

(*o*) (1840) 1 W. P. C. 641.

(*p*) *Re* Gare's Patent, (1884) L. R. 26 Ch. D. 105; *Re* Morgan's Patent, (1876) 24 W. R. 245; Judicature Act, (1873) s. 17, sub-s. 6.

Correction and Explanation.

In *Re Gare's Patent* (*q*) the Master of the Rolls allowed the correction of a clerical error in a specification which had been filed under the Patent Law Amendment Act of 1852, and gave it as his opinion that the Act of 1883 does not affect the power of the Master of the Rolls, as keeper of the records, to allow the amendment of a clerical error in a specification, which is to be considered as under his authority. The Master of the Rolls expressed the further opinion that so long as the specification is in the Patent Office, and before the patent is sealed, the proceedings of s. 18 of the Act of 1883 should be the only proceedings taken by any one asking for amendment.

Present practice is to allow correction of clerical errors under s. 18 of Act of 1883, whether the patent is sealed or not.

This section also regulates the correction of clerical errors as well as all other matters of legitimate correction after the patent is sealed, for the amendment of a clerical error is included in the term "correction" in s. 18, sub-s. 1, of the Act of 1883, and consequently it is not necessary to invoke the authority of the Master of the Rolls to rectify a clerical mistake. S. 91 expressly gives the Comptroller power to correct clerical errors in, or in connection with, any application for a patent, or in the name, style, or address of a registered proprietor.(*r*)

Delay may be a bar to amendment.

The amendment of a clerical error in a specification, as also other amendments, may be refused on the ground of delay.(*s*) Thus in *Re Blamond's Patent* (*t*) the Lord Chancellor, though doubting whether he had power under 15 & 16 Vict. c. 83 to order the amendment of a clerical error in the spelling of the patentee's name, refused to do so on the ground that the applicant had shown gross negligence in not applying to rectify the mistake earlier, as the patent was five years old, and it was impossible to say what interests might be affected by doing what was desired.

Amendment by inserting drawings.

So far there has been no reported case of an application for leave to amend a specification by the insertion of a drawing not described in the specification. It is submitted that, if the insertion of a drawing be desirable in order to make clear what the patentee intended when he filed his specification, it would be allowed, on the ground that a drawing is part of the specification, and its insertion merely amounts to a legitimate explanation.(*u*)

Explanation of ambiguous claim.

When a claim is ambiguous it may be amended by way of

(*q*) L. R. (1884) 26 Ch. D. 105.
(*r*) See Patent Rules, (1890) r. 16; Form P., Appendix.
(*s*) Blamond's Patent, (1860) 3 L. T. N. S. 800; Lacy's Patent, (1890) 7 R. P. C. 469; Johnson's Patent, (1896) 13 R. P. C. 659.
(*t*) (1860) 3 L. T. N. S. 800.
(*u*) But see *Re* Pullan's Patent Johns. Pat. Man. 5th ed. p. 118.

explanation, so as to make perfectly clear what was the real meaning of the patentee, taking into account the fact that the claim must be construed with reference to the context and drawings of the specification.(x) Conditions.

Conditions.—The Comptroller and law officer have the power to impose conditions when granting leave to apply at the Patent Office to amend;(y) as also has the Court or a Judge, in cases where a patentee desires to amend during an action for infringement or a petition for revocation.(z)

Amendments are frequently only allowed on conditions framed for the protection of the public or individuals.

It is not an uncommon condition that no action shall be brought on the amended specification in respect of infringements committed before amendment,(a) or in respect of certain continued infringements after amendment,(b) though it is not the usual practice to impose the former condition when leave is granted to amend the specifications of patents of later date than January 1, 1884. Such cases are regulated by s. 20 of the Act of 1883, and the Court has, on the trial, to decide whether the matters referred to in that section have been established to its satisfaction—that is to say, whether or not the original claim was framed in good faith and with reasonable skill and knowledge, for damages cannot be awarded in respect of prior infringements unless the Court finds that good faith and reasonable skill and knowledge have been exercised in framing the original specification.(c)

In *Re Hearson's Patent* (d) the Comptroller, on granting leave to apply at the Patent Office to amend the specification, imposed the condition that the applicants should not bring an action or take any proceeding in respect of an infringement of the patent prior to January 1, 1884.

An examination of the cases in which January 1, 1884, has been fixed shows that the reason for fixing that date was the doubt as to whether s. 20 of the Patents, &c., Act, 1883, would avail to protect persons who were sued for infringements alleged to have been committed prior to the passing of the Act.(e)

Any party is, however, at liberty to bring forward any

(x) Ashworth, (1878) No. 3513, Griff. L. O. C. 6.

(y) Hearson's Patent, (1884) 1 R. P. C. 214; Pietschman's Patent, (1884) Griff. P. C. 314.

(z) 46 & 47 Vict. c. 57, s. 19; p. 251 *post*.

(a) p. 272 *post*.

(b) p. 273 *post*; Holmes *v.* L. & N. W. Ry. Co. (1852) Macr. P. C. 31; Smith's Patent, (1855) Macr. P. C. 232; *Re* Medlock's Patent, (1865) Newton, L.J., vol. xxii. p. 69.

(c) 46 & 47 Vict. c. 57, s. 20; Wenham *v.* Carpenter, (1887) 5 R. P. C. 68.

(d) (1884) 1 R. P. C. 213.

(e) See cases in Griff. P. C.; Allen, (1887) Griff. L. O. C. 3.

Conditions.

special circumstances to cause the law officer to insert a later date than January 1, 1884,(*f*) though the usual practice is not to extend protection to infringers beyond that date.(*g*)

During the argument in *Ashworth's Application*,(*h*) the Solicitor-General said that if he saw, or if there was any evidence before him, that the patent had been used for the purpose of endeavouring to obtain a monopoly larger than that which the specification as amended claimed, he should consider that a special circumstance, and impose the condition that no action should be brought for anything done at any time before the amendment; for instance, if the patentees had been threatening persons, and endeavouring to prevent persons from making or selling wire hardened and tempered in a mode different to that described and claimed by the amended specification.

Under the old practice, in order to protect the interests of manufacturers who had embarked large capital in a trade on the strength of a patent having been allowed to remain in its imperfect state for a long time, the law officers frequently imposed conditions for their protection.(*i*) Such conditions were that the patentee should not sue in respect of infringements committed before amendment,(*k*) or in respect of certain continued infringements by the use of certain specified machines actually in use before the amendment,(*l*) or in respect of fresh infringements by certain persons in virtue of the continued use of a process employed by them prior to the amendment,(*m*) or in respect of infringements by machines made under specified contracts.(*n*)

A condition that no action be brought in respect of infringements prior to a certain date protects the continued user of infringing articles made before that date, and also the sale of such articles unsold at the fixed date.(*o*)

But a condition that no action be brought in respect of the infringement of a patent, of which the amendment of the specification is sought, does not prevent the patentee from

(*f*) Haddan, (1885) Griff. L. O. C. 12.

(*g*) Ashworth, (1886) Griff. L. O. C. 6.

(*h*) *Ibid.*

(*i*) Tranter's Patent, Jones' Patent, (1873) Johns. Pat. Man. 5th ed. pp. 191, 192.

(*k*) Lucas' Patent, (1854) Macr. P. C. 234, 239; Smith's Patent, (1855) Macr. P. C. 232.

(*l*) Harrison's Patent, (1853) Macr. P. C. 31; Westinghouse's Patent, (1885) Griff. P. C. 315; Crabtree's Patent, Eng. Rep. Jan. to Mar. 1881; Fox's Patent, (1878) No. 3988.

(*m*) *Re* Medlock's Patent, (1865) Newton, Lond. Journ. N. S. vol. xxii. p. 69.

(*n*) Fox's Patent, (1878) No. 3988.

(*o*) Cheesebrough's Patent, (1884) Griff. P. C. 303.

bringing an action on another patent belonging to him, if those articles infringe such other patent.(*p*) Conditions.

When the condition is imposed that no action be brought in respect of certain specified machines, it is usual to order that such machines be marked with distinguishing marks.(*q*)

In the case of patents bearing dates subsequent to January 1, 1884, it is not usual for the Comptroller or law officer to impose the condition that no action shall be brought in respect of any infringements committed after that date, as such cases are provided for by s. 20 of the Act of 1883.

Actions commenced after the amendment of the specifications in respect of infringements committed before amendment are, in certain cases, justifiable, on the ground that it is not right that a person should gain his information from a patentee, and, acting on that information, copy and use his invention. He must not presume upon some defect in the specification, and infringe upon the valuable part of the patent.(*r*)

Under the law prior to the Act of 1883, amendments by disclaimer were retrospective, except when entered pending an action for infringement, in which case it was specially provided that the amended specification should not be given in evidence at the trial.(*s*) Retrospective effect of amendments.

No action, however, could be brought at all in respect of infringements committed before amendment without the leave of the law officer, certified by his fiat.(*t*) Cases in which amendments were made retrospective, and power was given to the patentee to proceed against those who had infringed before the disclaimer was filed, were the exception, and not the rule, and it lay on the party applying for a certificate giving a disclaimer a retrospective power to make out a case entitling him to that certificate.(*u*)

The terms usually imposed by the Court, in granting leave to apply to amend under s. 19 of the Act of 1883, together with the concluding words of the section, "and may direct that, in the meantime, the trial or hearing of the action shall be postponed," are a clear indication that the amendment speaks from the date of the patent, and that there are cases where the Court, in

(*p*) United Telephone Co. *v.* London and Globe Telephone Co., (1884) L. R. 26 Ch. D. 766.

(*q*) Edison's Patent, (1877) No. 2909; Westinghouse's Patent, (1885) Griff. P. C. 315; Haddan's Patent, (1885) Griff. L. O. C. 12, 13; Crabtree's Patent, Eng. Rep. Jan. to Mar. 1881.

(*r*) See Lucas' Patent, (1854) Macr. P. C. 234.

(*s*) 5 & 6 Will. IV. c. 83, s. 1; Perry *v.* Skinner, 2 M. & W. 471; R. *v.* Mill, (1850) 10 C. B. 379.

(*t*) 15 & 16 Vict. c. 83, s. 39.

(*u*) Lucas' Patent, (1854) Macr. P. C. 234, 239.

Amendment after Action on, or Petition against, the Patent.

its discretion, ought to, and would, under the present law, allow an amended specification to be given in evidence in a pending action.(*x*)

If a patentee obtains an injunction against an infringer, before he amends the specification, he cannot enforce his injunction after the amendment, but must proceed *de novo*.(*y*)

When leave to amend has been given, even though on condition and the patentee's assent to the condition has not been notified, an action on the amended specification can be sustained though the amendment of the specification itself was not actually made by the Patent Office officials till after the commencement of the action.(*z*)

Amendments may be made after adverse decision in an action:

Amendment after Action for Infringement.—From a consideration of the principles discussed in the foregoing pages of this chapter, and also from the fact that a judgment adverse to the validity of the patent on the ground of defective specification amounts at most to a declaration of the Court to the effect that the specification as it stands is wholly, or in part, as the case may be, bad, and is not an order for revocation, it will appear that a patentee may be allowed to amend after judgment. If after amendment any portion of the specification which the Court held to be bad is not removed either by excision or alteration in meaning consequent on some amendment made, the judgment would of course act as an estoppel against the patentee as being *res judicata* in any subsequent proceedings against the same defendant.(*a*)

also after a conditional order for revocation.

Amendment after Order for Revocation.—As already demonstrated, so long as certain defects remain in the specification the patent is invalid.(*b*) In the event of a petition for revocation being presented to the Court, the Court is bound on proof of the existence of any one fatal defect in the specification, however meritorious the real invention may be, to hold that the patent is bad, and to make some order as to its revocation. It is only just that, if the removal by amendment of the defect in the specification on the strength of which the Court comes to a conclusion against the patent, would leave proper subject-matter, the patentee should have an opportunity of amending. Should the Court make an order for revocation without any condition it may be doubtful whether the Comptroller-General has, under any circumstances thereafter, juris-

(*x*) Bray *v.* Gardner, (1887) 4 R. P. C. 41, 42.
(*y*) Dudgeon *v.* Thompson, (1877) L. R. 3 App. Cas. 34.
(*z*) Andrew *v.* Crossley, (1892) 9 R. P. C. 165.
(*a*) See p. 523 *post*.
(*b*) Chap. V. *ante*.

diction to allow any amendment to be made, seeing that it may well be that the order for revocation operates as an immediate revocation, and so there is no patent in existence for the Comptroller to deal with.(*c*)

Practice when no Action or Petition is pending.

In a case where the Court of first instance had made an order for the unconditional revocation of a patent, and the House of Lords held that the patent was bad on certain grounds, but not on all the grounds alleged by the petitioner, and directed a postponement for the purpose of giving the patentee an opportunity of applying at the Patent Office for leave to amend and so remove the invalid claims, the Comptroller-General, acting on the advice of the law officer, refused leave on the ground that the patent having been revoked by the order of the Judge of first instance, there was no patent existing for him to deal with. The matter being again mentioned to the House of Lords, their Lordships did not decide the point as to the jurisdiction of the Comptroller under the above circumstances, but did justice by, instead of simply affirming the order of the Judge of first instance, making an order (which was of course *nunc pro tunc*) "that the patent be revoked, unless within three months or such further time as the Court may allow the patentee obtain leave to amend his specification," &c.(*d*)

When the Judge of first instance finds all the claims bad, it is submitted he can only make an unconditional order for revocation; but when he finds that one or more of the claims are good and others bad, the proper order to make is that above referred to and adopted by the House of Lords in *Deeley* v. *Perks*.(*e*)

Part II.—Practice.

No Action for Infringement or Petition for Revocation pending.—When there is no pending action for infringement or petition for revocation the procedure for amendment and the kind of amendments allowable are regulated by s. 18 of the Act of 1883,(*f*) as amended by the Act of 1888,(*g*) and by the Patents Rules 1890, rr. 52 to 59.(*h*)

S. 18 of Act of 1883, as amended by Act of 1888, applies when there is no pending action for infringement or petition for revocation.

S. 18 of the Act of 1883, as amended by the Act of 1888, is as follows:—

(*c*) See Deeley *v.* Perks, (1896) 13 R. P. C. 589–590.
(*d*) Deeley *v.* Perks (1896) 13 R. P. C. 581.
(*e*) (1896) 13 R. P. C. 590.
(*f*) 46 & 47 Vict. c. 57, s. 18.
(*g*) 51 & 52 Vict. c. 50, s. 5.
(*h*) p. 721 *post*.

Practice when no Action or Petition is pending.

S. 18 of Act of 1883 as amended by Act of 1888.

"1. An applicant or a patentee may from time to time, by request in writing left at the Patent Office, seek leave to amend his specification, including drawings forming part thereof, by way of disclaimer, correction, or explanation, stating the nature of such amendment and his reasons for the same.

"2. The request and the nature of such proposed amendment shall be advertised in the prescribed manner, and at any time within one month from its first advertisement any person may give notice at the Patent Office of opposition to the amendment.

"3. When 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. When no notice of opposition is given, or the person so giving notice does not appear, the Comptroller shall determine whether, and subject to what conditions, if any, the amendment ought to be allowed.

"6. When leave to amend is refused by the Comptroller, the person making the request may appeal from his decision to the law officer.

"7. The law officer shall, if required, hear the person making the request, and the Comptroller, and may make an order determining whether, and subject to what conditions, if any, the amendment ought to be allowed.

"8. No amendment shall be allowed that would make the specification, as amended, claim an invention substantially larger than, or substantially different from, the invention claimed by the specification as it stood before amendment.

"9. Leave to amend shall be conclusive as to the right of the party to make the amendment allowed, except in case of fraud; and the amendment shall, in all Courts and for all purposes, be deemed to form part of the specification.

"10. The foregoing provisions of this section do not apply when, and so long as, any action for the infringement or proceeding for the revocation of a patent is pending."

Applicant's right to be heard.

The Comptroller *cannot exercise any discretionary* power adversely to an applicant for leave to amend a specification without (if so required within the prescribed time) giving the applicant an opportunity of being heard personally or by his agent.(*i*)

(*i*) 46 & 47 Vict. c. 57, s. 94; P. R. (1890) rr. 11–14.

Practice when no Action or Petition is pending.

Under the old law it was competent for the grantee of a patent to enter a disclaimer, even though he had partially(*k*) or wholly(*l*) parted with his interest; but this is not so now, as, according to the provisions of the Act of 1883,(*m*) only an applicant or a patentee is entitled to apply for leave to amend, and the term "patentee" is expressly defined as meaning the person for the time being entitled to the benefit of the patent.(*n*) An assignee of a patent is consequently entitled to apply for leave to amend the specification, as he was before the Act of 1883. It would appear that in the case of co-owners, whether as original grantees or as assignees, they should all join as petitioners on an application to amend; though the petition would not be refused in the absence of co-owners not on the register.

Who may be an applicant.

Mortgagee need not be a party.

It is submitted that a mortgagee need not be made a party to an application by the beneficial owner of a patent for leave to apply to amend the specification, and that he could not make the application himself without the beneficial owner being a party.(*o*)

Signature and advertisement of request.

The request for leave to amend must be signed by the applicant or patentee and must be accompanied by a duly certified printed copy of the original specification and drawings, showing in red ink the proposed amendment.(*p*) The request, which states the nature of the desired amendment and the applicant's reasons for making the same,(*q*) is then advertised in the official journal of the Patent Office, and in such other manner (if any) as the Comptroller may in each case direct.(*r*) Advertisements are necessary, through the specification has not been published, if the procedure of s. 18 applies, and the fact that no advertisements have taken place may be raised as an objection to any amendment being allowed. But when the amendment is once allowed it cannot be objected against it that the advertisements were not duly made, and so it was *ultra vires*.(*s*)

Any one may oppose.

It is open to any person at any time within one month from the first advertisement of the request for and the nature of the proposed amendment to give notice at the Patent Office of opposition to the amendment.(*t*)

(*k*) Spilsbury *v.* Clough, (1842) 1 W. P. C. 255.

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

(*m*) s. 18, sub-s. 1.

(*n*) s. 46.

(*o*) Van Gelder Co. *v.* Sowerby Co., (1889) 7 R. P. C. 208.

(*p*) Patents Rules, (1890) r. 52; p. 721 *post*.

(*q*) 46 & 47 Vict. c. 57, s. 18, sub-s. 1.

(*r*) Patent Rules, (1890) r. 52; p. 721 *post*.

(*s*) Farbenfabrikens, vorms. F. Bayer, (1891) 8 R. P. C. 396; see p. 257 *ante*.

(*t*) 46 & 47 Vict. c. 57, s. 18, sub-s. 2.

Practice when no Action or Petition is pending.

Notice of opposition.

The notice of opposition must state the ground or grounds on which the opponent intends to oppose the amendment and must be signed by him. Such notice must state the opponent's address for service in the United Kingdom and be accompanied by an unstamped copy.(*u*) The notice must be upon Form G (*x*), and the stamp charge is 10s.(*y*) The unstamped copy is forthwith forwarded by the Comptroller to the applicant.(*z*)

Evidence.

Within fourteen 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 them he must deliver to the applicant a list thereof.(*a*) The provisions of Rules 38 to 44 of the Patent Rules 1890 (*b*) then apply to the applicant's evidence, the evidence in reply, the closing of the evidence, the notice of hearing, the disallowance of opposition upon grounds not stated in the notice and the notification of the Comptroller's decision.

Hearing by the Comptroller.

The Comptroller, upon the date fixed in the notice of hearing, hears and decides the case, subject to an appeal to the law officer.(*c*)

Appeal to the law officer.

The practice upon appeal to the law officer as regards notices, evidence, cross-examination of witnesses, hearing, &c., is regulated by the Law Officers' Rules.(*d*) Though the respondent is entitled to service of the notice of appeal, yet if he appears without having received the notice the law officer will not refuse to hear the case.(*e*)

If the Comptroller decides against an applicant or patentee applying for leave to amend his specification, the applicant or patentee must not delay exercising his right of appeal and must file the fourteen days' notice required by the Law Officer's Rules,(*f*) or the appeal may not be heard, on the ground that it is too late.

Thus in *Arnold's Application*,(*g*) the Comptroller decided against the applicant, who two years afterwards applied again, and then appealed to the law officer. The Attorney-General said that he thought he should have allowed the proposed amendment, but the affidavit of the applicant, to the effect that he was ignorant of the patent law and that he could have

(*u*) Patent Rules, (1890) r. 53; p. 721.
(*x*) p. 755 *post*. (*y*) p. 839 *post*.
(*z*) Patent Rules, (1890) r. 54.
(*a*) Patent Rules, (1890) r. 55.
(*b*) p. 719 *post*; see Patent Rules. (1890) r. 56, p. 722 *post*.
(*c*) 46 & 47 Vict. c. 57, s. 18, sub-s. 3.
(*d*) p. 726 *post*.
(*e*) See Rylands' Patent, (1888) 5, R. P. C. 668.
(*f*) L. O. Rules, r. 1.
(*g*) (1882) Griff. L. O. C. 5.

appealed against the former decision of the Comptroller, did not satisfy him that any sufficient reason existed why proceedings were not taken to question the previous decision of the Comptroller, and he refused to allow the appeal.

Practice when no Action or Petition is pending.

Sub-s. 3 of s. 18 of the Act of 1883, which regulates the practice before the Comptroller on an application for leave to apply to amend, does not appear to give the applicant any right to object to the opposer as being a person not entitled to be heard in opposition, whereas sub-s. 4, which relates to an appeal to the law officer, provides that he (the law officer) shall hear the applicant and the opposer, who is, "in the opinion of the law officer, entitled to be heard in opposition," thus giving the applicant the right to object to the opposer as a person not entitled to be heard.

Right to question *locus standi* of opponent before the law officer.

In *Bell's Case*,(*h*) however, the Comptroller refused to listen to the objection that a proposed amendment would make *Bell's* specification claim the same invention as that described in two prior specifications, on the ground that the opponents were not the owners of the prior patents, and therefore, being mere members of the public, the objection was not one which it was competent for them to set up. On appeal, the Solicitor-General supported the decision of the Comptroller, and held that the opponents were not in the position of persons entitled to be heard with regard to the prior patents; (*i*) but this case cannot be regarded as an authority for the statement that the *locus standi* of an opponent may be questioned before the Comptroller.

A prior patentee is a person entitled to oppose an application for leave to apply to amend the specification of a subsequent patent on the ground that the amendment, if allowed, would prejudice the patentee's rights under the prior patent.(*j*)

Decision of Comptroller when there is no opposition.

When there is no notice of opposition, or the opponent does not appear, the Comptroller determines whether, and subject to what conditions,(*k*) if any, the amendment ought to be allowed. If leave to amend is refused by the Comptroller the applicant may appeal to the law officer, who must, if required, hear the applicant and the Comptroller, and may make an order determining whether, and subject to what conditions, if any, the

(*h*) (1887) Griff. L. O. C. 10.

(*i*) See also Glossop, (1884) Griff. P. C. 285; Heath and Frost, (1886) Griff. P. C. 288; Hookham's Patent, (1886) Griff. L. O. C. 32; Macevoy's Patent, (1888) 5 R. P. C. 285; Stuart's Patent, (1896) 13 R. P. C. 627,

(*j*) Hampton *v.* Facer, (1885) Griff. L. O. C. 15.

(*k*) pp. 271–274 *ante*.

Practice when no Action or Petition is pending.

amendment ought to be allowed; (*l*) and the decision of the law officer is final.(*m*)

When leave to amend is given, the applicant must, 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, and prepared in accordance with the prescribed rules.(*n*) Every amendment of a specification is forthwith advertised by the Comptroller in the official journal of the Patent Office, and in such manner, if any, as the Comptroller may direct.(*o*)

Leave to amend is conclusive of right to amend.

Leave to amend is conclusive of the applicant's or patentee's right to make the amendment, except in the case of fraud,(*p*) *e.g.*, where a disclaimer was filed without the consent of the patentee.(*q*)

Costs.

The Comptroller has no power over the costs of an application either directly, or indirectly by making the payment of costs a condition of the amendment; (*r*) but, on appeal, the law officer may order costs to be paid by either party, and any such order may be made a rule of Court.(*s*) Where the law officer orders that costs shall be paid by any party, he has power to fix the amount of such costs, and, if he does not fix the amount thereof, he must direct by whom and in what manner the amount of such costs shall be ascertained.(*t*)

As a general rule, costs of an appeal to the law officer are given against the unsuccessful party, but, in the case of a second amendment, costs will most probably not be given against the opponents, on the ground that second amendments are not to be encouraged if they can possibly be avoided.(*u*)

Where an applicant appeals from the decision of the Comptroller, on an unopposed application, and the Comptroller is represented at the hearing, the Comptroller does not, except in very special circumstances, either give or receive costs.(*x*)

In cases where leave is given to apply to amend a specification pending an action for infringement, or proceeding for the revocation of a patent, the Court or a Judge does not as a rule order

(*l*) 46 & 47 Vict. 57, s. 18, sub-s. 5, 6, and 7.
(*m*) See pp. 259, 260 *ante*.
(*n*) P. R. (1890) r. 57; p. 722 *post*.
(*o*) *Ibid.*
(*p*) 46 & 47 Vict. c. 57, s. 18, sub-s. 9.
(*q*) *Re* Berdan's Patent, (1875) L. R. 20 Eq. 346.
(*r*) Pietschmann's Patent, (1884) Griff. P. C. 314; Codd's Patent, (1884) Griff. P. C. 305.
(*s*) 46 & 47 Vict. c. 57, s. 38.
(*t*) L. O. Rules, r. xi.; Ashworth's, (1878) Griff. L. O. C. 9; Bell's, (1885) Griff. L. O. C. 11.
(*u*) See Haddan, (1885) Griff. L. O. C. 12.
(*x*) Lake, (1887) Griff. L. O. C. 16.

the applicant to pay to the defendant, or petitioner, his costs of appearing to oppose the application on the hearing before the Comptroller.(*y*)

Practice pending Action or Petition.

When, however, a plaintiff's application was refused by the Comptroller on the ground that an action was pending and the leave of the Court or Judge had not been obtained, on an application to the Court for leave to apply again to the Comptroller, the Judge made it a condition that the plaintiffs should pay the costs of the first application.(*z*)

Where, in an action for infringement, the plaintiff obtained the leave of the Judge to apply at the Patent Office for leave to amend, and did so, but subsequently abandoned the action, and then applied, under s. 18 of the Act of 1883, to make a different amendment, the Comptroller and the law officer both refused to make it a condition of allowing the amendment that the applicant should pay the costs of the opponents (who were the defendants in the action) incurred in respect of the opposition to the abandoned application.(*a*)

In *Morgan's Application* (*b*) the Comptroller refused to allow an amendment, on the ground that he thought it would enlarge the scope of the invention; but the law officer, on appeal, allowed the amendment, being of opinion that the provisional specification was comprehensive enough to cover the claim to the thing shown in a certain drawing and indicated by the corrected description.

In this case an application was made for a return of the stamp on the notice of appeal, but the law officer refused the application, on the ground that there was sufficient difficulty to justify the Comptroller in declining to allow the amendment, and leaving it to the law officer.

When leave to amend had been obtained, but the amended specification was found defective and the patent revoked on petition on subsequent notice, costs of the motion for leave to amend were not given to either side, though on the one hand the application to amend had succeeded in procuring the amendment, and on the other hand the amendment had failed to render the patent valid.(*c*)

S. 19 of Act of 1883 applies when there is a pending action for infringement or petition for revocation.

Amendment pending Action for Infringement, or Petition for Revocation.—If a patentee is desirous of amending his specification during an action for infringement

(*y*) See Fusee Vesta Co. *v.* Rylands, (1889) 4 R. P. C. 71.

(*z*) Codd *v.* Bratby, (1884) 1 R. P. C. 209, 211.

(*a*) Bell, (1887) Griff. L. O. C. 10.

(*b*) (1886) Griff. L. O. C. 17.

(*c*) Perks *v.* Deeley, (1896) 14 R. P. C. 3.

Practice pending Action or Petition.

or proceeding for revocation of a patent, he cannot apply at the Patent Office for the necessary leave without first obtaining the permission of the Court or a Judge to do so, and the authority of the Court or Judge in such cases is limited to granting permission to apply at the Patent Office for leave to amend by disclaimer.(*d*)

Meaning of "pending action for infringement or petition for revocation."

The terms "action for infringement" and "proceeding for revocation" here mean an action for infringement and proceeding for revocation before judgment.(*e*)

In *Cropper* v. *Smith* (*f*) the plaintiffs obtained, at the trial, judgment against the defendants, which, however, the Court of Appeal reversed as against one of the defendants, *Hancock*. The plaintiffs thereupon applied to the Comptroller, under s. 18 of the Act of 1883, for leave to apply at the Patent Office to amend the specification by disclaimer, and the defendants opposed the application. The defendant *Hancock* subsequently appealed to the House of Lords, and the Comptroller, being doubtful whether the appeal was a pending action within s. 18, sub-s. 10, of the Act of 1883, refused to proceed with the application until the consent of the Court had been obtained. Accordingly the plaintiffs took out a summons under s. 19 of the Act of 1883 that they might be at liberty to apply at the Patent Office to disclaim. *Chitty*, J., held that an action for infringement pending means an action before judgment, and further that, final judgment having been given, there was in the present case no action for infringement pending; and the summons was consequently dismissed, but, under the circumstances, without costs.

S. 19 of Act of 1883.

S. 19 of the Act of 1883 (*g*) deals with the amendment of the specification during an action for infringement or proceeding for the revocation of a patent, and enacts as follows:—

> "In an action for the infringement of a patent, and in a proceeding for the 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."

(*d*) 51 & 52 Vict. c. 50, s. 5; 46 & 47 Vict. c. 57, s. 19.

(*e*) Cropper *v.* Smith, (1884) 1 R. P. C. 254; L. R. 28 Ch. D. 148; Lawrence *v.* Perry, (1885) 2 R. P. C. 179, 188; Haslam *v.* Hall, (1888) 5 R. P. C. 1, 24.

(*f*) (1884) 1 R. P. C. 254.

(*g*) 46 & 47 Vict. c. 57, s. 19.

Practice pending Action or Petition.

The above section confers power on the Vice-Chancellor of the County Palatine of Lancaster to grant leave to apply to amend a specification by way of disclaimer pending an action in his Honour's Court.(*h*)

But it would appear that, since "the Court" means "the High Court of Justice,"(*i*) the House of Lords has therefore no original jurisdiction under the section.(*k*)

Proceedings for amendment begun under s. 18, but not completed before commencement of action for infringement or petition for revocation.

When an amendment is actually made under the procedure referred to in s. 18 of the Act of 1883,(*l*) it cannot be objected to on the ground that before it was completed an action for infringement had been commenced.(*m*) But it would appear that, if proceedings for amendment are commenced under s. 18, and then, before the Comptroller's decision is obtained, an action for infringement or petition for revocation is commenced, the effect of sub-s. 10 of s. 18 of the Act of 1883 as amended by the Act of 1888 (*n*) is to suspend the proceedings for amendment upon the commencement of the action or presentation of the petition, and to render it necessary for the applicant to obtain the leave of the Court under s. 19 of the Act of 1883 to proceed with the amendment. The Court has a discretion in such a situation which it must exercise, having regard to the circumstances of each particular case.(*o*)

Leave may be obtained by summons or motion.

The leave of the Court or a Judge necessary under s. 19 may be obtained by summons in chambers,(*p*) or on motion in Court.

Advantages of amendments under s. 19.

As a rule, patentees who obtain the consent of the Court or a Judge, pending an action for infringement or proceeding for the revocation of a patent, are not allowed to use the amended specification in evidence in the action or petition as the case may be.(*q*) Nevertheless, the patentee may in such a case derive a great benefit from being allowed to make an amendment, for there may be other persons, not parties to the action or proceeding for revocation, who, relying on some defect in the specification, are continuing an infringement on the advice that the patent is bad; and it may be of great importance to the patentee to remedy the defect, and place himself in a position to sue other parties besides the defendants in the action or the petitioners in the proceeding for revocation.

To allow a plaintiff in an action for infringement or a re-

(*h*) Winter *v.* Baybut, (1884) 1 R. P. C. 76.
(*i*) s. 117.
(*k*) Cropper *v.* Smith, (1884) L. R. 28 Ch. D. 148, 152; 1 R. P. C. 90.
(*l*) p. 276 *ante*.
(*m*) Farbenfabriken, vorms. F. Bayer *v.* Bowker, (1891) 8 R. P. C. 389.
(*n*) p. 276 *ante*.
(*o*) See Deeley's Patent, (1894) 11 R. P. C. 72.
(*p*) Singer *v.* Stassen, (1884) 50 L. T. N. S. 326; 1 R. P. C. 121.
(*q*) But see *ante*.

Practice pending Action or Petition.

spondent in a proceeding for the revocation of a patent to use in evidence a specification amended pending such action or proceeding would be to give him, when he had originally come to the Court with a patent which could not be relied on, power to put himself in a different position as against the defendant or petitioner; and though the consequences of amendment may be that the plaintiff or respondent is entitled to maintain an action in respect of previous acts, which are infringements of the patent as amended, yet an absolute discretion is vested in the Court to impose, as a condition of leave being granted, that the amended specification shall not be given in evidence so as to enable a patentee to sue on a patent which, at the time when he commenced his action, he could not sue on at all.(*r*)

Court has an absolute discretion under s. 19.

The Court has a discretion, unfettered by authority, to grant or refuse leave to apply to amend by disclaimer pending an action for infringement or petition for the revocation of a patent, and to impose such terms and conditions as it may think the justice of each particular case requires,(*s*) and the Court of Appeal will not lightly interfere with the discretion of a judge of first instance.(*t*)

The result of the decisions appears to be that leave will only be given, under s. 19 of the Act of 1883, where the Court sees its way to make full compensation to those against whom the leave is asked, and that where such compensation can be given then the leave will be given.(*u*)

When several actions or petitions are pending leave is only necessary in one.

It is submitted that if there be more than one action for infringement or more than one petition for revocation of a patent, or an action for infringement and a petition for revocation pending, leave may be given, under s. 19 of the Act of 1883, in one such proceeding without application being made in any other proceedings; (*x*) though no doubt the parties to the other proceedings would be protected by the terms imposed by the Court, or by the Comptroller, when granting the leave to amend.

The former practice of the Patent Office in cases where there was more than one action for infringement or petition for revocation, or an action for infringement and petition for

(*r*) See remarks of Cotton, L.J., Bray *v.* Gardner, (1887) 4 R. P. C. 43.

(*s*) Allen *v.* Doulton, (1887) 4 R. P. C. 377; Lang *v.* Whitecross Co., (1889) 6 R. P. C. 570.

(*t*) Armstrong's Patent, (1897) 14 R. P. C. 747.

(*u*) Per Kekewich, J., In the Matter of Gaulard and Gibbs' Patent, (1888) 4 R. P. C. 191; Bray *v.* Gardner, (1888) 5 R. P. C. 40; Gaulard *v.* Lindsay, (1888) 5 R. P. C. 192.

(*x*) See In the Matter of Hall and others, (1888) 5 R. P. C. 306, 310; L. R. 21 Q. B. D. 137; but see Gaulard *v.* Lindsay, (1888) 5 R. P. C. 192, 196.

Practice pending Action or Petition.

revocation, pending, was to refuse to allow an application for leave to amend, unless the leave of the Court or a Judge was obtained in all the different pending proceedings ; (*y*) but, it is submitted, the Comptroller would not now refuse to entertain an application made in respect of the leave of the Court, or a Judge, obtained in one only of such proceedings.(*z*)

Terms usually imposed by the Court.

The Court or a Judge exercising the power of imposing terms (*a*) when granting leave to apply at the Patent Office for leave to amend, pending an action for infringement or petition for the revocation of a patent, usually imposes the terms laid down in the case of *Bray* v. *Gardner*.(*b*) These terms are that the amended specification shall not be given in evidence at the hearing of the action or petition,(*c*) and that the costs of, and occasioned by, the plaintiff's or respondent's application, as the case may be, shall be the defendant's or petitioner's in any event ; though the terms to be imposed are entirely in the discretion of the Court, and no rule can be given applicable to every case.

In *Winter* v. *Baybut*, (1884) 1 R. P. C. 76, a case tried in the Court of the County Palatine of Lancaster, the Vice-Chancellor only imposed the terms that the plaintiffs should pay the defendant's taxed costs of the motion and of the action up to, and inclusive of, the hearing of the motion ; and that proceedings in the action should be stayed pending the application to the Patent Office.

In *Singer* v. *Stassen*, (1884) 1 R. P. C. 121, the Court of Appeal held that s. 19 of the Act of 1883 applied in the case of an action commenced before the Act came into operation, and gave liberty to apply to amend the plaintiff's specification upon the terms that the costs of, and occasioned by, the amendment should be the defendant's in any event ; and that the specification, as amended, should not be receivable in evidence in the action ; and that the costs of the appeal should be costs in the action, as there had been a substantial failure and a substantial success by both parties.

In *Codd* v. *Bratby*, (1884) 1 R. P. C. 209, *Chitty*, J., granted leave to apply under s. 19 of the Act of 1883, on the terms that the specification, when amended, should not be given in evidence at the trial of the action, and that no evidence should be

(*y*) Codd's Patent, (1884) Griff. P. C. 385 ; Gaulard and Gibbs, (1888) 5 R. P. C. 192, 196.

(*z*) In the Matter of Hall and others, (1888) 5 R. P. C. 307 ; L. R. 21 Q. B. D. 137.

(*a*) 46 & 47 Vict. c. 57, s. 19.

(*b*) (1887) 4 R. P. C. 40 ; Lang *v.* Whitecross Co., (1889) 6 R. P. C. 570.

(*c*) But see p. 273 *ante*.

Practice pending Action or Petition.

Terms usually imposed by the Court.

given of any infringement prior to the date of the filing of the amended specification; and that the costs of the motion, and of the previous application to the Comptroller, thrown away by reason of the amendment, be paid by the plaintiff.

In *Fusee Vesta Co. v. Bryant & May*, (1887) 4 R. C. P. 71 *Kay*, J., granted the plaintiffs leave to apply to amend before they had delivered their statement of claim, upon the terms that they paid all costs, in any event, of the defendants of the action up to and including the application consequent on the amendment of the specification; that no further proceedings should be taken till the disclaimer had been properly made; that the plaintiffs should undertake, forthwith, to take proceedings for disclaimer, and then to amend the action by stating the disclaimer pending the action on the specification as amended; failing this, the action to be dismissed.

In *Allen* v. *Doulton*, (1887) 4 R. P. C. 377, *Huddleston*, B., held, on the authority of *Bray* v. *Gardner*, that leave to apply to amend should be given to the plaintiffs only on condition that the specification, as amended, should not be receivable in evidence in the action. Upon appeal to the Divisional Court the learned Judges were divided in opinion, and upon appeal to the Court of Appeal it was held that ss. 18 and 19 of the Patents, &c., Act of 1883 give a discretion to the Court or a Judge, to be exercised on the circumstances of each particular case, and which is not fettered by authority; and that, although there had been no exercise of discretion by the Judges below, yet, having regard to the nature of the proposed amendment, the Court, in the exercise of their discretion, would not interfere with the order.

In the Matter of Gaulard and Gibbs' Patent, (1888) 5 R. P. C. 189) was a petition for the revocation of *Gaulard and Gibbs'* patent for a system of distribution of electricity. *Kekewich*, J., granted the respondents leave to apply at the Patent Office to amend, on condition that they paid the petitioner's costs up to date; and that they applied at the Patent Office forthwith, and prosecuted their application with due diligence. His Lordship also gave the petitioner leave, within fourteen days after the amendment, or after it should be ascertained that no amendment would be made, to discontinue by notice, or, if he did not do that, to have fourteen days to amend the petition and the particulars of objection.

In *Haslam Foundry and Engineering Co.* v. *Goodfellow*, (1888) 5 R. P. C. 28, *Kay*, J., granted leave under s. 19 of the Patents, &c., Act of 1883, on the following terms: The plaintiffs to pay the costs of the application and the costs of, and occasioned by, the disclaimer; the plaintiffs and defendants to be allowed to make all necessary amendments in their pleadings after dis-

claimer; the plaintiffs to undertake, forthwith, to amend the pleadings, confining their action to the specification as amended by the disclaimer, or to consent to the action being dismissed with costs.

Practice pending Action or Petition.

In *Gaulard* v. *Lindsay*, (1888) 5 R. P. C. 192, which was an action for infringement of five patents, a petition for the revocation of one of such patents having been previously presented, and leave to apply for liberty to disclaim having been granted in the petition, *Kekewich*, J., refused to grant similar leave in the action, but subsequently it was granted by consent by the Court of Appeal. The patentees were allowed to give the amended specification in evidence, but the terms imposed were that the plaintiffs should consent to pay all costs of the action up to the application, and waive all claim to relief in respect of any infringement before the date of disclaimer; and that they should pay the costs of the application, but not on the higher scale.

Terms usually imposed by the Court.

In *Lang* v. *Whitecross Co.*, (1889) 6 R. P. C. 570, *Wills*, J., gave the plaintiffs leave to apply at the Patent Office for liberty to amend their specification by way of disclaimer. The Judge also gave the plaintiffs leave to use the amended specification as evidence, on condition that no damages should be recovered, or claim for an injunction founded, on anything done before disclaimer, and that the costs of the action up to the time (if disclaimer used) be the defendants' costs in the cause. The Judge further ordered that the costs of the application and the costs caused in the action by the disclaimer should be the defendants' in any event, and that proceedings should be stayed pending the disclaimer. The plaintiffs appealed from this order, and contended that the conditions imposed would prevent them from deriving any advantage from continuing the present action, and that the condition as to damages was not within the jurisdiction of the Judge at Chambers, but the Divisional Court and the Court of Appeal held that the Judge had absolute discretion, under s. 19 of the Act of 1883, to impose terms, and that the order ought not to be interfered with.

Recent decisions have not limited the discretion of the Court.

It would appear that neither of the House of Lords decisions in the recent cases of *Moser* v. *Marsden*,(*d*) and *Deeley* v. *Perks*,(*e*) have in any way limited the discretion of the Court in giving or refusing leave to apply for amendment.(*f*) Seeing that the Court has no jurisdiction as to the making of the amendment, when it has no means of saying whether the amendment should be allowed it would not, it is submitted, as a rule be a proper

(*d*) (1895) 13 R. P. C. 24.
(*e*) (1896) 13 R. P. C. 581.
(*f*) See Dellwick's Patent, (1896) 13 R. P. C. 591.

Practice pending Action or Petition.

exercise of the discretion to refuse the leave and so force the plaintiff or respondent to go to trial on an unamended specification, if he is willing to accept the leave on such terms as may be necessary to protect his opponent's interests.(*g*)

It is submitted, however, that where there has been an adverse decision against the patent, including (*inter alia*) a claim which the patentee is desirous of leaving untouched, or only slightly modified, the Court will not, upon a subsequent action for infringement or petition for revocation, exercise its discretion in favour of the applicant, unless it is satisfied that the applicant has substantial grounds of objection to the adverse decision worthy of being submitted to a Court with power to review it.(*h*) In one case where there was a pending petition for revocation leave to apply at the Patent Office for amendment was refused, on the ground that the patent if amended as desired would be still anticipated by a prior specification pleaded in the particulars.(*i*)

Procedure after leave of the Court has been obtained under s. 19 is regulated by s. 18 of the Act of 1883.

When, in an action for infringement or petition for revocation of a patent, permission to apply at the Patent Office for leave to amend a specification has been given by the Court or a Judge, the procedure to be observed in order to obtain the leave desired is that under s. 18 of the Act of 1883,(*k*) and it does not follow, as a matter of course, that, because the Court or a Judge has given permission to apply, therefore, the Comptroller will grant the application.

When the Court does not impose terms relative to the action or petition the Comptroller or law officer does not do so.

Where, however, the Court or a Judge, in an action for infringement or petition for revocation of a patent, has granted leave to apply to the Comptroller for leave to apply at the Patent Office without imposing any terms, no terms will be imposed by the Comptroller or law officer relative to the action or petition, as the case may be.(*l*)

(*g*) See Dellwick's Patent, (1896) 13 R. P. C. 591.

(*h*) See Deeley's Patent, (1894) 11 R. P. C. 72; 12 R. P. C. 65, in which leave to apply was given, and after amendment the patent was declared void.

(*i*) Armstrong's Patent, (1896) 13 R. P. C. 501; 14 R. P. C. 747.

(*k*) In the Matter of Hall, (1888) 5 R. P. C. 306.

(*l*) Hearson's Patent, (1884) 1 R. P. C. 213.

CHAPTER VII.

OBTAINING LETTERS PATENT FOR INVENTIONS.

Discretion of the Crown.

Crown exercises its discretion

No person can demand protection for an invention by letters patent as of right. The power of the Crown to grant letters patent is purely discretionary. It was exercised during, and most probably previous to, the reign of Edward III.,(*a*) and preserved by the Statute of Monopolies,(*b*) and is not suspended during the minority or other incapacity of the reigning Sovereign.(*c*)

through the medium of certain officers.

The Crown exercises its discretion in the matter of granting patents for inventions through the medium of certain officers referred to in the Patents Designs and Trade Marks Act, 1883—viz., the Comptroller-General of the Patent Office, and the Attorney-General, or the Solicitor-General.

The Crown can grant letters patent for an invention only to the true and first inventor or inventors, but the grant may be made to such true and first inventor or inventors alone, or jointly with any other person or persons.(*d*)

Grant is made at the patentee's peril.

Every grant of letters patent is made at the grantee's peril, and on condition that it is valid only if one or more of the grantees is or are in fact the true and first inventor or inventors, the invention is new and useful, and the specifications are sufficient to fulfil the requirements of the law; moreover, the Crown in no way whatever guarantees the validity of any letters patent if the representations and conditions on the strength of which it is made are not rigidly correct and fulfilled.

Practice is regulated by Acts and rules made thereunder.

The practice, which it is necessary for any person desirous of obtaining a grant of letters patent to observe, is laid down, and regulated by the Act of 1883 together with the Amending

(*a*) Year Book, part iv., 40 Edw. III. fol. 17, 18; Darcy *v.* Allen, (1602) Moore's Reps. 675.

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

(*c*) Co. Lit. 43b; 5 Co. 27a; 7 Co. 12a.

(*d*) 21 Jac. I. c. 3, s. 6; 46 & 47 Vict. c. 57, s. 4; 48 & 49 Vict. c. 63, s. 5.

Patent Agents.

Acts of 1885, 1886, and 1888, and the rules and regulations from time to time made by the Board of Trade in pursuance of the powers conferred by that statute.(*e*)

Except as regards patents binding the Crown and compulsory licences, the Act of 1883 in all respects (including the amount and time of payment of fees) extends to all patents granted before the commencement of the Act, or on applications then pending, in substitution for such enactments as would have applied thereto if the Act had not been passed; and all instruments relating to patents granted before the commencement of the Act required to be left or filed in the Great Seal Patent Office are deemed to be so left or filed if left or filed before or after the commencement of the Act in the Patent Office.(*f*)

Patent Agents.

It is the usual practice for a would-be patentee to engage the services of a patent agent of experience and skill to aid him in filling up the many necessary forms, drafting the specifications and attending the hearing of oppositions, if any, to the grant of the patent.

The form of application must be signed by the applicant himself, 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.(*g*)

Qualifications of patent agents.

With a view to avoid the abuse of ill-qualified persons practising as patent agents, Parliament, by the Patents Designs and Trade Marks Act, 1888, provided that, if after the passing of that Act any person describe himself as a patent agent, either 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 the Act,(*h*) he is liable on summary conviction to a fine not exceeding twenty pounds. But any person who proves to the satisfaction of the Board of Trade that he had been practising *bonâ fide* as a patent agent prior to December 24, 1888, is entitled as of right to be registered.(*i*)

(*e*) 46 & 47 Vict. c. 57, s. 101.
(*f*) 46 & 47 Vict. c. 57, s. 45.
(*g*) P. R. (1890) r. 8.
(*h*) 51 & 52 Vict. c. 50, s. 1.
(*i*) *Ibid.* sub-s. 3.

Application.

It is also provided by the Act of 1888 that persons seeking to be registered as patent agents must satisfy various examinational tests, both theoretical and practical, before they are entitled to be placed on the register.

Register of Patent Agents.

Correct copies of the Register of Patent Agents are published annually, and may be obtained at the Patent Office, or any of the depôts where its publications are kept on sale, for the sum of one shilling. In this list will be found the names and business addresses of all the registered members of the Institute of Patent Agents for the time being.

Registor of Patent Agents' Rules.

The Act further provides (*k*) that the Board of Trade shall have power from time to time to make such general rules as are in the opinion of the Board required for giving effect to the provisions of the Act, and that the provisions of s. 101 of the Act of 1883 (*l*) shall apply to all rules so made as if they were made in pursuance of that section. The Register of Patent Agents' Rules for the time being in force will be found in the Appendix.(*m*) The rules so made by the Board of Trade are submitted to Parliament, and, if not annulled by either House within forty days after they are laid on the table, they acquire the force of an Act of Parliament, and the Courts will not entertain the question of any rules made with the prescribed formalities being *ultra vires*.(*n*) In case of the infraction of any rule for which a penalty is imposed—*e.g.*, practising as a patent agent without registration—the proper course is for the Institute of Patent Agents to prosecute for the penalty, and it is incompetent for the Institute or any other person aggrieved to proceed by way of action for injunction in the Supreme Court.(*o*)

Any one may act as an ordinary agent.

A person is entitled to act on behalf of another, in the matter of obtaining a patent, as an ordinary agent, and may so describe himself on every document without fear of prosecution. He is not entitled to describe himself as a "patent agent."(*p*)

Application.

Any person may make an application.

Any person, whether a British subject or not, is entitled to make an application for a patent, and two or more persons may

(*k*) s. 1, sub-s. 2; p. 684 *post*.
(*l*) 46 & 47 Vict. c. 57, s. 101; p. 671 *post*.
(*m*) p. 735 *post*.
(*n*) Chartered Institute of Patent Agents *v.* Lockwood, (1893) 10 R. P. C. 167; 11 R. P. C. 374.
(*o*) *Ibid.*
(*p*) Graham *v.* Fanta, (1872) 9 R. P. C. 164.

Application.

make a joint application, and a patent may be granted to them jointly.(*q*)

How the application must be made.

The application must be made on one of the forms set forth in the first schedule to the Act of 1883, or in such other form as may be from time to time prescribed.(*r*)

If an invention is partly original and partly communicated from abroad, it is doubtful whether it is incumbent on the applicant to distinguish which is which ;(*s*) and it is an undecided point whether or not the omission to do so would render the patent void.(*t*)

Form A is not applicable to the case of a corporation, but is intended for personal applicants who are true and first inventors. Form A 1 is intended for use where there has been a communication from abroad, whether the communicator is a corporation or a private individual.(*u*)

Application must be left at or sent by post to the Patent Office,

The applicant having filled up the form of application, which must be signed by himself, must leave it at, or send it by post to, the Patent Office. If sent by post as a prepaid letter it will be deemed to have been left at the Patent Office at the time when the letter containing the same would be delivered in the ordinary course of post, and, in case it becomes necessary to prove such sending, it will be sufficient to prove that the application was properly addressed and posted.(*x*)

and must contain a declaration, and be accompanied by a specification.

The application must contain a declaration, which may be either a statutory declaration under the Statutory Declarations Act, 1835, or not, as may be from time to time prescribed,(*y*) to the effect that the applicant is in possession of an invention whereof he claims, 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 a complete specification.(*z*)

Where the provisional specification is accepted it cannot be impeached as being too general.(*a*)

(*q*) 46 & 47 Vict. c. 57, s. 4 ; 48 & 49 Vict. c. 63, s. 5.

(*r*) 46 & 47 Vict. c. 57, s. 5, sub-s. 1. The forms at present in use for this purpose will be found in the second schedule to the Patent Rules (1890) ; see Appendix.

(*s*) Renard *v.* Levinstein, (1864) 10 L. T. N. S. 177.

(*t*) *Re* Avery's Patent, (1887) L. R. 36 Ch. D. 307 ; Moser *v.* Marsden, (1893) 10 R. P. C. 209, 350.

(*u*) Société Anonyme du Générateur du Temple's Patent, (1896) 13 R. P. C. 54.

(*x*) 46 & 47 Vict. c. 57, s. 5, sub-s. 1 ; s. 97 ; P. R. (1890) r. 16a.

(*y*) 48 & 49 Vict. c. 63, s. 2.

(*z*) 46 & 47 Vict. c. 57, s. 5, sub-s. 2. As to size of paper drawings, &c., see P. R. (1890) rr. 10, 30–33 ; see Appendix.

(*a*) Penn *v.* Bibby, (1866) L. R. 2 Ch. App. 127.

Application.

The form of declaration at present in use(*b*) is not a declaration, under the Statutory Declarations Act, 1835.

Statutory declarations for use in the Patent Office are to be made and subscribed in a certain manner.

Statutory declarations required for use in the Patent Office are to be made and subscribed as follows (*c*):—

(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.

If any person is, by reason of infancy, lunacy, or other inability, incapable of making any declaration, or doing anything required or permitted by the Act of 1883, or by any rules made thereunder, then the guardian or committee (if any) of such incapable person, or, if there be none, any person appointed by the 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 are, for the purposes of the Act, as effectual as if done by the person for whom he is substituted.(*d*)

and are exempt from duty under Stamp Act, 1870.

A statutory declaration, made under the provisions of the Statutory Declarations Act, 1835, and forming part of an application for a patent, in conformity with the Patents, Designs, and Trade Marks Act, 1883, is exempt from the stamp duty charged on a statutory declaration, under the provisions of the Stamp Act, 1870.(*e*)

Application should comprise only one invention.

An application for a patent should comprise only one invention. It is provided by the Act of 1883(*f*) that every patent shall be granted for one invention; though, if a patent should, by

(*b*) See Appendix.
(*c*) P. R. (1890) r. 17; see Appendix.
(*d*) 46 & 47 Vict. c. 57, s. 99.
(*e*) 47 & 48 Vict. c. 62, s. 9.
(*f*) s. 33.

Examination and Acceptance.

inadvertence, be made to include several inventions, it is not competent for any person, in an action, or other proceeding, to take any objection on the ground that it comprises more than one invention.(*g*)

Every application is referred to an examiner appointed under the Act of 1883 to discharge certain duties.

Examination and Acceptance.—Every application for a patent is referred by the Comptroller-General to an examiner appointed under the Act of 1883,(*h*) whose duty it is to ascertain 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 whether the title sufficiently indicates the nature of the invention.(*i*) It is also the examiner's duty to report whether the invention is contrary to law and morality,(*k*) and whether the application comprises more than one invention.(*l*) 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, or that the invention is contrary to law and morality, or that the application comprises more than one invention, the Comptroller may, subject to appeal to the law officer, refuse to accept the application, or require that the specification or drawings be amended before he proceeds further; and in the latter case the application must, if the Comptroller so directs, bear date as from the time when the requirement is complied with.(*m*)

Comptroller acts on the report of the examiner.

It is not the duty of the examiner to make any search with the object of ascertaining whether there are existing complete specifications which would render the patent void for want of novelty. This consideration does not influence the Patent Office officials, and the patent is granted at the applicant's peril. It might be of real benefit to inventors, and the public, if the law were altered so as to allow of an official search being made and to give the Comptroller power, as in the case of trade marks, to refuse—subject, of course, to appeal—a patent on the express ground of lack of novelty and invention, having regard to subsequent specifications. This would in many instances save much expense to persons wrongly supposing themselves to be first and true inventors.

Right of appeal

The Comptroller is not entitled to exercise any discretionary

(*g*) 46 & 47 Vict. c. 57, s. 33.
(*h*) 46 & 47 Vict. c. 57, s. 83.
(*i*) 46 & 47 Vict. c. 57, s. 6. See chap. v.
(*k*) 46 & 47 Vict. c. 57, s. 86.
(*l*) 46 & 47 Vict. c. 57, s. 33.
(*m*) 51 & 52 Vict. c. 50, s. 2.

power adversely to an applicant without (if so required within the prescribed time by the applicant) giving the applicant an opportunity of being heard personally or by his agent.(*n*)

Examination and Acceptance.

In any case where a person, having the right, intends to appeal to the law officer from a decision of the Comptroller, he must, within fourteen days from the date of the decision appealed against, file in the Patent Office a notice of such intention, stating the nature of the decision appealed against, and whether the appeal is from the whole or part only, and if so what part, of the decision, and he must otherwise conform to the Law Officer's Rules.(*o*) In all cases of appeal to the law officer it is desirable that a statement of fees paid be handed in to the law officer, so that he may have it before him when considering the question of costs.(*p*) Where the right of appeal to the law officer lies against a decision of the Comptroller, the *effect* of Nos. 1 and 2 of the Law Officer's Rules is to limit the hearing before the law officer to points specifically raised by the notice of appeal, and where a notice of appeal is given as to parts only of the Comptroller's decision, the person receiving such notice, if he desires to question other parts of the Comptroller's decision, must give a counter notice. If the original notice of appeal is only given just before the expiration of the fourteen days, the time for giving a counter notice may be extended under Rule 5.(*q*)

to the law officer from any decision of the Comptroller.

Costs.

The Act of 1883 gives the law officer control over the costs of the proceedings before him, but there is no such provision in the case of proceedings before the Comptroller.(*r*)

As a general rule the costs of an appeal to the law officer follow the event,(*s*) unless there has been unfair conduct;(*t*) and where an appeal is withdrawn the opponent pays the costs.(*u*)

Example of an objection to the title.

In *Brown's Application* (*x*) for a patent under the title "improvements in casks and tubs," accompanied by a complete specification in the first instance, which stated that the invention was applicable to barrels or other casks and also to tubs *and analogous vessels*, in which the staves are formed with a croze

(*n*) 46 & 47 Vict. c. 57. s. 94; see P. R. (1890), rr. 11–14.

(*o*) See Appendix.

(*p*) See remarks of Webster, A.G., In the Matter of Sielaff's Application, (1888) 5 R. P. C. 487.

(*q*) In the Matter of Bairstow's Patent, (1888) 5 R. P. C. 289.

(*r*) 46 & 47 Vict. c. 57. s. 38.

(*s*) Anderton, (1885) Griff. L. O. C. 25; *Ex parte* Fox, (1812) 1 V. & B. 67; 1 W. P. C. 431n.

(*t*) *Re* Lowe's Patent, (1856) 25 L. J. N. S. Ch. 456.

(*u*) Knight, (1886) Griff. L. O. C. 35; *Re* Cobley's Patent, (1861) 8 Jur. N. S. 106; *Re* Ashenhurst's Patent, (1853) 2 W. R. 3.

(*x*) (1887) Griff. L. O. C. 1.

Examination and Acceptance.

or groove for receiving the head or bottom, and the object of the invention was to secure the bottom or head against outward displacement, and also to support the staves beyond the croze against any force or blow delivered upon the exterior of the staves such as would tend to break off their ends projecting beyond the croze, the Comptroller refused to accept the specification unless the words "and analogous vessels" were added to the title or omitted from the specification, on the ground that the title did not, in view of the words "and analogous vessels" in the body of the specification, sufficiently indicate the subject-matter of the invention. The law officer on appeal, however, reversed the Comptroller's decision, being of opinion that the title, taken together with the claims, which were specific, was sufficient, and he also pointed out that the patentee is entitled to frame his title in his own way, provided he does not infringe the rules of the statute.

Application refused as comprising more than one invention may be amended by limitation to one invention.

If the Comptroller refuse to accept an application on the ground that it includes more than one invention, the person making it may amend it so as to apply to one invention only, and may make application for separate patents for each of such inventions accordingly, and every such application must bear the date of the first application and must be proceeded with as if it had been originally made on that date for one invention only.(*y*)

Test of one invention.

Lord *Herschell*, when Solicitor-General,(*z*) gave it as his opinion that the general object of the invention is the test by which the question of one invention must be decided, and in reference to a particular case said:—

> "If you have a particular general object of an invention to make rails rest more securely, and you describe one, or two, or three devices of an analogous nature, cognate devices, for carrying it into effect, I should say they were all one invention; but if there is no common purpose, so that you could say, 'I use this as a substitute for that,' both serving the same purpose, although there is some difference between them, but they are to serve some different purpose, there is no connection between them, except that both are used in connection with rails, and it strikes me that would be two inventions. I should always allow alternative devices for producing a particular object as one invention. But if you say, 'I have invented six different kinds of railway sleepers, each of which has its own merits and purposes and objects distinct,' then those are six inventions."

(*y*) P. R. (1890) r. 19.

(*z*) Jones's Patent, Griff. P. C. 265.

Examination and Acceptance.

The following two cases are given as illustrations of the circumstances in which an applicant is required to amend his application so as to limit it to one invention only.

Examples of cases in which amendment by limitation to one invention is required.

In *Hearson's Patent*, (1885) Griff. P. C. 266, an applicant applied for a patent, under the title "Improvements in apparatus for rapidly heating flowing water, *a part of which improvements is applicable to other purposes*," and after describing in his provisional specification an apparatus consisting of several parts, including improved mechanism, by which the turning of the taps of a geyser, otherwise than in the required order, was prevented, stated: "The arrangements hereinbefore described for locking the water and gas-cocks is applicable to oxyhydrogen light apparatus, and to other apparatus in which two cocks, or a number of cocks, are required to be turned in a certain order," he was ordered to amend his application by striking out from the title the words in italics. Both the Comptroller and the law officer were of opinion that the application, as it stood before amendment, included more than one invention, and the latter pointed out that the applicant was entitled, if he so desired, to make a separate contemporary application for his new and improved cock, or arrangement of cocks by itself, and that he might of course describe the cock, or arrangement of cocks, as part of his combination or apparatus which he claimed to have invented, but that he should in doing so refer to his contemporary application if he desired to make one.

In *Robinson's Patent*, Griff. P. C. 267, a person applied for a patent for an invention of "improvements in the art of producing and utilising induced electrical currents for telegraphy and other purposes," and it appeared that the invention consisted in the employment in telegraphic transmitting and receiving instruments of a certain appliance. The Comptroller objected to the title, stating that the appliance could be applied to purposes other than telegraphic, and required an amendment so as to limit the invention to such purposes, and held that, if the applicant desired to claim the general use of the appliance for the production of induced currents, it must form the subject of a separate patent.

On appeal, the law officer informed the applicant that if he intended to claim, as a combination, the whole of the apparatus as one telegraphic apparatus, then it might all be included in one specification; but if he was including, for all purposes, the invention of "the appliance," then it was something different, which could not be protected by the same patent. The law officer further stated that he would allow that, if the whole were limited to telegraphy, because that would make an

Statutory Offences.

improved telegraphic arrangement, and although consisting of several parts, he would allow it to be included in one patent; but if there were to be two separate things, which could only be allowed together because they went to make up one better kind of instrument or machine, then he would never allow the use of a part of that for a purpose independent of the main object of the machine.

It was therefore a question for the applicant whether it answered his purpose better to protect "the appliance" for all purposes, or to protect improved telegraphic apparatus, consisting of the employment of "the appliance" therein. The applicant elected to take a patent for the general use of "the appliance," and the law officer allowed the title to be amended to "improvements in the art of producing and utilising induced electrical currents," the description of the telegraphic apparatus being struck out of the provisional specification.

Separate patents granted to joint applicants who are inventors of distinct parts.

If an application be made by two or more joint applicants, and it appears that the invention consists of distinct parts, invented separately by the applicants respectively, it seems that separate patents will be granted to the actual inventors in respect of the separate and distinct parts.(*a*)

Notice of acceptance of application.

If the application is accepted the applicant will receive due notice to this effect,(*b*) and the invention may, during the period between the date of the application and the date of sealing the patent, be used and published without prejudice to the patent to be granted for the same;(*c*) though the applicant is not entitled to sue in respect of infringements of the invention committed before the acceptance and publication of the complete specification.(*d*)

Representation that an article is patented where no patent has been granted.

Statutory Offences.—S. 105 of the Act of 1883 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 for every offence, on summary conviction, to a fine not exceeding five pounds. The effect of s. 15 of the same Act, however, is to render it no offence to represent an article as "patented" when the complete specification has been accepted, though the patent has not been sealed.(*e*)

(*a*) See Craig and Macfarlane's Application, P. M. J. vol. iv. 3rd series, p. 366.
(*b*) 51 & 52 Vict. c. 50. s. 2 (4).
(*c*) 46 & 47 Vict. c. 57, s. 14; p. 138 *ante*.
(*d*) 46 & 47 Vict. c. 57, s. 13; p. 139 *ante*; chap. xiii. *post*.
(*e*) R. *v.* Townsend, (1896) 13 R. P. C. 265; In R. *v.* Wallis, (1886) 3 R. P. C. 1; and R. *v.* Crampton, (1886) 3 R. P. C. 367, fines were inflicted.

Filing Complete Specification.

It is not an offence under the Act of 1883 to represent an article as patented when the patent has expired.(*f*)

A person is deemed to represent that an article is patented if he sells the article with the word "patent," "patented," or any other word expressing or implying that a patent has been obtained for the article stamped, engraved, or impressed on, or otherwise applied to the article.(*g*)

Unauthorised use of the Royal Arms.

Any person who, without the authority of her Majesty, or any of the Royal Family, or of any Government department, assumes or uses in connection 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, is liable, on summary conviction, to a fine not exceeding twenty pounds.(*h*)

Penalties in Scotland.

In Scotland, any offence under the Act of 1883 declared to be punishable on summary conviction may be prosecuted in the Sheriff Court.(*i*)

Penalties in the Isle of Man.

The punishment for a misdemeanour, under the Act of 1883, in the Isle of Man, is imprisonment for any term not exceeding two years, with or without hard labour, and with or without a fine not exceeding one hundred pounds, at the discretion of the Court.(*k*) And any offence 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.(*l*)

Complete specification must be filed within nine, or upon leave ten, months from date of application.

Filing the Complete Specification.—If an applicant does not leave a complete specification with his application, he may leave it at any subsequent time within nine months, or, on obtaining the leave of the Comptroller on payment of the prescribed fee, within a further extended period of one month (*m*) from the date of application, but, unless a complete specification is left within that time, the application will be deemed to be abandoned.(*n*)

(*f*) Cheavin *v.* Walker, (1877) L. R. 5 Ch. D. 850.

(*g*) 46 & 47 Vict. c. 57, s. 105, sub-s. 2; but see Cheavin *v.* Walker, (1877) L. R. 5 Ch D. 863; Linoleum Co. *v.* Nairn, (1877) L. R. 7 Ch. D. 834.

(*h*) 46 & 47 Vict. c. 57, s. 106.

(*i*) 46 & 47 Vict. c. 57, s. 108.

(*k*) 46 & 47 Vict. c. 57, s. 112, sub-s. 2.

(*l*) 46 & 47 Vict. c. 57, s. 112, sub-s. 3.

(*m*) 48 & 49 Vict. c. 63, s. 3; see P. R. 1890, rr. 50, 51.

(*n*) 46 & 47 Vict. c. 57, s. 8; see also 46 & 47 Vict. c. 57, s. 98.

Filing Complete Specification.

The nine months is reckoned exclusively of the day of the date of the application.(*o*)

Where an application for a patent has been abandoned or become void, the specification or specifications and drawings (if any) accompanying or left in connection with such application are not at any time open to public inspection, or published by the Comptroller.(*p*)

If a provisional specification is left with the application a fee of £1 is payable, and a further fee of £3 becomes due on the filing of the complete specification, whereas, if a complete specification is left with the application, a fee of £4 must be paid at the same time.(*q*)

The complete specification must be signed by the applicant or his authorised agent, but in the case of a joint application the Comptroller will not refuse to accept the complete specification on the ground that it is only signed by, or only on behalf of, one applicant.(*r*)

Reference of the complete specification to an examiner.

The complete specification is referred to an examiner, whose duty it is to report whether the invention particularly described in the complete specification is substantially the same as that which is described in the provisional specification, and, if the examiner reports that it is not so, the Comptroller is empowered to refuse to accept the complete specification unless and until it shall have been amended to his satisfaction; any such refusal, however, is subject to appeal to the law officer, who must, 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.(*s*)

Comptroller, subject to appeal to law officer, may refuse the complete specification or require it to be amended.

The requisite amendment, if any, is to be determined by the judicial act of the Comptroller, subject to appeal to the law officer. The function of deciding what the amendment is to be is not delegated by the Act to the examiner, though the application proceeds if he reports favourably to the applicant.(*t*)

The fact that the complete specification narrows the scope of the provisional is not a ground on which the Comptroller or law officer is justified in refusing it.(*u*) Thus in *Everitt's Application* (*x*) the Comptroller refused to accept the complete speci-

(*o*) Russell *v.* Ledsam, (1843) 14 M. & W. 572, 582; 16 M. & W. 633; Williams *v.* Nash, (1859) 28 Beav. 93.

(*p*) 48 & 49 Vict. c. 63, s. 4.

(*q*) See Table of fees in the Appendix.

(*r*) In the Matter of Grenfell and McEvoy's Patent, (1890) 7 R. P. C. 151.

(*s*) 46 & 47 Vict. c. 57, s. 9 (1), (2), (3); see in the Matter of Anderson's Patent, (1890) 7 R. P. C. 323.

(*t*) See C.'s Patent, (1890) 7 R. P. C. 256.

(*u*) Everitt, (1886) Griff. L. O. C. 27, p. 163 *ante*.

(*x*) (1888) Griff. L. O. C. 27.

Filing Complete Specification.

fication on the ground that it claimed only a special means of carrying a principle into effect, whilst the provisional was apparently for the principle, but this decision was reversed on appeal, on the ground that in law the Comptroller was not entitled to refuse to accept the complete specification, which only narrowed down the ambit of the provisional and did not go outside it.

Also, if the specification ends with a real statement of the invention claimed, distinct from the description in the body of the document, it is not competent to the Comptroller or law officer to inquire whether the claim is in conformity with the description or not. A claim to an improved machine, "substantially as described," is not a distinct statement within the meaning of sub-s. 5, s. 5, of the Act of 1883, and is not sufficient.(*y*)

Reports of examiners are not published or open to public inspection.

Reports of examiners are not in any case published or open to public inspection, and are not liable to production or inspection in any legal proceedings under the Act of 1883, unless the Court or officer having power to order discovery in such legal proceedings shall certify that such production or inspection is desirable in the interests of justice, and ought to be allowed.(*z*) It consequently follows that where there are two applicants for a patent for the same or analogous inventions, each cannot know the nature of the other's specification until the rival complete specifications themselves are accepted and open to public inspection.(*a*)

Subsequent application before seal is obtained in respect of a prior application.

Sub-s. 5 and 6 of s. 7 of the Act of 1883 were found in practice to be useless, and to give rise to much hardship and blackmailing, perpetrated by prior against later applicants, and they were abolished by the Act of 1888, which substituted a new section for s. 7 of the original Act of 1883, and *inter alia* provides that (*b*) "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."

(*y*) Smith's Patent, Griff. P. C. 268.
(*z*) 46 & 47 Vict. c. 57, s. 9, sub-s. 5; 51 & 52 Vict. c. 50, s. 3.
(*a*) 46 & 47 Vict. c. 57, s. 10.
(*b*) 51 & 52 Vict. c. 50, s. 2.

Filing Complete Specification.

In cases where the Comptroller refuses to accept an application or requires an amendment, the applicant has the right of appeal to the law officer, who must, 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.(*c*)

The above-mentioned substituted s. 7 and s. 9 of the Act of 1883 (*d*) do not define any limits within which the Comptroller may require an amendment of the specifications before the final specification is accepted.

Amendment of a complete specification before and after acceptance.

It may happen that the applicant himself may desire to amend his specifications before the seal is obtained. It is submitted that if this is so the Comptroller may under the substituted s. 7 and s. 9 of the Act of 1883 allow the amendment before acceptance of the complete specification (*e*) in the form of a requirement by him. On the other hand, it is also submitted that if the applicant is so minded he may proceed under s. 18 of the Act of 1883 (*f*) and obtain amendment under that section even though the complete specification has not been accepted.(*g*) If the complete specification has not become open to public inspection (*h*) there is no necessity for the advertisement of the request for leave to amend under s. 18.(*i*)

Disagreement by joint applicants as to form of specification.

When joint applicants disagree as to the form of the complete specification and desire to file separate specifications, the Comptroller and law officer have no jurisdiction to decide between them, or to accept two separate specifications, or to accept a specification at all, unless the parties come independently to an agreement and settlement as to its form.(*k*)

Acceptance of complete specification is no guarantee in law.

The acceptance of a specification by the Comptroller is no guarantee that it is good in law. The Comptroller is only required to be satisfied that the specification is prepared in the prescribed manner, and that the invention particularly described in the complete is substantially the same as that described in the provisional specification.

Acceptance of

If a complete specification is not accepted within twelve

(*c*) 51 & 52 Vict. c. 50, s. 2. The practice on appeal to the law officer is regulated by the Law Officer's Rules: see Appendix.

(*d*) 46 & 47 Vict. c. 57, s. 9; 50 & 51 Vict. c. 50, s. 2.

(*e*) Dart's Patent, Griff. P. C. 307.

(*f*) p. 275 *ante*.

(*g*) Jones's Patent, Griff. P. C. 313.

(*h*) p. 303 *post*.

(*i*) Jones's Patent, Griff. P. C. 313. In this case the complete specification was not yet open to public inspection. The term "public property" in the Attorney-General's judgment probably referred to the date of lodging the specification.

(*k*) Apostoloff's Patent, (1896) 13 R. P. C. 275.

months from the date of application, or within a further extended period of three months, on obtaining the leave of the Comptroller and payment of the prescribed fee,(*l*) then (save in the case of an appeal having been lodged against the refusal to accept) the application at the expiration of such period becomes void.(*m*)

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complete specification must take place within a definite period.

When the complete specification is accepted, the Comptroller is required by the Act of 1883 to advertise the acceptance in the official journal of the Patent Office, and the application and specification or specifications, with the drawings (if any), are thereupon open to public inspection and may be inspected at the Patent Office upon payment of the prescribed fee.(*n*)

When a complete specification becomes public.

Foreigner's Application.—In order to enable the British Government to join the "Union for the Protection of Industrial Property," which consists at present of the following States—Great Britain, Belgium, Brazil, Spain, France, Guatemala, Italy, Holland and its East Indian colonies, Portugal, Servia, Switzerland, Norway, Sweden, Tunis, the United States, and Mexico—it is provided by s. 103 of the Act of 1883, as amended by s. 6 of the Act of 1885, as follows:

Foreign applicants.

"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, then any person who has applied for protection for any invention in any such State shall be entitled to a patent for his invention under the Act of 1883, in priority to other applicants; and such patent shall have the same date as the date of application in such foreign State: provided that his application is made within seven months from his applying for protection in the foreign State with which the arrangement is in force: And provided further that the patentee shall not be entitled to recover damages for infringements happening prior to the date of the actual acceptance of his complete specification."

The word "person" includes "corporation," and so the section gives the same rights of priority to foreign corporations as to individuals.(*o*)

It is also enacted that the publication in the United Kingdom or the Isle of Man, during the above period of seven months, of any description of the invention, or the use therein during such

(*l*) 48 & 49 Vict. c. 63, s. 3.
(*m*) 46 & 47 Vict. c. 57, s. 9 (4).
(*n*) 46 & 47 Vict. c. 57, s. 10; P. R. (1890) rr. 21, 22.
(*o*) Carey's Patent, (1889) 6 R. P. C. 552; Société Anonyme du Générateur du Templé's Patent, (1896) 13 R. P. C. 56.

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period of the invention, shall not invalidate the patent which may be granted for the same.

This latter provision does not apply in all cases where a patent has been previously obtained in a foreign country, but is only applicable, as part of the general provisions of s. 103 of the Act of 1883, to cases where the patentee avails himself of the privilege given by that section. The Act gives a foreign patentee, who has obtained a patent in a State which has joined the convention, a double right—viz., either to apply in this country for a patent ante-dated to the date of his foreign application, or, running the risk of publication, to obtain a patent in the ordinary way for the full period from the date of application.(*p*)

The application for the grant of a patent under the above provisions must be made in the same manner as an ordinary application; and those provisions 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.(*q*)

Retrospective effect of Order in Council.

An Order in Council, made under the above provisions, has a retrospective effect. Thus, where a person has applied for a patent in a foreign State or British possession to which the provisions of s. 103 of the Act of 1883 have not been extended at the date of the application, he is entitled, during the period of seven months from the date of such application (if it is the first foreign application he has made) to a British patent, bearing the date of such application, if the provisions of s. 103 of the Act of 1883 have been extended to such foreign State or British possession before the expiration of such period of seven months.(*r*)

Provisions of s. 103 of Act of 1883 may by order in Council be applied to British possessions.

The Act of 1883 further empowers her Majesty, where it is made to appear to her that the legislature of any British possession has made satisfactory provision for the protection of inventions patented in this country, by Order in Council (to take effect as if its provisions had been contained in the Act, and from the date fixed by the Order), to apply the above provisions with such variations or additions, if any, as to her Majesty in Council may seem fit; and it is lawful for her Majesty in Council to revoke any such order.(*s*)

(*p*) British Tanning Co. Ltd. *v.* Groth, (1891) 8 R. P. C. 113.

(*q*) 46 & 47 Vict. c. 57, s. 103, (3) and (4).

(*r*) In the Matter of Main's Patent, (1890) 7 R. P. C. 13.

(*s*) 46 & 47 Vict. c. 57, s. 104; see International Convention in the Appendix

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A patent in this country can only be granted under the provisions of s. 103 of the Act of 1883, to the person who has actually made application for protection in the foreign State, and not to another person on his behalf.(*t*)

Only the person who actually made the foreign application is recognised.

Moreover, s. 103 of the Act of 1883 does not confer any rights on a person making an application for a British patent, in respect of an invention communicated to him from abroad. The rights conferred by the section are personal, and intended to encourage people who have invented abroad to come to this country and to make known their inventions.(*u*)

The rights conferred by s. 103 are personal.

L'Oiseau and *Pierrard's Application*(*x*) is an instance of the advantages conferred on foreign applicants by s. 103 of the Act of 1883. In that case the applicants applied for a patent for "automatic apparatus for subjecting the person to the action of electric currents," which was opposed by one *Everitt*, on the ground that his prior application, in which his complete specification had been accepted, for a patent for "improvement in completing electric currents," contained the subject-matter of the applicant's alleged invention. It appeared, however, that *L'Oiseau* and *Pierrard* had obtained a patent for their invention in France within seven months of their application in England, and on an application in France of earlier date than *Everitt's* application in England. *L'Oiseau* and *Pierrard* were therefore held entitled to an English patent, under the Act of 1883 and the Convention of 1884, to the disadvantage of *Everitt*.

Effect of an abortive foreign application.

When a foreigner makes an abortive application in a foreign country, and then a successful application, before applying in this country, the British patent is antedated to the date of the successful foreign application.

Thus when a person on February 8, 1887, made an application in America for a patent, which became abortive, and on September 7, 1887, renewed his application, and then on April 8, 1888, made an application for a British patent, under s. 103 of the Act of 1883, to bear date September 7, 1887, the Comptroller refused the application. The law officer reversed the Comptroller's decision, and ordered a patent to be granted and dated September 7, 1887, on the ground that the patentee had no subsisting rights

(*t*) In the Matter of Shallenberger's Application, (1889) 6 R. P. C. 550; in the Matter of Carey's Application, (1889) 6 R. P. C. 552.

(*u*) In the Matter of Shallenberger's Application, (1889) 6 R. P. C. 550.

(*x*) (1887) Griff. L. O. C. 36.

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under his abortive application in America, of February 8, 1887.(*y*)

Practice on applications under s. 103 of the Act of 1883.

A foreigner applying for a British patent under the provisions of s. 103 of the Act of 1883 must include in his application a declaration that the foreign application as defined by the Patent Rules 1890 has been made,(*z*) and must specify the foreign States or British possessions in which foreign applications have been made, and the official date or dates thereof respectively. The application must be made within seven months from the date of the first foreign application, and must be signed by the person or persons by whom such first foreign application was made. If such person, or any of such persons, be dead, the application must be signed by the legal personal representative of such dead person, as well as by the other applicants, if any.(*a*)

The application in the United Kingdom must be made in the Form A2,(*b*) and must be accompanied by a specification, provisional or complete, together with :—

(1) A copy or copies of the specification, and drawings or documents corresponding thereto, filed or deposited by the applicant in the Patent Office of the foreign State or British possession, in respect of the first foreign application, duly certified by the official chief or head of the Patent Office of such foreign State or British possession, or otherwise verified to the satisfaction of the Comptroller.

(2) A statutory declaration as to the identity of the invention in respect of which the 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 must be annexed to and verified by such statutory declaration.(*c*)

Minor differences of departure in an applicant's English specification may be allowed, if the Comptroller and law officer are enabled, by the agreed translation of the foreign specification,

(*y*) In the Matter of Van de Poele's Patent, (1890) 7 R. P. C. 69.

(*z*) "Foreign application" means an application by any person for protection of his invention in a foreign State, or British possession, to which by an order of her Majesty in Council for the time being in force the provisions of s. 103 of the Act of 1883 have been declared applicable, see Patent Rules (1890), r. 24.

(*a*) See P. R. (1890) r. 25.

(*b*) See Appendix.

(*c*) See P. R. (1890) r. 26; for further details as to practice on applications under s. 183 of Act (1883) see rr. 27, 29.

to conclude that the inventions referred to in the two documents are substantially the same.(*d*) Should the British patent, however, be granted for an invention different to that forming the subject of the foreign application, this fact may seriously affect the validity of the patent.(*e*)

Opposition—General.

Though when a foreigner applies for a British patent under the provisions of s. 103 of the Act of 1883 his specification must not claim any invention which is not included in his foreign patent, the British specification may contain a description of an invention not included in the foreign patent, but the claim must be limited to the invention protected in the foreign State.(*f*)

Opposition.

By s. 11 of the Patents, Designs and Trade Marks Act, 1883, as amended by the Act of 1888, which (*inter alia*) relieved the Patent Office officials of the necessity of sending notices of interferences to prior applicants or patentees,(*g*) it is enacted as follows:—

S. 11 of Act of 1883 as amended by Act of 1888.

"(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 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.

"(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

(*d*) L'Oiseau and Pierrard, (1887) Griff. L. O. C. 37; in the Matter of Main's Patent, (1890) 7 R. P. C. 13.

(*e*) Averey's Patent, (1887) 4 R. P. C. 152; Renard *v.* Levinstein, (1864) 10 L. T. 177; Milligan *v.* Marsh, (1856) 2 Jur. N. S. 1083; Moser *v.* Marsden, (1893) 10 R. P. C. 209.

(*f*) L'Oiseau and Pierrard's Patent, (1887) Griff. L. O. C. 56.

(*g*) 51 & 52 Vict. c. 50, s. 4.

Opposition—General.

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."

Opposition is allowed on only three grounds.

Hence the only grounds on which a person entitled so to do may oppose the grant of letters patent are—

(1) That the applicant has obtained the invention from him, or from a person of whom he is the legal representative.

(2) That the invention has been patented in this country, on an application of prior date.

(3) 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.

Formerly, want of novelty, non-utility, and lack of subject-matter were all grounds of opposition, but the effect of the Act of 1883 is to abolish the right of the opposer to raise any of these grounds on an application for a patent; though, if the patent is granted, the Crown in no way guarantees that it may not be upset on one or other of these points in subsequent proceedings.(*h*)

When the two months time limit for giving notice of opposition has expired, it is submitted, a would-be opponent can only obtain leave to oppose by obtaining a *fiat* from the Privy Council.

Notice of opposition.

A person entitled so to do, and desirous of opposing a grant of letters patent, must, within the two months allowed from the date of the advertisement of the acceptance of the complete specification, give a notice of his opposition at the Patent Office, on Form D, stating the ground or grounds on which he intends to oppose, and he must himself sign the notice, stating his address, for service in the United Kingdom;(*i*) and, if he opposes on the ground that the invention has been patented in this country on an application of prior date, the notice must specify the title, number, and date of the patent granted on such prior application.(*k*)

The Comptroller has power to allow an amendment of an

(*h*) p. 289 *ante*.
(*i*) P. R. (1890) r. 34.
(*k*) P. R. (1890) r. 36. The practice on oppositions to grants of patents is regulated by the Patent Rules (1890), rr. 34–44, and the Law Officer's Rules.

improperly drawn notice of opposition to be made at the hearing, but he cannot impose terms.(*l*) **Opposition—General.**

On giving the notice of opposition the opponent is required to pay a fee of ten shillings, and on the hearing of the opposition both the applicant and the opponents are required to pay a fee of one pound.(*m*)

The Comptroller will, on receipt of the notice of opposition, furnish the applicant with a copy of it.(*n*)

Within fourteen days after the expiration of two months from the date of the advertisement of the acceptance of the complete specification—*i.e.*, within fourteen days after the expiration of the time fixed by the Act as the limit within which notice of opposition can be taken—the opponent is required to leave at the Patent Office statutory declarations(*o*) in support of his opposition, lists of which he must also deliver to the applicant.(*p*) Evidence of opponent and applicant.

The applicant on his part must, within fourteen days from the delivery of such list, leave at the Patent Office statutory declarations in answer, delivering a list of them to the opponent, who then is allowed fourteen days from such delivery to leave at the Patent Office statutory declarations in reply, which must be confined strictly to matters in reply, and a list of which he must give to the applicant.(*q*)

If either party files a useless and unnecessary multiplicity of declarations, the law officer will, as far as possible, endeavour to fix him with the costs and responsibility of them.(*r*)

Either party desiring copies of any of the statutory declarations of the other party may obtain them from the Patent Office or such other party.(*s*)

Neither party is allowed to leave any further evidence except with the leave of the Comptroller, and upon the written consent of the opposite party, or by special leave of the Comptroller on application made to him for that purpose,(*t*) of which application the party making it must give notice to the other party who is entitled to oppose it.(*u*)

When the evidence is finally completed, the Comptroller appoints a time for the hearing of the case, of which he must give at least ten days' notice to the parties.(*x*) Time for hearing.

(*l*) In the Matter of Airey's Application, 5 P. O. R. 348; Lake, (1886) No. 8642, Griff. L. O. C. 35; P. R. (1890) r. 16.
(*m*) See Appendix.
(*n*) P. R. (1890) r. 35.
(*o*) See p. 293 *ante*.
(*p*) P. R. (1890) r. 37.
(*q*) P. R. (1890) r. 38.
(*r*) Brand's Patent, (1894) 12 R. P. C. 102.
(*s*) P. R. (1890) r. 38.
(*t*) P. R. (1890) r. 39.
(*u*) P. R. (1890) r. 40.
(*x*) P. R. (1890) r. 41. The hearing may be during the legal vacations.

Opposition—General.

Application to be heard.

If the applicant or opponent desires to be heard, he must forthwith send the Comptroller an application on Form E.(*y*) 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 decides the case and notifies his decision to the parties.(*y*)

Limit of opposition.

On the hearing, no opposition can 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 is not allowed upon such ground unless the title, number, and date of the patent granted on such prior application is duly specified on the notice of opposition.(*z*)

Where the ground of an opposition is that the applicant has obtained the invention from the opponent, or from a person of whom such opponent is the legal representative, unless evidence in support of such allegation is left at the Patent Office within the time prescribed by the Patent Rules, 1890, the opposition is deemed to be abandoned, and the Patent is sealed forthwith.(*a*)

Hearing.

As a rule, at the hearing of an opposition, the applicant begins; but when the opponent alleges *fraud* as a ground of opposition, the *onus* being on him, his evidence may be ordered to be taken first.(*b*)

If the opponent does not appear at the hearing, the Comptroller will decide the case in his absence, and will not recall his decision, even though it is subsequently shown that the opponent did not, in fact, receive the notice of hearing, which was duly posted. In such a case, on appeal to the law officer, the matter would most probably be sent back to the Comptroller for rehearing.(*c*)

Appeal from the Comptroller's decision.

The Comptroller will notify his decision to the parties,(*d*) either of whom has the right of appeal to the law officer.(*e*)

The evidence used on such an appeal will be the same as that used at the hearing before the Comptroller, and no further evidence can 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.(*f*) Such leave may

(*y*) P. R. (1890) r. 41.
(*z*) P. R. (1890) r. 42.
(*a*) P. R. (1890) r. 43.
(*b*) Luke's Patent, (1887) Griff. P. C. 294.
(*c*) Warmann, (1887) Griff. L.O.C. 43.
(*d*) P. R. (1883) r. 41.
(*e*) 46 & 47 Vict. c. 57, s. 11 (2).
(*f*) L. O. Rules, r. viii.; 46 & 47 Vict. c. 57, s. 38; Hampton *v.* Facer, (1887) Griff. L. O. C. 13; Cheesebrough's Patent, Griff. P. C. 303.

in a proper case be obtained for the examination of witnesses who did not make declarations when the matter was before the Comptroller.(*g*)

Opposition—General.

An appeal to the law officer is a rehearing.(*h*) The law officer is entitled, if he desires it, to the assistance of an expert;(*i*) and he is also empowered, at the request of either party, to order the attendance at the hearing, for the purpose of cross-examination, of any person who has made a declaration;(*k*) and he is entitled to examine witnesses on oath, and to administer oaths for that purpose, and to order costs to be paid by either party.(*l*)

The law officer does not allow the cross-examination of witnesses or the admission of further evidence, when it appears to him that there has been ample opportunity for the filing of declarations when the case was before the Comptroller, and that he could not deal better with evidence given on cross-examination than with the declarations.(*m*) The law officer does not take on himself to decide adversely to the applicant fine points of anticipation.(*n*)

The law officer (and [*sic*] the Comptroller) is entitled to look at models in order to better understand the drawings and specifications, though the models are not exhibits, and consequently not evidence.(*o*)

Where an opposer appeals to the law officer from a decision of the Comptroller, it is not necessary that he should send a copy of his notice of appeal to the applicant.(*p*)

Power of Comptroller and law officer to impose conditions.

Both the Comptroller and the law officer have power to impose conditions on the granting of a patent, which power arises from the discretion of the Crown exercised through the Comptroller-General and the law officer to refuse the grant altogether.(*q*) Many instances of conditions imposed, and the reasons for the same, will be found in the following pages, where the different grounds of opposition are separately discussed.

Patent is only refused when the opposition is proved.

A patent is ouly refused in cases where the opposer proves his ground or grounds of opposition beyond all possibility of doubt, as there is no appeal from the decision of the law officer. It is evident that, should the law officer wrongfully refuse a

(*g*) Thwaites' Patent, (1892) 9 R. P. C. 515.
(*h*) Stubbs' Patent, Griff. P. C. 298.
(*i*) 46 & 47 Vict. c. 57, s. 11 (4).
(*k*) L. O. Rules, r. ix.
(*l*) 46 & 47 Vict. c. 57, s. 38.
(*m*) In the Matter of Pitt's Patent, (1888) 5 R. P. C. 343, 345.
(*n*) *Ibid.*
(*o*) Lancaster's Patent, (1887) Griff. P. C. 294.
(*p*) Anderson and McKinnell, (1886) Griff. L. O. C. 23.
(*q*) p. 289 *ante*; L'Oiseau and Pierrard's Patent, (1886) Griff. L. O. C. 36.

Opposition—General.

patent the applicant would suffer an irremediable injury, whereas if a grant be made in the face of what is really a valid ground of opposition the public injury thereby occasioned may be remedied in a subsequent action for infringement, or petition for the revocation of the patent.(*r*)

The law officer is only justified in stopping the issue of a patent, having examined all the evidence given on one side or the other, if he is so clearly of opinion that the opponent has made out his case that he would, if a jury were to find in favour of the applicant, refuse to accept the finding and overrule the decision on the ground that it was perverse and contrary to the obvious weight and effect of the evidence.(*s*)

Costs.

The law officer, unlike the Comptroller, has power to award costs at the hearing before him.(*t*)

It is not the custom of the law officer to attempt to give costs to such an amount as would indemnify the parties. To do so would be seriously to discourage appeals, and to limit very much the usefulness of the office which the law officers fill in these matters.(*u*)

Where an applicant, on appeal, consented to make a slight modification in his specification to satisfy the ground of opposition, but asked for costs of appeal, as he had not been previously asked to make the modification, costs were disallowed, as it was not the fault of the other side that the matter had arisen.(*x*)

In cases of unsuccessful opposition, the insertion of a few explanatory words in the specification may be allowed at the hearing before the law officer, and if the amendment is not a substantial alteration the costs of the appeal may be given as if no such modification had been accepted.(*y*)

Grounds of Opposition.—It will be convenient to con-

(*r*) *Re* Russell's Patent, (1857) 2 De G. & J. 130, 132; *Re* Simpson and Isaacs' Patent, 21 L. T. N. S. 81; *Re* Spence's Patent, (1859) 3 De G. & J. 523; *Re* Lowe's Patent, 25 L. J. Ch. 454; *Re* Tolson's Patent, (1856) 6 De G. M. & G. 422; Chandler's Patent, (1886) Griff. P. C. 270; Stubbs' Patent, (1884) Griff. P. C. 298; Welch's Patent, (1884) Griff. P. C. 300; Edmund's Patent, (1886) Griff. P. C. 281; Newman, (1887) Griff. L. O. C. 40; Jones, (1887) Griff. L. O. C. 33; in the Matter of Aire and Calder Glass Bottle Works and Walker's Application, (1888) 5 R. P. C. 345; in the Matter of Daniel's Application, (1888) 5 R. P. C. 413; in the Matter of Wallis and Ratcliff's Application, (1888) 5 R. P. C. 347; in the Matter of Luke's Patent, (1889) 6 R. P. C. 548; Stewart's Patent, (1892) 9 R. P. C. 452; Codd's Patent, (1892) 9 R. P. C. 488; Levinstein's Patent, (1894) 11 R. P. C. 348.

(*s*) Per Clarke, S.G., Stuart's Patent, (1892) 9 R. P. C. 452.

(*t*) 46 & 47 Vict. c. 57, s. 38.

(*u*) Per Clarke, S.G., Stuart's Patent, (1892) 9 R. P. C. 453.

(*x*) Woodhead, (1886) Griff. L. O. C. 44.

(*y*) Fletcher, (1886) Griff. L. O. C. 30.

sider separately the three grounds on which the grant of a patent to the applicant may be opposed by persons having a *locus standi* to oppose.

Opposition—First Ground.

I. *The applicant has obtained the invention from the opponent, or from a person of whom he is the legal representative.*

Legal representative.

A person who has obtained an assignment of a patent, with the full benefit of all improvements and modifications thereof, from the assignee of the patentee, does not thereby become the legal representative of the patentee, so as to entitle him to oppose the grant of a patent to another inventor on the ground that the applicant obtained the invention from the prior patentee;(*z*) nor is a person holding a power of attorney from a patentee his legal representative within the meaning of the Act.(*a*) The term legal representative must be construed in its ordinary meaning of executor or administrator.(*b*)

Issue of true and first inventor is not open.

It is not the duty of the Comptroller on an application which is opposed, or of the law officer on appeal, to decide whether or not the applicant is the true and first inventor, and he cannot inquire into the circumstances under which the applicant became possessed of the invention, other than those which go to show that it was derived from the opponent, or the person of whom he is the legal representative, if this ground of opposition is properly raised.(*c*)

If this objection be clearly proved no patent will be granted.(*d*)

Objection may succeed in part.

The objection may succeed as to part only of the applicant's claim, in which case a patent may be ordered to be sealed for that portion only to which the opposition does not extend.(*e*)

The words "obtained the invention" are to be read as meaning "obtained the invention which is purported to be patented," and as referring to the identity of the invention and not to the right of the person from whom it was obtained to be regarded as the first and true inventor.(*f*)

Patent is sealed when evidence is conflicting.

If at the hearing before the Comptroller the evidence as to the applicant having obtained the invention from the opponent

(*z*) Spiel's Patent, (1887) 5 R. P. C. 281.

(*a*) Edmund's Patent, (1888) Griff. P. C. 281.

(*b*) *Ibid.*

(*c*) See in the Matter of Adolph Spiel's Application, (1888) 5 R. P. C. 281; in the Matter of Lake's Patent, (1888) 5 R. P. C. 415.

(*d*) In the Matter of Marshall's Application, (1888) 5 R. P. C. 661; in the Matter of Griffin's Application, (1889) 6 R. P. C. 296; Stuart's Patent, (1892) 9 R. P. C. 452; Paterson and Dundon's Patent, (1884) Griff. P. C. 295; Griffin's Patent, (1888) 6 R. P. C. 452.

(*e*) Thwaite's Patent. (1892) 9 R. P. C. 515.

(*f*) *Ibid.*

Opposition—First Ground.

or a person of whom he is the personal representative is conflicting, the patent will be ordered to be sealed without prejudice to an appeal to the law officer,(*g*) and in order that the witnesses may be cross-examined.(*h*)

Employer and employed.

With regard to the right of an employer to oppose the grant of a patent for an invention to his servant, it is to be noticed that there is no authority which lays down that, in the absence of special contract, the invention of a servant, even made in the employer's time, and with the use of the employer's materials, and at the expense of the employer, thereby becomes the property of the employer so as to prevent the person employed from taking out and exclusively enjoying a patent for it.(*i*)

In *David* and *Woodley's Application*,(*k*) the facts were that *Jones*, having invented some improvements in sewing machines, was introduced by *David* to *Woodley*, and *Woodley* was employed by *Jones* and *David* conjointly (*David* claiming some interest in *Jones's* invention) to make a model. *Woodley* made some suggestions, which were embodied in the model. *Jones* took out a patent for the machine, whereupon *David* and *Woodley* applied for a patent for the suggestions made by *Woodley*. *David* and *Woodley* had also applied for a patent for alleged improvements on this invention. The Comptroller refused the grant, and the law officer upheld his decision, on the ground that when a workman is employed by an inventor to make a model for the purpose of carrying out his invention, and the workman suggests improvements in detail of the machine which are adopted in the machine or model as completed, those suggestions are the property of his employer, and the workman cannot afterwards take out a patent for them. Further, if *Woodley* was in the employment of *Jones* and *David*, and not of *Jones* alone, the invention was *Jones's*, and he had never parted with his property in it, and *Woodley* stood to *Jones* in the relation of paid servant to employer. *David* was entitled to enforce in a court of law any claims he might have against *Jones*, founded on the alleged partnership or of a pecuniary character.

Experiments by persons other than *applicant*.

The fact that other persons have made experiments identical with the applicant's will not stop the patent being granted unless the opposer shows that the applicant derived the invention from the person making such experiments, and then

(*g*) Luke's Patent, (1887) Griff. P. C. 294.

(*h*) Hatfield's Patent, (1884) Griff. P. C. 288.

(*i*) See Heald's Patent, (1891) 8 R. P. C. 429; p. 14 *ante*.

(*k*) (1884) Griff. L. O. C. 26.

only if such person or his legal representative is the opponent.(*l*)

Opposition—First Ground.

In cases of agreements for the assignment of unpatented and unpublished inventions questions may arise as to the right of the alleged assignee to be made the patentee.

Assignment of unpatented and unpublished inventions.

Thus, where an opponent in carrying on business had got into difficulties and had made an agreement to sell the business to the applicant, part of the consideration being an understanding that the opponent should give the applicant the benefit of a certain invention for sewing button-holes, and the opponent opposed on the ground that the invention had been obtained from him, the patent was refused in the absence of a written assignment.(*m*)

Fraud committed abroad will not prejudice an applicant in respect of an invention stated to have been communicated to him from abroad.

Fraud committed by applicant abroad.

Thus where,(*n*) on an application for a patent on a communication from abroad, the opposer objected that the applicant had obtained the invention from him through a third party abroad, the patent was granted on the ground that a person availing himself of information from abroad is an inventor within the Statute of Monopolies.(*o*) It is to be observed that the Comptroller and law officer have no authority to inquire into the source of the patentee's information in such a case;(*p*) neither will they inquire as to any alleged fraud committed by the applicant (communicator) against the opponent abroad.(*q*)

Though a foreign applicant has important rights under s. 103 of the Act of 1883 and the convention of 1884, he is not entitled, on the ground that the applicant obtained part (*r*) or the whole (*s*) of the invention from him, to oppose an application in this country of later date than his own.(*t*)

Rights of inventor who is a foreigner.

It is a good ground of opposition to the grant of a patent for a communication from abroad that the applicant had no

(*l*) See *Ex parte* Henry, (1872) L. R. 8 Ch. 167; in the Matter of Homan's Patent, (1889) 6 R. P. C. 104; Saxby *v.* Gloucester Waggon Co., (1887) Griff. L. O. C. 57.

(*m*) In the Matter of Marshall's Application, (1888) 5 R. P. C. 661.

(*n*) In the Matter of Lake's Patent, (1888) 5 R. P. C. 415.

(*o*) 21 Jac. I. c. 3, s. 6; Nickels *v.* Ross, (1849) 8 C. B. 679.

(*p*) See Edmund's Patent, (1886) Griff. P. C. 281; in the Matter of Adolph Spiel's Patent, (1888) 5 R. P. C. 281; in the Matter of Bairstow's Patent, (1888) 5 R. P. C. 286.

(*q*) Higgin's Patent, (1891) 9 R. P. C. 74; Edmund's Patent, (1886) Griff. P. C. 283; Spiel's Patent, (1887) 5 R. P. C. 281; Bairstow's Patent, (1887) 5 R. P. C. 286; Lake's Patent, (1887) 5 R. P. C. 415.

(*r*) Edmund's Patent, (1886) Griff. P. C. 281.

(*s*) In the Matter of Lake's Patent, (1888) 5 R. P. C. 415.

(*t*) Everitt, (1887) Griff. L. O. C. 28.

Opposition—First Ground.

authority from the foreign inventor to make the application, but that the opposer was the person to whom the foreigner entrusted his invention with the view of getting protection in this country.(*u*)

Joint grantees.

Sometimes the patent is granted to the applicant and opponent conjointly, if it appears that the invention is the joint production of both.(*x*)

Concurrent applications.

When there were concurrent applications for a patent in respect of the same invention, it was formerly a recognised principle that the patent would be awarded to the inventor who ran quickest through the process and was ready first to obtain the Great Seal.(*y*) Now, however, since the patent is in all cases dated as on the day of application,(*z*) in the case of concurrent applications on the same day, one patent would most probably be granted to the two applicants jointly, and if the concurrent applications were not made on the same day the prior applicant would be entitled to the prior patent.

Condition that grantee shall assign a share.

It may be made a condition that the grantee shall assign a certain share to another person if the interests of justice appear to require it, as in the case of joint inventors making separate applications;(*a*) and each co-owner may be bound to pay a proportionate part of the fees necessary to keep the patent on foot.(*b*)

Condition that opponent shall be made a joint patentee.

The condition has been imposed, under circumstances that called for it, that the grantee and opponent should enter into an agreement by which the former should undertake to do all such acts as might be necessary to secure to the latter the full rights of a joint patentee in the invention, and the latter should undertake not to commence proceedings for revocation of the patent when granted.(*c*)

Rival applicants.

In the case of rival applicants, if it appear that distinct parts are the separate inventions of the rival applicants, separate patents will be ordered to be sealed to each applicant in respect of his own invention alone.(*d*)

Applicant's invention only an improvement on opponent's.

When it is clear that the applicant obtained the idea of his alleged invention from the opponent, and that the alleged

(*u*) Fiechter, (1882) Griff. P. C. 284.

(*x*) Eadie's Patent, (1885) Griff. P. C. 279: *Re* Russell's Patent, (1857) 2 De G. & J. 130; Luke's Patent, (1886) Griff. P. C. 294.

(*y*) *Ex parte* Dyer, Hindmarch on Patents, p. 535; *Re* Simpson and Isaacs' Patent, (1853) 21 L. T. 81.

(*z*) 46 & 47 Vict. c. 57, s. 13.

(*a*) Evans and Otway's Patent, (1884) Griff. P. C. 279; Garthwaite's Patent, (1886) Griff. P. C. 284.

(*b*) Evans and Otway's Patent, (1884) Griff. P. C. 279.

(*c*) Luke's Patent, (1885) Griff. P. C. 294.

(*d*) Craig and Macfarlane's Applications, P. M. J. vol. iv. 3rd series, p. 366.

invention is really nothing more than an improvement upon the opponent's patented invention, the application will be allowed only on the condition that the applicant insert in his specification a statement to the effect that his invention is an improvement upon the opponent's.(*e*)

Opposition—Second Ground.

II. *The invention has been patented in this country on an application of prior date.*

It would appear at first sight that this ground of opposition is open to any person, whether he have a direct interest in opposing the patent or not; but the decisions lead to the conclusion that only persons having a direct interest are allowed to oppose on this ground now, as they were formerly by the special enactment of the repealed Act of 1852.(*f*) It must also be noticed that sub-s. 3 of s. 11 of the Act of 1883 directs the law officer, on an appeal, to hear the applicant and any person giving notice, and being, "*in the opinion of the law officer*, entitled to be heard," and thus it is evident that the section contemplates the existence of persons who have no right of opposition.

Opponent must have a *locus standi*.

The only persons having a *locus standi* to be heard on this ground of opposition before the Comptroller, or on appeal from him before the law officer, are those who, as original owners or assignees, have a direct interest under prior patents subsisting or expired. The law officer has no wider jurisdiction than the Comptroller. He only hears cases by way of appeal, and the words "being, in the opinion of the law officer, entitled to be heard" refer back to the persons who are allowed to oppose in sub-s. 1.(*g*)

A person having a *locus standi* is entitled to rely in his opposition upon specifications other than those in which he is, or was, interested and from which he derives his *locus standi*.(*h*)

A person who is merely an agent—*e.g.*, a patent agent—of a prior patentee has not such an interest in the prior patent as will entitle him to oppose a subsequent application in his own name.(*i*) The opposition must be in the name of the principal: otherwise this ground of opposition cannot be raised.(*k*)

(*e*) Hoskins's Patent, (1884) Griff. P. C. 291; Newman's Patent (2), (1888) 5 R. P. C. 279; for form of statement see Griff. P. C. 292 n.

(*f*) s. 12.

(*g*) Stewart's Patent. (1896) 13 R. P. C. 627; Glossop's Patent, (1884) Griff. P. C. 285; Heath and Frost's Patent, (1886) Griff. P. C. 288; Hookham's Patent, (1886) Griff. L. O. C. 32; Macevoy's Patent, (1888) 5 R. P. C. 285.

(*h*) *Ibid.*

(*i*) Heath and Frost's Patent, (1886) Griff. P. C. 288; Lake, (1887) Griff. L. O. C. 35; Hookham, (1887) Griff. L. O. C. 32.

(*k*) *Ibid.*

Opposition—Second Ground.

It has been held that where a person is about to commence to work an invention, which he alleges is included under certain expired patents, he has not such an interest in the expired patents as to entitle him to be heard in opposition to the granting of a fresh patent; (*l*) though where the opponent was the patentee by direct grant,(*m*) or by assignment (*n*) under the expired patent, he is entitled to oppose; (*o*) but a person who has no further interest in an expired patent than the fact that he manufactured under it is not entitled to be heard in opposition to the grant of a fresh patent.(*p*)

Webster, A.G., has stated that, in his opinion, the only persons entitled to oppose under the words "patented, &c.," are persons who have made an application in the United Kingdom of prior date to the date of the applicant's patent,(*q*) and that the effect of s. 15 of the Act of 1883 is to place a person who has had a complete specification accepted in the same position, for the purpose of opposition, as a person who has already got a patent upon which he can oppose.(*r*)

Though law officer overrules Comptroller on question of *locus standi*, he will not lightly interfere with result of the decision.

Though the law officer on appeal allows the objection that the opponent is not a person entitled to be heard, he will not interfere with the Comptroller's decision as to the grant or refusal of the patent, unless he is satisfied that, looking at the substance of it, that decision ought to be interfered with.(*s*)

Patent allowed in doubtful cases.

When an application is resisted on this ground of opposition,(*t*) all the Comptroller or law officer can, on the hearing, be called on to decide is, whether or not the invention sought to be patented is the same as that patented on an application of prior date, and in cases of doubt the grant is allowed.(*u*)

(*l*) In the Matter of Bairstow's Patent, (1888) 5 R. P. C. 286.
(*m*) Lancaster's Patent, (1884) Griff. P. C. 293.
(*n*) Glossop's Patent, (1884) Griff. P. C. 285.
(*o*) Lancaster's Patent, (1884) Griff. P. C. 293.
(*p*) Macevoy's Patent, (1888) 5 R. P. C. 285.
(*q*) Everitt, (1887) Griff. L. O. C. 28.
(*r*) L'Oiseau and Pierrard, (1887) Griff. L. O. C. 36; but see *Ex parte* Henry, (1872) L. R. 8 Ch. 167.
(*s*) Heath and Frost's Patent, (1886) Griff. P. C. 290. (*t*) p. 317 *ante*.
(*u*) p. 281 *ante*; Jones, (1886) Griff. L. O. C. 33. In the following cases, decided since the Act of 1883 came into operation, patents were refused on the ground that the respective inventions had been patented on applications of prior date :—

Heath and Frost's Patent, (1886) Griff. P. C. 310.
In the Matter of Daniel's Application, (1888) 5 R. P. C. 413.
In the Matter of Aire and Calder Glass Bottle Works and Walker's Application, (1888) 5 R. P. C. 345.
In the Matter of Wallis and Ratcliff's Application, (1888) 5 R. P. C. 347.
In the Matter of Webster's Patent, (1888) 5 R. P. C. 163.
Green's Patent, (1887) Griff. P. C. 286.
Lancaster's Patent, (1887) Griff. P. C. 293.
Re Bailey, Goodeve, P. P. 57.

Opposition—Second Ground.

It is no part of the duty of the Comptroller or law officer to inquire whether the applicant's patent, if granted, would infringe a prior patent,(*x*) or whether the alleged invention is proper subject-matter,(*y*) or whether the patent, if granted, would be invalid from any other cause; (*z*) and the applicant in all cases frames his specification at his peril.(*a*)

Notice of opposition must be distinct.

The notice of opposition must distinctly allege this ground of opposition in specific terms; it will be wrong in form if it allege that the prior invention was the same, "*or substantially the same*," as the applicant's,(*b*) or that the applicant's invention is "*a direct infringement of the opponent's patent.*"(*c*)

Question of validity of prior patent is not open.

It is not competent to the applicant to object that the prior patent relied on was void on the ground of disconformity between the specifications or between the title and the specifications, or upon any other ground.(*d*)

Green's Patent.

In *Green's Patent*, decided under the Act of 1883, before amendment of the Act of 1888,(*e*) the grant was opposed by *Lowcock* and *Sykes*, on the ground that the invention for which the applicant sought to obtain protection had been, as to certain parts, patented by them. The applicant objected that the opponent's patent was bad, because the complete specification

Boult's Application, (1893) 10 R. P. C. 275.
Stewart's Application, (1896) 13 R. P. C. 627.
Whittaker's Application, (1896) 13 R. P. C. 580.
Smith's Application, (1896) 13 R. P. C. 200.
Wylie and Morton's Application, (1896) 13 R. P. C. 97.

In the following cases, decided since the Act of 1883 come into operation, the objection was taken that the respective inventions had been patented on applications of prior date, but unsuccessfully:—

In the Matter of Lorrain's Patents, (1888) 5 R. P. C. 142.
In the Matter of Newman's Patent, (1888) 5 R. P. C. 271.
In the Matter of Pitt's Patent, (1888) 5 R. P. C. 343.
In the Matter of Airey's Application, (1888) 5 R. P. C. 348.
In the Matter of Sielaff's Application, (1888) 5 R. P. C. 484.
In the Matter of Brownhill's Patent, (1889) 5 R. P. C. 135.
Anderton, (1887) Griff. L. O. C. 25.
Fletcher, (1887) Griff. L. O. C. 30.
Von Buch, (1887) Griff. L. O. C. 40.
Huth's Patent, (1884) Griff. P. C. 292.
Cumming's Patent, (1884) Griff. P. C. 277.
Stubbs' Patent, (1884) Griff. P. C. 298.
Ross' Patent, (1891) 8 R. P. C. 477.
Bartlett's Patent, (1892) 9 R. P. C. 511.
Maxim and Silverman's Application, (1894) 11 R. P. C. 314.
Marsden's Patent, (1896) 12 R. P. C. 87.

(*x*) Jones, (1887) Griff. L. O. C. 35; In the Matter of Sielaff's Application, (1888) 5 R. P. C. 484.
(*y*) Jones, (1887) Griff. L. O. C. 33.
(*z*) p. 289 *ante*.
(*a*) In the Matter of Lorrain's Patents, (1888) 5 R. P. C. 142.
(*b*) Jones, (1887) Griff. L. O. C. 33.
(*c*) In the Matter of Daniel's Application, (1888) 5 R. P. C. 413.
(*d*) Green, (1887) Griff. P. C. 286; Newman, (1887) Griff. P. C. 40; In the Matter of Haythornthwaite's Application, (1890) 7 R. P. C. 70.
(*e*) (1885) Griff. P. C. 286.

Opposition—Second Ground.

went beyond the provisional, which did not include the parts which the applicant wished to cover. The law officer held that, though the opponent's patent might in fact be void, yet he could not entertain the objection; and since the opponent's patent included the parts in dispute he could not allow a patent to be sealed to the applicant. The applicant consequently suffered in that he was prevented from obtaining a patent for the parts which he had invented between the dates of filing the opponent's specifications. The opponent's specifications having been referred to an examiner, and reported favourably upon by him, it was the duty of the Comptroller and law officer, for the purpose of the application, to treat them as good specifications, and consequently the question of disconformity could not be raised.(*f*)

The third ground of opposition,(*g*) which was introduced by the Act of 1888,(*h*) provides for such a case as the above. If the Act of 1888 had then been in force it would have been competent to *Green* to have opposed the grant to *Lowcock* and *Sykes*, and to have himself applied for a patent in respect of his own invention.

Claim by applicant to something not foreshadowed in the provisional specification of patent relied on by the opponent.

Where something claimed by the applicant is not to be found foreshadowed in the provisional specification of the patent relied on by the opponent, though it may possibly be found described in the complete specification of such patent, and the said complete specification was in fact filed after the date of the application, these dates become most important. In such a case the patent of the applicant should be sealed on the ground that, by refusing it, great injustice might be done to the applicant. He might succeed, if the patent is allowed, in satisfying a Court that what was described in the opponent's complete specification was in fact novel at the date of his application, since it was not foreshadowed in the opponent's provisional.(*i*)

Expiration of prior patent relied on is no bar.

Whenever the application is opposed on the ground now under discussion it does not signify that the prior patent has expired; (*k*) but if an invention has only received provisional protection it cannot be made an objection to a later application.(*l*)

Invention described, but not claimed in a prior patent.

If an invention is only described and not claimed in a prior

(*f*) Green's Patent, (1885) Griff. P. C. 286. In the Matter of Haythornthwaite's Application, (1890) 7 R. P. C. 70.

(*g*) p. 308 *ante*. In the Matter of Anderson and Anderson's Patent, (1890) 7 R. P. C. 323. (*h*) s. 4.

(*i*) Bartlett's Patent, (1892) 9 R. P. C. 511.

(*k*) Lancaster's Patent, (1884) Griff. P. C. 293.

(*l*) Bailey's Patent, (1884) Griff. P. C. 269; Patterson's Patent, Griff. P. C. 295.

specification, it may be patented on an application of later date, it being a long-established and obvious rule that only that is patented which the inventor claims.(*m*) There would, of course, be great doubt as to the validity of a patent granted under such circumstances.(*n*)

Opposition—Second Ground.

The question of the validity of the prior patent, which is said by the opponent to cover the whole or a part of the applicant's claim, is quite immaterial.(*o*) An applicant, however, is entitled to contend that the state of common knowledge is such that the opponent's claim ought to be read in a particular way which will exclude the subject-matter of the applicant's claim.(*p*)

Ambit of opponent's claim may be disputed.

The point always is, Has what the applicant claims been already granted by the Crown, i.e., formed the subject of a prior claim or claims? No doubt it would require a very clear case to stop a patent when it is sought to establish this ground of opposition by putting together claims taken from two separate prior specifications, but still it is submitted this might be done.(*q*)

In cases where the law officer is forced to the conclusion that there is no substantial difference between the invention or combination claimed in the applicant's specification and an earlier specification it has not only been the practice but it is the duty of the law officer to refuse the patent.(*r*) For example, when the applicant merely claimed to effect a certain result by the use of one of many salts of chromium and one of many salts of iron from out of those covered by the claim on the opponent's specification, and there was no particular advantage shown in doing so, the patent was refused.(*s*)

Patent is refused when there is no appreciable difference between the applicant's and opponent's claims.

When an application is opposed on the ground that an alleged invention is the same as that comprised in the opponent's patent, and it appears that there is a difference, but that such difference is quite immaterial, the patent is refused.(*t*)

(*m*) Von Buch, (1887) Griff. L. O. C. 40.

(*n*) See chap. iii.

(*o*) Thornborough and Well's Patent, (1896) 13 R. P. C. 115.

(*p*) Haythornthwaite's Patent, (1890) 7 R. P. C. 71.

(*q*) Ross' Patent, (1891) 8 R. P. C. 477.

(*r*) Per Webster, A.-G., Todd's Patent, (1892) 9 R. P. C. 488; see also Thwaites' Patent, (1892) 9 R. P. C. 515; Daniels' Patent, (1888) 5 R. P. C. 413; Aire and Calder's Patent, (1888) 5 R. P. C. 345; Wallis and Redcliff's Patent, (1888) 5 R. P. C. 347; Webster's Patent, (1888) 6 R. P. C. 163; Bailey's Patent, (1887) Goodeve P. C. 57; Boult's Patent, (1893) 10 R. P. C. 275.

(*s*) Wylie's Patent, (1896) 13 R. P. C. 97; see p. 35 *ante*, as to selection from a class being the subject-matter of invention.

(*t*) In the Matter of Aire and Calder's Patent, (1888) 5 R. P. C. 345; Wallis and Ratcliffe's Patent, (1888) 5 R. P. C. 347; in the Master

Opposition—Second Ground.

In *Hedge's Patent*,(*u*) it appeared that after eliminating matters of common knowledge nothing in the slightest degree materially different remained to distinguish the applicant's claim from the opponent's that could possibly be valid subject-matter, and the patent was refused accordingly. This case was somewhat unusual. The general course in such a case is to grant the patent subject to a disclaimer,(*x*) though, no doubt, the implication in the Act is that in some cases the Comptroller or law officer must take the responsibility of judging whether or not the invention is the same, and he must look to substance and not be influenced by mere verbal changes in the specifications.(*y*)

Mechanical equivalents.

It is competent to the Comptroller or law officer, when an application is opposed on the ground that the invention has been patented on an application of prior date, to consider the question of mechanical equivalents; (*z*) though the application will not be refused unless it is clear that the invention in respect of which it is made is practically identical with that forming the subject-matter of the prior patent(*a*)—*e.g.*, where the only difference was the substitution of a coil for an internal cylinder in a heating apparatus,(*b*) or an equivalent for a crank bar(*c*) when the opponent's claim referred to a "crank bar or its equivalent."

When a would-be patentee has good subject-matter, which is not identically the same as that comprised in a prior patent, he is entitled to have his patent sealed, though an action for infringement may lie against him if he puts his alleged invention into practice.(*d*)

Object of the power to refuse the patent, or to require an amendment or a disclaimer.

It is the duty of the Comptroller and the law officer, on appeal from him, to see that no claim in an applicant's specification is allowed which is wide enough to include something which might unquestionably form part of that which is claimed in a prior specification relied on by the opponent.(*e*) This principle is given effect to by disallowing the claim, or by ordering the claim as originally drawn to be modified, or a general or special

of Daniel's Application, (1888) 5 R P. C. 413; In the Matter of Haythornthwaite's Application, (1890) 7 R. P. C. 70; Heath and Frost's Patent, (1886) Griff. P. C. 310.

(*u*) (1895) 12 R. P. C. 136.

(*x*) See Marsden's Patent, (1897) 14 R. P. C. 174.

(*y*) Boult's Patent, (1893) 10 R. P. C. 275.

(*z*) In the Matter of Haythornthwaite's Application, (1890) 7 R. P. C. 70.

(*a*) p. 321 *ante*.

(*b*) Smith's Patent, (1896) 13 R. P. C. 200.

(*c*) Whittaker's Patent, (1896) 13 R. P. C. 580.

(*d*) In the Matter of Newman's Patent, (1888) 5 R. P. C. 271.

(*e*) Curtis and André's Patent, (1892) 9 R. P. C. 499.

Opposition—Second Ground.

disclaimer of the principle embodied in the prior patent to be inserted in the applicant's specification.(*f*)

The exercise of the authority of the Comptroller and law officer to impose conditions on the grant of a patent in this way operates for the protection of previous inventors (*g*) and the public generally.(*h*)

If a subsequent patent be granted and a specification accepted which actually or apparently claims something which is included in a prior patent, or something which is not patentable, the prior patentee in the one case, or the public in the other, suffers what may be a disadvantage to them, in so far as the subsequent patentee may endeavour under his grant to lay claim to the exclusive monopoly in the particular thing in question, yet they do not sustain any permanent injury, for the subsequent patent granted under such circumstances would be void.(*i*)

It is not to the interests of subsequent patentees that their patents should be apparently for an original invention, when, as a matter of fact, they can only claim a particular combination which they have described; and it is not to the interest of the public that they should be led into supposing that a description in a specification is entirely general, whereas it can only be supported as a specification of valid letters patent if the description be understood to be a description of an improvement.(*k*)

Grounds for requiring a disclaimer.

The Comptroller and law officer, in deciding upon the propriety or impropriety of inserting a disclaimer in the applicant's specification, are in no way whatever concerned with the question whether the applicant's claim amounts to an infringement of the opponent's patent or not. And it is not their duty to stop a patent at the instigation of an opponent because some principle of patent law may be infringed.(*l*) Thus when the opponent desired a special reference in the applicant's specification on the ground that a claim in the prior specification amounted to a legitimate broad claim to a principle as carried out by the means described by the applicant, which were analogous to those claimed in the opponent's specification, the

(*f*) Curtis and André's Patent, (1892) 9 R. P. C. 495.

(*g*) In the Matter of Newman's Patent, (1888) 5 R. P. C. 271; Griff. L. O. C. 40.

(*h*) In the Matter of Lorrain's Patent, (1888) 5 R. P. C. 142; In the Matter of Guest and Barrow's Patent, (1888) 5 R. P. C. 312; Teague's Patent, (1884) Griff. P. C. 298.

(*i*) Chap. iii. *ante*. In the Matter of Hill's Application, (1888) 5 R. P. C. 599.

(*k*) Hoskins' Patent, (1884) Griff. P. C. 291; In the Matter of Newman's Patent (2), (1888) 5 R. P. C. 279.

(*l*) Newman's Patent, (1887) 5 R. P. C. 277; McHardy's Patent, (1891) 8 R. P. C. 432; Todd's Patent, (1892) 9 R. P. C. 487.

Opposition—Second Ground.

law officer allowed the patent without disclaiming clause at all.(*m*) To obtain a disclaimer the opponent must show that the applicant's claim, without it, will be a repetition of the opponent's.(*n*)

That is to say, it is a principle recognised by the law officers that where there is an existing patent, and there is fair ground for supposing that on the true construction a claim made by a subsequent applicant would interfere with the rights claimed by an existing patentee, he is entitled to be protected; and such protection is usually given by the insertion in the specification of the subsequent applicant of a general disclaiming clause or special reference.(*o*)

It would appear that, if there be a distinct reference in the applicant's provisional specification to an invention or device, which was within the specification of the opponent properly construed, the opponent is entitled to have a disclaimer on the face of the complete specification.(*p*)

It is to the interests of the public that, where patents overlap, the distinctions between the inventions described in the specifications filed under the earlier and later applications should be made clear;(*q*) but it must be remembered that the object of a disclaiming clause is to guard against the inclusion in a new patent of something embraced by the old patent, not of something merely mentioned in the old patent, but of something which has been claimed as part of the previous invention.(*r*)

Thus in *Guest* and *Barrow's Patent* (*s*) *Webster*, A.G., said:—

"I have on many occasions pointed out that the insertion of these disclaimers does not affect the rights of the prior patentee at all. They are inserted for the purpose of preventing the subsequent patentee from alleging that his invention is wider than he is entitled to claim, both in his own interests, in order

(*m*) Marsden's Patent, (1896) 13 R. P. C. 87.

(*n*) Stell's Patent, (1891) 8 R. P. C. 236; Hill's Patent, (1888) 5 R. P. C. 599.

(*o*) In the Matter of Newman's Patent, (1888) 3 R. P. C. 271; In the Matter of Hall and Hall's Patent, (1888) R. P. C. 283; In the Matter of Lynde's Patent, (1888) 5 R. P. C. 663; In the Matter of Gozney's Patent, (1888) 5 R. P. C. 597; In the Matter of Guest and Barrow's Patent, (1888) 5 R. P. C. 312; In the Matter of Wallace's Patent, (1889) 6 R. P. C. 134; Anderson and McKinnell, (1887) Griff. L. O. C. 23; In the Matter of Hoffman's Patent, (1889) 7 R. P. C. 92.

(*p*) Hookam, (1887) Griff. L. O. C. 32; see also in the Matter of Hoffman's Patent, (1890) 7 R. P. C. 92.

(*q*) In the Matter of Hill's Application, (1888) 5 R. P. C. 599.

(*r*) In the Matter of Gozney's Patent, (1888) 5 R. P. C. 597; in the Matter of Hoffman's Patent, (1890) 7 R. P. C. 92.

(*s*) (1888) 5 R. P. C. 312.

Opposition—Second Ground.

that his specification may not be considered as being too wide, and in the interests of the public, on the ground that the public are entitled to know what a subsequent patentee may claim, and to have a fair description of the existing state of knowledge. It is not because a particular patentee, or a prior inventor, has made a broad claim that he is entitled to have limiting words inserted, unless he can show, upon a fair view of the evidence before the law officer, or before the Comptroller, that such words are really necessary to protect him."(*t*)

Special references and concurrent applications.

There is no reported case of a special reference having been ordered where the application of the opponent, though prior to, is practically concurrent with that of the applicant, and *Webster*, A.G., has recently pointed out that the considerations above referred to do not apply in the case of concurrent applications, and reserved the decision of the question as to what are the proper disclaimers or references to be inserted in the case of concurrent applications till the matter has to be decided for the purposes of a particular case.(*u*) As a rule concurrent applicants might be expected to agree on the matter to their mutual advantage.(*x*)

References to defects.

Where a specification only contains a statement of general knowledge, there is nothing in the Patent Law to prevent a patentee on the face of his specification referring to the general defects which he alleges rightly or wrongly exist; but it would appear that, if a prior patentee is referred to specifically in a subsequent specification, no reference to any defect in the prior invention ought to be allowed in the latter specification.(*y*)

When special disclaimers are required.

The Comptroller and law officers are always very unwilling to order the insertion of a special reference to the patent of a prior inventor and opponent, unless they can be sure that they have the whole knowledge of the trade before them, and that there are no other specifications which claim part of the ground claimed by the applicant (*z*)—*e.g.*, where it is practically admitted by the applicant that the governing principle was for the first time discovered or disclosed in the opponent's specification.(*a*)

That is to say, an opponent, who is prior patentee, has no

(*t*) See also Newman's Patent, (1888) 279, 281; In the Matter of Hoffman's Patent, (1890) 7 R. P. C. 92.

(*u*) Gough's Patent and Greenhalgh's Patent, (1897) 14 R. P. C. 388.

(*x*) *Ibid.*

(*y*) Guest and Barrow's Patent, (1888) 5 R. P. C. 316.

(*z*) See Stell's Patent, (1891) 8 R. P. C. 236; Kilner's Patent, (1889) 8 R. P. C. 35.

(*a*) Welch's Patent, (1891) 8 R. P. C. 442.

Opposition—Second Ground.

right to be specially named in a disclaiming clause in the specification of a subsequent patent unless the applicant is willing to name him, or unless it is clear that there is no other prior publication than the specification of the opponent.(*b*)

General disclaimers are more usually required than special disclaimers.

The Comptroller and law officer usually prefer to insert a general disclaimer of the principle included in the invention of the prior patentee,(*c*) bearing in mind that every prior patentee does not possess a right to have a disclaiming clause inserted in a subsequent specification, because, as was pointed out by Lord *Cairns*, every specification must be read as though the patentee had a knowledge of every previous complete and published specification of earlier letters patent.(*d*)

The legitimate objects for which general and special disclaimers are ordered.

Disclaimers and especially special disclaimers ought not to be ordered for the mere purpose of making earlier patents known, but only for the purpose of explaining what the claim of the applicant really is. A claim may be so general in its terms as to include something which has been the subject of a prior grant, as well as the improvement which the applicant has, or thinks he has, invented. It is in such a case, where it might be the duty of the Comptroller and law officer to refuse the patent altogether, unless the claim were amended in such a way as to show that it is not directed to the matters which have formed the subject of the prior grant or grants, that a special disclaimer referring *nominatim* to the prior patent or patents should be ordered. The special disclaimer is only a substitute for the more scientific way of altering the language of the claim itself to the form it ought to have assumed if it had been skilfully drawn in the first instance, having regard to the prior patent or patents.(*e*)

In cases, therefore, where the rights of prior patentees cannot be effectually protected without special mention of the prior patents, the insertion of a special disclaimer is usually made a condition of the granting of a patent to a subsequent applicant, and the form of reference generally ordered is to the effect that the patentee is aware of the existence of the prior patent, and that he does not claim anything claimed and described there-

(*b*) Teague's Patent, (1884) Griff. P. C. 298; Guest and Barrow's Patent, (1888) 5 R. P. C. 312; Brownhill's Patent, (1889) 6 R. P. C. 135.

(*c*) Anderson and McKinnell, (1887) Griff. L. O. C. 23; In the Matter of Sielaff's Application, (1888) 5 R. P. C. 484; In the Matter of Wallace's Patent, (1889) 6 R. P. C. 134; Kilner's Patent, (1889) 8 R. P. C. 35.

(*d*) See In the Matter of Newman's Patent, (1888) 5 R. P. C. 279.

(*e*) Marsden's Patent, (1896) 13 R. P. C. 87; Adam's Patent, (1896) 13 R. P. C. 548; Marsden's Patent, (1897) 14 R. P. C. 174.

in.(*f*) So also in the case of concurrent applications and cross oppositions, if it appear that the specification of one of the applicants includes something which is the sole invention of the other applicant the Comptroller will insist on the first applicant amending his specification so as to confine it to what has actually been invented by him.(*g*)

Opposition—Second Ground.

On the same principle, if an invention is merely an improvement on and subsidiary to a prior patented machine or process, the Comptroller and law officer will require a disclaimer by reference to the name and number of the prior patent, since it is only just to the opponent and in the interests of the public that this should be so.(*h*)

The Comptroller and law officer are bound to protect the public from being misled;(*i*) and the object for which special references to prior patents are ordered to be inserted in the applicant's specification is to guide the public to the proper construction of the claim made by the applicant.(*k*) So a special disclaimer may be ordered for the purpose of removing an ambiguity.(*l*) If, on the other hand, a special disclaimer might prejudice the construction a mere reference to the prior patent will be ordered instead (*m*)—*e.g.*, in a case where neither the Comptroller nor the law officer could come to a clear conclusion that the invention had been patented on the application of prior date relied on, and the Comptroller had ordered a special disclaimer in the words, "We are aware of the specification of patent No. of granted to , *and we make no claim to anything described and claimed therein*," the law officer, on appeal, to meet the justice of the case and the public interest, ordered the words, "*and we make no claim to anything described and claimed therein*," to be struck out.(*n*) A special disclaimer may be ordered on the ground that though

(*f*) In the Matter of Lorrain's Patent, (1888) 5 R. P. C. 142; In the Matter of Airey's Patent, (1888) 5 R. P. C. 348; In the Matter of Lynde's Patent, (1888) 5 R. P. C. 663; In the Matter of Newman's Patent, (1888) 5 R. P. C. 271; In the Matter of Wallace's Patent, (1889) 6 R. P. C. 134; Hoskins' Patent, (1884) Griff. P. C. 291; Welch's Patent, (1884) Griff. P. C. 300.

(*g*) Paterson's Patent, (1884) Griff. P. C. 295; Craig and Macfarlane's Application, P. M. J. vol. iv. 3rd series, p. 366.

(*h*) Hoskins' Patent, (1884) Griff. P. C. 291; Welch's Patent, (1884) Griff. P. C. 300; In the Matter of Newman's Application, (1888) 5 R. P. C. 271, 279; In the Matter of Lynde's Patent, (1888) 5 R. P. C. 663; Levinstein's Patent, (1894) 11 R. P. C. 349; Tattersall's Patent, (1892) 9 R. P. C. 150.

(*i*) Lorrain's Patent, (1888) 5 R. P. C. 143.

(*k*) Van Gelder's Patent, (1892) 9 R. P. C. 326; p. 322 *ante*.

(*l*) Brand's Patent, (1895) 12 R. P. C. 102.

(*m*) Van Gelder's Patent, (1892) 9 R. P. C. 325; Maxim and Silverman's Patent, (1894) 11 R. P. C. 314.

(*n*) Maxim and Silverman's Patent, (1894) 11 R. P. C. 314.

Opposition—Second Ground.

in the applicant's specification there are differences from the opponents, yet there is a very strong resemblance between the mechanism as claimed by the opponent's specification and described in the applicant's specification and drawings.(*o*)

Speaking generally, a special reference, at the request of the opponent, to a prior patent ought to be allowed only, if in the event of the insertion of that reference being refused by the applicant the Comptroller or law officer would be justified in saying that the patent with the proposed claim should not be sealed at all.(*p*) Sometimes the opponent is allowed to elect whether the objectionable claim of the applicant should be struck out or a disclaiming clause should be inserted in his specification.(*q*)

A special reference will sometimes tend to stop further litigation where a general disclaimer would not, and will be ordered to be inserted on that account.(*r*)

Agreement between parties as to the meaning of a specification.

If the meaning of a specification be ambiguous, the Comptroller or law officer may, on the hearing of the application, order it to be placed on record to what the specification is understood to be confined by the statement and agreements of both the opposer and applicant;(*s*) and, if the provisional specification contain a reasonably clear indication of the improvement it is ultimately desired to protect by the patent, the Comptroller has power to order any amendment which will put the particular description of the invention claimed absolutely beyond doubt.(*t*)

Striking out claims.

Sometimes a claim in an applicant's specification is ordered to be struck out altogether, when it includes something claimed by the complete specification under a prior patent;(*u*) but it must be remembered that the applicant is entitled to frame his specification as he pleases, so long as he does not interfere with existing rights.(*x*) The Comptroller or law officer has no authority to order a claim to be struck out merely because he may invite the public to infringe a prior patent, if the applicant, in the body of the specification, shows some invention with regard to the thing claimed.(*y*) Nor can the Comptroller or

(*o*) Thornborough and Wilks' Patent, (1896) 13 R. P. C. 115.

(*p*) Per Finlay, S.-G., Marsden's Patent, No. 2, (1897) 14 R. P. C. 174; see also Stell's Patent, (1891) 8 R. P. C. 235; p. 326 *ante*.

(*q*) Teague's Patent, (1885) Griff. P. C. 298.

(*r*) In the Matter of Lynde's Patent, (1888) 5 R. P. C. 663.

(*s*) Anderton, (1887) Griff. L. O. C. 25.

(*t*) Chandler's Patent, (1884) Griff. P. C. 270, 274.

(*u*) In the Matter of Hall and Hall's Patent, (1888) 5 R. P. C. 283; In the Matter of Webster's Patent, (1889) 6 R. P. C. 163.

(*x*) See p. 302 *ante*.

(*y*) In the Matter of Webster's Patent, (1889) 6 R. P. C. 165.

law officer require the amendment of a claim in order to make it conform to the description in the specification, if the claim is otherwise a real statement of the invention claimed.(*z*)

Opposition—Third Ground.

The applicant should draft his claim in the first instance so as to embrace only his real invention. If he does not do so, he runs the risk, in the event of opposition, of not being allowed to make such an extensive amendment as might be required to remedy a defective claim, or to remedy the claim by the less scientific method of inserting a special reference to the opponent's patent.(*a*)

Thus, in a recent case the law officer refused to seal a patent when the applicant's specification contained a claim wide enough to include, without doubt, what had been patented by the opponent; and he further refused to allow a special disclaimer or words limiting the claim, on the express ground that the claim should have been drawn originally for the slight alleged improvement if the intention was to claim it.(*b*)

Appeal may be limited to the question of a special reference.

An opponent, though not appealing against the grant of a patent, is entitled to appeal against the Comptroller's decision that no reference to his patent be inserted in the specification.(*c*)

III. *That the complete specification describes and 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.*

When disconformity is a ground for refusing the patent.

A disconformity between the complete and provisional specifications is fatal to the validity of the grant of letters patent, as has been already demonstrated.(*d*) Disconformity, however, will not induce the Comptroller and law officer to refuse to seal a patent, unless in accordance with the above-stated ground of objection (which was created by sec. 4 of the Act of 1888) (*e*) the matter in the applicant's complete specification which is in excess of the provisional has, in the interval between the leaving of the two documents, formed the subject of an application by the opponent.

(*z*) Smith's Patent, (1884) Griff. P. C. 268.
(*a*) See Whittaker's Patent, (1896) R. P. C. 58.
(*b*) Lupton and Place's Patent, (1897) R. P. C. 261.
(*c*) Brownhill's Patent, (1889) 6 R. P. C. 135.
(*d*) p. 168 *ante*. (*e*) See Appendix.

Sealing the Patent.

When this objection is raised it is the duty of the Comptroller or law officer to ascertain what is the real and proper construction of the language of the provisional specification, and not to accept any meaning suggested by the applicant which the document itself will not bear out.(*f*) It then becomes important to ascertain whether the alleged excess invention is really only a legitimate development of the invention to be found described in the provisional,(*g*) or whether it is really a different one, and the same as that forming the subject of the opponent's subsequent application. If it is only a legitimate development the opposition will fail.(*h*)

Wilson's Patent (*i*) affords a good illustration of this ground of opposition. In that case the invention related to bicycle tyres, and the applicant's provisional specification described various combinations of parts for the construction of tyres, but did not allude to any method or methods of fastening the tyres to the wheels. The complete specification, on the other hand, described the tyres as fitted to specially constructed wheel rims with special means for fastening the tyres, and the rims, combined with the methods of fastening, were the subjects of claims. The grant was opposed by four different opponents, who had, between the dates of the filing of the applicant's provisional and complete specification, made applications for patents for the various methods of attachment claimed in the applicant's complete specification. The Comptroller ordered the excision of the figures and drawings and of the corresponding description and claims referring to the methods of fastening the tyres to the wheels. The law officer on appeal somewhat varied the Comptroller's decision, but required that the complete specification should be amended so as to prevent the applicant from claiming as a part of his invention the means of fastening the tyres to the wheels as distinct from the construction of the tyres themselves.

Sealing the Patent.

Seal of the Patent Office.

If there be no opposition, or if there be opposition, and the determination is in favour of the applicant, the Comptroller is required, by the Act of 1883,(*k*) as soon as may be, to cause a patent to be sealed with the seal of the Patent Office, which is

(*f*) Birt's Patent, (1892) 9 R. P. C. 489.
(*g*) See p. 166 *ante*.
(*h*) Edward's Patent, (1894) 11 R. P. C. 461.
(*i*) (1892) 9 R. P. C. 512. (*k*) s. 12.

equivalent for this purpose to the Great Seal of the United Kingdom.(*l*)

Sealing the Patent.

A patent cannot be sealed after the expiration of fifteen months from the date of application,(*m*) except in the following cases:—

Time within which the patent must be sealed.

(1) When the sealing is delayed by an appeal to the law officer, or by opposition to the grant of the patent, in which case the patent may be sealed at such time as the law officer may direct.(*n*)

(2) If the person making the application dies before the expiration of fifteen months from the date of application, in which case the patent may be granted to his legal representative, and sealed at any time within twelve months after the death of the applicant.(*o*)

(3) Where the Comptroller has granted an extension of time for the leaving and accepting of a complete specification, in which case a patent may be sealed within nineteen months from the date of the application.(*p*)

In the case of delay caused by opposition, a patent may be sealed at such time as the law officer appoints, even though the opposition is not adjudicated upon till after the expiration of fifteen months from the date of the application;(*q*) the case, however, is different when the delay is caused by the applicant. Thus, where there was an opposition which caused some delay, and the applicant by mere inadvertence neglected to comply with the Comptroller's requisition till long after fifteen months from the application, the law officer refused to seal the patent on the ground that the delay was not caused by the opposition.(*r*)

It is expressly enacted that every patent shall be dated and sealed as of the day of the application: Provided that, in the case of more than one application for a patent for the same invention, the sealing of a patent on one of those applications shall not prevent the sealing of a patent on an earlier application.(*s*)

Before the Act of 1883, where there was more than one applicant for a patent for the same invention, the applicant who first obtained the Great Seal was held to be entitled to the benefit of it, and the patent of any other applicant, if

(*l*) 46 & 47 Vict. c. 57, s. 12, sub-s. 2.
(*m*) *Ibid.* sub-s. 3.
(*n*) *Ibid.*
(*o*) *Ibid.*
(*p*) 48 & 49 Vict. c. 63, s. 3.
(*q*) *Re* Somerset and Walker's Patent, (1879) L. R. 13 Ch. D. 397; *Re* Johnson's Patent, (1879) L. R. 13 Ch. D. 398 n.
(*r*) A. & B.'s Patent, (1896) 13 R. P. C. 63.
(*s*) 46 & 47 Vict. c. 57, s. 13.

Extent and Duration of Letters Patent.

granted at all, was dated subsequently.(*t*) Such is not the case now, for the patent of each applicant (if granted) must bear the date of the application, and consequently the first applicant is the one who gets the real benefit of the invention; for where there is more than one patent for the same invention, anything done under those subsequently dated is an infringement of that which bears the earliest date.(*u*) Formerly, however, in cases where there was evidence of *mala fides* the patent of a second applicant was ordered to be dated before that of the prior applicant.(*x*) The reason was that the Crown will not grant a second patent in derogation of its own grant, and the system of ante-dating enabled the question of validity to be decided in subsequent proceedings.(*y*)

Extent and Duration of Letters Patent.

Geographical extent.

Every patent when sealed has effect throughout the United Kingdom and the Isle of Man,(*z*) and the term for which every patent is granted originally is fourteen years,(*a*) which may however, in certain cases, be prolonged on petition to her Majesty in Council.(*b*) The time from which a patent runs dates from, and includes, the day on which the patent is dated.(*c*)

Conditional on payment of renewal fees.

A patent is conditional on the patentee making the prescribed payments within the prescribed times,(*d*) and ceases if he fail to do so.(*e*)

Enlargement of time for payment of fees.

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, and the Comptroller is required, if he is satisfied that the failure has arisen from any of the above causes, on receipt of the prescribed fee for enlargement,(*f*) not exceeding ten pounds, to enlarge the time accordingly, subject to the following conditions:—

(*t*) *Ex parte* Bates and Redgate, (1876) L. R. 4 Ch. 577, 580; see p. 8 *ante*.

(*u*) Saxby *v.* Hennett, (1873) L. R. 8 Ex. 210.

(*x*) *Ex parte* Scott and Young,(1871) L. R. 6 Ch. 274; Saxby *v.* Hennett, (1873) L. R. 8 Ex. 210; *Re* Vincent's Patent, (1867) L. R. 2 Ch. D. 341.

(*y*) *Ex parte* Bailey, (1872) L. R. 8 Ch. 61; *Ex parte* Henry, (1872) L. R. 8 Ch. 167, 169; *Ex parte* Bates and Redgate, (1869) L. R. 4 Ch. 577.

(*z*) 46 & 47 Vict. c. 57, s. 16.

(*a*) *Ibid.* s. 17.

(*b*) *Ibid.* s. 25; chap. xi.

(*c*) Russell *v.* Ledsam, (1847) 14 M. & W. 574.

(*d*) 46 & 47 Vict. c. 57, s. 24; P. R. (1890) rr. 45, 46.

(*e*) 46 & 47 Vict. c. 57, s. 17 (2).

(*f*) See Appendix.

Extent and Duration of Letters Patent.

(a) The time for making any payment shall not in any case be enlarged for more than three months.

(b) If any proceeding shall be taken in respect of an infringement of the patent committed after a failure to make any payment within the prescribed time, and before the enlargement thereof, the Court before which the proceeding is proposed to be taken may, if it shall think fit, refuse to award or give any damages in respect of such infringement.(*g*)

An application for enlargement of the time for making a prescribed payment must state in detail the circumstances in which the patentee, by accident, mistake, or inadvertence, had 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.(*h*)

Whenever the last day for leaving any document, or paying a fee, at the Patent Office falls on Christmas Day, Good Friday, or on a Saturday or Sunday, or on a day observed as a holiday at the Bank of England, or on any day observed as a public fast or thanksgiving, the documents may be left, or the fee may be paid, on the day next following any of these days.(*i*)

Revival of patent void through non-payment of fees.

If a patentee fails to make a prescribed payment, whether he has obtained an enlargement of time or not, his patent is void and can only be revived by a special Act of Parliament.(*k*) A special Act will most probably not be obtained unless it is made clear that the renewal fees were not paid in consequence of the serious illness of the patentee,(*l*) and if a special Act is passed it will most probably provide protection for persons who may have used the subject-matter of the invention after the notice of the lapsing of the patent.(*m*)

Effect on British patent of lapse of foreign patent.

Under the Act of 1853 (*n*) letters patent, obtained in the United Kingdom for inventions already patented abroad, did not continue in force after the expiration of the foreign patent. This provision was repealed by the Act of 1883, but the effect of s. 113, which provides that the past operation of any Act

(*g*) 46 & 47 Vict. c. 57, s. 17 (3) (4).
(*h*) P. R. (1890) r. 49.
(*i*) 46 & 47 Vict. c. 57, s. 98.
(*k*) *E.g.*, Wright's Patent Act, (1884) Boult's Patent Act, (1885); Bradbury and Leman's Patent Act, (1884); Auld's Patent Act, (1885); Potter's Patent Act, (1887). See also Appendix A. to Report of Select Committee on Potter's Patent Bill [H. L.], Skrivanow's Patent Bill [H. L.] and Gilbert and Sinclair's Patent Bill [H. L.].
(*l*) See Report of Select Committee on Potter's Patent Bill [H. L.], Skrivanow's Patent Bill [H. L.], and Gilbert and Sinclair's Patent Bill; Worms and Bale's Patent Act (1891).
(*m*) *Ibid.*; Appendix A., Potter's Patent Act, (1887); Worms and Bale's Patent Act, (1891).
(*n*) s. 25.

Extent and Duration of Letters Patent.

repealed shall not be affected, is to render it still a fatal objection to the validity of any patent in the United Kingdom, dated earlier than January 1, 1884, that there was a prior foreign patent for the same invention which expired before that date.

Confirmation of letters patent dated prior to January 1, 1884.

The Act of 1834 was repealed by the Act of 1883, but all rights and privileges of patentees in respect of patents granted prior to the Act of 1883 were preserved by that Act, and are still subsisting.(*o*) One of the rights and privileges of a patentee under letters patent granted prior to January 1, 1884, the date on which the Act of 1883 came into operation, is that provided by the repealed Act of 1834, viz:—

> "If in any suit or action it shall be proved, or specially found by the verdict of a jury, that any person who shall have obtained letters patent for any invention or supposed invention was not the first inventor thereof, or of some part thereof, by reason of some other person or persons having invented or used the same, or some part thereof, before the date of such letters patent, or, if such patentee or his assignees shall discover that some other person had, unknown to such patentee, invented or used the same, or some part thereof, before the date of such letters patent, it shall and may be lawful for such patentee or his assigns to petition his Majesty in Council to confirm the said letters patent, or to grant new letters patent, the matter of which petition shall be heard before the Judicial Committee of the Privy Council; and such Committee, upon examining the said matter and being satisfied that such patentee believed himself to be the first and original inventor, and being satisfied that such invention, or part thereof, had not been publicly and generally used before the date of such first letters patent, may report to his Majesty their opinion that the prayer of such petition ought to be complied with, whereupon his Majesty may, if he think fit, grant such prayer; and the said letters patent shall be available in law and equity to give to such petitioner the sole right of using, making, and vending such invention as against all persons whatsoever, any law, usage, or custom to the contrary thereof notwithstanding: Provided that any person opposing such petition shall be entitled to be heard before the said Judicial Committee: Provided also, that any person, party to any former suit or action touching such first letters patent, shall be entitled to have notice of such petition before presenting the same."(*p*)

(*o*) In the Matter of Brandon's Patent, (1884) 1 R. P. C. 154

(*p*) 5 & 6 Will. IV. c. 83, s. 2. The following reported cases relate to petitions presented under this section: Heurteloup's Patent, (1836) 1 W. P.

Journal and Report of Cases.

Confirmation may still be applied for in the case of patents granted prior to January 1, 1884, but the privileges conferred by the Act of 1883 cannot be called in aid by the petitioner. The old law is applicable to such cases. Thus, if the British patent was obtained subsequently to a foreign patent, the British patent, since it expired with the foreign patent, cannot be resuscitated by petition for confirmation, the provisions of the Act of 1883 to the effect that British patents do not now expire with prior foreign patents not being applicable to those granted prior to January 1, 1884.(*q*)

Application in fraud of true and first inventor.

S. 35 of the Act of 1883 enacts that 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.

Duplicates of letters patent.

In the event of a patent being lost or destroyed, or its non-production being accounted for to the satisfaction of the Comptroller, the Comptroller has authority at any time to cause a duplicate to be sealed.(*r*)

Adverse decision in action of infringement does not annul the patent.

A decision in an action brought upon a patent to the effect that a claim in the specification cannot be supported does not annul the patent.(*s*) Such a decision is not an order for revocation, but merely a decision that the specification is bad as it stands. The defect may well be one capable of being cured by amendment,(*t*) in which case fresh actions might be brought upon the patent after amendment.(*u*)

Illustrated Journal and Report of Cases.

Illustrated journal and reports of cases.

The Comptroller is required to cause to be issued periodically an illustrated journal of patented inventions, as well as reports of cases decided by Courts of law, and any other information that he may deem generally useful or important.(*x*) The Comptroller is also required to keep on sale copies of the illustrated journal, and all complete specifications of patents for the time being in force; and to prepare and publish indexes,

C. 553; Westrupp and Gibbin's Patent, (1836) 1 W. P. C. 554; In the Matter of Card's Patent, (1848) 2 W. P. C. 161; In the Matter of Lamenaude's Patent, (1850) 2 W. P. C. 164; Honiball's Patent, (1854) 2 W. P. C. 201.

(*q*) Jablochkoff's Patent, (1891) 8 R. P. C. 281.

(*r*) 46 & 47 Vict. c. 57, s. 37; P. R. (1890) Form N.

(*s*) Deeley's Patent, (1894) 11 R. P. C. 75.

(*t*) See chap. vi. *ante*.

(*u*) p. 274 *ante*.

(*x*) 46 & 47 Vict. c. 57, s. 40.

Patent Office Museum. Register of Patents.

abridgments of specifications, catalogues, and other works relating to inventions, as he may see fit.(*y*)

Patent Office Museum.

Patent Office Museum.

The control and management of the Patent Museum is vested in the Department of Science and Art, subject to such directions as her Majesty in Council may see fit to give.(*z*)

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.(*a*)

Register of Patents.

Register of Patents under Act of 1883.

The Act of 1883 (*b*) provides that 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 licences under patents, and of amendments, extensions and revocations of patents, and such other matters affecting the validity of proprietorship of patents as may from time to time be prescribed. Such other matters include applications for amendments of specifications and notices of oppositions thereto, as well as the decisions of the Comptroller and law officer; requests for entry of notifications of assignments, licences, Orders in Council affecting the patent; certificates of enlargements of time within which renewal fees may be paid; and notifications of the expiration of patents.

The Register of Patents is *prima facie* evidence of any matters by the Act directed or authorised to be inserted therein. Copies of dates, licences, and any of the documents affecting the proprietorship in any letters patent, or in any licence thereunder, must be supplied to the Comptroller, in the prescribed manner, for filing in the Patent Office.(*c*)

It is provided that former registers of patents and of

(*y*) 46 & 47 Vict. c. 57, s. 40. The Illustrated Official Journal, comprising reports of the cases decided by the courts of law, the Comptroller, and the law officers, is at present published weekly. Cases decided before the Comptroller or the law officer ought not to be cited before the High Court of Justice or the Court of Appeal; Siddell *v.* Vickers, (1888) 5 R. P. C. 416, 436.

(*z*) 46 & 47 Vict. c. 57, s. 41.

(*a*) *Ibid.* s. 42.

(*b*) s. 23.

(*c*) P. R. (1890) rr. 67-69.

proprietors shall be deemed parts of the same book as the Register of Patents, kept under the Act of 1883 (*f*)

Register of Patents.

By s. 85 of the Act of 1883 (*g*) it is provided that no notice of any trust—expressed, implied, or constructive—is to be entered on the Register of Patents, nor is any such notice receivable by the Comptroller.(*h*)

Notices of trusts, as such, cannot be registered,

Where any person becomes entitled by assignment, transmission, or other operation of law, to a patent, it is the duty of the Comptroller on request, and on proof of title to his satisfaction, to cause the name of such person to be entered as proprietor of the patent in the Register of Patents; and the person for the time being entered in the Register of Patents as proprietor of a patent has, subject to the provisions of the Act 1883, and to any rights appearing from such register to be vested in any other person, power absolutely to assign, grant licences 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 may be enforced in like manner as in respect of any other personal property.(*i*)

The effect of this s. 85, read, as it must be, together with ss. 23 and 87, and the Patent Rules, 1890, rr. 68–76, is only to exclude from the register simple notices of trusts, but not documents affecting the proprietorship of a patent, whether by creating trusts or otherwise. Consequently equitable assignments of a patent, or of a share in a patent, may be entered on the register as documents affecting the proprietorship.(*j*)

but documents affecting the proprietorship —*e.g.*, equitable assignments—can be registered.

A document which creates neither a legal nor an equitable interest cannot be registered. Thus, a patentee wrote a letter agreeing to give an exclusive licence, and, the patentee and proposed licensee subsequently disagreeing as to whether the amount of royalty had been fixed by subsequent parol agreement, the licensee obtained an entry of the letter on the register. On subsequent motion for rectification of the register, *North*, J., held that, even assuming the royalty had been subsequently fixed by parol agreement, the letter itself did not give any legal or equitable interest in the patent, and could not be registered.(*k*)

Documents creating neither legal nor equitable interests cannot be registered.

(*f*) 46 & 47 Vict. c. 57, s. 114.
(*g*) p. 668 *post*.
(*h*) 46 & 47 Vict. c. 57, s. 85.
(*i*) 46 & 47 Vict. c. 57, s. 87; 51 & 52 Vict. c. 50, s. 21.
(*j*) Stewart *v.* Casey, (1891) 9 R. P. C. 9; in view of this case the decision in Haslett *v.* Hutchinson, (1891) 8 R. P. C. 457, would appear to be wrong.
(*k*) In the Matter of Fletcher's Patent, (1893) 10 R. P. C. 252.

Register of Patents.

Questions sometimes arise as to the entry on the register of documents dated prior to the patent.

Documents of earlier date than the patent.

For example, where it appeared that, before the date of a patent, the grantee and another person signed a document referring to certain proposed dealings with the ownership of patents to be obtained for a process said to be the invention for which a patent was subsequently granted, the Comptroller refused to enter this document on the Register of Patents, on the ground that it was dated before the grant of the patent; and this decision was upheld on motion to the Court, but upon the ground that the applicant did not appear to be entitled to any share in the patent.(*l*)

It would appear from the judgment in *Parnell's Patent*(*m*) that there may be documents dated before the grant of a patent which ought to be entered on the register after the patent is obtained, and that an agreement as to the ownership is such a document.

Registration is not notice to all persons.

Registration under the Act of 1883 of an exclusive licence for a limited area is not notice to the world, so as to affect defendants buying certain machines manufactured by the patentee outside the area,(*n*) and using them inside the area, without notice of the licence.

Registration fee.

A fee of ten shillings is charged in respect of each entry made in the Register of Patents,(*o*) and the procedure to be observed on the registration of documents is regulated by the Patent Rules, 1890, rr. 67–69.(*p*)

Inspection of Register.

The Register of Patents is at all convenient times open to the inspection of the public, subject to the provisions of the Act of 1883, and to the prescribed regulations,(*q*) and any person requiring it may obtain, on payment of the prescribed fee, a certified copy, sealed with the seal of the Patent Office, of any entry made in the register.(*r*)

Evidence of entries on the Register.

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, are admitted in evidence in all Courts in her Majesty's dominions, and in all proceedings, without further proof or production of the originals.(*s*)

(*l*) In the Matter of Parnell's Patent, (1888) 5 R. P. C. 126.
(*m*) (1888) 5 R. P. C. 128.
(*n*) Heap *v.* Hartley, (1888) 5 R. P. C. 603; 6 R. P. C. 495.
(*o*) See list of fees, Appendix.
(*p*) See Appendix.
(*q*) Patent Rules, (1890) r. 78.
(*r*) 46 & 47 Vict. c. 57, s. 88; 51 & 52 Vict. c. 50, s. 22.
(*s*) 46 & 47 Vict. c. 57, s. 89.

Register of Patents.

A certificate purporting to be under the hand of the Comptroller as to any entry, matter, or thing which he is authorised under the Act of 1883, or any general rules made thereunder, to make or do, is *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.(*t*)

Rectification of the Register.

The Court is empowered by s. 90 of the Act of 1883, as amended by s. 23 of the Act of 1888, 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 the register, or of any entry made without sufficient cause in the register, to 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. And the Court has power, in any proceedings under this section, to decide any question that it may be necessary or expedient to decide for the rectification of the register, and to direct an issue to be tried for the decision of any question of fact, and to award damages to the party aggrieved.

Any order of the Court rectifying the register must direct that due notice of the rectification be given to the Comptroller.(*u*) Where an order has been made by her Majesty in Council for the extension of a patent for a further time, or for the grant of a new patent,(*x*) or where an order has been made by the Court for the revocation of a patent or the rectification of the register under s. 90, or otherwise affecting the validity or proprietorship of the patent, the person in whose favour such order has been made is required forthwith to leave at the Patent Office an office copy of such order. The register will thereupon be rectified, or the purport of such order will otherwise be duly entered in the register, as the case may be.(*y*)

It is submitted that the Act of 1883 (*z*) gives the Court power to expunge any entry fraudulently made on the register, and to enter any facts relative to the ownership of a patent, but not any legal inference to be drawn from these facts. It was held that the corresponding section of the repealed Act of 1852 (*a*) gave such power to the Master of the Rolls alone.(*b*)

An appeal lies from any order made by the Court or a

(*t*) 46 & 47 Vict. c. 57, s. 96.
(*u*) 46 & 47 Vict. c. 57, s. 90, sub-s. 3.
(*x*) Chap. xi.
(*y*) P. R. (1890) r. 74.
(*z*) s. 90.
(*a*) s. 38.
(*b*) *Re* Morey's Patent, 25 Beav. 581; *Re* Green's Patent, (1857) 24 Beav. 145; *Re* Horsley and Knighton's Patent, (1869) L. R. 8 Eq. 475; *Re* Berdan's Patent, (1875) L. R. 20 Eq. 346.

Register of Patents.

Judge for the rectification of the register,(*c*) though formerly there was no appeal from the decision of the Master of the Rolls.

If any rectification of the Register of Patents 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 must be served on the Comptroller, who is required to rectify the register accordingly.(*d*)

Falsification of the Register is a misdemeanour.

It is a misdemeanor for any person to make, or cause to be made, a false entry in the Register of Patents, or a writing falsely purporting to be a copy of an entry in such register, or to produce or tender, or cause to be produced or tendered, in evidence any such writing, knowing the writing or entry to be false.(*e*)

(*c*) *Re* Morgan's Patent, (1876) 24 W. R. 245 ; *Re* Myer's Patent, (1882) W. N. 53, 76.

(*d*) 46 & 47 Vict. c. 57, s. 111 (2).

(*e*) 46 & 47 Vict. c. 57, s. 93.

CHAPTER VIII.

ASSIGNMENT OF LETTERS PATENT.

ORIGIN OF POWER TO ASSIGN.

Rights of an author.

THE author of a literary, or musical, composition actually *creates* the work which is the produce of his mental labour. The law recognises that he has as much natural and moral right to the results created by his mental exertions as he has to the proceeds of his manual industry, and, *independently of any grant from the Crown*, gives him an exclusive copyright in his book or musical composition.(*a*)

Rights of an inventor.

It cannot, however, be contended that an inventor has any natural, or even moral, right in his invention, for he does not create in the same sense as an author does.

In the case of a book, the result of the author's skill and industry has no existence before the author commits his thoughts to paper; but in the case of an invention, in the patent law sense, all that the inventor does is to make use of natural laws, which must necessarily have been pre-existent, though perhaps undiscovered, and, by a new application of them, produce a manufacture or article of commerce, which has either not been produced before or not been produced in the same way.

Distinction between a *literary* composition and an invention.

The distinction between the production of a great literary composition and the discovery of a great invention is made apparent by a contrast of a play of Shakespere—"Hamlet," for instance—with a world-revolutionising invention, such as the steam engine of Watt. Had Shakespere never written "Hamlet," it is practically certain that the play would never have existed, and the literature of the world would, undoubtedly, have been the loser; but had Watt never lived it can scarcely be doubted that the vast superiority of the plan of condensing the steam in a steam engine in a separate vessel, instead of in the cylinder, would have been perceived and communicated to the world by some other inventor.

(*a*) See Millar *v.* Taylor, 4 Burr. 2303.

Origin of Power to Assign.

It is thus evident that an inventor merely produces a new art, consisting of a novel application of previously existing, though it may be undiscovered, physical laws to the production of a new article of commerce, or of an old article of commerce in a new manner. The law does not recognise any natural, or moral, right in the inventor to the exclusive use of the invention, and will not, except on certain conditions, attempt to guarantee him a monopoly in the profitable exercise of it.

The law only gives a right in an invention on condition.

The conditions upon which the law will secure to an inventor an exclusive property in his invention for a limited period are, as we have seen,(*b*) that he shall disclose the secret of it, so that the public may enjoy it after the expiration of the patent; and also that he shall describe the best means known to him of performing the invention, in order that the public may enjoy it to the same extent as the patentee himself, when the term for which the patent is granted expires.

The inventor may perhaps be able to keep the invention a profound secret, and make considerable profit by its use; but there are very few inventions, producing valuable results, which could be worked long without the method by which the results are arrived at becoming matter of public knowledge; in which event the law will not prevent any member of the public from exercising the invention for his own gains, provided he has not been guilty of a breach of trust.(*c*) Undoubtedly the man who makes a useful discovery, or invention, and communicates it to the public is a benefactor; and it is because the law recognises this fact, as well as the desirability of encouraging the production of useful inventions for the public good, that it guarantees to the inventor, his executors, administrators, and assigns the sole privilege of making, using, exercising, and vending the invention within this realm for a definite period, by means of a grant of letters patent from the Crown, upon condition, however, that the inventor discloses the best means known to him of performing the invention.

Effect of keeping an invention secret.

If an inventor endeavours to work the invention in secret the law will not compel him to disclose it, but, if it does leak out, it can never afterwards form the subject of a grant of letters patent, and the inventor cannot claim any monopoly or acquire any right or property in it of any nature whatever, which the law will protect or recognise.

This follows from the fact that one inventor has no natural

(*b*) Chap. v. *ante.*
(*c*) Yovatt *v.* Winyard, (1820) 1 J. & W. 394.

right to prevent another from making the same invention, and deriving profit therefrom; the law only allows, as we have seen,(*d*) the grant of a monopoly in the invention for a limited period to the first and true inventor, *i.e.*, the inventor who actually *first* communicates a knowledge of it to the public.

Origin of Power to Assign.

Thus in *Canham* v. *Jones*, 2 Ves. & B. 218, the plaintiff, as the proprietor of a receipt for the preparation of a certain vegetable syrup, which had been bequeathed to him by a person named *Swainson*, who purchased it from the inventor, sought to restrain the defendant from selling an article under the same name as the plaintiff's. Sir *Thomas Plumer*, V.C., gave judgment in favour of the defendant, and used the following words: "This Bill proceeds upon an erroneous notion of exclusive property, now subsisting in this medicine, which *Swainson*, having purchased, had a right to dispose of by his will, and, as it is contended, to give the plaintiff the exclusive right of sale of. If this claim of monopoly can be maintained without any limitation of time, it is a much better right than that of a patentee; but the violation of right, with which the defendant is charged, does not fall within the cases in which the Court has restrained a fraudulent attempt by one man to invade another's property—to appropriate the benefit of a valuable interest in the nature of a goodwill, consisting in the character of his trade or production, established by individual merit; the other representing himself to be the same person, and his trade or production the same as in *Hogg* v. *Kirby*, 8 Ves. 215, combining imposition on the public with injury to the individual. This is not that sort of case. The observation is correct, that the Bill stating the defendant's medicine to be spurious asserts it not to be the same as the plaintiff's. The defendant does not hold himself out as the representative of *Swainson*, setting up a right in that character to the medicine purchased by him; but merely represents that he sells, not the plaintiff's medicine, but one of as good a quality. He is perfectly at liberty to do so. If any exclusive right in this medicine ever existed, it has long expired. The foundation of this Bill therefore, the exclusive right asserted by the plaintiff, failing, all the consequential relief falls with it; and the demurrer must be allowed."

If a discoverer keeps his invention secret, not only does he run the risk of losing the monopoly of it by an inadvertent disclosure, but he puts himself in a position of evident disadvantage, if he should wish to dispose of it to another person,

(*d*) Chap. i.

Origin of Power to Assign.

for the Court could not decree the specific performance of an agreement for the sale of a secret invention, or prevent the disclosure of it. Either it is or it is not a secret. If it is, what means has the Court of interfering, so as to enforce its own orders? If it is not, there can be no ground for interfering.(*e*)

The Courts will neither decree specific performance of a contract for sale of, nor restrain the publication of, a secret invention.

Moreover, it would be useless for the Court to grant an injunction to restrain the publication of a secret, for there would be no means of determining whether the injunction had been violated or not.(*f*)

In a case (*g*) where the plaintiff sought to restrain the defendant from communicating the secret of preparing a certain medicine, Lord *Eldon*, L.C., dissolved an injunction which had been obtained, and stated the principle on which the Court acts in such cases, thus :—

> "So far as the injunction goes to restrain the defendant from communicating the secret, on general principles, I do not think the Court ought to struggle to protect this sort of secret in medicine. The Court is bound, indeed, to protect them in cases of patents to the full extent of what was intended by the grant of the patent, because the patentee is a purchaser from the public, and bound to communicate his secret to the public at the expiration of the patent. Then, whether this principle can be extended to such a case as this—whether a contracting party is entitled to the protection of the Court, in the exercise of its jurisdiction, to decree the specific performance of agreements by restraining a party to the contract from divulging the secret he has promised to keep—that is a question which would require very great consideration. But the present case is not one which calls for the determination of it. If the defendant has already disclosed the secret the injunction can be of no use. If he only threatens to disclose, it thus becomes necessary to look at his affidavit; and by that he insists that what he has to disclose is no secret at all—then how is the Court to try this question? Or what can the Court do with the case altogether?"

The monopoly in an invention exists only by virtue of the grant of letters patent.

The monopoly created by the grant of letters patent for a limited period is the only right or property which the law recognises an inventor as possessing in his invention; and the sole or exclusive privilege of using the invention which is vested

(*e*) Newburry *v.* James, 2 Mer. 446, judgment of Lord Eldon, L.C.
(*f*) *Ibid.*
(*g*) Williams *v.* Williams, 3 Mer. 157.

in the patentee by the patent has existence only by virtue of the grant. **Origin of Power to Assign.**

The privilege is a mere naked right vested in the patentee, and it would not be assignable unless the letters patent expressly made it so, for it contains no property within itself making it of an assignable nature.(*h*)

Notwithstanding the fact that an inventor has no property in his invention unless and until it is made the subject of a grant of letters patent, he has such an interest in an invention for which he intends to take out a patent as to be able to make and enforce an agreement concerning it. Thus, in the case of *Smith* v. *Dickinson*,(*i*) it appeared that the defendant had, in fraud of the plaintiff, obtained a patent for an invention which had been communicated to him by the plaintiff under an agreement, whereby the defendant undertook, subject to a penalty, not to avail himself or take any advantage of such communication, and the Court held that the plaintiff was entitled to maintain an action for the breach of this agreement.(*k*) Interest in an invention before the grant of letters patent.

According to the law as it at present stands, every patent for an invention granted by the Crown is made in the form prescribed in the first schedule to the Patents, &c., Act of 1883. Eight forms, which are modifications of the form in the schedule to the Act of 1883, to meet special circumstances, are at present in use in the Patent Office.(*l*) The form in the schedule to the Act of 1883 grants to the patentee the Royal licence, "full power, sole privilege, and authority, that the said patentee, by himself, his agents, or licensees, and no others, may at all times hereafter, during the continuance of 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." By a previous recital, the term "patentee," as used in the letters patent, is expressly defined to mean the grantee, his executors, administrators, and assignees. Form of letters patent.

Thus, the authority by which a patent right is created invests it with the quality of assignability; and there is now no limit to the number of persons to whom it may be assigned, though formerly it was made a condition that the grant should become void if the patent became vested in more than a specified number of assignees. Patent is assignable only in virtue of the terms of the grant.

An assignment may be made to a body corporate, and the Body corporate.

(*h*) Duvergier *v.* Fellows, (1828) 10 B. & C. 829.

(*i*) (1804) 3 Bos. & Pul. 630.

(*k*) See also McDougall *v.* Partington, (1890) 7 R. P. C. 216; Punchard *v.* Dale, (1894) 11 R. P. C. 257.

(*l*) See p. 741 *post*.

Assignment by Deed.

body corporate is entitled to be entered on the Register of Patents as the proprietor in its corporate name.(*m*)

Patents dated prior to 1884.

Previous to the Act of 1883, a patent in the United Kingdom, in respect of an invention which had been patented abroad, was only valid for so long as the foreign patent remained in force.(*n*) Since the Act of 1883 does not affect the past operation of any repealed Act,(*o*) it is advisable for an assignee of a British patent of earlier date than January 1, 1884, in respect of an invention previously patented abroad, to ascertain that the foreign patent was in force on the date of the assignment, and to keep it on foot subsequently.

Assignment for a district.

A patentee may assign his patent for any place in a 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.(*p*)

A deed of assignment for a district should contain a covenant on the part of the assignor to pay the renewal fees within the prescribed times, and to give due notice to his co-owner of every such payment when made or permit him to pay the same, and to repay the sums so paid on demand, and until repayment to charge them, together with interest, on his share in the patent.(*q*)

Assignment may be by deed or by act and operation of law.

A patent right may be assigned by deed by the patentee, or by act and operation of law.

Assignment by Deed.

Legal assignments must be by deed failing act and operation of law.

Failing an act and operation of law, which will be discussed later,(*r*) a legal assignment of letters patent can only be made by deed,(*s*) and such an assignment purporting to be made by an agent on behalf the patentee is only valid if the agent is authorised by deed to make it.(*t*) Though the letters patent provide that a licence to use the invention must be under the hand and seal of the patentee, they do not specify any particular form or manner in which assignments are to be made. It is, however, necessary that the grant of letters patent shall be under seal,(*u*) and it is a rule of law that things which can

(*m*) P. R. (1890) r. 72; p. 724 *post*.
(*n*) 15 & 16 Vict. c. 83, s. 25.
(*o*) 46 & 47 Vict. c. 57, s. 113.
(*p*) 46 & 47 Vict. c. 57, s. 36.
(*q*) See Morris' Patents Conveyancing, p. 116.
(*r*) p. 363 *post*.
(*s*) Cook's Case, Power *v.* Walker, 3 M. & S. 9; Stewart *v.* Casey, (1892) 9 R. P. C. 9; L. R. (1892) 1 Ch. 104.
(*t*) Hazlehurst *v.* Rylands, (1891) 9 R. P. C. 7.
(*u*) Co. Litt. 9b, 172a; Shep. Touch. 229–231.

only be granted or created by deed are assignable only by deed.(*x*) Assignment by Deed.

In the words of Lord *Ellenborough*, C.J.(*y*): "If the licence, which is the lesser thing, must be in writing, *a fortiori* the assignment, which is the greater thing, must also be."

No particular form of words is necessary to effect an assignment of a patent right, and it has been held that where a patentee has covenanted, under his hand and seal, to assign a patent on the happening of a certain event, the covenant, on the happening of the event, amounts to an actual assignment.(*z*) No particular form of words is necessary.

An equitable assignment of a patent may, without a deed, arise from the conduct of the parties when there is consideration, and though the consideration be a past service, the equitable agreement may be enforced. Thus, a letter containing an agreement to give a share of a patent in consideration of a past service is an equitable assignment of the share. The principle on which this is so is that a past service raises an implication that it was to be paid for, and a subsequent promise to pay, if not supportable by the consideration of the past service, can be supported as a statement of the remuneration to be accepted in lieu of, or as fixing, the remuneration which the law implies in the first instance on the performance of the service.(*a*) Equitable assignments may arise from conduct when there is consideration.

As the assignment of a grant of letters patent is by deed, no consideration need be stated. Consideration.

Sometimes patents are assigned in consideration of a royalty reserved to the assignor, and where such is the case it is not, in the absence of covenants to that effect, obligatory on the part of the assignee to pay the duties necessary to keep the patent on foot. No obligation on an assignee to maintain the patent.

Thus, in *Re Railway and Electric Appliances Company* (*b*) it appeared that on the sale of a patent by the patentees to the company a deed of assignment was executed by the parties, by which, after a recital that the patentees had agreed to sell the patent to the company for £250, "and for the other considerations herein appearing," the patentees assigned the patent to the company absolutely, and after covenants for title by the patentees, including a covenant for quiet enjoyment of the patent "during the time subsisting therein," the company

(*x*) 3 Co. R. 63a, Lincoln Coll. Cas.
(*y*) Power *v.* Walker, (1814) 3 M. & W. 9.
(*z*) Cartwright *v.* Amatt, (1799) 2 Bos. & Pul. 43.
(*a*) Stewart *v.* Casey, (1892) 9 R. P. C. 9, 14; L. R. (1892) 1 Ch. 184, judgment of Bowen, L.J.
(*b*) (1888) L. R. 38 Ch. D. 597.

Assignment by Deed.

covenanted to pay to the patentees a royalty for every article which should be manufactured or sold by the company under the patent "while subsisting," and also a proportion of the profits arising from the manufacture or sale and from licences granted for the manufacture or sale of articles to be manufactured under the patent "while subsisting." The deed contained no express covenant by the company to keep the patent on foot or to manufacture or sell articles under the patent. On the expiration of the first four years of the patent, the company duly paid the first renewal fee, but on the expiration of the fifth year, by inadvertence, omitted to pay the second renewal fee, and consequently the patent lapsed. After an ineffectual attempt to obtain a private Act of Parliament to revive the patent, the company passed resolutions for a voluntary winding up, and the patentees thereupon sent in a claim for damages for the loss, through the lapse of the patent, of the royalties reserved by the assignment, contending that a covenant to keep the patent on foot should be implied in the assignment. The Court, however, held that no such covenant could be implied; and that, even if it could, the patentees could not obtain more than nominal damages, the company being under no obligation, express or implied, to manufacture the patented articles.

Power of Secretary of State for War to acquire inventions by assignment.

The Secretary of State for War is empowered, either for or without valuable consideration, to acquire by assignment to himself, on behalf of her Majesty, all the benefit of the invention and of any patent obtained or to be obtained for any improvement in instruments or munitions of war; and where any such assignment has been made to the Secretary of State for War he may at any time before the application for a patent for the invention, or before the publication of the specification or specifications, certify to the Comptroller his opinion that, in the interests of the public service, the particulars of the invention and of the manner in which it is to be performed should be kept secret; and if the Secretary of State for War so certifies, the specifications of the invention will not be published or open to public inspection at any time without the sanction of the Secretary of State for War.(*c*)

Equitable and legal interests of a licensee.

The equitable interests of a licensee in relation to the district comprised in the licence are co-extensive with those of the grantee or assignee of the letters patent, yet his legal title is very different. Though an exclusive licensee may perhaps sue

(*c*) See 46 & 47 Vict. c. 57, s. 44.

in his own name for infringements (*d*) he cannot apply to amend the specification or obtain an extension of the patent, and a mere licensee is not able to sue for infringements in his own name.

Assignment by Deed.

Before the passing of the Act of 1883 it was not uncommon to include more than one invention in a grant of letters patent, but the practice is not so frequent now, for it is provided by that Act (*e*) that every patent shall be granted for one invention only, but may contain more than claim.

Different inventions included in one patent.

It is, however, declared (*e*) that 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. It is consequently possible that a patent granted under the present practice may comprise more than one invention.

If the patents comprise two or more inventions separate and distinct in their nature, valid assignments may be made of the different parts of the patent to different persons, and it is competent to the assignee of a separate and distinct portion of a patent to give for an infringement of that part, without joining one who has an interest in another part, the damages recovered in the action accruing to the former alone.(*f*)

Sometimes the assignor covenants with the assignee that he will not trade in competition with him. Such a covenant should be carefully drawn so as not to be contrary to the doctrine of covenants in general restraint of trade. If the restraint is not wider than is necessary for the protection of the covenantee, the covenant can be enforced.(*g*) Thus, a patentee and manufacturer of guns and ammunition for purposes of war covenanted with a company to which his patents and business had been transferred that he would not for twenty-five years engage, except on behalf of the company, either directly or indirectly in the business of a manufacturer of guns or ammunition. The House of Lords held, affirming the Court of Appeal, that this covenant, though unrestricted to space, was not, having regard to the nature of the business and the limited number of customers (namely, the Governments of this and other countries), wider than was necessary for the protection of the company, nor injurious to the public interests of this country; and

Covenants by an assignor in restraint of trade.

(*d*) p. 386 *post*.
(*e*) 46 & 47 Vict. c. 57, s. 33.
(*f*) Dunnicliff *v.* Mallett, (1859) 7 C. B. N. S. 209; Walton *v.* Lavatu, (1860) 8 C. B. N. S. 162, 184.
(*g*) Nordenfelt *v.* Maxim-Nordenfelt Guns and Ammunition Co., (1894); L. R. (1894) A. C. 535; Dubowski *v.* Goldstein, L. R. (1896) 1 Q. B. 478.

Co-Owners.

that it was, therefore, valid, and might be enforced by injunction.(*h*)

Reservation by an assignor of right to use the invention.

A patentee may assign the patent but reserve to himself the right to use the invention. When this is done questions may sometimes arise as to the power of the assignee to restrain persons claiming to act as the agents of the assignor from manufacturing or selling articles manufactured according to the invention. Thus, in one case,(*i*) the patentee assigned two patents, reserving to himself the right to work the patents personally, which right was not to be transferable. After the death of the assignee the patents became vested in a company. The assignor entered into partnership with two other persons and by an agreement between him and his firm he agreed to employ the firm, on certain terms, to manufacture articles under the patents on his behalf, and to sell them for him, which they did. In an action by the company against the firm for an infringement of the two patents by working under the agreement, it was held that according to the true construction of the agreement, although the firm were the agents of the assignor as far as selling was concerned, they were manufacturing, not as his agents, but as contractors for him, and had thereby infringed the rights of the plaintiff company, and an injunction was granted in special terms.

Co-Owners.

Assignment to several persons.

A patent may be assigned to different persons in different portions as joint tenants, or as tenants in common.(*k*)

When a share in a patent is assigned, it is advisable that the deed of assignment should contain covenants binding not only the parties, but all future owners, to account to each other for the profits made by them respectively, and to grant, or concur in granting, licences in a manner prescribed.(*l*) A deed of assignment of a share of a patent should also contain a covenant by the assignee to perform and observe the stipulations (if any) which bind the assignor and to indemnify him from future breaches thereof; (*m*) and each owner should covenant to pay his proper proportion of the renewal fees, and should charge

(*h*) Nordenfelt *v.* Maxim-Nordenfelt Guns and Ammunition Co., L. R. (1894) A. C. 535.

(*i*) Howard *v.* Tweedales, (1895) 12 R. P. C. 519.

(*k*) Walton *v.* Lavater, (1860) 8 C. B. N. S. 162; Smith *v.* London and North-Western Ry. Co., (1853) Macr. P. C. 203.

(*l*) See Morris' Patents Conveyancing, p. 120; see form of assignment, Appendix.

(*m*) See Morris' Patents Conveyancing, p. 121.

his share in the patent with the payment of any moneys which may be paid by any other owner on his behalf in this respect.(*n*) There should also be a provision to the effect that licences should be granted by the co-owners jointly, and that all benefits arising therefrom should be shared by such co-owners in proportion to their shares.(*o*) If a deed of assignment of a share of a patent provides for the sole working of the patent by one of the co-owners alone, it is well to reserve to the other co-owners the right to use the share or shares assigned on agreed conditions; and to enter a notification of such the right can be entered on the Register of Patents.(*p*)

Co-Owners.

It is submitted that when a patent for a single invention is held by different persons, either as joint tenants or as tenants in common, it is competent for one of such co-owners to sue alone in respect of an infringement,(*q*) though the Court of Queen's Bench in *Smith* v. *London and North-Western Railway Co.*,(*r*) decided in favour of the right of the survivor of two persons, to whom a patent had been assigned as tenants in common, to sue for the whole damages caused by an infringement, on the ground that, if one of the assignees had not died, the action must have been brought by both.(*s*)

Rights of co-owners.

In *Smith* v. *London and North-Western Railway Co.*(*t*) it was held that where a patent is assigned to two persons as tenants in common they may maintain a joint action in respect of infringements, and the right of action survives, so that after the death of one tenant in common the survivor may sue for and recover the whole of the damages in respect of infringements committed during the lifetime of the deceased tenant in common. It must be noticed that one ground for the decision in favour of the plaintiff *Smith*, who was a surviving tenant in common, being entitled to sue in respect of the infringements in question, was that, had the action been brought during the lifetime of both tenants in common, it must have been brought by them both jointly, and the case is consequently to that extent an authority for saying that one of two co-assignees cannot sue for infringement without the other being a party to the action.(*u*)

There is, however, the authority of *Malins*, V.C., for saying that one person interested in a patent is entitled to sue without making his co-owners parties to the action, either for an in-

(*n*) See Morris' Patent Conveyancing, p. 123.
(*o*) *Ibid.*
(*p*) *Ibid.* p. 126.
(*q*) Sheehan *v.* Great Eastern Ry. Co., (1880) L. R. 16 Ch. D. 59.
(*r*) (1853) Macr. P. C. 207.
(*s*) See p. 352 *post;* Bergmann *v.* Macmillan, (1881) L. R. 17 Ch. D. 423.
(*t*) (1853) 2 E. & B. 69; Macr. P. C. 188.
(*u*) But see above.

Co-Owners.

junction or for an account.(*x*) It must be concluded, from a consideration of the case (*y*) on which the learned Vice-Chancellor's opinion was mainly formed, that the damages to which the plaintiff would in such circumstances be held entitled would be, not the whole profits, but only such proportion as should appear to be his, having regard to the proportion of the patent vested in the other co-owners. And on the analogy of *Bergmann* v. *Macmillan* (*z*) the account must be taken in the presence of all the parties interested.

Moreover, it has been held that where an assignment is made of a share in profits (arising, *e.g.*, from the working of a patent by licences) the assignee is entitled to an account from the licensee, but that the account must be taken once for all in the presence of all the parties interested. Thus, if there be more than one assignee, all the assignees are necessary parties. And the assignee who asks for an account of the profits must place himself in the position of the assignor, by offering to pay to the accounting party anything which may be due to him from the assignee. Also an account of profits will not be directed if it is clear that no profits have been made.(*a*)

All parties interested in the patent, if they do not join as co-plaintiffs, may be, and for safety's sake should be, joined as defendants, in order that the infringing defendant may not be called on to account more than once, first to the plaintiff, and then separately to the other persons claiming an interest in the patent.(*b*)

Each one of a number of joint grantees of a patent is entitled to use the invention himself, without being under any obligation to obtain the consent of the others, or to account to them for any profits made by such use.(*c*) It is, however, doubtful whether one of such co-grantees could grant a valid licence without the consent of the rest, and without a liability to account to them for royalties received.(*d*)

But a person who is co-owner in fee of one moiety of a patent and mortgagee of the other moiety is entitled to work the patent himself without liability to account to the mortgagor; and if he grant licences he would no doubt in an action for redemption be bound to account to the mortgagor for

(*x*) Sheehan *v.* Great Eastern Ry. Co., (1880) L. R. 16 Ch. D. 62.
(*y*) Dent *v.* Turpin, (1861) 2 J. & H. 139.
(*z*) (1881) L. R. 17 Ch. D. 427.
(*a*) Bergmann *v.* Macmillan, (1881) L. R. 17 Ch. D. 423.
(*b*) Westhead *v.* Keene, (1838) 1 Beav. 287; Bergmann *v.* Macmillan, (1881) L. R. 17 Ch. D. 423; Van Gelder Co. *v.* Sowerby, Limited, (1890) 7 R. P. C. 41.
(*c*) Mathers *v.* Green, (1865) L. R. 1 Ch. 29.
(*d*) p. 368 *post.*

Assignment of Improvements.

royalties received as being profits received by him when mortgagee in possession.(*e*)

It is clear that one of two co-patentees cannot dispose of the rights of the other. Thus, if A. and B. are patentees, and B. wants to get rid of A., the only way in which he can do so is by getting A. to assign his rights to him: he cannot assign the whole patent to C., and then say that A. has no right to use it at all.(*f*)

Trustee and *cestuis que trustent*.

A patent may be vested in one as trustee for another person or persons, and it is competent for trustees to sue alone in respect of infringements, but the Court or a judge may at any stage of the proceedings order the *cestuis que trustent* to be made parties;(*g*) also a person is entitled to bring an action in his own name when the patent is registered in the name of another, if that other is a trustee for the plaintiff.(*h*)

Assignment of future Improvements.

Covenants to assign future improvements

When inventors have once turned their attention to a particular class of inventions, or to some problem, the successful solution of which is felt to be a desideratum, which must bring benefit to the public and remuneration to the discoverer, it is well known that they are very likely to go on inventing fresh methods and improvements in the same direction. It frequently happens, therefore, that a purchaser of an invention is desirous of acquiring the right to an assignment of all future inventions and improvements of a like nature to the invention sold, which may be the produce of the assignor's inventive talent, for, as far as the purchaser is concerned, the utter destruction of the value, from a commercial point of view, of the original invention may be the result, if the monopoly in a better method, or an improvement in the means of achieving the desired object, is allowed to pass into the possession of anybody but himself. To prevent this, a covenant by the vendor of a patent to assign to the purchaser all future patent-rights which the vendor may thereafter acquire, in whatever way, of a like nature to the patent sold, is frequently inserted in deeds of assignment; and such an agreement is not contrary to public policy.(*i*)

(*e*) See Steers *v.* Rogers, (1892) 9 R. P. C. 177; 10 R. P. C. 245.

(*f*) *In re* Horsley and Knighton's Patent, (1869) L. R. 8 Eq. 475.

(*g*) R. S. C. Order xvi. r. 8.

(*h*) Speckhart *v.* Campbell, "Times," Mar. 13, 1884.

(*i*) Printing and Numerical Registering Co. *v.* Sampson, (1875) L. R. 19 Eq. 462.

Estoppel.

are not contrary to public policy.

On the contrary, public policy is directly in favour of such an agreement, by means of which a needy and struggling inventor may obtain a present payment to put his intellectual gifts at the service of a purchaser, and thus become enabled, in comparative ease and affluence, to devote his attention to scientific research, whereas if such a contract were prohibited he would be compelled to apply himself to some menial, or mechanical, or lower calling, in order to gain a livelihood.(*k*)

The purchaser of a patent can maintain an action for breach of an agreement to assign further improvements and inventions, but specific performance will not be ordered on an interlocutory application.(*l*)

Covenants for the assignment to the purchaser of patents for improvements upon the invention which the assignor shall in future become possessed of should be carefully drafted. Where an assignor covenanted that "any improvements on the said invention that he shall during the continuance of the aforesaid patents become possessed of shall be considered and be held to be part of the property hereby assigned, &c.," the covenant was held to contemplate only improvements discovered or made by the assignor himself, which he would be in a position to patent and assign to the assignee, and not to apply to patents in which he had only a beneficial interest with other persons.(*m*)

Estoppel.

Recitals and covenants by the assignor which operate as an estoppel.

If a deed of assignment recite that the assignor is the inventor, he is estopped from denying the validity of the patent in any subsequent action brought by the assignee, or any person deriving title through him, in respect of any infringement; for the principle of the law of estoppel is, that where a man has entered into a solemn engagement by deed under his hand and seal as to certain facts he shall not be permitted to deny any matter which he has so asserted.(*n*)

When there is fraud, or common mistake between the parties as to what was intended, then there is no estoppel.(*o*)

(*k*) Printing and Numerical Registering Co. *v.* Sampson, (1875) L. R. 19 Eq. 462; see judgment of Jessel, M.R., p. 465.

(*l*) London and Leicester Hosiery Co., Limited *v.* Griswold, (1886) 3 R. P. C. 251.

(*m*) Pneumatic Tyre Co. *v.* Dunlop, (1896) 13 R. P. C. 553.

(*n*) Bowman *v.* Taylor, (1834) 2 A. & E. 278, 291; per Taunton, J., Walton *v.* Lavater, (1860) 8 C. B. N. S. 162; Dunnicliff *v.* Mallett, (1859) 7 C. B. N. S. 209; Franklin Hocking & Co. *v.* Franklin Hocking, (1889) 6 R. P. C. 69, 72; see also rule in Pickard *v.* Sears, (1837) 6 A. & E. 469.

(*o*) Ashworth *v.* Law, (1889) 7 R. P. C. 234; Hayne *v.* Maltby, (1789) 3 T. R. 439; Lovell *v.* Hicks, (1836) 2 Y. & C. 46.

Estoppel.

It is the usual practice for the assignor to enter into covenants that he is the true and first inventor, and that the patent is valid, so far as his acts and omissions are concerned. A covenant for title is implied if the assignor is expressed to assign as beneficial owner or trustee.(*p*)

There may be an estoppel by matter of recital,(*q*) but an estoppel must be certain, and is not to be taken from argument or inference.(*r*)

If the recital only amount to an assertion that the assignor is himself an assignee of the actual inventor, it appears that the assignor is not estopped from denying the validity of the patent in an action brought by the assignee on a covenant contained in articles of agreement.(*s*)

The grantee and assignor of letters patent is estopped in an action brought by the assignee against him for infringement, from denying that he had any title to convey.(*t*)

Assignor not estopped from denying a particular construction of the specification.

It is competent, however, for the grantee and assignor to dissent, at the hearing of an action for infringement brought against him by his assignee, from a particular construction of the specification which would have the effect of sustaining the patent as against another construction which would invalidate it.(*u*)

Also in such an action the defendant assignor, though not entitled to dispute the validity of the patent, may contend that the specification bears such a construction as to exclude what he is in fact doing from the ambit of the claim. Thus in *Hocking & Co.* v. *Hocking* (*x*) the patent was for "an improved apparatus for heating water and other liquids, applicable also as a condenser, cooler, or refrigerator." The specifications had been amended by disclaimer and memorandum of alteration filed by other assignees and predecessors in title of the plaintiff company. The complete specification, as amended, described and claimed the construction of a condenser, cooler, or refrigerator, consisting of an arrangement of annular spaces (*i.e.*, steam-spaces), substantially as described and shown, the principle of annularity and concentricity being disclaimed. Reversibility of the steam and water spaces was also pointed out in the specification as a

(*p*) Conveyancing Act, 1881, s. 7.

(*q*) Lainson *v.* Tremere, (1834) 1 A. & E. 792; Bowman *v.* Taylor, (1834) 2 A. & E. 278, 293.

(*r*) Co. Litt. 352 b; Bowman *v.* Taylor, (1834) 2 A. & E. 278, 294.

(*s*) Hayne *v.* Maltby, (1789) 3 T. R. 438; 1 W. P. C. 291; Bowman *v.* Taylor, (1834) 2 A. & E. 278.

(*t*) Oldham *v.* Langmead, (1789) 1 W. P. C. 291.

(*u*) Hocking & Co. *v.* Hocking, (1887) 4 R. P. C. 255, 434; 6 R. P. C. 69.

(*x*) (1887) 4 R. P. C. 255, 434; 6 R. P. C. 69.

Estoppel.

special feature. The plaintiffs alleged against the defendant infringement of the condensing apparatus. It appeared in evidence that the apparatus of the defendant, in its simple form, was composed of a helical steam-space between two water-spaces, all the spaces being concentric and annular, and his multiform arrangement consisted of a cluster of the simple forms inside a large cylindrical vessel, and neither of his forms admitted of reversibility. At the trial, the defendant denied infringement, and alleged that, if the patent was so construed as to cover the alleged infringement, it would be void for want of novelty. *Kekewich*, J., who was the Judge of first instance, held (1) that the Court would regard with extreme jealousy the defendant's claims, as being in derogation of his own grant, and would assume that the patent must have a reasonable meaning; (2) that the essence of the amended patent was the alternation of steam- and water-spaces of the particular character described and shown in the figures, combined, if convenient, but not of necessity, with concentricity; and (3) that the defendant's apparatus infringed, although it contained certain minor differences and additions, and in one form only a single steam-space, while in the rest the spaces were not concentric. The Court of Appeal (*dissentiente Fry*, L.J.), dismissed the appeal with costs, and the defendant thereupon appealed to the House of Lords. The House of Lords held that, although it approved of the principle that a grantee shall not defeat his own grant, the language of the specification must not be strained against the patentee, and that the effect of the disclaimer was to limit the patent to machines constructed substantially as described, and, therefore, the only question was whether the defendant's apparatus was so constructed. The House found as a matter of fact that the defendant's apparatus was not so constructed, and the decisions of the Court of Appeal and *Kekewich*, J., were accordingly reversed with costs, in favour of the appellant and defendant in the action.

Assignor not estopped from assisting a defendant with evidence.

Though an assignor, who assigns under terms which amount to an express or implied warranty of the validity of the patent, is estopped from denying the patent in an action brought against him by the assignee, he cannot be restrained from assisting as a scientific witness or otherwise a defendant, other than himself, in an action instituted by the assignee, or from communicating to such defendant evidence tending to show the invalidity of the patent.

Thus, on an interlocutory application in *London and Leicester*

Hosiery Company Limited v. *Griswold* (*y*) the plaintiff sought to obtain an injunction of the Court to restrain the defendant in the action, who was the original patentee and assignor of the company's patents, from assisting, as a scientific witness or otherwise, the defendants in two other actions then pending for the infringement of the company's patents. *North*, J., in refusing the injunction asked for, pointed out that he could not, under any circumstances, grant an injunction to restrain the defendant from obeying the subpœna to attend as a witness in Court and answering questions which might be properly put to him in the course of examination as a witness, the refusal to answer which might lead to his committal to prison for contempt. **Warranty.**

On the same application it was also sought by the plaintiffs to restrain the defendant in the action from communicating to the defendants in other actions information in his possession which might enable the defendants in the other actions to show that the patents assigned were not valid patents. The Court refused to grant an injunction, and the learned Judge stated that, though it is well settled that a licensee of a patent is, during the continuance of the licence, estopped from disputing the existing patent, yet it is going a great deal further to say that a man, who has assigned a patent, is to be restrained from mentioning to any person, at any time, or under any circumstances, matters which might show that the patent, which was granted by the Crown in the belief that the invention claimed was a new invention, was not, as a matter of fact, a new invention.

Assignment by trustee in bankruptcy does not raise an estoppel against the bankrupt patentee.

A bankrupt patentee, whose patent has been sold by his trustee in bankruptcy, is not estopped, in an action subsequently brought against him (the patentee) for infringement, from denying the validity of the patent, either by matter of record, on the ground that the letters patent were matters of record; or by deed, by reason of the specification being under his seal; or by matters *in pais*, on the ground of the statements in the declaration accompanying his application, there being nothing to show that the purchaser bought on the faith of those statements.(*z*)

Warranty.

Warranty may be express or implied.

In cases arising on the breach of contracts by purchasers of letters patent, it is always most important to consider whether

(*y*) (1886) 3 R. P. C. 251.
(*z*) Cropper *v.* Smith, (1884) L. R. 26 Ch. D. 700; L. R. 10 App. Cas. 249: 1 R. P. C. 81: 2 R. P. C. 17.

Warranty.

In the absence of warranty the doctrine of *caveat emptor* applies.

the contract contains any express or implied warranty on the part of the assignor as to the validity of the patent, for, if there is no such warranty, the purchaser, in the absence of fraud, cannot repudiate the contract on the ground that he has subsequently discovered the patent to be void. A purchaser, without a warranty from the assignor, in the absence of fraud, is bound to take the patent with all its faults, if it have any.(*a*)

In *Hall* v. *Conder*,(*b*) the leading case on this point, the facts were as follow:—By an agreement reciting that the plaintiff had invented a method for the prevention of boiler explosions, and had obtained a patent for the use of the same within the United Kingdom, and was desirous of taking out patents in France, Belgium, and such other places as might be found expedient, and that he had disposed of a moiety of the English patent, and had applied to the defendant to purchase the other moiety, and, to assist him in taking out the foreign patents, it was agreed that the defendants should pay to the plaintiff a certain sum in such manner as should be mutually agreed on, and also a proportion of the net profits, and in consideration of such agreement on the part of the defendant, the plaintiff "agreed to make over and transfer, and did thereby accordingly make over and transfer to the defendant one-half of the said foreign patents, when the same should be obtained, and the above-mentioned one-half of the English patent thereinbefore referred to." The action was brought for the specific performance of this agreement, and the defendant objected that the invention was wholly worthless, and of no public utility, and was not new in England, and that the plaintiff was not the true and first inventor. The Court of Common Pleas, however, held that, in the absence of any allegation of fraud, it must be assumed that the plaintiff was an inventor, and there was no warranty, express or implied, either that he was the true and first inventor, within the meaning of the statute of James I., or that the invention was useful or new; but that the contract was for the sale of the patent such as it was, each party having equal means of ascertaining its value, and each acting on his own judgment.

In *Smith* v. *Buckingham* (*c*) it appeared that the defendant had agreed to purchase the patent rights of the plaintiff in an invention for which provisional protection had been obtained. The agreement contained a recital to the effect that the plaintiff

(*a*) Hall *v.* Conder, (1857) 2 C. B. N. S. 22; Smith *v.* Neale, (1857) 2 C. B. N. S. 67.

(*b*) (1857) 2 C. B. N. S. 22.

(*c*) (1870) 21 L. T. N. S. 819.

had lately invented an improved composition or material to be used in waterproofing, or rendering woven fabrics impervious to moisture. The action was on the breach of the agreement, and the defendant pleaded that the plaintiff had not invented an improved, or any, composition or material which could be employed in rendering woven fabrics impervious to moisture, but the Court of Queen's Bench gave judgment for the plaintiff, holding that the plea did not show a total failure of consideration, and that there was no express or implied warranty, and that the defendant had got what he bargained for. Warranty.

When a company is promoted for the purpose of acquiring a patent, which has not been declared void by a Court of law and is described in the prospectus as a "valuable and valid patent" on the strength of a favourable report of an expert, it is not competent to a shareholder in an action for the removal of his name from the register of members, on the ground of misrepresentation in the prospectus, to adduce evidence of the invalidity of the patent. In such a case the question is whether the patent was valuable at the date of the prospectus.(*d*) Statement that a patent is "valuable and valid."

When, upon an agreement for purchase, the validity of the patent is a subject specially contemplated by the parties, the agreement should make it clear whether the question of validity is to be decided by the opinion of the purchaser, or whether the patentee warrant the validity in fact. Thus, when an agreement for purchase was entered into for a sum down and the remainder "within twenty-eight days, which latter payment the purchaser agrees to make immediately he has satisfied himself that the said patents are valid and of full force and effectual in law," and the vendor warranted the validity, it was held that in an action for specific performance the plaintiff was entitled to particulars of the purchaser's objections to validity; and, as it turned out that one of the patents in question was void for non-payment of fees, the action was dismissed, the real question being as to the validity of the patents in fact and not whether the purchaser was satisfied as to validity.(*e*)

No injunction restraining the patentee from dealing with patents which are the subject of an alleged agreement for sale and distribution of the proceeds of sale between him and the purchaser will be granted unless the purchaser is in a position to obtain specific performance of the agreement.(*f*)

(*d*) Stavert *v.* Passberg Grain Syndicate, (1891) 8 R. P. C. 400.
(*e*) Hazlehurst *v.* Rylands, (1892) 9 R. P. C. 1.
(*f*) Harlett *v.* Hutchinson, (1891) 8 R. P. C. 457.

Rights of Assignees.

No implied warranty that assignee will be able to use the invention without licence.

It is submitted that upon the sale of a patent there is no implied warranty that the purchaser will be entitled to put the invention into practice without liability to obtain the licence of a prior patentee.(*g*)

Assignee with notice takes subject to prior assignee's covenants.

When an assignee takes from a prior assignee, with notice, he takes subject to the prior assignee's covenants. Thus,(*h*) a patentee assigned letters patent to two persons, A. and B., who covenanted with him that they, their executors, administrators, and assigns, would use their best endeavours to introduce the invention by granting licences, or working the patent, or selling it, and that the patentee should be entitled to receive £5 per cent. of all net profits, whether arising from royalties, sale, or otherwise, which should be received by A. and B., or the survivor of them, the executors or administrators of such survivor, or their or his assigns, and that an account of profits should be rendered yearly to the patentee and his share of profits paid to him by A. and B., and the survivor of them, and the executors or administrators of such survivor, or their or his assigns, with a proviso that, after a sale had been made of the patent, the interests of the patentee in the profits should cease and a final account be come to. A. and B. had taken the assignment with a view to forming a company to work the patent. The company was formed, and the patent made over to it. The patentee sued the company for an account of profits. The company demurred, on the ground that there was no privity between them and the plaintiff, and that the plaintiff's right, if any, was against A. and B. only. It was held, however, both by *Bacon*, V.C., and the Court of Appeal, that the plaintiff could sue the company for an account of profits, since the stipulations of the assignment to A. and B. amounted to a contract that the owners for the time being of the patent should account for and pay to the plaintiff a share of the profits, unless a sale within the meaning of the deed was effected, and no person taking the patent with notice of this contract could refuse to give effect to it.

Rights of Assignees.

Action for infringement by assignee.

The assignee of a patent may maintain an action for infringement, though he has acquired the right by two assignments of separate portions and the party sued is the original grantee. Moreover, the action is maintainable, although there has been

(*g*) Monforts *v.* Marsden, (1895) 12 R. P. C. 266

(*h*) Werdermann *v.* Société Générale d'Electricité, (1881) L. R. 19 Ch. D. 246.

no infringement since the defendant has received notice that the entire interest in the patent has become vested in the plaintiff.(*i*) **Rights of Assignees.**

The assignment of a patent restrains the assignor and subsequent licensees from him from working or using the invention without the leave or licence of the assignee ; (*k*) and with respect to prior licensees from the assignor the rule seems (in the absence of any express reservation in the assignment of their rights) to be that, if the assignee took the assignment with notice thereof, he takes it subject to their licences, and, therefore, cannot restrain them, but that, if he had no such notice, he is entitled to restrain them. Action for infringement against assignor.

An assignee is, at any time so long as he remains the person for the time being entitled to the benefit of the patent, entitled to ask for leave to apply at the Patent Office for liberty to amend the specification ; he is in fact included in the meaning of the term "patentee" as used in the Act of 1883.(*l*) Amendment of specification by assignee:

It may be questioned whether a person to whom a patent has been assigned by way of mortgage is entitled to apply at the Patent Office for leave to amend the specification, or to present a petition to the Privy Council for the prolongation of the patent, without his mortgagor being a party to the application.(*m*) *e.g.*, mortgagee.

It is advisable for the mortgagor of a patent to insist on the mortgagee entering into a covenant not to seek leave to amend the specifications or drawings without the written consent of the mortgagor.

An assignee, as the person for the time being entitled to the benefit of the patent, is included in the meaning of the term "patentee," as defined by the Act of 1883, and competent to petition for the prolongation of the patent ; (*n*) and an extension may be granted to the assignee, if the patentee has ceased to have any connection with the working of the patent,(*o*) or if the assignee has paid a large sum for the assignment and the development of the invention.(*p*) Petition for prolongation of patent by assignee.

But assignees petitioning for the extension of letters patent,

(*i*) Walton *v.* Lavater, (1860) 8 C. B. N. S. 162.

(*k*) Hassall *v.* Wright, (1870) L. R. 10 Eq. 509.

(*l*) 46 & 47 Vict. c. 57, s. 46.

(*m*) See Van Gelder Co. *v.* Sowerby, Limited, (1890) 7 R. P. C. 41, 208.

(*n*) 5 & 6 Vict. c. 83 ; 7 & 8 Vict. c. 69 ; Russell *v.* Ledsam, (1847) 14 M. & W. 574, 588 ; 1 H. L. Cas. 687.

(*o*) Napier's Patent, (1861) 13 Moo. P. C. 543.

(*p*) Bodner's Patent, (1849) 6 Moo. P. C. 468.

Assignment and Partnership.

are not received with so much favour as the original grantee,(*q*) and the prayer of the petition is not usually granted unless it is evident that the original grantee will derive some benefit by the extension.(*r*)

Not unfrequently conditions are imposed for the benefit of the patentee when prolongations are granted on the petition of assignees,(*s*) and in *Bovill's Patent*,(*t*) where the petition was presented by the patentee and his mortgagee, the extension was granted to the patentee alone.

Assignment and Partnership.

Assignment of a share may constitute a partnership.

The assignment of a share in the profits of letters patent may constitute a partnership between the assignor and assignee, and create consequences not perhaps contemplated between them which might have been avoided by the grant of a licence at a royalty instead of an assignment.(*u*)

Rights of partners in an invention.

Where a partnership at will is formed for the purpose of working an invention for which a patent has been taken out by, and registered in the name of, one of the partners alone, the patent becomes an asset of the partnership and each partner acquires a right to practise the invention, which right is not taken away by the registered owner assigning the patent to third parties who have notice of the existence of the partnership; and even after the determination of the partnership each of the partners has an equal right and licence to use the invention, the dealings between them having been such as to create in the one partner an irrevocable licence, as far as the other partner, the patentee, is concerned, to use the invention.(*x*)

Thus a person named *Kenny*, who had invented an improved kind of button-hole for boots and shoes, and a machine for making it, obtained a loan from a person, *Lutwyche*, to enable him to meet the expense of taking out a patent for the invention; and the patent having been obtained by *Kenny*, in his name alone, he and *Lutwyche* for more than four years worked the invention in partnership, together. After the partnership

(*q*) Norton's Patent, (1863) 1 Moo. P. C. N. S. 3, 9; Claridge's Patent, (1851) 7 Moo. P. C. 394; Normand's Patent, (1870) L. R. 3 P. C. 193; p. 411 *post*.

(*r*) Norton's Patent, (1863) 1 Moo. P. C. N. S. 339; Pitman's Patent, L. R. 4 P. C. 87; p. 411 *post*.

(*s*) Pitman's Patent, (1871) L. R. 4 P. C. 84, 87; Herbert's Patent, (1867) L. R. 1 P. C. 399; Whitehouse's Patent, (1830) 1 W. P. C. 473; Markwick's Patent, (1860) 13 Moo. P. C. 310; Russell *v.* Ledsam, (1847) 14 M. & W. 574; p. 438 *post*.

(*t*) (1863) 1 Moo. P. C. N. S. 348.

(*u*) 1 W. P. C. 417 n.

(*x*) Kenny's Patent Button-holing Co. *v.* Somervell, (1878) 26 W. R. 787.

had existed for some years, *Kenny* agreed with the trustee of a projected company to assign the patent to it, and the company having been formed, the assignment was duly made and registered. At the time of the agreement and assignment respectively, the trustee and directors of the company knew that *Lutwyche* and *Kenny* had been working the invention together. Notice of the assignment was given to *Lutwyche*, and he was warned not to infringe the patent, but he continued to work the invention, and the company then sought to restrain him from so doing, but the Court held that by the partnership *Lutwyche* had obtained a licence to work the invention; that at the time of the assignment of the patent the company had notice of the existence of his right; and that they could not revoke the licence.(*y*)

Assignment by Act and Operation of Law.

Assignment by Act and Operation of Law.

An assignment by act and operation of law takes place when a person becomes entitled to a patent right without any deed of assignment from the person to whom he succeeds or through whom he claims. The patent is granted to the grantee, his executors, administrators, and assigns, and these words of limitation constitute it an assignable chattel interest, assignable by act and operation of law, just as any other chattel is.

Act and operation of law.

On the death of a grantee or assignee of a patent, the patent vests in his executor if he has made a duly executed will, and in his administrator if he dies intestate; (*z*) and such executor or administrator may sue for and recover in respect of infringements committed during the lifetime of the testator or intestate, as the case may be, if the probate of the will or grant of letters of administration has been entered on the register of patents.

Death of grantee or assignee.

If a person die possessed of an invention without having made an application for a patent, the right to apply vests in his legal representative, who of course would hold the patent, if granted, subject to any trusts contained in the will of the deceased, or for the benefit of the next of kin in cases of intestacy. And the 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.(*a*)

Death of person possessed of an invention.

(*y*) Kenny's Patent Button-holing Co. *v.* Somervell, (1878) 26 W. R. 787.
(*z*) Williams on Executors, 8th ed. vol. i. p. 824.
(*a*) 46 & 47 Vict. c. 57. s. 34; p. 5 *ante*.

Registration of Assignments.

Trustee in bankruptcy.

If a grantee or assignee is declared bankrupt, the patent vests in his trustee in bankrutcy,(*b*) who thereupon becomes entitled, for the benefit of the creditors, to sue in respect of infringements, whether committed before the bankruptcy or not, but it is submitted that the trustee, before commencing action, must obtain an entry of his title on the register of patents.

Rights of undischarged bankrupt to fruits of unpatented invention.

If a bankrupt before he obtains his certificate of discharge obtain a patent it will vest in his trustee for the benefit of the creditors.(*c*) The fruits which result from schemes which a bankrupt has in his head before he obtains his discharge do not pass to the trustee, provided such results are subsequent to the bankrupt's discharge; but if he avail himself of his knowledge and skill, and thereby acquires a beneficial interest, which may be the subject of assignment, that interest will pass to the trustee.(*d*)

Letters patent are liable to seizure by the sheriff under a writ of *fi. fa.* in satisfaction of a judgment debt. It would appear that the writ authorises the sheriff to sell and assign the chattel interest of the judgment debtor.(*e*) The assignee, on application at the Patent Office, will be duly entered on the register as patentee.

Registration of Assignments.

Statutory provisions.

By s. 87 of the Act of 1883 (*f*) it is enacted that when a person becomes entitled by assignment, transmission, or other operation of law, to a patent, the Comptroller shall, on request, and on proof of title to his satisfaction, cause the name of such person to be entered in the register of patents as proprietor of the patent; and it is by the same section further provided that the person for the time being entered on the register of patents as proprietor of a patent shall, subject to any rights appearing from such register to be vested in any other person, have power absolutely to assign, grant licences 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 patents

(*b*) Hesse *v.* Stevenson, (1808) 3 Bos. & P. 565; Bloxam *v.* Elsee, (1827) 6 B. & C. 169; 9 Dowl. & R. 215; Bankruptcy Act, (1883).

(*c*) Hesse *v.* Stevenson, (1808) 3 Bos. & P. 565.

(*d*) *Ibid.* See judgment of the Court of Common Pleas, delivered by Lord Alvanley, C.J.

(*e*) Coleman *v.* Rawlinson, 1 F. & F. 330; Harley *v.* Harley, 11 Ir. Ch. Rep. 451.

(*f*) See also s. 23.

may be enforced in like manner as in respect of any other personal property. Registration of Assignments.

It is submitted that a person can only claim registration under this section if he possesses the legal estate, and consequently a mere equitable assignee is not entitled to registration under this section.(*g*) Equitable assignments, however, may be entered on the register as documents affecting the proprietorship of the patent.(*h*)

It is to the interest of assignees to register their assignments as soon as possible.(*i*) Assignments should be registered immediately.

Mortgagees of patents are always entered on the register as "mortgagees," and not as "assignees." It is submitted that a mortgagee, together with his mortgagor, form the proprietor.(*k*) Mortgagees are registered as such and not as assignees.

As a rule, documents relative to the proprietorship of letters patent of earlier date than the letters patent will not be entered on the register. It cannot, however, be laid down as a hard-and-fast rule that such documents ought not to be entered on the register, for there may be some which, as amounting to assignments, ought to be entered, whilst, on the other hand, to the entry of others very forcible objections might be raised which would prove absolutely insuperable.(*l*) Documents of earlier date than the letters patent.

The practice to be observed where an application is made for an entry of an assignment on the register of patents is regulated by Patent Rules, 1890.(*m*) Practice on registration.

Since the Act of 1883 came into operation, there has been no decided case in which the question has been determined whether an assignee of a patent is entitled to maintain an action for infringement before the assignment has been entered on the register, but on the authority of the old cases it is submitted that he could not do so, unless the defendant had notice of the assignment. Is registration a condition precedent to right to sue?

In *Chollet* v. *Hoffman*,(*n*) a case decided under the Act of 1852, which provided for the registration of assignments,(*o*) it was held that an assignee could not sue until his assignment had been registered, otherwise as the statute provided that before such registry the original patentee should be deemed the sole owner, a defendant would be liable to be sued at one

(*g*) Stewart *v.* Carey, (1892) 9 R. P. C. 9, judgment of Bowen, L.J.

(*h*) See p. 337 *ante*.

(*i*) See *post*.

(*k*) See Van Gelder Co. *v.* Sowerby, Limited, (1890) 7 R. P. C. 41, 208.

(*l*) In the Matter of Parnell's Patent, (1888) 5 R. P. C. 126, 130.

(*m*) rr. 67 to 73.

(*n*) (1857) 7 E. & B. 686.

(*o*) 15 & 16 Vict. c. 83, s. 35.

Registration of Assignments.

and the same time by the grantee and assignee of the letters patent. It would appear that the reasoning upon which this case was decided applies equally to the law as it now stands.

In *Hassall* v. *Wright*,(*p*) which differed from *Chollet* v. *Hoffman* in that it was an action between assignee and assignor, whereas the latter case was between assignee and third parties, it was decided that the assignee could maintain an action against the assignor and his licensees, who had notice of the assignment, notwithstanding the fact that the assignment had not been registered.

Has registration a retrospective effect?

The question as to whether the registration of an assignment has a retrospective effect, so as to place the assignee in a position to sue for and recover damages in respect of infringement committed after the assignment, but before the registration, has not been judicially determined, but it is submitted that the registration being merely an evidence of title, relates back to the date of the assignment, and that the assignee, on having his title perfected, is entitled to maintain the action.(*q*)

Where the plaintiff in an infringement action derived his title to the patent under an assignment from the executors of the patentee, and it appeared that the assignment was made after probate was granted, but before it was registered, and that the deed of assignment was not registered until after the registration of the probate, it was held that the plaintiff was entitled to maintain his action.(*r*)

Surrender.

Letters patent may be surrendered to the Crown.

A patentee or an assignee may dispose of the patent by surrender to the Crown, the effect being to extinguish the privilege. If there is more than one patentee or assignee, all should join in a surrender of the patent, though probably a joint patentee or assignee might surrender his part of the patent.

The surrender of a patent must be made by deed, which requires enrolment, for nothing can be conveyed to the Crown except by matter of record.(*s*)

(*p*) (1870) L. R. 10 Eq. 509; 40 L. J. N. S. Ch. 145.

(*q*) Hassall *v.* Wright, (1870) L. R. 10 Eq. 509.

(*r*) Ellwood *v.* Christy, (1864) 17 C. B. N. S. 754; 18 C. B. N. S. 494; 34 L. J. C. P. 130.

(*s*) Hindmarch on Patents, 247.

CHAPTER IX.

LICENCES.

Origin of Power to Grant Licences.

Query whether patentee could grant licences without express authority.

It is open to question whether a patentee could give a valid licence authorising another person to exercise the privilege granted by the Crown, which is of a personal nature, unless the power to grant such licence was expressly given by the letters patent themselves, which, as we have seen, not only grant, but actually create the monopoly.(*a*)

Old form of letters patent.

The old form in which letters patent were granted gave express power to the grantee to authorise his licensees to perform the invention.

Present form of letters patent.

Express power of granting licences is likewise conferred on the patentee by the form prescribed by the Act of 1883, which, or which slightly modified to meet special circumstances, is now used for the grant of letters patent for inventions.(*b*) The grant is made to the "patentee," which by a previous recital means the grantee, his executors, administrators, and assigns; and then follows a prohibition to all the Queen's subjects whomsoever, within the United Kingdom of Great Britain and Ireland, and the Isle of Man, that they do not at any time during the continuance of the term for which the patent is granted, either directly or indirectly, make use of or put in practice the invention, or any part of the same, nor in anywise imitate the same, nor cause to be made any addition thereto or subtraction therefrom, whereby to pretend themselves the inventors thereof, without the consent, licence, or agreement of the 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 the royal command, and of being answerable to the patentee, according to law, for his damages thereby occasioned. And the letters patent further contain a proviso that nothing therein contained shall prevent

(*a*) p. 344 *ante*.

(*b*) See p. 741 *post*.

How Licences may be Granted.

the granting of licences in such manner and for such considerations as they may by law be granted.

Powers of co-owners to grant licences.

Each of two or more co-owners of a patent is entitled to work the invention for himself, and to assign his share, but there is some doubt whether he is entitled to grant licences without the consent of his co-owner.(*c*)

The question whether one of several co-owners is entitled to grant a licence alone depends on the words of the letters patent.(*d*) If, as in *Mathers* v. *Green*,(*e*) the grant is made to the grantees, their executors, administrators, and assigns, that they and every of them, by themselves, their servants and agents, *and such others as they shall agree with*, and no others, may use the invention, then it is submitted that no licence could be granted without the concurrence of all the patentees.(*f*)

Royalties received by co-owners.

Each co-owner is entitled to retain whatever profit he makes by his own working of the invention, though it is open to question whether, if he is entitled to and does grant licences, he is not liable to account to his co-owners for the royalties he receives.(*g*)

Mortgagee in possession may grant licences.

A mortgagee in possession may grant licences; but he is liable to account to the mortgagor in an action for redemption for royalties received, as being profits made by him whilst mortgagee in possession.(*h*)

How Licences may be Granted.

Form in which licences must be granted.

The effect of the prohibiting clause in the letters patent seems to make it compulsory that the licence must be under the hand and seal of the patentee; that is to say, it must be made by deed, or rather, speaking strictly, by an instrument which is only of the nature of a deed, because it does not require delivery, and will not be refused in evidence, though unstamped.(*i*)

The prohibiting clause, however, must be read in conjunction with the provision contained in the latter part of the patent, which is in the words "but nothing herein contained

(*c*) Mathers *v.* Green, (1865) L. R. 1 Ch. 29; see p. 352 *ante*.

(*d*) See p. 741 *post* as to forms of letters patent at present in use in cases of grants to joint grantees.

(*e*) L. R. 1 Ch. 29.

(*f*) See Jessel, M.R., Powell *v.* Head, (1879) L. R. 12 Ch. D. 690.

(*g*) Dunnicliff *v.* Mallett, (1859) 7 C. B. N. S. 209; Walter *v.* Lavater, (1860) 8 C. B. N. S. 162; Mathers *v.* Green, (1865) L. R. 1 Ch. 29; Hancock *v.* Bewley, (1860) Johns R. 601.

(*h*) Steers *v.* Rogers, (1892) 9 R. P. C. 177; 10 R. P. C. 245.

(*i*) Chanter *v.* Johnson, (1845) 14 M. & W. 408.

shall prevent the granting of licences in such manner and for such considerations as they may by law be granted." If there is a writing purporting to be an agreement of licence between the parties which has been acted upon, it is not competent to either party to repudiate responsibility under it on the ground that it is not under seal.(*k*)

How Licences may be Granted.

A writing if acted upon is effective though not under seal.

Also an effective licence may arise from parol agreement,(*l*) if acted upon.

Licence may arise from a parol agreement acted upon.

In the case of an executory agreement for a licence under seal, it is a question of construction as to whether the grant of a formal deed is a condition precedent; and, if this is not so, the agreement is, in equity, equivalent to a formal deed of licence in questions affecting the rights of the parties.(*m*) For example, in *Tweedale* v. *Howard and Bullough, Ltd.*,(*n*) it appeared that negotiations had taken place between the plaintiff and defendants, which in the plaintiff's view resulted in an arrangement for a licence. There never was a complete agreement between the parties as to the terms of the licence by deed which was intended to be entered into; but they had, whilst negotiating as to the terms of the deed, entered into a binding agreement which covered part of the ground contemplated, and which rendered the defendants licensees up to a specific date. The plaintiff accordingly obtained a declaration that the defendants were licensees up to that date, and also an account of royalties due.

Necessity for a formal deed is a question of construction in cases of executory agreements.

An agreement for a licence made before the patent is granted and in contemplation of the grant may be sued upon after the grant. Thus, where an applicant before filing his complete specification granted a licence to use the invention, and the licensees on being sued, after the grant of the patent, for the payment of royalties refused to pay, on the ground that the letters patent were obtained for an invention less than the whole invention described in the provisional specification, *Chitty*, J., held that, on the construction of the licence, without deciding the point so raised by way of defence, the bargain was that in the circumstances the royalties should be paid.(*o*)

Agreement for licence prior to the grant of the patent.

A licence to use a patented invention, if made by deed, bears a ten-shilling stamp; and an *ad valorem* stamp is required in cases where a fixed sum is paid as consideration. In cases

Stamps.

(*k*) Chanter *v.* Dewhurst, (1844) 12 M. & W. 823; 13 L. J. Ex. 198; Chanter *v.* Johnson, (1845) 14 M. & W. 408; Post Card Automatic Supply Co. *v.* Samuel, (1889) 6 R. P. C. 560.

(*l*) Crossley *v.* Dixon, (1863) 10 H. L. C. 291.

(*m*) Post Card Automatic Supply Co. *v.* Samuel, (1889) 6 R. P. C. 560; Tweedale *v.* Howard and Bullough, Ltd., (1896) 13 R. P. C. 522.

(*n*) (1896) 13 R. P. C. 522.

(*o*) Otto *v.* Singer, (1889) 7 R. P. C. 7.

Classification of Licences.

where the licensee covenants to pay a minimum royalty the Stamp Office requires an *ad valorem* duty to be paid on the gross minimum royalty, and this whether or not the licence is determinable.

A mere licence in writing does not require any stamp, but if the writing amounts to an agreement it must be stamped accordingly.(*p*)

Classification of Licences.

Licences to use patented inventions may be—

(1) *Expressed.*
(2) *Implied.*

Sale of patented article without restrictions gives purchaser right to use where and how he pleases.

The sale of an article without any restriction, whether manufactured under a British or foreign patent, as against the vendor, gives the purchaser an implied licence to deal with the article in any way he thinks fit, and of course that includes selling in any country where there is a patent in the possession of, and owned by, the vendor.(*q*)

The vendee of a licensee has all the privileges of an ordinary vendee, including that of resale. Thus, where the defendant in an action for the infringement of a patent for improvements in the manufacture of soap pleaded that the alleged infringement was the resale by him of soap purchased by himself from licensees of the plaintiff, the Court of Common Pleas held this to be a good defence, and gave judgment for the defendant accordingly.(*r*)

What the letters patent prohibit the public from doing without the consent, licence, or agreement of the patentee, is the making use of, or putting in practice, the invention comprised in the patent—that is, the art by the exercise of which the patentee produces the finished product.

When use of a patented article is an infringement.

The public are generally entitled to use the invention in the sense of the finished product without the further licence of the patentee, if that finished product was not produced in infringement of the patent—*i.e.*, it was produced by the patentee, or under licence from him.

Use of a manufactured article only constitutes an infringement when the article used was produced without authority;(*s*)

(*p*) Wilson *v.* Union Oil Mills, (1892) 9 R. P. C. 62.

(*q*) Société Anonyme des Manufactures des Glaces *v.* Tilghman's Patent Sand Blast Company, per Cotton, L.J., (1883) L. R. 25 Ch. D. 9; Betts *v.* Willmott, (1870) L. R. 6 Ch. 239; Heap *v.* Hartley, (1888) 5 R. P. C. 603; 6 R. P. C. 495; but see p. 379 *post*.

(*r*) Thomas *v.* Hunt, (1864) 17 C. B. N. S. 183.

(*s*) p. 497 *post*.

or where it was produced under a licence strictly limited to its manufacture and not applicable to its use,(*t*) for a licence to manufacture an article does not necessarily imply a licence to use the article when manufactured.(*u*)

Classification of Licences.

Licences to use patented inventions may also be—

(1) *Compulsory.*
(2) *Voluntary.*

Patentee may be compelled to grant licences.

Previous to the Act of 1883 it was optional with the grantee of a patent whether he would grant licences authorising other persons to use the invention, but s. 22 of the Act of 1883 (which only applies in this respect to patents granted on applications since January 1, 1884),(*x*) enacts (*y*) as follows:—

> 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 licences 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 licences 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.(*z*)

It is to be observed that neither the Act nor the Rules give any powers either to the Board of Trade, or the Comptroller, over the costs incurred on presenting a petition for the grant of a compulsory licence.

Appeal from the decision of the Board of Trade.

The Act does not directly provide for any appeal from the decision of the Board of Trade, and in the case of a refusal on the part of the Board to grant an application there is absolutely no appeal; but it would appear that in the event of the Board granting the prayer of the petition the patentee may obtain a revision of the Board's decision by leaving the petitioner to move for a mandamus to enforce the order. A writ of mandamus is a prerogative writ, and not a writ of right, and it is in this sense in the discretion of the Court whether

(*t*) Basset *v.* Graydon, (1897) 14 R. P. C. 701.
(*u*) *Ibid.*
(*x*) 46 & 47 Vict. c. 57, s. 45 (2).
(*y*) 46 & 47 Vict. c. 57, s. 22.

(*z*) The practice on an application for the grant of a compulsory licence is governed by rules 60 to 67 inclusive of the Patent Rules, (1890); 51 & 52 Vict. c. 50, s. 25.

Classification of Licences.

it shall be granted or not. The Court may refuse to grant the writ, not only on the merits, but upon some delay, or other matter personal to the party applying for it; in this the Court exercises a discretion which cannot be questioned. So in cases where the right, in respect of which a rule for a mandamus has been granted upon showing cause, appears to be doubtful, the Court frequently grants a mandamus in order that the right may be tried upon the return; this is also a matter of discretion.(*a*) The writ may be refused on a consideration of the special circumstances of a particular case,(*b*) and it was refused where it was impossible, owing to want of funds, to perform an order of the Board of Trade.(*c*)

Licences may also be—

(1) *Revocable.*
(2) *Irrevocable.*

Licences containing provisions for revocation.

Frequently the licence contains a provision under which it may be revoked and terminated by one or both of the parties on the happening of certain events, such as the non-payment of royalties or a decision of a Court of law to the effect that the patent is void. In the latter case, where the patent is in fact declared invalid in an action against third parties, but the decision of the Court is afterwards reversed, even though by consent, the licensee cannot rely upon the decision of invalidity since it was reversed, and under such circumstances he is liable to the licensor in an action to recover unpaid royalties.(*d*)

When from an examination of the whole instrument it appears clear that the intention of the parties was that the licence was to be irrevocable, neither party can, without the consent of the other, put an end to it.(*e*)

Licence coupled with an interest is not revocable, though a mere licence is revocable.

If the licence is silent as to the power of the parties to revoke it, it then becomes of the utmost importance to decide whether the licence is one coupled with an interest or not. A mere licence is, in the absence of provisions to the contrary, revocable at the will of either party;(*f*) but a licence coupled with an interest cannot be so revoked.(*g*)

(*a*) Per Lords Chelmsford and Hatherley, R. *v.* Churchwardens of All Saints', Wigan, (1876) L. R. 1 App. Cas. 620, 622.

(*b*) R. *v.* Garland, (1870) L. R. 5 Q. B. 269.

(*c*) *Re* The British and North Somerset Ry. Co., L. R. 3 Q. B. D. 10.

(*d*) Cheetham *v.* Nuttall, (1893) 10 R. P. C. 321.

(*e*) Kenny's Patent Button-holing Co. *v.* Somervell, (1878) 26 W. R. 787; 38 L. T. N. S. 870.

(*f*) Wood *v.* Ledbitter, 9 Jur. 187; Redges *v.* Mulliner, (1893) 10 R. P. C. 21; Crossley *v.* Dixon, (1863) 10 H. L. C. 291.

(*g*) Wood *v.* Ledbitter, 9 Jur. 187; Ward *v.* Livesay, (1888) 5 R. P. C. 102; Guyot *v.* Thomson, (1894) 11 R. P. C. 541; Cutlan *v.* Dawson, (1897) 14 R. P. C. 249; 13 R. P. C. 716–717.

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"Coupled with an interest" is a somewhat ambiguous term, and it is probably more correct, with reference to licences to use patented inventions, to say "coupled with obligations."(*h*)

Though a licence is one coupled with an interest, or involving obligations on each of the parties, and so not revocable, yet it may, upon the terms of the instrument, be liable to forfeiture in the event of breach of the terms and conditions on which it was made.(*i*)

When from the terms of the licence it appears not to be coupled with obligations on either the licensor or licensee it is, as stated above, generally speaking, revocable at the will of either party.(*k*)

When, however, the licence is coupled with obligations on both the parties it is not so revocable—*e.g.*, where the licence is exclusive and the licensor is under the obligation not to use the patented invention himself, and the licensee is under the obligation to use his best endeavours to advertise and push the invention.(*l*)

Licence providing for revocation by one party only.

And where the agreement expressly provides that one party may determine the licence, but is silent as to the power of the other party to put an end to it, the Courts will infer an intention to the effect that the licence is not determinable by such other party.(*m*)

Revocation need not necessarily be by deed.

In the absence of express provision, if the licence is revocable, whether it be made by deed or otherwise, a deed is not necessary to revoke it.(*n*) It may be revoked by an expression of intention to revoke; but a mere plea in a defence to an action to recover royalties, to the effect that a licence has been abandoned, is not a notice of determination, and consequently in an action to recover royalties, when an account is obtained, the account, notwithstanding such a plea, goes in respect of user after action brought till the proper determination of the licence.(*o*)

Party to a licence may contract not to exercise his power of revocation.

Though a licence be one which is revocable at the will of one or of either of the parties, yet, upon the true construction of the agreement, the party or parties having the power of revoking the license may have contracted not to exercise it,

(*h*) Guyot *v.* Thomson, (1894) 11 R. P. C. 553.

(*i*) Ward *v.* Livesey, (1888) 5 R. P. C. 182.

(*k*) Wood *v.* Ledbitter, 9 Jur. 187; Ridges *v.* Mullinar, (1893) 10 R. P. C. 21; Crossley *v.* Dixon, (1863) 10 H. L. C. 293.

(*l*) Guyot *v.* Thomson, (1894) 11 R. P. C. 541.

(*m*) Cutlan *v.* Dawson, (1897) 14 R. P. C. 249; 13 R. P. C. 716–717; Guyot *v.* Thomson, (1894) 11 R. P. C. 541.

(*n*) Ward *v.* Livesey, (1888) 5 R. P. C. 102.

(*o*) Cheetham *v.* Nuttall, (1893) 10 R. P. C. 321.

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in which case, in the event of a revocation, an action for damages in respect of the breach of contract would be maintainable.(*p*)

Licences may also be—

(1) *General.*
(2) *Limited.*
(3) *Exclusive.*

General licences.

General licences are those which include the right to use every part of the invention, and apply to the whole of the geographical area for which the patent was granted.

Limited licences.

Limited licences may be limited in the sense that they apply only to a part of the invention; or to the construction or use of a patented article, but not to both; (*q*) or to the use of the invention in a particular manner, (*r*) or in a particular district, (*s*) or for a specified portion of the term for which the patent was granted.

Exclusive licences.

Exclusive licences are those under the terms of which the patentee is prevented from making a like grant to any one other than the licensee during the continuance of the licence.

Not unfrequently patentees grant exclusive licences for the whole or some particular part of the invention, applying to the whole or some particular part of the geographical area over which the patent right extends. It is usual to insert in an exclusive licence a covenant on the part of the patentee to the effect that he will not grant any other licence authorising any other person to use the invention within the district to which the licence applies. It may be questioned whether such a covenant divests the patentee of all power of granting any other licence in breach of his covenant, so far as the validity of such other licence is concerned; but he would be clearly liable in damages if he were to do so.

An irrevocable exclusive licence for the whole term of the patent which reserves no interest to the licensor operates as an assignment.

If an exclusive licence be made irrevocable and applicable to the whole geographical area of the patent right, and reserves no interest in the patent to the licensor, it is a grant, or an agreement for a grant, and amounts to an assignment, or an agreement for an assignment, of the patent; (*t*) and it would

(*p*) Kerrison *v.* Smith, (1897) 2 Q. B. 445.

(*q*) Basset *v.* Graydon, (1897) 14 R. P. C. 701.

(*r*) Société Anonyme pour la Fabrication d'Appareils d'Eclairage *v.* Midland Lighting Co., (1897) 14 R. P. C. 419; Incandescent Light Co. *v.* Cantelo, (1895) 12 R. P. C. 262.

(*s*) Société Anonyme des Manufactures des Glaces *v.* Tilghmann's Patent Sand Blast Co., (1883) L. R. 25 Ch. D. 11.

(*t*) Guyot *v.* Thomson, (1894) 11 R. P. C. 554; Heap *v.* Hartley, (1889) 6 R. P. C. 500.

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appear that if the licence is made by deed, since no particular form of words is required to effect an assignment, such an exclusive licensee would be entitled to apply to have his name entered on the register of patents as the owner for the time being.(*u*)

An exclusive licence operates as an assignment of the patent in the same way as a demise by a lessee of the premises comprised in his lease for the whole of the term granted amounts to an assignment to the under-lessee.(*x*) For an assignment is a transfer or making over to another of the whole right of the assignor in the thing transferred,(*y*) and any words which show an intention to do this in a deed are sufficient with respect to a patent-right.(*z*)

Exclusive licence which reserves an interest to licensor is not an assignment.

If, however, the exclusive licence reserves to the patentee any direct interest in the patent—*e.g.*, the right to sue for infringements of the patent—it does not amount to an assignment.(*a*) A deed conferring an exclusive licence not amounting to an assignment is not a conveyance within the meaning of the Conveyancing Act, 1881; but the introduction of the words "as beneficial owner" into the deed may tend to show an intention that the licence is not to be revocable.(*b*)

Grantor of exclusive licence may be restrained from infringing.

A patentee who grants an exclusive licence may be restrained by the licensee from working or selling under the patent during the continuance of the licence when there is no reservation to the patentee to so work and sell.(*c*)

Exclusive licensee's rights to make departures in details from the invention.

The exclusive licensee is entitled to make unimportant departures in details from the specification, and may restrain the patentee, by injunction of the Court, from representing that articles so made and sold by him, the licensee, are not made in accordance with the patent.(*d*)

Licences may also be—

(1) *Assignable.*
(2) *Not assignable.*

Whether a licence is assignable or not depends on its terms.

A licence may be made to an individual only, or to him, his executors, administrators, and assigns, and the question whether or not a licence is assignable depends in each case upon the words by which it was granted.

In *Bown* v. *Humber* (*e*) it appeared that the plaintiff, the

(*u*) See p. 337 *ante;* Heap *v.* Hartley, (1889) 6 R. P. C. 495, 500.

(*x*) Palmer *v.* Edwards, (1779) 1 Doug. 187 n; Parmenter *v.* Webber, (1818) 8 Taunt. 593; 2 B. Mo. 656; Shep. Touch. 266.

(*y*) 2 Bl. Com.

(*z*) p. 347 *ante.*

(*a*) Guyot *v.* Thomson, (1894) 11 R. P. C. 554.

(*b*) *Ibid.*

(*c*) *Ibid.* p. 541.

(*d*) *Ibid.*

(*e*) (1889) 6 R. P. C. 9.

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owner of a patent for improvements in the bearings of bicycles in the year 1885, granted to a firm of bicycle manufacturers a licence to use the invention within the United Kingdom, the Channel Islands, and the Isle of Man, for the purpose of applying the invention to the wheels of bicycles, &c., manufactured for sale or use or otherwise by the licensees, or by persons employed by them, but not in any other manner, with a proviso that the licence should not be construed to permit the licensees to make or sell the patent bearings to be applied to the wheels of bicycles, &c., manufactured by any other person or company other than the licensees, or by persons employed by them ; and that the licence should not authorise the use of the said invention by the licensees individually or separately, but only by the licensees jointly, or such two or one of them as should continue to carry on the business hitherto carried on by the three licensees at Beeston, or the person or persons or company from time to time carrying on such business. In 1887 the defendants were registered as a limited company to acquire and carry on the business of the licensees and various other businesses at other places. The defendants claimed under the licence the right to manufacture the patent bearings at all places where they carried on business, and also to apply the patent bearings to all bicycles, &c., manufactured by them, whether manufactured by them at Beeston or elsewhere. The plaintiff contended that the licence only authorised the defendants to manufacture the patent bearings at Beeston, in connection with the business of the original licensees ; and, secondly, only to apply the patent bearings to all bicycles, &c., manufactured by them at Beeston in connection with the said business; and the plaintiff brought the action and moved for an injunction to restrain the defendants from using the patent otherwise than according to the plaintiff's construction of the licence, but the Court held that the defendants, as carrying on the original business of the licensees at Beeston, were entitled to start other businesses elsewhere, and to apply the patent bearings to any bicycles, &c., manufactured by them in such other businesses, and dismissed the action with costs.

Patentee is estopped from disputing assignability if he accepts royalties from an assignee.

When a patentee has accepted royalties from an assignee of the licensee he is estopped from contending that the licence was not assignable.(*f*)

(*f*) Lawson *v.* Donald Macpherson and Co., (1897) 14 R. P. C. 696.

Right of the Crown to Use Inventions.

Right of Crown to free use of inventions patented prior to 1884.

The Crown has the right to use the inventions comprised in all letters patent granted before the commencement of the Act of 1883, *i.e.*, January 1, 1884, or on any application then pending. And the Crown has the power to use any such invention without the assent of, or compensation to, the patentee.(*g*) The Crown enjoys this right, not because it is exempted from the effect of the letters patent, but because the privilege thereby granted is granted against the subjects only, and not against the Crown.(*h*)

Crown only entitled to use inventions patented after January 1, 1884, on terms.

With regard to all patents granted on applications dated after January 1, 1884, it is provided by the Act of 1883(*i*) that they shall have to all intents the like effect as against her Majesty the Queen, her heirs and successors, as they have against a subject. But the officers or authorities administering any department of the service of the Crown may, by themselves, their agents, contractors, or others, at any time after the application, use the invention for the 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.

Government contractors.

Contractors who supply the Government with manufactured articles are not servants of the Crown, aud if such articles are manufactured according to a patented invention, without the licence of the patentee, the manufacturers are liable to be sued by the patentee for infringement.(*k*)

Procedure to question Crown's authority to use a patented invention.

It is submitted that the patentee's remedy, in case he wishes to question the authority of the Crown to use the patented invention, is by petition of right, and not by action against the officer of the Crown using the invention. With regard to patents granted prior to the Act of 1883, the reverse was the case.(*l*) But, since the patent now has the like effect against the Crown as against a subject, and the officers or authorities administering any department of the service of the Crown are

(*g*) Feather *v.* The Queen, (1865) 6 B. & S. 257; Dixon *v.* The London Small Arms Co. Ltd., (1875) L. R. 1 App. Cas. 632.

(*h*) Per Lord Selborne, Dixon *v.* The London Small Arms Co., Limited. (1875) L. R. 1 App. Cas. 659.

(*i*) 46 & 47 Vict. c. 57, ss. 27 and 45 (2).

(*k*) Dixon *v.* The London Small Arms Co., Ltd., (1875) L. R. 1 App. Cas. 632.

(*l*) Feather *v.* The Queen, (1865) 6 B. & S. 257; Walker *v.* Congreve, (1816) 1 Coop. P. C. 356.

Consideration. Covenants.

authorised to use the invention upon terms the settlement of which is not a condition precedent, it would, it is submitted, appear that the proper procedure now is by petition of right.(*m*)

Consideration.

No restriction as to consideration for a licence to use a patented invention.

There is no restriction as to the consideration in respect of which a licence may be granted. When a licence is granted by deed, it is, of course, not necessary that there should be any consideration at all.

The patentee generally grants licences in return for some consideration, which is usually a money payment, either of a fixed amount, or a sum varying according to the extent to which the licensee uses the invention, or of a fixed royalty in respect of every single article manufactured by the licensee according to the invention, or a royalty on profits.

Covenants.

Usual covenants.

It is usual to insert in a licence which is granted in consideration of a periodical or other payment, a covenant on the part of the licensor that the patent is valid so far as his acts or omissions are concerned, and that he has power to grant the licence, and on the part of the licensee a covenant for payment of the various sums as they become due. And if the sums reserved vary with the extent of the licensee's user of the invention, it is usual for him to covenant to render accounts to the patentee, and to permit periodical inspections of premises and machinery.(*n*)

It is usual also to insert conditions avoiding the licence altogether if the licensee fail to pay any of the sums and royalties reserved by the licence, or to perform any of his covenants.(*o*)

In the interests of a patentee it is absolutely necessary that a licence which is made in consideration of periodical payments should contain covenants on the part of the licensee for payment of the sums reserved, and a proviso terminating the licence if default is made; otherwise a defaulting licensee might assign the licence (if assignable),(*p*) and so escape all liability in respect of it.

(*m*) Feather *v.* The Queen, (1865) 6 B. & S. 257; Walker *v.* Congreve, (1816) 1 Coop. P. C. 356.

(*n*) p. 777 *post.*
(*o*) p. 777 *post.*
(*p*) p. 375 *ante.*

Estoppel.

It is not unusual for the patentee to covenant that if he grants licences to others upon more favourable terms the licensee shall have the benefit of such terms.(*q*)

To meet the requirements of particular cases many other covenants and conditions may be requisite and need careful consideration as occasion arises.

Difference between licence to work under a foreign patent and the unconditional sale of an article made under a foreign or British patent.

A licensor is not entitled to interfere with the trade of his licensee pending disputes as to collateral matters; (*r*) but the owner of both English and foreign patents, who has granted a licence to work under one or all of the foreign patents, but not under the English patent, will not be restrained from issuing circulars, warning the public that the sale in England of articles made abroad according to the patented invention is an infringement of the English patent.(*s*) A licence to use a patented invention under a foreign patent stands in a very different position to the sale of an article manufactured under either a foreign or an English patent.

Estoppel.

Estoppel in virtue of recitals or covenants implying validity.

A licensee, who has covenanted with the patentee to pay a royalty for the right to use a patented invention, is, by recitals or covenants implying the validity of the patent, estopped, during the continuance of the licence, from denying that validity as against the licensor in any legal proceedings to which they are both parties;(*t*) and he is so estopped independent of estoppel by deed,(*u*) and even when he has used the invention under a mere verbal agreement.(*x*)

No estoppel against denial of the existence or ambit of a licence.

The licensee is entitled to dispute the existence of the licence. Thus where it is made coterminous with the existence of the

(*q*) In Cheetham *v.* Nuttall, (1893) 10 R. P. C. 321, the licensee was unsuccessful on the facts in establishing his claim to a revision of terms.

(*r*) Clark *v.* Adie, (1873) 21 W. R. 456, 764.

(*s*) Société Anonyme des Manufactures de Glaces *v.* Tilghman's Patent Sand Blast Co., (1883) L. R. 25 Ch. D. 1; Betts *v.* Willmott, (1870) L. R. 6 Ch. 239.

(*t*) Baird *v.* Neilson, (1842) 8 Cl. & Fin. 726; Cutler *v.* Bower, (1848) 11 Q. B. 973; 17 L. J. Q. B. 217; Hills *v.* Laming, (1853) 9 Exch. 256; 23 L. J. Ex. 60; Bowman *v.* Taylor, (1834) 2 A. & E. 278; 1 W. P. C. 292; Lawes *v.* Purser, (1856) 6 E. & B. 930; 26 L. J. Q. B. 25; Norton *v.* Brooks, (1861) 7 H. & N. 499; Smith *v.* Scott, (1859) 28 L. J. C. P. 325; 6 C. B. N. S. 771; Bessmans *v.* Wright, (1858) 6 W. R. 719; Crossley *v.* Dixon, (1863) 10 H. L. 293; 32 L. J. Ch. 617; Hall *v.* Conder, (1857) 2 C. B. N. S. 22, 53; 26 L. J. C. P. 138, 288; Trotman *v.* Wood, (1864) 16 C. B. N. S. 479; Clark *v.* Adie, (1877) L. R. 2 App. Cas. 423; Liardet *v.* Electric Lighting Co., (1883) W. N. 96; Ashworth *v.* Law, (1890) 7 R. P. C. 231; Wilson *v.* Union Oil Mills, (1892) 9 R. P. C. 63; but see p. 381 *post*.

(*u*) Lawes *v.* Purser, (1856) 6 E. & B. 930; Norton *v.* Brooks, (1861), 7 H. & N. 499.

(*x*) Crossley *v.* Dixon, (1863) 10 H. L. C. 293, 308, 310; Clark *v.* Adie, (1873) L. R. 2 App. Cas. 423.

Estoppel.

patent the licensee is not estopped in an action for royalties from contending that the patent has in fact expired, *e.g.*, on the ground that its life depended on that of a foreign patent which has lapsed.(*y*)

Estoppel terminates with the licence.

After the termination of the licence, the licensee may dispute the validity of the patent,(*z*) but he cannot sell articles as manufactured under licence from the patentee.(*a*)

Licence to construct only may operate as an estoppel against a third party, with notice, using a patented article.

When the licence is limited to the construction as opposed to the use of a patented article when constructed, a question may arise as to the right of a third party for whom the article was constructed under the licence to deny the validity of the patent as against the patentee. It may well be that if the third party knew the nature of the licence when he gave the order for the construction an estoppel by conduct arises, and such third party is at the mercy of the patentee as to the terms upon which he may be permitted to use the article. There does not appear to be any authority against the existence of such a state of things.(*b*)

Licensee though estopped from denying validity may dispute ambit of patentee's claim.

Though the licensee during the continuance of the licence is estopped from denying the validity of the patent as against the licensor in an action for the recovery of royalties, he is entitled to dispute the ambit of the patentee's claim.(*c*) Thus he may dispute the construction put upon the specification by the licensor, and contend that the acts done by him in respect of which it is sought to make him liable in royalties are not covered by the patent upon the true construction of the specification, *i.e.*, they would not be held to be infringements in an action brought for infringement.(*d*) And, for the purpose of showing the true ambit of the claim, he may refer to anything which shows the state of public knowledge at the date of the patent.(*e*)

A licensee under a patent is in a situation analogous to a tenant who, during the tenancy, cannot dispute the title of the lessee to any of the land held under the lease; but who is nevertheless at liberty to show that part of the land he actually

(*y*) Muirhead *v.* Commercial Cable Co., (1894) 11 R. P. C. 317; 12 R. P. C. 39, 370.

(*z*) p. 381 *post*.

(*a*) Postcard Automatic Supply Co. *v.* Samuel, (1889) 6 R. P. C. 560.

(*b*) Basset *v.* Graydon, (1897) 14 R. P. C. 711.

(*c*) Crossley *v.* Dixon, (1863) 10 H. L. C. 293; Adie *v.* Clark, (1876) L. R. 2 App. Cas. 423; Cropper *v.* Smith, (1884) L. R. 26 Ch. D. 700; Couchman *v.* Greener, (1884) 1 R. P. C. 197; The Useful Patents Co. *v.* Rylands, (1885) 2 R. P. C. 253; Siemens *v.* Taylor, (1892) 393.

(*d*) Young *v.* Hennand Oil Co., (1891) 8 R. P. C. 285; 9 R. P. C. 373; Ashworth *v.* Roberts, (1892) 9 R. P. C. 89, 309.

(*e*) Young *v.* Hennand Oil Co. (1892) 9 R. P. C. 373.

occupies is really not comprised within the lease, but belongs to himself under some other right.(*f*)

Estoppel.

If the licensee, as is commonly done, is sued for infringements as well as royalties, it is open to him to plead the determination of the licence, if, in fact, he has determined it; and then he can also dispute the validity of the patent.(*g*) It is thus open to a licensee, by a revocation of the licence where such is possible, to turn himself from a licensee into a trespasser and wrongdoer if the patent is valid, but a lawful user if the patent is void.

Determination of licence may be pleaded in action to recover royalties.

A licensee (not a party to the action) cannot be compelled to give inspection in an action against the licensor, but if the licensor can arrange for an inspection it is proper he should do so; and if it appear that the licensor is himself or by his licensee working the process in dispute the usual order for inspection will be made.(*h*)

Inspection against licensee not a party to an action against his licensor.

A licensee is a competent witness for the plaintiff in an action for the infringement of a patent under which he has a licence. He has no direct pecuniary interest in supporting the patent, and it may be for his advantage that it should not be supported.(*i*)

Licensee is a competent witness in an action brought by the patentee.

Where a person has agreed, not under seal, with the patentee to pay a certain sum of money, annually or otherwise, for the use of a patented invention, but has not actually used the invention, he is not estopped from denying the validity of the patent in an action brought against him by the patentee for recovery of royalties.(*k*)

No estoppel against a person who has made an agreement, not under seal, for a licence, but has not used the invention.

An equitable assignee of an exclusive licensee also is not estopped, in an action brought against him by the patentee for infringement, from disputing the validity of the patent.(*l*)

No estoppel against an equitable assignee of an exclusive licence.

If it is the intention of the parties that it is to be open to the licensee to dispute the validity of the patent, then the licence ought to be specially framed to allow of this by the insertion of covenants on the part of the licensor for title to grant the licence, and that the patent is valid.

Right to dispute validity may be specially provided for.

If there are no express covenants on the part of the licensor as to his power to grant the licence, and as to the validity of the

(*f*) Per Lord Blackburn, (1873) Clark *v.* Adie, L. R. 2 App. Cas. 435.

(*g*) Redges *v.* Mullinar, (1892) 10 R. P. C. 21; Crossley *v.* Dixon, (1863) 10 H. L. C. 293.

(*h*) Germ Milling Co. *v.* Robinson, (1886) 3 R. P. C. 11, 14.

(*i*) Per Lord Abinger, C. B., Derosne *v.* Fairie, (1835) 2 Cr. M. & R. 476; 1 W. P. C. 154.

(*k*) Chanter *v.* Leese, (1838) 1 W. P. C. 295; 8 L. J. Ex. 58; 9 L. J. Ex. 327; 4 M. & W. 295; 5 M. & W. 698.

(*l*) Pidding *v.* Franks, (1849) 1 Mac. & G. 56; 18 L. J. Ch. 295.

Estoppel.

patent, the law will not import any, since the privilege created by letters patent is impressed with the nature of personality, and the law will not create a covenant respecting a personal thing.(*m*)

In *Hayne* v. *Maltby* (*n*) the action was brought for the breach of an agreement which recited that the plaintiffs were assignees of a patent granted to *T. Taylor*, and that the defendant had applied to the plaintiffs for permission to use the patented invention, to which they assented, on condition of his working it in the manner described in the specification. The agreement contained a covenant by the plaintiffs with the defendant that he should have the free use and quiet enjoyment of the patent machine, in case the same should be worked only in the manner described in the specification, and also a covenant by the defendant that he would not, during the residue of the term, use any of the patent machines except the one by the articles allowed to be used by him. Under these circumstances, the Court of King's Bench held that the defendant was not estopped from denying the validity of the patent, and gave judgment for him on the ground that the patent was void. It is to be noticed that the agreement merely recited that the plaintiffs were assignees of the patent, not that the patent was valid.(*o*)

After the termination of the licence, the licensee is in just the same position as the rest of the Queen's subjects, with regard to being able to deny the validity of the patent, if the patentee brings any action against him for infringement.(*p*)

In *Goucher* v. *Clayton* (*q*) it appeared that the plaintiff took proceedings in 1854 against a certain firm of *Clayton & Co.* for infringement of his patent. The firm submitted to a judgment in the action, and took a licence for five years (afterwards extended to seven) to work under the patent. The present suit was instituted in 1864 against the same firm, but two new partners had entered the firm after the judgment at law. The defendants raised the issues of want of novelty and sufficiency of the specification. *Wood*, V.C., overruled the objection that the defendants were estopped from denying the validity of the patent, both as having been licensees and by

(*m*) Com. Dig. tit. Covenant A. 4.

(*n*) (1789) 3 T. R. 438; 1 W. P. C. 291.

(*o*) See Bowman *v.* Taylor, (1834) 2 A. & E. 278; 1 W. P. C. 293; and remarks of Lord Cottenham, L.C., in Neilson *v.* Fothergill, (1841) 1 W. P. C. 290.

(*p*) Axmann *v.* Lund, (1874) L. R. 18 Eq. 330; 43 L. J. Ch. 655; Goucher *v.* Clayton, (1865) 11 Jur. N. S. 107; 34 L. J. Ch. 239; Dangerfield *v.* Jones, (1865) 13 L. T. N. S. 142; Neilson *v.* Fothergill, (1841) 1 W. P. C. 290.

(*q*) (1865) 11 Jur. N. S. 107; 34 L. J. Ch. 239.

reason of the judgment at law, and stated that in any case he could not prevent those defendants who were not parties to the action at law from setting up that defence. Registration.

It is not competent to the defendant to an action for infringement to set up alternative pleas to the effect that the acts complained of as infringements were either done under licence of the patentee, or the patent is itself invalid. He must adopt one line of defence or the other. Thus, where, in an action for infringement, the defendant, who was the mortgagee of certain articles manufactured under a licence which the plaintiff alleged was revoked, disputed the fact of revocation, and contended that the patent was invalid, the Court held that he must elect which line of defence he would adopt.(*r*) In action of infringement alternative pleas of no infringement in fact or acts done under licence are not allowable.

Registration.

A notification of every licence to work under a patent must be entered in the Register of Patents, and an attested copy of every licence granted under a patent must be left at the Patent Office by the licensee, with a request that a notification thereof may be entered in the register. The licensee must cause the accuracy of such copy to be certified as the Comptroller may direct, and the original licence must at the same time be produced and left at the Patent Office, if required, for further verification.(*s*) All licences should be registered.

The subject of the registration of licences has already been fully discussed in the chapter dealing with the proceedings at the Patent Office for obtaining a grant of letters patent.(*t*)

Recovery of Royalties.

The licensor has a right of action on the contract to sue for the recovery of royalties in arrear, and if successful he may obtain an account of profits against the licensee. Royalties may be recovered by action,

An account of profits, however, will not be granted against a licensee at the instance of the licensor or his assignee if there is proof that no profits have arisen, and not in any case unless all parties interested are before the Court.(*u*)

(*r*) Postcard Automatic Supply Co. *v.* Samuel, (1889) 6 R. P. C. 560.

(*s*) 46 & 47 Vict. c. 57, s. 23; P. R. (1890) r. 77.

(*t*) pp. 336–340 *ante*.

(*u*) Bergman *v.* Macmillan, (1881) L. R. 17 Ch. D. 423.

Recovery of Royalties.

even though the patent has been declared void.

Though previously to the commencement of an action for the recovery of royalties due under a licence the patent has been declared void in other proceedings, the defendant, if he be the licensee of the plaintiff, under a licence containing no covenant on the part of the licensor as to his title to grant the licence and as to the validity of the patent, cannot plead that the patent is bad.(*x*)

A licensee also who has covenanted to pay royalties for a term certain is bound to pay such royalties, though the patent is in the meantime declared void and cancelled,(*y*) and he cannot, in the absence of fraud, recover royalties which he has paid under a licence, though, after the termination of the licence, it should turn out that the patent is bad.(*z*)

So where a licensee under several patents covenanted to pay royalties in respect of anything manufactured under any of the patents until the effluxion of all the terms of years respectively granted by the said letters patent, he was held liable to pay royalties for the use of any of the inventions so long as any of the patents were subsisting.(*a*) Thus, in consequence of his covenant, a licensee may be compelled to pay for the use of an invention the subject of a lapsed or cancelled patent, whilst the rest of the public are entitled to use it free.

Fraud is a defence to an action to recover royalties.

Fraud is a defence to an action for the recovery of royalties, and it is also a ground on which a licensee, who has paid royalties under a licence tainted therewith, can recover the moneys he has disbursed.(*b*)

Royalties paid after breach of covenant by licensor.

Royalties paid by the licensee after, and without knowledge of, a breach of covenant by the licensor may be recovered. Thus, when the licensee agreed to pay royalties for a term certain, and the patentee covenanted to protect and defend the patent from infringement, and the patent lapsed through non-payment of renewal fees by the patentee, the licensee was held entitled to recover back the royalties he had paid after, and without knowledge of, the lapse. The reason for the decision was that the neglect of the patentee to pay the renewal fees was a breach of his covenant to protect and defend the patent

(*x*) Grover and Baker Sewing Machine Co. *v.* Millard, (1862) 8 Jur. N. S. 713.

(*y*) African Gold Recovery Co. *v.* Sheba Gold Mining Co., (1897) 14 R. P. C. 660.

(*z*) Taylor *v.* Hase, (1805) 1 B. & P. N. R. 260; 1 W. P. C. 292; Collinge *v.* Bowman, (1834) 1 W. P. C. 295.

(*a*) Siemens *v.* Taylor, (1892) 9 R. P. C. 393.

(*b*) Cutler *v.* Bower, (1848) 11 Q. B. 973; 17 L. J. Q. B. 217; Hall *v.* Conder, (1857) 2 C. B. N. S. 22; 26 L. J. C. P. 138; Lawes *v.* Purser, (1850) 6 E. & B. 930; 26 L. J. Q. B. 25; Smith *v.* Scott, (1859) 28 L. J. C. P. 325; 6 C B. N. S. 771.

against infringers, which implied a covenant to keep the patent in such a position that he should be able to do so.(*c*)

Recovery of Royalties.

Important questions as to the liabilities of licensees to pay royalties after breach of covenant by the patentee, *e.g.*, involving lapse of the patent, depend sometimes in particular cases upon whether or not the patentee's covenant for quiet enjoyment and the licensee's covenant to pay royalties are conditional and co-extensive or not. In the one case royalties may be claimed by the patentee notwithstanding his breach and the lapse of the patent; in the other case they cannot be so claimed. Moreover it must be remembered that an express condition for cesser of the payments will negative any implied condition for cesser.(*d*)

Action may be brought for recovery of royalties or in the alternative for relief in respect of infringement.

The action for recovery of royalties is frequently brought for the recovery of the royalties or, in the alternative, for an injunction and the usual relief to restrain infringement.(*e*) In such an action where it appeared that the plaintiff was the owner of three patents, under two of which the defendant was a licensee in arrear, and did not appear on the hearing of a motion for an interlocutory injunction, the Court granted an injunction restraining infringement, but specially worded the order so as not to restrain the defendant from working under the licence.(*f*)

Court may only be able to estimate royalties due.

On the taking of an account of royalties due for the use of an invention the Court may, under the circumstances of the case, only be able to estimate the real sum due; and, under such circumstances, the Court of Appeal will not lightly put aside the finding of the officer of the Court, who comes to a conclusion upon an estimate.(*g*)

Recovery of interest on unpaid royalties.

Whether or not a patentee can in a particular case recover interest on unpaid royalties depends on the question of fact, whether, upon the true construction of the licence, the overdue royalty is a sum certain payable at a fixed time by virtue of the instrument itself.(*h*)

Taxation pending an appeal.

The taxing master has a discretion as to proceeding with the taxation when an appeal is pending and shortly coming on for

(*c*) Lines *v.* Usher, (1896) 13 R. P. C. 685; 14 R. P. C. 206.

(*d*) Mills *v.* Carson, (1892) 10 R. P. C. 9.

(*e*) Wilson *v.* Union Oil Mills Co., (1892) 9 R. P. C. 57.

(*f*) Pneumatic Tyre Co. *v.* Ferguson, (1894) 11 R. P. C. 459.

(*g*) Alma Veneer Felt Co. *v.* Fisher, (1897) 14 R. P. C. 159.

(*h*) Muirhead *v.* Commercial Cable Co., (1894) 11 R. P. C. 346; Redges *v.* Mullinar, (1893) 10 R. P. C. 25; London, Chatham and Dover Ry. Co. *v.* South Eastern Ry. Co., (1893) L. R. App. Cas. 429; Merchant Shipping Co. *v.* Armitage, (1873) L. R. 9 Q. B. 99.

Licensor and Licensee Plaintiff in Action for Infringement.

hearing. Thus, when the taxing master on being informed at the taxation that an appeal was pending and might possibly be decided in three days time, in the exercise of his discretion, refused to proceed with the taxation pending the result of the appeal, the defendant took out a summons asking that the taxing master might be ordered to proceed with the taxation. The Court of Appeal decided that an order in the action refusing stay of execution was not so peremptory but that the taxing master had a discretion, which he had wisely exercised, and refused to grant the order asked for.(*i*)

When an action for the recovery of royalties is one of especial difficulty and importance, costs may be given on the higher scale.(*k*)

Licensor's and Licensee's Powers to Sue in Respect of Infringement.

Action for infringements at the instance of licensors and licensees respectively.

It is clear that a mere licensee having a simple licence to work under a patent cannot sue alone in respect of infringements of the patent, but he must join the patentee; since the patentee may grant a licence to any other person, the defendant in the action might possibly be a licensee also, and the infringement is an injury to the patentee and not to the mere licensee.(*l*)

It consequently follows that a patentee, who has merely granted simple licences, is entitled to sue alone in respect of any infringements without joining his licensees; for, since he may grant licences to whom he pleases, the injury affects him alone, and it would appear that a patentee, who has granted an exclusive licence, which does not amount to an actual assignment of the patent (*e.g.*, one which contains a power of revocation in the event of breach of covenant), may sue to restrain infringements without bringing the exclusive licensee before the Court; for the injury done to the patentee is distinct from that suffered by the exclusive licensee. The infringement affects the exclusive licensee by injuring his trade; it affects the patentee both by loss of reputation of the patent through infringements being permitted, and by loss of royalties, if royalties are paid for the licence.

An exclusive licensee, whether the licence is for a limited

(*i*) Muirhead *v.* Commercial Cable Co., (1895) 12 R. P. C. 258.
(*k*) *Ibid.* (1894) 12 R. P. C. 39.
(*l*) Newby *v.* Harrison, cited in Rennard *v.* Levinstein, 2 H. & M. 628; Derosne *v.* Fairie, (1835) 1 W. P. C. 155; Heap *v.* Hartley, (1888) 5 R. P. C. 603; 6 R. P. C. 495.

area or not, is not entitled to sue alone in respect of infringements, if the licence is not coupled with, or equivalent to an assignment, but the patentee must join as plaintiff (*m*) or be added as a defendant.

Licensor and Licensee Plaintiff in Action for Infringement.

In the case of exclusive licences it is usual to insert a covenant on the part of the patentee binding him to proceed against all persons who may infringe the patent, or to allow the licensee to do so in his name.(*n*)

The decision of Lord *Hatherley*, then Vice-Chancellor *Wood*, in *Renard* v. *Levinstein*,(*o*) appears to be an authority for the statement that an exclusive licensee is entitled to sue alone to restrain infringements within the area of the exclusive licence. It must, however, be noticed that in that case the owners of the patent were joined as defendants, and there does not appear to be any decided case in which the licensee has been allowed to sue without the patentee being a party.(*p*)

(*m*) Heap *v.* Hartley, (1888) 5 R. P. C. 603 ; 6 R. P. C. 495. See R. S. C. or 162.

(*n*) See Form in Appendix.

(*o*) 2 H. & M. 628.

(*p*) Plimpton *v.* Malcolmson, (1875) L. R. 3 Ch. D. 531 ; Barnett *v.* Barrett's Screw Stopper Bottling Co., (1884) 1 R. P. C. 9; Heap *v.* Hartley, (1888) 5 R. P. C. 603.

CHAPTER X.

REVOCATION OF LETTERS PATENT.

The Petition

Effect of grant of letters patent.

Letters Patent for inventions are obtained on the faith of representations made by the patentee, and where there is no opposition (*a*) they are rarely refused.

The Crown makes the grant at the patentee's peril, and does not guarantee its validity, if the representations contained in the applicant's declarations are not true, or if all the requirements of the law are not satisfied.(*b*)

The grant of a patent for an invention operates as a curtailment of the rights of the public, for it prohibits all her Majesty's subjects, other than the patentee and his licensees, from using the invention, even if they should discover it independently for themselves.(*c*) As we have seen, the justification for making the grant is the consideration that the patentee is the first to give the public a knowledge of the invention and the means of making practical use of it.(*d*)

It is evident that, if a grant of letters patent for an invention be made, which is in fact void owing to the grantee not being the true and first inventor, or on account of the alleged invention not being proper subject-matter, or in consequence of some defect as regards novelty, utility, proper specification, or any other ground which vitiates a patent, so long as the grant remains unrevoked the public suffers an injury, and the patentee is in the enjoyment of a monopoly to which he is not entitled.

Validity may be questioned by defendant in an action for infringement.

We shall see hereafter that in the event of a patentee bringing an action against any member of the public in respect of any act alleged to be an infringement of his rights under the grant, it is competent to the defendant to put in issue the validity of the patent on any one or more of the grounds which

(*a*) pp. 289, 311 *ante*.
(*b*) p. 289 *ante*.
(*c*) p. 92 *ante*.
(*d*) p. 92 *ante*.

in law render it void, so as to obtain the declaration of the Court on the point, which, if found in the defendant's favour, is a complete answer to the action.(*e*)

The Petition.

It is sometimes to the interest of a particular member of the public to obtain a revocation of a void patent, quite independently of any proceedings against him in respect of infringement. For instance, where an individual is using an invention, in respect of which another person claims to have a patent, which the unlicensed user believes to be invalid; or where a person is desirous of using an invention included in a patent which he has good reason to believe is defective. The law has long provided a means to enable an aggrieved member of the public to obtain the repeal of a void patent. Formerly the procedure was by *scire facias;* but now it consists in the presentation of a petition to the Court, under s. 26 of the Act of 1883,(*f*) for the revocation of the patent.

A member of the public may have an interest in obtaining a revocation.

Under the old practice, if two persons had obtained patents for the same invention the Courts would not interfere between them, but left them to determine their rights by *scire facias,*(*g*) for which proceeding the presentation of a petition for revocation has been substituted by the Act of 1883.(*h*)

Petition for revocation substituted for the old procedure by *scire facias.*

The presentation of a petition for revocation of a patent, as did the prosecution of a *scire facias,* entails expense on the part of the person presenting it, and in order that the public may not be put to the trouble or cost of resisting an unlawful patent, the Crown imposes a condition on the grantee of every letters patent for an invention. This condition is a proviso in the letters patent to the effect that, if at any time during the term for which the patent is granted it be made to appear to the Queen, her heirs, or successors, or any six or more of her Privy Council, that the grant is contrary to law, or prejudicial, or inconvenient to her Majesty's subjects in general, or that the invention is not a new invention as to the public use and exercise thereof, within the United Kingdom of Great Britain and Ireland, and the Isle of Man, or that the patentee is not the first and true inventor thereof within the realm, the letters patent shall forthwith determine and be void to all intents and purposes.(*i*)

Conditions of letters patent.

There is no instance in modern times of the determination

(*e*) p. 517 *post.* (*f*) p. 648 *post.*
(*g*) Copeland *v.* Webb, (1862) 11 W. R. 134; 1 N. R. 119; Baskett *v.* Cunningham, (1762) 2 Eden, 137,
(*h*) s. 26.
(*i*) 46 & 47 Vict. c. 57, 1st Schedule, Form D.

The Petition.

of a patent under this proviso, but it is probable that it was under some such proviso that Queen Elizabeth was enabled to recall patents for monopolies, which were found to be so grievous to the public during her reign.(*k*)

A valid patent might probably be cancelled under the above proviso, if the conduct of the patentee rendered the grant prejudicial or inconvenient to the public—*e.g.*, if the patentee refused to sell the patented article or to grant licences upon reasonable terms.(*l*)

Revocation in part of the United Kingdom is applicable to the whole.

The Act of 1883 defines the term "patent" as meaning letters patent for an invention (*m*) which have effect throughout the United Kingdom and the Isle of Man,(*n*) and therefore, if revocation be obtained in any portion of the United Kingdom or the Isle of Man, it is applicable to the whole area for which the patent was originally granted.

Revocation may be obtained in England, Scotland, or Ireland.

The words of s. 26 of the Act of 1883,(*o*) which establish the proceeding by petition are: "Revocation of a patent may be obtained on petition to the Court," and it is submitted that in view of the evident contemplation by the Act of proceedings in England, Scotland, and Ireland,(*p*) the "Court" must be taken to mean in England her Majesty's High Court of Justice in England; (*q*) in Scotland, any Lord Ordinary of the Court of Session; (*r*) and in Ireland, the High Court of Justice in Ireland.(*s*)

Power of the Court of the County Palatine of Lancaster to revoke a patent on petition.

Before the Chancery of Lancaster Act 1890, it was held that the Court of the County Palatine of Lancaster, not being a "Court" within the Act of 1883, was not competent to entertain a petition for revocation, but it would appear that it has jurisdiction to do so now.(*t*)

Action of reduction in Scotland.

In Scotland, proceedings for revocation of a patent are in the form of an action of reduction at the instance of the Lord Advocate, or at the instance of a party having interest, with his concurrence, which concurrence may be given on just cause shown only; and service of all writs and summonses in the action must be made according to the forms and practice existing at the commencement of the Act of 1883.(*u*)

(*k*) See Hindmarch on Patents, p. 432. See also Remb. 98, 223.

(*l*) Universities of Oxford and Cambridge *v.* Richardson d'Ewes, (1802) 652; 6 Ves. 712; judgment of Lord Eldon, L.C., Matthey's Patent, Darcy *v.* Allin, (1602) Noy. R. 183.

(*m*) s. 46.

(*n*) s. 16.

(*o*) p. 648 *post*.

(*p*) See s. 26 (4) (a) (b).

(*q*) 46 & 47 Vict. c. 57, s. 117.

(*r*) *Ibid.* s. 111.

(*s*) *Ibid.*

(*t*) 53 & 54 Vict. c. 23, s. 3; Proctor *v.* Sutton Lodge Chemical Co., (1888) 5 R. P. C. 184.

(*u*) 46 & 47 Vict. c. 57, s. 109.

In Ireland, all parties have their remedies under or in respect of a patent as if it had been granted to extend to Ireland only.(*x*)

The Petitioner.

Revocation in Ireland.

No proceeding by petition or otherwise lies for revocation of a patent relating to any improvement in instruments, or munitions of war, which has been assigned to her Majesty's Principal Secretary of State for the War Department, and in respect of which such Secretary of State has, before the application for a patent, or before the publication of the specification or specifications, certified to the Comptroller his opinion that, in the interests of the public service the particulars of the invention and of the manner in which it is to be performed should be kept secret.(*y*)

Improvements in munitions of war.

The Petitioner.

It is to be noticed that s. 26 sub-s. 4 of the Act of 1883 authorises various persons to present a petition for the revocation of a patent; but, whereas by s. 109 the proceeding for revocation in Scotland is further limited, the only persons entitled to initiate proceedings for the revocation of a patent in Scotland are the Lord Advocate and persons having an interest, with his concurrence.

Persons who are entitled to take proceedings for revocation.

The Act of 1883(*z*) authorises the following persons to present a petition for the revocation of a patent:—

(1) The Attorney-General in England or Ireland, or the Lord Advocate in Scotland.

(2) Any person authorised by the Attorney-General in England or Ireland, or the Lord Advocate in Scotland.

(3) Any person alleging that the patent was obtained in fraud of his rights, or of the rights of any person under or through whom he claims.

(4) Any person alleging that he, or any person under or through whom he claims, was the true inventor of any invention included in the claim of the patentee.

(5) Any person alleging that he, or any person under or through whom he claims an interest in any trade, business, or manufacture, had publicly manufactured, used, or sold, within this realm, before the date of the patent, anything claimed by the patentee as his invention.

(*x*) 46 & 47 Vict. c. 57, s. 110.
(*y*) *Ibid.* s. 44 (9) (1) (3).
(*z*) s. 26, sub-s. 4; p. 648 *post*.

The Petitioner.

With regard to (3) the power of presenting a petition for the revocation conferred on "any person alleging that the patent was obtained in fraud of his rights, or of the rights of any person under or through whom he claims "(*a*) relates only to cases of fraud, and will not be extended to cases of mistake, notwithstanding that the consequences of the mistake may be to deprive the inventor of his patent-rights.(*b*) Thus, where a subject of the United States of America, and resident there, gave a power of attorney to an English patent agent, with instructions to obtain a patent in this country, and the agent employed a sub-agent, who took out a patent in his own name for the invention, together with some improvements of his own, without stating in the specification that it, or any part of it, was a communication from abroad, and made a statutory declaration that he was the first and true inventor, the Court of Appeal held that, even if the patent was void by reason of the non-disclosure in the specification of the communication from abroad, as there was no proof of any intention on the part of the patentee to deprive the inventor of his rights, the petition could not be sustained on the ground of fraud, and it was dismissed, without prejudice to any petition which the inventor might be advised to present as a person claiming to be the first and true inventor.(*c*)

If the petitioner is qualified under (3), (4), or (5), he presents his petition as of right; any other person must obtain the fiat of the Attorney-General in England or Ireland, or the Lord Advocate in Scotland, authorising the presentation.

When once the petitioner has a *locus standi* to present the petition he can impeach the patent on any lawful ground he chooses. Consequently, if he is qualified to present the petition without the fiat on any one ground, he does not need the fiat if he wishes to add other grounds.(*d*)

Fiat of the Attorney-General where necessary.

If there is any doubt as to whether a would-be petitioner is qualified as of right, he should take the precaution to arm himself with the fiat of the Attorney-General or the Lord Advocate, as the case requires, for the Court will at the hearing refuse to go into the question whether the patent is good or bad, if it appear that the petitioner has no *locus standi*.(*e*) But any person who presents a petition under any one of the above

(*a*) p. 391 *ante*.
(*b*) *In re* Avery's Patent, (1887) L. R. 36 Ch. D. 307; 4 R. P. C. 152, 322.
(*c*) *Ibid*.
(*d*) Morgan's Patent, (1887) 5 R. P. C. 186.
(*e*) *In re* Avery's Patent, (1887) L.R. 36 Ch. D. 307, 322; 4 R. P. C. 152, 322.

clauses is, as above stated, if he proves his right to do so, entitled to impeach the patent on any other lawful ground.(*f*)

The Petitioner.

Procedure to obtain the fiat of the Attorney-General.

In order to obtain the Attorney-General's fiat authorising the presentation of a petition for the revocation of a patent, it is necessary to forward the following papers to the Patent Clerk:—

1. Memorial to the Attorney-General 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.(*g*)
4. Certificate of a barrister that the petition is proper to be authorised by the Attorney-General.
5. Certificate of a solicitor that the proposed petitioner is a proper person to be a petitioner, and that he is competent to answer the costs of all proceedings in connection with the petition if unsuccessful.

Under the old practice in *scire facias* the fiat of the Attorney-General was necessary in all cases, and was not issued as of course; (*h*) neither does a petitioner under the present practice obtain the fiat as of right, for the Attorney-General grants or refuses it at his discretion; though it is usual for the Attorney-General to exercise his discretion in favour of the petitioner when there is anything like a *primâ facie* case.(*i*)

In some cases the Attorney-General decides *ex parte* whether to grant or refuse his fiat, and in others he directs notice to be given to the patentee, and that the parties he heard before him. Thus, where no other proceeding was pending, the Attorney-General's fiat was granted without a direction to give notice to the patentees; (*k*) so likewise where an action for infringement of the patent had been commenced but abandoned.(*l*) Where an action for infringement against the applicants was pending in Scotland, and the patentees objected that, as they were resident in Scotland, the application should have been made to the Lord Advocate, the Attorney-General's fiat was refused, pending the result of the action in Scotland, but leave was given to renew the application if necessary.(*m*) Where the

(*f*) Morgan's Patent, (1888) 5 R. P. C. 186.

(*g*) For forms, see Appendix.

(*h*) 1 W. P. C. 671 n; R. *v.* Prosser, 14 Beav. 306.

(*i*) Shoe-Machinery Co. *v.* Cutlan, (1895) 12 R. P. C. 533.

(*k*) Gaulard and Gibbs' Patent, Griff. P. C. 320.

(*l*) Bothwell's Patent, Griff. P. C. 320.

(*m*) Bell and Coleman's Patent, Griff. P. C. 320; see also *In re* Young's Patent, P. M. J. 2nd series, vol. vii. p. 44.

Grounds for Revocation.

applicant was a licensee under the patent notice was directed to be given to the patentee;(*n*) so also where the applicant was a defendant in an action for infringement at the instance of the patentee and the application was made during the interval after judgment in the Court of First Instance and the hearing of an appeal;(*o*) and where notice had been given to the patentee, the application was at the hearing ordered to stand over, on the patentee undertaking to commence an action for infringement within a month.(*p*)

Attorney-General may grant his fiat *nunc pro tunc*.

The Attorney-General has authority to grant the fiat *nunc pro tunc*. Thus when a petition came on for hearing without the fiat, which was necessary, having been obtained, and the respondent objected, it was ordered to stand over generally with liberty to either side to restore it, so as to afford an opportunity to the petitioner to obtain the fiat.(*q*)

Costs of proceedings necessary to obtain Attorney-General's fiat.

The Act of 1883 gives the Attorney-General power to award the costs of proceedings before him,(*r*) including a petition for his fiat, which is heard out; but it does not give him any authority over the costs of a petition presented to him praying for the grant of his fiat when that petition is subsequently abandoned.(*s*)

Grounds for Revocation.

Grounds on which patents are revoked.

A patent may be revoked on any ground on which previous to the Act of 1883 it could have been repealed by *scire facias*.(*t*)

A *scire facias* lay to repeal a patent in three cases according to the authority of the fourth Institute.(*u*)

(1) When the King by his letters patent doth grant by several letters patent one and the selfsame thing to several persons, the former patentee shall have a *scire facias* to repeal the second patent.

(2) When the King granteth anything that is grantable upon a false suggestion, the King by his prerogative *jure regio* may have a *scire facias* to repeal his own grant.

(3) When the King doth grant any thing which by law he cannot grant, he, *jure regio* (for the advancement of justice and right), may have a *scire facias* to repeal his own letters patent.

(*n*) Martin's Patent, Griff. P. C. 320.
(*o*) Watling's Patent, Griff. P. C. 320.
(*p*) Siddell's Patent, Griff. P. C. 320.
(*q*) Dedge's Patent, (1895) 12 R.P.C. 453.
(*r*) s. 38.
(*s*) Martin's Patent, Griff. P. C. 320.
(*t*) 46 & 47 Vict. c. 57, s. 26 (3).
(*u*) p. 88.

Grounds for Revocation.

It was laid down by another well-known authority (*x*) that the grounds on which a patent could be repealed by *scire facias* were: "fraud, false suggestion, non-compliance on the part of the patentee with the conditions of the letters patent, failure of any of the essential requisites of novelty and utility, or abuse of the privileges granted by the letters patent."(*y*)

Thus a patent may be revoked on the grounds that the patentee was not the true and first inventor, that the alleged invention is not proper subject-matter, or lacks the essential elements of utility or novelty, or that the specifications are defective, or on any one of those grounds singly. It may also be revoked on the ground that it was obtained in fraud of the rights of the petitioner.(*z*)

Parke, B., delivering the judgment of the Court of Exchequer in a case where a patent was upset on the ground of false suggestion, said:—

> The question is "whether this patent, which suggests that certain inventions are improvements, is avoided, if there be one, which is not so. And upon the authorities we feel obliged to hold that the patent is void, upon the ground of fraud on the Crown, without entering into the question whether the utility of each and every part of the invention is essential to a patent, where such utility is not suggested in the patent itself, as the ground of the grant. That a false suggestion of the grantee avoids an ordinary grant of land or tenements from the Crown is a maxim of the Common Law, and such a grant is void, not against the Crown merely, but in a suit against a third person.(*a*) It is on the same principle that a patent for two or more inventions, when one is not new, is void altogether, as was held in *Hill* v. *Thompson* and *Brunton* v. *Hawkes*; for although the statute invalidates a patent for want of novelty, and consequently by force of the Statute the patent would be void, so far as related to that which was old, yet the principle on which the patent has been held to be void altogether is that the considera- for the grant is the novelty of all, and the consideration failing, or, in other words, the Crown being deceived in its grant, the patent is void, and no action maintainable upon it." (*b*)

Recitals in the letters patent.

Under the present practice, all letters patent contain a recital

(*x*) Webster on the Law and Practice of Letters Patent for Inventions, p. 32.

(*y*) See R. *v.* Cutler, (1847) Macr. P. C. 124; R. *v.* Arkwright, (1785) 1 W. P. C. 66.

(*z*) p. 391 *ante*; p. 397 *post*.

(*a*) Travell *v.* Carteret, 3 Lev. 135; Alcock *v.* Cooke, (1829) 5 Bing. 340.

(*b*) Morgan *v.* Seaward, (1837) 2 M. & W. 544; 1 W. P. C. 196.

Grounds for Revocation.

to the effect that the patentee has represented to the Crown that he is in possession of an invention of which he is the true and first inventor, and that the same is not in use by any other person to the best of his knowledge and belief;(*c*) and a further recital to the effect that the patentee has by and in his complete specification particularly described the nature of his invention.(*d*)

Distinction between a false representation recited in the patent and a false statement in the specification.

The distinction between a false representation made by the patentee and recited in the letters patent and a false statement, as an error in the specification, is of the greatest importance. A distinction must be drawn between an error in the specification, such as will make a suggestion in the letters patent false, and an error in a matter of direction or otherwise, such as affects the suggestion in some degree short of the preceding, as, for instance, to diminish the extent of utility.(*e*)

Inventions with the same objects.

If a patentee invents an apparatus or process for achieving a given object, he will not necessarily be entitled to obtain (on the ground that he was the first and true inventor) the revocation of a subsequent patent for achieving the same object, when the invention comprised therein is a different method of arriving at the same result and the later patentee shows a different way of dealing with knowledge common at the date of the first patent.(*f*) If, however, the prior patentee has discovered a new principle and a method of carrying it out, he may be entitled to the revocation of a subsequent patent for another and analogous method of carrying out the same principle.(*g*)

In a case (*h*) where revocation of a patent for "improvements in the preparation of foods for infants and invalids" was sought, on the ground that the petitioner had for many years previous to the date of the patent been manufacturing foods by a process substantially similar to that of the patentee, and the evidence established the fact that the two processes were chemically the same, *Kay*, J., in giving judgment for the petitioner said:—

> "This is an application to recall a patent. It is made under the statute of 1883, which provides that a petition for revoca- of a patent may be presented by, among other people, 'any person alleging that he or any person under or through whom

(*c*) Appendix. (*d*) *Ibid.*
(*e*) See 1 W. P. C. 42 n.
(*f*) Walker *v.* Hydrocarbon Syndicate, Ld., (1885) 2 R. P. C. 3.
(*g*) See pp. 44, 45 *ante*.
(*h*) In the Matter of Haddan's Patent, (1885) 2 R. P. C. 219.

Grounds for Revocation.

he claims an interest in any trade, business, or manufacture, had publicly manufactured, used, or sold, within this realm, before the date of the patent, anything claimed by the patentee as his invention.' Now, the justice and common sense of that is too apparent to need much comment. A man has been carrying on a particular manufacture for some time; and that another person should come and take out a patent for that manufacture as for a new invention by that other person, and stop the manufacture that has been going on for years, would be an intolerable wrong, carried out under the apparent sanction of the Patent Law; and therefore when anything of the kind happens the Legislature provides this simple remedy, that the person who has been carrying on this manufacture may come to the Court and have the patent revoked."

Cases of revocation on the ground that the patent was obtained in fraud of the petitioner's right.

Under the following circumstances patents have been revoked on the ground that they were obtained in fraud of the rights of the petitioner. Where it appeared that the petitioner and respondent had jointly put in a provisional specification, which had been allowed to lapse, and the respondent had thereupon, without the knowledge of the petitioner, obtained the patent for the invention of which the petitioner was the first and true inventor.(*i*) And where the evidence showed that experiments finally resulting in the invention were not made by one of two separate petitioners under the direction of the patentee as the patentee contracted, but by the other separate petitioner assisted by the first petitioner, and the patentee, not being the true and first inventor, had obtained the patent in fraud of the latter petitioner's rights.(*k*)

A fresh patent may be granted to the petitioner when he succeeds on the ground that the original patent was obtained in fraud of his rights, but not when he succeeds on any other ground.

When a petitioner succeeds on the ground that the patent was obtained in fraud of his rights, the patent of the respondent will be revoked, and a fresh patent may be granted to the petitioner,(*l*) which will terminate on the expiration of the term for which the revoked patent was granted,(*m*) but such a patent will not be granted as matter of course; the Comptroller-General has a discretion in the matter.(*n*)

In all other cases when the petitioner succeeds on grounds other than that of fraud of his rights, the invention cannot be good subject-matter of a fresh patent.(*o*)

(*i*) Gale's Patent, (1891) 8 R. P. C. 438.

(*k*) Norwood's Patent, (1895) 12 R. P. C. 214; see also Avery's Patent, (1887) 4 R. P. C. 152; L. R. 36 Ch. D. 307; Norwood's Patent (No. 2), (1898) 15 R. P. C. 99.

(*l*) *In re* Avery's Patent, (1887) L. R. 36 Ch. D. 326; 4 R. P. C. 152, 322.

(*m*) 46 & 47 Vict. c. 57, s. 26 (8).

(*n*) Norwood's Patent, (1895) 12 R. P. C. 219; Norwood's Patent (No. 2), (1898) 15 R. P. C. 99.

(*o*) *Ibid.*

Practice.

Parties.

Every petition for the revocation of a patent must be presented in the name of the person making the allegations in respect of which the revocation is sought, such person, when necessary, being duly authorised by the fiat of the Attorney-General;(*p*) and all persons having an interest in the patent must be made respondents.(*q*)

Under the old practice it was not competent for two persons to have a *scire facias* for the same patent,(*r*) and if the patent had been originally granted to two persons jointly it was necessary to make them both parties, notwithstanding the fact that one had, before the issue of the suit, assigned his share to the other.(*s*)

Under the present practice it is only necessary to make the persons respondents who have an interest in the patent at the time the petition for revocation is presented; and when the patent is assigned after the presentation of a petition the name of the assignee may, on payment of a sum into Court, be substituted for that of the patentee as respondent.(*t*)

Particulars of objections.

The petitioner is required to deliver with his petition particulars of the objections on which he means to rely.(*u*) These particulars may be, from time to time, amended by leave of the Court or a Judge,(*x*) and no evidence will, except by leave of the Court or a Judge, be admitted in proof of any objection of which particulars have not been delivered.(*y*)

In a case of *scire facias*, though particulars of objection were not specially requisite, ambiguous charges were not allowed. Thus it was held that a suggestion in the words "the grant is prejudicial and inconvenient to our subjects in general" was too vague, and the Court refused to hear evidence on this issue.(*z*) Again after a verdict had been given for the Crown it was held to be no ground for granting a new trial that the patentee could bring further evidence, if there was no allegation of surprise, or the discovery of further evidence.(*a*)

(*p*) p. 392 *ante*.

(*q*) *Re* Avery's Patent, (1887) L. R. 36 Ch. D. 307; 4 R. P. C. 152, 322.

(*r*) R. *v.* Neilson, (1842) 1 W.P. C. 673.

(*s*) R. *v.* Betts, (1850) 15 Q. B. 540; L. J. Q. B. 13, 53.

(*t*) *Re* Haddan's Patent, (1885) 2 R. P. C. 218.

(*u*) 46 & 47 Vict. c. 57, s. 26 (5). For a form of particulars of objection to be delivered with a petition for the revocation of a patent, the reader is referred to In the Matter of Haddan's Patent, (1885) 2 R. P. C. 218: and further detailed information, relative to particulars of objections, will be found at pp. 527–540 *post*.

(*x*) *Ibid.* (6). (*y*) *Ibid.* (5).

(*z*) R. *v.* Arkwright, (1785) 1 W.P.C. 64 n.

(*a*) R. *v.* Arkwright, (1785) 1 W. P. C. 64, 74.

Practice.

In an action for infringement it is necessary for the successful party to obtain the Judge's certificate of the reasonableness and propriety of his particulars, in order that his costs of such particulars may be allowed on taxation,(*b*) but this does not seem necessary in the case of a petition for the revocation of a patent, and it would appear that the Court or a Judge has no power to give such a certificate.(*c*)

Interrogatories.

The petitioner is entitled to administer interrogatories to the respondent as in an action for infringement.(*d*)

Service of the petition.

All persons interested in the patent ought to be made respondents and served with the petition.(*e*)

The Act of 1883 does not, however, provide any special procedure for the service of the petition out of the jurisdiction. It is therefore sufficient if such notice is given as is required by natural justice.(*f*)

In *Drummond's Patent* (*g*) it appeared that the patentee was resident and domiciled in Scotland. After a copy of the petition, together with the particulars of objection, was delivered to him personally in Scotland, he wrote to the petitioner's solicitors, stating that he did not intend to appear, and objecting to the jurisdiction of the English Court. On the application of the petitioner, the Court ordered that the case should be set down for hearing, unless by a certain day, of which notice was to be given to the respondent, he should appear and show cause to the contrary; it being open to him, if he appeared, to dispute the jurisdiction.

In *Goerz and Hough's Patent* (*h*) the respondents were both domiciled out of the jurisdiction, and on an application for directions as to service, *North*, J., pointed out that the respondents could not be served at all, but that the proper thing for the petitioner to do was to follow the procedure adopted in *Drummond's Patent* above referred to. The Judge also stated that he could not authorise the petitioner to do anything, but that if he (the Judge) was satisfied that the respondents had had proper notice he might proceed in their absence.

In *Hirschfeld's Patent*,(*i*) on motion for directions as to

(*b*) 46 & 47 Vict. c. 57, s. 29 (6).
(*c*) 46 & 47 Vict. c. 57, s. 26; Gaulard and Gibbs' Patent, (1888) 5 R. P. C. 525, 537.
(*d*) Haddan's Patent, (1884) 54 L. J. Ch. N. S. 126; 51 L. T. N. S. 190; W. R. (1884) p. 192.
(*e*) Avery's Patent, (1887) L. R. 3 Ch. D. 307; 4 R. P. C. 152.
(*f*) See King and Co.'s Trade Mark. (1892) L. R. 2 Ch. D. 463.
(*g*) (1889) 6 R. P. C. 756
(*h*) (1895) 12 R. P. C. 370.
(*i*) (1895) 11 R. P. C. 514.

Practice.

service of the petition on a foreigner resident abroad, leave was given to the petitioner to send to the respondent by registered letter a copy of the petition, together with a notice that the petition had been ordered to go into the witness list. The respondent did not appear, and the patent was revoked in his absence.

In *Kay's Patent* (*k*) one of three respondent joint patentees was out of the jurisdiction, and the petition had been duly served on the other two within the jurisdiction. On motion for directions, it was ordered that the petition should go into the witness list; but unless the third patentee appeared by counsel on notice given to him (*l*) it should not come on for hearing without leave; and liberty was given to either party to apply.

Respondent out of the jurisdiction cannot be compelled to give security for costs.

The Court will not compel a respondent out of the jurisdiction to give security for costs, since he does not appear before the Court in consequence of his own application.(*m*)

Respondent has the right to begin at the hearing.

At the hearing of a petition for revocation the *onus* is on the respondent, who therefore has, by statute, the right to begin and give evidence in support of the patent, and he has the right to reply, if the petitioner tenders evidence impeaching the validity of the patent.(*n*)

In an action of *scire facias* the burden of proof was on the plaintiff, and in order to succeed he had to do more than establish a mere *primâ facie* case.(*o*)

Petition is an action and tried like other actions.

A petition for revocation is, in every sense of the word, an action, except that it is commenced by a petition instead of a writ, and it will be tried in the way in which actions usually are tried—*i.e.*, by *viva voce* evidence—if either of the parties desires to have it so determined.(*p*)

Trial with witnesses.

If it is desired to have the petition tried with witnesses the proper course is to make an application, on the day on which the petition is returnable, that the petition should go into the witness list to be tried on oral evidence.(*q*)

Trial on affidavit evidence.

When the petition is to be tried by the Court on affidavit evidence, it is proper for the party who has the right to begin

(*k*) (1894) 11 R. P. C. 279.
(*l*) As in King and Co.'s Trade Mark, 9 R. P. C. 350.
(*m*) Miller's Patent,(1894) 11 R. P. C. 55; La Société Anonyme Trade Mark, (1893) 10 R. P. C. 290.
(*n*) 46 & 47 Vict. c. 57, s. 26 (7).
(*o*) R. *v.* Cutler, Macr. P. C. 124, 133, 134.
(*p*) *In re* Gaulard and Gibbs' Patent (1886) L. R. 34 Ch. D. 396; Walker *v.* Hydrocarbon Syndicate, (1884) 2 R. P. C. 3; *In re* Haddan's Patent, (1885) 2 R. P. C. 218.
(*q*) Miller's Patent, (1894) 11 R. P. C. 55.

to file his evidence in chief first, and if there is any cross-examination of any of the witnesses of either side such cross-examination ought to be brought before the Court at the trial.(*r*) **Practice.**

The Court may, and on the request of either of the parties it must, call in the aid of an assessor specially qualified, and try and hear the case wholly or partially with his assistance.(*s*) **Trial with assessor.**

Unless the Court otherwise decide, the petition is heard without a jury.(*t*) **Trial without a jury.**

To suit the convenience of the parties to the petition for revocation and their witnesses, an order may be obtained directing the trial of the petition before a Judge without a jury at assizes.(*u*) **Trial at assizes.**

Again, if there is an action for infringement of the patent pending, an order may be obtained for the hearing of the petition at the same time as the trial of the action.(*x*) **Hearing at same time as an action for infringement.**

As a rule joint petitioners must appear by the same counsel, but in *Norwood's Patents* (*y*) two joint petitioners were, under the peculiar circumstances of the case, allowed to appear separately, and one conducted his case in person.(*z*) **Joint petitioners must appear by same counsel.**

Where the respondent consents, an order for revocation with costs will be made when the petition comes on for directions.(*a*) **Revocation when respondent consents.**

When the respondent does not appear the patent may be revoked at once on the petition coming on and the production of affidavits verifying the service and the grounds of revocation stated in the petition.(*b*) And since petition is the only way open to a member of the public to obtain the revocation of a void patent, costs will be given against a respondent patentee who does not appear.(*c*) Also costs will be given against a respondent who abandons his case.(*d*) **Revocation when respondent does not appear.**

There is no estoppel against a petitioner for revocation who has been an unsuccessful defendant to an action for infringement of the patent brought at the instance of the respondent. **No estoppel against an unsuccessful defendant to an action for infringement.**

(*r*) Gale's Patent, (1891) 8 R. P. C. 438.
(*s*) 46 & 47 Vict. c. 57, s. 28.
(*t*) *Ibid.*
(*u*) R. S. C. O. 36, r. 8; In the Matter of Edmond's Patent, (1889) 6 R. P. C. 355.
(*x*) Edge's Patent, (1890) W. N. 149.
(*y*) (1895) 12 R. P. C. 214.
(*z*) Norwood's Patents, (1895) 12 R. P. C. 219, 221.
(*a*) Sleight's Patent, (1893) 10 R. P. C. 447; Rendell's Patent, (1894) 11 R. P. C. 277; Wilkinson's Patent, (1894) 11 R. P. C. 298.
(*b*) Hirschfeld's Patent, (1894) 11 R. P. C. 514; Vaisey's Patent, (1894) 11 R. P. C. 593.
(*c*) Wallace's Patent, (1895) 12 R. P. C. 444; Simmon's Patent, (1895) 12 R. P. C. 446.
(*d*) Dege's Patent, (1895) 12 R. P. C. 448.

Practice.

The reason of this is, that the petitioner on the petition appears as a member of the public, and consequently there is no *res judicata* between him and the respondent in that capacity.(*e*) And this fact will materially influence the Court of appeal in exercising its discretion to allow fresh evidence of invalidity upon the appeal of an unsuccessful defendant to an action for infringement.(*f*)

Old practice as to nonsuits and postponements of actions for infringements pending a *scire facias*.

Under the old practice, the fact of a *scire facias* pending was a ground for refusing a nonsuit on an objection to a patent in an action for infringement.(*g*). Where a *scire facias* was sued out after a verdict in an infringement action, and a rule obtained to show cause why a nonsuit should not be entered, the Court refused to extend the time for this rule until after the hearing of the *scire facias*. *Tindal*, C.J., pointed out that even if the *scire facias* availed, and the patent was repealed, that would not necessarily prevent the Court from giving judgment on the objections taken at the trial of the cause.(*h*) So also the Court refused to deprive the plaintiff in an action for infringement of his Common Law right to try where a *scire facias* had been set down.(*i*) As a general rule, the plaintiff had a right to have his cause go on to trial, according to the ordinary course of business, but there might be special circumstances upon which the Court might see fit to interpose.(*k*)

Where, in a case in the Common Pleas, an action for the infringement of a patent had been tried, and a rule *nisi* for a new trial had been obtained and argued, and it appeared that another action was pending in that Court for another infringement of the same patent, the Court suspended judgment upon the rule for a new trial, and ordered the trial of the other action to be postponed until after the trial of the *scire facias*;(*l*) and in another action in the Common Pleas, where it appeared that the defendants had sued out a *scire facias* to repeal the plaintiff's patent, and a verdict had been obtained for the Crown, but a rule *nisi* for a new trial was pending in the Queen's Bench, and the defendant in the Common Pleas gave notice of

(*e*) Deeley's Patent, (1895) 12 R. P. C. 192, 199; Shoe Machinery Co. *v.* Cutlan, (1895) 12 R. P. C. 533; Lewis and Stickler's Patent, (1897) 14 L. R. 24, 35.

(*f*) Shoe Machinery Co. *v.* Cutlan, (1895) 12 R. P. C. 530, 533.

(*g*) Haworth *v.* Hardcastle, (1834) 1 W. P. C. 485.

(*h*) Haworth *v.* Hardcastle, (1834) 1 W. P. C. 486 n.

(*i*) Muntz *v.* Foster, (1843) 2 W. P. C. 93 n.

(*k*) *Ibid.*

(*l*) Patteson *v.* Holland, Hindmarch Patents, p. 293.

trial *by proviso*, the Court upon the application of the plaintiff made a rule absolute for postponing the trial.(*m*) **Practice.**

In *Walker* v. *The Hydrocarbon Syndicate*(*n*) an application for the postponement of an appeal in a petition for revocation, on the ground that the petitioner could not be found at the hearing, and for leave to adduce further evidence, was refused. **Fresh evidence on appeal from order for revocation.**

The respondent may, if he thinks fit, on obtaining the leave of the Court or a Judge, during a proceeding for the revocation of his patent, apply at the Patent Office for leave to amend his specification by way of disclaimer, and a postponement of the hearing may be granted to allow of this being done.(*o*) **Amendment of specification pending proceedings for revocation.**

If a petitioner succeeds in obtaining the order of the Court for the revocation of a patent he must forthwith leave at the Patent Office a copy of such order, and the purport of it will be duly entered in the Register of Patents,(*p*) but the Patents Act, 1883,(*q*) and the Patent Rules, 1890, do not deprive the Court of its power to stay proceedings on an order pending an appeal.(*r*) **Stay of proceedings on order for revocation pending an appeal.**

Under the old practice, if the trial of a *scire facias* resulted in favour of the Crown the Lord Chancellor had authority to order the patent to be restored into Chancery to be cancelled,(*s*) but recent legislation has not provided for the delivering up of a patent which has been revoked by a decision of the Court.

The judgment of the Court itself is a revocation of the patent, and the practice now is for the Comptroller to register the judgment. If this judgment of revocation is reversed by a Court of Appeal, the judgment of that Court is then entered on the register, and the patent is resuscitated again.(*t*) It is proper for the Court to stay proceedings on the order for revocation pending an appeal.(*u*) **Effect of an order for revocation.**

It is to be noticed that a decision of the Court in an infringement action against the validity of the patent does not destroy it, since it is not an order for the revocation of the patent;(*x*) and it is open to a patentee by amendment of the

(*m*) Smith *v.* Upton, (1843) 6 M. & G. 251.

(*n*) (1886) 3 R. P. C. 253.

(*o*) 46 & 47 Vict. c. 57, s. 19; p. 234 *ante*.

(*p*) P. R. (1890) r. 74.

(*q*) ss. 18 & 19.

(*r*) Armstrong's Patent, (1897) 14 R. P. C. 755.

(*s*) R. *v.* Newton, Hindmarch on Patents, p. 427; R. *v.* Eastern Archipelago Co., (1853) 4 De G. M. & G. 199.

(*t*) Deeley *v.* Perks, (1896) 13 R. P. C. 586–587.

(*u*) Armstrong's Patent, (1897) 14 R. P. C. 755; Deeley *v.* Perks, (1896) 13 R. P. C. 586–587.

(*x*) Deeley's Patent, (1894) 11 R. P. C. 75; Deeley *v.* Perks, (1896) 13 R. P. C. 581.

Practice.

specification to remove the ground on which the Court has held the patent to be bad; and, if there is sufficient subject-matter left, he may thus make the patent perfectly valid,(*y*) though it may still be liable to attacks by petition for revocation on the ground that what is left is, in fact, not subject-matter.(*z*)

Costs.

The Act of 1883 does not contain any special provision as to the costs on the hearing of a petition for revocation, but the Court, acting under its general jurisdiction, awards the costs of the petition at its discretion.(*a*)

(*y*) p. 259 *ante*.

(*z*) Deeley's Patent, (1895) 12 R. P. C. 192; 13 R. P. C. 581.

(*a*) In the Matter of Haddan's Patent, (1885) 2 R. P. C. 218; In the Matter of Edmond's Patent, (1889) 6 R. P. C. 358.

CHAPTER XI.

PROLONGATION OR EXTENSION OF LETTERS PATENT.

PROLONGATION PRIOR TO 1884.

Object of grant of letters patent.

THE Common Law sanctions the grant of letters patent for inventions because the pecuniary reward which a monopoly usually brings to the patentee acts as an inducement to others possessing inventive ability to disclose their inventions for the public good.

Letters patent are never granted in the first instance for a longer period than fourteen years; (*a*) and it sometimes happens that this term is not sufficient to enable the patentee, by means of the profits arising from his monopoly, to recoup himself the outlay to which he has been put, and to reap the remuneration which the law considers he is entitled to in return for communicating a valuable and perfected invention to the public.

Though an invention be beneficial, it may happen that the patentee does not reap any adequate reward during the original term, on account of his outlay in experiments, or on account of the public hesitating to perceive and adopt the discovery. The patentee may also fail to reap a proper reward, because he has been compelled to carry on expensive litigation against persons who have infringed his patent, or to oppose petitions for its revocation. Again, inventors who are not affluent may nearly reach the expiry of their monopoly before they succeed in obtaining the monetary assistance necessary to enable them to develop their discoveries so as to make any adequate profit within the residue of the term.

Power of the Crown to prolong the monopoly.

If from any cause whatever an inventor has not been able to reap the pecuniary benefits to which he was entitled in respect of the disclosure of his secret, there is nothing in the spirit of the patent law which prohibits the Sovereign, acting

(*a*) p. 332 *ante.*

Prolongation prior to 1884.

for and on behalf of (*b*) the public, from prolonging the duration of the monopoly, if there is any likelihood of the patentee making profit during the extended period.

Prolongation prior to 1835.

Previous to the year 1835 the only way in which a patentee could obtain a prolongation of the period for which the patent was originally granted was by obtaining a special Act of Parliament, and instances of such special Acts are not wanting.(*c*)

Lord Brougham's Act of 1835.

S. 4 of Lord *Brougham's* Act,(*d*) passed in the year 1835, provided that—

> "If any person who now hath or shall hereafter obtain any letters patent as aforesaid—*i.e.*, as grantee, assignee, or otherwise (*e*)—shall advertise 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 carried 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 apply to his Majesty in Council for a prolongation of his term of sole using and vending his invention, and shall petition his Majesty in Council to that effect, it shall be lawful for any person to enter a caveat at the Council Office; and if his Majesty shall refer the consideration of such petition to the Judicial Committee of the Privy Council, and notice shall first be by him given to any person or persons who shall have entered such caveats, the petitioner shall be heard by his counsel and witnesses to prove his case, and the persons entering the caveats shall likewise be heard by their counsel and witnesses, whereupon, and upon hearing and inquiring of the whole matter, the Judicial Committee may report to his Majesty that a further extension of the term in the said letters patent should be granted, not exceeding seven years; and his Majesty is hereby authorised and empowered, if he shall think fit, to grant new letters patent for the said invention for a term not exceeding seven years after the expiration of the first term, any law, custom, or usuage to the contrary in anywise notwithstanding: provided that no such extension shall be granted if the application by petition shall not be made and prosecuted with effect before the expiration of the term originally granted in such letters patent."

(*b*) Harmer *v.* Playne, (1809) 14 Ves. 132; Bac. Abr. tit. Prerog.; Year Book, 40 Edw. III. fol. 18.

(*c*) See 16 Geo. II. c. 25; 23 Geo. II. c. 33; 15 Geo. III. c. 52; 16 Geo. III. c. 29; 17 Geo. III. c. 6; 25 Geo. III. c. 38; 32 Geo. III. c. 72; 10 Geo. IV. c. 135.

(*d*) 5 & 6 Will. IV. c. 83, s. 4.

(*e*) *Ibid.* s. 1.

Prolongation prior to 1884.

In consequence of the hardships which patentees suffered who were unable to prosecute their petitions with effect before the expiration of the term of their patents,(*f*) so much of the above recited Act as provided that no extension of the term of letters patent should be granted, if the application by petition were not prosecuted with effect before the expiration of the term originally granted in such letters patent, was repealed by 2 & 3 Vict. c. 67.

Stat. 2 & 3 Vict. c. 67.

It was provided by this latter statute (*g*) that the Judicial Committee of the Privy Council should have power wherever it appeared to them that any application for an extension of the term granted by any letters patent, the petition for which extension should have been referred to them for their consideration, had not been prosecuted with effect before the expiration of the said term from any other causes than neglect, or default of the petitioner, to entertain such application, and to report thereon as by Lord *Brougham's* Act (*h*) provided, notwithstanding the term might have expired before the hearing of such application: and her Majesty was empowered, if she should think fit, on the report of the Judicial Committee recommending an extension of the term of such letters patent, to grant such extension, or to grant new letters patent for the invention or inventions specified in such original letters patent for a term not exceeding seven years after the expiration of the term mentioned in the said original letters patent: Provided that no such extension or new letters patent should be granted if a petition for the same should not have been presented as by Lord *Brougham's* Act directed, before the expiration of the term sought to be extended, nor in case of petitions presented after November 30, 1839, unless such petition should be presented six calendar months at least before the expiration of such term, nor in any case unless sufficient reason should be shown to the satisfaction of the Judicial Committee for the omission to prosecute with effect the said application by petition before the expiration of the said term.

Stat. 7 & 8 Vict. c. 69.

The fact being recognised that, for the encouragement of inventions in the useful arts, it was desirable to give the Crown power to extend the period of a patentee's monopoly beyond seven years from the expiration of the original term in cases where it could be satisfactorily shown that the expense of the invention had been too great for the patentee to recoup

(*f*) See Bodmer's Patent, (1838) (1), 2 Moo. P. C. 471; 13 Newton, L. J. O. S. 175. (*g*) s. 2. (*h*) p. 406 *ante*.

Prolongation prior to 1884.

himself during the term then limited by law, the Legislature in 1844 by the Act 7 & 8 Vic. c. 69, ss. 2 & 3 enacted as follows:—

> "If any person having obtained a patent for any invention shall, before the expiration thereof, present a petition to her Majesty in Council, setting forth that he has been unable to obtain a due remuneration for his expense and labour in perfecting such invention, and that an exclusive right of using and vending the same for the further period of seven years in addition to the term in such patent mentioned will not suffice for his reimbursement and remuneration, then, if the matter of such petition shall be by her Majesty referred to the Judicial Committee of the Privy Council, the said Committee shall proceed to consider the same after the manner and in the usual course of its proceedings touching patents, and if the said Committee shall be of opinion and shall so report to her Majesty that a further period greater than seven years' extension of the said patent term ought to be granted to the petitioner, it shall be lawful for her Majesty, if she shall so think fit, to grant an extension thereof for any term not exceeding fourteen years, in like manner, and subject to the same rules as to the extension for a term not exceeding seven years as now granted. Provided always, and be it enacted, that nothing herein contained shall prevent the said Judicial Committee from reporting that an extension for any period not exceeding seven years should be granted, or prevent her Majesty from granting an extension for such lesser term than the petitioner shall have prayed." (*i*)

Stat. 15 & 16 Vict. c. 83.

By an Act of 1852 (*k*) it was provided that any letters patent obtained in the United Kingdom in respect of any invention first invented in any foreign country, or by the subject of any foreign power or State, and in respect of which any foreign letters patent or like privilege should have been obtained, should not continue in force after the expiration of the term which should first expire or be determined of such foreign letters patent or like privileges: Provided that no letters patent granted in the United Kingdom in respect of any invention which formed the subject of any foreign expired letters patent should be valid.

It was, however, provided by the Act of 1852 (*k*) that the provisions of Lord *Brougham's* Act,(*l*) the Act of 1839,(*m*)

(*i*) 7 & 8 Vict. c. 69, ss. 2 and 3.
(*k*) 15 & 16 Vict. c. 83, s. 25.
(*l*) 5 & 6 Will. IV. c. 83.
(*m*) 2 & 3 Vict. c. 67.

and the Act of 1844 (*n*) as to prolongation of letters patent should still continue in force.

Extension under Act of 1883.

EXTENSION BY PETITION UNDER ACT OF 1883.

The Act of 1883 (*o*) substitutes the term "extension" in place of "prolongation" used in the earlier statutes, and repeals the whole of the statutes hereinbefore referred to, but at the same time provides that the repeal of those enactments shall not affect their past operations, or any patent, 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 done or suffered under or by any of those enactments before or at the commencement of this Act.

Effect of the Patents, &c., Act of 1883.

The Act provides that the repeal of the statutes referred to shall not 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 that Act had not been passed; or take away or abridge any protection or benefit in relation to any such action.(*p*)

The effect of the above reservation was to preserve to patentees whose patents were dated before January 1, 1884, all the rights vested in them by virtue of the repealed statutes. Thus, a patentee whose patent was prior to January 1, 1884, was entitled to present a petition to the Judicial Committee of the Privy Council praying for a prolongation of the term of his monopoly at any time before the expiration of such term,(*q*) though a patentee whose patent is later than that date can only present such a petition at least six months before the time limited for the expiration of his patent.(*r*)

Practice on petitions under s. 25 of the Act of 1883.

The practice which regulates the presentation and hearing of petitions for the prolongation or extension of patents presented under s. 25 of the Act of 1883 is now governed by the Privy Council Rules, 1898, made under the powers created by that section.(*s*) The former practice was governed by the Privy Council Rules(*t*) made under Lord *Brougham's* Act,(*u*) which are not expressly repealed by the new rules of 1898,

(*n*) 7 & 8 Vict. c. 69.
(*o*) 46 & 47 Vict. c. 57, s. 113.
(*p*) *Ibid.*
(*q*) Brandon's Patent, (1884) L. R. 9 App. Cas. 589; 1 R. P. C. 154.
(*r*) 46 & 17 Vict. c. 57, s. 25, sub-s. 1.
(*s*) See Appendix.
(*t*) *Ibid.*
(*u*) See 5 & 6 Will. IV. c. 83; Newton's Patent, (1884) L. R. 9 App. Cas. 592; 1 R. P. C. 177.

Extension under the Act of 1883.

and which it is presumed will still be enforced where not inconsistent with the new rules of 1898.

S. 25 of the Act of 1883 enacts as follows:—

S. 25 of the Act of 1883.

(1) A patentee may, after advertising in manner directed by any rules made under this section his intention to do so, present a petition to her Majesty in Council, praying that his patent may be extended for a further term; but such petition must be presented at least six months before the time limited for the expiration of the patent.

(2) Any person may enter a caveat, addressed to the Registrar of the Council at the Council Office, against the extension.

(3) If her Majesty shall be pleased to refer any such petition to the Judicial Committee of the Privy Council, the said committee shall proceed to consider the same, and the petitioner and any person who has entered a caveat shall be entitled to be heard by himself or by counsel on the petition.

(4) The Judicial Committee shall, in considering their decision, have regard to the nature and merits of the invention in relation to the public, to the profits made by the patentee as such, and to all the circumstances of the case.

(5) If the Judicial Committee report that the patentee has been inadequately remunerated by his patent, it shall be lawful for her Majesty in Council to extend the term of the patent for a further term not exceeding seven, or in exceptional cases fourteen, years; or to order the grant of a new patent for the term therein mentioned, and containing any restrictions, conditions, and provisions that the Judicial Committee may think fit.

(6) It shall be lawful for her Majesty in Council to make, from time to time, rules of procedure and practice for regulating proceedings on such petitions, and subject thereto such proceedings shall be regulated according to the existing procedure and practice in patent matters of the Judicial Committee.(*x*)

(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.

(*x*) By a recent Order in Council, her Majesty, by and with the advice of her Privy Council, approved of the several rules and regulations contained in the schedule thereunto annexed, and ordered that on and after January, 1898, the same be respectfully observed. The Order in Council and rules referred to will be found at p. 731 *post*.

The Petitioner.

Who may petition.

The term "patentee," as defined by the Act of 1883, means the person for the time being entitled to the benefit of the patent;(*y*) and it is, therefore, clear that prolongation or extension of the patent could be granted on the petition of the original patentee, his legal personal representative, or assignee, or, in the case of a partial assignment, the assignee or assignees *conjointly* with the original patentee or patentees.

The term "patentee" includes the executor of a deceased assignee,(*z*) the trustees of a company,(*a*) the patentee agent of a foreign inventor,(*b*) or a mortgagee.(*c*)

Under Lord *Brougham's* Act (*d*) it was doubtful whether the Crown had power to grant a prolongation in cases where there had been a complete or partial assignment of the patent right; but it was subsequently enacted that it should be lawful for her Majesty, on the report of the Judicial Committee of the Privy Council, to grant such extension as was authorised by Lord *Brougham's* Act either to an assignee or assignees, or to the original patentee or patentees conjointly;(*e*) and assignees may obtain an extension under the present Acts.(*f*)

Committee consider probable benefit to the petitioner as well as injury to the public.

The Judicial Committee in forming their decision whether or not to recommend an extension of a patent always consider separately whether the extension will benefit the inventor, and also whether it will injure the public.

Assignees are not received so favourably as original patentees.

Assignees do not stand the same chance of success, on an application for extension of the patent, as original patentees,(*g*) for the object of the Crown, in granting an extension, being to reward the person who communicated the invention to the public, unless such person—*i.e.*, the original patentee—derives some benefit the extension will not be granted.(*h*)

The ground that the merits of the inventor ought to be properly rewarded, in dealing with an invention which has proved useful and beneficial to the public, does not exist in the

(*y*) s. 46.
(*z*) Bodmer's Patent, (1849) 6 Moo. P. C. 469.
(*a*) Petitt Smith's Patent, (1850) 7 Moo. P. C. 133.
(*b*) Newton's Patent (1), (1861) 14 Moo. P. C. 156.
(*c*) Southworth's Patent, (1837) 1 W. P. C. 486; *but see Church's Patent*, (1886) 3 R. P. C. 95.
(*d*) 5 & 6 Will. IV. c. 83.
(*e*) 7 & 8 Vict. c. 69, s. 4.
(*f*) Davies Patent, (1894) 11 R. P. C. 28.
(*g*) Norton's Patent, (1863) 1 Moo. P. C. N. S. 339; Normand's Patent, (1870) L. R. 3 P. C. 193; Claridge's Patent, (1851) 7 Moo. P. C. 394.
(*h*) See Norton's Patent, (1863) 1 Moo. P. C. N. S. 339; Normand's Patent, (1870) L. R. 3 P. C. 193; Bovill's Patent, (1863) 1 Moo. P. C. N. S. 348; Hopkinson's Patent, (1896) 14 R. P. C. 10.

The Petitioner.

case of an assignee, unless the assignee be a person who has assisted the patentee with funds to enable him to perfect and bring his invention into use.(*i*)

On an application by assignees, the Judicial Committee always consider that by favourably listening to the application of an assignee they are, though not directly, yet mediately and consequentially, as it were, giving a benefit to the inventor, because, if the assignee is not remunerated at all, it might be said that the patentee's chance of making an advantageous conveyance to an assignee would be materially diminished, and consequently his interest damnified. For this reason, consideration is given to the claims of the assignee who has an interest in a patent (*k*) and has assisted in the development of the invention.

It thus appears that an assignee who has assisted with capital in developing the invention will be viewed by the Judicial Committee more favourably (*l*) than one who has rendered no such assistance, but has merely purchased the invention on speculation.(*m*)

Companies.

Companies formed for the purpose of taking over patents and working them stand in the same position as other assignees with regard to petitions for prolongation or extension ; *i.e.*, if it can be shown that the company has expended money in developing the invention for the public benefit, and has not obtained an adequate return, the Judicial Committee will report favourably to the company,(*n*) but if the company has been formed for purposes of speculation merely no prolongation or extension will be recommended.(*o*)

Extension is not recommended unless original patentee would be directly or indirectly benefited.

There is no reported case in which the Committee have recommended an extension, on the petition of an assignee, when it would not directly or indirectly tend towards the benefit

(*i*) Per Lord Romilly, Norton's Patent, (1863) 1 Moo. P. C. N. S. 339.

(*k*) See judgment of Lord Brougham, Morgan's Patent, (1843) 1 W. P. C. 738.

(*l*) Bodner's Patent, (1849) 6 Moo. P. C. 468; Berry's Patent, (1850) 7 Moo. P. C. 187 ; Whitehouse's Patent, (1830) 1 W. P. C. 473 ; 2 Moo. P. C. 496 ; Carp. P. C. 565 ; Woodcroft's Patent, (1846) 2 W. P. C. 18 ; 10 Jur. 363 ; Normand's Patent, (1870) L. R. 3 P. C. 193 ; 6 Moo P. C. N. S. 477 ; Houghton's Patent, (1871) L. R. 3 P. C. 461.

(*m*) *Ibid.* ; Sillar's Patent, (1882) G. P. C. 581 ; Norton's Patent, (1863) 1 Moo. P. C. N. S. 339 ; 9 Jur. N. S. 419 ; G. P. C. 553 ; Hopkinson's Patent, (1896) 14 R. P. C.

(*n*) Petitt Smith's Patent, (1850) 7 Moo. P. C. 133 ; Houghton's Patent, (1871) L. R. 3 P. C. 461 ; 7 Moo. P. C. N. S. 309 ; Napier's Patent (1), (1861) 13 Moo. P. C. 543 ; Church's Patent, (1886) 3 R. P. C. 95.

(*o*) Sillar's Patent, (1882) 1 G. P. C. 581 ; Claridge's Patent, (1851) 7 Moo. P. C. 394 ; Reece's Patent, (1881) 17 Iron. 155 ; 51 Eng. 207 ; Duncan and Wilson's Patent, (1884) 1 R. P. C. 257 ; see also Norton's Patent, (1863) G. P.C. 554, per Romilly, M.R. ; Hopkinson's Patent, (1896) 14 R. P. C. 5.

of the original inventor, who would, had there been no assignment, have been in a position to claim an extension himself.(*p*) **The Petition.**

Thus an assignee who has acquired a patent as a commercial venture cannot hope to obtain an extension when the original inventor could have no legitimate interest in making the application himself, *e.g.*, when the original patentee has been sufficiently rewarded at the expense of the patent, though the assignee has made a loss, or only a small profit, by the adventure, an extension will not be granted.(*q*)

Merit of an importer is less than that of an original inventor.

The merit of an importer,(*r*) *i.e.*, an inventor in the patent law sense, and not a mere assignee, is less than that of an original inventor.(*s*) To use the language of Lord *Brougham*, "the patent law is framed in a way to include two species of public benefactors; the one, those who benefit the public by their ingenuity, industry, science, invention, and personal capability; the other, those who benefit the public without any ingenuity or invention of their own, by the importation of the results of foreign inventions. Now, the latter is a benefit to the public incontestably, and, therefore, they render themselves entitled to be put upon somewhat, if not entirely, the same footing as inventors."(*t*)

Exclusive licensees should be co-petitioners.

When the patentee has granted an exclusive licence, the exclusive licensee should be a co-petitioner in order that he may show his accounts, and that the exclusive licence was not in fact prejudicial to the public, and further that he may release any rights he may have in the extension if granted.(*u*) If an exclusive licence has proved detrimental to the public interest, this fact may influence the Committee not to recommend an extension.(*x*)

The Petition.

Petition may include several patents.

Two or more patents relating to cognate inventions may be included in one petition.(*y*)

(*p*) Bower Barff's Patent, (1895) 12 R. P. C. 386.

(*q*) Claridge's Patent, (1851) 7 Moo. P. C. 394; Norton's Patent, (1863) 1 Moo. P. C. N. S. 339; Bower Barff's Patent, (1895) 12 R. P. C. 5; Carmont's Patent, (1897) 14 R. P. C. 239.

(*r*) See p. 16 *ante*.

(*s*) Soames' Patent, (1843) 1 W. P. C. 729.

(*t*) Berry's Patent, (1850) 7 Moo. P. C. 187; see also Bower Barff's Patent, (1895) 12 R. P. C. 385.

(*u*) Shone's Patent, (1892) 9 R. P. C. 438, 440.

(*x*) Darby's Patent, (1891) 8 R. P. C. 380; Shone's Patent, (1892) 9 R. P. C. 438.

(*y*) See Johnson and Atkinson's Patents, (1873) L. R. 5 P. C. 87; Clarke's Patent, (1870) L. R. 3 P. C. 421; 7 Moo. P. C. N. S. 255; Church's Patent, (1886) 3 R. P. C. 95; Erard's Patent, (1835) 1 W. P. C. 557.

The Petition.

Requisites of petition.

A petitioner seeking the grace and favour of the Crown is bound to strict truth in his statements ; (*e*) and the petitioner should remember that a prolongation or extension is a matter of favour and not of right,(*a*) and that a petition will be dismissed if it fails to state everything connected with the patent fairly and fully.(*b*) Thus, the petitioner in his petition and accounts (*c*) must refer to all foreign patents granted to him in respect of the invention forming the subject-matter of the English patent, and to the remuneration or loss he has derived or sustained through such foreign patents.(*d*) Prolongation has been refused on the ground that the petition was nominally presented by one, but actually in the interest and for the benefit of another company, to whom the shares in the first company had been transferred and no statement of this fact appeared in the petition, and the Judicial Committee would not have been cognisant of it, had it not been brought forward by the Attorney-General.(*e*)

Where it appeared from the petition that the petitioners were a company who had purchased the patent, but in fact no company, in a commercial sense, had been formed under the Companies Acts, and the persons really interested were the petitioner and a creditor, the Judicial Committee did not recommend an extension.(*f*)

And where the petition concealed the fact that the manufacture of the patented article had been, by contract, carried on by one of several joint patentees, who had carried on such manufacture in conjunction with the manufacture of other articles, and the accounts did not disclose any other manufacture than that of the patented article, the petition was dismissed.(*g*)

The petitioner cannot be too careful in framing his petition properly, as the indulgence of the Judicial Committee in granting amendments and adjournments cannot be relied upon ; but in some cases, where there are special circumstances, an amend-

(*e*) Clarke's Patent (2), (1870) L. R. 3 P. C. 421, 426 ; 7 Moo. P. C. N. S. 255 ; Johnson's Patent, (1871) L. R. 4 P. C. 75, 83 ; 8 Moo. P. C. N. S. 282 ; Hill's Patent, (1863) 1 Moo. P. C. N. S. 258 ; 9 Jur. N. S. 1209 ; 9 L. T. N. S. 101 ; Horsey's Patent, (1884) 1 R. P. C. 225.

(*a*) Adair's Patent, (1881) L. R. 6 App. Cas. 176.

(*b*) Pitman's Patent, (1871) L. R. 4 P. C. 84 ; 8 Moo. P. C. N. S. 293.

(*c*) p. 429 *post*.

(*d*) Johnson's Patent, (1871) L. R. 4 P. C. 75 ; 7 Moo. P. C. N. S. 255 ; Pitman's Patent, (1871) L. R. 4 P. C. 84 ; 8 Moo. P. C. N. S. 293 ; Adair's Patent, (1881) L. R. 6 App. Cas. 178 ; 50 L. J. P. C. 68 ; Clarke's Patent, (1870) L. R. 3 P. C. 421.

(*e*) Reece's Patent, (1881) 17 Iron. 155 ; 51 Eng. 207.

(*f*) Horsey's Patent,(1884) 1 R. P. C. 225.

(*g*) Yates and Kellett's Patent,(1887) L. R. 12 App. Cas. 147.

ment, and, if necessary, an adjournment, may be allowed.(*h*) The procedure for such relief is by way of a separate petition to the Committee.(*i*)

The Petition.

A departure from the statutory provisions on presenting a petition affects the jurisdiction of the Judicial Committee, and is consequently fatal; but an omission to observe properly the rules laid down by the Judicial Committee itself may be remedied.(*k*)

Departure from statutory requirements affects the jurisdiction of the Committee, but not so a *failure to comply* with the rules.

In the case of patents granted prior to January 1, 1884, the petition may be presented at any time before the expiration of the patent, provided that it is prosecuted with effect (*i.e.*, the report of the Judicial Committee is obtained),(*l*) before the expiration of the term.(*m*)

When petition may be presented.

The Act of 1883 does not require the petition to be prosecuted with effect before the expiration of the original term of the monopoly; and it is submitted that, if it be presented at least six months before the time limited for the expiration,(*n*) any patent to which the Act applies in this matter may be extended, notwithstanding that the report of the Judicial Committee is obtained, after the expiry of the original term.

There is nothing in the patent law which renders invalid a new grant of letters patent, dated after the expiry of the original term, if such new grant is made on the representations of a report of the Judicial Committee of the Privy Council properly obtained. If, however, the petition is not presented in time, *i.e.*, six months before the natural expiration of the patent, the Judicial Committee has no jurisdiction in the matter, and so cannot entertain the petition.(*o*)

Advertisements.

It is provided by the Judicial Committee Rules, 1898,(*p*) that a party intending to apply by petition under s. 25 of the Act of 1883 shall give public notice by advertisement three times in the *London Gazette*, and once, at least, in each of three London newspapers. If the applicant's principal place of business is situated in the United Kingdom at a distance of fifteen miles or more from Charing Cross, he shall also advertise once, at

(*h*) See Reece's Patent, (1881) 17 Iron. 155; 51 Eng. 207; Adair's Patent, (1881) L. R. 6 App. Cas. 176, 180; Hutchinson's Patent, (1861) 14 Moo. P. C. 364.

(*i*) Brandon's Patent, (1884) 1 R. P. C. 154.

(*k*) Hutchinson's Patent, (1861) 14 Moo. P. C. 364; Lindon's Patent, (1897) 14 R. P. C. 643; Judicial Committee Rules, (1898) r. 7, p. 734 *post*.

(*l*) Ledsam *v.* Russell, (1847) 1 H. L. Cas. 687.

(*m*) Brandon's Patent, (1884) 1 R. P. C. 154.

(*n*) 46 & 47 Vict. c. 57, s. 25 (1).

(*o*) Jablochkoff's Patent, (1891) 8 R. P. C. 281; see above.

(*p*) Rule 1, p. 731 *post*

The Petition.

least, in some local newspaper published or circulating in the town or district where such place of business is situated. If the applicant has no place of business, then, if he carries on the manufacture of anything made under his specification at a distance of fifteen miles or more from Charing Cross, he shall advertise once, at least, in some local newspaper published or circulating in the town or district where he carries on such manufacture. If he has no place of business, and carries on no such manufacture, then, if he resides at a distance of fifty miles or more from Charing Cross, he shall advertise once, at least, in some newspaper published or circulating in the town or district where he resides.

It is further provided by the same rules (*q*) that the applicant shall in his advertisements state the object of his petition and shall give notice of the day on which he intends to apply for a time to be fixed for hearing the matter thereof, which day shall not be less than four weeks from the date of the publication of the last of the advertisements to be inserted in the *London Gazette*. He shall also give notice that caveats must be entered at the Council Office on or before such day so named in the said advertisements.

Petition must be presented within one week of last advertisement in the *London Gazette*.

A petition for revocation under s. 25 of the Act of 1883 must be presented within one week from the publication of the last of the advertisements required to be published in the *London Gazette*.(*r*)

Affidavit of advertisements.

The petition must be accompanied with an affidavit or affidavits of advertisements having been published according to the requirements of the Judicial Committee Rules, 1898. The statements contained in such affidavit or affidavits may be disputed upon the hearing.(*s*)

Application for time for hearing.

It is further the duty of the petitioner to apply to the Lords of the Committee to fix a time for hearing the petition, and when such time is fixed the petitioner is required forthwith to give public notice of the same by advertisement once at least in the *London Gazette* and in two London newspapers.(*t*)

Documents to be lodged by petitioner at the Council office.

The petitioner must, not less than fourteen days before the day fixed for the hearing, lodge at the Council office eight printed copies of the specification; but if the specification has not been printed, and if the expense of making

(*q*) Rule 1; p. 731 *post*.
(*r*) Judicial Committee Rules, (1898) r. 2, p. 732 *post*.
(*s*) *Ibid*. (*t*) *Ibid*.

eight copies of any drawing therein contained or referred to would be considerable, the lodging of two copies only is to be deemed sufficient.(*u*) **The Petition.**

The petitioner is also required, not less than fourteen days before the day fixed for the hearing, to lodge at the Council office eight copies of the balance-sheet of expenditure and receipts relating to the patent in question, which amounts are to be proved on oath before the Lords of the Committee at the hearing. He must also furnish three copies of the said balance-sheet for the use of the Solicitor to the Treasury, and must, upon receiving two days' notice, give the Solicitor to the Treasury, or any person deputed by him for the purpose, reasonable facilities for inspecting and taking extracts from the books of account, by reference to which he proposes to verify the said balance-sheet at the hearing, or from which the materials for making up the said balance-sheet have been derived.(*x*)

Equitable assignee petitioning with the legal owner.

If an equitable assignee is desirous of petitioning with the legal owner, his name must appear in the advertisements.(*y*)

Petitioner resident abroad.

In cases where the patentee resides abroad, and the invention is carried on under licences, the advertisements should be inserted in papers circulating in places where the manufacture is actually carried on.(*z*)

Proof of advertisements.

The advertisements must be proved before the petition is heard,(*a*) for if anything required by the statute to be done is not done the Crown has no power to grant a prolongation.(*b*) The Judicial Committee has, however, power to dispense with exact compliance with the mode of advertisement as required by its own rules, and in a proper case will do so (*c*)—*e.g.*, where there has by an oversight been an omission to issue the preliminary advertisements, and, if the rules were insisted on, it would be impossible to comply with the statutory requirement that the petition must be presented at least six months before the expiration of the patent, the Committee will allow the petition to be received before the insertion of the advertisements, the parties undertaking to insert before a day named all the advertisements required, and the order being served on the

(*u*) Judicial Committee Rules,(1898) r. 3, p. 732 *post.*

(*x*) *Ibid.*

(*y*) *In re* Noble's Patent, (1850) 7 Moo. P. C. 191.

(*z*) Derosne's Patent, (1844) 2 W. P. C. 2.

(*a*) Perkin's Patent, (1845) 2 W. P. C. 8 ; p. 416 *ante.*

(*b*) *In re* Noble s Patent, (1850) 7 Moo. P. C. 194 ; p. 415 *ante.*

(*c*) Jablochkoff's Patent, (1891) 8 R. P. C. 281 ; see p. 415 *ante;* Lindon's Patent, (1897) 14 R. P. C. 643.

Opposition.

Attorney-General, and to be subject to any objection he may make.(*d*)

Order fixing the day for hearing.

The usual order fixing the day for hearing requires the petitioner to advertise the date fixed in the *London Gazette*, and two other papers named in the order.(*e*)

If on the application to fix a day for hearing it appear that the petition has been presented some considerable time (*e.g.*, eighteen months) before the expiry of the patent, the hearing will be postponed, on the ground that the profits made during the unexpired period may be sufficient adequately to reward the patentee, or affect the term of extension (if any) granted,(*f*) but it will not be necessary to serve fresh notices.(*g*)

OPPOSITION.

Any person may enter a caveat.

It is to be observed that any person may, on or before the day fixed by the petitioner for his application for a time to be fixed for the hearing of his petition, enter a *caveat* or warning to the Sovereign not to accede to the prayer of the petition.(*h*) An extension of the time for entering a *caveat* will not be granted as a rule on the ground that the applicant did not see the advertisements of the intended application for a day for hearing till too late.(*i*) Interest in the patent is not essential, as in the case of opposition to the grant,(*j*) the amendment of a specification,(*k*) or the revocation of a patent.(*l*) A person who has entered a *caveat* is entitled to receive four weeks' notice from the petitioner of the day fixed for the hearing,(*m*) and to be served with a copy of the petition ;(*n*) but this rule has been relaxed, and an earlier date fixed for the hearing in a case where the patent would have expired before the notice.(*o*) He is also entitled to notice of any special application by the petitioner,(*p*) and, at his own expense, copies of all papers lodged in reference to the petition.(*q*)

Notice to opponents of day fixed for hearing.

Notice of opponents objections to be

The Judicial Committee rules (1898) require an opponent, within three weeks of being served with the petition, to lodge

(*d*) Lindon's Patent, (1897) 14 R.P.C. 643.
(*e*) See p. 804 *post*.
(*f*) See Macintosh's Patent, (1837) 1 W. P. C. 739 n.
(*g*) *Ibid.*
(*h*) p. 410 *ante*.
(*i*) Hopkinson's Patent, (1897) 13 R. P. C. 114.
(*j*) p. 317 *ante*.
(*k*) p. 278 *ante*.
(*l*) p. 391 *ante*.
(*m*) Judicial Committee Rules, (1898) r. 4, see p. 733 *post*.
(*n*) *Ibid.*
(*o*) Thomas's Patent, (1892) 9 R. P. C. 378.
(*p*) Hutchison's Patent, (1861) 14 Moo. P. C. 364.
(*q*) Judicial Committee Rules, (1898), r. 5, p. 733 *post*.

at the Council office eight printed copies of the grounds of his objections to the granting of the prayer of the petitioner.(*r*) It will be sufficient if the grounds of the objections are stated, though particulars are not given.(*s*) The rules (*t*) made under Lord *Brougham's* Act contained a similar provision.

Opposition.

lodged at the Council office.

Opposers are not entitled to production and inspection of the petitioner's accounts until the hearing,(*u*) but they are allowed copies of them, at their own expense, when they are filed.(*x*)

Copies of petitioner's accounts.

A party intending to oppose a petition under s. 25 of the Act must enter a *caveat* at the Council Office before the day on which the petitioner applies for a time for hearing the matter thereof, and having entered such *caveat* shall be entitled to have from the petitioner four weeks' notice of the time appointed for the hearing.(*y*) The petitioner is required to serve copies of his petition on all parties entering caveats in accordance with the rules, and no application to fix a time for hearing may be made without affidavit of such service.(*z*)

Time within which caveats may be entered.

Petition must be served on all opponents.

All parties intending to oppose are required, within three weeks after such copies are served on them, respectively to lodge at the Council office eight printed copies of the grounds of their objections to the granting of the prayer of the petition.(*a*)

Copies of opponent's grounds of opposition to be lodged at Council office.

Parties are entitled, at their own expense, to have copies of all papers lodged in respect of the petition.(*b*)

Copies of all papers lodged may be obtained.

And all petitions as well as all statements of grounds of objection are to be printed in the form prescribed by the rules which apply to proceedings before the Judicial Committee of the Privy Council. Balance-sheets of expenditure and receipts are to be printed in a form convenient for binding along with such petitions.(*c*)

How petitions and notices of opposition, &c., are to be printed.

The Lords of the Committee will hear the Attorney-General or other counsel on behalf of the Crown on the question of granting the prayer of the petition. The Attorney-General is not required to give notice of the grounds of any objection he may think fit to take, or of any evidence which he may think fit to place before the Lords of the Committee.(*d*)

Attorney-General may be heard without notice.

Costs incurred in the matter of the petition are taxed by the

Costs of hearing may be taxed.

(*r*) Rule 4, p. 733 *post*.
(*s*) Ball's Patent, (1879) L. R. 4 App. Cas. 171; 48 L. J. P. C. 24.
(*t*) Rule 6, p. 729 *post*.
(*u*) Bridson's Patent, (1852) 7 Moo. P. C. 499.
(*x*) Judicial Committee Rules, (1898) r. 5; p. 733 *post*.
(*y*) *Ibid.* r. 4; p. 733 *post*.
(*z*) *Ibid.* (*a*) *Ibid.*
(*b*) *Ibid.* r. 5; p. 733 *post*. (*c*) *Ibid.*
(*d*) *Ibid.* r. 8; p. 734 *post*.

Hearing of the Petition.

Registrar of the Privy Council, or other officer deputed by the Lords of the Judicial Committee of the Privy Council to tax costs in the matter of any petition, and the Registrar or such officer has authority to allow or disallow in his discretion all payments made to persons of science or skill examined as witnesses.(*e*)

Compliance with rules may be dispensed with.

The Lords of the Committee have power expressly given them by the present rules to excuse petitioners and opponents from compliance with any of the requirements of the rules relating to the practice as to petitions under s. 25 of the Act of 1883, and to give such directions in matters of procedure and practice under the section as they shall consider to be just and expedient.(*f*)

Hearing of the Petition.

Parties may appear personally or by counsel.

At the hearing of the petition, the petitioner and opposing parties, if there are any, may appear either in person or by counsel; but where there are several opponents not more than two counsel will be heard on either side, unless the opposing parties have distinct and separate interests.(*g*)

Hearing when there is no opposition.

If there is no opposition, or if any of the grounds on which the patent might be opposed are admitted in the patentee's favour by the opponent, the Committee will require formal evidence in support of the petition as a whole, or in support of the admitted grounds, as the case may be.(*h*)

Petition heard though there are pending proceedings affecting question of validity.

The Judicial Committee will hear and adjudicate on a petition notwithstanding that there are proceedings pending affecting the question of validity of the patent, or judgment has been given or the patent has been declared void by a Court from which an appeal lies, and the decision of which is not binding on the Committee.(*i*)

Practice of the Committee.

It is the usual practice, on the hearing of a petition, for the Judicial Committee to deal first with the question of the utility of the invention to the public,(*k*) and afterwards with that of adequacy of remuneration;(*l*) but sometimes this order is reversed—*e.g.*, where the accounts (*m*) show that the

(*e*) Judicial Committee Rules, (1898) r. 6; p. 440 *post*.
(*f*) *Ibid.* r. 7; p. 734 *post*.
(*g*) Woodcroft's Patent, (1841) 3 Moo. P. C. 172 n.
(*h*) Toy's Patent, (1893) 10 R. P. C. 89.
(*i*) Kay's Patent, (1839) 1 W. P. C. 568; 572 note (*f*); Heath's Patent, (1853) 2 W. P. C. 247; Lane Fox's Patent, (1892) 9 R. P. C. 411.
(*k*) p. 425 *post*. (*l*) p. 423 *post*.
(*m*) p. 429 *post*.

remuneration has been such that it would be preposterous to grant the petition,(*n*) or the accounts are unsatisfactory.(*o*)

Hearing of the Petition.

In accordance with the rule laid down in *Erard's Patent*,(*p*) the Attorney-General always appears at the hearing of petitions for the extension of letters patent, whether there is opposition or not, to watch the interests of the Crown and the public, and he is entitled to be heard without having previously entered a *caveat*.(*q*) Also he is not bound to give any notice of objections at all, and may at the hearing raise objections of which no notice has been given.(*r*) The patentee comes to ask a favour, and it is his duty to show the exact state of knowledge at the time of his patent, and the exact pale of his invention, by himself referring to previous publications.(*s*)

Attorney-General always appears.

The Judicial Committee may, if they think fit, appoint one of the clerks of the Privy Council to take any formal proofs required to be taken, in dealing with the matter before them, and may proceed on the clerk's report as if the proofs had been taken by the Committee itself;(*t*) and under the Act of 1883 they may call in the aid of an assessor specially qualified and hear the petition, wholly or partially, with his assistance, and determine the remuneration he is to receive.(*u*)

Formal proofs may be taken by Clerk of the Committee.

Where a petitioner applied to have the hearing of his petition advanced, or his evidence taken on commission on account of his impending absence from England, an order was made to the effect that, if his absence proved to be imperative, his evidence might be taken before the Registrar, subject to any objection which the Attorney-General might raise. In the result the evidence was so taken, and the Registrar directed that it should not be published before the hearing of the petition.(*x*)

A patentee is never entitled to demand, *ex debito justitiæ*, a prolongation or extension of the term of his monopoly. In

Committee's discretion is absolute.

(*n*) Crighton's Patent, 39 Eng. 135; Saxby's Patent, (1870) L. R. 3 P. C. 292; 7 Moo. P. C. N. S. 82; 19 W. R. 513; Clark's Patent (2) (1870) L. R. 3 P. C. 421; 7 Moo. P. C. N. S. 255; Trotman's Patent, (1866) L. R. 1 P. C. 118; Houghton's Patent, (1871) 7 Moo. P. C. 309.

(*o*) Wield's Patent, (1871) L. R. 4 P. C. 89; 8 Moo. P. C. N. S. 300; Thomas's Patent, (1892) 9 R. P. C. 367.

(*p*) (1835) 1 W. P. C. 557 n; Whitehouse's Patent, (1830) 1 W. P. C. 474.

(*q*) Petitt Smith's Patent, (1850) 7 Moo. P. C. 133; rule 8, p. 734 *post*.

(*r*) Rule 8, p. 734 *post*; 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.

(*s*) Fountain Livet's Patent, (1892) 9 R. P. C. 331, 332.

(*t*) 7 & 8 Vict. c. 69, s. 8.

(*u*) 46 & 47 Vict. s. 28, sub-s. 2 and 3.

(*x*) Whitworth's Patent, 48 Eng. 15.

Grounds for Extension.

all cases, the Judicial Committee have an absolute discretion in recommending the Crown to promote the progress of the petition ;(*y*) and the only limit to this recommendation is that the period of extension shall not be more than fourteen years.(*z*)

Grounds for Extension.

Grounds for extension have reference to the patentee and to the public.

It is expressly provided by the Act of 1883 (*a*) that "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."

All the grounds upon which the Judicial Committee of the Privy Council grant extensions of patents may be said to have reference to the inventor himself. They are, in the first place, to reward the inventor for the peculiar ability and industry he has exercised in making the discovery ; in the second place, to reward him because some great benefit of an unusual description has by him been conferred upon the public, through the invention itself ; and, lastly, because the inventor has not been sufficiently remunerated by the profits derived from his strenuous exertions to make the invention profitable. All these grounds proceed upon the supposition that the invention is new and useful.(*b*) But, nevertheless, the grant of an extended term must not be detrimental to the public interest.(*c*) The fact that the patentee has granted an exclusive licence is a point against the extension of a patent, for it is against public policy that there should be only one licensee.(*d*) This objection may be got over by making it a condition of extension that the exclusive licensee shall renounce all right and benefit in the licence.(*e*)

(*y*) Jones's Patent, (1840) 1 W. P. C. 577 ; Smith and Robertson's Patent, (1847) 30 Newton L. J. O. S. 451 ; Porter's Patent, 1 Newton, L. J. N. S. 179 ; Morgan's Patent, (1843) 1 W. P. C. 739 ; Soames' Patent, (1843) 1 W. P. C. 733 ; Perkins' Patent, (1845) 2 W. P. C. 16 ; Derosne's Patent, (1844) 2 W. P. C. 4 ; Honiball's Patent, (1855) 9 Moo. P. C. 393 ; Cardwill's Patent, (1856) 10 Moo. P. C. 490.

(*z*) 46 & 47 Vict. c. 57, s. 25 ; Ledsam *v.* Russell, (1847) 1 H. L. Cas. 687.

(*a*) s. 25, sub-s. 4.

(*b*) Per Lord Romilly, Norton's Patent, (1863) 1 Moo. P. C. N. S. 339 ; 9 Jur. N. S. 419 ; see also Whitehouse's Patent, (1830) 2 Moo P. C. 496 ; 1 W. P. C. 473 ; Erard's Patent, (1835) 1 W. P. C. 557 ; Downton's Patent, (1839) 1 W. P. C. 565 ; Derosne's Patent, (1844) 2 W. P. C. 1 ; 4 Moo. P. C. 417 ; Carp. P. C. 699 ; Woodcroft's Patent, (1841) 2 W. P. C. 18 ; 10 Jur. 363.

(*c*) McInnes' Patent, (1868) L. R. 2 P. C. 54 ; 37 L. J. P. C. 23 ; 5 Moo. P. C. N. S. 72.

(*d*) Cardwill's Patent, (1856) 10 Moo. P. C. 488 ; Darby's Patent, (1891) 8 R. P. C. 380 ; Shone's Patent, (1892) 9 R. P. C. 438.

(*e*) Shone's Patent, (1892) 9 R. P. C. 441.

Grounds for Extension.

The fact that an extension would prevent the public from using the invention, which is one of public importance—*e.g.*, a process for deodorising manure may weigh against the grant of the prayer of the petition.(*f*)

But the fact that the invention deals with a subject, *e.g.*, smoke prevention, which the public are by statute obliged to use, does not, though the public may practically be obliged to use the patentee's invention, raise an insuperable objection against the extension of the patent.(*g*)

Two things necessary to obtain an extension.

It is thus clear that a petitioner, in order to induce the Judicial Committee to recommend the Crown to grant the prayer of the petition, must satisfactorily prove two things, viz. :—

(i) The invention is meritorious.
(ii) He has been insufficiently remunerated, owing to no fault of his own.

Invention must be proved to be independently meritorious.

(i) **Merit.** The applicant must make out a *prima facie* case of validity.(*h*) For this purpose, a decision of the High Court of Justice, or the Court of the County Palatine of Lancaster, in favour of the validity of the patent will be sufficient.(*i*)

The invention must be shown to be independently meritorious—*e.g.*, it will not do to show that it could only be useful in conjunction with some later discovery.(*k*) It is, however, not an objection to the grant of a prolongation or extension that the invention is an improvement on, and is intended to be used with, some previously patented invention,(*l*) or that the original invention would not be used without it,(*m*) provided that there is utility in the improvement.(*n*)

Only part of invention meritorious.

If an invention consist of several parts, and it appear that some part, or parts, is, or are, not meritorious, but that there is merit in the remaining part or parts, an extension will probably be recommended in respect of the meritorious part or parts alone.(*o*)

(*f*) McDougall's Patent, (1867) L.R. 2 R. P. C. 1; 5 Moo. P. C. 1; Sillar's Patent, (1882) G. P. C. 581; Morgan's Patent, (1843) 1 W. P. C. 739; Soames' Patent, (1843) 1 W. P. C. 734.

(*g*) Foardes' Patent, (1855) 9 Moo. P. C. 376.

(*h*) Erard's Patent, (1835) 1 W. P. C. 557; Kay's Patent, (1839) 1 W. P. C. 568; 3 Moo. P. C. 24.

(*i*) See Bett's Patent, (1862) 7 L. T. N. S. 577; 9 Jur. N. S. 137; 1 Moo. P. C. N. S. 49.

(*k*) Bett's Patent, (1862) 1 Eng. 335; 1 Moo. P. C. 49; 7 L. T. N. S. 577.

(*l*) Bovill's Patent, (1863) 1 Moo. P. C. N. S. 348; Soames' Patent, (1843) 1 W. P. C. 729.

(*m*) Woodcroft's Patent, (1841) 1 W. P. C. 740; 3 Moo. P. C. 171; Galloway's Patent, (1843) 1 W. P. C. 727.

(*n*) Bell's Patent, (1846) 2 W. P. C. 160; 10 Jur. 363.

(*o*) Bodmer's Patent, (1881) 8 Moo. P. C. 282; Lee's Patent, (1881) 10 Moo. P. C. 226; Napier's Patent, (1881) L. R. 6 App. Cas. 174; 50 L. J. P. C. 40; (1886) Church's Patent, 3 R. P. C. 95. As to effect of an admission that one claim is bad see Burlingham's Patent, (1898) 15 R. P. C. 195.

Grounds for Extension.

Committee does not decide question of validity.

The Judicial Committee will not recommend the extension of a patent which, on the face of it, appears to be invalid; (*p*) but they will not discuss or decide the question of validity, if it appear decidedly doubtful on the ground of lack of novelty, or utility, or from any other cause,(*q*) and evidence of these points may be given at the hearing.(*r*) In cases of doubt as to the validity of the patent, the Judicial Committee exercises its discretion,(*s*) and it will not refuse to act though there are proceedings pending in which the validity is in question, or there is a decision against the patent of a Court whose judgments are not binding on the Committee.(*t*) Though the Committee does not try the issue of validity, questions which go to validity may be material upon the question of merit. Thus, prolongation was refused where it appeared that the main merit of the invention lay not in the disclosure of a principle, but in the details of construction, and the petitioner had not given sufficient disclosure in his specification as to those details, and the evidence showed that all the articles constructed under the patent were made under the personal supervision of the patentee, who alone knew the details, and so the specification was insufficient.(*u*)

A new grant is open to same objections as the old one.

If a new grant is allowed, it is of course open to the same objections, and may be annulled in the same manner as the old one; (*x*) and the Judicial Committee are not called on to discuss the question as to whether an extension, if granted, would avail the petitioner anything: that is left to the Courts of law.(*y*)

Merit in the sense of ntility must be proved.

There is an obvious distinction between the "merit of ingenuity and the merit of utility" of an invention; (*z*) and unless the Judicial Committee are satisfied that the invention

(*p*) Kay's Patent, (1839) 1 W. P. C. 568; 3 Moo. P. C. 24; Erard's Patent, (1835) 1 W. P. C. 557; McDougal's Patent, (1867) L. R. 2 P. C. 1; 37 L. J. P. C. 17; 5 Moo. P. C. N. S. 1.

(*q*) Hill's Patent, (1863) 9 Jur. N. S. 1209; 9 L. T. N. S. 101; 1 Moo. P. C. N. S. 258; 18 Newton, L. J. N. S. 109; Cocking's Patent, (1885) 2 R. P. C. 151; Stewart's Patent, (1886) 3 R. P. C. 7; Saxby's Patent, (1870) L. R. 3 P. C. 292; 7 Moo. P. C. N. S. 82; Lyon's Patent, (1894) 11 R. P. C. 537.

(*r*) *Ibid.*

(*s*) Per Sir William Erle, McInnes' Patent, (1868) L. R. 2 P. C. 54; 37 L. J. N. S. P. C. 23; 5 Moo. P. C. N. S. 72; Woodcroft's Patent, (1846) 2 W. P. C. 18; 10 Jur. 363; 28 Newton L. J. C. S. 196; Pinker's Patent, (1848) 12 Jur. N. S. 433; Soames' Patent, (1843) 1 W. P. C. 729; 23 Newton, L. J. C. S. 462.

(*t*) Kay's Patent, (1839) 1 W. P. C. 568, 572 n; Heath's Patent, (1853) 2 R. P. C. 247; Lane Fox's Patent, (1892) 9 R. P. C. 411.

(*u*) Fountain Livet's Patent, (1892) 9 R. P. C. 327.

(*x*) Galloway's Patent, (1843) 1 W. P. C. 724; 7 Jur. 453.

(*y*) Per Lord Brougham, Woodcroft's Patent, (1841) 2 W. P. C. 18; 10 Jur. 363; 28 Newton, L. J. C. S. 196.

(*z*) Bett's Patent, (1862) 7 L. T. N. S. 577; 9 Jur. N. S. 137; 1 Moo. P. C. N. S. 49; Pinker's Patent, (1848) 12 Jur. N. S. 433.

possesses the latter, they will not recommend an extension; (*a*) though mere simplicity of invention is not necessarily an objection to an extension,(*b*) yet the fact of great labour and ingenuity being required to produce the invention will go far to establish a case of utility strong enough to satisfy the Committee that the public is likely to derive a benefit from the invention sufficient to warrant an extension.(*c*)

Grounds for Extension.

The test of utility is not the same for the purposes of prolongation as in an action of infringement or petition for revocation. In the former case commercial utility is of the utmost importance, but not so in the latter.(*d*) And generally in order to succeed, the petitioner must show that there is in the invention merit beyond that ordinary merit which would be sufficient to sustain a patent in the first instance—that is to say, there must be something beyond that merit which would, in an action for infringement, support a patent in the face of a plea of want of utility.(*e*) Consequently, because an invention is new, in the sense that a patent for it could be supported on the ground of novelty, it does not necessarily follow that it is sufficiently novel, having regard to prior inventions of a like character, to satisfy the Judicial Committee that the benefit conferred by it on the public is sufficient to warrant an extension.(*f*)

Test of utility necessary for an extension.

Thus, where there have been previous patents for somewhat analogous methods of attaining the same result as that achieved by the petitioner's patented invention, and the petitioner's invention has not been taken up by the public, though it has been advertised to a considerable extent, the Judicial Committee will not deem the invention to possess such a sufficient degree of novelty or merit as will justify them in recommending a prolongation.(*g*)

(*a*) Simister's Patent, (1842) 1 W. P. C. 721; 7 Jur. 451; 4 Moo. P. C. 164; 21 Newton, L. J. C. S. 465; Longmaid's Patent, 1 Eng. 347; Derosne's Patent, (1835) 2 W. P. C. 1; Carp. P. C. 699; 4 Moo. P. C. 417; 24 Newton, L. J. C. S. 459.

(*b*) Per Lord Watson, Hazeland's Patent, (1894) 11 R. P. C. 470.

(*c*) Hill's Patent, (1863) 9 L. T. N. S. 101; 9 Jur. N. S. 1209; 1 Moo. P. C. N. S. 258; 18 Newton, L. J. N. S. 109.

(*d*) Lawrence's Patent, (1892) 9 R. P. C. 83; McDougal's Patent, (1884) 2 R. P. C. 11; Pitman's Patent, (1871) L. R. 4 P. C. 84; 8 Moo. P. C. N. S. 293.

(*e*) See remarks of Grove, J., Stoney's Patent, (1888) 5 R. P. C. 520; see also Saxby's Patent, (1886) 3 R. P. C. 294; Bett's Patent, (1862) 1 Moo. P. C. N. S. 49; 9 Jur. N. S. 137; 7 L. T. N. S. 577.

(*f*) Stuart's Patent, (1886) 3 R. P. C. 7; Sillar's Patent, (1882) G. P. C. 581; M'Dougal's Patent, (1867) L. R. 2 P. C. 1; 37 L. J. N. S. P. C. 17; 5 Moo. P. C. N. S. 1; McInnes' Patent, (1868) L. R. 2 P. C. 54; 37 L. J. N. S. P. C. 23; 5 Moo. P. C. N. S. 72.

(*g*) Allan's Patent, (1867) L. R. 1 P. C. 507; 4 Moo. P. C. N. S. 443; Stewart's Patent, (1885) 3 R. P. C. 7; Hall's Patent, (1895) 12 R. P. C. 400.

Grounds for Extension.

Extent of user is an important question.

The extent to which the invention has been used by the public is, in more ways than one, an important consideration. If there has been an extensive use by the public, of course this fact is unfavourable to the contention of an applicant for prolongation or extension, for though it shows that the invention is useful, it also shows that the patentee has had an opportunity of making profit out of it.(*h*) On the other hand, if the invention has not been extensively used by the public, the presumption is against its utility, and therefore unfavourable to the applicant.(*i*) In the words of Lord *Romilly*, the Judicial Committee "find much more difficulty in dealing with the case of a patent where it has not been used for fourteen years than in dealing with one where a user has taken place, because, assuming that there is no utility in the invention, there is nobody whose interest it is to oppose it; but where it has been used for a considerable number of years there are persons who always desire to get rid of the invention [patent], and from them their Lordships hear all the arguments which can properly be brought against the validity of the patent." (*k*)

Presumption of non-utility arising from limited use may be rebutted.

The presumption of non-utility arising from a limited use of the invention by the public is not in every case fatal, for it is often capable of being rebutted,(*l*) even though there has been no user at all; (*m*) but strong evidence is required to do this.(*n*)

For example, in the case of *Southby's Patent*,(*o*) the original invention which was patented in 1877 was of great merit, but had never been brought into practical use, because the patentee was not satisfied that he had brought the invention into such practical efficiency as could justify him in incurring the expense

(*h*) Downton's Patent, (1839) 1 W. P. C. 565.

(*i*) Allan's Patent, (1867) L. R. 1 P. C. 507; 4 Moo. P. C. N. S. 443; Herbert's Patent, (1867) L. R. 1 P. C. 399; 4 Moo. P. C. 300; Simister's Patent, (1842) 1 W. P. C. 721; 7 Jur. 451; 4 Moo. P. C. 164.

(*k*) Allan's Patent, (1867) L. R. 1 P. C. 507; 4 Moo. P. C. N. S. 433.

(*l*) Norton's Patent, (1863) 1 Moo. P. C. N. S. 339; 9 Jur. N. S. 419; Bakewell's Patent, (1862) 15 Moo. P. C. 385; Wright's Patent, (1839) 1 W. P. C. 575; Jones' Patent, (1840) 1 W. P. C. 577; Allan's Patent, (1867) L. R. 1 P. C. 507; 4 Moo. P. C. N. S. 433; Cocking's Patent, (1885) 2 R. P. C. 151; Berrington's Patent, cited L. R. 1 P. C. 509; 4 Moo. P. C. N. S. 445; Coryton, 225; Simister's Patent, (1842) 1 W. P. C. 721; 7 Jur. 451; Southworth's Patent, (1837) 1 W. P. C. 486; Herbert's Patent, (1867) L. R. 1 P. C. 399; 4 Moo. P. C. N. S. 300; Hughes' Patent, (1879) L. R. 4 App. Cas. 174; 48 L. J. P. C. 20; Semet and Solway's Patent, (1894) 12 R. P. C. 10; Roper's Patent, (1887) 4 R. P. C. 201; Southby's Patent, (1891) 8 R. P. C. 433.

(*m*) Roper's Patent, (1887) 4 R. P. C. 4; Southby's Patent, (1891) 8 R. P. C. 433.

(*n*) Allan's Patent, (1867) L. R. 1 P. C. 507; 4 Moo. P. C. N. S. 433.

(*o*) (1891) 8 R. P. C. 433.

Grounds for Extension.

of putting it on the market. In 1885 the patentee took out a subsequent patent for an invention apparently essential to the working of his original machine, and which enabled such machine to be worked successfully. The Judicial Committee advised a prolongation of five years on the ground that the presumption of non-utility arising from non-user was rebutted, and that there might be some other way than that protected by the 1885 patent by which the machine might be successfully worked.

The following facts also have been held to be sufficient evidence to rebut the presumption of non-utility arising from a limited user by the public: there was a special trade opposition; (*p*) the invention was of a special nature and could not easily be brought into public use; (*q*) the market and demand was necessarily limited; (*r*) experimental difficulties; (*s*) legal proceeedings; (*t*) and the scarcity of labour.(*u*)

Probability of use in the future must be established.

The applicant must show that, if a prolongation or extension be allowed, there is every likelihood of the invention being used by the public—*i.e.*, that the conditions owing to which the public use has hitherto been limited (if such be the case) have ceased to exist; otherwise the intention of the Crown that the patentee should be rewarded by the profits arising from the invention, during the further period of the monopoly could not take effect, and the Judicial Committee would not recommend the Crown to accede to the petitioner's request.(*x*)

Benefit accrued to the public compared with that derived by the patentee.

(ii) **Insufficient remuneration owing to no fault of the patentee.**—In deciding whether the patentee has been sufficiently rewarded, the Judicial Committee take into consideration the benefit which has resulted and is likely to result to the public, as compared with that which has accrued to the patentee.(*y*)

Petitioner must prove that he has

The petitioner must satisfy the Judicial Committee that he has, having regard to the particular circumstances of each case,

(*p*) Sinister's Patent, (1842) 1 W. P. C. 721; 7 Jur. 451; 4 Moo. P. C. 161.

(*q*) Southworth's Patent, (1837) 1 W. P. C. 486; Jones's Patent, (1840) 1 W. P. C. 577; Hughes' Patent, (1879) L. R. 4 App. Cas. 174; 48 L. J. P. C. 20; Semet and Solway's Patent, (1894) 12 R. P. C. 10.

(*r*) Herbert's Patent, (1867) L. R. 1 P. C. 399; 4 Moo. P. C. N. S. 300.

(*s*) *Ibid.*

(*t*) Wright's Patent, (1839) 1 W. P. C. 575.

(*u*) Napier's Patent, (1861) 13 Moo. P. C. 543.

(*x*) Woodcroft's Patent, (1846) 2 W. P. C. 18; 10 Jur 363; Bates' Patent, (1836) 1 W. P. C. 739; Foarde's Patent, (1855) 9 Moo. P. C. 376.

(*y*) Newton's Patent, (1861) 14 Moo. P. C. 156; Derosne's Patent, (1844) 2 W. P. C. 4; Mallet's Patent, (1866) L. R. 1 P. C. 308; Nussey and Leachman's Patent, (1890) 7 R. P. C. 22.

Grounds for Extension.

used his best endeavours to make profit,

used his best endeavours to make the invention a pecuniary success, and that no circumstances under his control have led to his insufficient remuneration,(*z*) but that he has at all times been willing to give the public the benefit of the invention.(*a*)

Thus, in the case of *Roper's Patent*,(*b*) the patentee of a captain's bridge constructed as a life-raft petitioned for prolongation on the ground that, owing to illness and other circumstances beyond his control, he had not been adequately remunerated. It was proved that for nearly eight years he had been practically incapacitated from business in consequence of a railway accident. The invention had been awarded prizes at exhibitions, but had never been brought into actual use. Under the circumstances, the Judicial Committee considered that, having regard to the meritorious nature of the invention, the difficulty of bringing it into actual use, the patentee's illness, and the fact that no opposition was offered on behalf of the Crown, the case was an exceptional one, and an extension for seven years should be granted. But prolongation was refused when it appeared that for twelve years before the patent was assigned to a certain petitioner no effort to work it or push it commercially had been made, and no sufficient excuse was forthcoming for the delay.(*c*)

and has not permitted open infringements.

If infringements of the patent have been openly committed, it will be necessary for the petitioner to show that proceedings have been taken to protect the patent, as evidence of negligence on his part to do so will induce the Judicial Committee to refuse to recommend a prolongation or extension; (*d*) whereas if the expense of litigation necessary to maintain the patent has prevented the petitioner from deriving adequate profits from the invention this circumstance will tell in his favour.(*e*)

Disputes by co-owners.

The circumstance that the invention has not been brought into public use owing to disputes between the co-owners of a

(*z*) Southworth's Patent, (1837) 1 W. P. C. 486; Kollman's Patent, (1839) 1 W. P. C. 564; Lowe's Patent, (1846) 2 W. P. C. 158; 10 Jur. 363; Norton's Patent, (1863) 1 Moo. P. C. N. S. 339; 9 Jur. N. S. 419; Patterson's Patent, (1849) 6 Moo. P. C. 469; 13 Jur. 593; Wield's Patent, (1871) L. R. 4 P. C. 89; 8 Moo. P. C. N. S. 300; Cardwell's Patent, (1856) 10 Moo. P. C. 488; Bakewell's Patent, (1862) 15 Moo. P. C. 385; Stewart's Patent, (1886) 3 R. P. C. 7.

(*a*) Stewart's Patent, (1886) 3 R. P. C. 10.

(*b*) (1887) 4 R. P. C. 201.

(*c*) Dolbear's Patent, (1896) 13 R. P. C. 203.

(*d*) Simister's Patent, (1842) 1 W. P. C. 724; 4 Moo. P. C. 164; 7 Jur. 451.

(*e*) Petitt Smith's Patent, (1850) 7 Moo. P. C. 133; Heath's Patent, (1853) 2 W. P. C. 247; 8 Moo. P. C. 217.

patent will not induce the Judicial Committee to recommend a prolongation or extension.(*f*)

Grounds for Extension.

Quantum of adequate remuneration.

There does not appear to be any case reported in which an extension has been granted where the patentee has received more than £20,000 from the patent; but this is not a hard and fast rule, and possibly in a case of very special merit such a sum might be treated as inadequate remuneration.(*g*) In a case where the patentee and his assignees had received £25,000 from the invention prolongation was refused.(*h*)

Accounts to be lodged by the petitioner and their requisites.

The petitioner must lodge at the Council Office, not less than one week before the day for the hearing,(*i*) a statement of accounts as evidence of his contention that he has been insufficiently rewarded, having regard to the value of the invention to the public. Where the accounts are not lodged within the time specified by the Judicial Committee Rules, an adjournment of the hearing may be ordered on the request of the Attorney-General or other opponents.(*k*) The Judicial Committee insist that the statement of accounts shall be a full, clear, and accurate (*l*) balance-sheet, showing the whole *profit and loss* which has been derived or sustained in respect of the invention.(*m*) It is the petitioner's duty to satisfy the Committee, in a manner which admits of no controversy, as to the amount of remuneration which in every point of view the invention has brought to those who have introduced, or helped to introduce, it to the public, in order that their Lordships may be able to come to a conclusion whether that remuneration may fairly be considered a sufficient reward or not.(*n*) To use the language of Lord *Cairns*, "It is not for the Committee to send back the accounts for further particulars, nor to dissect the accounts for the purpose of surmising what may be their real outcome if they were differently cast; it is for the applicant to bring his accounts before the Committee in a shape which will leave no doubt as to what the remuneration has been that he has received."(*o*)

(*f*) Patterson's Patent,(1849) 6 Moo. P. C. 469; 13 Jur. 593.

(*g*) Thomas' Patent, (1892) 9 R. P. C. 372.

(*h*) Carmont's Patent, (1897) 14 R. P. C. 239.

(*i*) Judicial Committee Rules, (1898) r. 3; p. 732 *post*.

(*k*) Johnson's and Atkinson's Patents, (1873) L. R. 4 P. C. App. Cas. 87; Chatwood's Patent, (1874) L. R. 4 P. C. App. Cas. 88 n.

(*l*) Clark's Patent, (1870) L. R. 3 P. C. 421; 7 Moo. P. C. N. S. 255; Hill's Patent, (1863) 1 Moo. P. C. N. S. 258; 9 Jur. N. S. 1209; 9 L. T. N. S. 101.

(*m*) Judicial Committee Rules,(1898) r. 3; p. 732 *post*.

(*n*) Saxby's Patent, (1870) L. R. 3 P. C. 292; 7 Moo. P. C. N. S. 82; Clark's Patent, (1870) L. R. 3 P. C. 421; 7 Moo. P. C. N. S. 255; Wield's Patent, (1871) L. R. 4 P. C. 89; 8 Moo. P. C. N. S. 300.

(*o*) Saxby's Patent, (1870) L. R. 3 P. C. 295; 7 Moo. P. C. 82.

Grounds for Extension.

If this requirement is not attended to carefully, the Committee will most probably refuse to grant the petitioner leave to amend the accounts,(*p*) and will dismiss the petition altogether; (*q*) and the petitioner will not as a rule be excused on the ground that he has kept no such accounts, or has destroyed his books.(*r*)

Absence of books of account may sometimes be explained.

In some cases—*e.g.*, in the case of fire—the absence of books of account may be satisfactorily explained, and an affidavit of want of profits will then be accepted;(*s*) but in the absence of such books of account, whether owing to destruction by fire or otherwise, and of a reasonable explanation of such absence, everything must be taken most strongly against the petitioner.(*t*) Thus, where a statement made in the prospectus of an assignee company would, if true, necessitate the conclusion that the patentee had received as adequate remuneration more than he admitted, in the absence of his books, which had been destroyed, prolongation was refused.(*u*)

Sometimes losses need not be proved with strict accuracy.

Under special circumstances, where the invention is of indisputable great merit, it may not be necessary to prove the petitioner's losses with the strict accuracy usually required.(*x*)

Manner in which a patentee should keep his accounts from the first.

The following passage from the decision of the Judicial Committee, delivered by Lord *Hobhouse* in *Lake's Patent*,(*y*) indicates the way in which the patentee should keep his accounts from the beginning and present them to the Committee:—

> "In this case their Lordships have come to the conclusion that the petition must be dismissed because it is not shown, and on the materials before the Committee it cannot be shown with propriety on this occasion, that the patentee has not been adequately remunerated. In order to show that, the patentee should keep his accounts in a way which would enable the Crown Officers to whom they are produced and this Committee, and indeed members of the public, to form some judgment on the question whether he has or has not received adequate remu-

(*p*) Newton's Patent, (1884) (4) 4 L. R. 9 App. Cas. 592; 1 R. P. C. 177; 52 L. T. 329; Yates and Kellett's Patents, (1887) 4 R. P. C. 150.

(*q*) Adair's Patent, (1881) L. R. 6 App. Cas. 176; 50 L. J. P. C. 68; Saxby's Patent, (1870) L. R. 3 P. C. 292; 7 Moo. P. C. N. S. 82; Bett's Patent, (1862) 1 Moo. P. C. N. S. 49; 9 Jur. N. S. 137; 7 L. T. N. S. 577.

(*r*) Yates and Kellett's Patent, (1887) L. R. 12 App. Cas. 149; 4 R. P. C. 150.

(*s*) Hutchinson's Patent, (1861) 14 Moo. P. C. 222; Marwick's Patent, (1860) 13 Moo. P. C. 310; Lowe's Patent, (1852) 10 Jur. 363.

(*t*) Yates and Kellett's Patent, (1887) L. R. 12 App. Cas. 147; 4 R. P. C. 150; Lawrence's Patent, (1892) 9 R. P. C. 85.

(*u*) Lawrence's Patent, (1892) 9 R. P. C. 85.

(*x*) Darby's Patent, (1891) 8 R. P. C. 380.

(*y*) (1891) 8 R. P. C. 228; see also Hughes' Patent, (1898) 15 R. P. C. 371.

neration; and not only should the accounts be kept in such a form, but they should be produced before this Committee in such a shape that it does not require long and minute investigation of supplemental accounts in order to understand the result of them. Grounds for Extension.

"The principle on both points has been stated very clearly on several occasions by this Committee. In *Bett's Patent*, so far back as the year 1862 it was stated that 'there can be no difficulty in a patentee beginning from the first to keep a patent account distinct and separate from any other business in which he may happen to be engaged. He knows perfectly well that if his invention is of public utility, and he has not been adequately remunerated, he will have a claim for an extension of the original term of his patent. It is not, therefore, too much to expect that he should be prepared, when the necessity arises, to give the clearest evidence of everything which has been paid and received on account of the patent.' That refers to the mode in which the accounts should be kept. In *Saxby's Patent* this Committee made some observations on the mode in which the accounts should be produced. Lord *Cairns*, in delivering the judgment, said: 'It is the duty of every patentee, who comes for the prolongation of his patent, to take upon himself the onus of satisfying this Committee, in a manner which admits of no controversy, on what has been the amount of remuneration which in every point of view the invention has brought to him, in order that their Lordships may be able to come to a conclusion whether that remuneration may fairly be considered a sufficient reward for his invention or not. It is not for this Committee to send back the accounts for further particulars, nor to dissect the accounts for the purpose of surmising what might be their real outcome if they were differently cast. It is for the applicant to bring his accounts before the Committee in a shape which will leave no doubt as to what the remuneration has been that he has received.'"

Thus, where a company being assignees of a patent kept books on a wrong system for the first eight years of the patent, and the accounts furnished to the Committee included certain entries, amounting to a considerable sum, as corrections of the books, which could not be checked from the accounts themselves without an examination of the books, the Judicial Committee held that the accounts were insufficient, and refused to allow the petitioners to call evidence to explain them.(z) Effect of keeping accounts on a wrong system.

The Judicial Committee are by statute (a) required, when Committee have regard to

(z) Lake's Patent, (1891) 8 R. P. C. 227; see also Hughes' Patent, (1898) 15 R. P. C. 370.

(a) 46 & 47 Vict. c. 57, s. 25, sub-s. 4.

Grounds for Extension.

deciding the question of adequacy of remuneration, to "*have regard to the profits made by the patentee as such*"; accounts which do not show this are consequently defective. Thus where it appeared that the patentee had assigned to a company for a considerable sum, both his business and also the patent in question, together with another one, and the petitioning assignee company presented general accounts of their business which showed a considerable profit, but failed to show what the patentee had received in respect of the patent alone, or what profit had been made by the petitioning company from the patent alone apart from its general business, the Committee refused to recommend a prolongation on the ground that, upon the materials before them, they could not come to the conclusion that the patentee had been inadequately remunerated by the patent.(*b*)

the profits made by the patentee as such.

Advisability of striking a balance at the end of each year's accounts.

It is most material for the Judicial Committee to know in what ratio the profits have increased or diminished from year to year; therefore it is advisable for the petitioner to strike a balance at the end of each year's accounts.(*c*)

The Committee are required to have regard to all the circumstances of the case.(*d*)

Total remuneration actually derived from, or which could have been derived from the patent, is an important question; consequently assignee's or licensee's profits must be disclosed.

One question always is, What has been the total remuneration derived from the patent, or which could have been derived from the patent? Consequently, when the patent has become vested in an assignee—*e.g.*, a company—the Committee require a disclosure, not only of the assignee's profits, but also of all the profits derived by his predecessors in title,(*e*) and also, when licences have been granted, a disclosure of not only the royalties received by the patentee, but also, where possible, some evidence as to the profits made by the licensees.(*f*) A petition has been dismissed on the ground that the manufacturing profits due to the use of the invention by an assignee of a share in the patent and free licensee under it were not shown.(*g*)

Though it be clear that the patentee himself has received no profits, it is still a fatal defect if the accounts do not disclose the profits made by his assignees or licensees.(*h*)

(*b*) Williams and Robinson's Patent, (1896) 13 R. P. C. 550. But see Parson's Patent, (1898) 15 R. P. C. 357, where the patentee was not responsible for the difficulty.

(*c*) Perkin's Patent, (1845) 2 W. P. C. 16, 17.

(*d*) 46 & 47 Vict. c. 57, s. 25, sub-s. 4.

(*e*) Deacon's Patent, (1887) 4 R. P. C. 119.

(*f*) Trotman's Patent, (1866) L. R. 1 P. C. 123; 3 Moo. P. C. N. S. 488; Saxby's Patent, (1870) L. R. 3 P. C. 298; 7 Moo. P. C. N. S. 82; Hill's Patent, (1863) 1 Moo. P. C. N. S. 258, 268; 9 L. T. N. S. 101.

(*g*) Thomas' Patents, (1892) 9 R. P. C. 367; Barff and Bowers' Patent, (1895) 12 R. P. C. 383; (1895) L. R. App. Cas. 675.

(*h*) Lane Fox's Patent, (1892) 9 R. P. C. 411.

Grounds for Extension.

Rule in Pitman's patent.

In *Pitman's Patent* (*i*) the Committee laid down the rule for their future guidance to the effect that they would consider a failure to make a full disclosure of everything relating to the patent—*e.g.*, particulars as to profits on foreign patents—as absolutely fatal to the petitioner. Further, it is to be noticed that the direction in the Act of 1883 to the effect that the Judicial Committee, in coming to a conclusion, "shall have regard to the profits made by the patentee as such,"(*k*) in effect, specifies one particular class of profits as absolutely necessary; but there is nothing in the section of the Act to suggest that the Committee shall not consider the profits in relation to the patent arising from other sources, and consequently the accounts must disclose all profits arising from the working of foreign patents, as was the practice before the Act of 1883.(*l*) The profits, if any, arising from the sale of articles made under the patent expressly for exportation abroad must also be disclosed.(*m*)

Former practice with regard to inventions patented abroad.

It was formerly the practice of the Judicial Committee, previous to the Act of 1883, not to recommend the prolongation of a patent for an invention the subject of a prior foreign patent, which had expired before the hearing of the petition, on the ground that they had no authority to recommend such prolongation.(*n*) Where, however, a foreign inventor held an English patent and also foreign patents in respect of the invention, one of which, though of later date than his English patent, had expired,(*o*) or was about to expire,(*p*) the Committee, in the exercise of their discretion, refused to recommend a prolongation. When the inventor was an English-born subject, the practice was that his application should not be unduly prejudiced by the fact that a foreign patent of later date than his English patent had expired.(*q*)

Present practice with regard to inventions patented abroad.

The expiration of foreign patents does not affect the validity of English patents granted after January 1, 1884,(*r*) but it is submitted that, notwithstanding the repeal of former Acts by

(*i*) (1871) L. R. 4 P. C. 84.

(*k*) s. 25 (4).

(*l*) Newton's Patent, (1884) L. R. 9 App. Cas. 592; Johnson's Patent, (1871) L. R. 4 P. C. 82; Adair's Patent, (1881) L. R. 6 App. Cas. 178; Pieper's Patent, (1895) 12 R. P. C. 293.

(*m*) Hardy's Patent, (1849) 6 Moo. P. C. 441.

(*n*) Bodmer's Patent, (1853) 8 Moo. P. C. 282; Aube's Patent, (1854) 9 Moo. P. C. 43; Blake's Patent, L. R. 4 P. C. 535; 9 Moo. P. C. N. S. 373.

(*o*) Newton's Patent, (1862) 15 Moo. P. C. 176; 9 Jur. N. S. 109: Normand's Patent, (1870) L. R. 3 P. C. 193; 6 Moo. P. C. N. S. 477.

(*p*) Normand's Patent, (1870) L. R. 3 P. C. 193; 6 Moo. P. C. N. S. 477.

(*q*) Bett's Patent, (1862) 1 Moo. P. C. N. S. 49; 9 Jur. N. S. 137; 7 L. T. N. S. 577.

(*r*) p. 333 *ante*.

Grounds for Extension.

the Act of 1883, in the case of patents dated before January 1, 1884, the Judicial Committee will still take cognisance of the existence of foreign patents, in forming their decision whether to recommend an extension or otherwise,(*s*) as indeed it will when a patent of later date than January 1, 1884, is the subject of the petition.

The Committee considers all the circumstances of the case: (*t*) and if foreigners are at liberty to use the invention free, this fact may induce the Committee not to accede to the petition, on the ground that to do so would be to unduly handicap the British public, and so the fact that there are foreign patents which the petitioner has allowed to expire is still a great obstacle in the way of a patentee desirous of obtaining an extension of a British patent.(*u*) In such circumstances it requires a very strong case to be made out by the petitioner for extension, but if the invention is of rare or exceptional merit, and the inventor has been very insufficiently remunerated, notwithstanding that there are lapsed foreign patents, the Committee will recommend a prolongation, when there is no reason to suppose that the inhabitants of Great Britain and Ireland would be thereby placed at a disadvantage in competing with foreigners.(*x*)

Items which may be credited to the petitioner.

The petitioner is entitled to place on the credit side of the account various items and expenses, but if he desires to contend that such sums are not to be considered as profits such claim must appear on the petition or in the accounts, otherwise he will not be allowed to offer any evidence in respect of it.(*y*) It is better to render a separate account of items in respect of which a deduction is claimed.

Expenses in connection with experiments, legal proceedings, salaries and commissions.

The petitioner is entitled to credit himself with the expenses incurred in making preliminary experiments, in obtaining the grant of the patent, and in legal proceedings necessary to defend it;(*z*) also necessary costs of exhibiting and advertising the invention;(*a*) and reasonable salaries and travelling

(*s*) 46 & 47 Vict. c. 57, s. 113; Newton's Patent, (1884) L. R. 9 App. Cas. 592; 1 R. P. C. 177; Brandon's Patent, (1884) 1 R. P. C. 154.

(*t*) 46 & 47 Vict., c. 57, s. 25, sub-s. 4.

(*u*) Fountain Levit's Patent, (1892) 9 R. P. C. 327; Shone's Patent, (1892) 9 R. P. C. 438, 440; Semet and Solway's Patent, (1894) 12 R. P. C. 10; Pieper's Patent, (1895) 12 R. P. C. 295.

(*x*) Semet and Solway's Patent, (1894) 12 R. P. C. 10; Pieper's Patent, (1895) 12 R. P. C. 295.

(*y*) Bailey's Patent, (1884) 1 R.P.C. 1.

(*z*) Kay's Patent, (1839) 1 W. P. C. 572; 3 Moo. P. C. 24; Heath's Patent, (1853) 2 W. P. C. 247; 8 Moo. P. C. 217; Hill's Patent, (1863) 1 Moo. P. C. N. S. 258; 9 Jur. N. S. 1209; 9 L. T. N. S. 101; Adair's Patent, (1881) L. R. 6 App. Cas. 176; 30 L. J. P. C. 68.

(*a*) Duncan and Wilson's Patent, (1884) 1 R. P. C. 257.

expenses for clerks; (*b*) and commissions on sales or royalties.(*c*)

Grounds for Extension.

A deduction has been allowed in the case of a foreign patentee resident abroad, who has obtained an English patent and has employed an agent in England to introduce the invention here.(*d*)

When the petitioner has compromised actions at law in relation to the patent, and foregone any claim to costs, it is improper for him to deduct the expenses of such proceedings in an unexplained lump sum.(*e*)

Deductions have been refused in respect of an item for the purchase of land for the purpose of working *in situ* a manufacture according to a patented process,(*f*) and also in respect of payments for the surrender of licences.(*g*) When a patentee, under the impression that the invention was one of small value, sold it for a trifling sum, and, after it had proved of considerable value, repurchased it at an increased price, he was not allowed to charge the item in the accounts as one of loss.(*h*)

Profits made as a manufacturer in contradistinction to profits made as a patentee.

When the patentee is also the manufacturer of the patented article, the profits which he makes as manufacturer, although they may not be in strict point of view profits of the patent, must undoubtedly be taken into consideration.(*i*) It is obvious that in different manufactures there will be different degrees of connection between the business of the applicant as manufacturer, and his business, or his position, as the owner of a patent. There are patents which have little or no connection with the business of the manufacturer, and there are others of a different kind, where there is such an intimate connection with the business of the manufacturer that the possession of the patent virtually secures to the patentee his power of commanding orders as a manufacturer.(*k*)

(*b*) Duncan and Wilson's Patent, (1884) 1 R. P. C. 257.

(*c*) *Ibid.*; Poole's Patent, (1867) L. R. 1 P. C. 514; 4 Moo. P. C. N. S. 452; 36 L. J. P. C. 76.

(*d*) Poole's Patent, (1867) L. R. 1 P. C. 514; 4 Moo. P. C. N. S. 452; 36 L. J. P. C. 76.

(*e*) Hill's Patent, (1863) 1 Moo. P. C. N. S. 258, 268; 9 Jur. N. S. 1209; 9 L. T. N. S. 101.

(*f*) Fryer's Patent, 47 Eng. 49.

(*g*) Hill's Patent, (1863) 1 Moo. P. C. N. S. 258; 9 Jur. N. S. 1209; 9 L. T. N. S. 101.

(*h*) Wield's Patent, (1871) L. R. 4 P. C. 89; 8 Moo. P. C. N. S. 300.

(*i*) Bett's Patent, (1862) 1 Moo. P. C. N. S. 49; 9 Jur. N. S. 137; 7 L. T. N. S. 577; McInnes' Patent, (1868) L. R. 2 P. C. 54, 57; 5 Moo. P. C. N. S. 72; 37 L. J. P. C. 23; Hill's Patent, (1863) 1 Moo. P. C. N. S. 258; 9 Jur. N. S. 1209; 9 L. T. N. S. 101; Johnson's Patent, (1871) L. R. 4 P. C. 75; 8 Moo. P. C. 282; Saxby's Patent, (1870) L. R. 3 P. C. 292, 295; 7 Moo. P. C. N. S. 82.

(*k*) See Saxby's Patent, (1870) L. R. 3 P. C. 295.

Grounds for Extension.

When it is not possible to sever the heads of a patentee's profits, as a manufacturer and as a patentee, but it is apparent that a substantial sum has been realised, the Committee will not recommend a prolongation or extension.(*l*)

There is no specific rule as to the proper ratio to fix as the proportion of the total profits to be allowed as manufacturer's profits when the patentee is also the manufacturer,(*m*) but the proportion must be divided according to the circumstances of each case.(*n*)

Where it appeared that a considerable sum had been received from sales of the patented article, the Committee refused to look on the difference between the actual cost of the articles and the price at which they were sold as mere profits made by the patentee as salesman, but concluded that a considerable proportion of this was profit which the patentee had received, because, having the patent, he was able to sell the articles, and refused to recommend an extension accordingly.(*o*)

Where the patentee is himself a manufacturer it is better for him to keep the accounts of his manufacturing business separate from those relating exclusively to the patent, so as to present them in this form to the Judicial Committee.

Personal remuneration when patentee is himself a manufacturer.

Where a patentee is a manufacturer and himself superintends the conduct of the business of making the patented article, he is often entitled to a reduction in respect of his personal services, but the amount varies with the special circumstances of each case.(*p*)

Effect of rendering incomplete accounts.

The effect of rendering incomplete accounts, or accounts in an improper form, is not always fatal, but the petitioner must not rely on the indulgence of the Committee, and he cannot be too particular in the matter of accounts. Under special circumstances, when it appears that the accounts are wrong through a *bonâ fide* mistake on the part of the patentee, the

(*l*) Muntz's Patent, (1846) 2 W. P. C. 113; Newton's Patent, 51 Eng. 208; 17 Iron, 155, 171.

(*m*) Duncan and Wilson's Patent, (1884) 1 R. P. C. 257, 260.

(*n*) See Trotman's Patent, (1866) L. R. 1 P. C. 118; 3 Moo. P. C. N. S. 488. Two-thirds has been held to be too large a proportion in Hill's Patent, (1863) 1 Moo. P. C. N. S. 258; 9 Jur. N. S. 1209; 9 L. T. N. S. 101; and also in Duncan and Wilson's Patent, (1884) 1 R. P. C. 257.

(*o*) Bailey's Patent, (1884) 1 R. P. C. 1.

(*p*) As much as £600 per annum has been allowed in the case of the chairman of a company formed to work the patent: Child's Patent, 56 Eng. 435; but as a rule £400 per annum, or less, is considered sufficient; Bailey's Patent, (1884) 1 R. P. C. 1; Carr's Patent, (1873) L. R. 4 P. C. 530; 9 Moo. P. C. N. S. 379; Perkin's Patent, (2) 47 Eng. 105; Cocking's Patent, (1885) 2 R. P. C. 151; Furness' Patent, (1885) 2 R. P. C. 175; Toy's Patent, (1893) 10 R. P. C. 89; Hazeland's Patent, (1894) 11 R. P. C. 467.

Judicial Committee may grant an adjournment in order that the accounts may be put right,(*q*) but in most cases of insufficient or improper accounts the petition will be dismissed at once.(*r*)

The New Grant.

The New Grant.

It is the practice for the Crown in cases where the Judicial Committee recommend a prolongation or extension of the term of a patent to give effect to the report of the Committee by a new grant of letters patent.(*s*)

Crown gives effect to the recommendation of the Committee by means of a new grant,

It is not necessary for the patentee to file a fresh specification on the grant of a new patent;(*t*) and the validity of the new patent may be questioned in the same way and on the same grounds as that of the old one.(*u*) The new grant is in the nature of a graft on the old one, and has no existence apart from it.(*x*) A new grant of letters patent is subject in all cases to the conditions imposed by the Act of 1883 and subsequent statutes,(*y*) and may be granted to more than one person jointly,(*z*) but, it is submitted, a new grant cannot be made to a person or persons who has, or have not, or one of whom has not a legal interest in the old letters patent.(*a*)

which is subject to same conditions as the expired grant.

The Crown in granting new letters patent has the power to, and frequently does, impose conditions in the interest of the original patentee (*b*) or his representatives.(*c*) The following are instances of cases in which such conditions have been imposed. In *Whitehouse's Patent* (*d*) extension was granted to an assignee on condition that he secured to the patentee and inventor, during the term, an annuity of £500, in addition to £300 already secured to him. In *Markwick's Patent*,(*e*) where the

Conditions in the interest of the original patentee are frequently, on the recommendation of the Committee, imposed by the Crown on a new grant.

(*q*) Perkins' Patent, (1845) 2 W. P. C. 17; Heath's Patent, (1853) 2 W. P. C. 256; 8 Moo. P. C. 217; Henry's Patent, 38 Eng. 343, 352; Chatwood's Patent, 37 Eng. 285; Johnson and Atkinson's Patent, (1873) L. R. 5 P. C. 87.

(*r*) Clark's Patent (2), (1870) L. R. 3 P. C. 421; 7 Moo. P. C. N. S. 255; Newton's Patent (4), (1884) L. R. 9 App. Cas. 592; 1 R. P. C. 177; Adair's Patent, (1881) L. R. 6 App. Cas. 178; 50 L. J. P. C. 68.

(*s*) Stoney's Patent, (1888) 5 R. P. C. 524; Cocking's Patent, 1885, 2 R. P C. 151.

(*t*) Wasteney Smith's Patent, (1885) 12 R. P. C. 14.

(*u*) Russell *v.* Ledsam, (1843) 14 M. & W. 583; H. L. C. 687; Bovill *v.* Finch, (1870) L. R. 5 C. P. 523.

(*x*) Bovill *v.* Finch, (1870) L. R. 5 P. C. 523; 39 L. J. C. P. 277.

(*y*) Wasteney and Smith's Patent, (1885) 2 R. P. C. 14.

(*z*) 46 & 47 Vict. c. 57, s. 4, sub-s. 2.

(*a*) Southworth's Patent, (1837) 1 W. P. C. 488.

(*b*) Whitehouse's Patent, (1830) 1 W. P. C. 473; reported as Russell's Patent, 2 Moo. P. C. 496.

(*c*) Herbert's Patent, (1867) L. R. 1 P. C. 399.

(*d*) (1838) 1 W. P. C. 473; reported as Russell's Patent, 2 Moo. P. C. 496.

(*e*) (1860) 13 Moo. P. C. 310.

The New Grant.

original patentee had been bankrupt, the condition was imposed that he should receive an annuity during the extended period. In *Morton's Patent* (*f*) the assignee was required to secure to the original patentee one-half the future profits after recouping his own losses. In *Herbert's Patent* (*g*) an extension was granted to assignees on condition that they secured upon trust to the widow and representatives of the inventor one-half of the profits.

Conditions are sometimes imposed for the benefit of persons other than the original patentee,

Sometimes conditions are imposed on the patentee for the benefit of other persons who have an interest in the patent,(*h*) or who might be liable in respect of infringements committed between the date of the order and the sealing of the new patent,(*i*) or to the effect that a patentee mortgagor should give to his mortgagee a like security over the new patent as he had over the old.(*k*)

or for the benefit of the public generally.

When the justice of the case requires, conditions will be imposed in favour of the Crown or the public generally.

Thus in *Petitt Smith's Patent* (*l*) the condition was imposed that the Crown should be allowed to use the invention without licence. See also *Lancaster's Patent*,(*m*) *Carpenter's Patent*,(*n*) and *Dixon* v. *London Small Arms Co.*(*o*) These cases were all prior to the Act of 1883. Such conditions are not now insisted upon in favour of the Crown, as they are provided for by s. 27 of the Act of 1883, which applies to all new grants of letters patent.

In *Mallet's Patent* (*p*) the condition was imposed that the patentee should grant licences upon terms similar to one already granted by him. In *Hardy's Patent* (*q*) it was made a condition of the new grant that the patentee should sell the patented article (iron axletrees) at a moderate fixed sum. Such conditions are, however, not imposed now, reliance being placed on s. 22 of the Act of 1883.

In *Bodner's Patent* (*r*) the condition was imposed that certain portions of the specifications which related to parts of the invention not worked out should be disclaimed. In *Lyon's Patent*,(*s*) where the patentee had granted an exclusive licence, the condition was imposed that the petitioner should grant

(*f*) 51 Eng. 274; 17 Iron. 250.
(*g*) (1867) L. R. 1 P. C. 399; 4 Moo. P. C. N. S. 300.
(*h*) Normandy's Patent, (1855) 9 Moo. P. C. 452; Baxter's Patent, 13 Jur. 593.
(*i*) Schlumberger's Patent, (1853) 9 Moo. P. C. 1.
(*k*) Church's Patent, (1886) 3 R. P. C. 95.
(*l*) (1850) 7 Moo. P. C. 133
(*m*) 2 Moo. P. C. N. S. 189.
(*n*) 2 Moo. P. C. N. S. 191 n.
(*o*) L. R. 1 App. Cas. 632.
(*p*) (1866) L. R. 1 P. C. 308.
(*q*) 6 Moo. P. C. 441.
(*r*) (1853) 8 Moo. P. C. 282.
(*s*) (1894) 11 R. P. C. 537.

licences on the same terms to all persons who should apply for them, the royalties to be limited to ten per cent. upon the selling price of each machine. **The New Grant.**

It is the practice when extension is granted in respect of two cognate patents to fix the expiry of each on the same day.(*t*) **Date of commencement and expiry of new grant.**

The Crown can only grant a prolongation or extension of letters patent on the report of the Judicial Committee of the Privy Council. It is the invariable practice for the Crown to act on such report, but it must be remembered that the Crown is not bound so to act.(*u*) The Judicial Committee before recommending a prolongation or extension requires security to be given that the conditions (if any) on which the new grant is recommended will be performed.(*x*)

The new grant may be made after the expiration of the original term, if all the statutory conditions have been complied with, but it is always dated as on the day on which the original term expires.

The Crown has no authority to grant more than one period of prolongation or extension of letters patent.(*y*) **Only one period of extension can be obtained.**

It is not usual for the Judicial Committee to recommend a longer prolongation or extension than seven years;(*z*) but in cases where it can be shown that the invention possesses such rare and exceptional merit that the patentee would not be likely to obtain an adequate reward in seven years, a longer period will be recommended,(*a*) which may in extreme cases be fourteen years, the longest period for which the Crown has power to grant a prolongation or extension.(*b*) The Judicial Committee, in recommending a prolongation or extension, always consider the merit of the invention from the point of view of the public as well as the remuneration which the patentee has received, and adjusts the period accordingly.(*c*) **Duration of new grant cannot exceed fourteen years.**

If the petitioner succeed, he must forthwith leave at the

(*t*) Johnson's and Atkinson's Patent, (1873) L. R. 5 P. C. 87; Church's Patents, (1886) 3 R. P. C. 95.

(*u*) Ledsam *v.* Russell, (1847) 1 H. L. Cas. 687.

(*x*) Whitehouse's Patent, (1830) 1 W. P. C. 473; Carp. P. C. 565; 2 Moo. P. C. 496.

(*y*) Goucher's Patent, (1865) 2 Moo. P. C. N. S. 532.

(*z*) Furness' Patent, (1885) 2 R. P. C. 175. Seven years was allowed in the following somewhat recent cases: Joy's Patent, (1893) 10 R. P. C. 89; Davies' Patent, (1893) 11 R. P. C. 27; Hazeland's Patent, (1894) 11 R. P. C. 467.

(*a*) Moncrieff's Patent, 22 Iron, 35; Mitchell's Patent, (1847) 30 Newton, L. J. C. S. 356; Darby's Patent, (1891) 8 R. P. C. 380; Currie and Timmiss' Patent, L. R. (1898) A. C. 347.

(*b*) Mitchell's Patent, (1847) 30 Newton, L. J. O. S. 356; 46 & 47 Vict. c. 57, s. 25, sub-s. 5.

(*c*) Newton's Patent, (1861) 14 Moo. P. C. 156; Bailey's Patent, (1884) 1 R. P. C. 1; Derosne's Patent, (1844) 2 W. P. C. 1; Carp. P. C. 699; 4 Moo. P.C. 417; Currie and Timmiss' Patent, L. R. (1898) A. C. 347.

Costs.

Patent Office a copy of the order for prolongation or extension when obtained, that it may be entered on the register of patents.(*d*)

Costs.

Costs are in the discretion of the Committee.

The costs of all parties of, and incident to, proceeding before the Judicial Committee are in its discretion.(*e*)

It is the practice of the Committee to award costs, on the principle that *bonâ fide* oppositions are rather to be encouraged than discouraged, that the Crown may be put in possession of all that can be alleged against the continuance of the patent.(*f*)

Costs of opponents will be refused, however, if the Committee are satisfied that there was no sufficient ground of opposition, and opponents may be ordered to pay costs occasioned by improper opposition,(*g*) and the opponent's costs will be refused if the Committee are of opinion that the opposition has been improperly conducted.(*h*)

In cases where the petition is abandoned, and there is opposition, the petitioner pays the opponent's costs.(*i*) It is not necessary for the opponent to serve the petitioner with notice of an intended application for costs.(*k*)

Sometimes one set of costs is given to each opponent,(*l*) and sometimes one set is given between all the opponents.(*m*)

In cases where there are more than one opponent it is not uncommon for the Committee to award a lump sum to be divided among the opponents, either with,(*n*) or without,(*o*) the option of taxation in the usual way by the Registrar of the Committee.(*p*)

The Attorney-General, who represents the Crown on the hearing of petitions, does not ask for, nor is he ordered to pay, any costs.

(*d*) R. R. 1890, r. 74.

(*e*) 46 & 47 Vict. c. 57, s. 25, sub-s. 7; as to taxation see p. 419 *ante*.

(*f*) Wield's Patent, (1871) L. R. 4 P. C. 89; 8 Moo. P. C. N. S. 300; Westrupp and Gibbin's Patent, (1836) 1 W. P. C. 556; Honiball's Patent, (1855) 9 Moo. P. C 378; 2 W. P. C. 201; 25 L. T. 1.

(*g*) Downton's Patent, (1839) 1 W. P. C. 567.

(*h*) Honiball's Patent, (1855) 9 Moo. P. C. 394; 2 W. P. C. 201; 25 L. T. 1.

(*i*) Bridson's Patent, (1852) 7 Moo. P. C. 499; Hornby's Patent, (1853) 7 Moo. P. C. 503; Milner's Patent, (1854) 9 Moo. P. C. 39; Mackintosh's Patent, (1837) 1 W. P. C. 739; Morgan Brown's Patent, (1886) 3 R. P. C. 212.

(*k*) Bridson's Patent, (1852) 7 Moo. P. C. 449.

(*l*) Nowton's Patent (2), Eng. Rep. Jan. to Mar. 1881.

(*m*) Newton's Patent (4), (1884) L. R. 9 App. Cas. 592; 52 L. T. 329; 1 R. P. C. 177.

(*n*) Milner's Patent, (1854) 9 Moo. P. C. 39; Hill's Patent, (1863) 1 Moo. P. C. N. S. 259; Wield's Patent, (1871) L. R. 4 P. C. 89.

(*o*) Schlumberger's Patent, (1853) 9 Moo. P. C. 1; Johnson's Patent, (1871) L. R. 4 P. C. 75, 8 Moo. P. C. N. S. 282; Jones' Patent, (1854) 9 Moo. P. C. 41; Hopkinson's Patent, (1896) 14 R. P. C. 10.

(*p*) Judicial Committee Rules, 1898, r. 6, p. 733 *post*.

CHAPTER XII.

ACTION TO RESTRAIN THREATS OF LEGAL PROCEEDINGS.

PART I.—GENERAL.

Sec. 32 of Act of 1883.

SEC. 32 of the Patents, Designs, and Trade Marks Act of 1883 enacts that:—

"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."

Sec. 32 creates a statutory right.

The principle embodied in this enactment seems to have been recognised by *Malins*, V.C., as early as 1871,(*a*) though the conclusion at which the learned Judge arrived—viz., that at that date the Court would restrain a patentee from issuing circulars threatening legal proceedings against alleged infringers unless he would undertake to commence proceedings to assert the validity of the patent—appears to have been based on the erroneous assumption that there is no presumption at law in favour of the validity of a patent which has not been declared void.(*b*) It was subsequently held by *Jessel*, M.R., and affirmed on appeal,(*c*) that no such principle at that date

(*a*) Rollins *v.* Hinks, (1872) L. R. 13 Eq. 355; Axman *v.* Land, (1874) L. R. 18 Eq. 330.

(*b*) Judgment of Jessel, M.R., Halsey *v.* Brotherhood, (1880) L. R. 15 Ch. D. 520, 523.

(*c*) Halsey *v.* Brotherhood, (1880) L. R. 15 Ch. D. 514; 19 Ch. D. 386; 49 L. J. Ch. 786; 51 L. J. Ch. 233.

General.

existed, and that a patentee was, in the absence of *mala fides*, justified in giving notice that his rights were being infringed without following up such notice by an action for the alleged infringement.

Slanderous statements made by patentee may be restrained apart from s. 32 of Act of 1883.

The Court has and always had power, by injunction, to restrain any person from making slanderous statements calculated to injure the business of another person, whether the statements complained of are oral or written,(*d*) and damages for the slander of title may be obtained upon proof of the absence of privilege and the existence of express malice on the part of the slanderer.(*e*)

Cases within either of the saving clauses of s. 32 of Act of 1883 are governed by the law in existence before the Act of 1883.

It is to be noticed that the foregoing section of the Act of 1883 does not apply to cases which are within either of the saving clauses—that is to say, to cases where the alleged manufacture, use, sale, or purchase to which the threats related are in fact an infringement of any legal rights of the person making such threats, and to cases where the threatening party with due diligence commences and prosecutes an action for the infringement of his patent.

Cases within either of the saving clauses of s. 32 of the Act of 1883 are still governed by the law as it existed prior to the Act.(*f*)

Statement of such law.

The law thus referred to as applicable to such cases was, and is, that a patentee was not liable for issuing circulars or other threats warning persons against using articles which he alleged were infringements of his patent, provided that he issued such notices *bonâ fide* and in the belief that the articles in question were really infringements.(*g*) Moreover, a patentee was not liable to be restrained by injunction from continuing to issue notices that the articles complained of were infringements, unless such statements were proved to be untrue, so that the further issue of them would not be *bonâ fide*, and would damnify the person threatened.(*h*)

Though the patentee was entitled to issue notices containing

(*d*) Loog *v.* Bean, (1884) L. R. 26 Ch. D. 306; Thomas *v.* Williams, (1880) L. R. 14 Ch. D. 864; Beddow *v.* Beddow (1878) L. R. 9 Ch. D. 89; Saxby *v.* Easterbrook, (1878) L. R. 3 C. P. D. 339; Thorley's Cattle Food Co. *v.* Massan, (1877) L. R. 6 Ch. D. 582; Riding *v.* Smith, (1877) L. R. 1 Ex. D. 91.

(*e*) *Ibid.*; Montgomerie *v.* Peterson, (1894) 11 R. P. C. 221, 633.

(*f*) Temler *v.* Stevenson, (1897) 15 R. P. C. 24.

(*g*) Wren *v.* Wield, (1869) L. R. 4 Q. B. 730; Halsey *v.* Brotherhood, (1880) L. R. 15 Ch. D. 514; L. R. 19 Ch. D. 386; Sharp *v.* Brauer, (1886) 3 R. P. C. 193; Skinner *v.* Shaw, (1893) L. R. 1 Ch. 413.

(*h*) Burnett *v.* Tate, (1883) 45 L. T. N. S. 743; Halsey *v.* Brotherhood, (1880) L. R. 15 Ch. D. 514; 19 Ch. D. 390; Sugg *v.* Bray, (1885) 2 R. P. C. 224; Dicks *v.* Brooks, (1880) L. R. 15 Ch. D. 40; 49 L. J. Ch. 812.

statements that articles being sold by others were infringements of his rights, if such statements were made with reasonable and probable cause,(*i*) an action would lie if the statements were not simply allegations of infringements, but went on to allege, as matters of fact, assertions which were not true. A question of infringement is one of law, and, in the words of *Bramwell*, L.J.,(*k*) "A man is not bound to be correct in his statement of the law, but he is bound to be correct in his statement of facts." General.

In some cases the patentee makes threats against persons making, using, selling, or purchasing articles which he considers to be infringements of his patent rights, as a means of protecting his own property; on the other hand, sometimes such threats are circulated maliciously, and *mala fide*, with the intention of injuring the trade of the person against whom they are made.

Before the Act of 1883, it was held that if a statement as to infringement was made by the patentee in defence of his own property, although it injured and was untrue, it was a privileged statement; it was a statement that the defendant had a right to make, unless, besides its untruth, and besides its injury, express malice was proved—that is to say, want of *bona fides* and the presence of *mala fides*.(*l*) In other words, if such a statement was made *bonâ fide*, though the party affected might be able to prove *damnum*, he could not at Common Law establish *injuria*, and consequently, it being merely a case of *damnum sine injuria*, he could not saddle the patentee with the commission of any tort.(*m*) It was also held that there was no obligation on the part of a person, who had issued notices stating that the acts of another were an infringement of his patent rights, to follow up such statements with an action for infringement against the person mentioned, for he might desist, and render such action unnecessary, or he might not be worth suing at all.(*n*)

If the plaintiff in an action to restrain the issue of threats of legal proceedings intends to rely on the old law and not on s. 32 of the Act of 1883, he should disclose his case as to Plaintiff intending to rely on the old law must disclose his case

(*i*) Per Baggalay, L.J.; Halsey *v.* Brotherhood, (1881) L. R. 19 Ch. D. 390.

(*k*) Dicks *v.* Brooks, (1880) L. R. 15 Ch. D. 22.

(*l*) Per Coleridge, L.C.J., Halsey *v.* Brotherhood, (1881) L. R. 19 Ch. D, 388; Sugg *v.* Bray, (1885) 2 R. P. C. 243; see also Skinner *v.* Shaw, (1893) L. R. 1 Ch. 413.

(*m*) Commercial Development Corporation, Ld. *v.* Castner-Kellner Alkali Co., (1897) 14 R. P. C. 939.

(*n*) Halsey *v.* Brotherhood, (1880) L. R. 15 Ch. D. 518.

General.

as to *mala fides*.

mala fides in his affidavits in support of his motion for an injunction.(*o*)

Law altered by Act of 1883.

The Act of 1883 has completely altered the law with regard to cases within s. 32 in favour of the public, for it provides that if a person claiming to be a patentee, by circulars, advertisements, or otherwise, threatens any other person with any legal proceedings or liability, in respect of any alleged manufacture, use, sale, or purchase of the invention, and does not with due diligence commence and prosecute an action for the infringement of his patent, he is liable to be sued by the person or persons who are aggrieved by such threats, and an injunction restraining the continuance thereof may be obtained, and damages awarded against him, if it turns out that the alleged manufacture, use, sale, or purchase was not, in fact, an infringement of any of his legal rights.(*p*)

Bona fides of the patentee immaterial when s. 32 of Act of 1883 applies.

If the case is within s. 32 and a person aggrieved brings an action against the patentee to restrain the issue of threats of legal proceedings, or liability in respect of any alleged manufacture, use, sale, or purchase of the invention, the question of the *bona fides* of the patentee does not affect the case one way or the other.(*q*) The only defence open to the patentee, if he has not at the date of the action with due diligence commenced and prosecuted an action for infringement of his patent, is to show that the allegations contained in the threatening notices were, in fact, true.(*r*) Thus an injunction was granted where the defendant refused to bring an action for infringement or to test the validity of his patent which was put in issue by the plaintiff.(*s*) The burden of proof that the patentee's statements are untrue lies, *primâ facie*, on the plaintiff,(*t*) as it did before the Act of 1883,(*u*) though he may easily rebut it in a particular case, and throw on the defendant the burden of proving them to be true.(*x*)

Equitable assignee, or a patentee who

A person who merely holds an agreement for an assignment of the patent upon terms does not possess legal rights of which

(*o*) English and American Machinery Co. *v.* Gare Machine Co., (1894) 11 R. P. C. 631. (*p*) p. 441 *ante*.

(*q*) Kurtz *v.* Spence, (1888) 5 R. P. C. 161; Herrburger *v.* Squire, (1888) 5 R. P. C. 581; Skinner *v.* Shew, (1893) L. R. 1 Ch. 413.

(*r*) Crampton *v.* Patents Investment Co., (1888) 5 R. P. C. 382; 6 R. P. C. 287; Automatic Weighing Machine Co. *v.* Combined Weighing and Measuring Machine Co., (1889) 6 R. P. C. 120.

(*s*) Willoughby *v.* Taylor, (1894) 11 R. P. C. 45.

(*t*) Challender *v.* Royle, (1887) L. R. 36 Ch. D. 435; 4 R. P. C. 363; Barney *v.* United Telephone Co., Ld., (1885) 2 R. P. C. 173.

(*u*) Burnett *v.* Tate, (1882) 45 L. T. N. S. 743; Anderson *v.* Liebig's Extract of Meat Co., (1881) 45 L. T. N. S. 757, 759.

(*x*) Challender *v.* Royle, (1887) L. R. 39 Ch. D. 435; 4 R. P. C. 363.

the acts referred to in a threat could be an infringement; (*y*) neither, it would appear, does a patentee who has obtained leave under s. 19 of the Act of 1883 in a pending action for infringement or a petition for revocation of the patent, for the fact of asking for leave to amend amounts to an admission that the patent is bad without amendment of the specification, and he is not, therefore, entitled to issue threatening notices till the amendment is actually made.(*z*) In such a case an injunction restraining the issue of the threats may be obtained upon motion in the pending proceeding.(*a*)

Person Aggrieved. What is a Threat?

has obtained leave to amend under s. 19 of Act of 1883, does not possess legal rights of which acts complained of in a threat could be an infringement.

Person aggrieved.—The right of action conferred by s. 32 of the Act of 1883 is given to "any person aggrieved." In founding the action, therefore, it is always necessary to consider whether the proposed plaintiff is really a person aggrieved. When threats are made against the customers of the person who supplies or agrees to supply the articles in respect of which the threats are made that person is a person aggrieved and may bring the action.(*b*) Also if the threats are made against the plaintiff's licensee the plaintiff is a person aggrieved.(*c*)

Who is a person aggrieved.

It would appear doubtful whether the section applies in the case of threats made by a licensee or other person having only a limited interest in the patent. It must be remembered that a mere licensee cannot sue alone for an infringement of the patent, and it is doubtful whether an exclusive licensee can do so,(*d*) because the term "patentee" as used in the Act means the person for the time being entitled to the benefit of the patent,(*e*) and it is doubtful whether this term would be held to include an exclusive licensee.(*f*) If an exclusive licensee cannot justify an action for the infringement of the patent, he cannot avail himself of the proviso, and it is submitted, therefore, in such case the section could not be held to apply.

What is a Threat?—In considering the question what are threats within the meaning of s. 32 of the Act of 1883, it is well to bear clearly in mind what the evil was which the enactment of the section was intended to guard against.

The evil which s. 32 of the Act of 1883 was intended to guard against.

(*y*) Kensington and Knightsbridge Electric Lighting Co. *v.* Lane Fox Electrical Co., (1891) 8 R. P. C. 277.

(*z*) Fusee Vesta Co. *v.* Bryant and May (2), (1887) 4 R. P. C. 191.

(*a*) *Ibid.*

(*b*) Kensington and Knightsbridge Electric Lighting Co. *v.* Lane Fox Electrical Co., (1891) 8 R. P. C. 277; Colley *v.* Hart, (1898) L. R. 44 Ch. D. 179; 7 R. P. C. 101; Skinner *v.* Shew, (1893) L. R. 1 Ch. 413; 62 L. J. Ch. 196; 10 R. P. C. 1.

(*c*) Kensington and Knightsbridge Electric Lighting Co. *v.* Lane Fox Electrical Co., (1891) 8 R. P. C. 277.

(*d*) p. 374 *ante*.

(*e*) 46 & 47 Vict. c. 57, s. 46.

(*f*) Barnett *v.* Barrett's Screw Stopper Bottling Co., (1884) 1 R. P. C. 9.

What is a Threat?

Before the section became law, a person aggrieved by the issue of threats of legal proceedings, or liability, at the instance of a person claiming to be the patentee of an invention in respect of which the threats were made, could only obtain the injunction of the Court restraining such threats and damages in respect of them, if he was able to discharge the *onus* which was upon him of proving that the threats were issued *mala fide* and without reasonable excuse. This *onus* of proof, which was upon the party aggrieved, almost nullified the remedy by injunction because of the extreme difficulty of proving that the patentee had put forward his assertion of patent rights maliciously and without just cause or excuse. The threat of a patent action is well calculated to paralyse the business of persons aggrieved, and in the words of *Bowen*, L.J.,(*g*) "the Legislature desires that threats of patent actions shall not hang over a man's head—that the sword of Damocles, in such a case, should either not be suspended or should fall at once, and it is with that view that the section seems to be framed." The object of the Legislature, therefore, was to prevent persons claiming to be patentees from issuing *any* kind of threat the result of which might be to paralyse a man in his trade by having an action on a patent suspended before his eyes without the opportunity of determining the suspense at once and bringing the question to a speedy and immediate issue.(*h*)

Effect of the words "or otherwise" as used in s. 32 of the Act of 1883.

Upon this view of the evil which the section was designed to guard against, the Court of Appeal have held that the words "*or otherwise*," as used in the section, are not to be construed *ejusdem generis* with "*circulars*" and "*advertisements*," but that, on the contrary, the words "*circulars*" and "*advertisements*" enlarge the meaning of the words "*or otherwise*" so as to include within the section all threats of whatsoever kind made in respect of any alleged manufacture, use, sale, or purchase of an invention by a person claiming to be the patentee thereof.(*i*)

Nature of threats which have been held to be within s. 32 of the Act of 1883.

Threats within s. 32 may, as above stated, be made by circular, advertisement, or otherwise. It has been held that a threat contained in a solicitor's letter,(*k*) in a private letter,(*l*)

(*g*) Skinner *v.* Shew, [1893] 1 Ch. 425.
(*h*) *Ibid.*
(*i*) Skinner *v.* Shew, [1893] 1 Ch. 413.
(*k*) Duffield *v.* Waterloo, (1886) 3 R. P. C. 46; L. R. 31 Ch. D. 638; Crampton *v.* The Patents Investment Co., (1888) 5 R. P. C. 393; The Combined Weighing and Advertising Machine Co. *v.* The Automatic Weighing Machine Co., (1889) 6 R. P. C. 502; Edlin *v.* Pneumatic Tyre and Brooks Cycle Agency, (1893) 10 R. P. C 312.
(*l*) Walker *v.* Clarke, (1887) 4 R. P. C. 113; Burt *v.* Morgan, 4 R. P. C. 278.

What is a Threat?

and in a letter written without prejudice,(*m*) or in answer to an inquiry as to whether the patentee considered a certain article an infringement of his patent,(*n*) are actionable. Further, a statement made by the patentee, or on his behalf, though it does not contain any direct reference to the patent, may nevertheless amount to a threat within the section. Thus, where the defendant wrote to probable customers of the plaintiff that they must not be surprised if he, the defendant, applied for an injunction against the plaintiff to restrain him from selling the articles in question, the Court held that such statement amounted to a threat in respect of the patent, and granted an injunction in the terms of the section.(*o*) It is submitted that the Court has power under this section to restrain oral statements which contain threats of legal proceedings against, or liability on the part of, persons aggrieved by allegations made by the patentee to the effect that they have infringed his patent.(*p*)

Continuation of threats by a person within the proviso of s. 32 of Act of 1883 pending action.

The question may arise as to how far a person who has issued threats within the meaning of s. 32 of the Act of 1883, and brought himself within the proviso by, with due diligence, commencing and prosecuting an action for infringement, is justified in continuing the threats whilst the action is pending. In this connection there is the authority of *Kekewich*, J., in *Fenner* v. *Wilson*,(*q*) for the proposition that, quite apart from s. 32 of the Act of 1883, a plaintiff in a pending action for infringement may, on motion in the action, be restrained from issuing advertisements warning the public that they are liable in damages for using the subject-matter of the plaintiff's patent, if such advertisements amount to statements that the pending action must succeed. The injunction is granted on the ground that the issue of such advertisements may prejudice the defendant, and so be an interference with the even course of justice;(*r*) and in such a case the order ought not to contain any undertaking as to damages, since, though subject to appeal, it is not obtained on interlocutary proceedings in the true sense.(*s*) The Court of Appeal, without expressing any opinion on the proposition of law above formulated, stated that

(*m*) Kurtz *v.* Spence, (1888) 5 R.P.C. 173.

(*n*) Skinner *v.* Shew, [1893] 1 Ch. 413.

(*o*) Douglass *v.* Pintsch's Patent Lighting Co., (1896) 13 R. P. C. 673.

(*p*) Kurtz *v.* Spence, (1888) 5 R. P. C. 161, 172, 173.

(*q*) (1893) 10 R. P. C. 283; see also Goulard *v.* Lindsay, (1887) 4 R. P. C. 189.

(*r*) Fenner *v.* Wilson, (1893) 10 R. P. C. 283; Goulard *v.* Lindsay, (1887) 4 R. P. C. 189.

(*s*) Fenner *v.* Wilson, (1893) 10 R. P. C. 287.

What is a Threat?

they could not consider the advertisements in *Fenner* v. *Wilson*, the particular case in question, as amounting to contempt of Court.(*t*)

Bonâ fide notice by plaintiff to customers of defendant in an infringement action.

The plaintiff in a pending action for infringement is entitled to give *bonâ fide* notice to the defendant's customers that, by dealing in the goods supplied by the defendant, they expose themselves to the risk of actions by the plaintiff, and that in the event of the plaintiff succeeding against them in such actions they are liable to pay damages and costs and to have their goods which were so purchased destroyed by order of the Court.(*u*)

Question whether threat to be actionable under s. 32 of Act of 1883 must relate only to an act done, or whether it may relate to something proposed to be done.

The question whether a threat, to be actionable under s. 32 of the Act of 1883, must be not merely a warning about something that is going to be done, but must be a threat about an act done—*i.e.*, whether it must be a threat of legal proceedings in respect of an alleged actual manufacture, use, sale, or purchase of the invention, and not in respect of a proposed manufacture, use, sale, or purchase, cannot be said to have been, as yet, definitely decided by the Courts. There are expressions in the judgments delivered by the Court of Appeal, especially in that of *Bowen*, L.J., in *Challender* v. *Royle*,(*x*) which, if read apart from the particular case, support the view that a threat in respect of a proposed manufacture, use, sale, or purchase, would not be a "threat" within the meaning of the section; but in the later case of *Johnson* v. *Edge*,(*y*) the Court of Appeal without deciding the point, which was not necessary to the decision of that case, expressed grave doubts as to whether upon the true construction of the section it does exclude intended infringements which have not actually taken place, and as to whether the language used by *Bowen*, L.J., in the judgment above referred to is to be taken to mean that, in all cases, such intended infringements are so excluded. It is submitted that the first part of the section should be construed as correlative with the proviso; and that consequently all threats of legal proceedings or liability in respect of any alleged past or future manufacture, use, sale, or purchase of an invention issued by or on behalf of a person claiming to be the patentee

(*t*) Fenner *v.* Wilson, (1893) 10 R. P. C. 287.

(*u*) Incandescent Gas Light Co. *v.* Sunlight Incandescent Gas Lamp Co., (1897) 14 R. P. C. 180; see also Dunlop Pneumatic Tyre Co. *v.* New Seddon Pneumatic Tyre and Self-closing Tube Co., (1897) 14 R. P. C. 332; Nähmaschinen Fabrik *v.* Singer Manufacturing Co., (1893) 10 R. P. C. 310.

(*x*) (1887) L. R. 36 Ch. D. 425.

(*y*) (1892) 9 R. P. C. 142; see also judgment of Kekewich, J. in Kurtz *v.* Spence, (1888) 5 R. P. C. 171; and of Day, J. in Willoughby *v.* Taylor, (1894) 11 R. P. C. 52.

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of such invention, are threats within the section if the person claiming to be a patentee is in a position when the threats are issued to found an action for the infringement of his patent upon the past or future Acts referred to therein. A patentee may found an action upon a threatened infringement, even though no actual infringement has taken place.(z) And, it is submitted, s. 32 must be interpreted as including any threat made by the patentee in respect of any alleged intended infringement when the person threatened has actually done something which the patentee is justified in construing as an expression of an intention to infringe.

General warning to infringers issued by a patentee.

S. 32 of the Act of 1883, according to this view of its construction, does not in any way limit the right of every patentee to issue a general warning to infringers, and to advise the public that the patent to which he is entitled, and under which he claims, is one which he intends to enforce.(a) It must, however, be remembered that what at first sight appears to be a justifiable general warning may, in view of the peculiar circumstances of a particular case, well be construed as a threat directed against a particular individual, and so actionable under the section.(b)

In the event of a patentee obtaining an injunction and damages against a manufacturer, he is entitled to warn purchasers from the manufacturer not to pay the purchase-money to him, and that, if the manufacturer fails to pay the damages, he (the plaintiff) will claim from the purchasers.(c)

Use of a thing *simpliciter* as distinguished from use in a particular manner.

If the use *simpliciter* of a certain apparatus does not amount to an infringement of the patent, but the use of that apparatus in a particular manner does amount to such an infringement, the patentee cannot escape liability for issuing threats to the users of such apparatus, unless he makes it perfectly clear that what he complains of is not the use *simpliciter*, but the use in the particular manner specified.(d)

Threat not withdrawn.

A threat which is not withdrawn is considered as continuing.(e)

The Proviso.—S. 32 of the Act of 1883 provides that the remedy created by the section shall not be applicable, if the person making the threats complained of, with due

(z) See pp. 504, 516 *post*.
(a) Johnson *v.* Edge, (1892) 9 R. P. C. 142; Challender *v.* Royle, (1887) 2 R. 36 Ch. D. 428.
(b) Johnson *v.* Edge, (1892) 9 R. P. C. 142, 148.
(c) Cropper *v.* Smith, (1883) L. R. 24 Ch. D. 305, 312.
(d) Burt *v.* Morgan, (1887) 4 R. P. C. 278.
(e) Driffield *v.* Waterloo, (1886) L. R. 31 Ch. D. 638, 643.

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diligence, commences and prosecutes an action for infringement of his patent.

Nature of infringement action which will secure the benefit of the proviso.

The question naturally arises, By whom and against whom and when must such an action be commenced and prosecuted, so as to bring the case within the proviso?

The proviso will not be satisfied unless the action for infringement is brought by the person making the threats—*e.g.*, an action brought by the equitable or legal assignee of the defendant to the threats action will not do.(*f*) Also the proviso will not be satisfied unless the action for infringement is in respect of the patent to which the threats relate, but, if several patents relate to the same general subject-matter, it is not necessary that the patentee bring the action in respect of all such patents.(*g*)

It is not always possible for the defendant to a threats action to bring an action for the infringement of his patent against the person aggrieved by the threats. For instance, the patentee of a rival machine would necessarily be a person aggrieved if threats were made against him; but if such person does not manufacture and sell, but only licenses the manufacture and sale of such rival machine, there would be no means of bringing an action for infringement against him.

It would appear that what the words of the proviso point at is a case where some act has been done which can be tested whether or not it is an infringement. The words, "if the alleged manufacture, use, sale, or purchase to which the threats related was not in fact an infringement of any legal rights of the person making such threats," clearly point to an act done or contemplated which has been alleged to be, but as a matter of fact is not, an infringement of the patent of the person issuing the threat, and the mere fact that, where the owner of a rival patent is the aggrieved person, it is in many cases impossible that an action for infringement should be brought against him, precludes the notion that the action mentioned in the proviso must be confined to an action against the aggrieved party.(*h*) On the contrary, the proper view seems to be that the proviso will be satisfied if an action for infringement of the patent be honestly brought and diligently prosecuted against any person to whom the threats complained of are applicable;(*i*)

(*f*) Kensington and Knightsbridge Electric Lighting Co. *v.* Lane Fox Electrical Co., (1891) 8 R. P. C. 277.

(*g*) Temler *v.* Stevenson, (1897) 15 R. P. C. 24.

(*h*) See p. 445 *ante*.

(*i*) Challender *v.* Royle, (1887) L. R. 36 Ch. D. 425; 4 R. P. C. 363; Day *v.* Foster, 7 R. P. C. 54.

but an action commenced against a third party in respect of infringements totally different to those alleged against the plaintiff to the threat action is not an action for infringement within the meaning of s. 32.(*k*) The Proviso

If the action for infringement be brought, not against the party aggrieved, but against a third party, and if that action be not prosecuted with due diligence, or, if it be collusive, then, no doubt, the person claiming an injunction to restrain threats would be entitled to contend that the case was within the section, and that such an infringement action did not bring it within the proviso.(*l*) Thus, in a case where the defendant had commenced an action for infringement against the plaintiff, and undertook to prosecute it with due diligence, the Court refused an injunction to restrain the issue of a threatening circular, which, however, was granted subsequently, on the ground that the defendants were not, as a matter of fact, prosecuting their infringement action diligently.(*m*)

An action against licensees for royalties in respect of articles which the defendant alleges were manufactured under another patent and not under the licence is an action for infringement within the meaning of s. 32 of the Act of 1883.(*n*)

In considering the question whether an action for infringement has been commenced and prosecuted with due diligence, so as to bring the case within the proviso of s. 32, it must be noticed that the section is silent on the point whether it is necessary that the action for infringement must be commenced before or after the action for threats. It has been held that, if a threatened action for infringement be commenced and prosecuted with due diligence, there is no ground upon which an action under s. 32 can be commenced at all.(*o*) Due diligence.

Moreover, an action for infringement commenced before the issue of the threats complained of is sufficient to bring the case within the proviso of s. 32, if the alleged infringements are the same as those forming the subject of the threats, and it is not necessary that the action for infringement should be one in which the issue of validity can be contested.(*p*)

In forming a conclusion as to whether an action for infringement has been commenced with due diligence after the issue of

(*k*) The Combined Weighing and Advertising Machine Co. *v.* The Automatic Weighing Machine Co., (1889) 6 R. P. C. 502; L. R. 42 Ch. D. 665; 58 L. J. Ch. 709.

(*l*) Challender *v.* Royle, (1887) L. R. 36 Ch. D. 425, 439; 4 R. P. C. 363.

(*m*) Household *v.* Fairburn, (1884) 1 R. P. C. 109; 2 R. P. C. 142.

(*n*) Day *v.* Foster, (1890) 7 R. P. C. 54.

(*o*) *Ibid.* 54, 60.

(*p*) *Ibid.* 54.

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threats, account must be taken of the time that has elapsed since the threats complained of were first issued and the infringement action was commenced, and not of the time since the defendant first became aware that the plaintiff was doing the acts which are alleged in the threatening notices to be an infringement of the defendant's right.(*q*)

There is no rule as to the length of time within which a patentee must bring an infringement action in order to escape liability in respect of threatened proceedings.(*r*) If delay in bringing the infringement action were caused by negotiations between the parties, it would no doubt be held that the conditions of the proviso were satisfied.(*s*) But where the defendants in a threat action did not commence an action for infringement till over two months after the threats complained of were issued, and then only issued writs against two persons, not the plaintiffs in the threat action, and subsequently entered a counterclaim in the threat action alleging infringement by the plaintiffs, they were held not to have commenced and prosecuted an action for infringement with due diligence.(*t*)

It has been held that an action commenced and subsequently discontinued by consent is not an action prosecuted with due diligence, so as to entitle a defendant in a threat action to exemption from liability;(*u*) though this decision would appear to be wrong in view of the fact that subsequent cases have decided that an action which is abandoned because the defendant gives in, and desists from the infringement, or because the plaintiff is advised that the action must fail, is an action for infringement prosecuted with due diligence.(*x*) Moreover, it cannot be contended that an action for infringement to come within the meaning of the proviso of s. 32 of the Act of 1883 must be prosecuted down to a successful result; on the contrary, the action may be within the proviso though it is discontinued, or judgment is against the plaintiff,(*y*) or it was

(*q*) Challender *v.* Royle, (1887) L.R. 36 Ch. D. 435, 437; 4 R. C. P. 363; Combined Weighing Machine Co. *v.* Automatic Weighing Machine Co., (1889) 6 R. P. C. 502.

(*r*) Colley *v.* Hart, (1890) 7 R. P. C. 101, 106.

(*s*) Edlin *v.* Pneumatic Tyre and Brooks Cycle Co., (1893) 10 R. P. C. 311.

(*t*) Herrburger *v.* Squire, (1888) 5 R. P. C. 581; 6 R. P. C. 194; but see Challender *v.* Royle, (1887) L. R. 36 Ch. D. 437.

(*u*) Crampton *v.* Patents Investments Co., (1888) 5 R. P. C. 382, 393; but see Colley *v.* Hart, (1890) 7 R.P.C. 101.

(*x*) Colley *v.* Hart, (1890) 7 R. P. C. 101, 108, 110; English and American Machinery Co. *v.* Gare Machinery Co., (1894) 11 R. P. C. 627.

(*y*) Colley *v.* Hart, (1890) 7 R. P. C. 101, 109, 110; English and American Machinery Co. *v.* Gare Machinery Co., (1894) 11 R. P. C. 627.

originally in respect of several patents and was dropped in respect of some of them.(z) Issues.

The fact that a patentee, who has commenced an action for infringement against a person subsequently claiming an injunction restraining the continuance of threats, has not applied for an interlocutory injunction, is not evidence that he has not prosecuted his action with due diligence.(a)

An action commenced to obtain an injunction to restrain the defendant from passing off his goods as and for the plaintiffs, and tardily after the issue of the writ in an action under s. 32 amended to an infringement action, is not commenced and prosecuted with due diligence.(b)

PART II.—PRACTICE.

Specimens of the pleadings in an action under s. 32 of the Act of 1883 will be found in the Appendix.(c) The action for breach of the statutory right created by s. 32 of the Act of 1883 lies against individuals, and also against a corporation.(d) Pleadings.

Issues.—In any action brought under s. 32 of the Act of 1883 to restrain threats of legal proceedings, not only the issue of infringement may be raised, but also that of the validity of the patent to which the threats relate;(e) and it is therefore open to the plaintiff to prove, in either of two ways, that he has not infringed any legal right of the defendant. Either he may say, "The patent is valid, but I have not infringed it;" or he may say, "The patent is invalid, and, therefore, I have not infringed any legal right of the person making the threats."(f) That is to say, in order to act on the above-mentioned section, the Court must be satisfied, at the hearing of the action, that the articles in respect of which the threats were made are not "an infringement of any legal rights of the person making such threats." The question, therefore, whether the patent of the person making the threats is a valid patent must come into consideration, if the plaintiff in Issues of infringement and also validity of the patent may be raised.

(z) Temler *v.* Stevenson, (1897) 15 R. P. C. 24.

(a) Anderson *v.* Liebig's Extract of Meat Co., (1881) 45 L. T. N. S. 757.

(b) Johnson *v.* Edge, (1892) 9 R. P. C. 142.

(c) p. 796 *post*.

(d) Combined Weighing Machine Co. *v.* Automatic Weighing Machine Co., (1889) L. R. 42 Ch. D. 669; Fusee Vesta Co. *v.* Bryant and May, (1887) 4 R. P. C. 194; Kensington and Knightsbridge Electric Lighting Co. *v.* Lane Fox Electrical Co., (1891) 8 R. P. C. 277; L. R. (1891) 2 Ch. 579.

(e) Challender *v.* Royle, (1887) L. R. 36 Ch. D. 425; 4 R. P. C. 363; Kurtz *v.* Spence, (1887) 4 R. P. C. 427; Herrburger *v.* Squire, (1888) 5 R. P. C. 589.

(f) Per Charles, J. Herrburger *v.* Squire, (1888) 5 R. P. C. 589.

Particulars.

the action seeks to have it considered, because, if the patent is invalid, there is no infringement of a legal right of the patentee.(*g*)

Practice in pleading.

It would appear to be the more correct course for the plaintiff not to plead the invalidity of the defendant's patent in the statement of claim, but to leave the defendant to raise the issue in the defence. The plaintiff is at liberty to deny the validity in the reply, and to deliver particulars of objections therewith, and such further pleadings as may be necessary are allowed.(*h*) It is, however, competent to the plaintiff, if he is so minded, to raise the issue of the validity of the patent by a denial in the statement of claim.(*i*)

The burden of proof of the fact of infringement is on the defendant.(*k*)

Particulars of breaches.

Particulars.—The defendant may be ordered to furnish particulars of breaches, pointing out how the acts complained of are infringements of his patent, and pointing out, by reference to pages and lines of the specification, which parts of the invention therein described he alleges have been infringed;(*l*) and the plaintiff, if he denies the validity of the defendant's patent, may be required to deliver to the defendant particulars of his objections.(*m*)

If the defendant is the owner of more than one patent, it is proper that he should deliver particulars of the patents on which he relies to support the threats before the plaintiff delivers his particulars, which may be confined to the patents mentioned in the defendant's list.(*n*)

If the plaintiff pleads non-infringement of any legal right of the defendant, and defendant, though not admitting the plea, does not allege infringement of any particular legal right, the plaintiff cannot claim particulars showing in what respect the defendant alleges the infringement of his legal rights, or in what respect he does not admit that the plaintiffs do not infringe the alleged legal rights of the defendant.(*o*)

Particulars of objections.

The defendant is entitled to particulars of objections before

(*g*) See judgment of Cotton, L.J., Challender *v.* Royle, (1887) L. R. 36 Ch. D. 435; 4 R. P. C. 363.

(*h*) Dowson *v.* Drosophore Co., (1895) 12 R. P. C. 95.

(*i*) Willoughby *v.* Taylor, (1894) 11 R. P. C. 47.

(*k*) Ungar *v.* Sugg, (1889) 6 R. P. C. 337.

(*l*) Wren *v.* Wield, (1869) L. R. 4 Q. B. 213; Union Electrical Power and Light Co. *v.* Electrical Power Storage Co., (1888) 5 R. P. C. 329; Law *v.* Ashworth, (1890) 7 R. P. C. 86.

(*m*) Union Electrical Power and Light Co. *v.* The Electrical Power Storage Co., (1888) 5 R. P. C. 329; Smith *v.* Laing, (1890) 7 R. P. C. 148.

(*n*) *Ibid.* Particulars of breaches and objections are discussed more fully at pp. 512, 527 *post*.

(*o*) Dowson Taylor *v.* Drosophore Co., (1894) 11 R. P. C. 653.

he delivers his defence if invalidity is pleaded in the statement of claim.(*p*)

Interlocutory Injunction.

When the plaintiff alleges that the threats were made by the defendant's agents, he may be compelled to give particulars of the names of such agents.(*q*)

Usual course where defendant brings an action for infringement.

Interlocutory Injunction.—In cases where the defendant brings an infringement action which satisfies the conditions of the proviso of s. 32 of the Act of 1883, it is the usual course for the Court, on motion by the plaintiff for an interlocutory injunction, to make no order except that the threats action be stayed until the trial of the infringement action or further order, and that the costs of the threats action be costs in the infringement action; and the defendant usually gives an undertaking to prosecute the infringement action diligently, and disclaims any intention of issuing new threats in the meantime.(*r*) In the event of the defendant not prosecuting the infringement action with due diligence, the plaintiff has thus an opportunity of moving again.(*s*)

Ex parte applications.

An injunction to restrain threats of legal proceedings or liability in respect of alleged infringement of a patent will not, as a rule, be given on an *ex parte* application, and there does not appear to be any reported case in which this has been done, though no doubt, under very special circumstances, the Court might do so, if the interests of justice would not be otherwise satisfied.

It is usual to allow short notice of motion to be given in the ordinary way:(*t*) but when threats are issued by an agent in this country at the instigation of a foreigner abroad, and the agent appears, though the foreign patentee has not been served, the practice is for the Court to grant an *ex parte* injunction against the foreigner, his servants, and agents. The order indicates that the agent defendant appears, and is directed in particular against him as agent. The plaintiff should give an undertaking to accept short service of notice to dissolve the injunction.(*u*)

Primâ facie case

In an action to restrain threats under s. 32 the Court

(*p*) Law *v.* Ashworth, (1890) 7 R. P. C. 86.

(*q*) Dowson Taylor *v.* Drosophore Co., (1894) 11 R. P. C. 536.

(*r*) Mackie *v.* Salvo Laundry Co., (1892) 9 R. P. C. 465; Edlin *v.* Pneumatic Tyre and Booth's Cycle Agency, (1893) 10 R. P. C. 316; English and American Machinery Co. *v.* Gare Machinery Co., (1894) 11 R. P. C. 628; Dowson Taylor *v.* Drosophore, (1895) 12 R. P. C. 95.

(*s*) *Ibid.*

(*t*) Wilson and Co. *v.* Walter E. Church Engineering Co. Ld., (1885) 2 R. P. C. 175.

(*u*) Overton *v.* Burns, (1896) 13 R. P. C. 455.

Interlocutory Injunction.

will not grant an interlocutory injunction unless it is satisfied that the plaintiff has made out a *primâ facie* case to the effect either that he has not infringed the defendant's patent or that the patent is void; and, unless there is such a *primâ facie* case, the Court does not take into consideration the balance of convenience to the parties.(*x*)

of non-infringement or invalidity is essential without which the Court does not consider the balance of convenience to the parties.

Cotton, L.J., commenting in the Court of Appeal on a decision(*y*) to the effect that the Court has power to grant an interlocutory injunction in a threat action, though it is not proved that the plaintiff has not infringed the defendant's patent, and also on the question whether an interlocutory injunction should be granted depends upon the balance of convenience to the parties, said:—(*z*)

> "It is very true that in all cases of interlocutory injunction the Court does consider, and ought to consider, the balance of convenience and inconvenience in granting or refusing the injunction. But there is another very material question to be considered: Has the plaintiff made out a *primâ facie* case? That is to say, if the evidence remains as it is, is it probable that at the hearing of the action he will get a decree in his favour? Therefore, although I quite agree that the Court ought not, on an interlocutory injunction, to attempt finally to decide the question whether the Act complained of is an infringement, or (if the question of the validity of the patent is raised) whether the patent is a valid one or not, yet in my opinion it ought to be satisfied that on one or both of those two points the plaintiff in the action has made out a *primâ facie* case, and unless the Court is so satisfied it would be wrong to grant an injunction, merely on the ground that it cannot do the defendant any harm. Injunctions ought to be granted only on a case made out entitling the plaintiff to that particular remedy."

If the Court is satisfied, on a motion for an interlocutory injunction, that the plaintiff had made out a *primâ facie* case of non-infringement, it will grant the interlocutory injunction restraining the defendant until the trial of the action from continuing to threaten any person with legal proceedings or liability in respect of the alleged manufacture, use, sale, or purchase of his invention.(*a*) On the other hand, where the Court

(*x*) Challender *v.* Royle, (1887) L. R. 36 Ch. D. 425; 4 R. P. C. 363; Société Anonyme des Manufactures de Glaces *v.* Tilghman's Patent Sand Blast Co., (1883) L. R. 25 Ch. D. 1; Barney *v.* United Telephone Co., (1885) L. R. 28 Ch. D. 394.

(*y*) Walker *v.* Clarke, (1887) 4 R. P. C. 111; Challender *v.* Royle, (1887) L. R. 36 Ch. D. 428; 4 R. P. C. 363.

(*z*) Challender *v.* Royle, (1887) L. R. 36 Ch. D. 436; 4 R. P. C. 363.

(*a*) Colley *v.* Hart, (1888) 6 R. 17.

is of opinion that the plaintiff, by his affidavits, fails to raise a probable case of non-infringement, and that there is a conflict of testimony on the question, an injunction will be refused.(*b*) The Court, in deciding whether the defendant has made out a *primâ facie* case of infringement, takes into consideration the fact whether or not he has commenced an action for infringement, and, if he has not done so, this fact is evidence against him.(*c*) Damages.

When there is a question as to whether the alleged threat is really a threat within the section which would be better decided at the trial, and the defendant denies any intention of making threats, this circumstance induces the Court to order the motion to stand to the trial, with liberty to the plaintiff to bring it on again in the interval upon two days' notice.(*d*) Other considerations on motion for interlocutory injunction.

Where (*e*) it appeared that the defendants were only exclusive licensees for a limited area of the patent referred to, and that the patentee had commenced an action for infringement against the plaintiff, in which the defendants were to be made co-plaintiffs, the Court ordered the motion for an injunction restraining the further issue of the circular to stand over till after the hearing of the infringement action.(*f*)

Another circumstance which may influence the Court to grant an interlocutory injunction is the probable incapacity of the defendant to satisfy the plaintiff's claim if ultimately defeated.(*g*)

Damages.—Damages are only awarded when the plaintiff shows that he has really suffered loss owing to the defendant's conduct.(*h*) Moreover, the defendant is only liable for damage directly caused by the threats. He is not liable for damage resulting from the mere rumour of legal disputes or legitimate general statements, or by threats unauthorised by him, though he may be liable in respect of a falling off in the plaintiff's general business traceable to the threats in respect of a particular article dealt in by the plaintiff.(*i*) Damages to be recoverable must result directly from the threat.

When it can be shown that the plaintiff has lost a contract

(*b*) Barney *v.* United Telephone Co., (1885) 2 R. P. C. 173.

(*c*) Colley *v.* Hart, (1889) 6 R. P. C. 17.

(*d*) Douglass *v.* Pintsch's Patent Lighting Co., (1895) 13 R. P. C. 60.

(*e*) Barnett *v.* Barrett's Screw Stopper Bottling Co., Ld., (1884) 1 R. P. C. 9.

(*f*) See also Combined Weighing and Advertising Machine Co. *v.* Automatic Weighing Machine Co., (1889) 6 R. P. C. 502.

(*g*) p. 551 *post*.

(*h*) Driffield *v.* Waterloo, (1886) L. R. 31 Ch. D. 638; 55 L. J. Ch. 391; 3 R. P. C. 46.

(*i*) Ungar *v.* Sugg, (1891) 8 R. P. C. 385; 9 R. P. C. 113, in which the principles on which damages for threats ought to be assessed are discussed.

Certificates.

in consequence of the threats the measure of damage is the loss of profit.(*k*)

If the Judge is able to assess the damages at the trial it is right that he should do so instead of sending the case to an inquiry.(*l*)

Can a certificate of validity be given in an action to restrain threats?

Certificate of Validity.—It is submitted that an action which is in the form of one to restrain the issue of threats under s. 32 of the Act of 1883, but in which the validity of the patent is put in issue and decided in favour of the patentee, is an "action for infringement" within the meaning of s. 31, and that the Court has, therefore, jurisdiction to give a certificate of validity under that section. The authorities, however, appear to be in conflict.(*m*) It is submitted that the object of the Legislature in framing s. 31 was to protect patentees, who have once established the validity of their patent in expensive litigation, from being unduly harassed by having the same question raised against them again by the parties to different proceedings; and that the section ought not to be so construed as to limit it to cases in which the action is one for infringement in the ordinary sense, and to exclude cases in which the action, though in substance one for infringement, is not so in mere form.

Is certificate as to particulars necessary on taxation?

Certificate as to Particulars.—It does not appear to have been definitely decided whether or not in order for a successful party in an action under s. 32, in which the questions of infringement and validity of the patents were in issue, to be entitled to the costs of his particulars, it is necessary for him to obtain the Judge's certificate under s. 29, sub-s. 6 of the Act of 1883, to the effect that such particulars delivered by him were proven or reasonable and proper.(*n*) It is submitted that an action under s. 32, in which the issues of infringement and validity of the defendant's patent are properly raised, whether or not the defendant counterclaims for damages, is in all but mere form an action for the infringement of the patent and that the term "action for infringement" as used in s. 29 should be construed as including such an action, with the result that the Court has jurisdiction to grant the certificate in a threats action and that

(*k*) Skinner *v.* Perry, (1894) 11 R. P. C. 406.

(*l*) Ungar *v.* Sugg, (1892) 9 R. P. C. 113; Herrberger *v.* Squire, (1887) 5 R. P. C. 596; 6 R. P. C. 194; Kurtz *v.* Spence, (1887) 5 R. P. C. 177; 57 L. J. Ch. 238.

(*m*) Kurtz *v.* Spence, (1885, 1888) 5 R. P. C. 184; Crampton *v.* The Patents Investment Co., (1888) 5 R. P. C. 404; Herrburger *v.* Squire, (1888) 5 R. P. C. 595.

(*n*) Willoughby *v.* Taylor, (1894) 11 R. P. C. 45.

on taxation no costs should be allowed in respect of any particular which has not been duly certified by the Court. It is to be observed that the submission is the other way in the case of a petition for the revocation of a patent, for s. 26 of the Act of 1883 is confined expressly to the practice in cases of revocation of a patent upon petition, whereas s. 28 refers to "an action or proceeding for infringement *or* revocation of a patent," and s. 29 commences "In an action for infringement of a patent," and makes no reference to proceeding for revocation upon petition. Ss. 26 and 29 contain analogous directions as to the delivery of particulars and confining the evidence to them, but s. 26 does not contain the clause which is in s. 29, having reference to the certificate.(*o*)

Costs.

Costs.—The general costs of an action to restrain threats are dealt with by the Courts under their ordinary jurisdiction.

Ordinary jurisdiction of the Court applies.

It is the duty of the defendant to a threat action who brings a cross-action for infringement to endeavour by arrangement to avoid causing unnecessary costs by trying the same action in two different forms.(*p*)

Where the plaintiff obtains judgment with costs the Master will, on taxation, tax in favour of the defendant any issues upon which he has been wholly successful,(*q*) but see above as to costs of particulars of breaches and objections.

(*o*) p. 399 *ante*.

(*p*) Combined Weighing Machine Co. *v.* Automatic Weighing Machine Co., (1889) 6 R. P. C. 367, 502; Colley *v.* Hart, (1890) 7 R. P. C. 101, 108, 189.

(*q*) Herrburger *v.* Squire, (1888) 5 R. P. C. 596; Longbottom *v.* Shaw, (1888) 5 R. P. C. 502.

CHAPTER XIII.

ACTION OF INFRINGEMENT.

General.

Former spirit of interpretation of letters patent.

It was not for two hundred years after the Statute of Monopolies became law that the popular prejudices against patent privileges disappeared, and Judges began to determine questions arising between patentees and the public in a fair and impartial spirit. Formerly the Courts were only too ready to seize on any slight defects to declare a patent null and void. They were, no doubt, actuated by the deep-seated prejudice which was extremely general in the public mind, and which was the direct outcome of the monstrous oppression practised by means of patent grants before the statute of James I.

Modern spirit of interpretation.

The Courts now recognise the principle laid down by Lord *Eldon*, L.C.,(*a*) that the patent may be considered as a bargain between the public (represented by the Crown) and the patentee, and the specification, therefore, must be construed on the same principle of good faith as that which regulates all other concontracts. Consequently, all questions which arise between patentees and the public are determined between the parties without any bias or strained construction put upon the law or patent in favour of either.

The privilege conferred by letters patent for an invention, which is created by the law, (*b*) would be of no practical use to the grantee if he did not possess legal remedies against persons found to have invaded it.

Remedies for infringement.

It is open to a patentee, whose exclusive privilege is being invaded, to bring an action for infringement against the offending party, and so vindicate his right by a prceeding in which, if he succeeds, he can obtain not only an injunction of the Court restraining a continuance of the wrongful acts, but also an account of profits made by the infringer, or damages against him, and the costs of the litigation, together with

(*a*) Cartwright *v.* Eamer, (1807) cited 14 Ves. 131, 136.
(*b*) Chap. viii. ; p. 344 *ante*.

destruction of the infringing article. A patentee is also entitled to sue in one and the same action for the recovery of royalties from a defendant alleged to be a licensee, or in the alternative for the usual relief consequent on infringement.(*c*) General.

A secret use by the patentee of an invention before the date of letters patent will not, at any rate if there has been no profit derived therefrom, invalidate the patent subsequently obtained.(*d*) The question suggests itself, Can a patentee who has obtained letters patent for an invention, by an injunction of the Court, prevent another man from continuing what before the date of the patent had been the secret use of the invention? It is submitted that he could not do so, for the patent would be invalid because the requirements of the sixth section of the Statute of Monopolies are not satisfied, in that it cannot be said that the invention was one which falls within the class "which others at the time of making such letters patent and grants shall not use."(*e*) The prior secret user would no doubt be required to establish a very strong case, for the Courts would be inclined to the conclusion that an alleged prior secret use was merely experimental and incomplete, in which case it would be no anticipation of the completed invention, the subject of the subsequent patent.(*f*) Secret use of an invention.

The man who uses an invention and keeps the method of performing it a secret really inflicts a hardship on the public, for, if he never discloses it, the public may have no further advantage of it beyond that which the secret user chooses to give. It is open to the secret user, if he be the true and first inventor, to obtain a patent and enjoy the exclusive privilege of using the invention during the term for which it is granted.(*g*)

If any person has *openly* practised an invention before the date of subsequent letters patent, he clearly cannot be prevented from continuing to do, after the patent, that which he did before it, since the patent is bad in law on the ground of lack of novelty.(*h*)

Beside the remedy of an action for infringement, patentees are entitled, in common with other persons, to bring an action against any one who sells goods manufactured by himself or another in such a manner as to induce the purchasing public to believe that such goods are manufactured by the patentee or his nominees, when, in fact, they have not been so manufactured. Sale of goods in fraud of a patentee.

(*c*) Wilson *v.* Union Oil Mills Co., (1892) 9 R. P. C. 57.
(*d*) pp. 110, 120 *ante*.
(*e*) p. 121 *ante*.
(*f*) p. 107 *ante*.
(*g*) pp. 110, 120 *ante*.
(*h*) p. 111 *ante*.

General.

It does not signify in what way the offender carries out his fraudulent purpose, whether by counterfeiting a name,(*i*) word,(*k*) mark, or device (*l*) upon the spurious articles themselves, or upon the wrappers in which they may be wrapped,(*m*) or by using any other means to deceive the public into purchasing goods as the goods of the patentee when they are really not so.(*n*)

A plaintiff who succeeds in showing that the defendant has sold goods in a manner calculated to make the public believe that they were, contrary to the actual fact, purchasing the manufacture of the plaintiff, is entitled to an injunction against the defendant, and also to an account or damages.(*o*) And it is no answer for the defendant to say that the spurious goods are equal in quality to those made by the plaintiff.(*p*)

Further, a person selling goods in a manner which induces the purchaser to believe that he is buying the goods of another is liable to an action, notwithstanding the fact that he in a sense makes no actual misrepresentation. Thus, in a case where it appeared that the plaintiff made and sold goods which he was accustomed to mark with the words "Sykes' patent," and the defendant (who was of the same name as the plaintiff) made and sold similar goods to the retailers which he also marked with the words "Sykes' patent," and the patent right had expired, the defendant was restrained by the injunction of the Court, on the ground that he was selling his goods as and for those manufactured by the plaintiff; and this notwithstanding the fact that he did not himself represent his goods to be of the plaintiff's manufacture.(*q*) A rule *nisi* for a new trial was refused by the Court of King's Bench.(*r*)

On the other hand, any person who becomes acquainted with the process of making an article which is merely a secret, and not the subject of a patent, is entitled to manufacture it; and, if the name of the first manufacturer has become descriptive of the article apart from its origin, any person is entitled to describe

(*i*) Ransome *v.* Bentall, (1834) 3 L. J. N. S. 161; Singer Manufacturing Co. *v.* Loog, (1880) L. R. 18 Ch. D. 395, 422.

(*k*) Knott *v.* Morgan, 2 Keen 213; Wotherspoon *v.* Currie, L. R. 5 E. & I. App. 508; Ford *v.* Foster, L. R. 7 Ch. App. 611; Siegert *v.* Findlater, L. R. 7 Ch. D. 801.

(*l*) *In re* Worthington, L. R. 14 Ch. D. 8; Orr Ewing *v.* Johnson, L. R. 13 Ch. D. 434; L. R. 7 App. Cas. 219: Seixo *v.* Provezende, L. R. 1 Ch. App. 192.

(*m*) Blofield *v.* Payne, 4 B. & A. 410; Blackwell *v.* Crabb, 36 L. J. Ch. 504; Upmann *v.* Elkan, L. R. 12 Eq. 140; L. R. 7 Ch. App. 130.

(*n*) See Graham, Designs and Trade Marks, pp. 87–110, and cases there collected.

(*o*) See *post*.

(*p*) Blofield *v.* Payne, 4 B. & A. 410.

(*q*) Sykes *v.* Sykes, 3 B. & C. 541; *cf.* Turton *v.* Turton, (1889) L. R. 42 Ch. D. 128.

(*r*) 3 L. J. N. S. 161.

it by such name, provided he does not so use the name as to lead the public to believe that they are buying goods made by such original manufacturer.(*s*) Infringement.

A person is liable to be sued in one and the same action both for the infringement of a patent or in the alternative for passing off his goods as and for those of the plaintiff.(*t*) Patentee may sue in one action in respect of infringement and passing off.

The public are secured against the injurious effects of illegal patents by the following remedies which exist for their protection :— Security of public against illegal patents.

First: Any member of the public against whom proceedings are taken by the patentee is entitled to show that the patent in question is void,(*u*) and so defeat the action, for there can be no infringement of an invalid patent; and, unless the patent has all the elements of validity in itself, it cannot be made the means of complaint by reason of an alleged infringement.(*x*)

Secondly: Any person entitled as of right so to do, or authorised by the Attorney-General in England or Ireland, or the Lord Advocate in Scotland, may obtain the revocation of an illegal patent on petition to the Court.(*y*)

Thirdly: Every patent contains a proviso to the effect that it shall forthwith determine and be void to all intents and purposes, if at any time during the term for which it is granted it be made to appear to the Queen, her heirs, or successors, or any six or more of her Privy Council, that the grant is contrary to law, or prejudicial or inconvenient to the subjects in general, or that the invention is not a new invention as to the public use and exercise thereof within the United Kingdom of Great Britain and Ireland, or the Isle of Man, or that the patentee is not the first and true inventor thereof.(*z*)

INFRINGEMENT.

A person invades the exclusive rights of a patentee and commits an infringement when, without the licence of the owner for the time being of the patent, he directly or indirectly uses the art or invention which is the subject of the patent, and applies it in any way for his own profit or benefit, otherwise than for the purpose of *bonâ fide* experiment. Definition of infringement.

There is no infringement unless that which is protected by

(*s*) Massam *v.* J. W. Thorley's Cattle Food Co., L. R. 6 Ch. D. 574; 14 Ch. D. 748.

(*t*) Lees *v.* West London Cycle Works, (1892) 9 R. P. C. 300.

(*u*) But see p. 522 *post.*

(*x*) Dudgeon *v.* Thomson, (1877) L. R. 3 App. Cas. 37.

(*y*) p. 391 *ante.*

(*z*) p. 742 *post.*

Infringement.

the patent—*i.e.*, that which is claimed—is taken without the leave and licence of the patentee.(*a*)

Thus in a recent case it was held that a claim for a process for stiffening incandescent gas mantles, which was limited upon its proper construction to the use of suitable materials which set by cooling, was not infringed by the use of other suitable materials which set by evaporation.(*b*)

Patentee may fix the ambit of his claim.

Sometimes it is open to a patentee to claim more than he actually does claim, *e.g.*, he may be in a position to claim both a process and a result, but he prefers to limit his claim to the one or the other and not to make it wide enough to include both. There are obvious dangers in making too wide a claim and there are obvious disadvantages in making it narrower than the patentee is obliged to do, having regard to the validity of the patent.(*c*)

It must also be remembered that what is not embraced by the claim is to be considered as disclaimed, and, consequently, open to all the world.(*d*)

Also, if a patentee in his specification points away from the use of a certain thing, he cannot complain of its adoption by an alleged infringer.(*e*)

No infringement of the equity of a patent.

Formerly there used to be an idea that it was possible to infringe upon the equity of a statute. If it were not possible to show that the words of the statute had been infringed, it was contended that the equity had been invaded; and, similarly, by a confusion of ideas a notion was prevalent that there might be an infringement of the equity of a patent. There is, however, no sound principle of this kind in the patent law; that which is protected is that which is specified, and that which is held to be an infringement must be an infringement of that which is specified, though it may not be the less an infringement because it has been coloured or disguised by additions or subtractions, which additions or subtractions may exist, and yet the thing protected may be taken notwithstanding.(*f*)

(*a*) See p. 467 *post*.

(*b*) Sunlight Incandescent GasLamp Co. *v.* Incandescent Gas Light Co., (1897) 14 R. P. C. 757.

(*c*) Lancashire Explosives Co. *v.* Roburite Explosives Co., (1897) 14 R. P. C. 311–312.

(*d*) Harrison *v.* Anderston Foundry Co., (1876) L. R. 1 App. Cas. 581; United Telephone Co. *v.* Harrison, (1882) L. R. 21 Ch. D. 741; Jackson *v.* Wolstenholmes, (1884) 1 R. P. C. 108; Lucas *v.* Miller, (1885) 2 R. P. C. 159; Easterbrook *v.* G. W. Ry. Co., (1885) 2 R. P. C. 208; Ticket Punch Register Co. *v.* Colley's Patents, (1896) 12 R. P. C. 171.

(*e*) Nobel's Explosives Co. *v.* Anderson, (1895) 12 R. P. C. 164; Morris *v.* Young (1895) 12 R. P. C. 466.

(*f*) Dudgeon *v.* Thomson, (1874) 30 L. T. N. S. 244; L. R. 3 App. Cas. 34, judgment of Cairns, L.C. See also per Smith, L.J., Ticket Punch Register Co. *v.* Colley's Patents, (1895) 12 R. P. C. 185; Lancashire Explosives Co. *v.* Roburite Explosives Co., (1889) 14 R. P. C. 311, 312.

Infringement.

Intention and its effect.

It is not material to consider the intention of a person who commits an infringement of a patent ;(*g*) evidence of intention may be material for the consideration of the jury, but if the invention be in point of fact adopted or imitated, whether in ignorance or with intention, an infringement is committed.(*h*) An infringer is liable for what he does, not for what he intends ;(*i*) and there may be an indirect infringement, as well as a direct one, though the intention of the party be perfectly innocent,(*k*) and even though he may not know of the existence of the patent itself,(*l*) or that the thing he was dealing with was an infringement.(*m*) Neither is it a sufficient answer to a motion to commit, for breach of an injunction, to say that the defendant did not intend to infringe ;(*n*) nor is ignorance a valid defence.(*o*)

Evidence of intention may be of some value to a jury in dealing with the question whether an infringement has taken place or not ;(*p*) and also the Court takes it into account when deciding whether to grant or refuse an injunction,(*q*) and how to deal with the cost of the action.(*r*)

Jessel, M.R., in a case of infringement of copyright, laid it down that where a plaintiff comes to enforce a legal right, and there has been no misconduct on his part, nor omission or neglect which would induce the Court to deprive him of his costs, the Court has no discretion, and cannot take away the plaintiff's right to costs.(*s*)

On the other hand, where the defendant was a retail dealer who unwittingly sold articles which were an infringement of

(*g*) McCormick *v.* Gray, (1861) 7 H. & N. 25, 39; 31 L. J. Ex. 42; Heath *v.* Unwin, 15 Sm. 552; Stead *v.* Anderson, 2 W. P. C. (1847) 156; 4 C. B. 834; Seed *v.* Higgins (1858) 5 Jur. N. S. 540; 8 E. & B. 771; Young *v.* Rosenthal, (1884) 1 R. P. C. 29, 39.

(*h*) 2 W. P. C. 227 n.

(*i*) Stead *v.* Anderson, (1847) 2 W. P. C. 156; 4 C. B. 834: Newall *v.* Elliott, (1864) 10 Jur. N. S. 954; Nobel's Explosives Co. *v.* Jones, (1882) L. R 8 App. Cas. 12, 13.

(*k*) United Telephone Co. *v.* London, &c., Telephone Co., (1884) 1 R. P. C. 117; L. R. 26 Ch. D. 766; Adair *v.* Young, (1879) L. R. 12 Ch. D. 13.

(*l*) Heath *v.* Unwin, (1854) 2 W. P. C. 228, 315; 5 H. L. C. 505; Wright *v.* Hitchcock, (1870) L. R. 5 Ex. 37; Davenport *v.* Rylands, (1865) L. R. 1 Eq. 302; Young *v.* Rosenthal, (1884) 1 R. P. C. 39.

(*m*) Walton *v.* Lavator, (1860) 8 C. B. N. S. 162; Wright *v.* Hitchcock. (1870) L. R. 5 Ex. 37: Geary *v.* Norton (1846) 1 De G. & S. 9: Davenport *v.* Rylands, (1865) L. R. 1 Eq. 302.

(*n*) Plimpton *v.* Spiller, (1877) L. R. 4 Ch. D. 286, 288.

(*o*) Upmann *v.* Forrester, (1883) L. R. 24 Ch. D. 231; Wittman *v.* Oppenheim, (1884) L. R. 27 Ch. D. 260; Wright *v.* Hitchcock, (1870) L. R. 5 Ex. 37; Davenport *v.* Rylands, (1865) L. R. 1 Eq. 302; Walton *v.* Lavater, (1860) 8 C. B. N. S. 162; Geary *v.* Norton, (1846) 1 De G. & S. 9: Young *v.* Morris, (1894) 11 R. P. C. 617.

(*p*) Heath *v.* Unwin, (1845) 2 W. P. C. 227, n.; see above.

(*q*) p. 594 *post*.

(*r*) p. 613 *post*.

(*s*) Cooper *v.* Whittingham, (1880) L. R. 15 Ch. D. 501; see also Upmann *v.* Forrester, (1883) L. R. 24 Ch. D. 231.

Infringement.

the plaintiff's patent, *James*, V.C., held that he was not liable for the costs of an action to restrain the infringement, if he at once gave full information as to the persons from whom he obtained the articles complained of, and promised not to retail any more.(*t*) And, adopting the same principle, Lord *Hatherley*, in a trade-mark case, held that forwarding agents and warehousemen who had received boxes of cigars bearing forged brands, but were unaware of the forgery, and gave all information in their power immediately on being informed thereof, were not liable to the costs of an action brought to restrain the sale of such cigars.(*u*)

Act done under subsequent patent is an infringement of a prior patent for the same invention.

When there is more than one patent for the same invention, anything done under one of those of subsequent date is an infringement of that which bears the earliest date;(*x*) and if an invention is shown to be new and useful, the fact that it is much more useful with a subsequent improvement affords no ground for infringing the original invention by using it with the subsequent improvement;(*y*) neither can the infringer escape liability on the plea that the later patent was unsuccessfully opposed before the Comptroller by the plaintiff in the action. The proceedings before the Comptroller are irrelevant and immaterial to the action.(*z*)

Necessity for a determination of the exact invention protected.

In determining whether an act complained of is really an infringement of a patent or not, it is always most important to ascertain from the specifications what is the exact invention protected. If this invention is taken by the defendant, an infringement is committed, and it will not save the defendant from the consequences that, though he has taken the invention, he has dressed it up colourably, added something to it, or taken something away from it, provided that of the whole it can be said that the machine or process is either the plaintiff's or differs from it only colourably.(*a*)

(*t*) Betts *v.* Wilmott, (1870) 18 W. R. 946; Nunn *v.* D'Abuquerque, (1865) 34 Beav. 595; see also Jenkins *v.* Hope, (1895) 13 R. P. C. 57.

(*u*) Upmann *v.* Elkan, (1871) L. R. 7 Ch. App. Cas. 130.

(*x*) Saxby *v.* Hennett, (1873) L. R. 8 Ex. 210.

(*y*) Thomson *v.* Batty, (1889) 6 R. P. C. 84, 100.

(*z*) Ticket Punch Register Co. *v.* Colley's Patents, (1893) 12 R. P. C. 1, 15.

(*a*) Dudgeon *v.* Thomson, (1877) L. R. 3 App. Cas. 34; Minter *v.* Wells, (1834) 1 W. P. C. 134; Stevens *v.* Keating (1847) 2 W. P. C. 181; Muntz *v.* Foster (1843) 2 W. P. C. 95; Walton *v.* Potter, (1841) 1 W. P. C. 585; Gamble *v.* Kurtz, (1846) 3 C. B. 425; Trotman *v.* Wood, (1864) 16 C. B. N. S. 479; Hayward *v.* Pavement Light Co., (1884) 1 R. P. C. 207; Nordenfelt *v.* Gardner, (1884) 1 R. P. C. 61; Walker *v.* Hydrocarbon Syndicate, (1885) 2 R. P. C. 8; Sugg *v.* Bray, (1885) 2 R. P. C. 233; United Telephone Co. *v.* St. George, (1886) 3 R. P. C. 321; Richardson *v.* Castrey, (1887) 4 R. P. C. 265; Ellington *v.* Clark, (1888) 5 R. P. C. 135, 319; Wenham *v.* May, (1887)

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Objection to the use of the word "colourable" or "colourably."

The use of the word "colourable" or "colourably" in reference to an infringement is highly inappropriate, and apt to lead to great confusion, as connoting the idea that a patent may be infringed though the invention is not identically or substantially copied, if it is forgotten that the real question always is, Has the property of the patentee been taken?(*b*) The identity of the invention may be disguised, but there is no infringement unless what the infringer does is to take identically and substantially the patentee's invention. So a patent may be infringed by a colourable imitation, though there would be no infringement in the use of a mechanical or chemical equivalent.(*c*)

Right way to consider the question of infringement.

The proper way to consider the question of infringement is to assume that the plaintiff's patent is valid, and to construe it in the proper way, and then to see whether the defendant has taken a substantial part of the invention claimed without any regard to what anybody else had done before. The matter should be considered just as if the plaintiff's was the only patent and the only user prior to the defendant's.(*d*) The question of infringement is really a mixed one of law and fact.(*e*) It is the duty of the Court to construe the specification and claims together,(*f*) and thus to ascertain what is the nature of the invention protected by the patent; and this question must be determined by the Court independently of a jury, expert, or other witness. This is a rule which is often lost sight of by counsel in examining witnesses.(*g*) Expert evidence may, however, be relied on to explain technical terms, to show the practical working of machinery described or drawn, to point out what is old and what is new in the specification, and to show the particulars in which an alleged invention has been used by an alleged infringer, and the real importance of any differences between the plaintiff's invention and the alleged infringement,(*h*) as also the relative importance of the different

4 R. P. C. 303; Procter *v.* Bennis, (1887) 4 R. P. C. 333; Ehrlich *v.* Ihlee, (1888) 5 R. P. C. 198, 437; Garrard *v.* Edge, (1889) 6 R. P. C. 372, 563; Boyd *v.* Horrocks, (1889) 6 R. P. C. 152, 528; Automatic Weighing Machine Co. *v.* Combined Weighing Machine Co., (1889) 6 R. P. C. 121, 367; Shaw *v.* Jones, (1889) 6 R. P. C. 328; Winby *v.* Manchester, &c., Steam Tramways Co., (1889) 6 R. P. C. 359, 365; 7 R. P. C. 30.

(*b*) *Ibid.*

(*c*) Tweedale *v.* Howard and Bullough, (1896) 13 R. P. C. 536: in conjunction with Tweedale *v.* Ashworth, (1892) 9 R. P. C. 121; also Scott *v.* Hull Steam Fishing Co., (1897) 14 R. P. C. 143; in conjunction with Scott *v.* Hamling, (1897) 14 R. P. C. 12; also p. 481 *post.*

(*d*) Per Lord Esher, M.R., Lyon *v.* Goddard, (1893) 10 R. P. C. 341.

(*e*) p. 237 *ante;* Seed *v.* Higgins, (1860) 8 H. L. C. 565; Curtis *v.* Platt, (1866) 35 L. J. Ch. 852.

(*f*) p. 247 *ante.*

(*g*) *Ibid.* Brooks *v.* Steel, (1896) 14 R. P. C. 47: pp. 570, 578 *post.*

(*h*) *Ibid.*; Brooks *v.* Steel, (1896) 14 R. P. C. 47.

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parts of the invention, in order to ascertain whether the substance has been appropriated.(*i*) It is the duty of the Court to construe the specification quite apart from what the defendant has done. The first canon of construction is that the specification must be construed, like all other written instruments or business documents, as if the Court had to construe it the day after it was published; and the Court is bound to construe the specification as if it had to be construed before the defendant was born, if the patent was before that time.(*k*)

Importance of ascertaining the principle of the invention protected.

In this connection it is always most important to consider what is the principle of the invention.(*l*) The reader must observe that the word "principle," when thus used, is not intended to signify any of those first principles or laws of nature which cannot be the subject of a valid patent,(*m*) but is intended to mean a practical application of one or more of those first principles which is properly denominated an art by means of which articles of commerce may be manufactured; and an art of this description is that which must necessarily be the subject of every valid patent.(*n*) Thus, in the case of *Watt's* steam-engine, *Watt* invented the art of making a steam-engine with a condenser separate from the cylinder, and in common parlance it is said that the principle of that invention is the construction of a steam-engine so that the steam shall be condensed in a vessel separate from the cylinder. Whenever it can be shown that any act done without the sanction of the patentee comes, in this sense of the word, within the principle of the invention, the act is an infringement of the patent, for it necessarily implies that the art invented by the patentee has been used contrary to the prohibition in the grant. The law intends a patent to reward the patentee for his invention by means of the profit to be derived from the exercise of the sole privilege granted by the patent; and if other parties could evade the patent privilege by making some mechanical variation from the mode of applying the invention, or the articles to be produced by means of it, as described in the specification, the object of the patent would be frustrated, for no one would pay the patentee a profit for the patented article, if he could obtain an article substantially the same at a cheaper rate.(*o*)

(*i*) Clark *v.* Adie, (1873) L. R. 10 Ch. 667; L. R. 2 App. Cas. 315; Incandescent Gas Light Co. *v.* De Mare Incandescent Gas Light System, (1896) 13 R. P. C. 302; pp. 470, 471, 570 *post*.

(*k*) Nobel's Explosives Co. *v.* Anderson, (1894) 11 R. P. C. 523, judgment of Esher, M.R.

(*l*) Thomson *v.* Moore, (1889) 6 R. P. C. 426, 450.

(*m*) p. 37 *ante*.

(*n*) p. 21 *ante*.

(*o*) Hindmarch on Patents, pp. 493, 494; Thomson *v.* Moore, (1889) 6 R. P. C. 426, 450.

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Adoption of the principle of the invention protected, though details differ, is an infringement.

Thus, when a principle in the above sense is invented and the infringer takes the principle and alters the details, and yet it is obvious that he has taken the idea which has been the subject-matter of the invention, and has simply altered the details so as to avoid the possibility of its being suggested that he has taken the same thing, the Court can look through the mere variation of details and see that the substance and pith of the invention has been pirated, and consequently can protect the inventor.(*p*) In another class of cases, although a certain principle is common to a variety of manufactures, the subject-matter of the patent is really the particular mechanical mode by which that common principle is carried into effect,(*q*) and such patents are only infringed when the particular mechanical mode which is the subject-matter of the patent is copied.

Crossley v. *Beverley* (*r*) may be given as an example of the point under discussion. In that case it appeared that the patentee had obtained a patent for an improved gas apparatus, and the infringement complained of was a close imitation of the patented machine, the principles applied in the plaintiff's machine and in the defendant's being the same. The plaintiff accordingly obtained a verdict.

Baron *Alderson*, in a subsequent case, commenting on *Crossley* v. *Beverley*, said: "There never was a more instructive case than that. I remember very well the argument put by the Lord Chief Baron, who led the case for the plaintiff, and succeeded. There never were two things to the eye more different than the plaintiff's invention and what the defendant had done in contravention of his patent right. The plaintiff's invention was different in form—different in construction; it agreed with it only in one thing, and that was, by moving in the water, a certain point was made to open, either before or after, so as to shut up another, and the gas was made to pass through this opening; passing through it, it was made to revolve. The scientific men, all of them, said the moment a practical scientific man has got that principle in his head he can multiply without end the forms in which that principle can be made to operate." (*s*)

In short, if the pith and marrow—*i.e.*, substance—of the

(*p*) Tweedale *v.* Ashworth, (1892) 9 R. P. C. 126; Moor *v.* Thomson, (1890) 7 R. P. C. 325; Badischen Anilin und Soda Fabrik *v.* Levinstein, 24 Ch. D. 170; Sellers *v.* Dickinson, (1850) 5 Ex. R. 312, 324, in which cases the infringement was quite outside the specification, but not the invention.

(*q*) Per Halsbury, L.C., Tweedale *v.* Ashworth, (1892) 9 R. P. C. 126; Curtis *v.* Platt, (1863) L. R. 3 Ch. D. 135 n.

(*r*) (1829) 1 W. P. C. 106.

(*s*) Jupe *v.* Pratt, (1837) 1 W. P. C. 146.

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patentee's invention be taken, an infringement is committed, and such a taking is none the less actionable because the infringer has added something to the invention which constitutes an improvement.(*t*)

It rarely happens that an infringer takes the identical thing described and claimed by the patentee. He usually modifies it or dresses it up with some additional matters. Nevertheless, if he has taken the substance or pith and marrow of the patentee's invention he is guilty of an actionable infringement,(*u*) and this notwithstanding the fact that everything done by the patentee since the date of the patent may be an improvement upon it. The question is whether the defendant has taken the substance or pith and marrow of the plaintiff's invention as claimed in his specification; and this invention may be infringed although the defendant uses it in conjunction with an improvement which is not within the ambit of the patentee's claim.(*x*)

Relative importance of parts is a question to be settled by evidence.

The relative importance of the different parts of the patentee's combination or process is a question to be settled by evidence.(*y*) The fact, if such be the case, that the patentee in the specification attaches an undue importance to the use of something, handicaps him, no doubt, in a contest as to infringement, but has no further weight, and the Court is free to exercise its own judgment in weighing this fact with others when dealing with the question of infringement.(*z*)

(*t*) Erlich *v.* Ihlee, (1888) 5 R. P. C. 437; Hayward *v.* Hamilton, (1881) Griff. P. C. 115, 124; Proctor *v.* Bennis, (1887) L. R. 36 Ch. D. 740, 756; Cannington *v.* Nuttall, (1871) L. R. 5 E. & I. App. 205; 40 L. L. J. Ch. 739; Neilson *v.* Harford, (1841) 1 W. P. C. 310; Russell *v.* Ledsam, (1847) 14 M. & W. 579; Bateman *v.* Gray, (1853) Macr. P. C. 102; Saxby *v.* Clunes, 43 L. J. Ex. 228–241; Thorn *v.* Worthing Skating Rink Co., (1877) L. R. 6 Ch. D. 415; Plimpton *v.* Spiller, (1875) L. R. 4 Ch. D. 286; Curtis *v.* Platt, (1863) L. R. 3 Ch. D. 135 n.; 35 L. J. Ch. 852; Spencer *v.* Ancoats, &c., Co., (1889) 6 R. P. C. 46; Thompson *v.* Batty, (1889) 6 R. P. C. 84; Thompson *v.* Moore, (1889) 6 R. P. C. 428; 7 R. P. C. 325; Wilson *v.* Barbour, (1888) 5 R. P. C. 245, 675; Nordenfelt *v.* Gardner, 1 R. P. C. 61; Automatic Weighing Machine Co.'s cases; Boyd *v.* Horrocks, 5 R. P. C. 557; 6 R. P. C. 152; 9 R. P. C. 77; Montgomerie *v.* Paterson, 11 R. P. C. 221, 633; Wenham Gas Co. *v.* Champion Gas Lamp Co., 8 R. P. C. 373; 9 R. P. C. 49; Actien Gesellschaft für Cartonnagen Industrie *v.* Schrœder, 13 R. P. C. 466; Dudgeon *v.* Thomson, (1877) L. R. 3 App. Cas. 34; Incandescent Gas Light Co. *v.* De Mare Incandescent Gas Light System, (1896) 13 R. P. C. 301, 559: Proctor *v.* Bennis, (1877) L. R. 36 Ch. D. 740; Clark *v.* Adie, (1873) L. R. 10 Ch. 667; 2 App. Cas. 315; North British Rubber Co. *v.* Macintosh, (1894) 11 R. P. C. 477; North British Rubber Co. *v.* Gornully and Jeffery Manufacturing Co., (1896) 13 R. P. C. 691; 14 R. P. C. 283; 15 R. P. C. 245; Lane *v.* Herold, (1892) 9 R. P. C. 447; English and American Machinery Co. *v.* Union Boot and Shoe Co., (1894) 11 R. P. C. 137, 367.

(*u*) *Ibid.*

(*x*) Dudgeon *v.* Thomson, (1877) L. R. 3 App. Cas. 34.

(*y*) p. 471 *post.*

(*z*) Incandescent Gas Light Co. *v.* De Mare Incandescent Gas Light System, (1896) 13 R. P. C. 331; judgment of Wills, J.

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Though a claim to the details of a process may mention *nominatim* the use of a specific thing, it may be none the less infringed by the adoption in the process specified of a manufacturing equivalent for the specific thing mentioned, when such specific thing is not of the essence of the invention—*e.g.*, the substitution of a depositing tank for the centrifugal separating machine mentioned in the claim for the patented process for the manufacture of lanolin.(*a*)

With regard to the true way in which to determine what is important and what is of subsidiary consequence in reference to the patentee's invention, the following passage from the judgment of *Wills*, J., in the recent case of *Incandescent Gas Light and Coke Co.* v. *De Mare Incandescent Gas Light System*(*b*) may be quoted with great advantage as dealing with some of the older cases on the subject:—

> "It is contended by the defendants that what is important and what is of subsidiary consequence can only be gathered from the specification itself. I am satisfied that that neither is, nor can be, the law. Certainly *Dudgeon* v. *Thomson*, (1877) L. R. 3 App. Cas. 34, which is cited as an authority to that effect, says nothing of the kind. 'Additions and subtractions,' says Lord *Cairns*, 'may exist, and yet the thing protected by the specification may be taken notwithstanding.' There are no means of ascertaining whether, notwithstanding additions or subtractions, the invention has been taken except by seeing what they are worth as compared with the things which have been taken bodily from the invention. In the case of a patent for a combination, or for a series of operations, the specification very often contains no clue to the inventor's own view of the relative importance of the different elements in the combination. If he says nothing on the subject you must conclude that, as far as the specification goes, they are all presented as of equal importance, and all as essential parts of the combined whole, and yet there may be infringement notwithstanding 'slight variations.' (*c*) 'So again,' says *Cotton*, L.J.,(*d*) 'omissions and additions may be very material in considering whether, in fact, the machine of the defendant is an infringement of the combination which the plaintiff claims.' Omissions and additions may even be improvements, but that fact 'does not enable you,' says *Bowen*, L.J., 'to take the substance of the plaintiff's patent.' (*e*) 'If the instrument patented,' says Lord *Cairns*, 'consists of

(*a*) Benno Jaffé und Darmstadter Lanolin Fabrik v. Richardson, (1893) 11 R. P. C. 93, 261. (*b*) (1896) 13 R. P. C. 330.
(*c*) Cotton, L.J. in Proctor *v.* Bennis, (1887) L. R. 36 Ch. D. 740-754.
(*d*) *Ibid.* p. 756. (*e*) Proctor *v.* Bennis, (1887) L. R. 36 Ch. D. 756.

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twelve different steps producing in the result the improved clipper, an infringer who had taken eight, nine, or ten of those steps might be held by the tribunal judging of the patent to have taken the substance, the pith and marrow of the invention, although there are one, two, three, four, five steps which might not actually have been taken.' (*f*) In such a case, as far as the specification went, the patentee would, under ordinary circumstances, treat the whole of the twelve steps as essential parts of his combination, and, so far as the specification went, there would be nothing to indicate that any one of them was not indispensable or was of less importance than the others. In *Procter* v. *Bennis* there was nothing to indicate that the patentee thought the parts of his combination omitted or varied by the defendant of anything but cardinal importance. How was the question suggested by *Cotton*, L.J., whether the variations were 'slight' to be ascertained, except by evidence as to the relative importance of the variations in question as compared with the patented combination as a whole? 'There is, or may be, says *James*, L.J., and *Mellish*, L.J., 'an essence or substance of the invention underlying the mere accident of form: and that invention, like every other invention, may be pirated by a theft in a disguised or mutilated form, and it will be in every case a question of fact whether the alleged piracy is the same in substance and effect, or is a substantially new or different combination.' (*g*) Drop the word 'combination,' which is perfectly immaterial as regards the principle, and every word is applicable to the present case. Mr. *Bousfield* says I am not entitled to take this as an accurate statement of the law, as the case went to the House of Lords, and no such doctrine is, as he contends, enunciated by the Law Lords. This, however, is a mistake. Lord *Cairns* expressly says: 'I am quite satisfied with the judgment of the learned Lords Justices, and I should have been content to rest the decision of this case upon that judgment, but for its importance.'" (*h*)

Substance and principle of the invention is always the important question.

In each case the substance of the invention and the principle of the machine and not the mere form are to be looked to. If what the defendant does is in principle not the same but really different there is no infringement; (*i*) and the question always is, not whether the substantial part of the process or combination said to be an infringement has been taken from the patentee's specification, but the very different one, whether

(*f*) Clark *v.* Adie, (1873) L. R. 2 App. Cas. 315–320.

(*g*) Clark *v.* Adie, (1873) L. R. 10 Ch. App. 667–675.

(*h*) (1877) L. R. 2 App. Cas. 326.

(*i*) Morgan *v.* Seaward, (1836) 1 W. P. C. 171.

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what is done or proposed to be done takes from the patentee the substance of his invention as claimed. "A process might be wholly gathered from a specification and nowhere else, and yet be no infringement if it did not take substantially the thing invented. What the thing invented is must be gathered from the specification alone, and the patentee cannot escape from the thing he has claimed as the standard, and the only standard, with which to compare the alleged infringement so as to see if it constitutes substantially the appropriation of the thing claimed."(*k*)

Though it may be lawful to take the pith and marrow in one sense of a patented invention, it is never lawful to take its substance without licence.

Thus a person may be entitled to take the pith and marrow in one sense of the patentee's invention; (*l*) what he is not entitled to do is to take its substance. The term "pith and marrow" used by Lord *Cairns* and many Judges since is, as *Wills*, J., has pointed out, not so good a one to use as "substance of the invention," for it is very easy to misapply it, and it would be very likely to mislead a jury. To quote *Wills*, J., again: "'Pith' is a great deal less than the substance of the vegetable structure of which it is part, and 'marrow' is a great deal less than the substance of the animal structure of which it is part. Metaphors are very apt to mislead, as they are seldom close enough to the things to which they are applied." (*m*)

The "pith and marrow" of the *Welsbach* process of gas illumination is the construction of a mantle or skeleton of materials which will incandesce when subjected to the heat of a flame, but the "substance" of the invention *claimed* in the *Welsbach* specification is moulding the illuminant into shape by a certain chemical process of reduction from salts, with the necessary consequence that the skeleton is homogeneous throughout. It has been held that it is no infringement of this claim to produce a mantle which will incandesce, by a process consisting in first forming a mantle of alumina and zinconia homogeneous throughout and strong, but giving little incandescence, and secondly, coating this with a thin layer of oxide of chromium, which incandesces well. In such a structure the illuminant is not (as in the *Welsbach* process) that portion of a homogeneous mantle which is exposed to the flame, but a foreign substance laid on in a thin film and quite absent from the bulk of the substance. Though this is an appropriation of the pith and

(*k*) Per Wills, J., Incandescent Gas Light Co. *v.* De Mare Incandescent Gas Light System, (1896) 13 R. P. C. 330.

(*l*) Incandescent Gas Light Co. *v.* Sunlight Incandescent Gas Lamp Co., (1896) 13 R. P. C. 345; Lancashire Explosives Co. *v.* Roburite Explosives Co., (1897) 14 R. P. C. 303.

(*m*) Per Wills, J., Incandescent Gas Light Co. *v.* De Mare Incandescent Gas Light System, (1896) 13 R. P. C. 332.

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marrow of the *Welsbach* invention, it is not such a taking of the substance of it as will constitute an infringement of the claim. The patentee did not and could not claim the formation of a skeleton by other means and of other substances than those pointed out in the specification, or by means substantially identical and apart from the contemporaneous formation of the illuminants, and so the Court was reluctantly compelled to hold that there was no infringement.(*n*)

On the other hand, it has been held that to vary by omission and alteration the non-essential details of the chemical process claimed in the *Welsbach* specification, but at the same time to produce an illuminant which is homogeneous throughout, though in a form of a fringe of threads instead of a mantle as described in the specification, is to take the substance of the *Welsbach* invention and so to commit an infringement.(*o*)

Again, in an action brought for the infringement of *Bartlett's* patent for "improvements in tyres or rims for cycles and other vehicles," (*p*) *Romer*, J., held that the essence of *Bartlett's* invention was the combination of an outside flexible tyre that can be easily removed, because it is not itself a complete tube, and of an inside complete tube capable of inflation, so that when the inside tube is inflated the flexible tyre is kept on to the grooved metal rim of the wheel by the pressure of the sides of the flexible tyre against the groove. The patentee in his specification pointed out that by thickening the sides or edges of the flexible tyre the grip could be increased; and obviously the more the grip was increased the more difficult it would be for the inside complete tube, if made elastic, to force the flexible tyre out of the narrow mouth of the grooved metal rim. The defendants took the patentee's idea and the essence or substance of his invention. All they did in substance, by way of alteration, was to increase the size of the outside flexible tyre and the thickening of its edges, and to exaggerate the dovetailing of the metal grooved rim, so as to give a greater grip, and to render it more difficult for the flexible tyre to be forced out of the mouth of the groove, and thus they were enabled to employ for the inflatable inside tube a more elastic tube than that mentioned in the body of the specification. The Judge held that the defendant's tyre might be an improvement upon the plaintiff's, but still, in substance, it was the plaintiff's and an

(*n*) Incandescent Gas Light Co. *v.* Sunlight Incandescent Lamp Co., (1896) 13 R. P. C. 333, 345.

(*o*) Incandescent Gas Light Co. *v.* De Mare Incandescent Gas Light System, (1896) 13 R. P. C. 301, 559.

(*p*) North British Rubber Co. *v.* Macintosh, (1894) 11 R. P. C. 477.

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infringement of the patent. Other points incidental to the structure of the different parts of the combination used by the defendants were urged as differentiating it from the plaintiff's, but unsuccessfully, in face of the finding of the Court that the essence or substance of the plaintiff's invention was present in the defendant's combination.(*q*)

So also a patent for a chemical mixture or compound suitable for a beetle poison was held to be infringed by the addition of non-material ingredients to the material ingredients specified by the patentee.(*r*) And in a case where the defendants took what was the merit of the plaintiff's improved sewing machine—*i.e.*, using a looper in such a way and with such a variety of machinery as to present the thread at a sufficient tension to the notch of the needle, though they introduced a portion of an alleged anticipating but useless machine, which was not necessary to the plaintiff's mechanism, they were held to have infringed.(*s*)

Criterion of novelty and infringement are not the same.

An arrangement, though it be an infringement of a prior patent, may be such as would itself support a patent on the ground of novelty. The criterion of novelty and infringement in this respect are not the same. This point was stated by *Pollock*, C.B., in *Newton* v. *Grand Junction Railway Co.*(*t*) Thus :—

> "It was agreed that the same criterion is to be applied to the question of infringement as to that of novelty. But that is not so. In order to ascertain the novelty, you take the entire invention, and if in all its parts combined together it answer the purpose by the introduction of any new matter, by any new combination, or by a new application, it is a novelty entitled to a patent. But in considering the question of infringement, all that is to be looked at is, whether the defendant has pirated a part of that to which the patent applies; and if he has used that part for the purposes for which the patentee adapted his invention and for which he has taken out his patent, and the jury are of opinion that the difference is merely colourable, it is an infringement." (*u*)

(*q*) See also North British Rubber Co. *v.* Gormully and Jeffery Manufacturing Co., (1896) 13 R. P. C. 691; 14 R. P. C. 283; 15 R. P. C. 245; Pneumatic Tyre Co. *v.* Tubeless Tyre, (1897) 15 R. P. C. 74, 236; White *v.* Bertrams, (1897) 14 R. P. C. 501, 735; and as to the true construction of the claims of the Welch patent for bicycle tyres and what was and what was not held to be an infringement see the following cases: Pneumatic Tyre Co. *v.* Caswell, (1896) 13 R. P. C. 164, 375; Pneumatic Tyre Co. *v.* East London Rubber Co., (1897) 14 R. P. C. 77, 573; Pneumatic Tyre Co. *v.* Ixion Patent Pneumatic Tyre Co., (1897) 14 R.P.C. 853.

(*r*) Lane *v.* Herold, (1892) 9 R. P. C. 447.

(*s*) English and American Machinery Co. *v.* Union Boot and Shoe Co., (1894) 11 R. P. C. 137, 367.

(*t*) (1846) Ex. R. 334; 20 L. J. Ex. 427 n.

(*u*) See p. 467 *ante*.

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Combination may be infringed by an unlawful taking of its substance.

In further pursuance of the principle under discussion, viz., that there is no infringement unless the substance of the invention claimed is pirated by the alleged infringer, the following remarks of Lord *Cairns*, L.C., and Lord *Esher*, M.R., made in reference to patents for combinations, may be usefully quoted :—

Lord *Cairns* in *Clark* v. *Adie*, (1877) L. R. 2 App. Cas. 320, speaking in the House of Lords on the different possible modes of infringing a patent for a horse-clipper which consisted of a combination of several parts, said : "One mode of infringement would be a very simple and clear one : the infringer would take the whole instrument from beginning to end, and would produce a clipper made in every respect like the clipper described in the specification. About an infringement of that kind no question could arise. The second mode would be one which might occasion more difficulty. The infringer might not take the whole of the instrument here described, but he might take a certain number of parts of the instrument here described ; he might make an instrument which in many respects might resemble the patent instrument, but would not resemble it in all its parts. And then the question would be, either for a Judge or for any tribunal which was judging of the facts of the case, whether that which was done by the alleged infringer amounted to a colourable departure from the instrument patented, and whether in what he had done he had not really taken and adopted the substance of the instrument patented. But there is a third way in which it is possible to conceive an infringement of a patent of the kind to which I have referred. Inside the whole invention there may be that which itself is a minor invention, and which does not extend to the whole, but forms only a subordinate part or integer of the whole. Now, again, that subordinate integer may be a step, or a number of steps in the whole, which is or are perfectly new, or the subordinate integer may not consist of new steps, but may consist of a certain number of steps so arranged as to form a novel combination within the meaning which is attached by the patent law to the term "combination." Suppose that in a patent you have a patentee claiming protection for an invention consisting of parts which I will designate as A, B, C, and D ; he may at the same time claim that as to one of those parts, D, it is itself a new thing, and that as to another of those parts, C, it is itself a combination of things which were possibly old in themselves, but which, put together and used as he puts together and uses them, produce a result so new that he is entitled to protection for it as a new invention. In a patent of that kind

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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."

Lord *Esher*, M.R., speaking on the same question, in reference to the patent for the *Nordenfelt* gun in *Nordenfelt* v. *Gardner* (1884), 1 R. P. C. 61, 65, said: "That seems to me to claim the feeding apparatus as a combination, and to claim the combination, 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 these alters the combination. If the alteration, whether it be by addition, or subtraction, or substitution, be merely colourable, then the two machines are substantially the same; although not mathematically exactly the same, they are substantially the same, and in any case, notwithstanding such colourable alteration, there may be an infringement. An alteration by addition may be an improvement, but then that will leave the whole of the original combination, and add something to it. If such an alteration of the combination be made, it seems to me that no good patent can be made with regard to the new machine, except by claiming the invention as an improvement, and by showing distinctly what the addition is, so as to show what the improvement is. An alteration by subtraction, if it were more than a colourable subtraction, would, as it seems to me, alter the combination. It would not be a combination of the same things; it would be a combination of different things, and, if the combination were altered by a material subtraction, I should think that it was a new combination. But an alteration by substitution, that is by substitution of one of the material elements of the original combination, must to my mind be a new combination. The second combination, then, is a combination of different things from the first. There is a taking away of one of the elements, and a material element of the old combination, and the putting in of a

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new material element which is different from any of the elements of the former. Somebody tried to express these things by A, B, and C; but if the original combination is of A, B, and C, and you take away C, and make a combination of A, B, and D, it seems to me as clear as possible that the new combination is a different combination from the old."

Thus, the substitution of a weighted valve for a water valve or column in a combination forming a milking machine was held to be an infringement.(*x*) Also the substitution of a pump, though contrived with great ingenuity, for a bellows in a smoke-testing and fumigating apparatus.(*y*) Again, a patent for an improved carriage lamp, in which the candle tube was prevented from falling out by means of a flat sliding bolt which engaged with a knob on the tube being pushed home by the coachman's hand, or simply by shutting the door of the lamp, and kept in its place by contact with the door when shut, was infringed by a sliding bolt with spring engaging with a collar on the tube and kept in position by the shut door of the lamp.(*z*)

But if the defendant's combination is really a different one to the plaintiff's there is no infringement.(*a*)

Special claims for subsidiary parts of a combination.

It has been explained (*b*) that in the case of a patent for a combination of several parts a claim may be made to the combination as a whole, and also to any one or more of the several parts separately, or in combination as a minor invention. The question whether the use of one or more of the component parts of a combination is an infringement or not, depends upon whether or not the parts are claimed separately, or whether taken together they are claimed as a subsidiary combination. It is not possible to say in the abstract whether the use of two parts, A and B, of a combination consisting of A, B, and C, is or is not using part of the invention; nor can it be decided in the abstract whether or not the specification shows that A or B is claimed separately or whether they are claimed together as a separate subordinate combination within the larger combination consisting of A, B and C.(*c*)

A patent for a combination is infringed by the use of a subordinate part only, if that part is new and material and is

(*x*) (1893) 10 R. P. C. 417.
(*y*) Macdonald *v.* Fraser, (1893) 10 R. P. C. 386; 11 R. P. C. 169.
(*z*) Howes *v.* Webber, (1895) 12 R. P. C. 465; 13 R. P. C. 39.
(*a*) Automatic Diversions Syndicate *v.* Urry, (1897) 14 R. P. C. 365.
(*b*) p. 228 *ante*.
(*c*) Clark *v.* Adie, (1877) L. R. 2 App. Cas. 335.

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the subject of a claim; (*d*) though, if the patent is for a combination of two or more old inventions, the use of only one of them will not be an infringement, since the patentable novelty claimed is the combination of the two.(*e*)

Thus, if a man invents a machine consisting of three parts, of which one is a very useful invention, and the other two are found to be of less practical use, it is not free for a person to adopt the useful part, and contrive some other mode of carrying out the less useful parts.(*f*) The question always is, "Has the combination in substance been taken? Has the defendant, though not exactly taking the whole combination which has been patented, taken by slight variation or by mechanical equivalent the substance of it, so as to produce the same result by practically the same means?" (*g*)

Equivalents substituted for specified parts.

When the ambit of the claim is not limited to the particular thing specified, the law will not allow a person to take an article described by the patentee and give a substitute in its place, for the purpose of effecting the same end, by the use of equivalents, using the skill and knowledge which he may possess to evade the patent.(*h*)

In fact, when, having regard to the state of public knowledge, a narrow construction is not to be put upon the claim,(*i*) it is an infringement to substitute mechanical equivalents for parts of the patentee's invention and add at the same time an improvement;(*k*) or to omit some part or parts of a patented combination and add anything, whilst at the same time using the substance and essence of it.(*l*)

(*d*) Lister *v.* Leather, (1857) 8 E. & B. 1004; Parkes *v.* Stevens, (1869) L. R. 8 Eq. 358, 366; L. R. 5 Ch. App. 36; Wright *v.* Hitchcock, (1870) L. R. 5 Ex. 37; Foxwell *v.* Bostock, (1863) 12 W. R. 723; Sellers *v.* Dickinson, (1850) 5 Ex. 312; Newton *v.* Grand Junction Ry., (1846) 5 Exch. 331; Smith *v.* London and North-Western Ry., (1853) 2 E. & B. 69; Young *v.* Rosenthal, (1884) 1 R. P. C. 33; Clark *v.* Adie, (1873) L. R. 10 Ch. App. Cas. 667; 3 Ch. D. 134, 143; 2 App. Cas. 315, 327, 335.

(*e*) Smith *v.* London and North-Western Ry., (1853) 2 E. & B. 69, 76.

(*f*) *Ibid.*

(*g*) See per Cotton, L.J., Proctor *v.* Bennis, (1887) L. R. 36 Ch. D. 254, 740; 4 R. P. C. 333; see also Burnett *v.* Tate, (1882) 45 L. T. N. S. 143; Murray *v.* Clayton, L. R. 10 Ch. App. Cas. 675 n.; Kaye *v.* Chubb, (1888) 5 R. P. C. 641; Garrard *v.* Edge, (1889) 6 R. P. C. 372, 563.

(*h*) Bateman *v.* Gray, (1853) Macr. P. C. 102: Morgan *v.* Seaward, (1837) 1 W. P. C. 171; Thorn *v.* Worthing Skating Rink Co., (1876) L. R. 6 Ch. D. 415 n.; United Telephone Co. *v.* Harrison Cox-Walker, (1882) L. R. 21 Ch. D. 720: United Telephone Co. *v.* Bassano, (1886) 3 R. P. C. 295: United Telephone Co. *v.* St. George, (1886) 3 R. P. C. 321; Hancock *v.* Moulton, Johns. Pat. Man. 5th ed. p. 254.

(*i*) p. 480 *post.*

(*k*) Proctor *v.* Bennis, (1887) 4 R. P. C. 333: L. R. 36 Ch. D. 740: Ehrlich *v.* Ihlee, (1888) 5 R. P. C. 437. 454.

(*l*) Proctor *v.* Bennis, (1887) 4 R. P. C. 333: 36 Ch. D. 740, 755; Needham *v.* Johnson, (1884) 1 R. P. C. 49; Gwynne *v.* Drysdale, (1886) 3 R. P. C. 65, 67; Cannington *v.* Nuttall, (1871) L. R. 5 H. L. 205.

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Rule in Sellers v. Dickinson.

It is an accepted proposition of patent law, known as the rule in *Sellers* v. *Dickinson*,(*m*) that if a portion of a patented new arrangement of machinery is in itself new and useful, and a person, for the purpose of producing the same effect as it produces, uses that portion of the arrangement, and substitutes another mechanical equivalent for the other matters combined with it, he thereby commits an infringement of the patent.

Equivalents not known at the date of the patent.

In order, however, that the substitution of an equivalent for any part of an invention for which letters patent have been granted may constitute an infringement, the equivalent must, at the date of the patent, be known to be an equivalent. To produce the result arrived at by the prior patentee by the use of an equivalent means, which required subsequent invention to demonstrate that it was an equivalent, may be perfectly good subject-matter for a subsequent grant of letters patent, and no infringement of the prior patent.(*n*) Thus, rendering cast steel easy to weld and malleable by subsequently discovered equivalents, viz., the addition of coal tar and black oxide of manganese to a crucible containing bars of common blistered steel, broken into fragments, or mixtures of cast and malleable iron, or malleable iron and carbonaceous matter, and heated to the proper heat for melting the materials, was held by the House of Lords (*o*) to be no infringement of a prior patent for doing the same thing by means of carburet of manganese, although there was evidence to the effect that carburet of manganese was formed by exposing the mixture of carbon and oxide of manganese to a high temperature. This decision of the House of Lords was substantially to the same effect as that of Lord *Abinger*, C.B, in the Court of Exchequer, viz., that the materials or elements of carburet of manganese, as used by the defendant, being out of all proportion cheaper than the carburet of manganese itself, the use of such materials in the composition was a new discovery or invention, and not within the letters patent.(*p*)

State of public knowledge affects the question whether or not the substi-

With regard to the question of the infringement of patents by the substitution of equivalents for parts described by the patentee in the specification, it must be remembered that it is necessary first to determine the true construction of the speci-

(*m*) 5 Exch. 312, 326; 20 L. J. N. S. Ex 417.

(*n*) Badische Anilin und Soda Fabrik *v.* Levinstein, (1883) L. R. 24 Ch. D. 156, 170–173; L. R. 12 App. Cas. 710; Heath *v.* Unwin, (1855) 5 H. L. C. 545; Automatic Weighing Machine Co. *v.* Knight, (1889) 6 R. P. C. 113, 300; Thompson *v.* Moore, (1889) 6 R. P. C. 426; 7 R. P. C. 329.

(*o*) Heath *v.* Unwin, (1855) 5 H. L. Cas. 505.

(*p*) Heath *v.* Unwin, (1855) 2 W. P. C. 217; 5 H. L. C. 505.

fication, and so ascertain what is the real invention claimed.(*q*) It must also be borne in mind that the true construction of the specification is affected (*inter alia*) by the state of public knowledge at the date of the patent.(*r*) The substitution of an equivalent in the place of a part mentioned in the patentee's specification may, or may not, be an infringement according as the state of public knowledge affects the true construction of the claim. Thus, when the invention relates to the production of an old result, or a machine of a known type, the patentee is protected only in respect of the particular means of performing the invention he sets forth in the specification; and under such circumstances it may be no infringement to achieve the same result by the use of well-known equivalents.(*s*)

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Substitution of known equivalents is an infringement in a particular case, *i.e.*, public knowledge affects the true ambit of the claim.

In such a case it is necessary to give the claim the limited construction above indicated, for the rule is that the specification is to be construed so as to support the patent, if it can fairly and logically be done,(*t*) and if a wider construction were put upon it under the circumstances indicated it would claim what had been done before, and so make the patent void for want of novelty.

On the other hand, when the invention consists in the production of a new result, or a machine which is of a totally new type, the patentee is not tied down strictly to the particular means of performing the invention, or the identical parts he sets forth in the specification; and under such circumstances it is an infringement to substitute known equivalents for the parts specified, and at the same time to make use of the novel principle the carrying of which into effect is the real substance of the patentee's invention.(*u*)

Curtis v. *Platt*,(*x*) which followed the prior House of Lords' decision in *Seed* v. *Higgins*,(*y*) and the principle of which was also applied by the House of Lords in *Boyd* v. *Horrocks*,(*z*) and in *Morris* v. *Young*,(*a*) is usually cited as the leading authority

Curtis *v.* Platt and Proctor *v* Bennis as types of the two classes of cases.

(*q*) pp. 237, 466 *ante*.
(*r*) pp. 251, 253 *ante*.
(*s*) Curtis *v.* Platt, (1866) L. R. 3 Ch. D. 135 n; Seed *v.* Higgins, (1860) H. L. C. 550; Gosnell *v.* Bishop, (1888) 5 R. P. C. 550; Atkiebolaget Separator *v.* Dairy Outfit Co., (1897) 14 R. P. C. 473.
(*t*) p. 253 *ante*.
(*u*) Clark *v.* Adie, (1887) L. R. 2 App. Cas. 315; Proctor *v.* Bennis, (1887) L. R. 36 Ch. D. 740; Boyd *v.* Horrocks, (1891) 9 R. P. C. 77.
(*x*) (1863) L. R. 3 Ch. D. 135 n.
(*y*) (1860) 8 H. L. C. 550.
(*z*) (1892) 9 R. P. C. 77.
(*a*) (1895) 12 R. P. C. 455. The rule in Curtis *v.* Platt was also applied in the following cases: Bovill *v.* Pimm, (1856) 11 Exch. 718; British Tanning Co. *v.* Groth, (1891) 8 R. P. C. 113; Jahncke *v.* Bell, (1892) 9 R. P. C. 94; Nettlefolds *v.* Reynolds, (1892) 9 R. P. C. 270; Parkinson *v.* Simon, (1894) 11 R. P. C. 238, 493; Ticket Punch Register Co. *v.* Colley's Patents, (1894) 12 R. P. C. 1. 171; Shoe Machinery Co. *v.* Cutlan (2), (1896) 13 R. P. C.

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with reference to the first class of cases, and *Proctor* v. *Bennis*,(*b*) the principle of which was approved by the House of Lords in *Moore* v. *Thomson*,(*c*) as the leading authority with reference to the second class of cases.

Curtis *v.* Platt.

In *Curtis* v. *Platt*,(*d*) where the patent was for certain improvements in spinning mules, a class of machine previously well known, and the invention consisted in a novel combination of old parts, all of which had been previously used before, though not in the same combination, for a similar purpose, Lord *Hatherley* (then Vice-Chancellor *Wood*) and Lord *Westbury*, L.C., followed the rule laid down by the House of Lords in *Seed* v. *Higgins*,(*e*) which applies to patents for achieving known results, viz., that if you find a specific mechanical improvement claimed, then you must hold the person strictly to that particular mechanical device which he has claimed for effecting the object he had in view; and if he says it is to be done in one precise and particular way, to that precise and particular way he must be held, and those who have *bonâ fide* employed a different system and a different way must not be held to have infringed. "Where the thing is wholly novel and one which has never been achieved before, the machine itself which is invented necessarily contains a great amount of novelty in all its parts, and one looks very narrowly and very jealously upon any other machines for effecting the same object to see whether or not they are merely colourable contrivances for evading that which has been done before. When the object itself is one which is not new, but the means only are new, one is not inclined to say that a person who invents a particular means of doing something that has been known to all the world long before has the right to extend very largely the interpretation of those means which he has adopted for carrying it into effect."(*f*)

It has wrongly been alleged that *Curtis* v. *Platt* laid down the principle that, when an invention is claimed for improvements in machinery consisting only in combination, the patentee must be held to the description which he gives of

141; Cleaver *v.* Wallwork, (1896) 13 R. P. C. 277; Birch *v.* Harrap (1896) 13 R. P. C. 615; Scott *v.* Hamling, (1897) 14 R. P. C. 123; Scott *v.* Hull Steam Fishing and Ice Co., (1897) 14 R. P. C. 143.

(*b*) (1887) L. R. 36 Ch. D. 740; 4 R. P. C. 333.

(*c*) (1890) 7 R. P. C. 325. The rule in Proctor *v.* Bennis was held to apply in Gosnell *v.* Bishop, (1887) 5 R. P. C. 41, 151; Peckover *v.* Rowland, (1893) 118, 234; Jardine *v.* King, Mendham & Co., (1896) 13 R. P. C. 411.

(*d*) (1863) L. R. 3 Ch. D. 135 n; L. R. 1 H. L. 337.

(*e*) (1860) 8 H. L. Cas. 550.

(*f*) Per Page Wood, V.C., Curtis *v.* Platt, (1863) L. R. 3 Ch. D. 135 n.

the particular means by which his invention is to be carried into effect, and that there can be no infringement by the substitution of parts. What *Curtis* v. *Platt* really lays down is, "that where there is no novelty in the result, and where the machine is not a new one, but the claim is only for improvements in a known machine for producing a known result, the patentee must be tied down strictly to the invention which he claims and the mode which he points out of effecting the improvement."(*g*) Or, to put it in another way, where at the date of the patent there were other known combinations of elements equivalent to the elements of the patentee's combination, and the real invention is neither more nor less than the substitution of a combination of elements for and mechanically equivalent to the elements of the mechanism previously known and used to attain the same end as the patentee's combination attains, the patentee is not in a position to take benefit from the principle of mechanical equivalents. In such circumstances there can be no infringement unless the apparatus complained of is in substance identical with the combination claimed by the patentee.(*h*) Consequently under such circumstances a claim for a particular means to effect certain purposes is not infringed where the same purposes are effected by different means;(*i*) nor is a combination to effect certain results infringed by a combination of similar parts operating in a different manner, though the results effected are the same;(*k*) but the claim is infringed when a variation in detail which amounts only to a colourable imitation is used.(*l*) When there is not only novelty in the machine, but also novelty in the result it produces, *Curtis* v. *Platt* does not apply.(*m*)

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In *Proctor* v. *Bennis* (*n*) the patent in question related to a new combination of tappets, shafts and springs in connection with a flap or door, producing a new kind of mechanical inter-

Proctor *v.* Bennis.

(*g*) Per Cotton, L.J., Proctor *v.* Bennis, (1887) L.R. 36 Ch.D. 756, 757; see also Ehrlich *v.* Ihlee, (1888) 5 R. P. C. 437; Boyd *v.* Horrocks, (1889) 6 R. P. C. 152, 558; Thompson *v.* Moore, (1889) 6 R. P. C. 426; Brown *v.* Jackson, (1895) 12 R. P. C. 324.

(*h*) Miller *v.* Clyde Bridge Steel Co., (1891) 8 R. P. C. 198; 9 R. P. C. 470, 478; Gosnell *v.* Bishop, (1888) 5 R. P. C. 159, judgment of Bowen, L.J.

(*i*) Sugg *v.* Bray, (1885) 2 R. P. C. 233-9; p. 48 *ante*.

(*k*) Lawrence *v.* Perry, (1885) 2 R.P. C. 179, 188; Boyd *v.* Horrocks, (1889) 6 R. P. C. 152; 9 R. P. C. 77; Automatic Weighing Co. *v.* Knight, (1889) 6 R. P. C. 113, 297.

(*l*) See p. 490 *post*; Boyd *v.* Horrocks, (1888-91) 5 R. P. C. 557; 6 R. P. C. 152.

(*m*) Per Cotton, L.J., Proctor *v.* Bennis, (1887) L. R. 36 Ch. D. 756, 757; see also Ehrlich *v.* Ihlee, (1888) 5 R. P. C. 437; Boyd *v.* Horrocks, (1889) 6 R. P. C. 152, 558; Thompson *v.* Moore, (1889) 6 R. P. C. 426; Brown *v.* Jackson, (1895) 12 R. P. C. 324; Automatic Weighing Machine Co. *v.* Knight, (1889) 6 R. P. C. 113.

(*n*) (1887) 4 R. P. C. 333; L. R. 36 Ch. D. 740.

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mittent radial stoker for distributing coal on the fires of furnaces. The novel feature of this machiue as compared with others was that in it the result of throwing coal on to the furnace by the intermittent radial action of a flap or door was for the first time applied. There was thus not only novelty in the machine, but there was novelty in the effect and the result produced. The defendant did not copy exactly the plaintiff's machine; on the contrary, the defendant's combination looked at first sight very different to the plaintiff's. What the defendant really did was to omit certain parts from the patented combination and to substitute mechanical equivalents for other parts. Therefore, although the defendant had not got the exact combination, yet he had got the combination in substance and result by putting mere mechanical equivalents for those things which were in the plaintiff's machine and which were protected in combination by his patent as the combination which he successfully claimed to have invented.

The Court of Appeal held that, notwithstanding the substitution of the equivalents above referred to for analogous parts in the plaintiff's combination as specified, the defendant infringed because he had adopted the substance of the plaintiff's patented invention, and not the less so though he had added certain further improvements. *Cotton*, L.J.,(*n*) referring to *Curtis* v. *Platt*,(*o*) and distinguishing that case from the present, in his judgment said:—

> "The plaintiff there was a patentee or the assignee of a patent for improvements in spinning mules. A spinning mule was a well-known machine, working and acting long before the patent on which the plaintiff in that case relied was taken out, and it was necessary in such a machine that there should be an intermission of the action of certain parts, although the motive power was still acting on the machine as a whole. That result had been produced before the patent in question by, amongst other means, the patent of *Roberts* and the patent of *Lakin* and *Rhodes*, and they had done it by adopting certain mechanical means. What the patentee whose patent was relied on by the plaintiff did was to correct and improve the means which they described in their patents for the purpose of obtaining that result; and that, therefore, is a most material matter, because I find at page 857 of the 35 L. J. Ch., where the specification of the patent is set out, that what the patentee claimed was 'the novel construction, combination, and application of mechanism as

(*n*) 4 R. P. C. 355. (*o*) (1866) L. R. 3 Ch. D. 135 n; 35 L. J. Ch. 852.

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hereinbefore described, whereby one-half of the clutch or catch-box hereinbefore, and in the said specification of *Robert Lakin* and *William Henry Rhodes* described, or any mechanical equivalent therefor, is connected with and acts upon the cams or other similar parts of mechanism for effecting the changes in the action of the mule.' So that there he refers to that previous patent, and I think he also had done so with reference to the previous patent of the other patentee which I have mentioned. It was specially to introduce improvements into the mechanical means and arrangements which a previous patentee had used to obtain a well-known object in a well-known machine. Therefore, in that case, in applying those words used by the Judges we must deal with the case before them and must come to the conclusion, as I do, that what they meant was this, that where there is no novelty in the result, where neither the machine nor the result is new, there you must tie down the patentee, who claims an improvement in the machinery for producing in a known machine that result, strictly to the invention which he claims, and the mode of effecting the improvement which he says is his invention. But here the throwing coal on to the furnace by the intermittent radial action of a flap or door was new, and nothing of the kind had been done before. It is true there had been previous, though imperfect, machines for feeding furnaces automatically, but that had not been done previous to this machine by any intermittent radial action of a flap or door as was done by the plaintiff, and apparently successfully done by him. In my opinion, therefore, these opinions expressed by the Judges with reference to mere improvements in an old machine for an old purpose cannot lay down any law for a case like this, where the result of throwing coal on to the furnace by the intermittent radial action of the flap is first applied in a machine invented by the plaintiff. There was not only novelty in the machine, but there was novelty in the effect and in the result to be produced by that machine. In my opinion, therefore, we must come to the conclusion that here the defendant *Bennis*, and also the other defendants, do, in fact, infringe that which is claimed by the plaintiff as his combination, and that so far as that goes the appeal of *Bennis* fails."

Tweedale's invention and Everitt's invention as illustrating the application of the doctrines of Curtis v. Platt and Proctor v. Bennis respectively.

The history of the litigation in connection with *Tweedale's* invention, which related to cotton and wool carding and consisted in improvements in flats and fasteners for securing the carding cloth thereon and thereto; and also *Everitt's* invention of the so-called penny-in-the-slot or coin-feed weighing apparatus, afford good illustrations of the application of the principles of *Curtis* v. *Platt* and *Proctor* v. *Bennis* respectively.

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History of the litigation in connection with Tweedale's invention.

Tweedale's invention of "improvements in flats and fasteners for securing the card clothing thereon and thereto" was merely a new mechanical mode of obtaining an old result, *i.e.*, stretching evenly and fastening a carding cloth or fillet on the flat, and did not involve a question of principle. The claim, properly construed, was for the mode of achieving the result and the thing described. Consequently the rule in *Curtis* v. *Platt*(*p*) governed the question of infringement, and the doctrine of substitution of mechanical equivalents did not apply. Though *Tweedale's* invention was useful, ingenious, and meritorious, the claim was not infringed by another means of attaining the same result, the details of which were different. The new means adopted by *Tweedale* to attain the old result were thus described by Lord *Watson* (*q*) in the House of Lords: "The 'flat' consists of a straight bar of solid metal, to the surface of which there is attached a wire brush. What in ordinary language would be described as the back of the brush is of elastic material, and is technically termed its foundation. For the efficiency of the carding machine it is necessary that the surface of the brush shall be perfectly level, and shall remain so in course of working. The attainment of that result has been found in practice to depend mainly, if not wholly, upon the manner in which the foundation of the brush is fastened to the bar of metal upon which it rests. At the date of the patent there appears to have been only two known modes of attachment. The foundation was placed upon the bar, and its edges fastened to the bar either by a series of rivets about half an inch apart, or by substituting a wire thread, with stitches of that length, for the rivets. Both the methods were liable to the same defects. In attaching it to the bar the foundation was apt to become puckered, thereby causing inequalities in the surface of the brush; and in working the exposed edges of the foundation became frayed, and caused an accumulation of waste from the material carded. The patentee's invention obviated these defects by introducing a different mode of fastening the foundation of the brush to the bar. The fasteners which he employed were thin strips of metal, one for each side of the bar. One edge of each strip was moulded so as to grip firmly the outer edge of the foundation, independently of the bar; the other edge of the strip was moulded so as to fit and grip a ridge cast upon the back of the

(*p*) (1886) L. R. 3 Ch. D. 135 n; 35 L. J. Ch. 852; p. 481 *ante*.
(*q*) Tweedale *v.* Ashworth, (1892) 9 R. P. C. 128.

bar. After a strip was attached to each edge of the foundation the bar was inserted, producing a degree of tension which made the foundation adhere to it flatly and evenly, and then the other edges of the strips were made to grip the ridges cast on the other side of the bar, the result being that the surface of the brush was made and kept uniformly level, and that the edges of the foundation were, by the encasing metal, protected from fraying and becoming a receptacle for waste."

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In *Tweedale* v. *Ashworth*(*r*) it appeared that the alleged infringer attained the old result in the following manner: By a long strip of metal he clasped one side of the fillet to the bar, and then, by a steel comb operating like a carpet stretcher, he stretched the elastic material of the fillet to the other side, and then clamped this other side of the fillet to the bar by a long strip of metal, precisely as he had already clamped the first side of the fillet and bar together. The stretching was thus produced by external mechanical means. This different means was held by the Court of first instance, the Court of Appeal, and the House of Lords to be no infringement of the means claimed by the patentee, which necessarily involved as one of the merits of the invention the power of stretching the material of the fillet at the same time and by the same operation as completed the machine. An essential feature of the patentee's invention was the gripping the edges of the fillet independently of the bar; and, as stated in the specification, it was evident that the forms of the edges of the bar and of the bent portions of the strips might be varied, so long as it is provided that one edge of each strip secures a firm grip upon the foundation of the fillet, and the other edge secures a tight grip upon the under portion of the bar.

In a subsequent case, *Tweedale* v. *Howard* and *Bullough*,(*s*) it appeared that the infringers there had slightly varied the form of the parts employed, but had attained the result by a "colourable imitation" of the patentee's invention, in that they obtain a sufficient grip of the fillet independently of, and before, the insertion of the bar, which grip was increased when the strip was clamped upon the bar, and the insertion of the bar effected the desired stretching. The following *résumé* of the evidence(*t*) shows the variations in form adopted by the infringers. The defendants' fastener was a continuous strip of metal bent horizontally at the top and bottom, so that it firmly fixed the foundation of the clothing to the bar. There was no

(*r*) (1890) 7 R. P. C. 426; 8 R. P. C. 49; 9 R. P. C. 121.

(*s*) (1896) 13 R. P. C. 522.

(*t*) 13 R. P. C. 532.

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longitudinal rib, as in *Tweedale's*, under the bar, but the under side of the bar was bevelled for some distance in a slightly slanting upward direction, so as to admit of the fasteners being applied firmly. The top part of the strip had a distinct curl, by which it got a direct grip of the foundation, and the pressure applied to fix on the bar increased the curl, so that when the end of this part of the strip penetrated the foundation and was clinched, it got an adequate hold of the foundation, which was necessary for stretching purposes. The foundation was stretched by forcing in the bar. Thus the defendants attained the same end by substantially the same means, and the Court held that they had infringed, since the means used by them were only "colourable" variations of the patentee's means, and not mechanical equivalents for the parts specified by him and claimed in combination.

History of the litigation in connection with Everitt's invention.

Everitt's invention of the automatic weighing machine consisted essentially in a contrivance by which he set the indicating apparatus in motion by means of a penny placed in the slot. The patentee was clearly not entitled to a patent for this principle apart from the method in which it was carried out as disclosed by the specification; and especially the patentee was not entitled to protection for every mode of operating upon every conceivable indicating apparatus by means of a penny.(*u*) The essential elements in *Everitt's* invention are three, viz.: (a) a weighing apparatus, (b) an indicating apparatus, and (c) a break, or want of continuity between the two, together with a contrivance by means of which the indicating apparatus, broken from the weighing apparatus, is, by a penny placed in the slot, set at work in such a way that the indicator will stop at a point fixed by the weighing apparatus itself, or by a stop upon it, and the index does not operate to show the weight on the dial till the coin is inserted.(*x*)

Everitt's invention produced the first machine of its class, which operated by the utilisation of the principle above described, and therefore the rule in *Proctor* v. *Bennis* (*y*) applied as to the infringement of the claim by the use of mechanical equivalents.

The first reported case relating to an infringement of *Everitt's Patent* was *Automatic Weighing Machine Co.* v. *Knight*,(*z*) and both the Judge of first instance and the Court of Appeal held

(*u*) p. 39 *ante*.

(*x*) Automatic Weighing Machine Co. *v.* National Exhibitions Association, Ld., (1891) 9 R. P. C. 44 45.

(*y*) (1888) 4 R. P. C. 333; L. R. 36 Ch. D. 740.

(*z*) (1889) 6 R. P. C. 297.

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that no infringement had been committed, because the essential features of the patentee's apparatus were not reproduced by the substitution of equivalents, or otherwise in the alleged infringing machine. The defendant's apparatus in this case differed from the patentee's in that it had a stop which prevented the machine being set in operation till a coin was put in the slot and raised a lever, thereby allowing a handle to be moved by the person being weighed, and the machine so to be set in operation; this was in effect equivalent to putting a lock on the machine, and so, though both machines attained the same result by the operation of the coin, the defendant's by the intervention of a different principle did it in a different way to that protected by the claim of the patent.

Then in *Automatic Weighing Machine Co.* v. *Combined Weighing Machine Co.*,(*a*) it was also held that there was no infringement, where in the defendant's apparatus the coin was first introduced through the slot, and so placed in position; and then, on an outside knob being pushed by the person being weighed, the coin was moved and made to operate on the lever, which, so to speak, unlocked and set the weighing apparatus in action.

These cases were followed by *Automatic Weighing Machine Co.* v. *National Exhibition's Association, Ltd.*,(*b*) where it was held, both by the Judge of first instance and the Court of Appeal, that what the defendants had done was an infringement of *Everitt's Patent*, since the essential principle of the invention was pirated, though the defendants had most ingeniously attempted to conceal this fact by bringing about the same result by a somewhat different method. They adopted a lever instead of a wheel and axle, and they employed a different indicating apparatus, in which an electric battery was introduced; but these things were nevertheless held to be nothing but equivalents for the things pointed out by the patentee, and the defendants committed an infringement because they made use of the essential principle or substance of the patentee's machine, and gave effect to it merely in a different way by the substitution of mechanical equivalents for the parts which the patentee described.

In *Automatic Weighing Machine Co.* v. *International Hygienic Society*,(*c*) which was decided before the last-mentioned case, but did not go to the Court of Appeal, it was held that the

(*a*) (1889) 6 R. P. C. 367.
(*b*) (1891) 8 R. P. C. 345; 9 R. P. C. 41.
(*c*) (1889) 6 R. P. C. 475.

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defendants had infringed by the use of an indicating mechanism in which the indicating was effected by the removal of two shutters exhibiting the figures denoting the weight on a moveable dial, which was a mere mechanical equivalent for the patentee's indicating mechanism where the indicating was effected by the movement of an index on a fixed dial, and there was a break between the weighing and indicating part of the mechanism, though the spindles in the defendant's machine were not on the same axial lines.

Again, in *Automatic Weighing Machine Co.* v. *Fearby*,(*d*) the defendant there was held to have infringed by using an apparatus consisting of a weighing apparatus and an indicating apparatus disconnected, in which a coin put in the slot fell into position by its weight and formed a coupling between an exterior handle and a lever. The handle, when turned by the person being weighed, moved a lever, which drew down one arm and released a catch which set free the indicating mechanism and allowed it to fall down by its weight on the weighing mechanism and so indicate the weight.

"Pioneer patent" and "pioneer claim."

The terms "pioneer patent" and "pioneer claim" are sometimes not inaptly used in reference to a claim which, having regard to the state of public knowledge in relation to the art at the date of the patent, is properly construed according to the rule in *Proctor* v. *Bennis*.(*e*)

Correct application of the doctrine of infringement by substitution is a matter of difficulty in some cases.

The doctrine of infringement by substitution is, however, much misunderstood, and is by no means easy to apply correctly in dealing with many particular cases. It is necessary to consider the step in invention which the patentee has taken, and also the alleged infringement, and to ascertain if, in substance, it is the same. A mechanical equivalent is a mechanical variation, and if the step taken by the patentee is a small one, as in *Curtis* v. *Platt*, then identity means taking the same or only colourably different mechanical variations. If the invention is detail, difference in detail can be successfully pleaded by the alleged infringer. If on the other hand the step taken by the patentee is a long one, as in *Proctor* v. *Bennis*, then all the details in an infringement may be different, and, provided there is substantial identity, mere difference in detail cannot be pleaded as an excuse. In dealing with the facts of particular cases, great difficulty often arises in reference to what, having regard to the state of

(*d*) (1893) 10 R. P. C. 443.

(*e*) pp. 481, 482, *ante;* see also Proctor *v.* Binnis, (1888) L. R. 36 Ch. D. 764; Incandescent Gas Light Co. *v.* De Mare Incandescent Gas Light System, Ld., (1896) 13 R. P. C. 331.

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public knowledge at the date of the patent, is the true ambit of the claim, *i.e.*, whether it is to be construed according to the rule in *Curtis* v. *Platt*,(*f*) or according to the rule in *Proctor* v. *Bennis*.(*g*) This difficulty may be illustrated by a consideration of two somewhat recent cases, both of which were finally disposed of by the House of Lords, viz., *Boyd* v. *Horrocks*,(*h*) and *Thomson* v. *Moore*.(*i*) These cases may be supplemented by *Pneumatic Tyre Co.* v. *Tubeless Tyre, and Capon Heaton, Ltd.*(*k*)

Illustrations of the difficulty in correctly applying the doctrine of infringement by substitution.

In *Boyd* v. *Horrocks* (*l*) the patentee *Boyd* claimed as his invention not only an entire machine, but also a number of subordinate inventions. The invention comprised various improvements applicable to winding and doubling machinery of the same class or type as that described in various prior specifications. Two of the subordinate claims were alleged to have been infringed by a variation of some of the details referred to by the patentee, and the Court of First Instance held that such was the fact. The Court of Appeal, however, over-ruled this finding, on the ground that the claims in question ought to be construed very narrowly so as to limit them to the specific details mentioned, otherwise, if a sufficiently wide construction were put upon them to cover what the alleged infringer had done, they would also embrace a combination which was old and render the patent void for want of novelty. The House of Lords, on the other hand, on a careful consideration of the language of the specification, came to a different conclusion. Their Lordships held that what was claimed was a definite arrangement of parts producing a definite result as a consequence of the arrangement, and was not restricted to the details of the parts employed; and, further, that as the particular arrangement in question was present in the machine used by the infringer, though the details were different, but was absent from the alleged prior anticipating machine, the claims were valid and had been infringed.

Boyd *v.* Horrocks.

In *Thomson* v. *Moore* (*m*) the facts relative to the question of infringement were as follows. The plaintiff, now Lord *Kelvin*, was the patentee of improvements in the mariner's compass. The following were the chief features of the invention: an extremely

Thomson *v.* Moore.

(*f*) p. 481 *ante*. (*g*) p. 481 *ante*.

(*h*) (1888–1891) 5 R. P. C. 557; 6 R. P. C. 152; 9 R. P. C. 77.

(*i*) (1889–1890) 6 R. P. C. 426; 7 R. P. C. 325.

(*k*) (1897–1898) 15 R. P. C. 74, 236; see also Gormully and Jeffery Manufacturing Co. *v.* North British Rubber Co., (1896) 13 R. P. C. 691; 14 R. P. C. 283; 15 R. P. C. 245.

(*l*) (1888–1891) 5 R. P. C. 557; 6 R. P. C. 152; 9 R. P. C. 77.

(*m*) (1889) 6 R. P. C. 626; 7 R. P. C. 325.

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light card, consisting of a narrow rim of thin paper supported by a thin rim of aluminium on which were marked the cardinal points; the aluminium rim was attached to the central boss, which was also of aluminium, by fine silken filaments in tension; the needles, which were short and light, were arranged in a horizontal plane a little beneath the card and attached to the rim by light silken threads. By this combination three important objects were obtained, viz., (1) diminution of friction, resulting in increased sensitiveness and accuracy; (2) small magnetic moment, and consequent amenability to *Airey's* correctors; (3) long vibration period, the magnetic moment being small and a comparatively large proportion of the weight of the card being thrown to the periphery, securing steadiness in stormy weather.

The defendant constructed and sold a card resembling the plaintiff's in three features of (1) extreme lightness; (2) smallness of needles and magnetic moment; and (3) length of vibrational period and consequent steadiness in virtue of the greater part of the weight being thrown to the periphery. The construction of the defendant's card differed from the plaintiff's in that (a) the circumference consisted of an L-shaped aluminium ring instead of a thin rim; (b) the rim was connected to the boss by flat parallel strips of aluminium instead of silken threads in tension; (c) the short and light needles were arranged in vertical pairs some distance below the card, and were attached to it by aluminium wires instead of silk threads. The same combination of results attended the defendant's combination as were the consequence of the plaintiff's combination—viz., diminution of frictional error, steadiness and amenability to correctors. The defendant contended that his arrangement of the needles was specially adapted to his own patented correctors.

The case first came before the Irish Master of the Rolls and the result of his Lordship's view of the effect of the evidence as to the state of public knowledge at the date of the patent was, that the patent being for a new means of attaining a well-known object—viz., to produce a compass-card, which would be steady and true under all circumstances—it was the case of a combination of known mechanical means for effecting a known improvement in an old machine, and that the doctrine of mechanical equivalents did not apply, and further that the defendant's card not being the same in substance as the plaintiff's there was no infringement. The plaintiff thereupon appealed, and the Court of Appeal in Ireland took a different view of the

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evidence and held that the essence of the plaintiff's invention being so to combine extreme lightness of card with long period of vibration and shortness of needles as to obtain a combination of results not previously obtained, *viz.*, diminution of frictional error, steadiness, and amenability to correction, such a combination amounted to a new result, and the doctrine of mechanical equivalents applied. Further, the question was whether there was a pith and substance underlying the invention; and, if so, had the defendant taken that pith and substance? The Court held that he had done so, since his card attained the same results by substantially the same means, agreeing in essentials with the plaintiff's and differing only in non-essentials, and, consequently, he had infringed. The case ultimately went to the House of Lords, and their Lordships affirmed the decision of the Court of Appeal, and held that the plaintiff had attained a new result—a new instrument—and that the differences between his card and the defendant's were mere colourable differences introduced for the purposes of avoiding the appearance of imitation, and an infringement had been accordingly committed.

Chemical patents and infringement by substitution of equivalents.

As regards the infringement of chemical patents, the rules which have been discussed chiefly with reference to patents for mechanical contrivances have equal force when the subject-matter of the patent is a chemical process or a chemical compound, both as regards the true way in which to fix the ambit of the claims and to determine the question of infringement by the substitution of equivalents for the parts or ingredients referred to in the specification.(*n*) In many of the reported cases having reference to chemical patents the rule that there is no infringement in the substitution of an equivalent, when at the date of such patent the equivalent used was not known to be an equivalent of the process or ingredient for which it is substituted,(*o*) is of the utmost importance in arriving at a true conclusion.

Thus, in *Nobel's Explosives Co.* v. *Anderson*,(*p*) the Court of First Instance, the Court of Appeal and the House of Lords all decided that the claims of the specification were limited to the use of the "soluble" form of nitro-cellulose for the purpose of preparing the explosive compound referred to and that the

(*n*) Heath *v.* Unwin, (1855) 5 H. L. C. 505; as compared with Incandescent Gas Light Co. *v.* De Mare Incandescent Gas Light System, (1896) 13 R. P. C. 301, 332, 559, 578; see also Fabriques de Produits Chemiques de Thaun *v.* Caspers, (1897) 15 R. P. C. 94.

(*o*) p. 480 *ante*.

(*p*) (1894) 11 R. P. C. 115, 519; 12 R. P. C. 164.

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"insoluble" form was not known to be an equivalent at the date of the patent. The Lord Chancellor (*q*) pointed out that the contention that, though the patentee claimed only the combination of the "soluble" nitro-cellulose with nitro-glycerine, yet an infringement had been committed because all that had been done was that the "insoluble" form had been substituted for the "soluble," and that one chemical equivalent had been substituted for another, had not been made out, and that there was no evidence to show that the two were known to be equivalents at the date of the patent. The evidence was the other way; and the patentee, who obviously had a competent knowledge of the subject, was careful to always stipulate for the use of the "soluble" form.(*r*)

It is no infringement to use proportions of ingredients outside the limits claimed.

When proportions of the substances used are of the essence of the invention,(*s*) there is no infringement by the use of proportions outside the limits included by the claim.(*t*)

Various methods of infringing a patent.

The form (*u*) now used, of all letters patent for inventions, grants to the patentee full power, sole privilege, and authority by himself, his agents, or licensees, to make, use, exercise, and vend the invention, and then forbids the rest of the public during the continuance of the patent, either directly or indirectly, to make use of or put in practice the invention, or any part of the same, or in any wise to imitate the same, or make, or cause to be made, any addition thereto, or subtraction therefrom, whereby to pretend themselves the inventors thereof, without the consent or agreement of the patentee in writing under his hand and seal. Consequently, there are several ways in which a patent privilege may be infringed, *i.e.*, by manufacturing or making articles for use or sale by means of the art which is the subject of the patent; or by using, exercising, or putting the art in practice to the prejudice of the patentee in any other way; by making for use or sale, or vending articles made in pursuance of the invention; or by counterfeiting, or imitating the invention in any other way.

Ordering the construction of a patented article.

It is an infringement to order an article to be made according to a patented process, for he who causes an article to be made may be said to make it himself.(*x*)

(*q*) 12 R. P. C. 167.

(*r*) Other cases in which the infringement of chemical patents by the use of equivalents was considered are: Muntz *v.* Foster, (1844) 2 W. P. C. 95; Stevens *v.* Keating, (1847) 2 W. P. C. 181; Hancock *v.* Moulton, (1852) John's Pat. Man. 6th ed. 254.

(*s*) pp. 466, 468, 469, 472 *ante*.

(*t*) Maxim-Nordenfelt Guns and Ammunition Co. *v.* Anderson, (1897) 14 R. P. C. 371, 671.

(*u*) 46 & 47 Vict. c. 5, 1st Schedule, Form D.

(*x*) Gibson *v.* Brand, (1842) 1 W.P.C. 631.

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But it is not an actionable infringement to make, use, or sell a patented invention by or at the instigation of a patentee or his duly authorised agent; (*y*) neither is a person who gives another a licence to work under a patent which infringes the patent of a third person himself an infringer of that patent.(*z*)

Use of patented invention at the instigation of the patentee.

What the public is by the patent prohibited from doing is to exercise the art which is the subject of the grant. In the case of making an article without proof of sale, the fact that the defendant has not sold the article manufactured according to the patent, and therefore not derived pecuniary profit, does not prove that he has not exercised the art, though it does show that the plaintiff has not suffered any substantial loss, and it is, therefore, an argument in mitigation of damages.

Manufacture and sale of the separate parts of a patented combination.

When the patent is for a combination of various parts, each of which is in itself old, the manufacture and sale in this country of those parts is no infringement, nor is the exportation of them with the intention of putting them together abroad, for the single parts do not make the patented combination, and the making of them is in itself lawful.(*a*) Nor is it any infringement to manufacture or sell an article which may be used for the purpose of infringing a patent, whether in ignorance of the patent,(*b*) or even though the person manufacturing and selling it actually knows that it will be used for purposes of infringement;(*c*) though it appears that an injunction restraining the sale of a complete machine would be violated by the sale of all the component parts in such a way that they could be easily put together by any one.(*d*)

Restoration of a patented instrument.

It has been held to be an infringement of a combination patent to restore instruments by renewing parts which were essential to the combination.(*e*)

Infringement by manufacture without actual sale.

The mere making of articles for the purpose of sale or use, and not by way of *bonâ fide* experiment,(*f*) is an infringement, although no actual sale or use has taken place;(*g*) but there is no infringement unless a saleable article is produced;(*h*) though

(*y*) Kelly *v.* Batchelor, (1893) 10 R. P. C. 289.

(*z*) Montgomerie *v.* Paterson, (1894) 11 R. P. C. 221, 633.

(*a*) See Goucher *v.* Clayton, (1865) 11 Jur. N. S. 462; M'Cormick *v.* Gray, (1861) 7 H. & N. 25.

(*b*) Savage *v.* Brindle, (1896) 13 R. P. C. 267.

(*c*) Townsend *v.* Haworth, (1875) 48 L. J. Ch. N. S. 770; 12 Ch. D. 831 n; Sykes *v.* Howarth, (1878) L. R. 12 Ch. D. 826; 48 L. J. Ch. 769; but see Incandescent Gas Light Co. *v.* New Incandescent Gas Mantle Co., (1897) 15 R. P. C. 83, 84.

(*d*) United Telephone Co. *v.* Dale, (1883) L. R. 25 Ch. D. 778.

(*e*) United Telephone Co. *v.* Neilson, (1887) W. N. (1887) 193.

(*f*) p. 496 *post*.

(*g*) Muntz *v.* Foster, (1844) 2 W. P. C. 101; Jones *v.* Pearce, (1832) 1 W. P. C. 125.

(*h*) Higgs *v.* Goodwin, (1858) E. B. & E. 529; 27 L. J. Q. B. 421.

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the thing constructed may infringe without being separately prepared and saleable, as in the case of fitting a ship for the reception and laying of a telegraph cable.(*i*)

Use by way of *bonâ fide* experiment is no infringement.

It is no actionable invasion of a patentee's rights for another person to use the invention, and thereby produce the finished product by way of *bonâ fide* experiment or amusement, without the intention of selling or making use of the thing so made for the purpose for which the patent was granted, but with the view merely of improving upon the invention the subject of the patent, or with the view of seeing whether an improvement can be made.(*k*) In the words of *Jessel*, M.R.,(*l*) "patent rights were never granted to prevent persons of ingenuity exercising their talents in a fair way. But, if there be neither using nor vending of the invention for profit, the mere making for the purpose of experiment, and not for a fraudulent purpose, ought not to be considered within the meaning of the prohibition, and, if it were, it is certainly not the subject for an injunction."

Use for advantage is an infringement.

Use of a pirated article for the purpose of making experiments for the instruction of pupils is use for advantage, and an infringement of the patent under which the article was manufactured.(*m*) Thus, where an English electrician purchased and imported from a foreign manufacturer apparatus made according to an English patent, and maintained that he had only purchased the apparatus for examination and experiment by himself and his pupils, as certain royalty-paid instruments in his possession were too expensive to be taken to pieces, and further insisted that he had never sold, and had never otherwise used the apparatus, the Court held that such use was an infringement, and granted an injunction restraining the continuance of it.(*n*)

Also where it appeared that certain persons purchased infringing machines upon the understanding that they were not to be paid for unless they proved successful, and the machines in question were used by the defendants in their works for several months, the Vice-Chancellor of the Court of the County Palatine of Lancaster held that such use was not experimental; but the Court of Appeal dissolved the injunction

(*i*) Newall *v.* Elliot, (1863) 10 Jur. N. S. 954.

(*k*) Frearson *v.* Loe, (1878) L. R. 9 Ch. D. 48; Jones *v.* Pearce, (1832) 1 W. P. C. 121, 125; 5 M. & G. 208; Muntz *v.* Foster, (1844) 2 W. P. C. 101; United Telephone Co. *v.* Sharples, (1885) 2 R. P. C. 28; Proctor *v.* Bayley (1889) 6 R. P. C. 107.

(*l*) Frearson *v.* Loe, (1878) L. R. 9 Ch. D. 48.

(*m*) United Telephone Co. *v.* Sharples (1885) L. R. 29 Ch. D. 164.

(*n*) *Ibid.*

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on the ground, however, that supposing the infringement was proved, as the defendants were merely users and not manufacturers and the only infringement was put an end to some considerable time ago and there was no evidence of any intention on their part to continue in the wrongful act, an injunction ought not to have been granted.(*o*)

Pecuniary profit is not a condition precedent to liability.

The *ratio decidendi* of cases which decide that a person may be an infringer, though he has derived no pecuniary profit from his infringement, is that such profit is not a condition precedent to liability, but the condition precedent is actual or probable damage to the patentee arising from the acts complained of.

Unlicensed sale of patented article within the area of the patent is an infringement, notwithstanding the *locus* of the manufacture.

It is an infringement to sell or use an article which was manufactured according to a patented process without the licence of the patentee;(*p*) whether the article was made in this country or was imported from abroad,(*q*) or whether the sale was to an English or a foreign customer for shipment abroad,(*r*) makes no difference; but, if the article was in the first instance manufactured or sold by a licensee of the patentee, it is no infringement for the purchaser to resell it, either within or outside the area comprised by the licence.(*s*) And if the article is manufactured abroad and sold and delivered by such manufacturer abroad to the person or his agent who imports it into this country, such foreign manufacturer aiding and abetting the importation into this country does not thereby make himself amenable to the jurisdiction of the Court, nor is he an infringer.(*t*) In such a case the importer only is the infringer; but if the foreign manufacturer contracts for and, either personally or by means of an agent—*e.g.*, the post or other carrier—makes delivery in this country, he is himself the importer and an infringer.(*u*)

The *ratio decidendi* of the cases to the effect that the

(*o*) Proctor *v.* Bayley, (1889) 6 R. P. C. 106, 538.

(*p*) Wright *v.* Hitchcook, (1870) L. R. 5 Ex. 37; Davenport *v.* Rylands, (1865) L. R. 1 Eq. 302.

(*q*) Walton *v.* Lavater, (1860) 8 C. B. N. S. 162; Elmslie *v.* Boursier, (1869) L. R. 9 Eq. 217; Von Heyden *v.* Neustadt, (1880) L. R. 14 Ch. D. 230; Société Anonyme des Manufactures de Glaces *v.* Tilghman's Sand Blast Co., (1883) L. R. 25 Ch. D. 1; Cartsburn Sugar Refining Co. *v.* Sharp, (1884) 1 R. P. C. 181; United Telephone Co. *v.* Sharples, (1885) 2 R. P. C. 31; 26 Ch. D. 164.

(*r*) United Telephone Co. *v.* Sharples, (1885) 2 R. P. C. 28; L. R. 29 Ch. D. 164, 167; Lyon *v.* Goddard, (1894) 11 R. P. C. 113.

(*s*) Smith *v.* Buchanan, 26 S. J. 347; p. 498 *post*.

(*t*) Badische Anilin und Soda Fabrik *v.* Johnson, (1897) 14 R. P. C. 919, 405, 211.

(*u*) Badische Anilin und Soda Fabrik *v.* Johnson, (1897) 14 R. P. C. 919.

Infringement.

sale in this country of an article made abroad by a machine or process which is patented in this country is an infringement, is that the sale of the article is an indirect use of the invention within the prohibition of the patent. The selling of an article and converting it into money is about the most effectual mode that can be imagined of using the invention whereby it was produced.(*x*) The object of the patent is to give the inventor the profit of his invention; and the most effectual way of defeating that object would be to permit others to derive, from a sale of an article made in infringement of the patent, the profit which it was intended to secure to the patentee.(*y*)

Exposure for sale.

It has been held that the mere exposure for sale of an article made according to a patent, without actual proof of sale, is not an infringement;(*z*) though, on the other hand, it was held by a Court of first instance that where a defendant had manufactured articles, and his traveller had offered them for sale, though he had not actually sold any, there had been such a use as to amount to an infringement.(*a*)

Mere loan.

A mere loan of a patented article, without any intention of selling it or evading the patent, is no infringement.(*b*)

Unrestricted sale of a patented article by the patentee or his licensee.

Any person who purchases an article made under a British or a foreign patent, whether in this country or abroad, which is sold without any restrictions on the buyer, acquires an absolute right to resell it or otherwise deal with it as he pleases, and he is at liberty to sell it in any country where there is a patent in the possession of, and owned by, the vendor.(*c*) Also a purchaser of a patented article, without notice of an exclusive licence for a limited area, is not affected by the licence, and cannot be restrained from using the machine within the area;(*d*) but a licence to manufacture an article under a foreign patent in a foreign country does not imply permission to sell or use the article in this country in violation of an English patent.(*e*)

Unrestricted

An unrestricted licence to manufacture and sell a patent

(*x*) Per Keating, J., Walton *v.* Lavater, (1860) 8 C. B. N. S. 188.

(*y*) Erle, C.J., Walton *v.* Lavater, (1860) 8 C. B. N. S. 185.

(*z*) Minter *v.* Williams, (1835) 4 A. & E. 251.

(*a*) Oxley *v.* Holden, (1860) 8 C. B. N. S. 666; 30 L. J. C. P. 68.

(*b*) United Telephone Co. *v.* Henry, (1885) 2 R. P. C. 11.

(*c*) Per Cotton, L.J., Société Anonyme des Manufactures de Glaces *v.* Tilghman's Patent Sand Blast Co., (1883) L. R. 25 Ch. D. 9; Betts *v.* Wilmott, (1870) L. R. 6 Ch. 239.

(*d*) Heap *v.* Hartley, (1888) 5 R. P. C. 603.

(*e*) Société Anonyme des Manufactures de Glaces *v.* Tilghman's Patent Sand Blast Co., (1883) L. R. 25 Ch. D. 1.

article is an authority to the vendees of the licensee to vend it without the consent of the patentee, and their doing so is no infringement,(*f*) whether they do so inside or outside the area comprised in the licence; for a purchaser from an unrestricted licensee, whether special or general, acquires the patented article for all purposes, and can exercise every right of ownership in respect of it.(*g*)

Infringement.

licence to manufacture and sell..

It is competent to a patentee to sell, or to license the sale of, a patented article with a restriction that it shall be used only in a certain way. If the purchaser has notice of any such restriction, use in any but the authorised manner will constitute an actionable infringement. Thus, in *Incandescent Gas Light Co.* v. *Cantelo* (*h*) it appeared that the plaintiffs' course of business was to sell only through agents, whose dealings were restricted to their respective localities. The defendant employed a friend, who resided within the district of the plaintiff's London agent, to purchase from that agent certain goods. After these were paid for by his friend, and, at the request of the latter, consigned direct to the defendant in the Isle of Wight, the defendant discovered, on unpacking them, that each box had a notice on it stating that the goods were sold upon condition that they were to be used only in a certain way. The defendant covered up the notices with his own labels, and resold the goods to his customers. His friend when buying never saw the boxes or notices. The Court held that, as there was insufficient notice, there was no infringement under the circumstances; but the learned Judge, *Wills*, J., stated that, if a purchaser on the sale is cognisant of restrictions put upon the use of the goods, he is bound by them on the principle that "the patentee has the sole right of using and selling the articles, and he may prevent anybody from dealing with them at all. Inasmuch as he has the right to prevent people from using them, or dealing in them at all, he has the right to do the lesser thing—that is to say, to impose his own conditions. It does not matter how unreasonable or how absurd the conditions are. It does not matter what they are if he says at the time when the purchaser proposes to buy, or the person to take a licence, 'Mind, I only give you this licence on this condition,' and the purchaser is free to take it or leave it as he likes. If he takes it he must be bound by

Restrictions may be placed on purchaser of a patented article; and breach of restrictions is an infringement.

(*f*) Thomas *v.* Hunt, (1864) 17 C. B. N. S. 183.
(*g*) Smith *v.* Buchanan, (1882) 26 S. J. 347.
(*h*) (1895) 12 R. P. C. 262.

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the conditions. It seems to be common sense, and not to depend upon any patent law, or any other particular law."

Authority to construct does not necessarily imply permission to use a patented article.

Upon the same principle it does not follow that authority from the patentee to construct an article necessarily implies permission to use the article when constructed.(*i*) A person may be at one and the same time both a licensee and an infringer—*e.g.*, he may be a licensee in respect of articles actually paid for, but an infringer in respect of articles not paid for.(*k*)

Use for a purpose analogous to the purpose specified by the patentee.

When a patentee draws his specification and claims for his invention chiefly with reference to an application of it to a particular purpose, a person who uses the invention cannot escape the consequences of infringement if he uses it in an analogous manner though for a purpose different to that mentioned by the patentee; provided, of course, that the patentee has not distinctly limited his claim to the use of the invention for the first purpose. Thus, where the invention consisted in the adaptation of a machine (which was not subject-matter in itself) to the manufacture of cement for decorative purposes, an analogous adaptation of the machine to the manufacture of concrete blocks for street paving was held to be an infringement.(*l*) So, generally to adopt a combination of machinery, which originally was directed to one purpose, to make it minister to another and additional purpose is an infringement of the patent which first introduced that combination, provided there is no invention involved in the adaptation.(*m*)

Claim may be limited to use for one particular purpose.

But where the patentee distinctly limits his claim it is not infringed by a user outside the limitation. Thus, where a patentee distinctly limited his claim to the use of his invention to a process for making manure by chemically treating sewage-water with hydrate of lime, the claim was not infringed by a person who used the process for purifying water only, and did not sell or use any of the precipitated manure.(*n*) A claim for the use of a thing for one purpose is not infringed by the use of the thing for a totally different purpose, requiring different variations in the details of the use of the thing in question.(*o*)

Use for a purpose totally different to the purpose specified.

(*i*) Basset *v.* Gradon, (1897) 14 R. P. C. 701.

(*k*) Tweedale *v.* Howard and Bullough, (1896) 13 R. P. C. 529, 531.

(*l*) Adamant Stone Paving Co. *v.* The Corporation of Liverpool, (1896) 14 R. P. C. 11, 21.

(*m*) Cannington *v.* Nuttall, (1871) L. R. 5 E. & I. App. Cas. 205, 230.

(*n*) Higgs *v.* Goodwin, (1858) E. B. & E. 529; 27 L. J. Q. B. 421; see also Morewood *v.* Tupper, (1885) 3 C. L. R. 718; Lister *v.* Eastwood, (1864) 9 L. T. N. S. 766.

(*o*) Preston *v.* Black, (1894) 11 R. P. C. 299, 574; Fletcher *v.* Glasgow Gas Commissioners, (1887) 4 R. P. C. 386: Edison *v.* Holland, (1888) 5 R. P. C. 482.

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The use of an article which will amount to an infringement of a patent for its production may be either active or passive;(*p*) and the mere possession of an article made in infringement of a patent, if there is an evident intention to use it, is sufficient to entitle the patentee to an injunction.(*q*)

Possession may amount to an infringement.

Thus, an injunction was granted to restrain the master of a ship from using an invention for pumps, although he denied having used any pumps which were an infringement of the patent, and did not suggest that the owners ought to be parties. It was shown in evidence that the ship was fitted up exclusively with pumps which were an infringement of the patent, but had been so fitted up before the defendant, who was not a part owner, had command of her, and that he had nothing to do with putting them on board, and they had never been worked in British waters. The majority of the Court of Appeal held that the defendant, being in command of a ship exclusively fitted with pumps which were an infringement of the patent, was intending to use the invention.(*r*)

And where certain defendants, a telephone company, contracted with an American agent for the purchase of a number of telephones, and were supplied accordingly with instruments containing *Blake* transmitters, the subject of both English and American patents, which they kept unused in a warehouse, the Court held that they had infringed the English patent, notwithstanding that they had dismantled the telephones by taking out the *Blake* transmitters, and kept the different parts stored separately.(*s*)

Breach of contract is no justification for an infringement.

It is no answer to the charge of infringement for the defendant to say that he committed the acts complained of because the plaintiff failed to carry out an agreement whereby the plaintiff undertook to supply him with articles made according to the patent.(*t*)

Use of a patented invention in a foreign vessel within the jurisdiction of the British Courts.

The use of an invention for the purpose of the navigation of a foreign vessel within the jurisdiction of any of her Majesty's Courts in the United Kingdom or the Isle of Man is no infringement in respect of which the patentee can obtain

(*p*) Caldwell *v.* Vauvlissenger, (1851) 9 Hare 415; Betts *v.* Neilson, (1868) 3 De G. J. & S. 82.

(*q*) Adair *v.* Young, (1879) L. R. 12 Ch. D. 13; Proctor *v.* Bayley, (1889) 6 R. P. C. 106; United Telephone Co. *v.* London and Globe Telephone and Maintenance Co., (1884) 1 R. P. C. 117; L. R. 26 Ch. D. 766.

(*r*) Adair *v.* Young, (1879) L. R. 12 Ch. D. 13.

(*s*) United Telephone Co. *v.* London and Globe Telephone and Maintenance Co., (1884) 1 R. P. C. 117; L. R. 26 Ch. D. 766.

(*t*) United Telephone Co. *v.* Tasker, (1888) 5 R. P. C. 628.

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an injunction.(*u*) Neither is the use of any other invention in a foreign vessel within the jurisdiction of the same Courts, provided it is not used therein for or in connection with the manufacture or preparation of anything intended to be sold in, or exported from, the United Kingdom or the Isle of Man.(*x*)

The above provisions do not extend to vessels of any foreign State of which the laws authorise subjects of such foreign States, having patents or like privileges for the exclusive use or exercise of inventions within its territories, to prevent or interfere with the use of such inventions in British vessels while in the ports of such foreign State, or in the waters within the jurisdiction of its Court, where such inventions are not so used for the manufacture or preparation of anything intended to be sold in or exported from the territories of such foreign State.(*y*)

Transhipment of goods may be an infringement.

Transhipment in this country of goods made according to a British patented invention may be such a use as will amount to an infringement of the British patent. Thus, in *Betts* v. *Neilson*,(*z*) which was an action brought for the infringement of an *English* patent for the manufacture of a combined metal to be (amongst other purposes) applied as capsules to put on bottles, the House of Lords held that the defendant, who resided in *Scotland*, and purchased capsules, made according to the patent, from a foreign manufacturer, and *in Scotland* put them on beer bottles, which he sent to *England* for *transhipment and exportation*, was, by the user of the capsules whilst the beer remained in England, guilty of an infringement of the patent, and this notwithstanding that there was no evidence to show that the beer was sold in England for consumption there.

But in *Vavasseur* v. *Krupp*,(*a*) where it appeared that certain shells made in Germany for the Mikado of Japan, according to an *English* patent, were brought to this country to be placed on board a ship belonging to the Mikado, it was held that the Court could not interfere to prevent him removing the shells. The ground of this decision was that the Court had no jurisdiction to interfere with the property of a foreign Sovereign ; otherwise foreigners are subject to the laws of the country in which they happen to be, and if a foreigner in England infringes an English patent he may be restrained by the injunction of the Court.(*b*)

(*u*) 46 & 47 Vict. c. 57, s. 43, sub-s. 1.
(*x*) *Ibid.*
(*y*) 46 & 47 Vict. c. 57, s. 43, sub-s. 2.
(*z*) (1871) L. R. 5 H. L. 1.
(*a*) (1870) L. R. 9 Ch. D. 351.
(*b*) Caldwell *v.* Van Vlissingen, (1851) 9 Hare, 415 ; 21 L. J. N. S. Ch. 97.

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Custom House agents.

A person who is merely the Custom House agent of the actual importer is not responsible for infringements. Thus, in *Nobel's Explosives Co.* v. *Jones, Scott & Co.*(*c*) it appeared that the plaintiffs were the owners of an English patent for an invention for rendering nitro-glycerine less dangerous, and that certain foreigners imported into England an article compounded of nitro-glycerine and other substances, which they had manufactured abroad according to the patent, and the respondents, acting as Custom House agents for the importers, passed the article through the Custom House, and obtained permission (*d*) to land and store it in magazines belonging to the importers. The House of Lords held, affirming the decision of the Court of Appeal, that the respondents being only Custom House agents for the importers and not themselves the importers and having neither possession of nor control over the goods, their acts did not amount to an exercise or use of the patent, and that no action could be maintained against them for infringement.

Unauthorised use of an invention prior to the sealing of a patent.

Every patent is dated and sealed as of the day of the application, but no proceedings can be taken in respect of an infringement committed before the publication of the complete specification;(*e*) and after the acceptance of a complete specification until the date of sealing a patent in respect thereof, or the expiration of the time for sealing, an applicant has the like privileges and rights as if a patent for the invention had been sealed on the date of the acceptance of the complete specification, but he is not entitled to institute any proceedings for infringement unless and until a patent has been granted to him.(*f*) Consequently, until the patent is actually granted, no proceedings in respect of infringements can be taken at all, nor even then, in respect of any committed before the publication of the complete specification,(*g*) but in an action brought subsequently to the grant of the patent relief may be obtained in respect of infringements committed during the interval between the publication of the complete specification and the actual date of the grant as well as in respect of infringements committed since the grant.

Infringement committed in the interval

If a patentee brings an action for infringement against any member of the public, it is open to the defendant to give evidence showing that the patent is invalid; (*h*) and, if the

(*c*) (1882) L. R. 8 App. Cas. 5.
(*d*) As required by the Explosives Act, 1875.
(*e*) 46 & 47 Vict. c. 57, s. 13.
(*f*) *Ibid.* s. 15. (*g*) *Ibid.* s. 10.
(*h*) p. 517 *post.*

Proceedings before Action.

between a decision adverse to the validity of the patent and its reversal on appeal.

Court be of opinion that such is the case, a declaration of invalidity will be the result; also it is open to any member of the public, either of right or on obtaining the sanction of the Attorney-General in England or Ireland, or the Lord Advocate in Scotland, to obtain a declaration of invalidity on presentation of a petition to the Court.(*i*) The patentee has the right to appeal to the Court of Appeal and the House of Lords from the decision of the Court of First Instance declaring the patent void either in an action for infringement or upon a petition for revocation, and the adverse decision may be reversed. It is submitted that any act done by a member of the public during the interval between a decision of the Court of First Instance adverse to the patent and its reversal on appeal, which would be an infringement had the patent not been declared void, is, in fact, an infringement which entitles the patentee to damages or an account, because the decision of the Court of Appeal or House of Lords, as the case may be, gives validity to the patent *ab initio*; but it is further submitted that if the defendant could show that what he did was done in reliance on the former decision the plaintiff would only be entitled to nominal damages.(*k*)

Threatened infringements.

A patentee can sustain an action in respect of a threatened infringement of his patent, even though no actual infringement has taken place, for if a person threatens to do an act amounting to an infringement it is sufficient to found an action for an injunction.(*l*) The mere offer, however, to supply an article for the production of which there is an existent patent, which does not lay claim to the production of every kind of such article, in the absence of evidence of positive infringement, is not sufficient to support an application for an injunction.(*m*)

Proceedings before Commencement of Action.

Proper course for a patentee to pursue on discovering several infringers.

When a patentee becomes aware of the fact that several persons are infringing his patent he is in a somewhat awkward position, for he cannot join all the infringers as defendants in one action,(*n*) and, if he issues separate writs simultaneously against all the infringers, he will have to uphold the validity

(*i*) p. 391 *ante*.

(*k*) Arkwright *v.* Nightingale, (1785) 1 W. P. C. 60; Deeley *v.* Perkes, (1896) 13 R. P. C. 587.

(*l*) Frearson *v.* Loe, (1878) L. R. 9 Ch. D. 48, 66; Dowling *v.* Billington, (1890) 7 R. P. C 191; Shoe Machinery Co. *v.* Cutlan, (1895) 12 R. P. C. 357; Incandescent Gas Light Co. *v.* De Mare Incandescent Gas Light System, (1896) 13 R. P. C. 301, 559; Incandescent Gas Light Co. *v.* Sunlight Incandescent Gas Lamp Co., (1896) 13 R. P. C. 333; p. 516 *post*.

(*m*) Gynne *v.* Drysdale, (1885) 2 R. P. C. 160; 3 R. P. C. 65.

(*n*) pp. 509, 510 *post*.

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of his patent in several distinct proceedings, in each of which he may have to meet different objections, and further he may be guilty of the charge of oppressive litigation. On the other hand, if he singles out one infringer and establishes his patent against him first, as regards the others they are not bound by the decision in the first action, and may raise the question of validity anew, and the conduct of the plaintiff may be construed by the Court to amount to laches, and so disentitle him to interlocutory injunctions against the other infringers, to which, having previously established the validity of the patent, he would have been entitled had he commenced action against them earlier.(*o*) In such a state of circumstances the proper course for a patentee to pursue is that suggested by Lord *Hatherley*, then Vice-Chancellor *Page-Wood*,(*p*) viz., after getting information of case after case of infringement to select that which he thinks the best, in order to try the question fairly, and proceed in that case to obtain his interlocutory injunction. At the same time, he should write to all the others who are *in simili casu*, and say to them: "Are you willing to take this as a notice to you that the present case is to determine yours? Otherwise I shall proceed against you by way of interlocutory injunction, and if you will not object on the ground of delay, I do not mean to file bills against all of you at once. Am I to understand that you make no objection of that kind? If you do not object I shall file a bill against only one of you."

Usual course before commencing an action for infringement.

It is usual and proper for a patentee, before commencing proceedings in respect of an infringement of the patent, to apply to the alleged infringer, warning him not to continue the acts complained of, and asking him voluntarily to afford the relief which, in the event of the patentee bringing an action and succeeding, he would claim from the Court, though he is by no means bound to do so, and is entitled to commence his action without making any such demand.(*q*) Neither is he bound to rely on the infringer's promise not to repeat the wrongful act, but he is entitled to the injunction of the Court in aid of his legal rights,(*r*) though, if his conduct is oppressive,

(*o*) p. 542 *post*.

(*p*) Bovill *v.* Crate, (1865) L. R. 1 Eq. 391; see also North British Rubber Co. *v.* Gormully and Jeffery Manufacturing Co., (1894) 12 R. P. C. 21.

(*q*) Upmann *v.* Elkan, (1871) L. R. 12 Eq. 146; Upmann *v.* Forester, (1883) L. R. 24 Ch. D. 231; Burgess *v.* Hills, (1859) 26 Beav. 244, 247; Burgess *v.* Hately, (1859) 26 Beav. 249.

(*r*) Losh *v.* Hague, (1837) 1 W. P. C. 200; Geary *v.* Norton, (1846) 1 De G. & S. 9; Nunn *v.* D'Albuquerque, (1865) 34 Beav. 595; Upmann *v.* Forester, (1883) L. R. 24 C. D. 231; Nicols *v.* Pitman, (1884) L. R. 26 Ch. D. 374; Wittmann *v.* Oppenheim, (1884) L. R. 27 Ch. D. 260; Fradella *v.* Weller, (1831) 2 Russ. & My. 247; Procter *v.* Bayley, (1889) 6 R. P. C. 106.

Proceedings before Action.

he may lose the costs of the action.(*s*) The Court does not, as a rule, take notice of negotiations between the parties preliminary to the issue of the writ, unless they amount to an accord and satisfaction, or release and binding agreement in relation to the cause of action, or the proceedings are tainted with a lack of good faith.(*t*)

Patentee though successful in the action may be disentitled to an injunction or costs.

Consequently though a patentee has an undoubted right of action against an infringer who infringes, whether in ignorance of the patent or not, it does not follow, as a matter of course, that he will in all cases succeed in obtaining an injunction or costs of the action.(*u*).

Thus, where a defendant unknowingly sold a few articles in infringement of a patent, but gave the plaintiff full information as to where he had obtained the articles complained of, and promised not to sell any more, a Bill for an injunction was dismissed, and he was left to his remedy in damages.(*x*)

In another case, where it appeared that the plaintiff had obtained possession of certain instruments admitted to be made in infringement of his patent, but that the defendant had never intended to sell them, and relied on an undertaking for their return, the action was dismissed with costs, but an order was refused for the return of the instruments to the defendant.

And in a case tried in Scotland, where the facts were that the defendant admitted infringement before the action, but had discontinued and offered to pay damages in respect of such infringement, and the action was brought in respect of a different article which was not an infringement, the Court refused an interdict, and, notwithstanding the previous admitted infringement, condemned the plaintiff in the costs of the action.(*y*)

And when it appeared that there had been only one infringement, which had been discontinued, the Court of Appeal held that in the absence of any evidence of the defendant's intention to continue the unlawful act an injunction should be refused.(*z*)

(*s*) Nunn *v.* D Albuquerque, (1865) 34 Beav. 595; Hudson *v.* Bennett, (1866) 14 W. R. 911; Smith *v.* Roberts, (1888) 5 R. P. C. 611; p. 613 *post.*

(*t*) Edelston *v.* Edelston, (1863) 1 De G. J. & S. 203; Davenport *v.* Rylands, (1865) L. R. 1 Eq. 305.

(*u*) pp. 593, 612 *post.*

(*x*) Betts *v.* Willmott, (1870) 16 W. R. 1 Eq. 305; see also Upmann *v.* Elkan, (1871) L. R. 12 Eq. 145; Thornton *v.* Baker, (1886) 3 Times Rep. 715.

(*y*) Fletcher *v.* Glasgow Gas Commissioners, (1887) 4 R. P. C. 386.

(*z*) Procter *v.* Bayley, (1889) 6 R. P. C. 538.

Parties.

All persons interested in a patent should be made parties to an action for infringement, either as co-plaintiffs or, if they refuse to join, as defendants, especially if an account is claimed instead of damages, in order that the infringing defendants may not be called upon to account twice, first to the plaintiff and then to the other defendants who claim an interest.(*a*) If the patent is the separate estate of a married woman she is capable of suing alone.(*b*) The owner of a distinct and severable part of a grant can sue alone.(*c*) And a co-owner can do so, if the defendant does not object.(*d*) A defendant who means to object should do so without delay.(*e*)

All parties interested should be before the Court.

Assignees have the same rights to sue as the original patentee had,(*f*) whether they are assignees by direct assignment or act and operation of law—*e.g.*, trustee in bankruptcy or his assignee (*g*)—or whether they are co-owners.(*h*)

Assignee.

An assignee's title should be registered, but registration is not always a condition precedent to the right to sue.(*i*)

A trustee may sue alone, as also a *cestui que trust*.(*k*)

Trustee and *cestui que trust*.

The mortgagor of a patent is entitled to sue in respect of an infringement in his own name without joining the mortgagee as plaintiff, and the mortgagee does not possess such an interest in the patent as to make it necessary that he should be joined as a defendant.(*l*)

Mortgagor.

The mere agent of a foreign patentee cannot, in his own name, maintain an action of infringement.(*m*)

Agent.

It is provided by the Supreme Court Rules of 1883(*n*) that no cause or matter shall be defeated by reason of the misjoinder or nonjoinder of parties, and the Court may in every cause or matter deal with the matter in controversy so far as regards the rights and interest of the parties actually before

Misjoinder of parties.

(*a*) Westhead *v.* Keene, (1838) 1 Beav. 287, 295; Bergman *v.* MacMillan, (1881) L. R. 17 Ch. D. 423; Hindmarch on Patents, p. 308.

(*b*) See Savage *v.* Harris, (1896) 13 R. P. C. 375, as to the usual order as to costs when an action brought by a married woman is unsuccessful.

(*c*) Dunnicliffe *v.* Mallet, (1859) 7 C. B. N. S. 209; 29 L. J. C. P. 70.

(*d*) Davenport *v.* Richards, (1860) 3 L. T. N. S. 503.

(*e*) Sheehan *v.* G. E. Ry. Co., (1880) L. R. 16 Ch. D. 59.

(*f*) Boulton *v.* Bull, (1795) 2 H. Bl. 464; Electric Telegraph Co. *v.* Brett, (1851) 10 C. B. 838; Walton *v.* Lavater, (1860) 8 C. B. N. S. 162; p. 361 *ante*.

(*g*) Bloxam *v.* Elsee, (1827) 6 B. & C. 169.

(*h*) Anderson *v.* Patent Oxonite Co., (1886) 3 R. P. C. 279.

(*i*) See p. 365 *ante;* also Stewart *v.* Casey, (1891) 8 R. P. C. 259.

(*k*) p. 365 *ante*.

(*l*) Van Gelder Apsimon and Co., Ld. *v.* The Sowerby Bridge Flour Society, Ld., (1890) 7 R. P. C. 208.

(*m*) Adams *v.* North British Railway Co., (1873) 29 L. T. N. S. 367.

(*n*) R. S. C. (1883) Ord. xvi. r. 11.

Parties.

it, and the Court or a Judge may, at any stage of the proceedings, either upon or without the application of either party, and on such terms as may appear to the Court or a Judge to be just, order that the names of any parties improperly joined, whether as plaintiffs or as defendants, be struck out, and that the names of any parties, whether plaintiffs or defendants, who ought to have been joined, or whose presence before the Court may be necessary in order to enable the Court to effectually and completely adjudicate upon and settle all the questions involved in the cause or matter, be added.

The above rule does not authorise the amendment of the pleadings by allowing a plaintiff who has no right to sue to amend by joining as co-plaintiff a person who has a right to sue.(*o*)

In a case where it appeared that the plaintiff's rights had during the progress of the trial been transferred to a company, leave was given to add the company as plaintiffs, but the right was reserved to the defendant, if he thought fit, to have the trial postponed, although the fact of the transfer was known to him when he put in his statement of defence; (*p*) but where the defence was that the defendant had not infringed before the assignment of the patent to the plaintiff, leave, at the trial, was refused to add as co-plaintiffs the predecessors in title of the plaintiff;(*q*) as likewise was an order for leave to add as defendants the assignees of the defendants where it appeared that the assignment had been made pending the action.(*r*)

Any person who infringes or takes part in the infringement of a patent may be made a defendant to an action, and held responsible for his acts, whether he be a principal or an agent; and it is no justification for a servant to say that his master ordered him to commit the infringement; (*s*) nor can the master avoid liability for the acts of his workmen and servants by saying that he gave them directions not to violate the patent, for the principal is always responsible for the acts of his agent which are not done in excess of his authority.(*t*)

Any person who infringes or takes part in an infringement may be made a defendant.

(*o*) Walcott *v.* Lyons, (1884) L. R. 29 Ch. D. 584; Van Gelder, Apsimon and Co. *v.* The Sowerby Bridge Flour Society, Ld., (1890) 7 R. P. C. 41, 45; but see 7 R. P. C. 208.

(*p*) Ruston *v.* Tobin, (1878) 49 L. J. Ch. 262.

(*q*) Nobel's Explosives Co. *v.* Jones, (1880) 42 L. T. N. S. 754.

(*r*) Briggs *v.* Lardeur, (1885) 2 R. P. C. 13.

(*s*) Betts *v.* De Vitre, (1865) 11 Jur. N. S. 11; Adair *v.* Young, (1879) L. R. 12 Ch. D. 19; Betts *v.* Neilson, (1868) 6 N. R. 221; Denley *v.* Blore, (1851) 38 Lond. Jour. 224.

(*t*) Sykes *v.* Howarth, (1878) L. R. 12 Ch. D. 826; Betts *v.* De Vitre, (1873) L. R. 3 Ch. App. Cas. 429; Gregory *v.* Piper, (1829) 9 B. & C. 591; Whatman *v.* Pearson, (1868) L. R. 3 C. P. 422; Sharrod *v.* London and North-Western Ry. Co., (1849) 4 Exch. 580, 587; Gordon *v.* Rolte, (1849) 4 Exch. 365; Lyons *v.* Martin, (1838) 8 A. & E. 512; 3 N. & P. 509.

Though one individual partner in a firm may have a right to manufacture and sell under a patent, the firm may have no such right, as, according to the circumstances, the firm may be contractors for and not mere agents of the patentee and so properly made defendants.(*u*)

Parties.

Firm as distinct from a partner.

The directors of a company may be made personally liable, both in damages and costs of the action, for infringements carried out under their direction by the workmen employed by the company.(*x*) Of course the company could be made a defendant also.

Directors of a company.

Foreigners resident in Great Britain or the Isle of Man are responsible for any infringement of a British patent, just as they are for the infraction of any British law, and they may be made defendants to infringement actions.(*y*)

Foreigners.

The usual form in which injunctions are granted against infringers restrains the defendant, his servants, agents, or workmen from continuing the acts complained of.(*z*)

In cases where a plaintiff succeeds in obtaining a verdict against both a manufacturer and a person who uses an article made in infringement of his patent, he is entitled not only to an account against the former, but also to damages against the latter.(*a*)

Manufacturers and persons who have purchased from them may be made defendants to the same action or sued separately.

Manufacturers and persons who have purchased from them may be sued as defendants in the same action;(*b*) though if the manufacturer or user be sued alone, the other cannot claim to be joined as a defendant against the wish of the plaintiff. It is not the case of attacking a principal through his agent or the improper selection of a member of a class.(*c*)

Further, if a foreign manufacturer is not also an importer, he is not liable to the jurisdiction of the Courts in this country, and is not an infringer.(*d*) Thus, a foreign manufacturer who delivers goods abroad—*e.g.*, by means of the post—to a person who imports them into this country—*e.g.*, by his agent, the

Foreign manufacturer.

(*u*) Howard *v.* Tweedale, (1895) 12 R. P. C. 519.

(*x*) A.-G. *v.* Vestry of Bermondsey, (1883) L. R. 23 Ch. D. 60; Mathias *v.* Yates, (1882) 46 L. T. N. S. 497; Betts *v.* De Vitre, (1865) 11 Jur. N. S. 9; L. R. 3 Ch. App. Cas. 441; Spencer *v.* The Ancoats Rubber Co., (1889) 6 R. P. C. 46.

(*y*) Caldwell *v.* Van Vlissengen, (1851) 21 L. J. N. S. Ch. 97; 9 Hare, 415; Vavasseur *v.* Krupp, (1870) L. R. 9 Ch. D. 351.

(*z*) Seton, p. 352.

(*a*) Penn *v.* Bibby, (1866) L. R. 3 Eq. 308; 36 L. J. Ch. 277; United Telephone Co. *v.* Walker, (1887) 4 R. P. C. 67.

(*b*) Proctor *v.* Bennis, (1887) 4 R. P. C. 333; L. R. 36 Ch. D. 740; United Telephone Co. *v.* Walker, (1887) 4 R. P. C. 67.

(*c*) Moser *v.* Marsden, (1892) 9 R. P. C. 214.

(*d*) Badische Anilin und Soda Fabrik *v.* Johnson, (1897) 14 R. P. C. 919, 405, 211.

Parties.

post—is no infringer; but a foreign manufacturer who contracts for and makes delivery in this country—*e.g.*, by the post or other carrier—would be an infringer.(*c*)

Consignees of goods shipped from abroad are proper defendants.

When goods are made in infringement of an English patent, and shipped from abroad, the consignees are proper defendants in an action, and where they were resident out of the jurisdiction of the Court leave was given to serve the writ out of the jurisdiction.(*f*)

When separate actions must be brought against separate infringers.

In other cases of separate infringements of the same patent by different persons separate actions must be brought against each individually;(*g*) though where one person has infringed several patents belonging to the plaintiff he may be sued in respect of all the infringements in one action.(*h*) A plaintiff who brings several actions against the same defendant in respect of infringements of several patents will probably be allowed only the costs to which he would have been entitled had he included all the infringements in one action.(*i*)

Person who has indemnified the defendant may be allowed to take part in the action.

In an action for infringement against a person to whom an indemnity had been given by the manufacturers, and where such person gave notice under the third party procedure(*k*) claiming indemnity, and the manufacturers put in an appearance, it was held that the proper order to be made was that, on the manufacturers admitting their liability to indemnify the defendants, they should be at liberty to appear at the trial and take such part therein as the Judge should direct, and that they should be bound by the decision of the Court in the action on any question as to the above indemnity as might arise between them and the defendants, but not further or otherwise.(*l*) The Court of Appeal held that no injunction could be granted against such manufacturers brought in under the third party rules, as they were not made defendants, and leave to amend was refused, but they were ordered to pay the costs of the action.(*m*)

(*e*) Badische Anilin und Soda Fabrik *v.* Johnson, (1897) 14 R. P. C. 919, 405, 211.

(*f*) The Washburn and Moca Manufacturing Co. *v.* The Cunard Steamship Co., (1889) 6 R. P. C. 398; Massey *v.* Haynes, (1888) L. R. 21 Q. B. D. 330.

(*g*) Dilly *v.* Doig, (1794) 2 Ves. 486.

(*h*) Lister *v.* Wood, Seton, 3rd ed. p. 909.

(*i*) United Telephone Co. *v.* Sharples, (1885) 2 R. P. C. 28.

(*k*) R. S. C. 1883, Ord. xvi. r. 48.

(*l*) Edison *v.* Holland, (1886) 3 R. P. C. 397.

(*m*) Edison *v.* Holland, (1889) 6 R. P. C. 243.

Pleadings.

Usual pleadings.

The usual pleadings in an action for the infringement of a patent, after service of the writ with regard to which there is nothing special in patent actions,(*n*) are a statement of claim, particulars of breaches, a statement of defence, particulars of objections, and reply. Further pleadings are not usual in actions of infringement of patent rights, but, if they are required, the practice as to them is regulated by R. S. C. Order xxiii.

Trial without pleadings.

Where the parties to a cause or matter are agreed as to the questions of fact to be decided between them they may, after writ issued and before judgment, by consent and order of the Court or a Judge, proceed to the trial of any such questions of fact without formal pleadings.(*o*)

If the parties to a patent action adopt this course, it is submitted, they will not be exempted from the necessity of delivering particulars of breaches and particulars of objections, but these will be required, as was the case where issues were directed under the old practice by the Court of Chancery.(*p*)

The same rules apply to the service of the writ in patent actions as in other actions.(*q*)

Statement of Claim.

Allegation of grant and title.

In the statement of claim the patentee should allege the grant of the patent, and if his title is a derivative one it should be clearly stated.

Not necessary to allege novelty,

It is not necessary to allege that the invention was new at the date of the patent, since the allegation of the grant and the production of the letters patent themselves throws on the defendant the *onus* of disputing the novelty.(*r*)

or validity,

It is common to state in the statement of claim that the letters patent are, and since the grant thereof always have been, valid and subsisting, but this is not necessary, and the allegation is not contained in the form given in the Appendix to the Supreme Court Rules, 1883.(*s*)

(*n*) For forms of indorsement of the writ, see Appendix.

(*o*) R. S. C. 1883, Ord. xxxiv. r. 9.

(*p*) Order in Davenport *v.* Jephson, Seton, p. 346; Bovill *v.* Smith, (1867) W. N. 1867, p. 240; 46 & 47 Vict. c. 57, s. 29; pp. 512, 527 *post.*

(*q*) R. S. C.

(*r*) Amory *v.* Brown, (1869) L. R. 8 Eq. 654.

(*s*) R. S. C. 1883, Appendix C Form 6.

Particulars of Breaches.

or to set out the specifications.

It is not necessary to set out in the statement of claim either the whole or any portion of the specifications,(*t*) though this was usually done in bills in Chancery under the old practice.

Disclaimers should be alleged.

If any disclaimer has been entered at the Patent Office, this fact, with the date, should be alleged in the statement of claim.

Sufficient case to justify the relief asked for must be stated.

The statement of claim must state a sufficient case to justify the injunction asked;(*u*) and must not set out a separate and different cause of action to that endorsed on the writ.(*x*)

Particulars of Breaches.

Particulars of breaches are necessary.

The allegation of infringement in the statement of claim need only be in general terms, for it is specially enacted that the plaintiff must deliver with his statement of claim, or by order of the Court or a Judge at any subsequent time, particulars of the breaches complained of;(*y*) and at the hearing no evidence can, except by the leave of the Court or a Judge, be admitted in proof of any alleged infringement of which particulars have not been given.(*z*) Thus, when the particulars of breaches only alleged infringement by user and not by manufacture, the Court at the trial refused to consider the question whether there had been infringement by manufacturing the articles complained of.(*a*)

Amendment of particulars of breaches.

The Court or a Judge has power from time to time to grant leave to amend particulars.(*b*) And further and better particulars may be ordered at the instigation of either party, even though the action has actually been put down for trial and notice of trial given.(*c*) Though the Court of Appeal is not a "Court or Judge" within the meaning of sec. 29 of the Act of 1883, yet, when there is an appeal, it has, if not an inherent power, at any rate a special power, under R. S. C. 1883, Ord. 58, r. 4, to allow an amendment of the particulars of breaches or objections so as to admit further evidence.

(*t*) Kay *v.* Marshall, (1836) 2 W. P. C. 39; Westhead *v.* Keene, 1 Beav. 287; S. C. R. 1883, Appendix C, Form 6.

(*u*) Curtis *v.* Cutts, (1839) 8 L. J. N. S. Ch. 184.

(*x*) United Telephone Co. *v.* Tasker (2), (1889) 6 R. P. C. 38.

(*y*) 46 & 47 Vict. c. 57, s. 29, sub-s. 1. For forms of particulars of breaches see p. 785 *post*.

(*z*) 46 & 47 Vict. c. 57, s. 29, sub-s. 4.

(*a*) Hensee *v.* Hardie, (1894) 11 R. P. C. 421.

(*b*) 46 & 47 Vict. c. 57, s. 29, sub-s. 5.

(*c*) Mandelberg *v.* Morley, (1893) 10 R. P. C. 256.

Particulars of Breaches.

This power is purely discretionary, and the Court of Appeal is loath to exercise it, and only does so in special cases.(*d*)

Any party desiring an amendment of the particulars of breaches or objections in an action for infringement must satisfy the Court that he is really placed in a difficulty by the particulars as they stand.(*e*)

Where, on a motion for further and better particulars, it appeared that the plaintiff had stated that he was unable to give further particulars till he had obtained discovery from the defendant, the motion was ordered to stand over till after the defendant had given discovery.(*f*)

Particulars must be reasonable and proper.

The plaintiff must take care that the particulars which he furnishes are reasonable and proper ones, otherwise he will fail to obtain the certificate of the Court or a Judge, which is necessary to entitle him to the costs of such particulars on taxation.(*g*)

Sufficient if, with the pleadings, they give the defendant notice of the case to be made against him.

Particulars of breaches are sufficient if, taken together with the pleadings, they give the defendant fair notice of the case to be made against him.(*h*) The object of particulars is not to disclose evidence, but to tell the case to be made at the trial,(*i*) and the office of particulars of breaches is to tell the defendant what the plaintiff says he has done in infringement, and it is not the office of particulars to answer an interrogatory as to the construction of the patent.(*k*)

Thus, where the pleadings stated that the defendant's machine included a certain new and important combination which was the plaintiff's invention, and the particulars of breaches simply pointed to certain specified machines, and stated in general terms that these infringed the patent, they were held to be sufficient, in spite of the contention that the plaintiffs ought to specify precisely in what respect the defendant's machines were an infringement.(*l*) Again, where the particulars of breaches specified a particular article as an infringement, the Court, being of opinion that the defendant must know whether and in what respect he had infringed, refused to compel the plaintiff to specify the persons with respect to whom, and the

(*d*) Shoe Machinery Co. *v.* Cutlan, (1895) 12 R. P. C. 530.

(*e*) Haslam *v.* Hall, (1887) 4 R. P. C. 203, 207, per Wills, J.

(*f*) Russell *v.* Hatfield, (1885) 2 R. P. C. 144.

(*g*) 46 & 47 Vict. c. 57, s. 29 (6).

(*h*) Needham *v.* Oxley, (1863) 1 H. & M. 248; Petman *v.* Bull, (1886) 3 R. P. C. 390; S. C. reported in Ledgard *v.* Bull, L. R. 11 App. Cas. 648; Cheetham *v.* Oldham (3), (1888) 5 R. P. C. 624.

(*i*) Mandelberg *v.* Morley, (1893) 10 R. P. C. 260.

(*k*) Wenham Co. *v.* Champion Gas Co., (1891) 8 R. P. C. 22; Cassella *v.* Levenstein, (1891) 8 R. P. C. 473.

(*l*) Needham *v.* Oxley, (1863) 1 H. & M. 248.

Particulars of Breaches.

occasions on which, the infringement occurred, or to order him to point out the particular parts of the specification alleged to have been infringed.(*m*) And where the alleged infringement, which is not a complicated structure, is an exhibit in the case, it has been held not to be necessary that the particulars of breaches should point out the precise portion of the specification alleged to have been infringed.(*n*)

Must state how the patent has been infringed.

Where, however, a specification describes two processes wholly distinct from each other, and the defendant's process is capable of being an infringement of the one, but not of the other, particulars of breaches in general terms would not be sufficient.(*o*) And if the specification contain a description of a number of articles, all of which are the subject of the invention, the particulars must point out which part of the specification has been infringed.(*p*)

Thus, where the specification contained a description of thirteen different sorts of pens, the plaintiff was ordered to point out specifically which particular pens shown in the drawing he alleged to have been infringed.(*q*)

A user may require fuller particulars than a manufacturer.

It is to be noticed that when the alleged infringer is a user and not a manufacturer the particulars of breaches must be fuller than would be necessary if he were a manufacturer. When the alleged infringer is a manufacturer he knows what the process he uses is, but if the alleged infringer is a user or vendor only he may be dependent for his knowledge of the process used upon the statement of the actual manufacturer. The plaintiff might dispute the manufacturer's statement, and contend that some other process mentioned in the specification had been used. Hence the necessity in such a case of giving the user or vendor full notice of which of the plaintiff's processes it will at the trial be contended have in fact been used.(*r*)

Must specify which claims have been infringed,

The defendant is entitled to a statement in the particulars of breaches as to which one or more of several claims in the specification he is charged with having infringed;(*s*) but it is sufficient if the particulars refer to pages and lines of

(*m*) Talbot *v.* La Roche, (1854) 15 C. B. 310; see also Moseley *v.* Victoria Rubber Co., (1886) 3 R. P. C. 351.

(*n*) Batley *v.* Kynock (2), (1874) L. R. 19 Eq. 229; Needham *v.* Oxley, (1863) 1 H. & M. 248; Perry *v.* Mitchell, (1840) 1 W. P. C. 269.

(*o*) Talbot *v.* La Roche, (1854) 15 C. B. 310; Patent Type Founding Co. *v.* Richards, (1860) 2 L. T. N. S. 359.

(*p*) Perry *v.* Mitchell, (1840) 1 W. P. C. 269; Patent Type Founding Co. *v.* Richards, (1860) 2 L. T. N. S. 359;

(*q*) Perry *v.* Mitchell, (1840) 1 W. P. C. 269.

(*r*) Mandelberg *v.* Morley, (1893) 10 R. P. C. 260.

(*s*) Haslam *v.* Hall, (1887) 4 R. P. C. 203.

the specification without direct mention of the claiming clauses.(*t*)

Particulars of Breaches.

Provided the particulars of breaches give the defendant a fair idea of the case to be made against him, they will be sufficient if they refer to specific claims, and specify certain machines of the defendant as infringements of those claims, and it is not necessary that they should state by reference to pages and lines what portion of the specification has been infringed;(*u*) neither can the plaintiff be compelled to put a construction on his claims or specification in the particulars of breaches;(*x*) though if the invention is a complicated one, or the defendant has any other sufficient grounds for requiring the information in the preparation of his defence, the plaintiff may be compelled to furnish particulars of pages and lines of the specification alleged to have been infringed.(*y*)

if necessary, by reference to pages and lines of the specification.

The particulars of breaches must not merely refer in general terms to acts of the defendant, but must specify definite instances of infringements committed by him, and give at any rate the date of some of the various occasions when the infringements took place, and the names and addresses of the persons (if any) concerned as buyers, &c.(*z*)

Specific instances and dates of some infringements must be given, but certain general words may be added.

Thus, in an action for infringement, where the particulars of breaches alleged that the defendants had infringed by importing into this country, selling, exposing for sale, and otherwise dealing with glass globes, shades, and moons, having their surfaces wholly or in part roughened in a particular way, the Judge expressed an opinion that the plaintiffs ought to give two or three specific instances of globes which they alleged to be infringements, but ought to be at liberty to add general words so as not to be confined to such instances at the trial, and his Lordship accordingly made an order for further and better particulars.(*a*)

In *Walter C. Church Engineering Co.* v. *Wilson*,(*b*) the words "in particular and by way of illustration" were held

(*t*) Elsey *v.* Butler, (1884) 1 R. P. C. 189.

(*u*) Walter C. Church Engineering Co. *v.* Wilson, (1886) 3 R. P. C. 123: Electric Telegraph Co. *v.* Nott, (1847) 4 C. B. 462; Talbot *v.* La Roche, (1854) 15 C. B. 310; Batley *v.* Kynock (2), (1875) L. R. 19 Eq. 229; Cheetham *v.* Oldham (3), (1888) 5 R. P. C. 624.

(*x*) Cassella *v.* Levinstein, (1891) 8 R. P. C. 473.

(*y*) Lamb *v.* Nottingham Manufacturing Co., cited L. R. 19 Eq. 230; Wren *v.* Weild, (1869) L. R. 4 Q. B. 213; Jones *v.* Lee, 25 L. J. Ex. 241.

(*z*) Murray *v.* Clayton, (1872) L. R. 15 Eq. 115; Crossley *v.* Tomey, (1876) L. R. 2 Ch. D. 533; Sykes *v.* Howarth, (1878) L. R. 12 Ch. D. 826; *cf.* Flower *v.* Lloyd, (1876) 45 L. J. Ch. 746; 25 W. R. 17.

(*a*) Tilghman's Patent Sand Blast Co., Limited *v.* Wright and Butler Co., Limited, (1884) 1 R. P. C. 103; see also Talbot *v.* La Roche, (1854) 15 C. B. 310.

(*b*) (1886) 3 R. P. C. 123.

Particulars of Breaches.

to be too wide; but, on the other hand, in *Haslam* v. *Hall*,(c) where the particulars of breaches, "*by way of example and not of limitation*," alleged certain machines fitted by the defendants on board the "*Selembria*," and "*all machines made by the defendants similar to them*," to be infringements of the plaintiff's patent, the words in italics were allowed to remain, but the plaintiff was confined, so far as concerned machines fitted to ships, to the "*Selembria*," unless he gave further names.

Particulars of actual infringements are necessary, and evidence is limited by them, unless the action is solely based on threats to infringe.

Though a threatened infringement may be restrained,(d) an injunction will not be granted where the action is only framed in respect of, and fails as to *specific* infringements alleged to have been committed prior to the action, and the plaintiff seeks to give evidence of acts of a different nature committed after action as infringements, unless the pleadings are, by leave of the Court on terms, amended so as to include threatened infringements; in which case the subsequent real infringements may be evidence of intention prior to action brought to infringe, otherwise evidence of subsequent infringements will not be admitted at all.(e)

The patentee may bring two distinct kinds of action—the one based on the fact that the defendant has infringed before action brought, and the other based on the fact that the defendant threatens and intends to infringe. These two grounds of action may be combined in one action, but they are quite distinct in themselves. In the first case the plaintiff is entitled to claim damages or an account, and an injunction to prevent similar infringements in the future. In the second case the plaintiff may claim an injunction to restrain the threatened infringement. In so far as the action is based on infringement before action brought the plaintiff is bound to give particulars of breaches, and by statute no evidence can, except by leave of the Court or a Judge, be given, at the hearing, of any breaches other than those stated in the particulars. Of course, in so far as the action is based on threats to infringe no particulars of breaches can be given, but care is always taken that the defendant shall have fair notice as to the nature and particulars of the special infringement he is alleged to be contemplating.(f) *Shoe Machinery Co.* v. *Cutlan* (g) was on the

(c) (1887) 4 R. P. C. 203.
(d) p. 504 *ante*.
(e) The Shoe Machinery Co. *v.* Cutlan, (1895) 12 R. P. C. 342.
(f) Shoe Machinery Co. *v.* Cutlan, (1895) 12 R. P. C. 357.
(g) (1895) 12 R. P. C. 342.

pleadings an action of the first class referred to above. The plaintiff was obliged to admit that the acts done before action brought were in fact not infringements, but he sought to contend that acts done after action brought were different in nature and infringements. The Judge refused on the pleadings (no amendment of which was asked for) to admit evidence of such latter Acts. These latter acts were of such a nature that they would probably have been admissible as evidence of a threat or intention to infringe prior to action brought, if an amendment of the pleadings necessary to include threatened infringement had been asked for. *Frearson* v. *Loe* (*h*) was a case of the second class, and an injunction was granted to restrain the threatened infringements, evidence of which was on the pleadings clearly admissible. *Dowling* v. *Billington*,(*i*) on the other hand, though in form an action of the first class, was treated by the Judge as one of the second class, and under the peculiar circumstances of that case evidence of infringement committed after action brought was admitted. The peculiarity of the case was that the alleged infringements committed before action brought were technically not infringements at all, since the complete specification had not then been accepted. The articles made after action brought were admitted in evidence to be the same in kind as those made before, and since the action was brought in respect of that kind of article the Judge must be taken to have admitted the evidence of infringement after action, on the principle that the defendant had on the pleadings fair notice that the plaintiff would contend at the trial that the future manufacture of such articles would be an infringement and that he claimed an injunction to restrain such future manufacture.

Defence.

Defence.

By way of defence (*k*) it is open to the defendant to defeat an action for infringement of a patent by proving either that he has not committed any infringement, supposing the patent to be a valid one, or that the patent is in fact non-existent or void, and that the acts complained of are consequently no violation of any right vested in the plaintiff.(*l*)

Two main defences.

It is not a valid defence to say that the defendant committed the infringement because the plaintiff failed to carry out

Breach of contract by the plaintiff

(*h*) (1878) L. R. 9 Ch. D. 48. (*i*) (1890) 7 R. P. C. 191.
(*k*) For forms of defence see p. 787 *post*.
(*l*) Dudgeon *v.* Thomson, (1877) L. R. 3 App. Cas. 37.

Defence.

is not a valid defence.

an agreement whereby he undertook to supply the defendant with a certain number of the patented machines; but, in such a case, the injunction of the Court restraining further infringements will only be granted on the terms that the plaintiff undertakes to supply the defendant with a certain limited number of machines in the place of those which the injunction would prevent him from using.(*m*) Moreover, the defendant is at liberty to counterclaim for damages consequent on the breach of the agreement.(*n*)

All grounds of defence should be stated.

The defendant should state in his defence the grounds on which he relies, if he disputes the validity of the patent or alleges that the acts complained of were authorised by the plaintiff, for he cannot at the trial bring forward any ground of defence which is not stated in his pleadings.(*o*) He must also be careful that his pleas are not embarrassing, otherwise they may be ordered to be struck out at the instigation of the plaintiff.(*p*)

An order has been made that a defendant should, upon an issue as to the sufficiency of the specification, be at liberty to dispute the utility of the alleged invention, although he had not raised the general issue as to utility.(*q*)

Particulars do not stand in the place of pleas.

Particulars of objections do not stand in the place of pleas,(*r*) and they cannot go outside the pleas,(*s*) though they must give more detailed information,(*t*) and not be merely reiterations.(*u*) The Court has refused to allow a defendant to contend that the patent was illegal when it appeared that he had only given notice of an objection to that effect, and not specially pleaded it.(*x*)

Short form of defence.

It is submitted that any objection to the validity of a patent will be properly raised if the defence contains a simple denial of the validity of the patent, "on the grounds stated in the particulars of objection delivered herewith";(*y*) but it is advisable that the grounds of objection should appear on the defence itself.

(*m*) United Telephone Co. *v.* Tasker, (1888) 5 R. R. C. 628.

(*n*) Heald *v.* Incandescent Gas Light Co., (1893) 10 R. P. C. 165.

(*o*) Bovill *v.* Goodier (2), (1866) L. R. 2 Eq. 195; see R. S. C., (1883) Appendix D.

(*p*) R. S. C. Ord. 19, r. 27; Ashworth *v.* Law, (1887) 7 R. P. C. 231.

(*q*) Plimpton *v.* Malcolmson, (1876) L. R. 3 Ch. D. 531, 536.

(*r*) p. 528 *post*.

(*s*) Macnamara *v.* Halse, (1842) 2 W. P. C. 128; Jones *v.* Berger, (1843) 1 W. P. C. 544.

(*t*) Bulnois *v.* Mackenzie, (1837) 1 W. P. C. 260; Jones *v.* Berger, (1843) 1 W. P. C. 544; Walton *v.* Bateman, (1842) 1 W. P. C. 616.

(*u*) Neilson *v.* Harford, (1841) 1 W. P. C. 370; Betts *v.* Walker, (1850) L. R. 14 Q. B. 363, 368; Walton *v.* Bateman, (1842) 1 W. P. C. 268 n.

(*x*) Gillet *v.* Wilby, (1839) 1 W. P. C. 270.

(*y*) See order in Kurtz *v.* Spence, (1887) 36 Ch. D. 776.

Defence.

The defendant may deny infringement and plead also that the acts complained of were done by the leave and licence of the patentee.(*z*) It is further open to him to plead the invalidity of the patent on any one or more of the following grounds:—

Grounds on which invalidity may be pleaded.

i. The grantee was not the true and first inventor.(*a*)
ii. The alleged invention is not the proper subject-matter of a patent.(*b*)
iii. The invention is not useful.(*c*)
iv. The invention is not new.(*d*)
v. The specifications are insufficient.(*e*)
vi. There is some disconformity between the specifications.(*f*)
vii. The letters patent have lapsed previously to the committal of the acts complained of, in consequence of the non-payment of fees, or the period of their duration having expired.(*g*)
viii. Any ground on which the patent might, at the commencement of the Patents, Designs, and Trade Marks Act, 1883, have been repealed by *scire facias*,(*h*) *i.e.*:

a. Letters patent of earlier date than those forming the subject of the action have been granted in respect of the same invention.(*i*)
b. The letters patent were granted on a false suggestion.(*k*)
c. The grant of the letters patent was not lawful.(*l*)
d. Non-compliance on the part of the patentee with the conditions of the letters patent.
e. Failure of the essential requisites of novelty or utility.
f. Abuse of the privileges granted by the letters patent.

Not subject-matter.

The objection that the invention is not the proper subject-matter of a patent cannot be taken under a plea that the invention is not new,(*m*) or under a plea of insufficiency of the specification.(*n*)

(*z*) Hensee *v.* Hardie, (1874) 11 R. P. C. 421; Guyot *v.* Thompson, (1894) L. R. 3 Ch. 388; 11 R. P. C. 541.
(*a*) Chap. i. *ante.*
(*b*) Chap. ii. *ante.*
(*c*) Chap. iv. *ante.*
(*d*) Chap. iii. *ante.*
(*e*) Chap. v. *ante.* (*f*) *Ibid.*
(*g*) p. 332 *ante.*
(*h*) 46 & 47 Vict. c. 57, s. 26.
(*i*) Chap. iii. *ante.*
(*k*) *Ibid.*
(*l*) Chap. ii. *ante.*
(*m*) Walton *v.* Potter, (1841) 1 W. P. C. 597; Household Co. *v.* Neilson, 1 W. P. C. 677.
(*n*) 21 Jac. I. c. 3, s. 6; Household Co. *v.* Neilson. (1843) 1 W. P. C. 677; Jupe *v.* Pratt, (1837) 1 W. P. C. 151; Walton *v.* Potter, (1841) 1 W. P. C. 597.

Defence.

Not useful.

As we have seen,(*o*) the requirement of utility does not arise from any express words in the Statute of Monopolies, but is an inference to be drawn from the Common Law and the enactment that the monopoly granted must not be "mischievous to the State, or to the hurt of trade, or generally inconvenient."(*p*) Though it may be thought that the proper form of plea is to plead the statute, and not merely the want of utility, the practice at Common Law, which was adopted by the Court of Chancery,(*q*) *viz.*, to deny the utility in general terms, is that usually followed.(*r*) The defence of want of utility cannot be raised under a plea that the invention is not a new manufacture if the plaintiff objects.(*s*)

If the specification describes different modes of carrying out the invention, which vary in utility, though all are to some extent useful, this fact cannot be made a valid ground of defence.(*t*)

Not new.

The issue of novelty is quite distinct from that of true and first inventor,(*u*) for an invention may be a new manufacture within the Statute of Monopolies(*x*) but the patentee may not be the true and first inventor, in which case the patent would be void. The defendant is consequently entitled to have the question of newness of manufacture tried apart from that of newness of invention; (*y*) and a plea that the invention is not the proper subject-matter of letters patent does not raise the issue of novelty.(*z*)

In *Walton* v. *Potter* (*a*) it was pleaded that the invention was not a "new manufacture," and the Court held that this plea admitted the invention to be a "manufacture" within the meaning of the statute, and only put in issue the novelty. On the other hand, in *Spilsbury* v. *Clough* (*b*) it was held that a plea that the invention was not a "new manufacture" was bad, as it left it doubtful whether the objection was that the invention was not new, or that it was not a manufacture within the statute. But neither of these cases are to be considered as good law on the subject, for in *Bush* v. *Fox* (*c*) the House of Lords held that a plea to the effect that an invention is not a

(*o*) p. 125 *ante*.
(*p*) Morgan *v.* Seaward, (1837) 1 W. P. C. 197; 21 Jac. I. c. 3, s. 6.
(*q*) Seton, 4th Ed. p. 347; Plimpton *v.* Malcolmson, (1876) L. R. 3 Ch. D. 531, 536.
(*r*) Hindmarch on Patents, p. 275.
(*s*) Walton *v.* Bateman, (1842) 1 W. P. C. 623.
(*t*) Miller *v.* Searle, (1893) 10 R. P. C. 106.
(*u*) Household Co. *v.* Neilson, (1843) 1 W. P. C. 689.
(*x*) 21 Jac. I. c. 3.
(*y*) Spencer *v.* Jack, (1862) 3 De G. J. & S. 346; 11 L. T. N. S. 242; Household Co. *v.* Neilson, (1843) 1 W. P. C. 689.
(*z*) Booth *v.* Kennard, (1856) 1 H. & N. 527.
(*a*) (1841) 1 W. P. C. 601, 611.
(*b*) (1842) 1 W. P. C. 255.
(*c*) (1856) Macr. P. C. 179.

"new manufacture" puts in issue both the novelty of the invention and its being a manufacture; and in *Spencer* v. *Jack* (*d*) the Lords Justices, on appeal, ordered the questions of newness of invention and newness of manufacture to be tried separately. Defence.

Under the practice prior to the Act of 1883, insufficiency of the specification was one of the most frequent objections raised in patent actions. The reason of this was that formerly the letters patent contained a condition requiring the patentee within a stated period to file a specification ascertaining the nature of the invention, and in what manner the same was to be performed, under pain of forfeiting the grant altogether.(*c*) Insufficiency of specification.

The form of letters patent at present in use does not contain any condition (though it might do so) (*f*) avoiding the grant, if the specification, which is filed previously to the grant, is insufficient. As, however, insufficiency of the specification was a ground on which the repeal of a patent might at the commencement of the Act of 1883 have been obtained by *scire facias*, as being a failure to comply with one of the conditions of the grant,(*g*) it is still a ground of defence to an action for infringement under the present practice.(*h*)

It was formerly a ground for a *scire facias* to deceive the Crown by obtaining a patent by means of a false representation,(*i*) and, it is submitted, the Crown is deceived if there is a material difference between the provisional and complete specification; the patent must in such a case have been obtained in respect of an invention which was not foreshadowed in the provisional specification;(*k*) and the objection that there is disconformity is consequently a good defence to the validity of a patent.(*l*) Moreover, it may be said that the complete specification does not particularly describe and ascertain the nature of the invention, if it departs from the terms of the title or of the provisional specification, in which the nature of the invention must be described. It would consequently appear that evidence of a defect in the title and disconformity between the specification may be tendered under a plea of insufficiency.(*m*) Disconformity.

The Court will at any time during the progress of an action Fresh issues

(*d*) (1864) 3 De G. J. & S. 346; 11 L. T. N. S. 242.

(*e*) Arkwright *v.* Nightingale, (1785) 1 W. P. C. 61.

(*f*) 46 & 47 Vict. c. 57, s. 33.

(*g*) p. 394 *ante*.

(*h*) 46 & 47 Vict. c. 57, s. 26, sub-s. 3.

(*i*) R. *v.* Arkwright, (1785) 1 W. P. C. 66.

(*k*) Curtis *v.* Platt, (1863) Griff. L. O. C. 53.

(*l*) 46 & 47 Vict. c. 57, s. 26, sub.-s. 3; see also p. 394 *ante*.

(*m*) Penn *v.* Bibby, (1866) L. R. 2 Ch. App. 127, 130; but see Derosne *v.* Fairie, (1835) 1 W. P. C. 161; Neilson *v.* Harford, (1841) 1 W. P. C. 312; Morgan *v.* Fuller (1), (1866) R. R. 2 Eq. 297.

Defence during the progress of the action.

for infringement allow the defendant to raise a fresh issue on the discovery of facts which could not with due diligence have been discovered before.(*n*) Thus, in one case, the plaintiff having altered his case from that originally set up, the defendant was at the trial allowed to amend his defence by adding a plea of want of subject-matter.(*o*) In another case, where the defendant at the trial asked for leave to amend his defence by adding a plea of invalidity on the ground of variance between the title and the claims, the Court refused to grant the leave, on the ground that it was asked for too late.(*p*)

Decision in a prior action.

Estoppel.—The fact that a patent has been questioned and upheld in a former action does not estop a person questioning it again in a subsequent action, when the parties to the second action are not the same as the parties to the first; and, though the plaintiff in both actions is the same, the Court trying the second action is not bound by the decision in the former in favour of the plaintiff, for its operation is not *mutual* as between the parties to the second action,(*q*) and the evidence in the second action may be different to that in the former—*e.g.*, a prior user relied on as an anticipation may fail to defeat the patent from want of evidence in the first action, but be completely successful in view of further evidence adduced in the second action.(*r*) In second actions, however, the Court usually considers itself bound by the interpretation put on the specification by a Court of equal or superior jurisdiction in the first action when the facts as to prior knowledge are the same; (*s*) though, if the specification has to be reconstrued in the light of fresh facts as to prior knowledge, the Court would most probably not consider itself so bound.(*t*)

The fact that the patentee has been defeated in a prior action cannot be pleaded successfully as a bar to a subsequent action,(*u*) unless the patent was declared invalid in the prior action and the parties are the same when the matter is *res judicata*,(*x*) for until the patent is revoked, or lapsed by

(*n*) Holste *v.* Robertson, (1876) L. R. 4 Ch. D. 9; S. C. R. 1883, Order xxviii.; p. 591 *post*.

(*o*) Crosthwaite *v.* Moorwood, (1894) 11 R. P. C. 558.

(*p*) Shrewsbury and Talbot S. T. Cab and Noiseless Tyre Co. *v.* Morgan, (1896) 13 R. P. C. 75.

(*q*) Taylor on Evidence, 5th ed., vol. ii. p. 1444; Shedden *v.* A.-G., (1860) 30 L. J. N. S. Pr. & Mat. 217.

(*r*) Shaw *v.* Day, (1894) 11 R. P. C. 185.

(*s*) Edison *v.* Holland, (1888) 5 R. P. C. 459; 6 R. P. C. 243; Slazenger *v.* Feltham, (1889) 6 R. P. C. 130; Automatic Weighing Machine Co. *v.* Combined Weighing Machine Co., (1889) 6 R. P. C. 367.

(*t*) p. 253 *ante*.

(*u*) Arkwright *v.* Nightingale, (1785) Dar. P. C. 52.

(*x*) Horrocks *v.* Stubbs, (1895) 12 R. P. C. 540; 13 R. P. C. 69; Shoe Machinery Co. *v.* Cutlan (2), (1896) 13 R. P. C. 141.

effluxion of time, a right is presumed to be in the patentee, and his remedy for an infringement of such right is by action on the patent. When the question of validity has been fought out to judgment, and a separate finding has been come to on the point, the matter is *res judicata* between the parties, and cannot be raised again in any fresh action between the same parties. It cannot be raised afresh even if the defendant is prepared with fresh objections as to validity which were not before the Court on the former occasion. When the question of validity is brought to trial it is the duty of the defendant to put his whole case before the Court, and if he does not do so it is his fault or misfortune. In other words, he cannot be permitted to bring his case as to validity piecemeal before the Court in a series of actions.(*y*) He could, however, after action, petition for the revocation of the patent.(*z*)

Defence.

Estoppel.

When in the prior action the question of validity has been decided against the patentee, this fact may be pleaded by the defendant in the second action, on the ground that the matter is already *res judicata* between the parties.

In one case where the patentee was defeated on the validity of the patent on several grounds, including disconformity, and he then amended the specification, but did not remove the portions which affected the question of disconformity, and then commenced a fresh action, the Court of first instance held that the subject of the action was *res judicata*, and dismissed the action. On appeal, the Court of Appeal, without deciding whether the matter was *res judicata*, held that the true interpretation of a certain agreement between the parties was that the decision on the question of disconformity should be final between them, and dismissed the action on that ground.(*a*)

When, however, the portions of the specification which affected the question of validity in a prior action have been entirely removed by amendment before the commencement of a subsequent action, the decision in the former action cannot, of course, be pleaded by the defendant as an estoppel against the plaintiff in the subsequent action.(*b*)

Specification amended after prior adverse decision.

A defendant who has once submitted to an injunction is estopped in a second action, or, on being attacked for a second infringement, from either directly or indirectly raising argu-

(*y*) Shoe Machinery Co. *v.* Cutlan (2), (1896) 13 R. P. C. 141.
(*z*) p. 401 *ante*.
(*a*) Horrocks *v.* Stubbs, (1895) 12 R. P. C. 540; 13 R. P. C. 69.
(*b*) Deeley's Patent, (1894) 11 R. P. C. 76.

Defence.

Estoppel.

ments against the validity of the patent.(*c*) On the other hand, where a defendant has, prior to action brought, stated—not in litigation *inter parties*—in howsoever a definite manner, that he has infringed, this fact does not raise any sort of estoppel against him in an action brought for the infringement of the patent. The question of infringement is one which must in such circumstances be determined quite apart from the defendant's previous statements, excepting in so far as they may affect his credibility as a witness of truth or as an expert.(*d*)

Defendant a licensee.

The defendant in an action for infringement may in consequence of his relationship to the plaintiff be estopped from denying the validity of the patent, *e.g.*, where he is a licensee under a license granted by deed which contains a recital implying the validity of the patent;(*e*) for, the contract being by deed, the failure of the consideration is immaterial, and it is not competent to a defendant by plea to deny the effect of a deed which he has executed.(*f*) The incapacity of a licensee to deny the validity of a patent against the licensor terminates with the termination of the licence, and he is then in exactly the same position as any other member of the public against whom an action of infringement may be brought.(*g*) A revocable licence may be determined by due notice, and thus a licensee may, by proper notice given before action brought, determine the licence, and so turn himself from a licensee into a wrongdoer, and become entitled to dispute the validity of the patent in an action of infringement brought against him by his former licensor;(*h*) but a plea in a defence to the effect that the licence has been determined will not operate as a due notice of determination.(*i*)

Defendant an assignor.

Persons, other than licensees, may in consequence of their past conduct be estopped from denying the validity of the patent as against the plaintiff. Thus, a patentee who has assigned his patent is estopped from denying its validity in an action for infringement brought by the assignee.(*k*)

(*c*) Moor *v.* Thomson, (1890) 7 R. P. C. 327.

(*d*) Osborne *v.* Board, (1896) 13 R. P. C. 748.

(*e*) Bowman *v.* Taylor, (1834) 2 A. & E. 278; 1 W. P. C. 292; Cutler *v.* Bower, (1848) 11 Q. B. 973; see p. 379 *ante*.

(*f*) Smith *v.* Scott, (1859) 6 C. B. N. S. 771; 5 Jur. N. S. 1358; Hall *v.* Conder, (1857) 2 C. B. N. S. 22.

(*g*) Dangerfield *v.* Jones, (1865) 13 L. T. N. S. 142; Axman *v.* Lund, (1874) L. R. 18 Eq. 330; Crossley *v.* Dixon, (1863) 10 H. L. C. 293.

(*h*) pp. 381, 382 *ante*.

(*i*) *Ibid.*

(*k*) Oldham *v.* Longmead, (1789) cited 3 T. R. 441; Walton *v.* Lavater, (1860) 8 C. B. N. S. 162, 187; Heugh *v.* Chamberlain, (1877) 25 W. R. 742; but see pp. 354, 355 *ante*.

Defence.

Estoppel.

Although it is a sound principle of law that a grantor cannot derogate from his grant, yet the language of a specification must not be strained against an assignor who happens to be the original patentee and defendant in an action of infringement brought by the assignee;(*l*) and he is at liberty to show that the specification is not as wide as the plaintiff alleges.(*m*) Moreover, an assignor cannot be restrained from assisting, as a scientific witness or otherwise, the defendant in an action brought by the assignee.(*n*)

Defendant a former partner of the plaintiff.

A patentee who has worked the patent in partnership with his co-patentee, but has dissolved partnership and assigned the whole of his interest in the patent to his former partner, is estopped from denying the validity of the patent in an action of infringement at the instance of such former co-patentee.(*o*) But a person who has worked a patent in partnership with the patentee, and during the partnership asserted its validity against various infringers, but refrained from taking legal proceedings, is not estopped from disputing the patent in an action brought by the patentee after the termination of the partnership.(*p*)

Agreement may operate as an estoppel.

In *Baird* v. *Neilson*(*q*) it appeared that *Baird* had agreed with *Neilson* to put an end to litigation and pay a royalty for the use of *Neilson's* patented invention. Subsequently *Neilson* brought an action against *Baird* for specific performance of the agreement, and *Baird*, in a cross action, sought to deny that what he was doing was an infringement, but the House of Lords held that the very object of the agreement was to put an end to the question of the particular thing done by *Baird* being an infringement, and that he was therefore estopped from setting up the defence.

Where, on an action being brought to enforce an agreement, the defendants gave an undertaking to the patentee not to sell certain grates having a patent canopy, without marking them in an agreed manner, it was held, on a motion to commit them for breach of the agreement, which motion was by consent turned into a motion for an injunction, that they were estopped from denying the validity of the plaintiff's patent.(*r*)

Defendant may

A defendant may be estopped from denying the validity

(*l*) Hocking and Co. *v.* Hocking, (1889) 6 R. P. C. 69.
(*m*) *Ibid.*
(*n*) London and Leicester Hosiery Co., Ld. *v.* Griswold, (1886) 3 R. P. C. 250, 253.
(*o*) Chambers *v.* Crichley, (1864) 33 Beav. 374.
(*p*) Axmann *v.* Lund, (1874) L. R. 18 Eq. 330. (*q*) 8 C. L. & F. 726.
(*r*) Crossthwaite *v.* Steel, (1888) 5 R. P. C. 220.

Defence.

Estoppel.

be estopped from denying validity of the patent on a motion for interlocutory injunction though not at the trial.

of a patent on a motion for an interlocutory injunction, and yet not be so estopped at the trial.

Thus, where in a previous action judgment and costs had been given against the defendants, Lord *Hatherley*, then Vice-Chancellor *Wood*, on the hearing of a suit against the same defendants, for the infringement of the same patent, held that if the plaintiffs had made an interlocutory application they would have been entitled to an injunction till the hearing; but, the question being as to a perpetual injunction, the right of the defendants to deny the validity of the patent was not barred.(*s*) And again, where it appeared that the patentee had formerly worked the patent in partnership with the defendants under an agreement reciting the patent, and during the partnership the defendants had joined the patentee as co-plaintiff in suits against various infringers, the same Judge held that, the partnership having been determined, and the defendants having commenced working the invention without the leave of the patentee, the latter was entitled to an interlocutory injunction against them before establishing the patent at law.(*t*)

Where it appeared that in a previous action tried in Scotland, and decided in favour of the plaintiff, the defendant had omitted to dispute the validity of the patent, he was not allowed to set up this defence on a motion for an interlocutory injunction in England.(*u*) But in an action for the infringement of a patent which had been declared valid in a previous arbitration between the plaintiff and defendant, the Court held that the defendant was not estopped from disputing it at the trial.(*x*)

Assignment by trustee in bankruptcy no estoppel against the patentee.

A bankrupt patentee is not estopped from denying the validity of the patent against a purchaser from his trustee in bankruptcy, if there is nothing to show that the purchaser has bought on the faith of any representation made by the patentee.(*y*)

Estoppel may operate against one only of several defendants.

When there is more than one defendant, an estoppel may affect only one of them.(*z*) Thus, in a case where it appeared that one defendant had, during the existence of a partnership

(*s*) Goucher *v.* Clayton, (1865) 11 Jur. N. S. 107.

(*t*) Muntz *v.* Grenfell, (1842) 2 W. P. C. 88, 91.

(*u*) Dudgeon *v.* Thomson, (1877) 30 L. T. N. S. 244.

(*x*) Newall *v.* Elliott, (1863) 1 H. & C. 797.

(*y*) Cropper *v.* Smith, (1884) L. R. 26 Ch. D. 700, 706; 10 App. Cas. 249; 1 R. P. C. 81; 2 R. P. C. 17.

(*z*) Goucher *v.* Clayton, (1865) 11 Jur. N. S. 107; Heugh *v.* Chamberlain, (1877) 25 W. R. 742.

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between the plaintiff and the defendant, by his acts barred his right to dispute the validity of the patent against the plaintiff, the other defendant, who was not affected by the acts of his co-partner, was not estopped, in an action brought subsequent to the termination of the partnership, from disputing the patent.(*a*) But where two defendants, disputing in the same interest, sever their defence, and one delivers particulars disputing the validity of the patent, but the other omits to do so, the latter is entitled to the benefit of such particulars, if proved,(*b*) provided he is not otherwise estopped from denying the validity of the patent.(*c*)

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Must be delivered with the defence, or by order of the Court or a Judge, at any subsequent time.

It is enacted by the Patents, Designs, and Trade Marks Act, 1883,(*d*) that the defendant in an action for infringement must deliver with his statement of defence, or by order of the Court or a Judge at any subsequent time, particulars of any objections on which he relies in support thereof. And, if he disputes the validity of the patent, the particulars must state on what grounds he disputes it; and, if one of those grounds is want of novelty, they must state the time and place of the previous publication or user alleged by him.

Evidence limited by particulars.

It is also by the same statute (*e*) further enacted that at the hearing of an action for infringement no evidence shall, except by leave of the Court or a Judge, be admitted in proof of any alleged objection of which particulars have not been delivered.

Discretionary power of the Court or a Judge to admit evidence not within the particulars.

The Court only rarely exercises its power of admitting evidence of which particulars have not been delivered—*e.g.*, where not to do so would be to stultify the action of the Court. Thus, where the defendant pleaded that what he did was done under a patent granted to him prior to the plaintiff's patent, and then at the trial tendered evidence not included in the particulars to the effect that he himself had publicly used the very thing claimed by both patents years before the date of either, *Kay*, L.J., ordered an adjournment and granted leave to adduce the defendant's evidence of prior user within a certain time, though he was not asked to do so, and stated

(*a*) Heugh *v.* Chamberlain, (1877) 25 W. R. 742.

(*b*) Cropper *v.* Smith, (1885) L. R. 10 App. Cas. 249.

(*c*) Heugh *v.* Chamberlain, (1877) 25 W. R. 742; Goucher *v.* Clayton, (1865) 11 Jur. N. S. 107.

(*d*) s. 29. As to the disadvantages in giving an unnecessary multiplicity of objections see Allen *v.* Oates, (1898) 15 R. P. C. 303.

(*e*) s. 29, sub.-s. 4.

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that if it were put in he would allow the plaintiff an opportunity of dealing with it, otherwise there would be judgment for the defendant without costs.(*f*)

The discretionary power of the Court to admit evidence not within the particulars is quite independent of its power to allow an amendment of the particulars for the purpose of admitting fresh evidence.(*g*)

As we have seen, particulars of objections do not stand in the place of, and cannot go beyond, the pleas raised by the defence; (*h*) and it is to be noticed that the Act of 1883 requires far more detail in the particulars of objections than in the particulars of breaches complained of by the plaintiff.(*i*)

Amendment of particulars of objections.

It was decided that the notice of objections required by 5 & 6 Will. IV., c. 83, s. 5, to be delivered by a defendant in an action for infringement were not conclusive at his peril, but the Court or a Judge, under their general jurisdiction, as well as under the statute, might order a further and fuller notice.(*k*)

Under the Act of 1883, the Court or a Judge has power to order the amendment from time to time of the plaintiff's or defendant's particulars; (*l*) as also has the Court of Appeal; (*m*) and if they are insufficient or too general, the opposite party, if he means to object to them, should at once apply, by summons at chambers or a motion in Court,(*n*) for an order for further and better particulars; otherwise, where the particulars are too general, evidence within their literal meaning may be admitted.(*o*) In the words of *Mellish*, L.J.: "There is a very large difference between a case where a Judge has been applied to and has ordered further particulars, in order to state an objection more specifically, and a case where at the trial the plaintiff asserts that the defendant ought to be prevented from availing himself of an objection. It is perfectly obvious that if . . . . wherever the Court would order further

(*f*) Hill *v.* Adams, (1893) 10 R. P. C. 102; Solvo Laundry Supply Co. *v.* Mackie, (1893) 10 R. P. C. 68; see also Britain *v.* Hirsch, (1888) 5 R.P.C. 230; Peckover *v.* Rowland, (1893) 10 R. P. C. 118.

(*g*) Britain *v.* Hirsch, (1888) 5 R. P. C. 226; p. 529 *post*.

(*h*) p. 518 *ante*.

(*i*) pp. 512–517 *ante*.

(*k*) Bulnois *v.* Mackenzie, (1837) 1 W. P. C. 260.

(*l*) s. 29 (5).

(*m*) Shoe Machinery Co. *v.* Cutlan, (1895) 12 R. P. C. 530; Britain *v.* Hirsch, (1888) 5 R. P. C. 226; p. 512 *ante*; p. 591 *post*.

(*n*) Judicature Act, 1873, s. 39; Fearson *v.* Loe, (1878) 26 W. R. 138; R. S. C. 1883, Ord. xix. r. 7.

(*o*) Hull *v.* Bollard, (1856) 1 H. & N. 134; Curtis *v.* Platt, (1865) 35 L. J. N. S. Ch. 852, 868; Sugg *v.* Silber, (1876) L. R. 2 Q. B. D. 493.

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particulars because the objection had not been particularly specified, it would also hold that the party was precluded from raising it at the trial, nobody would be foolish enough to apply to a Judge for further particulars." (*p*)

If, however, the defendant delivers his objections fairly and honestly and does his best to give the plaintiff the information he is entitled to, it is not the province of the Court by ordering amendments to tie his hands so tight as to dictate to him in an early stage of the proceedings how exactly he is to frame his case,(*q*) since the object of the particulars is only to prevent surprise, to limit the scope of the inquiry and to prevent expense.

Time for pleading after delivery of particulars.

The party at whose instance particulars are delivered under a Judge's order has, unless the order otherwise provides, the same length of time for pleading after the delivery of the particulars that he had at the return of the summons; and an order for particulars does not, unless the order otherwise provides, operate as a stay of proceedings, or give any extension of time.(*r*)

Costs of further and better particulars.

The party against whom an order for further and better particulars is made may be ordered to pay the costs of the application; (*s*) and if the party against whom the order is made does not comply with it, the proper course is for the other side to apply by summons in chambers to have the insufficient particulars struck out.(*t*)

Fresh particulars cannot be given in compliance with an order for further and better particulars,

A defendant complying with an order for further and better particulars is not entitled to give *fresh* particulars without having obtained leave to amend, and if he does insert them they may be struck out by the plaintiff on summons.(*u*)

but can be given at any time by leave of the Court or a Judge.

It is competent for the defendant at any time during the progress of an infringement action, with the leave of the Court or a Judge (*x*) upon terms,(*y*) to raise a fresh issue on the discovery of facts which could not with due diligence have been discovered before,(*z*) and he will be allowed to amend his par-

(*p*) Sugg *v.* Silber, (1876) L. R. 2 Q. B. D. 495.

(*q*) Nettlefolds *v.* Reynolds, (1891) 8 R. P. C. 417, per Lindley, L.J.; see also Holliday *v.* Hippenstall, (1889) 6 R. P. C. 320.

(*r*) S. C. R. 1883, Ord. xix. r. 8; Boyd *v.* Farrar, (1888) 5 R. P. C. 33, 36.

(*s*) Grover and Baker Sewing Machine Co. *v.* Wilson, W. N. 1870, p. 78; Penn *v.* Bibby, (1866) L. R. 1 Eq. 548.

(*t*) Flower *v.* Lloyd, (1877) 20 S. J. 860; Higgins' Digest, Supplement p 78; Aktiebolagat Separator *v.* Dairy Outfit Co., (1896) 13 R. P. C. 725.

(*u*) Aktiebolagat Separator *v.* Dairy Outfit Co., (1896) 13 R. P. C. 725, 727.

(*x*) 46 & 47 Vict. c. 57, s. 29, sub-s. 5.

(*y*) p. 530 *post*.

(*z*) Holste *v.* Robertson, (1876) L. R. 4 Ch. D. 9; Otte *v.* Steel, (1885) 2 R. P. C. 139.

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ticulars of objections accordingly, though he may be liable for the costs occasioned by any such amendment.(*a*)

The defendant may, even during the progress of the trial, obtain leave on short service of motion to amend his particulars,(*b*) if he can show that the fresh evidence he is desirous of adducing could not with due diligence have been discovered earlier ; (*c*) but if an amendment be made late, though the defendant succeed in the action and the action is dismissed, it may be so dismissed without costs.(*d*)

The Court will not sanction an amendment, if, on the face of it, it appears that the fresh objection cannot be sustained.(*e*)

Particulars on a new trial.

Where a new trial is obtained the defendant is entitled to give particulars of objections which were not raised at the first trial.(*f*)

Terms usually imposed when leave is given to amend particulars of objections.

When leave to amend particulars of objections is given, the Court generally imposes terms, and the usual order, with the object of putting the plaintiff in the same position as he would have been in, if the particulars had originally been delivered in their amended form, gives the plaintiff time within which to to elect whether he will discontinue the action, and orders the defendant, in the event of discontinuance, to pay all costs incurred by the plaintiff since delivery of the original particulars of objections, and only allows the objections to be amended in the event of the plaintiff not electing to discontinue, and makes the cost of the application, and consequent on the amendment, the plaintiff's in any event.(*g*)

The fact that the plaintiff was aware of the existence of the fresh objection which the defendant seeks to raise will not in itself entitle the defendant to an order on any more favourable terms.(*h*)

When the plaintiff, at the hearing of an application by the defendant for leave to amend his particulars, elects to proceed

(*a*) Renard *v.* Levinstein, (1864) 13 W. R. 229 ; 11 L. T. N. S. 505 ; Daw *v.* Eley, (1865) L. R. 1 Eq. 38 ; Blakey *v.* Latham, (1889) 6 R. P. C. 29.

(*b*) *Ibid.*

(*c*) Moss *v.* Malings, (1886) L. R. 33 Ch. D. 603 ; Edison Electric Co. *v.* Sheppey, (1887) 4 R. P. C. 471 ; Blakey *v.* Latham, (1889) 6 R. P. C. 184.

(*d*) Allen *v.* Horton, (1893) 10 R. P. C. 412.

(*e*) Holste *v.* Robertson, (1876) L. R. 4 Ch. D. 9.

(*f*) Bovill *v.* Goodier, (1871) 36 L. J. N. S. Ch. 360.

(*g*) Edison Telephone Co. *v.* India-rubber Co., (1881) L. R. 17 Ch. D. 137 ; Baird *v.* Moule's Earth Closet Co., (1881) L. R. 17 Ch. D. 139 ; Aveling *v.* Maclaren, (1881) L. R. 17 Ch. D. 139 ; Ehrlich *v.* Ihlee, (1887) 4 R. P. C. 115, 119 ; Parker *v.* Maignen's Filtre Rapide Co., (1888) 5 R. P. C. 207 ; Darrar *v.* Purser, (1889) 6 R. P. C. 365 ; Solvo Laundry Supply Co. *v.* Mackie, (1893) 10 R. P. C. 68 ; Badische Anilin und Soda Fabrik *v.* La Société des Usines du Rhône, (1897) 14 R. P. C. 891.

(*h*) Ehrlich *v.* Ihlee, (1887) 4 R. P. C. 115.

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with the action, the order merely provides that the costs of the application, and all costs occasioned by the amendment, and costs unnecessarily caused to the plaintiff by reason of the amendment being made, shall be the plaintiff's in any event.(*i*)

Where a defendant in compliance with an order of the Court had amended his particulars of objections, and made an application for leave to reamend them by inserting further specified instances of alleged prior use which had come to his knowledge, he was ordered to pay the costs of the application, and the costs arising out of, and consequent on, the reamendment were reserved; (*k*) and where a cause was in the paper for hearing, the defendant was, after giving notice to the plaintiff, allowed to give evidence, by affidavit, of prior user discovered after the cause was in the paper, but the terms imposed insured to the plaintiff an opportunity of filing affidavits in answer, and the costs of, and consequent on, the application were reserved.(*l*)

Further evidence on appeal.

On an appeal the Court has power to receive further evidence, and to order an amendment of the particulars of objection for the purpose of admitting it,(*m*) but if the appeal is from a judgment after trial, this evidence, except as to matters subsequent to the judgment, can be admitted only on special grounds (*e.g.*, the party desiring to tender it has found a lost document),(*n*) and not without special leave.(*o*)

An appellant will not be allowed to give further evidence on appeal, unless it can be shown that he could not have tendered the evidence at the hearing in the Court below,(*p*) or that the defendant has been misled,(*q*) though he would be allowed to cure a merely formal defect in his title.(*r*)

Particulars of disconformity, or defective claims are necessary.

A patent may be void on account of the disconformity of the specifications, or in consequence of the claim being defective;(*s*) but, it is submitted, a defendant relying on either of these grounds cannot dispense with the necessity for delivering particulars of objections, for the Court will not undertake to decide as to the disconformity of the specifications or the validity of

(*i*) Parker *v.* Maignen's Filtre Rapide Co., (1888) 5 R. P. C. 208.

(*k*) Penn *v.* Bibby, (1866) L. R. 1 Eq. 548.

(*l*) Wilson *v.* Gann, (1875) W. N. 1875, 78.

(*m*) Cropper *v.* Smith, (1884) 1 R. P. C. 81; 2 R. P. C. 17; Shoe Machinery Co. *v.* Cutlan, (1895) 12 R. P. C. 530.

(*n*) Hinde *v.* Osborne, (1885) 45.

(*o*) R. S. C. 1883; Ord. lviii. r. 4.

(*p*) Hinde *v.* Osborne, (1885) 2 R. P. C. 45; Walker *v.* Hydrocarbon Syndicate, (1886) 3 R. P. C. 253; Blakey *v.* Latham, (1889) 6 R. P. C. 184.

(*q*) American Braided Wire Co. *v.* Thomson, (1888) 5 R. P. C. 113, 118.

(*r*) Nordenfelt *v.* Gardner, (1884) 1 R. P. C. 61, judgment of Lindley, L.J.

(*s*) Chap. v. *ante*.

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the claims without the evidence of witnesses,(*t*) which could not be given unless particulars had been previously delivered.(*u*)

Particulars of objections must be precise and definite.

The particulars of objections must be precise and definite, and should not contain a long list of anticipations, of which only a few are relied on at the trial ;(*x*) but they should give such information as will enable the plaintiff to make the necessary inquiries at any places named.(*y*)

Object of particulars of objections.

The Act of 1835 (*z*) was the first statute which specifically required the delivery of particulars of objections by the defendant to the plaintiff, and this was done, not to limit the defence, but to prevent the patent from being upset by any unexpected turn of the evidence, and to lessen the expense.(*a*) This object is similarly provided for by the Act of 1883.(*b*)

True and first inventor.

The objection that the patentee is not the true and first inventor does not raise the question of novelty generally, but only that the patentee obtained the invention from some one else, and should only be used for this purpose,(*c*) and the name of the person from whom it is alleged the patentee obtained the invention should be stated,(*d*) though this was not so under the old practice prior to the Act of 1883.(*e*)

Subject-matter.

When it is objected that the invention is not subject-matter the reason should be definitely stated. When other objections fail the objection that the invention is not subject-matter can rarely be made out.(*f*)

Prior grant.

Also when an objection is directed to the issue of prior grant it must state distinctly the grounds on which it is alleged that the patentee was not the first grantee.(*g*)

Novelty. Requisite details.

The Act of 1835 did not require any further detail in the defendant's particulars of objections than in the plaintiff's particulars of breaches, but the terms of the subsequent Act of 1852,(*h*) which are very similar to, though not quite so general as, the words of the Act of 1883, which regulates the

(*t*) Arnold *v.* Bradbury, (1871) L. R. 6 Ch. App. 706 ; Longbottom *v.* Shaw, (1889) 6 R. P. C. 510.

(*u*) p. 527 *ante*.

(*x*) Thomson *v.* Batty, (1889) 6 R. P. C. 84.

(*y*) Per Parke, B., Palmer *v.* Cooper, (1853) 9 Exch. 236.

(*z*) 5 & 6 Will. IV. c. 83, s. 5.

(*a*) See remarks of Tindal, C.J., Fisher *v.* Dewick, (1838) 1 W. P. C. 267 ; Curtis *v.* Platt, (1863) 8 L. T. N. S. 657.

(*b*) s. 29, sub-s. 2; Holliday *v.* Heppenstall, (1889) 6 R. P. C. 320; Nettlefolds *v.* Reynolds, (1891) 8 R. P. C. 417.

(*c*) Thomson *v.* Macdonald & Co., (1890) 8 R. P. C. 8; Household Co. *v.* Neilson, (1843) 1 W. P. C. 689.

(*d*) Siddell *v.* Vickers, (1887) 5 R. P. C. 85.

(*e*) Russell *v.* Ledsam, (1843) 11 M. & W. 64.

(*f*) See per Esher, M.R., Edison-Bell Phonograph Corporation *v.* Smith and Young, (1894) 11 R. P. C. 398, ll. 37-52.

(*g*) Rothwell *v.* Macintosh, (1894) 11 R. P. C. 274.

(*h*) 15 & 16 Vict. c. 83, s. 41.

present practice as regards particulars directed to the issue of want of novelty, required that the particulars of objection should state "the place or places at or in which and in what manner the invention is alleged to have been used or published prior to the date of the letters patent."

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Since the Act of 1883 requires greater detail in the particulars of objections than did the Acts of 1835 and 1852, it follows that words which were held to be too general under the latter Acts will be too general under the Act of 1883, which regulates the present practice in patent actions.

Must not be too general.

Particulars of objection will be too indefinite if, for instance, they allege as an anticipation a user by certain persons specified, and "*divers other persons*,"(*i*) or "*by other persons* in London and Birmingham,"(*k*) or "at Nottingham *and elsewhere*,"(*l*) or "*by manufacturers generally* in London *and the vicinity*,"(*m*) and in such cases the words in italics may be ordered to be struck out. The particulars of objection must state whether the whole of the invention is alleged to have been anticipated, or whether a portion only is old,(*n*) and, if the invention deals with complicated machinery or with several distinct machines, the particulars must state which particular machines, or which portion of the invention, has been anticipated.(*o*)

General public knowledge.

The defendant in an action for infringement frequently relies on the invalidity of the patent on the ground that the subject-matter of the alleged invention was matter of general public knowledge before the date of the patentee's application. A defendant who relies on general public knowledge as an objection must be careful not to refer to specific specifications, or other publications, as merely showing the state of general public knowledge, otherwise he may incur the costs of amending his particulars by striking out all such references. It is neither necessary nor proper for him to state in his particulars of objections the books or publications which contain that knowledge, but such general public knowledge should be proved by ordinary evidence, with a reference to well-known books, if necessary.(*p*)

(*i*) Galloway *v.* Bleaden, (1839) 1 W. P. C. 268 n; Fisher *v.* Dewick, (1838) 1 W. P. C. 551 n.

(*k*) Flower *v.* Lloyd, (1877) 20 S. J. 860.

(*l*) Jones *v.* Berger, (1843) 1 W. P. C. 544; Holland *v.* Fox, (1853) 1 C. L. R. 440.

(*m*) Alliance Pure White Lead Syndicate *v.* MacIvor's Patents, (1891) 8 R. P. C. 321; p. 534 *post*.

(*n*) Fisher *v.* Dewick, (1838) 1 W. P. C. 264; Russell *v.* Ledsam, (1843) 11 M. & W. 647.

(*o*) Boyd *v.* Farrar, (1888) 5 R. P. C. 33.

(*p*) Cole *v.* Squire, (1888) 5 R. P. C. 489; Holliday *v.* Heppenstall, (1889) 6 R. P. C. 320; Automatic Weighing Machine Co. *v.* Knight, (1889) 6 R. P. C. 302; Phillips *v.* Ivel Cycle Co., (1890) 7 R. P. C. 77.

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Prior specifications and rare books cannot be referred to under a plea of common knowledge.

Particulars directed to prior general public knowledge—*i.e.*, common knowledge—will not authorise the defendant to give in evidence prior specifications or rare books or users. Such publications must be referred to in separate particulars; and if this is not done the defendant will only be allowed to make the amendment necessary to admit the evidence on the usual terms.(*q*)

Distinction between issue of common knowledge and prior publication.

Common knowledge is really a different issue to prior publication, of which definite particulars must be given. Common knowledge goes to subject-matter and prior publication to novelty; and when common knowledge is pleaded it is not necessary to give particulars of it.(*r*) In framing a particular as to common knowledge care must be taken that it does not include or point to something of which a separate particular should be given, otherwise the plaintiff may be entitled to further and better particulars.(*s*) Thus, when the particular given was to the effect that "the alleged invention was not the subject-matter of valid letters patent, but was the mere analogous use and application to an old and well-known sewing machine of mechanical appliances and arrangements of parts well known and in common use in machines of a similar kind, and used for similar or analogous purposes, prior to the date of the said alleged Letters Patent," it was held not to be merely one of common knowledge, but to point to some particular mechanical appliance used in the machine as having been used previously to the date of the patent, and further and better particulars were ordered accordingly.(*t*)

Objection to general plea of want of novelty.

The general plea that the invention was not new is objectionable, as it may be said to be ambiguous in so far as it may go to general public knowledge or specific prior publications or users, of which detailed particulars are necessary.(*u*)

General user may be stated in general,

It may be that if the defendant relies on and states a general user in general terms—*e.g.*, the invention was previously to the patent in question used by persons engaged in the trade to which it refers, "*generally in London and the vicinity thereof*"—he is perfectly justified in so doing, and does not inflict any

(*q*) Edison Telephone Co. *v.* India Rubber Co., (1881) L. R. 17 Ch. D. 137; Peckover *v.* Rowland, (1893) 10 R. P. C. 118; Solvo Laundry Supply Co. *v.* Mackie, (1893) 10 R. P. C. 68; English and American Machinery Corporation *v.* Union Boot and Shoe Machine Co., (1894) 11 R. P. C. 373; p. 530 *ante*.

(*r*) Holliday *v.* Heppenstall, (1889) 6 R. P. C. 326; Boxwell *v.* Cochran, (1895) 12 R. P. C. 169.

(*s*) Chadburn *v.* Mechan, (1895) 12 R. P. C. 120; Birch *v.* Harrap, (1895) 12 R. P. C. 431.

(*t*) Birch *v.* Harrap, (1895) 12 R. P. C. 431.

(*u*) Singer *v.* Rudge Cycle Co., (1894) 11 R. P. C. 585.

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hardship on the plaintiff, for proof by one person is not sufficient to prove a general user, and the plaintiff in such a case cannot complain of generality of statement, for the more general it is the more the defendant must prove under it.(*x*) In such a case the plaintiff is entitled by means of interrogatories to obtain the names and addresses of such manufacturers, and the places and dates of user.(*y*) An allegation of general public user must not, however, be in too indefinite terms. Thus, in a case in which the defendant's particulars of objections alleged previous user of the invention by "*carriage-builders generally throughout Great Britain*," and also by "*various carriage-builders in or near London, Liverpool, Manchester, and Southampton, and various other of the principal towns of Great Britain*," they were held to be insufficient.(*z*) On the other hand, an application which alleged the general user of an invention by a particular class of persons, consisting of lace makers at Nottingham, has been held to be sufficient.(*a*)

but not too indefinite terms.

The Court will sometimes allow general words such as "amongst others,"(*b*) or "amongst other instances,"(*c*) to remain in the particulars of objections, but it will take care that the plaintiff shall not be taken by surprise at the trial.(*d*)

In one case the defendants by their particulars of objections alleged that the method described by the plaintiff in his specification had been in ordinary and common use for forty years prior to the date of the patent. In further answers to interrogatories they gave a description of the particular method they relied on to support their plea of general user. At the trial, evidence was given of another method which had been used at a large number of places, and which appeared to be a complete anticipation of the plaintiff's invention. The plaintiff objected that no particulars had been given of this, and asked that the case might stand over. *Kay*, J., held that the action must stand over, but at the plaintiff's risk as to costs, and that the defendants (whose witnesses had given many instances of this user) should be allowed to give particulars of further instances. The Judge refused an application to the effect that

(*x*) Palmer *v.* Wagstaff, (1853) 8 Exch. 840; Jones *v.* Berger, (1843) 1 W. P. C. 547; Bentley *v.* Keighley, (1844) 7 M. & G. 652; 8 Scott N. R. 372.

(*y*) Alliance Pure White Lead Syndicate *v.* MacIvor's Patents, Ld., (1891) 8 R. P. C. 321.

(*z*) Morgan *v.* Fuller (2), (1866) L. R. 2 Eq. 297.

(*a*) Jones *v.* Berger, (1843) 1 W. P. C. 549.

(*b*) Curtis *v.* Platt, (1863) 8 L. T. N. S. 657.

(*c*) Penn *v.* Bibby, (1866) L. R. 1 Eq. 548.

(*d*) Curtis *v.* Platt, (1863) 8 L. T. N. S. 657 judgment of Wood, V.C.

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the plaintiff might have a certain time, after the delivery of the fresh particulars, to elect whether he would discontinue the action on paying costs up to the first delivery of particulars, but to get the subsequent costs.(*e*)

Requisites of a particular directed to specific prior users.

Where specific users are relied on the defendant is generally required to state the time and place of such users,(*f*) and to describe the thing alleged to have been used by a definite description, *e.g.*, by use of a *Wenham* lamp will not do, as that might be by any lamp made by *Wenham*.(*g*)

The particulars will be sufficient if they state definitely the kind of article, the prior sale, manufacturer, or user of which it is alleged anticipates the patent, the names of the alleged prior sellers, manufacturers, or users, and the dates.(*h*) The particulars must, however, state the mode in which the alleged prior user anticipates the invention.(*i*)

We have seen that the Act of 1852 required the particulars of objections, if prior user was relied on, to state "the place or places at or in which, and in what manner, the invention was alleged to have been used or published prior to the date of the letters patent;"(*k*) whereas the words of the Act of 1883 are to the effect that if one of the grounds on which the defendant disputes the validity of the patent is want of novelty he "must state the time and place of the previous publication or user alleged by him."(*l*)

In consequence of the similarity between the wording of these two statutes, the cases decided under the former are important, as bearing on the construction which will probably be placed on the latter enactment as occasion requires.

In *Flower* v. *Lloyd* (*m*) the Court of Appeal held that the particulars of objections could not be required to go beyond the words of the Act, and varied the order of the Court below, which required the defendants to state "the names and addresses of the persons by whom, and the places where, and the dates at, and the manner in which" the invention had been publicly

(*e*) Pascall *v.* Toope, (1890) 7 R. P. C. 125.

(*f*) Holliday *v.* Heppenstall, (1889) 6 R. P. C. 320; Boyd *v.* Horrocks, (1886) 3 R. P. C. 281; Automatic Weighing Machine Co. *v.* Knight, (1889) 6 R. P. C. 302; Philips v. Ivel Cycle Co., (1890) 7 R. P. C. 82; Heathfield *v.* Greenway, (1894) 11 R. P. C. 17; Siemens *v.* Karo, (1891) 8 R. P. C. 376.

(*g*) Siemens *v.* Karo, (1891) 8 R. P. C. 376; Palmer *v.* Wagstaffe, (1853) 8 Ex. 840; Boyd *v.* Farrar, (1887) 5 R. P. C. 35; Sidebottom *v.* Fielden, (1891) 8 R. P. C. 272; Alliance Pure White Lead Syndicate *v.* MacIvor, (1891) 8 R. P. C. 321.

(*h*) Sidebottom *v.* Fielden, (1891) 8 R. P. C. 266.

(*i*) Scott *v.* Hull Steam Fishing and Ice Co., (1896) 13 R. P. C. 206.

(*k*) p. 532 *ante*.

(*l*) s. 29 (3).

(*m*) (1877) 46 L. J. Ch. 746; 20 S. J. 860.

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practised in *England* before the date of the patent, by requiring the defendants to state "the place or places at or in which, and in what manner" the invention was known or publicly practised in *England* before the date of the patent. In pursuance of this order, the defendants delivered particulars alleging prior user by three persons, whose names and addresses were given, and by other persons in *Birmingham* and *London* respectively. On summons for better particulars, the Judge held them to be insufficient, and ordered the defendants to give the names and addresses of the other persons in *Birmingham* and *London* by whom the patented process had been previously used, and pointed out that if they could not give further information the words in italics were useless, and ought to be struck out.

It was expressly held that under the Act of 1852 the plaintiff was entitled to the names and addresses (*i.e.*, the present residences) (*n*) of the persons by whom prior user was alleged to have been made, as well as the places where the prior user had taken place;(*o*) and, further, that where the plaintiff or the defendant, as the case might be, made out a proper case, the Court had jurisdiction to order interrogatories to be answered, notwithstanding the provision in the Act for the delivery of particulars.(*p*) And where the defendants objected that there was a prior American patent which had been surrendered; that the invention had been published in certain journals of specified dates, and in sketches and drawings in the Patent Office Library; and also alleged prior user, it was held that better particulars ought to be given, specifying the date, name of patentee, and time of surrender of the alleged American patent, and the pages of the journals, also identifying the drawings, and the order as to prior user ought to be in the terms of *Flower* v. *Lloyd*.(*q*)

Different requisites under Acts of 1852 and 1883 respectively.

It is to be observed that the Act of 1852 required the *place* and *manner*, &c., of prior publication to be stated in the particulars of objection, whereas the Act of 1883 requires a statement of the *time* and *place* of such prior publication. And it has been held that, if a defendant under the latter Act disputes the patent on the ground of want of novelty, he must state reasonably on what ground, in respect of want of novelty, he

(*n*) Palmer *v.* Cooper, (1853) 9 Exch. 236.

(*o*) Birch *v.* Mather, (1883) L. R. 22 Ch. D. 629.

(*p*) *Ibid.*

(*q*) Plimpton *v.* Spiller, (1877) 20 S. J. 859; see p. 536 *ante*.

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disputes it, and he must also state the time and place of the previous publications or user alleged by him.(*r*)

In *Curtis* v. *Platt*,(*s*) the particulars of objection, which were furnished under an order requiring a statement of "the place where, and the earliest date at which," certain alleged anticipating machines had been made, stated a list of thirteen persons and firms, and that, in all the cases, the user had been at the earliest from 1825 downwards; and, in answer to the contention that they ought to state in each instance the place at which the first machine had been made and the date of making, Lord *Hatherley*, then Vice-Chancellor *Wood*, ordered an amendment, on the ground that, as regarded the date of user and the place of user of the machines, the defendants were bound to give the plaintiff all the information they themselves possessed.

The defendants in this case were also ordered to amend an objection alleging prior publication in books, &c., with a mere general reference by stating the particular work or document and the volume of that work in which the alleged prior publication was to be found.(*t*)

Requisites of a particular directed to publication by prior specifications or printed books.

A defendant who relies on prior specifications,(*u*) or printed books,(*x*) must point out, by reference to pages and lines, what portions of such specifications or books he relies on; (*y*) and where particulars of objection stated, with regard to a certain alleged anticipating specification, "the parts relied upon are the whole specification but more particularly" certain specified portions, an order was obtained requiring their amendment by striking out the words denoting reliance on the whole specification, but the defendant was held to be at liberty to specify other pages and lines beyond those already referred to.(*z*) A defendant is entitled to rely on the whole of a specification if necessary, and cannot be forced to point out special parts, unless it appears that no attempt at discrimination has been made.(*a*) When, however, specifications or other publications are relied on, and the whole is stated to be relied on, it is always in the discretion of the Court to see how far the

(*r*) Fowler *v.* Gaul, (1886) 3 R. P. C. 247, 250; Boyd *v.* Horrocks, (1886) 3 R. P. C. 285; Darrah *v.* Purse, (1889) 6 R. P. C. 365.

(*s*) (1863) 8 L. T. N. S. 657.

(*t*) *Ibid.*

(*u*) Fowler *v.* Gaul, (1886) 3 R. P. C. 247.

(*x*) Harris *v.* Rothwell, (1886) 3 R. P. C. 243.

(*y*) See Grover and Baker Sewing Machine Co. *v.* Wilson, W. N., (1870) 78; Fisher *v.* Dewick, (1838) 1 W. P. C. 264; Plimpton *v.* Spiller, Higgins' Supplement, p. 79.

(*z*) Harris *v.* Rothwell, (1886) 3 R. P. C. 243.

(*a*) Sidebottom *v.* Fielden, (1891) 8 R. P. C. 266.

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defendant really does rely on the whole, and to order further particulars if it thinks fit; and each case must be considered on its own merits.(*b*)

A defendant may be required to state in the particulars of objection, by means of a reference to the claiming clauses of the plaintiff's specification, what portion or portions of the invention or inventions, as the case may be, he alleges have been anticipated and published, and he may be compelled to refer to pages and lines of any anticipating documents which he alleges as publications of any of the plaintiff's claims.(*c*) Where a specified machine is relied on, it is not necessary to state which of the plaintiff's claims it infringes, as he must be taken to understand his own patent well enough to be able, when he sees the machine, to judge how far it is or is not an anticipation of his invention.(*d*) And objections which referred to certain specified machines as anticipations of particular claims in the specification were held sufficient, notwithstanding the fact that the owner of some of the machines refused to allow the plaintiff to inspect them, and the defendants were not sure whether some of the others were in existence.(*e*)

Requisites of a particular directed to disconformity.

If a defendant object that there is a disconformity between the specifications, he may be required to state in what the disconformity consists, or how the invention described in the complete differs from that described in the provisional specification.(*f*) So when it was stated that the invention described in the complete specification was different to that described in the provisional specification, and in particular the inventions described in certain pages and lines of the complete were not described in the provisional specification, the particular was held too wide, and the defendant was ordered to limit the alleged variance to the particulars given.(*g*)

Requisites of a particular directed to insufficiency of specification.

If it be objected that the complete specification does not sufficiently describe and ascertain the invention and in what manner the same is to be performed, it is not sufficient for the particulars to state merely that the directions given are not sufficient to enable a workman skilled in the manufacture to

(*b*) Siemens *v.* Karo, (1891) 8 R.P.C. 376.

(*c*) Jones *v.* Berger, (1843) 1 W. P. C. 551 n.

(*d*) London and Leicester Hosiery Co. *v.* Higham, Lawson on Patents, 2nd ed. p. 498; Harris *v.* Rothwell, (1886) 3 R. P. C. 243; Fowler *v.* Gaul, (1886) 3 R. P. C. 247; Boyd *v.* Horrocks, (1886) 3 R. P. C. 285; Boyd *v.* Farrar, 5 R. P. C. 33, 36.

(*e*) Boyd *v.* Farrar, (1888) 5 R. P. C. 33, 35.

(*f*) Anglo-American Brush Electric Light Corporation *v.* Crompton, (1886) L. R. 34 Ch. D. 152; Fisher *v.* Dewick, (1838) 1 W. P. C. 551 n.

(*g*) Heathfield *v.* Greenway, (1894) 11 R. P. C. 17.

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which the patent relates to make a machine the subject of the invention, and if the defendant is in a position to give better particulars he must state in what respect the specification is insufficient.(*h*) But in a case under the Act of 1834 it was held that, if the plaintiff was content to accept as notice an objection that the specification was insufficient, any objection showing insufficiency at the trial might be taken.(*i*)

Also where the objection is that the specification is ambiguous and misleading it is necessary to state definitely in what respect it is alleged to be ambiguous and misleading.(*k*) And where the allegation is that the specification does not distinguish what is new from what is old the particulars must point out in what respect it fails to do this sufficiently.(*l*)

Greater detail is required under Act of 1883 than under the former practice.

The effect of the Act of 1883 and the recent cases is to require far greater detail in the particulars of objections than was formerly necessary, and particulars simply alleging that the specification does not describe the most beneficial method of practising the invention known to the patentee,(*m*) or that it is calculated to deceive,(*n*) or does not sufficiently set forth the nature of the invention,(*o*) or that the invention does not produce the effect stated,(*p*) which were held sufficient under the old practice, would most probably not be held so now.

Objection directed to non-payment of fees.

Under the practice prior to the Act of 1883, a defendant could, at the trial, take the objection that the patent was improperly stamped, without having raised it in the particulars.(*q*) It is, however, submitted that, if a defendant now desires to take the analogous objection that the patent is void for non-payment of duties, the particulars must refer to the fact.

Interlocutory Injunction.

Prima facie case must be established.

If the plaintiff in a patent action, as is usually the case, desires to obtain an interlocutory injunction restraining the

(*h*) Crompton *v.* Anglo-American Brush Corporation, (1886) L. R. 35 Ch. D. 283; Leaf *v.* Topham, (1845) 14 M. & W. 146; Heathfield *v.* Greenway, (1894) 11 R. P. C. 17; Heath *v.* Unwin, 1 W. P. C. 551 n.

(*i*) Neilson *v.* Harford, (1841) 1 W. P. C. 332.

(*k*) Farbenfabriken vorm F. Bayer *v.* Bowker, (1891) 8 R. P. C. 391; Heathfield *v.* Greenway, (1894) 11 R. P. C. 17.

(*l*) Delta Metal *v.* Maxim-Nordenfelt Guns and Ammunition Co., (1891) 8 R. P. C. 170; Thomson *v.* Batty, (1888) 6 R. P. C. 88; Fisher *v.* Dewick, (1838) 1 W. P. C. 551 n; Jones *v.* Berger, (1843) 5 M. & G. 208; Baker *v.* Kinnell, (1893) 9 R. P. C. 443.

(*m*) Jones *v.* Berger, (1843) 5 M. & G. 208; W. P. C. 546.

(*n*) Neilson *v.* Harford, (1841) 1 W. P. C. 324 n.

(*o*) Heath *v.* Unwin, (1842) 10 M. & W. 687.

(*p*) Jones *v.* Berger, (1843) 1 W. P. C. 551 n.

(*q*) Hindmarch on Patents, 438.

defendant from continuing the acts complained of, or commencing to commit threatened infringements, till the trial of the action, he ought to commence the action expeditiously on becoming aware of infringements or threats to infringe and apply to the Court, *ex parte*, or on notice, and in either case without delay.(*r*)

Interlocutory Injunction.

In order to obtain an interlocutory injunction it is necessary for the plaintiff, in addition to not being guilty of *laches*, to establish a *prima facie* case of validity of the patent and of the fact of infringement.

On an interlocutory application the Court avoids as far as possible expressing an opinion on the merits of the case,(*s*) and does not decide the question of validity unless the patent appears on the face of it so irretrievably and hopelessly bad that it could not possibly be supported.(*t*) The Court endeavours to keep things *in statu quo*.(*u*)

Acquiescence is a bar to the right to an interim injunction. Thus, an interim injunction was dissolved by *Cottenham*, L.C., where it appeared that the plaintiff, about two years before he applied to the Court, was aware that the defendant were at considerable expense in preparing and erecting apparatus for the purpose of using the patented invention, and never interfered to stop them, but permitted them to go on in the expectation that they would pay the royalties required.(*x*) Acquiescence also may at the trial of the action disentitle the plaintiff to an account of profits altogether,(*y*) or partially by limiting the account to profits made since the commencement of the action; (*z*) it may also be a ground for granting damages instead of an injunction.(*a*)

Acquiescence.

The conduct of a plaintiff who knows of the existence of a patent of later date than his own for the same invention, but takes no steps to get it repealed, does not amount to

(*r*) Bacon *v.* Jones, (1839) 4 My. & Cr. 436; Baxter *v.* Coombe, (1850) 1 Ir. Ch. R. 284; Bridson *v.* Benecke, (1849) 12 Beav. 1; Bovill *v.* Crate, (1865) L. R. 1 Eq. 388; Lister *v.* Norton, (1884) 1 R. P. C. 114; United Telephone Co. *v.* Equitable Telephone Co., (1888) 5 R. P. C. 235; Leonhardt *v.* Kellé, (1894) 11 R. P. C. 534.

(*s*) Plimpton *v.* Malcolmson, (1875) L. R. 20 Eq. 38.

(*t*) Briggs *v.* Lardeux, (1884) 1 R. P. C. 126; Shillito *v.* Lannuth, (1885) 2 R. P. C. 1; Plimpton *v.* Malcolmson, (1875) L. R. 20 Eq. 38; Tadman *v.* Owens, (1894) 11 R. P. C. 349.

(*u*) Plimpton *v.* Spiller, (1877) L. R. 4 Ch. D. 288.

(*x*) Neilson *v.* Thompson, (1841) 1 W. P. C. 275, 285.

(*y*) Crossley *v.* Beverly, (1829) 1 W. P. C. 120; Harrison *v.* Taylor, (1865) 11 Jur. N. S. 408.

(*z*) Ford *v.* Foster, (1872) L. R. 7 Ch. App. Cas. 611, 627; Beard *v.* Turner, (1866) 13 L. T. N. S. 746.

(*a*) Sayers *v.* Collyer, (1885) L. R. 28 Ch. D. 103.

Inter-locutory Injunction.

acquiescence, unless the invention is actually put in practice under the subsequent patent.(*b*)

Laches.

Unexplained delay is a bar to an interlocutory injunction, both when the patent has not been previously contested (*c*) and when it has been established in prior proceedings.(*d*) In case of delay the defendant may be able to plead a growth of trade which would not have arisen but for the plaintiff's *laches*, and the Court will not interfere with it pending a final decision as to the validity of the patent and the fact of infringement.(*e*)

Thus, a plaintiff was held to be too late who applied on December 2 for an interim injunction in respect of infringement committed on November 13 and 23.(*f*)

And where the plaintiff knew in December what the defendant was doing, but did not move for an injunction till the following July, he was held too late, notwithstanding that he had obtained judgments by default in several prior actions.(*g*) So again, a plaintiff was too late where it appeared that he had known of the defendant's conduct for eleven months before moving.(*h*)

Delay may sometimes be satisfactorily explained.

Delay in some cases is capable of a satisfactory explanation, and then it is no longer a bar to the injunction.

Thus, where it appeared that the plaintiff had on several previous occasions established his patent, and there was a combination of persons against him interested in resisting his claims, in consequence of which he waited till he had established his patent again against one of the members of this combination before proceeding against the other members, his conduct was held to be no bar to an interlocutory injunction.(*i*)

Again, where the plaintiffs, in February, received notice from the solicitors to a company that the company was being formed for the purpose of manufacturing an article which might possibly be an infringement of the plaintiff's patent, and inspection was offered, the Court held that they were not too late in applying,

(*b*) Newall *v.* Wilson, (1852) 2 De G. M. & G. 282.

(*c*) Bacon *v.* Jones, (1839) 4 My. & Cr. 436; Baxter *v.* Coombe, (1850) 1 Ir. Ch. R. 284; Bridson *v.* Benecke, (1849) 12 Beav. 1, 3; Bovill *v.* Crate, (1865) L. R. 1 Eq. 388; Lister *v.* Norton, (1884) 1 R. P. C. 114; United Telephone Co. *v.* Equitable Telephone Co., (1888) 5 R. P. C. 235; Leonhardt *v.* Kallé, (1894) 11 R. P. C. 534; Dunlop Pneumatic Tyre Co. *v.* Pneumatic Tyre Co., (1897) 14 R. P. C. 263.

(*d*) North British Rubber Co. *v.* Gormully and Jeffery Manufacturing Co., (1894) 12 R. P. C. 21.

(*e*) North British Rubber Co. *v.* Gormully and Jeffery Manufacturing Co., (1894) 12 R. P. C. 17; p. 593 *post.*

(*f*) Greer *v.* Bristol Tanning Co., (1885) 2 R. P. C. 268.

(*g*) Edison-Bell Phonograph Corporation *v.* Hough, (1894) 11 R. P. C. 594.

(*h*) Leonhardt *v.* Kallé, (1894) 11 R. P. C. 534.

(*i*) Bovill *v.* Smith, (1867) W. N. 240.

Interlocutory Injunction.

in March, for an interlocutory injunction, the delay being sufficiently explained on the ground that they had been advised not to apply for it till the company had raised a substantial capital, and had actually commenced to manufacture the infringing article.(*k*) And an interim injunction was granted, when the plaintiff became aware of the infringement on March 23, but spent some time in making inquiries before giving the defendant notice to desist on May 8, and continued in correspondence with him till the bill was filed on July 7.(*l*)

Defendant working under a patent of his own.

A plaintiff is not to be held guilty of *laches* disentitling him to an interim injunction merely on the ground that the infringement was committed under the supposed protection of a patent, of the existence of which he had knowledge some time before the commencement of the action.(*m*)

But where a defendant contended that he was working under a patent of his own, which he maintained was valid, *Cottenham*, L.C., in refusing an interim injunction, said: "It would be rash in me if I were to give an opinion, coming to a conclusion contrary to what is sworn by the most eminent scientific persons in this country. If in a question so open to doubt as this I should interfere with the defendant I should be setting up my own judgment in opposition to those who, being practically acquainted with matters of this description, have deposed that, according to all rules and principles, the subject-matter of the defendant's patent may be perfectly new and unconnected with anything claimed by the plaintiff. I may not be satisfied that these gentlemen are right, or that the plaintiffs are wrong, but I am satisfied that the case is not one so free from doubt as to justify me in interfering."(*n*)

Defendant the agent of a person who could establish a case of *laches*.

Where as against the actual defendant there has been no *laches*, it cannot be contended in his favour that he is merely the agent of another person not a party to the action, who would have been able to establish a complete case of *laches* if the action had been brought against him.(*o*) But where the defendant is merely the customer of another, against whom there is a pending action in which an interlocutory injunction has been refused, on an undertaking to pay money into Court

(*k*) United Telephone Co. *v.* Equitable Telephone Association, (1888) 5 R. P. C 233.

(*l*) Losh *v.* Hague, (1837) 1 W. P. C. 201.

(*m*) Osmund *v.* Hirst, (1885) 2 R. P. C. 265, 267.

(*n*) Electric Telegraph Co. *v.* Nott, (1847) 11 Jur. 157; 2 Coop. C. C. 41. See also Morgan *v.* Seaward, (1837) 1 W. P. C. 167; Muntz *v.* Vivian, (1840) 2 W. P. C. 87.

(*o*) Pneumatic Tyre Co. *v.* Warrilow, (1896) 13 R. P. C. 284.

Interlocutory Injunction.

and keep an account, most probably the injunction will not be granted and the motion will be dismissed with costs on the ground that it ought not to have been made at all.(*p*)

Ex parte application for an interlocutory injunction.

The rule laid down by Lord *Eldon*, L.C., in *Hill* v. *Thompson*,(*q*) is that when an injunction is applied for *ex parte*, on the ground of violation of the rights to an invention secured by patent, it is incumbent on the party making the application to swear, at the time of making it, as to his belief that he is the original inventor; for, although when he obtained his patent he might very honestly have sworn as to his belief of such being the fact, yet circumstances may have subsequently intervened, or information been communicated, sufficient to convince him that it was not his own original invention, and that he was under a mistake when he made his previous declaration to that effect.

It is submitted that in the case of a plaintiff having a derivative title the above rule will be satisfied if he swears that in his belief the original patentee was the first and true inventor.

Not only must a patentee applying for an *ex parte* injunction comply with the above-mentioned rule, but he must in all other respects exercise perfect good faith, and put the Court in possession of all the facts within his knowledge bearing on the question whether an injunction ought under the circumstances to be granted or not.(*r*)

Usual course on *ex parte* applications.

The Court does not commonly grant injunctions on *ex parte* applications, but the usual course is to make an order extending over a specified day, liberty being given to the applicant to serve short notice of motion for the day before that on which the order expires, and the applicant is required to give an undertaking to abide by the order of the Court as to any damages the defendant may be put to by reason of the interim order, such other terms being imposed upon him as the case may require.(*s*)

Validity of the patent is an important question on motion for interlocutory injunction.

The question of the validity of the patent, though not decided on an interlocutory application, is, and ought to be, an important consideration with the Court when determining whether or not to grant an interim injunction.(*t*)

(*p*) Pneumatic Tyre Co. *v.* Goodman, (1896) 13 R. P. C. 723.

(*q*) Hill *v.* Thompson, (1817) 1 W. P. C. 231; see also Sturtz *v.* De la Rue, (1828) 5 Russ. 322, 329; Gardner *v.* Broadbent, (1856) 2 Jur. N. S. 1041; Whitton *v.* Jennings, (1860) 1 Dr. & Sm. 110; Mayer *v.* Spence, (1860) 1 J. & H. 87.

(*r*) Dalglish *v.* Jarvie, (1850) 2 Mac. & G. 231; Curtis *v.* Cutts, (1839) 3 Jur. 34.

(*s*) Daniell's Chancery Practice, 6th ed. p. 1611; Moser *v.* Jones, (1893) 10 R. P. C 368.

(*t*) Jackson *v.* Needle, (1884) 1 R. P. C. 174, 177.

Inter-locutory Injunction.

The rule was laid down and acted upon previously to the Act of 1883, that an interim injunction will be refused where the patent is recent and its validity has not been established,(*u*) and this rule is still acted upon notwithstanding the investigation and protection afforded to the public by ss. 10 and 11 of the Act of 1883.(*x*)

Where the patent is recent and has not been questioned an injunction is refused.

An important factor is the strength of the presumption in favour of the validity of the patent. A presumption in favour of the validity of the patent may arise from long enjoyment, a prior action resulting in a declaration of validity, or other circumstances. Where there has been long enjoyment under a patent the presumption in favour of its validity is based on the consideration that it was in the power of anybody to have obtained the repeal of the patent by *scire facias* before 1884 and on petition for revocation since that date, yet no one has done so.(*y*)

Presumption in favour of validity arises from long uninterrupted enjoyment.

Where it is established to the satisfaction of the Court that the plaintiff has been in long, active,(*z*) and uninterrupted (*a*) enjoyment of the patent, an interim injunction will be granted, notwithstanding that the validity of the patent may be doubtful; for if a party gets his patent and puts his invention in execution, and has proceeded to a sale, that may be called possession under it, however doubtful it may be whether the patent can be sustained; and possession under colour of title is ground enough to enjoin and to continue the injunction till it is proved that it is only colour and not real title;(*b*) provided that the enjoyment has been sufficiently long, and the patent is not on the face of it so irretrievably and hopelessly bad that it is clear it cannot be supported.(*c*)

Thus, where a patentee had been in possession of his exclusive privilege for several years, and a defect in the specification was suggested, the Court refused to allow the privilege to be disturbed until the question of title had been decided;(*d*) and

(*u*) Jackson *v.* Needle, (1884) 1 R. P. C. 174, 177; Lister *v.* Norton, (1884) 1 R. P. C. 114; Caldwall *v.* Van Vlissengen, (1851) 9 Hare 424.

(*x*) Farbenfabriken vorm F. Bayer *v.* Bowker, (1891) 8 R. P. C. 397, 399; Jackson *v.* Needle, (1884) 1 R. P. C. 177.

(*y*) Davenport *v.* Jepson, (1862) 4 De G. F. & J. 440; Caldwell *v.* Van Vlissengen, (1851) Hare 415, 424; Electric Telegraph Co. *v.* Nott, (1847) 2 Coop. Ch. Cas. 41; 46 & 47 Vict. c. 57, s. 26.

(*z*) See above.

(*a*) *Ibid.*

(*b*) See judgment of Eldon, L.C., Universities of Oxford and Cambridge *v.* Richardson, (1806) 6 Ves. 706; Dudgeon *v.* Thomson, (1877) 30 L. T. N. S. 244; Betts *v.* Menzies, (1857) 3 Jur. N. S. 357, 358; Gardner *v.* Broadbent, (1856) 2 Jur. N. S. 1041.

(*c*) p. 546 *post;* Briggs *v.* Lardeur, (1884) 1 R. P. C. 126; Shillito *v.* Larmuth, (1884) 2 R. P. C. 1.

(*d*) Muntz *v.* Foster, (1843) 2 W. P. C. 93, 95.

Interlocutory Injunction.

an injunction has been granted in the face of a prior specification, which seemed to be fatal.(*e*)

It is not necessary for the plaintiff, on motion for an interim injunction, to state that the patent has never been disputed, nor is the mere assertion that the patent is invalid sufficient to determine the Court to withhold the injunction.(*f*)

The Court will, in the words of *Jessel*, M.R., "grant an injunction before the hearing, where the patent is an old one, and the patentee has been in long and undisturbed enjoyment of it, or where its validity has been established elsewhere, and the Court sees no reason to doubt the propriety of the result, or where the conduct of the defendant is such as to enable the Court to say that, as against himself, there is no reason to doubt the validity of the patent."(*g*)

If the plaintiff relies on long enjoyment as entitling him to a presumption in favour of the validity of his patent on an application for an interim injunction, it is incumbent on him to show that he has actually used the invention. Thus, an injunction was refused where the plaintiff was only able to produce evidence of actual user at a recent period, notwithstanding that the patent was ten years old.(*h*)

It is also incumbent on the plaintiff to show that his enjoyment of the monopoly has been an uninterrupted one;(*i*) and it has been held that where the invention is of such a nature that it cannot be exercised without the licence of a prior patentee, the plaintiff's undisturbed enjoyment only commences from the expiration of the prior patent, and where this amounts to only one year the injunction must be refused.(*k*)

Length of uninterrupted active enjoyment sufficient to raise a presumption in favour of validity.

In regard to the length of uninterrupted and active enjoyment of the monopoly claimed under a patent which will establish a monopoly in favour of the validity of the patent, and also entitle a plaintiff to an interim injunction,

(*e*) Losh *v.* Hague, (1837) 1 W. P. C. 201.

(*f*) Read *v.* Andrew, (1885) 2 R.P.C. 119, 122.

(*g*) Dudgeon *v.* Thomson, (1877) 30 L. T. N. S. 244; S. C 23 W. R. 464; see also Hill *v.* Thompson, (1817) 3 Mer. 622; S. C. 1 W. P. C. 229, 231; Universities of Oxford and Cambridge *v.* Richardson, (1806) 6 Ves. 689, 707; Stevens *v.* Keating, (1847) 2 W. P. C. 177; Hamar *v.* Plane, (1809) 14 Ves. 130; Bickford *v.* Skewes, (1837) 1 W. P. C. 211, 213; Electric Telegraph Co. *v.* Nott, (1847) 2 Coop. Ch. Cas. 41; Wilson *v.* Tindal, (1841) 1 W. P. C. 730; Renard *v.* Levinstein, (1864) 10 L. T. N. S. 94; Davenport *v.* Jepson, (1862) 4 De G. F. & J. 440.

(*h*) Plimpton *v.* Malcolmson, (1875) L. R. 20 Eq. 38.

(*i*) Collard *v.* Allison, (1839) 4 My. & Cr. 487; Curtis *v.* Cutts, (1839) 8 L. J. N. S. Ch. 184; 2 Coop. C. C. 60; Hill *v.* Thompson, (1817) 3 Mer. 622.

(*k*) Hugh *v.* Magill, (1877) W. N. 62.

thirteen,(*l*) twelve,(*m*) eleven,(*n*) ten,(*o*) nine,(*p*) eight,(*q*) seven,(*r*) and six (*s*) years have, on different occasions, been held to be sufficient. Interlocutory Injunction.

Three years were held sufficient under circumstances from which it appeared that, previously to the grant of the patent, many inventors had been endeavouring to obtain the result achieved by the patentee, who had since the grant sold, at considerable profits, numerous articles manufactured according to the invention without his monopoly being previously questioned; (*t*) though where the plaintiff's patent was three years old, but the works enabling him to carry on operations under it were not completed till one year before Bill filed, the injunction was refused.(*u*)

Where a patent was only two years old at the commencement of an action an interim injunction was obtained, but afterwards it was dissolved by the Lords Justices on appeal, *Knight Bruce*, L.J., saying, in reference to the recent date of the letters patent: "There cannot have been any considerable length of enjoyment under them, and the defendant, in such a case, at least is entitled, I apprehend, to the benefit of any reasonable doubt and reasonable difficulty which he can show to exist as to the sufficiency and validity of the specification."(*x*) And in a more recent case two years' uninterrupted enjoyment was held insufficient to warrant the granting of an interlocutory injunction.(*y*)

Again, where a patent was a recent one and the only question as to its validity was one founded on an objection to the sufficiency of the specification, and it was proved that a competent workman, with no other assistance than the specification, could work the invention, an interlocutory injunction was refused.(*z*)

Where the validity of the patent has been established on *A patent which*

(*l*) Hamar *v.* Plane, (1809) 14 Ves. 130; Read *v.* Andrew, (1885) 2 R. P. C. 119; Stevens *v.* Keating, (1847) 2 W. P. C. 176.

(*m*) Neilson *v.* Thompson, (1841) 1 W. P. C. 279.

(*n*) Wilson *v.* Tindal, (1841) 1 W. P. C. 730.

(*o*) Shillito *v.* Larmuth, (1884) 1 R. P. C. 1.

(*p*) Davenport *v.* Richard, (1865) 3 L. T. N. S. 503; Howes *v.* Webber, (1894) 11 R. P. C. 586.

(*q*) Betts *v.* Menzies, (1857) 3 Jur. N. S. 357; L. R. 3 Eq. 312.

(*r*) Stevens *v.* Keating, (1847) 2 W. P. C. 176; Osmond *v.* Hirst, (1885) 2 R. P. C. 265.

(*s*) Rothwell *v.* King, (1886) 3 R. P. C. 379; Bickford *v.* Skewes, (1837) 1 W. P. C. 211, 213; Renard *v.* Levinstein, (1864) 10 L. T. N. S. 94.

(*t*) Wheatstone *v.* Wilde, (1861) Griff. P. C. 247.

(*u*) Hill *v.* Thompson, (1817) 1 W. P. C. 232; 3 Mer. 622; see also Plimpton *v.* Malcolmson, (1875) L. R. 20 Eq. 37.

(*x*) Renard *v.* Levinstein, (1864) 10 L. T. N. S. 177.

(*y*) British Tanning Co. *v.* Groth, (1889) 7 R. P. C. 1.

(*z*) Coles *v.* Baylis, (1886) 3 R. P. C. 178.

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has been established is regarded as valid in an interlocutory application.

previous occasions, though it is open to the defendant at the trial to dispute it, the Court will, on an interlocutory application, regard its validity as sufficiently established by the previous proceedings to warrant the grant of an interim injunction,(*a*) if the infringement is clear,(*b*) or there is a *prima facie* case of infringement,(*c*) and this notwithstanding that the defendant disputes the validity of the patent on a ground not raised in any of the previous proceedings.(*d*)

Where the plaintiff has established the validity of the patent but there is an appeal pending to the Court of Appeal or House of Lords, the Court considers the validity as established on the hearing of a subsequent motion for an interlocutory injunction; and the injunction may be obtained notwithstanding that the defendant offers to pay royalties pending the appeal.(*e*)

If it could be established to the satisfaction of the Court that the judgment in favour of the patent in a prior action was wrongly obtained, this fact would no doubt induce the Court to depart from the usual course of treating the question of validity as established; (*f*) though it has been held that a certificate of validity given in a prior action in which judgment was obtained by default or consent is ground for treating the validity as established on subsequent motion for interlocutory injunction.(*g*)

The fact that a plaintiff has succeeded in obtaining an interdict of a Scotch Court restraining a prior infringement in Scotland is sufficient *prima facie* evidence of the validity of the patent to justify the grant of an interim injunction against a subsequent infringement in England.(*h*)

Where a patent had been the subject of an arbitration at the request of parties to a former action, and the arbitrator had given his award in favour of its validity, the Court, in a subsequent action of infringement against the same defendant, considered the patent sufficiently established by the arbitrator's award, and granted an interlocutory injunction.(*i*)

(*a*) Dudgeon *v.* Thomson, (1877) 30 L. T. N. S. 244; Davenport *v.* Jepson, (1862) 4 De G. F. & J. 440; Davenport *v.* Goldberg, (1865) 2 H. & M. 282; Newall *v.* Wilson, (1852) 2 De G. M. & G. 282; Bovill *v.* Smith, (1867) W.N. p. 240; Bovill *v.* Goodier, (1866) L. R. 2 Eq. 200.

(*b*) Hayward *v.* The Pavement Light Co., (1884) 1 R. P. C. 207.

(*c*) Thorn *v.* Worthing Skating Rink Co., (1876) L. R. 6 Ch. D. 415 n.

(*d*) Newall *v.* Wilson, (1852) 2 De G. M. & G. 282; 19 L. T. 161.

(*e*) Moser *v.* Sewell, (1893) 10 R. P. C. 365; Moser *v.* Jones, (1893) 10 R. P. C. 368.

(*f*) Pneumatic Tyre Co. *v.* Marwood, (1896) 13 R. P. C. 347.

(*g*) Edison-Bell Phonograph Corporation *v.* Bernstein, (1897) 14 R. P. C. 153.

(*h*) Dudgeon *v.* Thomson, (1877) 30 L. T. N. S. 244; Stevens *v.* Keating, (1847) 19 L. J. N. S. Ex. 57; 2 W. P. C. 176, 177.

(*i*) Lister *v.* Eastwood, 26 L. T. 4.

Interlocutory Injunction.

An interim injunction may be granted in a subsequent action, where it is shown by the plaintiff that he has established his patent on a former occasion, though against a different defendant; but the subsequent defendant will at the trial be in no way bound by the previous decision, and may contest the patent anew on the same or different evidence, and he cannot be compelled to do so by presenting a petition for its revocation.(*k*) It is submitted that in such a case the Court will consider itself bound as to the interpretation of the specification by the construction put upon it by a Court of equal or superior jurisdiction.(*l*)

Interlocutory injunctions are usually refused where there is a real doubt as to infringement.

An interlocutory injunction is granted when the Court is satisfied that what the defendant has done, or threatens to do, is a mere invasion of the plaintiff's right,(*m*) or where the infringement is clear and the patent has been established in former proceedings and there is no *laches*.(*n*) Also when the sole question between the parties is the validity of the patent,(*o*) and there is a strong presumption or case in its favour;(*p*) but it is usually refused if there is a real doubt as to the infringement.(*q*) Thus, where there was only evidence of possession and not of user, and the defendant had before action offered to give an undertaking not to use during the continuance of the patent, the injunction was refused, and the defendant undertaking not to use till the trial of the action or further order, the motion was dismissed with costs.(*r*)

Degree of the doubt as to infringement is an important factor.

In cases where there is a question as to the infringement, it depends on the degree of doubt whether or not an injunction will be granted; and the Court will consider the degree of convenience or inconvenience to the parties caused by granting or refusing the injunction.(*s*) Thus, if there is a *bonâ fide* doubt as to infringement and the trade of the defendants is a new one likely to lead to the sale of a large number of

(*k*) Bovill *v.* Goodier (2), (1866) L. R. 2 Eq. 195; Russell *v.* Barnsley, (1834) 1 W. P. C. 472; 2 Coop. Ch. Cas. 58; but see Davenport *v.* Goldberg, (1865) 2 H. & M. 286.

(*l*) Edison *v.* Holland, (1889) 6 R. P. C. 243, 249, 276; Slazenger *v.* Feltham, (1889) 6 R. P. C. 130; p. 579 *post*.

(*m*) Thorn *v.* Worthing Skating Rink Co., (1876) L. R. 6 Ch. D. 415 n.

(*n*) Pneumatic Tyre Co. *v.* Warrilow, (1896) 13 R. P. C. 288.

(*o*) Neilson *v.* Thompson, (1841) 1 W. P. C. 277; Stevens *v.* Keating, (1847) 2 W. P. C. 179; Electric Telegraph Co. *v.* Nott, (1847) 11 Jur. 157.

(*p*) p. 544 *ante*.

(*q*) Neilson *v.* Thompson, (1841) 1 W. P. C. 277; Stevens *v.* Keating, (1847) 2 W. P. C. 179; Electric Telegraph Co. *v.* Nott, (1847) 11 Jur. 157; Wood *v.* Cockerill, (1889) 2 Coop. C. C. 58; Plimpton *v.* Malcolmson, (1875) L. R. 20 Eq. 38.

(*r*) Lyon *v.* Mayor and Corporation of Newcastle-upon-Tyne, (1894) 11 R. P. C. 218.

(*s*) Bridson *v.* McAlpine, (1846) 8 Beav. 230; Thompson *v.* Hughes, (1890) 7 R. P. C. 71.

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the alleged infringing articles, it is more convenient, and less likely to produce irreparable damage, to stop him by injunction from selling, than it would be to allow him to sell and merely keep an account, thus forcing the plaintiff to commence a multitude of actions against the purchasers;(*t*) and where there is evidence of long enjoyment, and consequently *primâ facie* evidence of title which ought to be respected,(*u*) the Court will not consider the injury to the defendant, but will protect the plaintiff from the possible consequences of the market being flooded with articles manufactured in infringement of his patent, supposing him to be able to sustain it.(*x*) If it appears that an interim injunction would seriously prejudice the defendant, and not benefit the plaintiff, it will be refused.(*y*)

To obtain an injunction on an interlocutory application it is sufficient to show one clear instance of infringement,(*z*) or to make out a *primâ facie* case; (*a*) and the Court of Appeal is slow to interfere with the discretion of a Judge of First Instance who is satisfied as to the existence of a *primâ facie* case.(*b*)

Affidavits made from information and belief.

Affidavits made from information and belief should show the source of such information and belief, otherwise they will not have much weight with the Court, and will not be of much material help to the plaintiff in making out the necessary *primâ facie* case of infringement.(*c*)

Interlocutory injunctions are granted where infringement is established and there is a presumption in favour of validity.

Where the infringement is made out, and there is a presumption in favour of the validity of the patent arising, *e.g.*, from long previous enjoyment, or from the circumstance of the patent having been supported in previous litigation,(*d*) or if the defendant is estopped from denying the validity of the patent(*e*) an interim injunction will be granted. Where the defendant admitted that he had exhibited machines which to some extent were or had been infringements of the plaintiff's patent, the

(*t*) Plimpton *v.* Spiller, (1877) L. R. 4 Ch.D. 286, 292; but see North British Rubber Co. *v.* Gormully and Jeffery Manufacturing Co., (1894) 12 R. P. C. 17, where the defendant pleaded laches *plus* growth of his trade.

(*u*) Stevens *v.* Keating, (1847) 2 W. P. C. 177; p. 545 *ante*.

(*x*) Davenport *v.* Jepson, (1862) 4 De G. F. & J. 448; Hamar *v.* Plane, (1809) 14 Ves. 130; Stevens *v.* Keating, (1847) 2 W. P. C. 177.

(*y*) Neilson *v.* Thompson, (1868) 1 W. P. C. 275, 286; Morgan *v.* Seaward, (1837) 1 W. P. C. 167; Thomson *v.* Hughes, (1890) 7 R. P. C. 71.

(*z*) United Telephone Co. *v.* Sharples, (1885) L. R. 29 Ch. D. 164, 169.

(*a*) Briggs *v.* Lardeur, (1884) 1 R. P. C. 128; Shillito *v.* Larmuth, (1885) 2 R. P. C. 1, 3; Anderson *v.* Patent Oxonite Co., Ld., (1886) 3 R. P. C. 279.

(*b*) Baker *v.* White, (1884) 1 Times R. 64.

(*c*) Saccharin Corporation *v.* The Chemical Dye and Drugs Co., (1898) 15 R. P. C. 53.

(*d*) Dudgeon *v.* Thomson, (1877) 30 L. T. N. S. 244; Bovill *v.* Goodier, (1865) 35 L. J. Ch. 174; 35 Beav. 427; Bovill *v.* Smith, (1867) W. N. 240; Davenport *v.* Goldberg, (1865) 2 H. & M. 282; Davenport *v.* Jepson, (1862) 4 De G. F. & J. 448; Newall *v.* Wilson, (1852) 2 De G. M. & G. 282.

(*e*) p. 522 *ante*.

Court granted an injunction in general terms, but left open the question as to the particular machines.(*f*)

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Although the Court has the power to grant an interlocutory injunction *simpliciter*,(*g*) it is the invariable practice not to do so, but to bind the plaintiff in an undertaking to indemnify the defendant, if it should ultimately turn out that the patent is bad and that the injunction ought, therefore, not to have been granted; (*h*) and the undertaking is equally required where the patent has been established on former occasions, as where there has been no previous contest.(*i*)

Indemnity on behalf of the defendant is required from the plaintiff when an interlocutory injunction is granted.

Unexplained and unreasonable delay in making an application to enforce the undertaking to be answerable in damages induces the Court to refuse the application; (*k*) but the undertaking is not put an end to by the discontinuance,(*l*) or dismissal,(*m*) of the action.

The undertaking can be enforced when the injunction has been wrongly granted owing to a mistake of law by the Judge; (*n*) and it may be entered into by,(*o*) and enforced against, a married woman.(*p*)

Inability on the part of the defendant to satisfy the plaintiff's claim for damages in the event of defeat is a consideration which induces the Court to grant an interlocutory injunction.(*q*) And if the defendant does not appear the injunction may be granted on affidavit as to validity, on the ground that the defendant not appearing the plaintiff may not be able to get an account.(*r*)

Inability on the part of the defendant to satisfy the plaintiff's claim.

Where there is an independent case, on any ground, against an interlocutory injunction being granted, the Court considers

The motion is usually ordered

(*f*) Edison-Bell Phonograph Corporation *v.* London Phonograph Co., (1894) 11 R. P. C. 193.

(*g*) Bacon *v.* Jones, (1839) 4 M. & C. 436; Wilson *v.* Tindal, (1841) 1 W. P. C. 730; Bickford *v.* Skewes, (1837) 1 W. P. C. 214; Tuck *v.* Silver, John. 218.

(*h*) Chappell *v.* Davidson, (1856) 8 D. M. & G. 1; Tuck *v.* Silver, John. 218; Wakefield *v.* Duke of Buccleuch, (1865) 11 Jur. N. S. 523; Graham *v.* Campbell, (1877) L. R. 7 Ch. D. 490; Muntz *v.* Grenfell, (1842) 2 W. P. C. 91; 2 Coop. Ch. Cas. 59; Moser *v.* Sewell, (1893) 10 R. P. C. 366; Moser *v.* Jones, (1893) 10 R. P. C. 368

(*i*) United Telephone Co. *v.* Taskar, (1888) 5 R. P. C. 628, 633; Bovill *v.* Smith, (1867) W. N. 240.

(*k*) *Ex parte* Hall, (1883) L. R. 23 Ch. D. 644.

(*l*) Newcomen *v.* Coulson, (1877) L. R. 7 Ch. D. 764.

(*m*) Newby *v.* Harrison, (1861) 3 De G. F. & J. 287; Graham *v.* Campbell, (1877) L. R. 7 Ch. D. 490.

(*n*) Griffith *v.* Blake, (1884) L. R. 27 Ch. D. 474; Rothwell *v.* King, (1887) 4 R. P. C. 76.

(*o*) *Re* Prynne, (1885) W. N., p. 144.

(*p*) Hunt *v.* Hunt, (1884) 54 L. J. Ch. 289.

(*q*) Kensington and Knightsbridge Electric Lighting Co. *v.* Lane Fox Electrical Co., (1891) 8 R. P. C. 277; Plimpton *v.* Spiller, (1876) L. R. 4 Ch. D. 291; Newall *v.* Wilson, (1852) 2 G. M. G. 282.

(*r*) Clarke *v.* Nichols, (1895) 12 R. P. C. 310.

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to stand over till the trial if there is an independent case against an interlocutory injunction being granted.

it better to order the motion to stand over till the trial, if the defendant asks for it, because, although when the case on the motion is the same as the case at the trial, it is better merely to make the costs in the motion costs in the action; yet, where there is an independent case against a motion, so that the defendant may say, "If you succeed at the trial, yet you must have failed on the motion by reason of this delay, and therefore you have exposed me in any view to unnecessary expense," it is better, then, to order the motion to stand to the trial, without prejudice to any question.(*s*)

And in some circumstances—*e.g.*, where the patentee has agreed with the defendant not to oppose any company formed for the purpose of purchasing his invention—the Court will order the motion to stand to the trial notwithstanding that the defendant refuses to give an undertaking to keep an account.(*t*)

When an interlocutory injunction is refused the defendant is usually ordered to keep an account.

When an interim injunction is refused, either on the ground that the infringement is doubtful, or on the ground of delay,(*u*) the usual course is to order the defendant to keep an account.(*x*)

This order for an account may be made in different forms, as the circumstances of the case may require.(*y*)

In *Neilson* v. *Thompson*, the account was for the past as well as from the commencement of the infringement.(*z*) But in *Vidi* v. *Smith* (*a*) the Court held that a retrospective account should not be granted till final judgment. This is the most general form in which the order is made; (*b*) though in *Plimpton* v. *Malcolmson*,(*c*) and *Russell* v. *Cowly*,(*d*) the account was of "all moneys received or to be received" by the sale of the patented articles, and in *Beardsell* v. *Schwann* (*e*) the account was of the articles only.(*f*) In *Pneumatic Tyre Co.* v. *Friswell* (*g*) the defendant refusing to keep an account for fear of admitting the validity of the patent, the order was prefaced with the words "the defendant not admitting the validity, but on the other hand contending that the patent is invalid."

(*s*) Per Chitty, J., Lister *v.* Norton, (1884) 1 R. P. C. 116.

(*t*) British Tanning Co. *v.* Groth, (1889) 7 R. P. C. 1.

(*u*) Bovill *v.* Crate, (1865) L. R. 1 Eq. 388; Neilson *v.* Thompson, (1841) 1 W. P. C. 286; Lister *v.* Norton, (1884) 1 R. P. C. 114.

(*x*) *Ibid.*; Bacon *v.* Jones, (1839) 4 My. & Cr. 436: Jackson *v.* Needle, (1884) 1 R. P. C. 176; Hill *v.* Thomp- (1817) 1 W. P. C. 232; 3 Mer. 662; Morgan *v.* Seaward, (1837) 1 W. P. C. 169.

(*y*) For common form of order see Seton, 4th ed. p. 344.

(*z*) 1 W. P. C. 286.

(*a*) 3 E. & B. 969.

(*b*) Plimpton *v.* Spiller, (1877) L. R. 4 Ch. D. 286.

(*c*) Seton, 4th ed. p. 344.

(*d*) 1 W. P. C. 458.

(*e*) Seton, 3rd ed. p. 910.

(*f*) Hill *v.* Thompson, (1817) 3 Mer. 626; Jackson *v.* Needle, (1884) 1 R. P. C. 176.

(*g*) (1895) 13 R. P. C. 15.

Discovery.

An interim injunction is not often granted when the defendant voluntarily offers to keep an account and the Court is satisfied that he will be sufficiently able to satisfy any claim the plaintiff may ultimately succeed in establishing against him.(*h*)

Action not prosecuted with due diligence.

If the plaintiff does not prosecute the action with due diligence after obtaining an interim injunction, the defendant may apply to have the injunction dissolved.(*i*)

Order as to payment of money out of Court.

In the event of the defendant paying money into Court and the plaintiff being successful in the action the proper course is for the Court to order the money to remain in Court to abide the result of the inquiry as to damages, or the taking of the amount and to be paid out to the plaintiff, or so much thereof as the plaintiff shall show he is entitled to.(*k*)

Discovery and Inspection.

Interrogatories

Discovery.—Notwithstanding that in patent actions particulars must be delivered by both the plaintiff and the defendant,(*l*) either party may, by leave of the Court or a Judge, deliver interrogatories in writing for the examination of the opposite parties, or any one or more of such parties, provided that interrogatories which do not relate to any matters in question in the action shall be deemed irrelevant, notwithstanding that they might be admissible on the oral cross-examination of a witness.(*m*)

must be limited to facts enabling the interrogating party to prove his case.

Interrogatories must be limited to facts, and an interrogating party is entitled only to such answers as will enable him to establish his case, and he is not entitled to administer interrogatories which inquire into the opposite parties' evidence,(*n*) nor is he entitled to answers to irrelevant questions(*o*) —*e.g.*, as to certain unsuccessful proceedings abroad for the infringement of a foreign patent in the possession of the

(*h*) Gardner *v.* Broadbent, (1856) 2 Jur. N. S. 1041; Copeland *v.* Webb, (1862) 11 W. R. 134; Jackson *v.* Needle, (1884) 1 R. P. C. 174; Lister *v.* Norton, (1884) 1 R. P. C. 114.

(*i*) Stevens *v.* Keating, (1847) 2 W. P. C. 175.

(*k*) North British Rubber Co. *v.* Gormully and Jeffery Manufacturing Co., (1894) 12 R. P. C. 17.

(*l*) 46 & 47 Vict. c. 57, s. 29.

(*m*) R. S. C. 1883, Ord. xxxi. r. 1; Birch *v.* Mather, (1883) L. R. 22 Ch. D. 629; Haddan's Patent, (1884) 54 L. J. N. S. Ch. 126; Finnigan *v.* James, (1874) L. R. 19 Eq. 72; Crossby *v.* Tomey, (1875) L. R. 2 Ch. D. 533; Saunders *v.* Jones, (1877), L. R. 7 Ch. D. 449.

(*n*) Delta Metal Co. *v.* Maxim-Nordenfelt Guns and Ammunition Co., (1891) 8 R. P. C. 169.

(*o*) Ehrlich *v.* Ihlee, (1888) 5 R. P. C. 37; Hoffmann *v.* Postill, (1869) L. R. 4 Ch. App. Cas. 673; R. S. C. 1883, Ord. xxxi. r. 6.

Discovery.

plaintiff;(*p*) but in one case the plaintiff was ordered to answer as to the terms of a compromise in another action as being material.(*q*) Consequently, if the particulars of breaches are sufficient, the plaintiff will not be compelled to answer further questions as to the alleged infringements.(*r*)

Thus the owner of letters patent for mechanical musical instruments brought an action for alleged infringement against the defendants, and delivered particulars of breaches, in which he complained generally of the infringement of the first claiming clause of the specification, and "in particular and by way of illustration" of a specific article held by the defendants. The defendants delivered particulars of objections which alleged (*inter alia*) that the alleged invention was not the subject of a patent, but the new application of old machinery to an analogous purpose; that, as disclosed by the specification, it did not make any useful addition to the existing stock of public knowledge; and that the specification did not sufficiently distinguish the new from the old. The defendants also delivered interrogatories which in effect asked the plaintiff to admit the truth of the above-mentioned objections, or to state how he made them out not to be true. The plaintiff having declined to answer these interrogatories, the defendant took out a summons to compel him to do so. The summons was adjourned into Court, and the plaintiff, then consenting to answer the interrogatories as to subject-matter, and to amend the particulars of breaches by omitting the words "by way of illustration," it was held that no further answer should be ordered.(*s*)

The Court will not compel a party to discover facts beyond what is necessary to enable his opponent to prove his case. (*t*) Thus, where the only plea raised by the defence was that the plaintiff was not the true and first inventor, the defendant was allowed to refuse to answer interrogatories as to the accuracy of the specification, the novelty of the process, and the fact of the infringement.(*u*)

Fishing interrogatories are not allowed.

Fishing interrogatories, which merely help one party to get at the other's evidence and see what he can make of it, are not allowed: *e.g.*, a plaintiff is not allowed to ask a defendant to

(*p*) Hoffmann *v.* Postill, (1869) L. R. 4 Ch. App. Cas. 673, 679.
(*q*) Betts *v.* Neilson, W. N. 1866, p. 170.
(*r*) Hoffmann *v.* Postill, (1869) L. R. 4 Ch. App. Cas. 673, 679.
(*s*) Ehrlich *v.* Ihlee, (1887) 5 R. P. C. 37.
(*t*) Bidder *v.* Bridges, (1885) L. R. 29 Ch. D. 29, 34.
(*u*) Young *v.* White, (1853) 17 Beav. 532.

state the names of the persons to whom he alleges he sold articles similar to the plaintiff's before the date of the patent; (*x*) though he may be required to state whether alleged anticipating machines mentioned in his objections are in existence, and the names and addresses of alleged prior users. (*y*) Discovery.

Plaintiff and defendant have an equal right to discovery.

It has been stated that interrogatories for the examination of a plaintiff are on a different footing from those for the examination of a defendant in this respect, that a plaintiff is not entitled to discovery of the defendant's case, but a defendant may ask any questions tending to destroy the plaintiff's claim. (*z*) This statement must, however, be taken as having been made in the first instance in reference to a particular case, and must not be taken as establishing the proposition that the defendant has a larger right of discovery than a plaintiff. No such proposition can be upheld in the face of the authorities which, on the contrary, establish that the rights of both plaintiff and defendant are equal in respect of discovery, *i.e.*, either party is entitled to a discovery of such material facts from the other as will enable him to make out *his case*, and not to a discovery of facts which relate exclusively to the manner in which the case of the other party is to be established, or to the evidence which relates exclusively to that case. (*a*)

Discovery which is a matter of indifference to the party against whom it is sought,

Where discovery is a matter of indifference to the party against whom it is sought, the Court does not weigh carefully the question of materiality or immateriality; still, where the nature of the discovery required is such that the giving of it may be prejudicial to such party, the Court takes into consideration the special circumstances of the case; on the one hand it takes care that the party desiring discovery obtains all which can be of use to him, on the other it protects the opposite party against undue inquisition into his affairs. (*b*)

or cannot help the interrogating party.

And when a defendant's answer to an interrogatory cannot help the plaintiff to obtain a decree, but will only be of use to

(*x*) Daw *v.* Eley, (1865) 2 H. & M. 725.

(*y*) Birch *v.* Mather, (1883) L. R. 22 Ch. D. 629.

(*z*) Hoffmann *v.* Postill, (1869) L. R. 4 Ch. App. 673; Lowndes *v.* Davies, (1834) 6 Sim. 468; Commissioners of Sewers *v.* Glasse, (1873) L. R. 15 Eq. 302.

(*a*) Bray on Discovery, pp. 467 and 468; Bovill *v.* Smith, (1866) L. R. 2 Eq. 459; Daw *v.* Eley, (1865) 2 H. & M. 725; Bidder *v.* Bridges, (1885) L. R. 29 Ch. D. 34, judgment of Kay, J.

(*b*) Moore *v.* Craven, (1874) L. R. 7 Ch. App. 94, 96; Simpson *v.* Charlesworth, (1866) W. N. p. 255; Daw *v.* Eley, (1865) 2 H. & M. 725; Rolls *v.* Isaacs, (1878) W. N. 37; Crossley *v.* Stewart, (1863) 1 N. R. 426; S. C. 7 L. T. N. S. 848; Craver *v.* Pinto Leite, (1871) 7 Ch. App. 90, 97; Orr *v.* Diaper, (1876) L. R. 4 Ch. D. 92.

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him if he obtains a decree, the Court has a discretion whether to oblige the defendant to answer before trial, and will not do so when compelling such discovery would be oppressive.(*c*) Thus, if the defendant denies infringement, but admits the possession of the infringing articles, he will not be compelled to answer interrogatories which seek an account of all such articles in his possession, as well as discovery as to the purchase or hire of them, and an account of sales and profits.(*d*)

Where a party interrogates as to facts tending to enable him to prove a particular issue, the party giving discovery will not be excused from answering fully on the ground that such answers cannot be of use to the party seeking it, if he fails to prove some other issue.(*e*)

The limitation as to answering interrogatories applies only to those relating to matters which depend on the part (or it may be the whole) of the case which will become immaterial if the case be not established, or are of such a nature that the party seeking the discovery is not entitled to it till his case is established by the judgment of the Court(*f*)—*e.g.*, where infringement is admitted and discovery is sought of the sales and profits made by trafficking in the infringing articles.(*g*) It does not protect a defendant who denies the plaintiff's title *in toto*, or alleges that the patent is invalid, from answering fully all interrogatories which are material.(*h*)

Rule that "he who answers at all must answer fully."

Subject to the above limitations, the old fixed and rigid rule that "he who answers at all must answer fully," guides the Court in deciding whether any particular answers given are sufficient, or whether any particular interrogatories are allowable or not.(*i*)

Cost of interrogatories must be secured.

In the event of the Court or a Judge granting leave to any party to administer interrogatories to any other party or parties the costs must in the first instance be secured by the party seeking such discovery in the manner prescribed by the Supreme Court Rules, 1883.(*k*)

(*c*) Parker *v.* Wells, (1880) L. R. 18 Ch. D. 477 ; Swabey *v.* Sutton, (1863) 1 H. & M. 514 ; Fennessy *v.* Clark, (1888) L. R. 37 Ch. D. 184 ; Lister *v.* Norton, (1885) 2 R. P. C. 68 ; Bray on Discovery, p. 553.

(*d*) De la Rue *v.* Dickinson, (1857) 3 K. & J. 388 ; Rolls *v.* Isaacs, (1878) W. N. p. 37 ; Fennessy *v.* Clark, (1888) L. R. 37 Ch. D. 184.

(*e*) Foxwell *v.* Webster, (1863) 2 Drew and Sm. 250.

(*f*) De La Rue *v.* Dickinson, (1857) 3 K. & J. 391 ; Parker *v.* Wells, (1880) L. R. 18 Ch. D. 477 ; Lister *v.* Norton, (1885) 2 R. P. C. 68.

(*g*) *Ibid.*

(*h*) Swinborne *v.* Nelson, (1852) 16 Beav. 416 ; Foxwell *v.* Webster, (1863) 3 N. R. 103 ; 9 Jur. N. S. 1189.

(*i*) Swinborne *v.* Nelson, (1852) 16 Beav. 416 ; Elmer *v.* Creasy, (1873) L. R. 9 Ch. App. 69 ; Saull *v.* Browne, (1874) L. R. 9 Ch. App. 364 ; Lister *v.* Norton, (1885) 2 R. P. C. 68.

(*k*) Ord. xxxi. rr. 25, 26, 27.

Discovery.

Objection on the ground that the right to discovery depends on the prior decision of an issue.

As in the case of inspection,(*l*) so, when discovery is sought, if the party from whom it is sought objects to it or any part thereof, the Court or a Judge may, if satisfied that the right to the discovery sought depends on the determination of any issue or dispute in the cause, or that for any other reason it is desirable that any issue or question in dispute in the cause should be determined before deciding upon the right to the discovery, order that such issue or question be determined first, and reserve the question as to discovery.(*m*)

The Court under this rule will not in the exercise of its unfettered discretion allow a defendant to postpone answering questions as to facts which go to establish infringement till after the issue of validity is determined.(*n*)

Thus, where the plaintiff framed interrogatories on statements contained in the specification of his patent and asked the defendant step by step if he ever used the processes therein described, and the defendant after answering some of the interrogatories refused to answer others on the ground that the discovery sought depended on the determination of the question at issue—viz., the validity of the patent—and that the matters inquired into were not material at that stage of the action and were a trade secret, the Court held the defendant had shown no sufficient reason for his refusal to answer and made an order for further and better answers.(*o*)

Trade secrets and discovery.

As in the case of inspection (*p*) so with regard to discovery, the fact that the particular discovery sought would lead to the disclosure of the trade secrets of the opposite party will not deter the Court from granting it, if it is necessary in the interests of justice to enable the applicant to establish his case.

In such cases the Court endeavours, where possible, to protect the party compelled to disclose trade secrets, and will not order discovery beyond what is necessary to prove the case of the party seeking it.

Thus, where a defendant denied having infringed a patent for "improvements in preparing colouring matters for dyeing and colouring," although he was compelled to answer interrogatories as to whether he used certain ingredients mentioned in the specification, whether he added anything else, and whether the

(*l*) p. 564 *post*.

(*m*) R. S. C. 1883, Ord. xxxi. r. 20.

(*n*) Benno Jaffé und Darmstaedter Lanolin Fabrik *v.* Richardson, (1893) 10 R. P. C. 136; Ashworth *v.* Roberts, (1890) L. R. 45 Ch. D. 623; 7 R. P. C. 451; Rawes *v.* Chance, (1890) 7 R. P. C. 275.

(*o*) Benno Jaffé und Darmstaedter Lanolin Fabrik *v.* Richardson, (1893) 10 R. P. C. 136.

(*p*) p. 565 *post*.

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additions made any difference in the process, yet he was not obliged to disclose the nature and quantities of the additions.(*q*)

At the hearing of another case against the same defendant, evidence as to the defendant's secret process was taken *in camerâ*, and the Judge ordered the shorthand notes and all the printed copies thereof to be sealed up and impounded in Court until there should be an appeal, in which case the parties were to be at liberty to apply for the delivery out of Court of as many copies as they should want, or until, either by lapse of time or otherwise, it should be determined that there was to be no appeal, in which case any application might be made to the Court for the disposal of them as the parties should think fit.(*r*)

There is, however, no hardship on the defendant in requiring him to state whether he has done what the specification says is to be done. If he answer No, but he has done something slightly different which might possibly be construed as an infringement, but which is a trade secret, the Court has ample power to protect the undue disclosure of such secret.(*s*)

Communications between a patentee and his patent-agent.

Communications between a patentee and his patent-agent relative to the preparation of the specification are not privileged, and he may be required to refer to them in answering interrogatories as documents in his possession. Thus, where the defendant interrogated the plaintiff as to documents in his possession relating to the preparation of the specification and the plaintiff refused to answer, stating as a reason for his refusal that the documents were confidential communications between himself and his solicitor (who was also his patent-agent) and counsel, the Court decided that the answer was insufficient, as not distinguishing communications between the plaintiff and his solicitor, and communications between him and his patent-agent, the former class of communications alone being privileged.(*t*)

And where an action was commenced in respect of the infringement of two patents for similar inventions, but discontinued as to one of such inventions, the plaintiff was nevertheless required to answer interrogatories as to communications relative to that patent between himself and his patent-agent, on the

(*q*) Renard *v.* Levinstein, (1864) 10 L. T. N. S. 94.

(*r*) Badische Anilin und Soda Fabrik v. Levinstein, (1883) L. R. 24 Ch. D. 176.

(*s*) Benno Jaffé und Darmstaedter Lanoiin Fabrik *v.* Richardson, (1893) 10 R. P. C. 139.

(*t*) Mosley *v.* Victoria Rubber Co., (1886) 3 R. P. C. 351.

ground that such answer might be material to the validity of the patent for the other cognate invention.(*u*)

Construction of documents.

Neither a plaintiff (*x*) nor a defendant (*y*) can be compelled to put a construction on the specification in answer to interrogatories.

When complete answer cannot be given without an ocular demonstration.

When a defendant, in answer to an interrogatory asking whether or not he was making articles identical with those manufactured by the plaintiff under the patent, and requiring him to state in what respects his articles differed from the plaintiff's, stated that he had for many years before the date of the patent applied to the articles in question the same treatment as was described in the specification, and that he now made articles which, save so far as his own method or process, adopted before the patent, was similar to that described in the specification of the plaintiff's patent, differed from the articles there described, but that it was impossible, without ocular demonstration, to show in what they differed, he was held to have given a sufficient answer.(*z*)

Names and addresses of alleged prior users.

When a defendant alleges prior user generally in a certain district he may be compelled to give the names and addresses of the manufacturers and the places and dates of user.(*a*)

Disclosure of processes used by an alleged infringer.

Where infringement has been alleged, anything showing, or tending to show, the fact of infringement may be required to be set out in answer to interrogatories.(*b*) Thus, where a plaintiff had been successful in actions against infringers and brought a subsequent action against another infringer, the defendant was compelled to answer whether the process used was the same as that used by one of the prior infringers;(*c*) and where the defendants denied infringement they were compelled to state, in answer to interrogatories, where they first manufactured, and to whom by name they first sold any, and what quantity, of the articles alleged by the plaintiff to be infringements, and by what process they were manufactured.(*d*)

(*u*) Mosley *v.* Victoria Rubber Co., (1886) 3 R. P. C. 351.

(*x*) Wenham Co. *v.* Champion Gas Co. (1890) 8 R. P. C. 22.

(*y*) Delta Metal Co. *v.* Maxim-Nordenfelt Guns and Ammunition Co., (1891) 8 R. P. C. 169.

(*z*) Crossley *v.* Tomey, (1876) L. R. 2 Ch. D. 533; see also Smith *v.* G. W. Ry. Co., (1854) Macr. P. C. 227; 6 E. & B. 405.

(*a*) Alliance Pure White Lead Syndicate *v.* MacIvor's Patents, (1891) 8 R. P. C. 321.

(*b*) De la Rue *v.* Dickinson, (1857) 3 K. & J. 391; Lister *v.* Norton, (1885) 2 R. P. C. 68, 69; Rennard *v.* Levinstein, (1864) 10 L. T. N. S. 94; Benno Jaffé und Darmstaedter Lanolin Fabrik *v.* Richardson, (1893) 10 R. P. C. 136; Ashworth *v.* Roberts, (1890) L.R. 45 Ch. D. 623; 7 R. P. C. 451; Rawes *v.* Chance, (1890) 7 R. P. C. 275.

(*c*) Bovill *v.* Smith, (1866) L. R. 2 Eq. 459. 461.

(*d*) Swinborne *v.* Nelson, (1853) 16 Beav. 416.

Discovery.

Names and addresses of defendant's customers.

Where infringement is admitted, the plaintiff is entitled to an answer to interrogatories asking for the names and addresses of the persons to whom the defendant's machines have been sold;(*e*) and where the defendant had, in answer to interrogatories, set forth the names and addresses of persons resident in England from whom he had received royalties for the use of machines which the plaintiff alleged were made in infringement of his patent, such defendant was ordered to give the names and addresses of persons resident abroad from whom royalties had been received by him in respect of machines made in England, on the ground that the answer might lead to the discovery of important facts relative to the infringement.(*f*)

A defendant will not be excused from giving the names and addresses of his customers on the ground that by so doing he may thereby expose them to actions for infringements.(*g*)

Production of documents.

The same rules apply to the production of documents in patent cases as in other cases.

Where a defendant company sought to withhold from production certain letters which had passed between the officers of the company, and between them and other persons, together with reports relative to infringement and the validity of the plaintiff's claim, it was held that such documents were not privileged, and their production was ordered.(*h*)

Where it appeared that certain plaintiffs, before they became owners of the patent in respect of which they were suing, had, in various proceedings, either disputed, or made preparations for disputing, its validity, and the defendants applied for inspection of the documents relating to such proceedings, it was held that they were entitled to have inspection of all except such as the plaintiff should state on oath to come within such terms as counsel should agree on, *i.e.*, to have come into existence merely to be communicated to the solicitor for the purpose of litigation, actual or intended, and either as materials for briefs or for his advice or consideration.(*i*)

Documents not

Where it appears probable from a document produced by the

(*e*) Tetley *v.* Easton, (1856) 18 C. B. 643.

(*f*) Crossley *v.* Stewart, (1863) 1 N. R. 426; see also Davenport *v.* Rylands, (1865) L. R. 1 Eq. 302, 308; Leather Cloth Co. *v.* Hirschfield, (1866) L. R. 1 Eq. 299.

(*g*) Tetley *v.* Easton, (1856) 18 C. B. 643; How *v.* McKernan, (1862) 30 Beav. 547; Bovill *v.* Cowan, (1867) W. N. p. 115.

(*h*) Westinghouse *v.* Midland Ry. Co., (1883) 48 L. T. N. S. 98, 462.

(*i*) Haslam *v.* Hall, (1887) 5 R. P. C. 1; see also Southwark and Vauxhall Water Co. *v.* Quick, (1878) L. R. 3 Q. B. D. 315, 320; Anderson *v.* Bank of British Columbia, (1875) L. R. 2 Ch. D. 644.

Discovery

disclosed in original affidavit.

plaintiff or defendant that he has in his possession relevant documents besides those which are scheduled to his original affidavit, the proper course is to apply for an order calling on him to make a further and better affidavit, and in particular to state whether he has not in his possession documents, which, from that which has been said by him on affidavit or from the documents he has produced, in all probability are in his possession.(*k*) Thus, a plaintiff who in his affidavit of documents referred to certain affidavits made in a previous action against different defendants, but omitted to schedule them, was ordered to make a further and better affidavit with particular reference to the affidavits filed in the previous action.(*l*)

Further affidavit of documents.

It is established that where an affidavit of documents has been made the opposite party cannot require a further affidavit to be made, if that affidavit is technically sufficient, unless he shows, either upon affidavit or from documents which are produced, or from the pleadings, or admissions in the pleadings of the party giving discovery, or from the very nature of the case (and as regards the nature of the case there must be very strong evidence to induce the Court to act), that there are, probably, in the possession of the party giving discovery documents other than those he has scheduled in his affidavit. There can be no cross-examination on an affidavit of documents which has been filed; but though the party requiring discovery cannot take any of those courses either as to cross-examination or without such evidence above referred to, on further affidavit he may, with the leave of the Court, interrogate the party who has made an affidavit as to documents with reference to certain specific documents which he has reason to suppose are in the possession of the party giving discovery, and which have not been disclosed.(*m*)

The Court may require an affidavit to the effect that the application is not for vexation, or for the purpose of delay, but that it is made honestly for the purpose of obtaining discovery; but it is doubtful whether an affidavit as to the existence and nature of documents supposed to be in the possession of the party giving discovery and not included in the schedule to his original affidavit of documents is admissible.(*n*)

(*k*) Per Cotton, L.J., Brown *v.* Sansom, (1888) 5 R. P. C. 515; Jones *v.* Monte Video Gas Co., (1880) L. R. 5 Q. B. D. 556.

(*l*) Brown *v.* Sansom, (1888) 5 R. P. C. 510.

(*m*) Judgment of Cotton, L.J., Edison *v.* Holland, (1888) 5 R. P. C. 216; see also Hall *v.* Truman, (1885) L. R. 29 Ch. D. 307; Rawes *v.* Chance, (1890) 7 R. P. C. 275.

(*n*) Edison *v.* Holland, (1888) 5 R. P. C. 216.

Inspection.

Interrogatories as to documents not disclosed.

After one party has made a sufficient affidavit of documents the other party to the action will not be allowed to administer to him a general roving interrogatory as to documents in his possession, the effect of which would be to compel him to make a further affidavit. There are cases in which, after a sufficient affidavit as to documents, the Court will allow a party to deliver an interrogatory as to some specific document or documents, but whether this shall be allowed is a matter within the discretion of the Judge in each particular case, and though this decision can be appealed from, the Court of Appeal will not readily reverse it.(*o*)

Limited order for discovery of documents.

If an application is made at chambers for the usual order for discovery of documents, and a limited order only is asked for and obtained, no further order can subsequently be made if the Judge has certified that he did not require argument in Court.(*p*)

Inspection is not a matter of right.

Inspection.—It sometimes happens that the plaintiff could not establish the infringement complained of without an inspection of the process or machinery which the defendant is actually using; or the defendant could not prove his innocence by showing that the patent is invalid or that he does not infringe, without a like inspection against the plaintiff. In such cases the Court has power to make an order for either party to be at liberty to inspect the other's process or machinery; but neither party can claim inspection as a matter of right;(*q*) and the Court will not allow it to be oppressive or to be carried beyond what is necessary in the interests of justice,(*r*) the object of inspection being to enable the Court to have the case properly tried, and to assist the Court in forming a right conclusion.(*s*)

Object of inspection.

Thus, where a defendant was charged with infringing a patent for a sewing machine, and objected to an order for the inspection by the plaintiff of all sewing machines on his premises, on the ground that such order would be oppressive, he was allowed to verify on affidavit all the different kinds of sewing machines

(*o*) Hall *v.* Truman, (1885) L. R. 29 Ch. D. 307.

(*p*) Thomson *v.* Hughes, (1890) 7 R. P. C. 187.

(*q*) 46 & 47 Vict. c. 57, s. 30.

(*r*) Bovill *v.* Moore, (1815) Dav. P. C. 361; 2 Coop. Ch. Ca. 56; Russell *v.* Cowley, (1833) 1 W. P. C. 458; Piggott *v.* Anglo-American Telegraph Co., (1868) 19 L. T. N. S. 46.

(*s*) The Patent Type Founding Co. *v.* Walter, (1860) Johns, 727; Bovill *v.* Moore, (1815) 2 Coop. Ch. Ca. 56; Russell *v.* Cowley, (1833) 1 W. P. C. 459; Davenport *v.* Jepson, (1862) 1 N. R. 308; Pemberton, 4th ed. 484; Russell *v.* Crichton, (1837) 15 Decisions of Court of Session, 1st Series, 1270; Germ Milling Co. *v.* Robinson, (1886) 3 R. P. C. 11; Cheetham *v.* Oldham, (1888) 5 R. P. C. 622.

which he had sold or exposed for sale since the date of the plaintiff's patent, and the order for inspection was confined to one of each class.(*t*) The defendant cannot be compelled to make an affidavit verifying the machines or processes he uses, if he has offered inspection.(*u*) Inspection.

Before the Court makes an order for inspection it will require to be satisfied that the inspection sought is necessary to the case of the party seeking it.(*v*) Evidence necessary to obtain an order for inspection.

Thus, an application for an order for inspection by the plaintiff was refused where he omitted to state on affidavit that it was necessary to his case, and the defendant swore that he made several kinds of the article complained of, and that some of them did not resemble those described in the plaintiff's specification, and that in his belief the inspection was not required for the purposes of the action, but to gain information of his improvements.(*y*) Again, when the Court was of opinion that the defendant's acts, as alleged by the plaintiff, could not possibly amount to an infringement, an order for inspection was refused.(*z*) And an order for inspection was refused where the plaintiff alleged that certain apparatus used by the defendant was an infringement, and the defendant on the other hand denied infringement and gave a description of the apparatus used by him, which showed it to be different to the plaintiff's. The order was refused notwithstanding the allegation that the plaintiff had failed to make the apparatus, as described by the defendant, work at all.(*a*)

In an action for infringement the plaintiff cannot, as a rule, be compelled to produce, or allow inspection of the patented machine or process at the instance of the defendant for the purpose of preparing the defence, since the specification should give sufficient information of what the invention is and the mode of performing it.(*b*) Inspection for the purpose of preparing pleadings.

When, however, the defendant alleges that he has in his possession apparatus which is an anticipation of the plaintiff's claim, and which was formerly used, an order for the production

(*t*) Singer Manufacturing Co. *v.* Wilson, (1865) 5 N. R. 505; 12 L. T. N. S. 140.

(*u*) Drake *v.* Muntz's Metal Co., (1886) 3 R. P. C. 43.

(*v*) Piggott *v.* Anglo-American Telegraph Co., (1868) 19 L. T. N. S. 46; Batley *v.* Kynock, (1874) L. R. 19 Eq. 90: Cheetham *v.* Oldham, (1888) 5 R. P. C. 617; Shaw *v.* Bank of England, (1852) 22 L. J. N. S. Ex. 26: Meadows *v.* Kirkman, (1860) 29 L. J. N. S. Ex. 205.

(*y*) Batley *v.* Kynock, (1874) L. R. 19 Eq. 91.

(*z*) Piggott *v.* Anglo-American Telegraph Co., (1868) 19 L. T. N. S. 46.

(*a*) Sidebottom *v.* Fielden, (1891) 8 R. P. C. 266.

(*b*) Crofts *v.* Peach, (1836) 1 W. P. C. 268.

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and inspection of such apparatus may be obtained at the instigation of the plaintiff.(*c*) But where certain defendants alleged that the patent was anticipated by the sale of articles made according to the alleged invention by various persons named in the particulars, and the plaintiff applied for an order for the production before trial of the articles to be proved by the specified persons, the Court refused the application, on the ground that there was no precedent for such an order, and that on principle it ought not to be made.(*d*)

Plaintiff's affidavit on application for an order for inspection.

An affidavit made by the plaintiff on an application for an order for inspection should state that he has reason to believe that the process or machine used by the defendant is an infringement of his patent ; (*e*) it should also show the grounds of such belief,(*f*) and in what the invention of the plaintiff consists.(*g*) If the plaintiff makes out a *primâ facie* case of infringement, and that inspection is necessary to enable him to prove it at the trial, an order will follow almost as matter of course,(*h*) but inspection will be limited to those machines and processes in respect of which a *primâ facie* case of infringement is made out.(*i*)

Power of the Court to enforce an order for inspection.

The Court is not dependent on its power to compel inspection by treating as a contempt a refusal to comply with an order. The order of the Court may authorise any person, for the purpose of inspection, to enter upon or into any land or building that may be necessary.(*k*)

An order for inspection may be made at any time during the progress of an action, and may be obtained on summons or on motion.(*l*)

Delay no bar.

Delay in asking for an order for inspection is no bar.(*m*)

Postponement of the question of inspection.

If the party from whom inspection is sought objects, the Court or a Judge may, if satisfied that the right to inspection depends on the determination of any issue or question in dispute in the cause, or that for any other reason it is desirable that any issue or question in dispute in the cause should be determined

(*c*) Sidebottom *v.* Fielden, (1891) 8 R. P. C. 266.

(*d*) Garrard *v.* Edge, (1889) 6 R. P. C. 372.

(*e*) Shaw *v.* Bank of England, (1852) 22 L. J. N. S. Ex. 26.

(*f*) Germ Milling Co. *v.* Robinson, (1884) 1 R. P. C. 217.

(*g*) Meadows *v.* Kirkman, (1860) 29 L. J. N. S. Ex. 205.

(*h*) Singer Manufacturing Co. *v.* Wilson, (1865) 13 W. R. 560; 5 N. R. 505 ; Batley *v.* Kynock, (1874) L. R. 19 Eq. 90 ; Piggott *v.* Anglo-American Telegraph Co., (1868) 19 L. T. N. S. 46 ; Cheetham *v.* Oldham, (1888) 5 R. P. C. 617.

(*i*) Cheetham *v.* Oldham, (1888) 5 R. P. C. 617.

(*k*) R. S. C. 1883, Ord. l. r. 3.

(*l*) Judic. Act, 1873, s. 39 ; R. S. C. 1883, Ord. liv. r. 12 ; Ord. lv. r. 15 ; Frearson *v.* Loe, (1878) 26 W. R. 138.

(*m*) The Patent Type Founding Co. *v.* Walter, (1860) Johns, 727.

before deciding upon the right to the inspection, order that such issue or question be determined first and reserve the question as to the inspection.(*n*) Inspection.

The order for inspection generally makes it a condition that reasonable notice be given to the parties against whom it is made,(*o*) and, if the inspection relates to machinery, that the machines be put to work (*p*) in the presence of persons named,(*q*) and further specifies the number of inspections that are to be allowed.(*r*) Conditions.

A licensee not a party to the action cannot be compelled to give inspection in an action against his licensor, though the order be made.(*s*) Inspection against licensee not a party to the action.

It is sometimes objected that an inspection if granted would lead to the disclosure of trade secrets, and damage the trade of the party against whom it is sought, but such an objection will not deter the Court from making an order if it appears to be necessary in the interests of justice,(*t*) though the Court will endeavour to prevent an undue advantage being taken of secrets disclosed during an inspection.(*u*) Trade secrets.

In *Flower* v. *Lloyd*,(*x*) where inspection was resisted on the ground of disclosure of trade secrets, an arrangement was come to in the Court of Appeal whereby the defendant's works should be inspected by scientific men to be agreed upon, but not by the plaintiff.

In *Cheetham* v. *Oldham*,(*y*) the plaintiff, a rival manufacturer of the defendant, was himself allowed to take part in the inspection.

In *Plating Co.* v. *Farquharson*,(*z*) the Court made an order

(*n*) R. S. C. (1883) Ord. xxxi. r. 20.

(*o*) Drake *v.* Muntz's Metal Co., (1886) 3 R. P. C. 43; Germ Milling Co. *v.* Robinson, (1886) 3 R. P. C. 11; Flower *v.* Lloyd, Seton, 4th ed. p. 351; Russell *v.* Cowley, (1833) 1 W. P. C. 458; Davenport *v.* Jepson, (1862) 1 N. R. 173; Pemberton, 4th ed. 484, p. 236: Drake *v.* Muntz's Metal Co., (1886) 3 R. P. C. 43.

(*p*) Seton, 4th ed. p. 351; Beardsel, *v.* Schwann, Seton, 3rd ed. p. 910; Davenport *v.* Jepson, (1862) Pemberton, p. 484: Germ Milling Co. *v.* Robinson, (1886) 3 R. P. C. 11; Bovill *v.* Moore, (1815) 2 Coop. C. C. 56; Russell *v.* Cowley, (1833) 1 W. P. C. 458.

(*q*) Russell *v.* Cowley, (1833) 1 W. P. C. 458; Drake *v.* Muntz's Metal Co., (1886) 3 R. P. C. 43.

(*r*) Heathfield *v.* Braby, Seton, 4th ed. p. 1661; Germ Milling Co. *v.* Robinson, (1885) 3 R. P. C. 11.

(*s*) Germ Milling Co. *v.* Robinson, (1886) 3 R. P. C. 11, 14.

(*t*) Renard *v.* Levinstein, (1864) 10 L. T. N. S. 94; Piggott *v.* Anglo-American Telegraph Co., (1868) 19 L. T. N. S. 46; Smith *v.* G. W. Ry. Co., (1854) Macr. P. C. 223; Russell *v.* Crichton, 15 Dec. of Court of Session, 1st Series, 1270; Cheetham *v.* Oldham, (1888) 5 R. P. C. 617; Rylands *v.* Ashley's Patent (Machine Made) Bottle Co., (1890) 7 R. P. C. 175.

(*u*) Russell *v.* Crichton, (1837) 15 Decisions of Court of Session, 1st Series 1270; Flower *v.* Lloyd, Seton, 4th ed. p. 351; Plating Co. *v.* Farquharson, Lawson, Patents, Designs, and Trade Marks Acts, 2nd ed. 500.

(*x*) (1876) W. N. 169.

(*y*) (1888) 5 R. P. C. 617.

(*z*) (1881) Griff. P. C. 187.

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authorising inspection by a scientific expert, but bound him not to disclose his report on the facts or opinion obtained or arrived at by him, without the leave of the Court or a Judge, and, at the trial, the expert was not allowed to be called as a witness or cross-examined.

Where the defendant desired an inspection of machines not belonging to, but in the power of the plaintiff, and the Court thought that such inspection would be beneficial in the interests of justice, an order was made that the plaintiff should *bonâ fide* endeavour to procure the inspection desired, and report the result to the Court.(*a*)

Where an independent inspector is appointed, he is usually required to "report to the Court upon the facts, and his opinion founded upon them."(*b*)

Samples.

Besides granting inspection, the Court or a Judge has the power, which is frequently exercised, to authorise samples to be taken, or any observation to be made, or experiment to be tried, which may be necessary or expedient for the purpose of obtaining full information or evidence.(*c*)

Inspection of books.

It was held that the inspection authorised by the Act of 1852 (*d*) referred to an inspection of the instrument or machinery manufactured or used by the parties, with a view to evidence of infringement, and not to an inspection of books;(*e*) and probably the same meaning must be attached to the word as used in s. 30 of the Act of 1883, and an inspection of books would not be allowed on affidavit merely showing the possibility of discovering matters advantageous to the case of the party seeking it.(*f*)

Inspection when the action is founded solely on a threat to infringe.

An injunction may be obtained restraining a threatened infringement;(*g*) and in a case where it appeared that the defendant had entered into a contract to make certain paddle-wheels, which the plaintiffs alleged were a violation of their patent, an order was obtained from the Court authorising the plaintiffs and their witnesses to be at liberty to inspect at all seasonable times, giving reasonable notice, the paddle-wheels or

(*a*) Rylands *v.* Ashley's Patent (Machine Made) Bottle Co., (1890) 7 R. P. C. 175.

(*b*) The Plating Co. *v.* Farquharson, (1881) Lawson, Patents, Designs, and Trade Marks Acts, 2nd ed. p. 500; see 500; see also Hill *v.* Touts, *ibid.* 499.

(*c*) (1883) R. S. C. Ord. l. r. 3; Russell *v.* Cowley, (1833) 1 W. P. C. 459; The Patent Type Founding Co. *v.* Walter, (1860) Johns, 727; The Plating Co. *v.* Farquharson, (1881) Griff. P. C. 187; The Germ Milling Co. *v.* Robinson, (1886) 3 R. P. C. 14; Cheetham *v.* Oldham, (1888) 5 R. P. C. 621.

(*d*) s. 42.

(*e*) Vidi *v.* Smith, (1854) 3 E. & B. 969.

(*f*) Smith *v.* G. W. Ry. Co., (1854) Macr. P. C. 223.

(*g*) p. 504 *ante*.

machinery relating to paddle-wheels made, or to be made, pursuant to the said contract.(*h*)

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Evidence when defendant does not appear at the trial.

If the defendant puts in a defence and does not appear at the trial, the plaintiff is not entitled to judgment without proof of his case: he must prove the grant and show that the specification is good on the face of it and also prove the infringement.(*i*)

Evidence not within the particulars.

By the Patent Act of 1852,(*k*) the evidence of both the plaintiff and the defendant was strictly confined to the particulars which had been given, and, therefore, if at the trial either party wished to give evidence not within them, the proper course was to apply at once for leave to amend, on the ground that fresh evidence had come to light since they were delivered.(*l*)

The Act of 1883 has somewhat enlarged the opportunities open to litigants of giving evidence at the trial by enacting that at the hearing no evidence shall, *except by the leave of the Court or a Judge*, be admitted in proof of any alleged infringement or objection of which particulars have not been delivered;(*m*) but it is not safe to rely on the Court granting the necessary leave, and consequently, if a party desire to go outside his particulars on the ground that the evidence was discovered since they were delivered, he should still apply for leave to amend, which will, however, not be granted unless he makes out a sufficient case,(*n*) and then only upon the usual terms. But the Court—*i.e.*, both the Court of First Instance and the Court of Appeal—has undoubted discretion under the Act of 1883 to admit evidence not within the particulars without requiring an amendment of the particulars.(*o*)

Particulars not objected to are construed widely.

When particulars have been delivered, and not objected to, such evidence may be given under them as their words are sufficiently wide to include;(*p*) and, however general they may be, if the evidence tendered is within their literal meaning, it will be admitted.(*q*)

(*h*) Morgan *v.* Seaward, (1835) 1 W. P. C. 169.

(*i*) Peroni *v.* Hudson, (1884) 1 R. P. C. 261.

(*k*) s. 41.

(*l*) Daw *v.* Eley, (1861) L. R. 1 Eq. 38.

(*m*) s. 29 (4).

(*n*) Moss *v.* Malings, (1886) L. R. 33 Ch. D. 603; Renard *v.* Levinstein, (1864) 13 W. R. 229; 11 L. T. N. S. 505.

(*o*) Britain *v.* Hirsch, (1888) 5 R. P. C. 226; see also p. 527 *ante*.

(*p*) Neilson *v.* Harford, (1841) 1 W. P. C. 332, 370.

(*q*) Hull *v.* Bollard, (1856) 1 H. & N. 134; Curtis *v.* Platt, (1866) 35 L.J. N. S. Ch. 852, 868; Sugg *v.* Silber, (1877) L. R. 2 Q. B. D. 495; Sykes *v.* Howarth, (1879) L. R. 12 Ch. D. 826; 48 L. J. N. S. Ch. 769; see also Adair *v.* Young, (1879) W. N. p. 8.

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Thus evidence of user in Cheshire was admitted under an objection which alleged that the invention had been publicly used in "corn mills";(*r*) and where the particulars alleged infringement by manufacture and sale at divers times between specified dates and also two specified instances of sale, evidence of a third sale was allowed, the defendant having, by his interrogatories, admitted such a sale.(*s*) When, however, an order for amendment of the particulars of objection had not been complied with, evidence of an anticipating specification not given under the order was not admitted.(*t*)

Patentee who has assigned his interest is a competent witness.

A patentee who has assigned the whole of his interest is a competent witness for the assignee in any action he may bring for the infringement of the patent.(*u*) If the patentee has covenanted with the assignee in respect of the validity of the patent, he may have an interest in the event of a subsequent action in which the question of validity is raised, but his evidence would not be excluded, although his interest would be a matter to be taken into consideration as affecting his credit.(*x*)

Licensee may be a witness for the plaintiff.

A licensee is also a competent witness for the plaintiff in a patent action,(*y*) though he may be an interested one.(*z*)

If the licensee is empowered to use the invention in consideration of a periodical payment or a payment in proportion to the extent of his user, he cannot have an interest in supporting the patent (unless the payments are merely nominal or not a full consideration for the privilege granted), but he may be interested in its destruction. If the licensee has paid a gross sum for an irrevocable licence, or has obtained it for any other consideration, he may have an interest in supporting the patent, for if the invention be thrown open to the public he cannot obtain any benefit from the licence.

but not when the action is brought for his own benefit.

If, however, the action be brought for the benefit of the licensee who has an exclusive licence for some particular district, he would not be a competent witness for the plaintiff, because he would be a person "in whose immediate and individual behalf" the action was brought.(*a*)

Necessity for

In patent actions the testimony of experts frequently forms

(*r*) Hull *v.* Bollard, (1856) 1 H. & N. 134.
(*s*) Sykes *v.* Howarth, (1879) L. R. 12 Ch. D. 826; 4 L. J. N. S. Ch. 769.
(*t*) Lister *v.* Leather, (1858) 3 Jur. N. S. 811.
(*u*) Bloxam *v.* Elsee, (1825) 1 C. & P. 563.
(*x*) 6 & 7 Vict. c. 85, s. 1.
(*y*) *Ibid.*
(*z*) *Ibid.*
(*a*) *Ibid.*

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and the value of the evidence of experts.

the chief part of the evidence submitted to the Court both in importance and in volume. The following remarks of the late Lord *Bowen* illustrate the great importance of the evidence of scientific men of repute in cases, such as Patent actions, where it is the duty of the Court to inform itself as to the state of scientific knowledge at the date of the patent bearing upon the subject-matter of the dispute between the parties.

"If we are to act in the present instance, one must fall back upon the opinions of experts, and I wish emphatically to state my view, that in a matter like the present, so far from thinking the opinions of experts unsatisfactory, it is to the opinion of experts that I myself should turn with the utmost confidence and faith. Courts of law and courts of justice are not fit places for the exercise of the inductive logic of science. Life is short; it is impossible to place endless time at the disposal of litigants; and the laws of evidence are based upon this very impossibility of prolonging inquiries to endless length. There is hardly a scientific theory in the world which, if we were to examine into it in law courts, might not take year after year of the whole time of a tribunal. Supposing, for a moment, one had brought in question the circular theory of storms, and were to propose before a tribunal like this to examine it, not by reference to the opinions of the most experienced persons who have made it a subject of study and investigation, but to inquire ourselves into all the special circumstances of storms, with which witnesses could favour us who had crossed the Atlantic or the Eastern seas, in order to form our opinion, assisted, no doubt, by scientific men, as to the circular theory of storms, with all the qualifications which might be adopted, and with all the definitions in which it might be embodied. Take another instance of a law which is very far from likely to be accepted by science, but most probably would be rejected as pure theory, and as utterly beyond reason. I believe there are many persons in India who endeavour to connect the existence of famine raging over tracts of country with spots on the sun. Supposing that theory were brought up in an English court of law, we should be bound to embark on an endless inquiry into all the instances in which spots on the sun had been found to be coincident with famines in India. The truth is, when you are dealing with scientific theories, it is hopeless for courts of law to do more than to take the evidence of scientific men, subject, no doubt, to cross-examination, which may or may not condescend to particular instances, which may be brought home to them to show, if it exists, the uncertainty of the grounds upon which their opinions are founded. The result of the admission of this evidence,

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assuming it, as I do, to be admissible, has been, in my judgment, to show that the endeavour to utilise such evidence launches us upon an inquiry fit only for the leisure of learned and scientific men, but for which the jury system and the judicial system are probably inadequate." (*b*)

Expert evidence is admissible to explain technical terms, to show the practical working of machinery described or drawn, to point out what is old and what is new in the specification, to show the particulars in which an alleged invention has been used by an alleged infringer or the real importance of any differences between the plaintiff's invention and the alleged infringement, and what are and what are not mechanical or chemical equivalents. But the nature of the invention for which a patent is granted must be ascertained from the specification, and has to be determined by the Judge and not by a jury, nor by any expert or other witness, which is familiar law, although often disregarded by counsel when examining witnesses.(*c*)

The Court always scrutinises very carefully—even with suspicion—expert evidence and experiments prepared expressly for the purposes of either party at the trial.(*d*)

Proof of the grant of the patent,

If the grant of the patent be denied, it must be proved by the production of the letters patent themselves or a copy thereof certified by the Comptroller and sealed with the seal of the Patent Office,(*e*) and no further proof is necessary.

The letters patent are only proof of the *purport* of the grant which they contain, the effect or operation of the grant being quite a different question. Although letters patent purport to grant a sole privilege to the patentee, it may be that the patent is for some reason illegal or void, and, if so, the patent is of no force, and the grant it purports to make has no operation, and consequently it is strictly correct to say that the Queen did not make such a grant as the plaintiff alleges, for a void grant is the same as no grant at all.(*f*) The letters patent merely prove the purport of the grant, and upon any dispute respecting the invention the specification must be read and considered as incorporated with the patent.(*g*)

(*b*) Fleet *v.* The Managers of the Metropolitan Asylums District (1886); Cunningham's "Life of Lord Bowen," p. 162.

(*c*) See Brooks *v.* Steel, (1896) 14 R. P. C. 73; Ticket Punch Register Co. *v.* Colley's Patents, (1895) 12 R. P. C. 186.

(*d*) Betts *v.* Neilson, (1868) L. R. 3 Ch. 433; Young *v.* Fernie, (1864) 4 Giff. 609; Plimpton *v.* Malcolmson, (1876) L. R. 3 Ch. D. 576; Crampton *v.* Patents Investment Co., (1888) 5 R. P. C. 382, 404.

(*e*) 46 & 47 Vict. c. 57, s. 89.

(*f*) Hindmarch, p. 440.

(*g*) Hornblower *v.* Boulton, (1799) 8 T. R. 102; Dav. P. C. 221; Crossley *v.* Beverley, (1829) 9 B. & C. 63.

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and the scope of the invention claimed.

It is incumbent on the plaintiff to prove what the invention really is for which the patent was granted. The proper way to do this is to put in the specification, and neither the patentee nor any other witness can be called to prove what the real invention is, the question being one which can only be answered from a critical examination of the specification,(*h*) which must, however, be interpreted by the light of public knowledge at the date of the grant, external evidence of which is, therefore, admissible for the purpose of deciding between two possible constructions of a claim.(*i*) Evidence of the patentee cannot be tendered to show what effect was intended by the specification.(*k*)

Issue of true and first inventor.

If the defendant raises the issue that the patentee was not the true and first inventor, the *onus* of proof rests with him, but it is usual for the plaintiff to tender *primâ facie* evidence to the effect that the patentee was the first person who actually communicated the invention to the public.(*l*) This is usually done by calling the patentee himself, who claims to be the inventor; but when the patent was obtained on a communication from abroad, it is not necessary to call the foreign inventor.(*m*)

Issue of subject-matter.

The decision of the issue raised by a plea that the alleged invention could not form the subject-matter of a valid patent rests more with a judge than a jury. The plaintiff must give the specification in evidence, in order that the judge may see what the alleged invention really is; and if there are terms of art involved, the jury, or judge acting as a jury, must determine the meaning to be applied to them in the construction of the specification, which is the duty of the Court alone.(*n*) It should also be remembered that the ingenuity of any alleged invention—*i.e.*, whether there has been a sufficient expenditure of the inventive faculty to support the patent on the ground of subject-matter—is to be judged in the light of the state of public knowledge at the time it was made.(*o*) If the issues of subject-matter, novelty, and utility, or sufficiency of specification, have been decided on a previous occasion by a Court of co-ordinate or superior jurisdiction, the Court as a matter of convenience considers itself bound by the finding of the

(*h*) Badische Anilin und Soda Fabrik *v.* Levinstein, (1887) L. R. 12 App. Cas. 717; Hinks *v.* Patent Safety Lighting Co., (1876) L. R. 4 Ch. D. 618; Brooks *v.* Steel, (1896) 14 R. P. C. 73; p. 467 *ante*.

(*i*) p. 251 *ante*.

(*k*) Kaye *v.* Chubb, (1887) 4 R. P. C. 289, 298.

(*l*) pp. 15, 17 *ante*.

(*m*) Nettlefolds *v.* Reynolds, (1892) 9 R. P. C. 270; Badische Anilin und Soda Fabrik *v.* Levinstein.

(*n*) p. 237 *ante*.

(*o*) p. 33 *ante*.

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Court on the former occasion, so far as the same evidence is concerned, and will refuse to admit such evidence again.(*p*) Of course, if different evidence is adduced on any of these points, and there is no estoppel on the ground of the matter being *res judicata* between the parties, or from any other cause, the Court receives and gives effect to such fresh evidence.(*q*)

The plea of want of novelty does not put in issue the fact of the invention being a manufacture within the meaning of the Statutes of Monopolies for which a patent could be granted ;(*r*) *i.e.*, it does not raise the issue of subject-matter.

When novelty is in issue plaintiff must give *primâ facie* evidence,

If the novelty of the invention be denied, the plaintiff must give *primâ facie* evidence that the invention had not been communicated to the public before the date of the patent.(*s*) In order to do this the plaintiff must call witnesses whose avocations were likely to have made them acquainted with the subject-matter of the alleged invention if it had been published prior to the date of the patent, and who are able to testify that it was unknown to them. It is clear that only indirect evidence of novelty can be given, since it is impossible to examine every member of the public; but if the plaintiff calls witnesses who for some time before the date of the patent were well acquainted with the particular branch of trade or manufacture to which the invention relates, and who can swear that they were ignorant of it until after the date of the patent, this will be sufficient *prima facie* evidence, and the *onus* of proving the negative will then be on the defendant.(*t*)

If the invention consist of several parts claimed separately,(*u*) or if several inventions have been comprised in the same patent,(*x*) it is incumbent on the plaintiff to give *primâ facie* proof of the novelty of all the parts, or all the inventions, as the case may be.(*y*)

after which the onus is on the defendant.

After the plaintiff has made a *primâ facie* case in respect of novelty, the *onus* is on the defendant of showing that the invention was public property at the date of the patent, and,

(*p*) Slazenger *v.* Feltham, (1889) 6 R. P. C. 130.

(*q*) p. 522 *ante*.

(*r*) p. 20 *ante*.

(*s*) Turner *v.* Winter, (1787) Dav. P. C. 153; Manton *v.* Manton, (1815) Dav. P. C. 348; Bovill *v.* Moore, (1815) Dav. P. C. 399; Galloway *v.* Bleaden, (1839) 1 W. P. C. 525; Cornish *v.* Keene, (1835) 1 W. P. C. 509.

(*t*) Cornish *v.* Keene, (1835) 1 W. P. C. 509; Manton *v.* Manton, (1815) Dav. P. C. 350, 353; Galloway *v.* Bleaden, (1839) 1 W. P. C. 526; Amory *v.* Brown, (1869) L. R. 1 Eq. 663; Harris *v.* Rothwell, (1887) L. R. 35 Ch. D. 416, 427.

(*u*) Manton *v.* Manton, (1815) Dav. P. C. 340, 341; Gibson *v.* Brand, (1841) 4 M. & G. 179; Gillett *v.* Wilby, (1839) 9 Car & P. 334; Losh *v.* Hague, (1837) 1 W. P. C. 208.

(*x*) Brunton *v.* Hawkes, (1820) 4 B. and Ald. 541; p. 294 *ante*.

(*y*) Chap. iii.

consequently not new as to the public knowledge and use of it,(*z*) but the evidence of one witness may be quite sufficient to do this;(*a*) though, if an alleged prior use made a long time ago is relied on, the uncorroborated evidence of persons interested in defeating the patent ought not to carry the alleged prior use further than an experimental use.(*b*) Evidence.

When a published document is alleged as an anticipation, evidence should be called to explain it, if necessary.(*c*) But if the anticipation relied on is an English complete specification filed in the Patent Office no proof is required of further publication or its contents having been seen by the public,(*d*) for the second of two patents for the same invention must be bad in law.(*e*) Documents as evidence of publication.

Where the want of novelty appears distinctly from a written document, it is for the Court, and not the jury, to determine the identity of the two supposed inventions,(*f*) aided as to the meaning of technical expressions by the finding of the jury, or the Judge acting as a jury.(*g*) But when a skilled workman, with the knowledge common to the trade at the date of the trial, produces in evidence a successful result, which he says he arrived at by following only the directions of an old and unused paper anticipation, the Court weighs very carefully indeed such evidence before accepting it.(*h*)

Upon the issue of novelty the plaintiff is entitled to call evidence in reply for the purpose of rebutting that given by the defendant, on whom lies the *onus* of proving his case,(*i*) and such rebutting evidence is usually called at the close of the defendant's case.(*k*) Thus, at the hearing of an action where evidence had been admitted on behalf of the defendants Rebutting evidence may be given by the plaintiff on the issue of want of novelty.

(*z*) Penn *v.* Jack, (1866) L. R. 2 Eq. 314; Minter *v.* Wells, (1834) 1 W. P. C. 129; Peroni *v.* Hudson, (1884) 1 R. P. C. 261.

(*a*) Badham *v.* Bird, (1888) 5 R. P. C. 238.

(*b*) Dick *v.* Tullis, (1896) 13 R. P. C. 149; Pneumatic Tyre Co. *v.* Marwood, (1897) 14 R. P. C. 240; p. 106 *ante*.

(*c*) Hocking *v.* Fraser, (1886) 3 R. P. C. 63; Bovill *v.* Smith, (1868) Griff. L. O. C. 52; Betts *v.* Menzies, (1862) 10 H. L. Cas. 117; pp. 107–110 *ante*.

(*d*) Plimpton *v.* Malcolmson, (1876) L. R. 3 Ch. D. 551, 557; Harris *v.* Rothwell, (1887) L. R. 35 Ch. D. 416, 428.

(*e*) Chap. ii.

(*f*) Bush *v.* Fox, (1856) 5 H. L. Cas. 707; Booth *v.* Kennard, (1857) 2 H. & N. 84; Hills *v.* London Gas Light Co., (1860) 5 H. & N. 312; Betts *v.* Menzies, (1862) 10 H. L. Cas. 134; Harwood *v.* Great Northern Ry. Co., (1865) 11 H. L. Cas. 654; Simpson *v.* Holliday, (1866) L. R. 1 H. L. 315.

(*g*) Betts *v.* Menzies, (1862) 10 H. L. Cas. 134; Harwood *v.* Great Northern Ry. Co., (1865) 11 H. L. C. 654; Simpson *v.* Holliday, (1866) L. R. 1 H. L. 320.

(*h*) Defries *v.* Sharwood, (1897) 13 R. P. C. 313; Plimpton *v.* Malcolmson; p. 575 *post*.

(*i*) p. 572 *ante*.

(*k*) Penn *v.* Jack, (1866) L. R. 2 Eq. 314; Westley Richards and Co. *v.* Perkes, (1893) 10 R. P. C. 187.

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which was not included under the particulars, the case was ordered to stand over, to allow of the plaintiff having an opportunity of rebutting such evidence, the defendants being allowed to amend their particulars.(*l*)

Recalling witnesses.

A plaintiff, however, who has tendered evidence of novelty, and has had his attention called to a particular alleged anticipating document, cannot for the purpose of explaining its contents recall a witness in reply, who when he gave his evidence was acquainted with the document.(*m*) A plaintiff has been allowed, after the conclusion of all evidence, but before judgment, which had been reserved, to give fresh evidence on a point relevant to the issue, which had not been "threshed out."(*n*)

A defendant cannot recall the plaintiff's witnesses, after the conclusion of the cross-examination, in order to put to them fresh instances of publication, unless it can be shown that such instances only came to the defendant's knowledge since the cross-examination, and could not, with due diligence, have been discovered earlier;(*o*) and he will not be allowed to give further evidence in answer to that given by the plaintiff in reply, if his evidence has been summed up.(*p*)

Notice to admit documents.

If the defendant relies upon publication in a prior document, he should give the plaintiff notice to admit that the document was published prior to the date of the patent. If the publication of any document is not admitted, it must be proved by calling the librarian of the public library at which the book or document was before the date of the patent.(*q*)

Where an affidavit of documents had been required by the plaintiff, he was not allowed to recall one of the defendant's witnesses for the purpose of cross-examining him as to the contents of a report the defendant had received from a patent agent, which report was not produced, and was only referred to at a late stage of the trial.(*r*)

Models as evidence.

Models are similar to documentary evidence, and the Court will draw its own conclusions from them.(*s*) If a witness goes too far in his statements or admissions as to the effect of an

(*l*) Blakey *v.* Latham, (1889) 6 R. P. C. 29, 36.

(*m*) Tetley *v.* Easton, (1852) Mac. P. C. 61.

(*n*) Boyd *v.* Horrocks, (1888) 5 R. P. C. 557.

(*o*) Moss *v.* Malings, (1886) 3 R. P. C. 373.

(*p*) Penn *v.* Jack, (1866) L. R. 2 Eq. 24.

(*q*) R. S. C. (1883) Ord. xxxii. r. 4.

(*r*) Sugg *v.* Bray, (1884) 54 L. J. N. S. Ch. 132.

(*s*) Seed *v.* Higgins, (1860) 8 H. L. Cas. 565; Westinghouse *v.* L. & Y. Ry. Co., (1884) 1 R. P. C. 245; Bovill *v.* Smith, (1868) Griff. L. O. C. 52; Winby *v.* Manchester, &c., Steam Tramways Co., (1891) 8 R. P. C. 63.

alleged anticipation, and proved or admitted models are before the Court, the Court may be guided by the actual models themselves, notwithstanding the statements or admissions of the witness.(*t*) Evidence.

When the difference between the patented article and an alleged disused prior anticipation is something apparently slight, but really important, the Court ought not to accept the evidence of a man who puts forward a perfected model as representing his idea of the alleged anticipation, when it appears that before making the model he saw the form patented, and made it with that knowledge evidently in his mind. Thus, *Jessel*, M.R., in the *Plimpton* skate case,(*u*) said, "I will not accept the evidence of any man who says that the drawing in the Patent Office is represented by a model if he has seen the real *Plimpton* skate."

It is, of course, a most improper thing for a party to make any alteration in the working power of a model once put in evidence, whether by cleaning or otherwise, unless it be done by permission of the Court, and upon notice to, and, if desired, in the presence of the other party, or his advisers.(*x*)

If the plea of want of utility is raised as an objection to the patent, the plaintiff must give *primâ facie* evidence to prove that the invention was useful to the public at the date of the grant.(*y*) It is important to do this, since the evidence of utility raises a presumption in favour of novelty and ingenuity.(*z*) Proof of utility.

If the defendant sets up a *primâ facie* case that the invention was not useful, the burden is then on the plaintiff to prove that it was useful.(*a*)

The fact that the defendant has attempted to infringe is itself evidence of utility.(*b*)

The degree of utility is quite immaterial under this issue; it is quite sufficient if the plaintiff can show that the invention was of *any* utility to the public.(*c*)

(*t*) Seed *v.* Higgins, (1860) 8 H. L. C. 565; *Moore v. Bennett*, (1884) 1 R. P. C. 137.

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

(*x*) Winby *v.* Manchester, &c., Steam Tramways Co. (2), (1891) 8 R. P. C. 63.

(*y*) Chap. iv., R. *v.* Arkwright. (1785) Dav. P. C. 135; Manton *v.* Parker, (1815) Dav. P. C. 327; Manton *v.* Manton, (1815) Dav. P. C. 333; Bovill *v.* Moore, (1815) Dav. P. C. 399; Minter *v.* Wells, (1834) 1 W. P. C. 129; Hill *v.* Thompson, (1817) 2 W. P. C. 237; Crane *v.* Price, (1842) 1 W. P. C. 411; Russell *v.* Cowley, (1835) 1 W. P. C. 467; *Brunton v. Hawkes*, (1820) 4 B. & Ald. 541; Derosne *v.* Fairie, (1835) 5 Tyr. 393; 2 Cr. M. & R. 476.

(*z*) Lyon *v.* Goddart, (1893) 10 R. P. C. 121, 334, 343; 11 R. P. C. 354.

(*a*) Ehrlich *v.* Ihlee, (1888) 5 R. P. C. 449.

(*b*) Lucas *v.* Miller, (1885) 2 R. P. C. 160; Reynolds *v.* Amos, (1886) 3 R. P. C. 215: United Horseshoe and Nail Co. *v.* Stewart, (1888) L. R. 13 App. Cas. 407; Badische Anilin und Soda Fabrik *v.* Levinstein, (1887) L. R. 12 App. Cas. 712.

(*c*) p. 146 *ante*.

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The question of utility must be determined with reference to the date of the patent. If it can be shown that it was then of some utility to the public, it is no objection that owing to more recent improvements it has since become useless;(*d*) and, if the patentee has obtained a subsequent patent for an improvement on a prior invention, it is not to be inferred that the prior invention was therefore useless.(*e*)

Each essential part of the invention must be shown to be useful;(*f*) for, if a material part is useless, the patent is void.(*g*)

It is not necessary that the utility of every part of an invention should be proved by actual trial; evidence of skilled persons to the effect that if tried it would answer may be sufficient.(*h*) Thus, in *Neilson* v. *Harford*(*i*) a question arose as to the utility of a certain vessel which according to the specification formed a material part of the invention. There was no evidence of any person having actually tried the vessel of the shape in question, but there was the evidence of scientific witnesses to the effect that it would answer, and the Judge who tried the case told the jury that if they were satisfied with that evidence it was quite sufficient to establish utility.

If the plaintiff proves that the invention as a whole is useful, he is not bound to prove that each part of it possesses an equal amount of utility.(*k*)

Effect of user on the issue of utility.

The fact that an invention has not come into general use raises a strong presumption against its utility;(*l*) but it is not to be assumed from such evidence that the invention was not sufficiently useful to support a patent. The reason why an invention has not come into general use may be that immediately after the discovery an improvement upon it may have been produced, which, for commercial reasons, prevented the general adoption of the former invention.(*m*)

It is to be observed that a large sale of a patented article

(*d*) p. 143 *ante*.

(*e*) Otto *v.* Linford, (1881) 46 L. T. N. S. 39; Edison *v.* Holland, (1889) 6 R. P. C. 277; Thompson *v.* Batty, (1889) 6 R. P. C. 100; p. 67 *ante*.

(*f*) p. 146.

(*g*) Hill *v.* Thompson, (1818) 8 Taunt. 375; United Horseshoe and Nail Co. *v.* Stewart, (1885) 2 R. P. C. 122, 132.

(*h*) pp. 144, 210 *ante*.

(*i*) (1841) 1 W. P. C. 295.

(*k*) p. 144, 149, 210 *ante*; Ehrlich *v.* Ihlee, (1888) 5 R. P. C. 203.

(*l*) Morgan *v.* Seaward, (1837) 1 W. P. C. 185; Simister's Patent, (1842) 1 W. P. C. 723; Morgan *v.* Windover, (1888) 5 R. P. C. 303; *Re* Bakewell's Patent, (1862) 15 Moo. P. C. 386; *Re* Allan's Patent, (1867) L. R. 1 P. C. 507; 4 Moo. P. C. N. S. 443.

(*m*) Badische Anilin und Soda Fabrik *v.* Levinstein, (1887) L. R. 12 App. Cas. 710, 712; United Telephone Co. *v.* Bassano, (1886) 3 R. P. C. 313; Kurtz *v.* Spence, (1888) 5 R. P. C. 182; Ehrlich *v.* Ihlee, (1888) 5 R. P. C. 450; Edison *v.* Holland, (1888) 5 R. P. C. 283.

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does not necessarily prove that it possesses the kind of utility which the patent law requires to support a patent—*i.e.*, that it is useful for the purpose in view,(*n*) or that it is novel.(*o*) The reason why the article has a large sale may be that it is well advertised, or got up in a manner likely to attract the purchasing public.(*p*) On the other hand, the fact that thousands of a patented article have been sold, and, in consequence of their superiority, others of a similar nature have become a drug in the market, may afford evidence of the utility of the patent.(*q*)

Proof of sufficiency of the specification.

The burden of giving some evidence of the sufficiency of the specification is upon the plaintiff, as was held by *Bullen*, J., in a case in which his Lordship is reported to have said: "I do not agree with the counsel who have argued against this rule in saying that it was not necessary for the plaintiff to give any evidence to show what the invention was, and that the proof that the specification was improper lay on the defendant; for I hold that a plaintiff must give some evidence to show what his invention was, unless the other side admits that it has been tried and succeeds. But wherever the patentee brings an action on his patent, if the novelty or effect of the invention be disputed, he must show in what his invention consists, and that he produced the effect proposed by the patent in the manner specified. Slight evidence of this on his part is sufficient, and it is incumbent on the defendant to falsify the specification."(*r*)

A plea of the insufficiency of the specification puts the plaintiff to the necessity of giving evidence to the effect that the specification does particularly describe and ascertain the nature of the invention, and in what manner it is to be performed.

For the purpose of proving the sufficiency of the specification it is enough for the plaintiff to call workmen of ordinary intelligence engaged in the trade to which the invention relates who are able to state that they can or have actually performed the invention with no other aid than the specification.(*s*)

Under an issue of insufficiency of the specification the plaintiff must prove that it sufficiently describes and ascertains every part of the invention; that it is intelligible to persons of ordinary

(*n*) pp. 143, 144 *ante*.
(*o*) pp. 27, 95 *ante*.
(*p*) Cole *v.* Saqui, (1888) 5 R. P. C. 489; 6 R. P. C. 41.
(*q*) Ehrlich *v.* Ihlee, (1888) 5 R. P. C. 437, 449; American Braided Wire Co. *v.* Thompson, (1888) 5 R. P. C. 113.
(*r*) Turner *v.* Winter, (1787) Dav. P. C. 153; 1 T. R. 606.
(*s*) Cornish *v.* Keene, (1835) 1 W. P. C. 503; Shaw *v.* Jones, (1889) 6 R. P. C. 335; Edison *v.* Holland, (1889) 6 R. P. C. 243.

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skill engaged in the trade to which the invention relates; and that the invention is capable of producing the effects specified.(*t*) If there are any technical terms or terms of art used in the specification which require explanation to make the description intelligible, evidence must be given of their meaning, but the plaintiff is not allowed to correct or explain any error or misdescription unless they be such that they could not possibly mislead.(*u*)

If the defendant can prove that there is anything material stated in the specification which is false(*x*) or calculated to mislead or puzzle a person who might attempt to follow its directions, the patent will be void.(*y*)

Proof of infringement.

The construction of the specification is for the Court, aided by such facts as are admissible, to explain written documents. The evidence of scientific witnesses is only admissible as proof of facts. Their opinion as to whether there has been an infringement or not, though sometimes received in order to save time and trouble, is, strictly speaking, inadmissible, and if objected to ought to be rejected.(*z*)

When expert evidence is called for the purpose of explanation, and the first witness explains all that requires explanation, and is not broken down in cross-examination, there is no need to call further expert witnesses on the same points, and it is not admissible to do so.(*a*)

In order to substantiate the allegation of infringement, the plaintiff must prove that the defendant has used the art which forms the subject-matter of the patent, or that he has violated the patent privilege in the manner alleged in the statement of claim. And in order to make out his case it is not necessary that the plaintiff should prove that the defendant has used the whole of the art or invention comprised in the patent; it is sufficient to show that he has used any essential part of it.(*b*)

The same rule applies to the infringement of all patents, whether they are "pioneer" or "master patents" or not—*i.e.*, in order to make out infringement it must be established to the

(*t*) p. 144 *ante*.
(*u*) p. 255 *ante*.
(*x*) Bickford *v.* Skewes, (1841) 1 Q. B. 938; Lewis *v.* Marling. (1829) 10 B. & C. 22.
(*y*) pp. 178, 183, 191 *ante*.
(*z*) Seed *v.* Higgins, (1860) 8 H. L. C. 565; Bovill *v.* Smith, (1868) Griff. L. O. C. 52; Westinghouse *v.* Lancashire and Yorkshire Ry. Co., (1884) 1 R. P. C. 245.
(*a*) Automatic Weighing Machine Co. *v.* Knight, (1889) 6 R. P. C. 116.
(*b*) Cornish *v.* Keene, (1835) 1 W. P. C. 501; Morgan *v.* Seaward, (1836) 1 W. P. C. 170; Jones *v.* Pearce, (1832) 1 W. P. C. 124; Crane *v.* Price, (1842) 4 M. & G. 580; Hill *v.* Thompson, (1817) 8 Taunt. 375; 3 Mer. 622; 1 W. P. C. 232; pp. 466–473 *ante*.

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satisfaction of the Court that the alleged infringer, dealing with what he is doing as a matter of substance, is taking the invention claimed by the patent, not the invention which the patentee might have claimed if he had been well advised or bolder, but that which he has in fact and substance claimed on a fair construction of the specification.(*c*)

Effect of prior construction of the specification by a Court of equal jurisdiction.

It is sometimes stated that the Court is bound by the construction put upon the specification by a Court of equal or superior jurisdiction in prior proceedings, but this statement is only partially true. When it is a matter of pure construction of the document itself, and the construction is not dependent upon a consideration of the external facts as to prior knowledge, the Court, as a matter of convenience to itself, follows the construction adopted by a Court of equal jurisdiction;(*d*) but whether the claim is too wide is a question of fact which must be decided *de novo* in the light of any fresh evidence as to the state of public knowledge which may be adduced in any subsequent action.(*e*)

Defendant himself a patentee.

The fact that the defendant has himself obtained a patent for what he is doing, is in itself no evidence of infringement, and the defendant is not placed thereby in any different position to any other member of the public. The question is what he has in fact done.(*f*)

Evidence must be given to the effect that the alleged infringement was not committed by an agent or under the licence of the patentee.

It must be proved strictly that the alleged infringing article was not made by the plaintiff, or any agent or licensee of the plaintiff.(*g*) Where the plaintiff omits to give this necessary evidence and merely proves the sale of the article by the defendant, an opportunity may be given him of perfecting the evidence, if he is able to do so, after his case is closed.(*h*) Care must, therefore, be taken, in collecting evidence of infringement, that the article relied on as proof of infringement was not made by the alleged infringer under such circumstances that he can contend that what he did was as agent of the plaintiff and therefore no infringement. Thus when a patentee for the purpose of getting evidence of infringement sent an agent to a manufacturer and ordered an article to be made in a particular way which was within the patent, and then, after obtaining it, moved for an interim injunction, the Court dismissed the motion

(*c*) Per Romer, J., Nobel's Explosives Co. *v.* Anderson, (1894) 11 R. P. C. 128.

(*d*) Edison *v.* Holland, (1889) 6 R. P. C. 276: Automatic Weighing Machine Co. *v.* Knight, (1889) 6 R. P. C. 367.

(*e*) *Ibid.*

(*f*) Tweedale *v.* Ashworth, (1890) 7 R. P. C. 431.

(*g*) Betts *v.* Willmott, (1871) L. R. 6 Ch. 239: 25 L. T. N. S. 181.

(*h*) Farbenfabriken vorm F. Bayer *v.* Bowker, (1891) 8 R. P. C. 389.

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with costs on the ground that the defendant, having worked to the detailed orders of the plaintiff's agent, was not liable as an infringer.(*i*)

When it is sufficient for the plaintiff to make out a *primâ facie* case of infringement.

There are many cases in which it is impossible to ascertain what it is the defendant has done. Under such circumstances the proper course is for the plaintiff to make out a *primâ facie* case, and if the plaintiff makes out a *primâ facie* case which the defendant does not venture to answer, the Court will conclude that the alleged wrongful acts have been done in the manner which the plaintiff or his witnesses believe.(*k*) The defendant may, however, give evidence to show that what he has done does not amount to a user of the art protected by the patent. Thus he may prove that the articles complained of are substantially different to those described in the specification, or that they were manufactured according to a process different to that claimed by the patentee, and this will be a complete answer to the charge of infringement.(*l*)

If the patent is for a process only and does not include the manufactured article, the *onus* is on the plaintiff to show that the article alleged to have been manufactured in infringement has, in fact, been so made.(*m*) And similarly, if the patent is for the manufacture of any particular machine, the sale of an article made by the machine might be no proof of infringement.

If the plaintiff proves that the defendant has without authority (*n*) sold a patented article he makes out a *primâ facie* case of infringement, and throws the *onus* on the defendant of showing either that he was a licensee of the plaintiff, or that he bought the article from a person who was authorised by the plaintiff to manufacture and sell it.(*o*)

Evidence that a defendant gave an order in England, which order was executed in England, for the manufacture by a patented process of articles which were afterwards received by him, is quite sufficient to satisfy an allegation that he made those articles; for he that causes and procures things to be made may well be said to have made them himself.(*p*)

(*i*) Kelly *v.* Batchelor, (1893) 10 R. P. C. 289.

(*k*) Huddart *v.* Grimshaw, (1803) Dav. P. C. 265; Hall *v.* Jarvis, (1822) 1 W. P. C. 100; Badische Anilin und Soda Fabrik *v.* Dawson,(1889) 6 R.P.C. 387, 396; Edison *v.* Woodhouse, judgment of Butt, J., (1886) 3 R. P. C. 167.

(*l*) Morgan *v.* Seaward, (1837) 1 W. P. C. 171; Walton *v.* Potter, (1841) 1 W. P. C. 585, 589.

(*m*) Palmer *v.* Wagstaffe, (1853) 8 Exch. R. 840; 22 L. J. N. S. Ex. 295; 9 Exch. R. 449; 23 L. J. N. S. Ex. 217.

(*n*) Betts *v.* Willmott, (1870) L. R. 6 Ch. 239.

(*o*) Badische Anilin und Soda Fabrik *v.* Dawson, (1889) 6 R. P. C. 387, 396; Gibson *v.* Brand, (1841) 1 W. P. C. 630.

(*p*) Gibson *v.* Brand, (1841) 1 W. P. C. 631.

Trial.

And in the absence of evidence to the effect that articles complained of may have been manufactured by a process different to that comprised in the patent,(*q*) the following facts are *prima facie* evidence of infringement: similarity of structure in the patented article and the things produced by the defendant where a trade secret is alleged and there has been no inspection by the plaintiff; (*r*) the offering for sale of an article in the state produced by the application of a patented machine where it is proved that the defendant had one such machine in his possession.(*s*)

When a plaintiff must prove that an alleged infringing article was not made under his authority.

Under some circumstances, however, the *onus* is on the plaintiff of proving not merely the sale of the patented article, but further that it was not manufactured by himself or under his authority, *e.g.*, where a patentee has manufactories both in England and abroad.(*t*)

Defence that an alleged infringement is a secret process.

Where the defence was that the alleged infringement was an exercise by the defendant of a secret process he was allowed to refuse to answer questions on cross-examination which might disclose his process, and, at his election, evidence was taken *in camerâ* of what the alleged secret process really was, and the shorthand notes of such evidence were ordered to be impounded in Court until there should be an appeal, or until further order.(*u*)

Special provisions of the Act of 1883.

The Patents Act, 1883, contains special provisions with regard to the giving in evidence of, and the effect as evidence of, the seal of the Patent Office,(*x*) the Register of Patents,(*y*) Patent Office copies and certificates of specifications, disclaimers, and other documents or extracts from them,(*z*) and orders and certificates made by the Board of Trade.(*a*)

Trial.

Jurisdiction of the Courts.

Action for infringements of patents may be brought in either division of the High Court of Justice, or in the Court of the County Palatine of Lancaster. The County Courts have no jurisdiction to

(*q*) The Cartsburn Sugar Refining Co. *v.* Sharp, (1884) 1 R. P. C. 181, 186.

(*r*) Huddart *v.* Grimshaw, (1803) 1 W. P. C. 91; Davenport *v.* Richard, (1860) 3 L. T. N. S. 503.

(*s*) Hall *v.* Jarvis, (1822) 1 W. P. C. 100.

(*t*) Betts *v.* Willmott, (1870) L. R. 6 Ch. App. Cas. 239; Société Anonyme, &c. *v.* Tilghman's, &c., Co., (1883) L. R. 25 Ch. D. 1.

(*u*) Badische Anilin und Soda Fabrik *v.* Levinstein, (1883) L. R. 24 Ch. D. 156, 170.

(*x*) s. 12, sub-ss. 2 and 84.

(*y*) s. 23, sub-s. 2.

(*z*) ss. 89 and 96.

(*a*) s. 102, sub-ss. 2 and 3; also Act of 1888, s. 25.

Trial.

entertain an action in which the validity of the patent is in question, because a patent is a franchise and under s. 56 of the County Courts Act, 1888, a County Court has no cognisance of any action in which the title to any franchise is in question. Moreover a special jurisdiction was given to the High Court by ss. 28, 29, and 117, of the Patents Act, 1883, and it cannot be contended that the later County Courts Act 1888 gave to County Courts an open jurisdiction in such actions.(*b*)

It is submitted that an action to recover royalties amounting to not more than fifty pounds could be brought in a County Court, notwithstanding the fact that the ambit of the claim may be disputed by a licensee.(*c*)

Arbitration.

The provisions of the Arbitration Act 1889 apply to patent actions equally as to other actions.

Trial is usually by the Court alone.

Infringement actions are tried without a jury unless the Court directs otherwise.(*d*)

Patent actions are in rare cases tried by jury.

As a rule, patent actions do not require the intervention of a jury, and can be more satisfactorily disposed of by a Judge alone.(*e*) In the words of Lord *Selborne*, L.C.,(*f*) "It is to be observed that such cases almost always involve questions of law and fact, not only mixed, but mixed in such a way as to render the extrication of them extremely difficult; secondly, that very often much must depend upon the construction of documents, as to which a jury must take their direction entirely from the Judge; thirdly, that much of the evidence in such cases is argumentative and relative to matters of opinion, so as to make it extremely hard, even for the Judge himself, to keep it under proper control; and, lastly, that even the questions of fact are often, to a very great extent, questions of science, which, to say the least, are as likely to be as well decided by a Judge as by a jury. It very rarely happens, if it ever does, that in such cases the practical work is not done by the Judge. It very rarely happens, if it ever does, when a thing is not reduced to a narrow question of fact, that the jury do not simply follow, after a very elaborate discussion of the case by the Judge, the direction of the Judge."

e.g., where there is

An allegation of fraud may induce the Court to accede to a request for a jury. Thus in a case where the plaintiff opened

(*b*) R. *v.* Judge of County Court of Halifax, (1891) 8 R. P. C. 338.

(*c*) Cutlan *v.* Dawson, (1896) 13 R. P. C. 710; 14 R. P. C. 249.

(*d*) 46 & 47 Vict. c. 57, s. 28.

(*e*) Bovill *v.* Hitchcock, (1868) L. R. 3 Ch. 417; Young *v.* Fernie, (1863) 1 De G. J. & S. 353; Downes *v.* Hughes and Co., (1880) 69 L. T. 150; Sugg *v.* Silber, (1874) L. R. 1 Q. B. D. 362.

(*f*) Patent Marine Inventions Co. *v.* Chadburn, L. R. 16 Eq. 447.

Trial.

an allegation of fraud.

fraud, but the defendant's counsel protested that this was not raised by the pleadings and asked for a jury, a trial by jury was allowed and the cause was directed to stand over for that purpose.(*g*)

Juries are rarely asked for now in patent cases, and it is submitted that only where there is an allegation of fraud would a jury be allowed.(*h*)

Trial by jury cannot be had before a Judge of the Chancery Division of the High Court of Justice.(*i*) Actions commenced in the Chancery Division must be set down in the general list, if they are to be tried by a jury, to be tried by one of the Judges of the Common Law Division.

Trial with the aid of an assessor.

The Court has power to, and on the request of either party it must, call in the aid of an assessor specially qualified, and try and hear the case wholly or partially with his assistance.(*k*)

In cases where an assessor is called in, the remuneration to be paid to him is determined by the Court, and paid in the same manner as the other expenses of the execution of the Act of 1883.(*l*)

Trial of issues separately.

Before the repeal of Lord *Cairns'* Act (*m*) and Sir John *Rolt's* Act,(*n*) the practice had arisen in the Court of Chancery of directing in patent suits the trial of issues relative to the validity of the patent and to the fact of infringement, and, though those Acts are now repealed,(*o*) the jurisdiction which they established is not abolished,(*p*) but is exercised by both divisions of the High Court of Justice,(*q*) though it is not usual to try the issues of validity and infringement on different occasions.

The Court has the power to order any issue of fact in a patent action to be tried before an official referee,(*r*) and to order a trial without a jury of any cause, matter, or issue requiring any prolonged examination of documents or accounts,

(*g*) Tangye *v.* Stott, (1865) 14 W. R. 128.

(*h*) Since the Act of 1883 there are only four patent actions reported as having been tried with a jury—viz., Young *v.* Rosenthal, (1884) 1 R. P. C. 29; Westinghouse *v.* Lancashire and Yorkshire Ry. Co., (1884) 1 R. P. C. 229; Edge *v.* Harrison, (1891) 8 R. P. C. 74; Westley *v.* Toiley, (1894) 11 R. P. C. 602.

(*i*) Warner *v.* Murdoch, (1877) L. R. 4 Ch. D. 750.

(*k*) 46 & 47 Vict. c. 57, s. 28.

(*l*) 46 & 47 Vict. c. 57, s. 28 (3). As to the effect of an assessor's opinion on the judgment of the Court, see The Beryl, L. R. 9 P. D. 137, 141.

(*m*) 21 & 22 Vict. c. 27.

(*n*) 25 & 26 Vict. c. 42.

(*o*) 46 & 47 Vict. c. 49.

(*p*) Sayers *v.* Collyer, (1884) L. R. 28 Ch. D. 103, 108.

(*q*) 46 & 47 Vict. c. 57, s. 117.

(*r*) 36 & 37 Vict. c. 66, s. 57; Saxby *v.* Gloucester Waggon Co., W. N. 1880, p. 28.

Trial.

or any scientific or local examination which cannot, in the opinion of the Court or a Judge, be tried with a jury,(*s*) or at any time to order any cause, matter, or issue to be tried by a Judge with a jury, or by a Judge sitting with assessors, or by an official referee or a special referee with or without assessors.(*t*)

If it appear to the Court or a Judge that the issues of fact in dispute in a patent action are not sufficiently defined, the parties may be directed to prepare issues, and, if the parties differ, such issues will be settled by the Court or a Judge;(*u*) but issues will not be directed unless the Court is satisfied that there is a real question to try,(*x*) and most probably not at all, if the motion is opposed by the plaintiff,(*y*) or is made after the disclosure of the plaintiff's evidence.(*z*)

If it appear to the Court or a Judge that there is in any cause or matter a question of law which it would be convenient to have decided before any evidence is given or any question or issue of fact is tried, or before any reference is made to a referee or an arbitrator, the Court or a Judge may make an order accordingly, and may direct such question of law to be raised for the opinion of the Court, either by special case or in such other manner as the Court or a Judge may deem expedient, and all such further proceedings as the decision of such question of law may render unnecessary may thereupon be stayed.(*a*)

And, subject to the provisions of the first seven rules of Order XXXVI. of R. S. C. 1883, the Court or a Judge may, in any cause or matter, at any time, or from time to time, order that different questions of fact arising therein be tried by different modes of trial, or that one or more questions of fact be tried before the others, and may appoint the places for such trials, and in all cases may order that one or more issues of fact be tried before any other or others.(*b*)

The Court of Appeal will not readily interfere with a decision of the Court below as to the mode of trial.(*c*)

(*s*) R. S. C. 1883, Ord. xxxvi. r. 5.
(*t*) R. S. C. 1883, Ord. xxxvi. r. 7 a.
(*u*) R. S. C. 1883, Ord. xxxiii. r. 1; see Seeton on Decrees, 4th ed. p. 347, for the form of issues.
(*x*) Davenport *v.* Phillipps, (1865) 5 N. R. 485.
(*y*) Henderson *v.* The Runcorn Soap and Alkali Co., W. N. 1868, p. 250; 19 L. T. N. S. 377.
(*z*) Roskell *v.* Whitworth, (1870) L. R. 5 Ch. App. Cas. 459.
(*a*) R. S. C. 1883, Ord. xxxiv. r. 2.
(*b*) R. S. C. 1883, Ord. xxxvi. r. 8.
(*c*) Bovill *v.* Hitchcock, (1868) L. R. 3 Ch. App. Cas. 417; Brooke *v.* Wigg, (1878) L. R. 8 Ch. D. 510, 517; Williams *v.* Guest, (1875) L. R. 10 Ch. App. Cas. 467; Ruston *v.* Tobin, (1878) L. R. 10 Ch. D. 558; Hunt *v.* Chambers, (1882) L. R. 20 Ch. D. 365; Wharton *v.* Boffin, W. N. 1883, p. 96; Saxby *v.* Gloucester Waggon Co., W. N. 1880, p. 28.

Trial.

Advantages of separate trial of issues.

It is generally highly inconvenient to try the issues in a patent action separately or before different tribunals,(*d*) but sometimes great expense may be saved to the litigants by adopting this course.(*e*) An order for the trial of the issue of infringement by itself will not be granted, unless the validity of the patent is not only admitted, but admitted in unqualified terms.(*f*)

The following are instances in which special issues may be directed to be tried separately: Where it is alleged that the specification is ambiguous or vague the question of sufficiency of the specification may be determined separately and without evidence; (*g*) or where several users are alleged as anticipations of a patent all the evidence on one alleged user may be taken before going into the others.(*h*) Where, at the trial of an action on a patent which had been repeatedly established, and the Judge was of opinion that the sufficiency of the specification, the utility of the invention, and the fact of infringement had all been proved, he granted an injunction, but ordered an issue as to the novelty of the invention to be tried before a jury.(*i*) And where the plaintiff admitted that, if the defendant could prove the prior use of a certain article, the patent would be void, the defendant was allowed to call at once his evidence of such prior use, and the action was dismissed.(*k*)

Reference to a referee.

It is enacted by s. 56 of the Judicature Act of 1873 that, subject to any Rules of Court, and to such right as existed at the date of the Act to have particular cases submitted to the verdict of a jury, any question arising in any cause or matter (other than a criminal proceeding by the Crown) before the High Court of Justice or before the Court of Appeal, may be referred by the Court or by any Divisional Court or Judge before whom such cause or matter may be pending for inquiry and report to any official or special referee, and the report of any such referee may be adopted wholly or partially by the Court, and may (if so adopted) be enforced as a judgment by the Court.

This power was exercised by *Pearson*, J., in *Badische Anilin*

(*d*) Young *v.* Fernie, (1863) 1 De G. J. & S. 353.

(*e*) Kurtz *v.* Spence, (1888) 5 R. P. C. 170; Muirhead *v.* Commercial Cable Co., (1894) 11 R. P. C. 323.

(*f*) United Telephone Co. *v.* Mottershead, (1886) 3 R. P. C. 213.

(*g*) The Republic of Bolivia *v.* The National Bolivian Navigation Co., (1876) 24 W. R. 361.

(*h*) Richardson *v.* Castrey, (1887) 4 R. P. C. 265.

(*i*) Bovill *v.* Goodier, (1866) L. R. 2 Eq. 195.

(*k*) Badham *v.* Bird, (1888) 5 R.P.C. 238.

Trial.

und Soda Fabrik v. *Levinstein*,(*l*) who directed certain experiments to be made by a special referee for the purpose of advising the Court; by the Court of Appeal in *Moore* v. *Bennett*,(*m*) where it was ordered that a special referee should make experiments to test the capability of a certain machine to cut brushes; by *Kay*, J., in *Edison* v. *Holland*,(*n*) where it was ordered that certain of the plaintiff's and defendant's witnesses should make experiments in the presence of a special referee, with a view of ascertaining the sufficiency of the complete specification; and by *Romer*, J., in *North British Rubber Co.* v. *Macintosh* (*o*) where a reference to an independent expert was ordered on points on which the evidence was directly in conflict. The expert is in such a case usually furnished by the direction of the Court with printed shorthand notes, has access to all the exhibits, and is to be at liberty to make such experiments as he may think desirable. Counsel are at liberty to make observations on the expert's report and the expert then reads the observations and advises the Court.

In certain cases a sufficiently qualified expert could only be found amongst a class of persons who would be likely to have a bias against the patent—*e.g.*, rival manufacturers—and these circumstances induce the Court to forego the assistance of an independent expert in such cases.(*p*)

Trial at assizes.

Any party to any cause or matter involving the trial of a question or issue of fact, or partly of fact and partly of law, may, with the leave of the Judge or Judges to whom, or to whose division, the cause or matter is assigned, require the question or issue to be tried and determined at the assizes or at sittings to be held in Middlesex or London.(*q*)

The rules (*r*) also empower the Court to send an action for trial at assizes with the object of getting an early trial whenever on an application before trial for an injunction or other order it appears that the matter in controversy is one which can be most conveniently dealt with by an early trial without first going into the whole merits on affidavit or other evidence for the purpose of the application.

To whatever division of the High Court an action may be

(*l*) (1883) L. R. 24 Ch. D. 156.
(*m*) (1884) 1 R. P. C. 129, 133.
(*n*) (1888) 5 R. P. C. 459, 479.
(*o*) (1894) 11 R. P. C. 477.
(*p*) Badische Anilin und Soda Fabrik *v.* La Société des Usines du Rhône, (1897) 14 R. P. C. 891.
(*q*) 36 & 37 Vict. c. 66, s. 29. The following actions were tried at assizes: Miller *v.* Searle, (1893) 10 R. P. C. 106; Legge *v.* Wakelan, (1893) 10 R. P. C. 379; Allen *v.* Duckett, (1893) 10 R. P. C. 397; Allen *v.* Horton, (1893) 10 R. P. C. 412; Westley *v.* Tolley, (1894) 11 R. P. C. 602.
(*r*) S. C. R. (1883) Ord. l. r. 1a.

Trial.

attached, if it has been ordered to be tried at the assizes the Judge has no power, except the interests of justice so require, to remit it for trial in London.(*s*)

Acceleration of trial.

Actions set down for trial in the Chancery Division may, upon the application of the plaintiff, even without the consent of the defendant, by order of the Court be advanced out of their turn for hearing if a proper reason be shown—*e.g.*, that delay would cause the loss of the object of the action.(*t*)

Where a plaintiff patentee of a chemical dye applied for the acceleration of the trial on the ground that new dyes were being continuously introduced and the trade in the patented dye could not be relied upon for long, and the defendant was offering the alleged infringing goods at reduced prices to the consequent detriment of the plaintiff's trade, the Court refused to expedite the trial for the reason that, if the plaintiff's case was well founded, he could get compensation in damages, and there was no ground, therefore, for giving him priority over other suitors.(*u*)

Motion for judgment on determination of a separate issue.

Where issues have been ordered to be tried, or questions of fact to be determined in any manner, the plaintiff may set down a motion for judgment as soon as such issues or questions have been determined. If he does not set down such a motion, and give notice thereof to the other parties within *ten days* after the right so to do has arisen, then, after the expiration of such ten days, any defendant may set down a motion for judgment, and give notice thereof to the other parties.(*x*) And where issues have been ordered to be tried, or questions of fact to be determined in any manner, and some only of such issues or questions of fact have been tried or determined, any party who considers that the result of such trial or determination renders the trial or determination of the others of them unnecessary, or renders it desirable that the trial or determination thereof should be postponed, may apply to the Court or a Judge for leave to set down a motion for judgment without waiting for such trial or determination. And the Court or a Judge may, if satisfied of the expediency thereof, give such leave upon such terms, if any, as shall appear just, and may give any directions which may appear desirable as to postponing the trial of the other issues of fact.(*y*)

(*s*) Fairbairn *v.* Household, (1885) 2 R. P. C. 195.

(*t*) S. C. R., (1883) Ord. 36, r. 16 n.

(*u*) Farbenfabriken vorm F. Bayer & Co. *v.* Bowker, (1890) 8 R. P. C. 136.

(*x*) R. S. C. (1883) Ord. xl. r. 7.

(*y*) R. S. C. (1833) Ord. xl. r. 8; Fernie *v.* Young, (1866) L. R. 1 H. L. 63; Macdougall *v.* General Sewage and Manure Co., (1875) W. N. 64; Tangye *v.* Stott, (1865) 14 W. R. 386.

Trial.

Motion for judgment on an admission of fact.

Any party may at any stage of a cause or matter where admissions of fact have been made, either on the pleadings or otherwise, apply to the Court or a Judge for such judgment or order as upon such admissions he may be entitled to, without waiting for the determination of any other question between the parties; and the Court or a Judge may upon such application make such order, or give such judgment, as the Court or Judge may think fit.(*z*) If a plaintiff moves for judgment under this power on admissions in the pleadings, he is bound by statements made in the defence, and thus where a defendant admitted ten, but denied any further infringements, an inquiry as to damages was limited to the ten admitted infringements.(*a*)

Judgment when a defendant does not appear.

If the defendant do not appear, the plaintiff may on motion obtain judgment and the usual certificates upon formal proof of his title and the fact of infringement.(*b*) In one case where judgment went by default the Court refused to hear counsel on behalf of the defendant in another pending action on the same patent in which an order had been made that the first action should be treated as a test case and the judgment should bind the parties to the second action.(*c*) The defendant to the second action could no doubt under such circumstances get the order set aside upon proper motion to the Court.

When there are two defendants—*e.g.*, the manufacturer and a user, and one—*e.g.*, the user—puts in no defence and refuses to submit to judgment, the Court will not give leave to the plaintiff to set down the action on motion for judgment against such defendant, because the other defendant may be able to prove the patent void, in which case the first defendant would be entitled to the benefit of the decision.(*d*)

Judgment by consent.

If judgment is obtained by consent against a defendant, such defendant may withdraw his consent before the judgment has been entered, but he will not, except under very special circumstances, be allowed to do so, when he has stated that he will not require evidence to be filed in support of the plaintiff's application, and then seeks to allege a mistake of fact with regard to infringement.(*e*)

Certificates

At the conclusion of the trial counsel on behalf of the

(*z*) R. S. C. (1883) Ord. xxxii. r. 6.

(*a*) United Telephone Co. *v.* Donohoe, (1886) L. R. 31 Ch. D. 399.

(*b*) Pneumatic Tyre Co. *v.* Chisholm, (1896) 13 R. P. C. 488; Edison United Phonograph Co. *v.* Young, (1894) 11 R. P. C. 489. Surprise may be a ground for a new trial: Incandescent Gas Light Co. *v.* New Incandescent Mantle Co., (1897) 15 R. P. C. 81.

(*c*) Edison United Phonograph Co. *v.* Young, (1894) 11 R. P. C. 489.

(*d*) Actien Gesellschaft für Cartonnagen Industrie *v.* Remus, (1895) 12 R. P. C. 94.

(*e*) Pneumatic Tyre Co. *v.* Cash Cycle Co., (1897) 14 R. P. C. 177, 326.

successful party should not omit to ask the Judge to certify that the validity of the patent came in question if the plaintiff succeeds and also that the particulars were reasonable and proper. These certificates are most important on taxation.(*f*)

Consolidation of Actions.

should be asked for at the conclusion of the trial.

Documents and evidence not actually produced and given at the trial should not be inserted in the minutes of judgment.(*g*)

Consolidation of Actions.

Actions may be consolidated,

When a patentee brings several actions on the same patent against different defendants, they may be consolidated, so that the validity of the patent and any other issues common to all the actions may be tried once for all in one action;(*h*) and actions pending in the same division are now to be consolidated in the manner in use before the commencement of the Judicature Act, 1873, in the superior Courts of Common Law.(*i*)

but only at the instance of the defendants.

Actions can only be consolidated at the instance of the defendants,(*k*) and at Common Law a plaintiff could not be bound without his consent by the result of one action, but could after an adverse verdict proceed with any of the others.(*l*)

Several actions by different plaintiffs against the same defendant.

Where several actions are brought by different plaintiffs against the same defendants the Court will, on the application of the plaintiffs, make an order enlarging the time for taking the next step in several of the actions, and staying proceedings therein till after one has been tried as a test action.(*m*)

Time when a consolidation order can be made.

It was held at Common Law that a consolidation could be made as soon as the defendants had appeared, and before declaration;(*n*) and where the defendants to several actions, by a consolidation order, consented to be bound by the result of one action, and the defendant in that action, which was decided against him, neglected to appeal, it was held that a defendant to one of the other actions had no equity to be allowed to carry the case to a superior Court.(*o*)

(*f*) pp. 617-621 *post*.

(*g*) Shoe Machinery Co. *v.* Cutlan (2), (1896) 13 R. P. C. 395.

(*h*) Foxwell *v.* Webster, (1863) 4 De G. J. & S. 77; Edison-Bell Phonograph Corporation *v.* Smith, (1894), 11 R. P. C. 148, 389.

(*i*) R. S. C. 1883, Ord. xlix. r. 8.

(*k*) Lush's Practice, 3rd ed. 965; Amos *v.* Chadwick, (1876) L. R. 4 Ch. D. 869.

(*l*) Lush's Practice, 3rd ed. p. 965.

(*m*) Amos *v.* Chadwick, (1876) L. R. 4 Ch. D. 869; Bennett *v.* Lord Bury, (1880) L. R. 5 C. P. D. 339.

(*n*) Lush's Practice, 3rd. ed. p. 965.

(*o*) Thomas *v.* Winter, (1867) 17 L. T. N. S. 148.

New Trial.

Procedure to obtain a new trial.

If, after the trial of a patent action, either party considers that he is entitled to a new trial, and desires to obtain one accordingly, the proper procedure is, if the action was tried with a jury, to apply by motion to the Court of Appeal; and, if the action was tried without a jury, the procedure is by appeal to the Court of Appeal.(*p*)

Where, after the reversal by the Court of Appeal of a judgment obtained by fraud, the respondents sought a rehearing of the appeal with fresh evidence, it was held that the Court had no jurisdiction to rehear the appeal, but that the proper course was an original action, analogous to a suit under the old practice to set aside a decree as obtained by fraud.(*q*)

Appeal.

Procedure.

All appeals to the Court of Appeal must be by way of rehearing,(*r*) and must be brought by notice of motion in a summary way, and no petition, case, or other formal proceeding, other than such notice of motion, is necessary. The appellant may, by the notice of motion, appeal from the whole or any part of any judgment or order, and the notice of motion must state whether the whole or part only of such judgment or order is complained of, and in the latter case must specify such part.(*s*)

It is not, under any circumstances, necessary for a respondent to give notice of motion by way of cross-appeal, but if a respondent intends, upon the hearing of the appeal, to contend that the decision of the Court below should be varied, he must, within eight days, or such time as may be specified by special order, give notice of such intention to any parties who may be affected by such contention.(*t*)

Power of Court of Appeal to order a new trial.

If, upon the hearing of an appeal, it appears to the Court of Appeal that a new trial ought to be had, the Court of Appeal has power, if it thinks fit, to order that the verdict and judgment shall be set aside, and that a new trial shall be had.(*u*)

(*p*) R. S. C. (1883) Ord. xxxix. r. 1; Hunt *v.* City of London Real Property Co., (1877) L. R. 3 Q. B. D. 19; Edison *v.* Shippey, (1887) 4 R. P. C. 473.

(*q*) Flower *v.* Lloyd, (1877) L. R. 6 Ch. D. 297.

(*r*) As to the effect of a finding of fact by the Judge of First Instance on the Court of Appeal see Haggenmacher *v.* Watson, (1897) 14 R. P. C. 634, judgment of Esher, M.R.; see also p. 592 *post*.

(*s*) R. S. C. (1883) Ord. lviii. r. 1. As to service of notice of motion, and time within which appeals are allowed, see R. S. C. (1883) Ord. lviii. r. 2–19.

(*t*) R. S. C. (1883) Ord. lviii. rr. 6 and 7.

(*u*) R. S. C. (1883) Ord. lviii. r. 5.

Appeal.

Security for costs of appeal.

An appellant may be ordered to give security for the costs of the appeal;(*x*) and if such security is not given within a reasonable time, an order will, in the absence of extenuating circumstances, be made for the immediate dismissal of the appeal.(*y*)

If a respondent contends that the appellant ought to be ordered to give security for costs, he must apply to the appellant before moving the Court for such order, otherwise he will be liable to the costs of the application.(*z*)

The appellant a bankrupt.

If a defendant becomes bankrupt, after setting down an appeal, the appeal cannot be proceeded with unless he give security for costs or the trustee in bankruptcy is made a party to the proceedings,(*a*) but on giving security for costs in such a case he is entitled to proceed with the appeal.(*b*)

It has been held not to be sufficient ground for postponing an appeal that the plaintiff was abroad, but desired to attend and instruct his counsel.(*c*)

Fresh evidence on appeal.

The Court of Appeal has power to admit evidence not given in the Court below, and may allow an amendment of the particulars for this purpose,(*d*) or in its discretion admit the fresh evidence, though it is not within the particulars originally delivered, without ordering an amendment of such particulars.(*e*)

If the defendant's witnesses at the trial give evidence of anticipations not within the particulars, and the plaintiff chooses not to ask for an adjournment to consider them, the Court of Appeal will not allow such evidence to be adduced by the plaintiff with regard to them.(*f*) And if the defendant in the Court below does not call evidence, but elects to rest his case on the admissions of the plaintiff's witnesses, the Court of Appeal will refuse to allow him to call fresh evidence for the purpose of making out a case, which, in the opinion of the Court of Appeal differing from the Judge below, was not substantiated by such admissions.(*g*)

Issues abandoned below.

If a party in the Court below abandons an issue, the Court of Appeal will not allow it to be raised on appeal. Thus, where the plaintiff's witnesses admitted in the Court below that, if an alleged anticipation was in fact made prior to the

(*x*) R. S. C. (1883) Ord. lviii. r. 15.

(*y*) Washburn and Moen Manufacturing Co. *v.* Patterson, (1885) L. R. 29 Ch. D. 48.

(*z*) Garrard *v.* Edge, (1890) 7 R. P. C. 139.

(*a*) United Telephone Co. *v.* Bassano, (1886) L. R. 31 Ch. D. 630.

(*b*) *Ibid.*

(*c*) Walker *v.* Hydrocarbon Syndicate, 3 R. P. C. 253.

(*d*) pp. 512, 528 *ante.*

(*e*) pp. 527, 528 *ante.*

(*f*) Barcroft *v.* Smith, (1897) 14 R. P. C. 172.

(*g*) Lancashire Explosives Co. *v.* Roburite Explosives Co., (1895) 12 R. P. C. 470, 480.

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patent as stated, it was a complete anticipation, and the plaintiff fought the case solely on the contention that the alleged anticipating machine was in fact not made, and at the same time charged the defendant with fraudulently altering it as originally constructed, the Court of Appeal refused to allow the appellant plaintiff to raise the question that though the alleged anticipation in question was made as stated yet it was no anticipation in fact, and dismissed the appeal with costs.(*h*)

Particulars of objection when appeal is in respect of infringement only.

Notwithstanding that the only question on appeal is the issue of infringement, the Appellate Court will consider the particulars of objection for the purpose of ascertaining the state of public knowledge at the date of the patent whereby to properly construe the ambit of the patentee's claim.(*i*)

Decisions on facts as well as law may be reversed on appeal.

There is no presumption that the Court of Appeal or the House of Lords ought not to interfere with what the Judge of First Instance has done with regard to matters of fact; but, on the contrary, the Appellate Court, in which both fact and law are open to review, is bound to pronounce such judgment as, in their view, ought to have been pronounced by the lower Court; and it is not competent to the Appellate Court to say that they would have pronounced a different judgment, if they had been Judges of First Instance, but because the Judge has pronounced a certain judgment they will adhere to his decision.(*k*)

Decision of several points when one is sufficient.

In *Parkinson* v. *Simon*,(*l*) the Court of Appeal stated a rule to the effect that when two distinct points have been argued in the Court below, and the Court of Appeal is obliged to dismiss the appeal on a consideration of one point alone, yet to render further litigation between the parties more unlikely the Court will give a decision on the other point also. In the same case, however, the House of Lords(*m*) dismissed the appeal on the same ground as the Court of Appeal, but declined to express any opinion on the second point, and did not call upon the respondent's counsel to argue it. And during the argument their Lordships stated that the practice of giving decisions (which only amount to *dicta*) on issues not necessary to decide on appeal is not to be recommended, and will not be adopted by their Lordships' House.

(*h*) Westly, Richards and Co. *v.* Perkes, (1893) 10 R. P. C. 181, 382.

(*i*) Morris *v.* Young, (1895) 12 R. P. C. 455.

(*k*) Rickmann *v.* Thierry, (1897) 14 R. P. C. 105; but see Haggenmacher *v.* Watson, (1897) 14 R. P. C. 634, judgment of Esher, M.R.

(*l*) (1895) 11 R. P. C. 493; Deeley's Patent, (1896) 12 R. P. C. 192, 197.

(*m*) 12 R. P. C. 403.

A decision of the Court of First Instance may be reversed by the Court of Appeal, notwithstanding the absence of a respondent who does not appear at the hearing in the Appellate Court.(*n*) Perpetual Injunction.

Perpetual Injunction.

If at the trial of an action the plaintiff succeeds in conclusively(*o*) proving that the defendant has infringed, and the validity of the patent is established, one of the remedies to which he is usually entitled is a perpetual injunction restraining the defendant from repeating the acts complained of during the continuance of the monopoly. And where the defendant is desirous and willing to consent to a perpetual injunction without bringing the action to a trial, it may be obtained, by the consent of both parties, on the hearing of the motion,(*p*) or by summons in chambers.(*q*) A defendant is entitled to withdraw his consent to a perpetual injunction if it was given under mistake or surprise.(*r*) Successful plaintiff is usually entitled to a perpetual injunction. Injunction by consent.

The Court does not invariably grant an injunction on proof of an invasion of the plaintiff's rights under the patent. An injunction does not in such circumstances follow as matter of course, but is in the discretion of the Court.(*s*) Injunction is not a matter of course.

Acquiescence on the part of the plaintiff may induce the Court to refuse an injunction and merely grant damages, or an account of profits.(*t*) Acquiescence.

Though *laches* may disentitle a plaintiff to an interlocutory injunction,(*u*) yet delay to enforce a legal right does not prevent a person from bringing an action, provided it does not cause a statutory bar ;(*x*) and, consequently, delay or acquiescence, which would prevent the plaintiff from succeeding on an interlocutory application, may be no bar to his right to a perpetual injunction at the trial,(*y*) and to damages or an account.(*z*) *Laches.*

(*n*) Pneumatic Tyre Co. *v.* Casswell, (1896) 13 R. P. C. 375.

(*o*) Hill *v.* Evans, (1862) 4 De G. F. & J. 288.

(*p*) Morrell *v.* Pearson, (1849) 12 Beav. 284.

(*q*) 46 & 47 Vict. c. 57, s. 30 ; Judic. Act, (1873) s. 39; Freason *v.* Loe, (1877) 26 W. R. 138.

(*r*) Elsas *v.* Williams, (1884) 1 Times Rep. 144.

(*s*) Betts *v.* De Vitre, (1864) 11 Jur. N. S. 9 ; Geary *v.* Norten, 1 De G. & S. 4; Proctor *v.* Bayley, (1889) 6 R. P. C. 538 ; Lyon *v.* Goddard, (1893) 10 R. P. C. 135 ; Jenkins *v.* Hope, (1895) 13 R. P. C. 57 ; Scott *v.* Hull Steam Fishing and Ice Co., (1897) 14 R. P. C. 143.

(*t*) Sayers *v.* Collyer, (1885) L. R. 28 Ch. D. 103.

(*u*) p. 506 *ante*.

(*x*) Three Towers Banking Co. *v.* Maddever, (1884) L. R. 27 Ch. D. 523; Wood *v.* Lambert, (1886) 3 R P. C. 84.

(*y*) Fullwood *v.* Fullwood, (1878) L. R. 9 Ch. D. 176; Johnson *v.* Wyatt, (1863) 2 De G. J. & S. 18, 25 ; Proctor *v.* Bennis, (1887) L. R. 36 Ch. D. 740; Bacon *v.* Spottiswoode, (1839) 1 Beav. 382.

(*z*) Bovill *v.* Crate, (1865) L. R. 1 Eq. 388.

Perpetual Injunction.

Expiry of the patent before conclusion of the action.

Generally speaking, the Court will not grant an injunction if the patent has expired before the commencement or during the course of an action;(*a*) but where it appeared that the patent would expire in a few days, and that the defendant had piratically manufactured a large stock of the patented article ready to throw on the market as soon as the monopoly was at an end, *Lyndhurst*, L.C., granted an injunction to restrain the sale of such articles both before and after the term limited by the grant of the patent.(*b*)

Absence of evidence of an intention to continue infringements.

Also, if the defendant has committed only one act of infringement and there is no evidence of an intention on his part to infringe again, the Court does not usually grant the plaintiff an injunction. Thus, where it was proved that the defendant was guilty of only one act of user, and the Judge was satisfied that the defendant had no intention of infringing again, the Court did not grant an injunction, but awarded a small sum by way of damages and gave the plaintiff liberty to apply for an injunction in case of necessity thereafter.(*c*) And where the defendant refused to submit to an injunction, but after writ issued and before statement of claim delivered offered to account for the profits made by the sale of infringing articles, to deliver up all such in his possession, to give a perpetual undertaking not to infringe, and to pay costs of the action, the Court held that the plaintiff was entitled to have his legal right recognised, but considering the smallness of the matter the defendant's undertaking not to manufacture or sell was sufficient and no injunction was granted, and the Court made certain provisions as to the costs of the action.(*d*)

Where, after the plaintiff had obtained an interlocutory injunction, the defendant removed the alleged infringing parts from a machine, the plaintiff, at the trial, was awarded a perpetual injunction together with an account of profits and costs, on the ground that the defendant, had, in fact, infringed, and had not submitted on the hearing of the interlocutory motion to the relief which the plaintiff asked for.(*e*)

Certain in-

When an injunction is granted, if in the interests of justice

(*a*) Betts *v.* Gallais, (1870) L. R. 10 Eq. 392; Davenport *v.* Rylands, (1865) L. R. 1 Eq. 302; 35 L. J. Ch. 204; Price's Patent Candle Co. *v.* Bauwen's Patent Candle Co., (1858) 4 K. & J. 727; Smith *v.* L. & S. W. Ry. Co., (1854) Macr. P. C. 209; 23 L. J. Ch. 562.

(*b*) Crossley *v.* Beverley, (1829) 3 Car. & P. 513; 1 Russ. & M. 166 n; 1 W. P. C. 106.

(*c*) Scott *v.* Hull Steam Fishing and Ice Co., (1897) 14 R. P. C. 143.

(*d*) Jenkins *v.* Hope, (1895) 13 R. P. C. 57.

(*e*) Edison-Bell Phonograph Corporation *v.* London Phonograph Co., (1894) 11 R. P. C. 471.

Perpetual Injunction.

it is desirable, certain infringements contemplated may be excluded from its operation. Thus, when the defendant had before trial accepted orders for infringing machines, and the plaintiff at the trial elected to take an account of profits in lieu of damages, the defendant agreeing to bring into the account any machines then under order, the Court granted an injunction, and made it operate immediately, but suspended its operation as to orders then accepted but not executed till the hearing of appeal, if notice of appeal should be given within three days of the drawing up of the order.(*f*) But where the infringing machines had been ordered since the commencement of the action, though they were not completed before judgment, no stay of the injunction was allowed.(*g*)

Infringements may be exempted from injunction.

Stay of injunction pending an appeal.

It is not usual for the Court to stay the injunction. In special and important cases, however, when it is obvious that, if an appeal which will be made, is successful, the injury caused to the defendant by the injunction continuing would be great, without any corresponding advantage to the plaintiff, the Court will suspend the operation of the injunction, and possibly also the taking of an account or inquiry as to damages pending the appeal.(*h*)

Injunction to restrain threatened infringements.

Although no actionable infringement has been committed, and consequently there could be no claim to damages, yet, if there is an evident intention on the part of the defendant to infringe, the Court will grant an injunction.(*i*) Thus, where it appeared that the defendants had opposed the plaintiff's application for a patent, and had infringed it during the interval between the filing and acceptance of the specification, and also subsequently, the Court, though there was no actionable infringement, granted its injunction on the ground that there was an evident intention to infringe.(*k*)

Injunction becomes inoperative if the specification is amended.

If a plaintiff, after having obtained an injunction, amends the specification, the injunction becomes inoperative, and in the event of fresh infringements by the defendant the plaintiff must proceed *de novo*.(*l*)

(*f*) Lyon *v.* Goddard, (1893) 10 R. P. C. 135; see also Ducketts *v.* Whitehead, (1895) 12 R. P. C. 191.

(*g*) Lyon *v.* Goddard (2), (1893) 10 R. P. C. 348.

(*h*) North British Rubber Co. *v.* Macintosh, (1894) 11 R. P. C. 489; Franklin, Hocking and Co. *v.* Fraser, (1885) 3 R. P. C. 7; Young *v.* Morris, (1894) 11 R. P. C. 214; National Opalite Glazed Brick and Tile Syndicate *v.* Ceralite Syndicate, (1896) 13 R. P. C. 658.

(*i*) Frearson *v.* Loe, (1878) L. R. 9 Ch. D. 48; Dowling *v.* Billington, (1890) 7 R. P. C. 191; The Shoe Machinery Co. *v.* Cutlan, (1895) 12 R. P. C. 342; see also pp. 504, 516 *ante*.

(*k*) Dowling *v.* Billington, (1890) 7 R. P. C. 191.

(*l*) Dudgeon *v.* Thompson, (1879) L. R. 3 App. Cas. 34.

Perpetual Injunction.

As a rule, the breach of an injunction of the Court is a contempt, which renders the party guilty of it liable to committal, and it is no answer for a defendant to say that he did not intend to commit the contempt, for if he has actually infringed after injunction he is guilty of contempt.(*m*)

Breach of injunction.

Motion for committal.

In all cases of motion for committal, where the liberty of the subject is involved the strictest proof is necessary, both as regards the fact of infringement(*n*) and proper and accurate compliance with the rules relating to service.(*o*) The copy of the order served must be accurate in every particular.(*p*) It is to be observed that there is a distinction between the procedure on attachment and committal. In the latter, which is the appropriate remedy when a defendant has done something which the Court has ordered him not to do and therefore applies to breach of an injunction in a patent case, service of the order is not absolutely necessary, and a defendant may be committed if the Court is satisfied that the order was brought to his knowledge, although not formally served upon him. In the case of attachment, which is the appropriate remedy where a defendant has failed to do something which the Court ordered him to do, the procedure requires the service of the order by producing the original or an office copy, and leaving an accurate copy with the person served.(*q*)

The following circumstances illustrate the necessity for accurate proof of the fact of infringement. An injunction was granted, and the defendant undertook to continue a previous undertaking not to part with infringing articles in his possession or under his control in this country, and the plaintiff on motion to commit failed to show that certain articles alleged to have been parted with, in breach of the undertaking, were, in fact, in the possession of, or under the control of, the defendant on the date on which the injunction was obtained, the Court refused an order for committal, but gave no costs, on the ground that the circumstances were suspicious and the plaintiff was justified in bringing on the motion.(*r*)

Breach of injunction

There may be cases in which a breach of an injunction of

(*m*) Plimpton *v.* Spiller, (1876) L. R. 4 Ch. D. 288; Thompson *v.* Moore, (1889) 6 R. P. C. 426, 445; Farbenfabriken vorm F. Bayer *v.* Laporte, (1894) 11 R. P. C. 190; Lyon *v.* Goddard, (1894) 11 R. P. C. 113.

(*n*) Dick *v.* Haslam, (1891) 8 R. P. C. 196; Edison-Bell Phonograph Co. *v.* Smith, (1894) 11 R. P. C. 164.

(*o*) R. S. C. 1883, Ord. lxvii. r. 1; Taylor *v.* Roe, 68 T. R. 213; *re* Evans, 9 T. R. 109; Hall *v.* Trigg, (1897) L. R. 2 Ch. at p. 222.

(*p*) *Re* Holt, (1879) L. R. 11 Ch. D. 168.

(*q*) R. S. C. 1883, Ord. lxvii. r. 1; see also *re* Holt, (1879) L. R. 11 Ch. D. 168.

(*r*) Edison-Bell Phonograph *v.* Smith, (1894) 11 R. P. C. 164.

the Court is not only justifiable but a positive duty. Thus, *James*, L.J., in reference to a case in which the majority of the Court of Appeal confirmed an injunction restraining the master of a ship from using certain patented pumps, with which the ship was exclusively fitted, said: "In the absence of the owners it appears to me that the Court could not make a mandatory injunction as to the equipment of the ship. And, that being so, I cannot concur in granting an injunction to restrain the master from doing what it appears to me to be his plain duty to do. Whatever appliances there may happen to be on board, however they came there—pumps, anchors, fire extinguishers, stolen or not stolen, pirated or not pirated—it is his bounden duty to use them according to the exigencies of navigation for the safety of ship, cargo, and life. To the master when out at sea (injunction or no injunction) *salus navis est suprema lex*. And, for myself, I believe that a master would be practically as safe in disobeying an injunction under a pressing emergency as he would be in shooting a mutineer. And in my opinion, if a single life was lost through the master's neglect to use such appliances, the injunction would be no defence to an indictment for manslaughter."(*s*)

Perpetual Injunction.

may under certain circumstances be justifiable.

It is doubtful whether, on a motion for sequestration against a company and committal against the directors for breach of a perpetual injunction, the Court has power to order an account of profits or the delivering up of the infringing articles.(*t*)

It is a complete answer to a motion for committal for breach of a perpetual injunction restraining infringements of a patent to show that, since the injunction, the patent has expired, and that the acts complained of were done subsequently to such expiration,(*u*) or that, since the injunction was granted, the specification has been amended and so the injunction has become inoperative.(*x*)

Expiry of the patent is an answer to a motion for committal.

When the defendant after injunction does something different to what he did before injunction, and the plaintiff wishes to restrain him on the ground that in the opinion of the plaintiff it is an infringement, the usual way to raise the question is by motion to commit.(*y*) In one such case, where it appeared that the article complained of was

Acts done since injunction granted, which are different in nature though similar to those in respect of which the injunction was granted.

(*s*) Adair *v.* Young, (1879) L. R. 12 Ch. D. 21; Basset *v.* Graydon, (1897) 14 R. P. C. 701.

(*t*) Spencer *v.* The Ancoats Vale Rubber Co., (1889) 6 R. P. C. 67.

(*u*) Daw *v.* Ely, (1867) L. R. 3 Eq. 497.

(*x*) Dudgeon *v.* Thompson, (1879) L. R. 3 App. Cas. 34.

(*y*) Plimpton *v.* Spiller, (1877) L. R. 4 Ch. D. 286; Lancashire Explosives Co. *v.* Roburite Explosives Co., (1896) 13 R. P. C. 435.

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different from that in respect of which the injunction was originally granted, the Court, being of opinion that the new article was also an infringement, but not deciding the question, did not make an order for committal, but upon the plaintiff giving an undertaking as to damages granted an injunction restraining the manufacture of the new article until further order, and this course was subsequently approved of by the Court of Appeal.(*z*) And in another case(*a*) the Court dismissed the motion with costs on the ground that what the defendant did was no infringement.

Contempt of Court.

It is not a contempt of Court to publish, after a judgment has been obtained, advertisements asking for evidence of the anticipation and publication of the subject-matter of the patent,(*b*) or for subscriptions towards the expenses of an appeal.(*c*) But it is a contempt for either party by advertisements to issue a representation of an *ex parte* statement of proceedings in Court for the purpose of his own profit.(*d*)

Solicitor and client's costs.

Solicitor and client's costs may, on a motion to commit for breach of an injunction, be given to a successful plaintiff,(*e*) but not to a successful respondent.(*f*)

Where it appeared that the acts complained of had not been done vexatiously, but in the probable belief—an erroneous one—that the defendants were entitled to do what they did, solicitor and client's costs were refused, but costs on the higher scale were given.(*g*)

Account or Damages.

Account or damages may be awarded to a successful plaintiff,

General.—A plaintiff who succeeds in showing that his patent rights are valid and subsisting, and that they have been infringed, is entitled, not only to an injunction restraining the defendant from continuing the infringements complained of, but also to an account of profits made by the defendant by means of his wrongful acts, or damages against him in respect of the infringements committed.

but he cannot have both against

An inquiry as to damages and an account of profits are not reconcilable, for, if an account be taken of profits, the infringe-

(*z*) Plimpton *v.* Spiller, (1876) L. R. 4 Ch. D. 286.
(*a*) Lancashire Explosives Co. *v.* Roburite Explosives Co., (1896) 13 R. R. C. 435.
(*b*) Plating Co. *v.* Farquharson, (1881) L. R. 17 Ch. D. 49.
(*c*) *Ibid.*
(*d*) Edlin *v.* Pneumatic Tyre and Brook's Cycle Agency (2), (1893) 10 R. P. C. 317.
(*e*) Plating Co. *v.* Farquharson, (1881) L. R. 17 Ch. D. 49.
(*f*) *Ibid.*
(*g*) Spencer *v.* The Ancoats Vale Rubber Co., (1889) 6 R. P. C. 46, 68.

ment is thereby condoned.(*h*) A plaintiff therefore cannot have both an account and damages against the same defendant; he must choose one or the other,(*i*) and this rule applies to every case of infringement.(*k*)

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the same defendant,

though he may have an account against one defendant and damages against another.

As regards different defendants to the same action, or to consolidated actions, the plaintiff may have an account of profits against one of such defendants and damages against the other.(*l*) It has never been held that an account directed against a manufacturer of a patented article licenses the use of that article in the hands of all purchasers. The patent is a continuing patent, and there is no reason why the article should not be followed in every man's hand, until the infringement is got rid of. So long as the article is used, there is continuing damage.(*m*)

When damages are preferable to an account of profits, and *vice versâ*.

When the action is brought in the early days of the patent, before the patentee has established a course of dealing in the patented article, the successful plaintiff would probably prefer an account of profits, because of the difficulty he would, under such circumstances, have in showing the damage he has sustained by the wrongful acts of the defendant. On the other hand, as a rule, when the plaintiff has an established course of business in the patented article, it is more to his interest to elect to take damages in lieu of an account of profits, because of the great difficulty there always is in taking the account of profits due to the infringement of patent rights. Thus *Lindley*, L.J., in *Siddell* v. *Vickers*,(*n*) in stating his experience in matters of account, used the following words of warning: "I do not know any form of account which is more difficult to work out, or may be more difficult to work out, than an account of profits. One sees it—and I personally have seen a good deal of it—in partnership cases, when the capital of a deceased or outgoing partner has been left in the trade; an account has been directed of the profits made in respect of capital, which is something like the profits made in respect of an invention, and the difficulty of finding out how much profit is attributable to any

(*h*) Neilson *v.* Betts, (1871) L. R. 5 H. L. 22, per Lord Westbury.

(*i*) Neilson *v.* Betts, (1871) L. R. 5 H. L. 22; Watson *v.* Holliday, (1882) 30 W. R. 747; Siddell *v.* Vickers, (1892) 9 R. P. C. 153, 162.

(*k*) De Vitre *v.* Betts, (1873) L. R. 6 H. L. 319; Vidi *v.* Smith, (1854) 3 E. & B. 969; Holland *v.* Fox, (1854) 3 E. & B. 977.

(*l*) Penn *v.* Bibby; Penn *v.* Fernie, (1866) L. R. 3 Eq. 308; 36 L. J. Ch. 277; United Telephone Co. *v.* Walker, (1887) 4 R. P. C. 67; Boyd *v.* Tootle Broadhurst, &c., Co., (1894) 11 R. P. C. 175.

(*m*) Per Page Wood, V.C., Penn *v.* Bibby, Penn *v.* Jack, Penn *v.* Fernie, (1866) L. R. 3 Eq. 308; 36 L. J. Ch. 277.

(*n*) (1892) 9 R. P. C. 162.

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one source is extremely great—so great that accounts in any form very seldom result in anything satisfactory to anybody. The litigation is enormous, the expense great, and the time consumed is out of all proportion to the advantage ultimately attained; so much so that in partnership cases, I confess, I never knew an account in that form worked out with satisfaction to anybody. I believe in almost every case people get tired of it, and get disgusted. Therefore, although the law is that a patentee has a right to elect which course he will take, as a matter of business he would generally be inclined to take an inquiry as to damages rather than launch upon an inquiry as to profits."(*o*)

Distinction between an account of profits and an inquiry as to damages.

There is a well-marked distinction between an account of profits and an inquiry as to damages, which must not be lost sight of in dealing with particular cases, and which arises from the fact that there is no necessary relationship between the two. Thus in some cases the greater the profit made by the infringer the less may be the damages sustained by the patentee, and in other cases the less the profit accruing to the infringer the greater the damage inflicted upon the patentee, *e.g.*, where the infringer undersells the patentee he may be satisfied with a very small profit with the object of ultimately getting the trade in his own hands, but the damage thereby inflicted upon the patentee may be very great.(*p*)

Order by agreement for payment of a proper royalty is sometimes preferable to an account or damages.

Where a plaintiff is not desirous of taking an inquiry as to damages it is sometimes well for the parties to agree to an order for an inquiry as to what would be a proper royalty, and that such sum should be accepted in lieu of damages. Such a course may save endless expense and time as against an account of profits in the ordinary way.(*q*)

Effect of delay in bringing the action.

An unexplained delay in bringing action may affect a plaintiff's right to an account of profits, or damages,(*r*) by barring the right altogether,(*s*) or limiting it to an account of profits, made since the commencement of the action,(*t*) for it is a principle of equity that a party who claims a right shall not lie by, and, by his silence or acquiescence, induce another to go on expending his

(*o*) See also Crossley *v.* Derby Gas Co., (1829) 1 W. P. C. 119; Automatic Coal Gas Retort Co. *v.* Mayor, &c., of Salford, (1897) 14 R. P. C. 471.

(*p*) Per Chitty, J., Howard *v.* Tweedales, (1896) 13 R. P. C. 214.

(*q*) Automatic Coal Gas Retort Co. *v.* Mayor, &c., of Salford, (1897) 14 R. P. C. 471.

(*r*) Crossley *v.* Derby Gas Co., (1829) 1 W. P. C. 120; Harrison *v.* Taylor, (1865) 11 Jur. N. S. 408; Sayers *v.* Collyer, (1885) L. R. 28 Ch. D. 103.

(*s*) Crossley *v.* Derby Gas Co., (1829) 1 W. P. C. 120; Harrison *v.* Taylor, (1865) 11 Jur. N. S. 408.

(*t*) Sayers *v.* Collyer, (1885) L. R. 28 Ch. D. 103.

money and incurring risk, and afterwards, if profit be made, come and claim a share in that profit without having been exposed to the losses which might have been sustained.(*u*)

Account or Damages—General.

An account of profits or an inquiry as to damages may now be had, notwithstanding the fact that the action is commenced or judgment is delivered after the expiration of the patent, and the plaintiff is, therefore, not entitled to an injunction.(*x*) Formerly the right to an account or damages was ancillary to the right to an injunction, and if an injunction could not be granted, *e.g.*, if the patent had expired before,(*y*) or during,(*z*) the litigation, or there was no evidence of any intention on the part of the defendant to repeat the infringement,(*a*) the plaintiff could not have an account,(*b*) except in the case of fraud.(*c*) Lord *Cairns'* Act empowered the Court of Chancery to award damages, and any division of the High Court is now entitled to award damages or grant an account of profits independently of any right on the part of the plaintiff to an injunction; (*d*) and it would appear that the Court of the County Palatine of Lancaster has now a similar jurisdiction.(*e*)

Account or damages may be awarded notwithstanding that the plaintiff is not entitled to an injunction.

When an account of profits or an inquiry, as to damages is ordered the account or the inquiry, in the absence of provision to the contrary, goes up to the date of the assessment, if the cause of action is a continuing one, as the infringement of a subsisting patent is;(*f*) and articles manufactured for export must be brought into the inquiry.(*g*)

Account of profits or inquiry as to damages usually goes up to the assessment.

As a rule, where a plaintiff has become possessed of the patent by assignment, the assessment is only ordered from the date of the registration of the assignment.(*h*)

Assessment where the plaintiff is an assignee.

But where it appeared that the plaintiffs had taken over a business and certain patents, and succeeded to the rights of their predecessors, they were held to be entitled, in estimating the

(*u*) Crossley *v.* Derby Gas Co., (1829) 1 W. P. C. 120.

(*x*) 21 & 22 Vict. c. 27, s. 2; 36 & 37 Vict. c. 66, s. 16; Betts *v.* Gallais, (1870) L. R. 10 Eq. 392; R. S. C. (1883) Ord. xv. r. 1; York *v.* Stowers, (1883) W. N. p. 174.

(*y*) Smith *v.* G. W. Ry. Co., (1854) Macr. P. C. 209; S. C. Kay 417.

(*z*) Price's Patent Candle Co. *v.* Bauwen's Patent Candle Co., (1858) 4 K. & J. 727; but see Fox and Dellestable, (1866) 15 W. R. 194.

(*a*) Proctor *v.* Bayley, (1889) 6 R. P. C. 538.

(*b*) Smith *v.* G. W. Ry. Co., (1854) Macr. P. C. 203; Price's Patent Candle Co. *v.* Bauwen's Patent Candle Co., (1858) K. & J. 727.

(*c*) Crossley *v.* Derby Gas Co., (1829) 1 W. P. C. 119.

(*d*) R. S. C. (1883) Ord. xv. r. 1; York *v.* Stowers, (1883) W. N. 174.

(*e*) 53 & 54 Vict. c. 23, s. 3; 21 & 22 Vict. c. 27; 36 & 37 Vict. c. 66, s. 16.

(*f*) R. S. C. (1883) Ord. xxxvi. r. 58; Fritz *v.* Hobson, (1880) L. R. 14 Ch. D. 542. As to ascertainment of damages in Queen's Bench Division, see R. S. C. (1885) Ord. xxxvi. r. 57.

(*g*) Lyon *v.* Goddard, (1894) 11 R. P. C. 113.

(*h*) Ellwood *v.* Christy, (1865) 18 C. B. N. S. 494.

Account or Damages—General.

damages and loss of sales consequent on the competition of the defendants, to take into account the total quantities sold by the defendants before the plaintiffs acquired such business.(*i*)

Assessment does not extend to infringements committed within certain periods.

The account of profits or inquiry as to damages does not include anything due to infringements committed within certain periods of time unless the Court otherwise directs, viz.:—

(1) Infringements prior to the publication of the complete specification.(*k*)

(2) Infringements prior to an amendment of the specification, unless the Court is satisfied that the original claim was framed in good faith and with reasonable skill and knowledge.(*l*)

(3) Infringements committed after a failure to make any payment in respect of keeping the patent on foot within the prescribed time and before the enlargement thereof.(*m*)

Time within which amount found due is to be paid.

The order for the account or inquiry as the case may be, usually states the time within which the amount found due must be paid after it has been duly certified ;(*n*) but sometimes the time within which such payment is to be made is reserved for further consideration,(*o*) and the costs of taking the account or instituting the inquiry are usually so reserved.(*p*)

Disclosure by the defendant of number of infringing articles sold and names and addresses of his customers and also prices.

On an account of profits or an inquiry as to damages the defendant must disclose the number of the infringing articles he has made, and the names and addresses of the persons to whom and the prices at which he has sold them, in spite of the fact that he thereby exposes his customers to attack from the plaintiff, and himself to a consequent loss of trade.(*q*)

(*i*) United Horseshoe and Nail Co. *v.* Stewart, (1888) L. R. 13 App. Cas. 401, 417.

(*k*) pp. 503 *ante*, 644 *post*.

(*l*) pp. 271 *ante*, 646 *post*; 46 & 47 Vict. c. 57, s. 20. *Semble* this section would include an account of profits as well as damages. In Wenham Gas Co. *v.* Champion Gas Lamp Co., (1890) 7 R. P. C. 313, the inquiry was limited to damages in respect of infringements since the date of amendment. In Hopkinson *v.* St. James's Electric Lighting Co., (1893) 10 R. P. C. 43, an account of profits was allowed from the date of the patent, the patentee having stated in evidence that he had framed the original claim in good faith with reasonable skill and knowledge.

(*m*) 46 & 47 Vict. c. 57, s. 17, sub-s. 4 (b) ; p. 645 *post*.

(*n*) Westinghouse *v.* Lancashire and Yorkshire Ry. Co., (1884) 1 R. P. C. 253 ; 11 W. R. 852; Young *v.* Fernie, Bovill *v.* Crate, Needham *v.* Oxley, Cunningham *v.* Colling, Seton, 4th ed. p. 355.

(*o*) Hocking *v.* Fraser, (1886) 3 R. P. C. 7; Betts *v.* Noel, Seton 4th ed. p. 355; Davenport *v.* Rylands, (1865) L. R. 1 Eq. 302 ; Pemberton, 4th ed. p. 484.

(*p*) United Telephone Co. *v.* Fleming, (1886) 3 R. P. C. 268 ; United Telephone Co. *v.* Patterson, (1889) 6 R. P. C. 140.

(*q*) Murray *v.* Clayton, (1872) L. R. 15 Eq. 115 ; American Braided Wire Co. *v.* Thompson (2), (1888) 5 R. P. C. 375 ; United Telephone Co. *v.* Walker, (1887) 4 R. P. C. 66 ; Leather-Cloth Co. *v.* Hirschfield, (1863) 1 H. & M. 295 ; Adair *v.* Young, (1879) L. R. 11 Ch. D. 136 ; 12 Ch. D. 13 ; Powell *v.* Birmingham Vinegar Brewery Co., (1896) 14 R. P. C. 1.

The very object for which the plaintiff desires the names of the defendant's customers may be to enable him to follow the infringing articles in the hands of such customers.

Account or Damages—Account.

Account.—When the plaintiff elects to take an account of profits he establishes a different relationship between himself and the defendant to that which exists between them on an inquiry as to damages. In the former case by electing to take an account of profits he condones the infringement,(*r*) and adopts that which was done by the defendant,(*s*) and claims for himself the profits made by the infringer from the use of the invention; in the latter case the defendant is treated all through the inquiry as a wrongdoer. Thus by electing to take an account it may be said that the plaintiff constitutes the defendant his agent as regards the acts whereby he, by the use of the invention, has made a profit or the reverse, and the question always is what in profit or loss was the result of the course of conduct actually pursued by the defendant, and not what might have been the profit had he pursued a different line of conduct. Consequently, the plaintiff is not entitled to an account of, and compensation for, the actual losses he may have sustained through the wrongful acts of the defendant; he is only entitled to an account and payment over to him of the actual profits, if any, derived from the defendant's use of the invention,(*t*) and, if the defendant has made profit by the illegal use of the patented invention, the fact that he might have made a profit otherwise—*e.g.*, by the sale of articles not manufactured by a machine the subject-matter of the patent—is quite immaterial.(*u*) The true test of comparison is to take the ratio of the profit derived when the invention was used with the profit which would have been derived had the defendant used that which, looking at all the circumstances of the case, he would most probably have used had he not illegally adopted the invention.(*x*)

Difference in relationship of the plaintiff to the defendant on the taking of an account to that which exists between them on an inquiry as to damages.

On the taking of the account the defendant may be compelled to disclose the profits arising from his business before he commenced to manufacture the articles to which the patent refers by the application of the patented process or machine, as well as since, if such information is necessary to put the Court in a

Profits of defendant's business before infringement as well as since.

(*r*) Neilson *v.* Betts, (1871) L. R. 5 H. L. 22.

(*s*) American Braided Wire Co. *v.* Thompson, (1890) 7 R. P. C. 158.

(*t*) Ellwood *v.* Christy, (1865) 18 C. B. N. S. 494.

(*u*) United Horseshoe and Nail Co. *v.* Stewart, (1888) L. R. 13 App. Cas. 401.

(*x*) Siddell *v.* Vickers, (1892) 9 R. P. C. 152.

Account or Damages—Account.

position to estimate what proportion of the total profits made by him since the commencement of the infringement is due to his wrongful acts.(*y*)

Extent of account of profits.

An inquiry as to profits made by an infringer extends to all profits, including those which accrued since the defendant became aware of the plaintiff's claim to the patent, as well as those which accrued before he became aware of such claim.(*z*)

The account also extends, not merely to the profits made by the sale of the pirated article, but also to all profits incidentally derived from its use. For example, where a defendant was sued for the infringement of a patent for gas-meters, and was ordered to account for profits made by him, the account was made to include the benefit derived by way of saving effected by the use of the piratical gas-meters.(*a*)

It would appear that if the plaintiff desires an account of collateral profits he must prove that such profits have been received;(*b*) and an account will not be directed when it is clear that no profits whatever have been made.(*c*)

Production of books and administration of interrogatories.

When an order for an account of profits is made against a defendant, he may be compelled to produce his books, and interrogatories may be administered, notwithstanding a pending appeal.(*d*)

Bankruptcy of defendant.

In the bankruptcy of a defendant the amount found due on an account of profits made by the infringement of a patent can be proved, as it is a liquidated debt.(*e*)

Plaintiff in the habit of supplying on royalty articles consisting of patented and non-patented parts.

Where the plaintiff is in the habit of supplying to his customers a complete instrument at a fixed royalty, and that instrument consists of patented and non-patented parts, it is proper, in estimating the amount to which he is entitled, to deduct from the royalty a sum in consideration of the non-patented portion of the infringing instrument.(*f*) Consequently, where the plaintiff elects to claim profits made by an unauthorised use of his invention it becomes material to ascertain how much of it was actually appropriated, in order to determine

(*y*) Siddell *v.* Vickers, (1889) 6 R. P. C. 464.

(*z*) Davenport *v.* Rylands, (1865) L. R. 1 Eq. 302, 308; United Horseshoe and Nail Co. *v.* Stewart, (1888) L. R. 13 App. Cas. 401.

(*a*) Crossley *v.* Derby Gaslight Co., (1829) 1 W. P. C. 119; see also Housahill Co. *v.* Neilson, (1843) 1 W. P. C. 697 n.

(*b*) Bacon *v.* Spottiswoode, (1839) 1 Beav. 382.

(*c*) Bergmann *v.* McMillan, (1881) L. R. 17 Ch. D. 423; Sanitas Co. *v.* Condy, (1887) 4 R. P. C. 530.

(*d*) Saxby *v.* Easterbrook, (1872) L. R. 7 Ex. 207.

(*e*) Watson *v.* Holliday, (1882) 30 W. R. 747; 31 W. R. 536; 52 L. J. Ch. 543; Bankruptcy Act, (1883) s. 37.

(*f*) United Telephone Co. *v.* Walker, (1887) 5 R. P. C. 61, 63.

what proportion of the net profits realised by the infringer was attributable to the use of the plaintiff's invention.(*g*)

Account or Damages—Damages.

Damages.—Before Lord *Cairns'* Act there was no jurisdiction in the Court of Chancery to give damages, and the old form of decree always gave the plaintiff an account of profits, but after Lord *Cairns'* Act jurisdiction was conferred on the Court to give damages, and in *Hills* v. *Evans* (*h*) Lord *Westbury* pronounced a decree giving the plaintiff both damages and profits, which course was held to be wrong in *Neilson* v. *Betts* (*i*) and *De Vitre* v. *Betts*,(*k*) in which the House of Lords settled finally that the successful plaintiff in an action of infringement of a patent is entitled, at his election, to damages or an account of profits, but not to both, which is the state of the law now,(*l*) and this relief may be obtained in either division of the High Court,(*m*) or in the Court of the County Palatine of Lancaster.(*n*)

Damages in lieu of an account of profits.

Before a plaintiff can be entitled to an inquiry as to damages, it is incumbent on him to show that he has in fact sustained some damage which is not merely nominal.(*o*)

The rate at which the plaintiff has accepted compensation for damages from non-litigants does not govern the assessment of the amount recoverable by action from the defendant.(*p*)

Assessment is not affected by amount accepted from non-litigants.

The measure of damages to which a successful plaintiff is entitled is the actual loss sustained by him by reason of the unlawful acts of the defendant, which loss must be the natural and direct consequence of the defendant's acts,(*q*) *i.e.*, the question is by how much would the plaintiff have been better off if there had been no infringement.(*r*) The plaintiff is not entitled to receive anything in respect of the annoyance and vexation he experiences from the necessity of having to establish his right in a Court of law, the award of the costs of the action being the only way the Court will attempt to recompense him in respect of such annoyance and vexation.(*s*)

Measure of damages.

(*g*) United Horseshoe and Nail Co. *v.* Stewart, (1888) L. R. 13 App. Cas. 412.

(*h*) (1862) 4 De G. F. & J. 288.

(*i*) (1871) L. R. 5 H. L. 1; 40 L. J. Ch. 317.

(*k*) (1873) 6 H. L. 319; 21 W. R. 705.

(*l*) Per Lindley, L.J., Siddell *v.* Vickes, (1892) 9 R. P. C. 162.

(*m*) p. 601 *ante*. (*n*) p. 601 *ante*.

(*o*) Dicks *v.* Brooks, (1880) L. R. 15 Ch. D. 39; United Telephone Co. *v.* Sharples, (1885) 2 R. P. C. 28; Sanitas Co. *v.* Condy, (1887) 4 R. P. C. 530; Cole *v.* Saqui, (1888) 5 R. P. C. 489, 496.

(*p*) Boyd *v.* Tootal Broadhurst, &c., Company, (1894) 11 R. P. C. 175.

(*q*) United Telephone Co. *v.* Walker, (1887) 4 R. P. C. 67.

(*r*) Boyd *v.* Tootal Broadhurst, &c., Co., (1894) 11 R. P. C. 175; Penn *v.* Jack, (1867) L. R. 5 Eq. 81; 37 L. J. Ch. 136.

(*s*) United Horseshoe and Nail Co. *v.* Stewart, (1888) L. R. 13 App. Cas. 401, 416; 5 R. P. C. 260.

Account or Damages—Damages.

From the above it is clear that it is important to establish what is the plaintiff's usual course of dealing with the invention, *e.g.*, the price at which he usually sells the patented article, or the amount of royalties he generally accepts from licensees authorised to use the invention.

In estimating the amount of damages to which a successful plaintiff is entitled, the Court recognises that every sale without licence of a patented article must be a damage to the patentee, and the inquiry is in the form, "what damage the plaintiff has sustained," not "what damage, if any." In the case of infringement of trade mark all the world are entitled to make the article, but not to brand it with the plaintiff's mark, but in the case of a patent every manufacture or sale of the article is necessarily a damage to the patentee.(*t*) The actual profit derived by the defendant is not in all cases necessarily the measure of the plaintiff's loss, for it cannot always be ascertained with arithmetical precision what, in the ordinary course of business, would have been the amount of the plaintiff's sales and profits. When the product of the patented process or machinery or the patented article itself is a new and special article which cannot be successfully imitated without using the invention, the process of estimation is comparatively simple, but on the other hand it is quite the reverse when this is not the case. An allowance is made to the plaintiff in respect of loss of sales caused by the defendant's competition, and at the same time the defendant is entitled to strike off a moderate percentage as representing sales due to increased activity in the trade produced by the rivalry of two competitors, if that is the relationship of the parties.(*u*)

Reduction of price by the plaintiff.

If a patentee whose patent is being infringed reduces the price at which he sells the patented articles, in order to be able to undersell the infringer, although in an action for damages he may be entitled to the benefit of all sales made by the infringer as if they were made by himself, so that he will get all the profit so made by the infringer, yet he will not be entitled to recover the difference between the original and reduced price, when the reduction is not a natural and direct consequence of the infringer's acts, and is therefore too remote.(*x*)

(*t*) Davenport *v.* Rylands, (1865) L. R. 1 Eq. 308.

(*u*) United Horseshoe and Nail Co. *v.* Stewart, (1888) L. R. 13 App. Cas. 401, 413, 417; Ellwood *v.* Christy, (1865) 18 C. B. N. S. 494; Penn *v.* Jack, (1866) L. R. 5 Eq. 81; Alexander *v.* Henry, (1895) 12 R. P. C. 360.

(*x*) United Horseshoe and Nail Co. *v.* Stewart, (1888) L. R. 13 App. Cas. 401; 5 R. P. C. 260.

Account or Damages—Damages.

But when it can be shown that the plaintiff has not reduced his price below that of the infringing defendant, and that the plaintiff's reduction has been consequent upon the defendant's, the Court, in estimating the amount of damages, will consider that the plaintiff, but for the defendant's wrongful acts, would have made all the sales effected by the defendant at the original and not at the lowered price.(*y*) A reduction, however, may be allowed to the defendant in consideration of the increase of sales by reason of the diminution of price, as also by reason of his business connection.(*z*)

Damages when it is not the plaintiff's usual course of business to grant licences.

When the patentee of machinery, who does not grant licences, claims damages from an infringing manufacturer who competes with him by selling the same class of goods as those made by the patented machine and in the same market, the profit made by the infringer is of no consequence. However large his gains, he is only liable in nominal damages so long as his illegal sales do not injure the trade of the patentee; and however great his loss he cannot escape from liability to make full compensation for the injury which his competition may have occasioned. Every sale of goods manufactured without licence by patented machinery is, and must be, treated as an illegal transaction in a question with the patentee; and its inherent illegality is not affected by the circumstance that the infringement consisted in using a small and, it may be, the least useful part of the invention.(*a*)

Damages when it is the plaintiff's usual course of business to grant licences.

When it is the plaintiff's usual course of business to grant licences, the measure of damage becomes the loss of royalties sustained by him through the defendant's acts; that is to say, the profit rent and royalties for the entire period during which the infringing article was in the hands of the defendant, whether it was or was not in use during the whole of that time.(*b*)

And where the plaintiff is in the habit of granting licences he cannot claim by way of damages a manufacturing profit, or any sum beyond the ordinary royalty; moreover, he will not be entitled to recover anything from the manufacturer if he has received the full royalty from the user.(*c*) And further it

(*y*) American Braided Wire Co. *v.* Thompson, (1890) 7 R. P. C. 47, 152; (1890) W.N. 68; L. R. 44 Ch. D. 274; Alexander *v.* Henry, (1895) 12 R. P. C. 360.

(*z*) *Ibid.*

(*a*) Per Lord Watson, United Horseshoe and Nail Co. *v.* Stewart, (1888) L. R. 13 App. Cas. 413; 5 R. P. C. 267.

(*b*) United Telephone Co. *v.* Walker, (1889) 4 R. P. C. 63; English and American Machinery Co. *v.* Union Boot and Shoe Machine Co., (1895) 13 R. P. C. 64.

(*c*) Penn *v.* Jack, (1867) L. R. 5 Eq. 81.

Account or Damages—Damages.

cannot always be taken for granted that the licences which it is presumed the plaintiff would have granted, had the defendant not infringed, would have been in force till the expiration of the patent; with regard to the duration of such supposed licences, the Court must make the best estimate it can, having regard to all the circumstances of the case, *e.g.*, the average duration of licences granted by the plaintiff about the time the defendant's acts were committed.(*d*)

A patentee who has obtained an injunction cannot be compelled to accept from an infringer desirous of continuing the use of the invention the same royalties he accepts from other and licensed users.(*e*)

Damages may be recovered either against a manufacturer or a user, or both, until the full amount has been recovered.

Damages for infringement may be recovered against either a manufacturer or a user, or both, until the full measure of damage which is the total loss of the profit which the plaintiff would have made had the infringing machine been supplied by him has been recovered.(*f*)

For example, if a patentee obtains an injunction and damages against an infringing manufacturer, and the manufacturer does not pay the damages, it is open to the patentee to claim from a purchaser of the manufacturer what is due to him by way of damages in respect of the purchase of infringing machines; (*g*) and the acceptance by the plaintiff of agreed damages from an infringing manufacturer of the patent article in respect of his wrongful acts, does not preclude the plaintiff from following the article in the hands of a purchaser from such manufacturer and claiming damages from him, for the payment of agreed damages by the manufacturer does not make the article "free" in the hands of a purchaser.(*h*) A plaintiff's right to damages against a defendant user is not affected by the fact that the user had no notice of the patent; (*i*) such a user cannot be heard to say that, if he had had notice of the patent, he might have bought articles other than those which infringe the patent and which would have done as well for him.(*k*)

(*d*) English and American Machinery Co. *v.* Union Boot and Shoe Machinery Co., (1895) 13 R. P. C. 64.

(*e*) Penn *v.* Bibby, (1866) L. R. 3 Eq. 310, 312; Penn *v.* Jack, (1867) L. R. 5 Eq. 81.

(*f*) Penn *v.* Bibby, (1866) L R. 3 Eq. 308; Penn *v.* Jack, (1867) L. R. 5 Eq. 81; United Telephone Co. *v.* Walker, (1889) 4 R. P. C. 63; United Horseshoe and Nail Co. *v.* Stewart, (1888) L. R. 13 App. Cas. 401; American Braided Wire Co. *v.* Thompson, (1890) 7 R. P. C. 47, 152; Boyd *v.* Tootal Broadhurst, &c., Co., (1894) 11 R. P. C. 175.

(*g*) Cropper *v.* Smith, (1883) L. R. 24 Ch. D. 305, 312.

(*h*) United Telephone Co. *v.* Walker, (1887) 4 R. P. C. 63, 67.

(*i*) Boyd *v.* Tootal Broadhurst, &c., Co., (1894) 11 R. P. C. 147.

(*k*) *Ibid.*

In cases where it appears that the defendant has infringed during the interval between a former decision adverse to the validity of the patent and its reversal on appeal, and further, that the defendant's wrongful acts were committed on the strength of that former decision, it is submitted that the defendant would be allowed to give evidence on this point in reduction of damages.(*l*)

Destruction or Delivery up of Infringing Articles.

Damages in respect of infringements committed on the strength of a judgment adverse to the patent.

It is open to question whether a Judge of the Chancery Division has jurisdiction to order an inquiry as to damages to be referred to a Judge and jury.(*m*)

Reference of inquiry to a Judge and jury.

Where the plaintiff in an action for the infringement of a patent claimed the costs of a former action against the same defendant, which it was alleged was discontinued owing to false evidence on the part of the defendant, the Court held that the proper course was to strike out those paragraphs of the statement of claim which referred to the costs of the former action, and to leave the plaintiff at liberty to bring a separate action in respect of them, and intimated that such action ought to be brought in the Queen's Bench Division.(*n*)

Costs of a former discontinued action.

Where damages, though claimed in the pleadings, were by an oversight not asked for at the trial, special leave was given, on subsequent motion by the plaintiff, to vary the minutes of the decree by adding an inquiry as to damages.(*o*)

Omission to ask for damages at the trial.

Destruction or Delivery to Plaintiff of Infringing Articles.

In addition to an injunction restraining the defendant from infringing the patent in future, and an account of profits or damages at his option, a successful plaintiff in an action for infringement may under the present practice obtain an order of the Court directing an inquiry as to how many of the infringing articles are in the possession of the defendant, and ordering further that all such articles shall be destroyed in the presence of the plaintiff or delivered up to him,(*p*) or that they shall be

Power of the Court to order the destruction or delivery to the plaintiff of infringing articles.

(*l*) pp. 503, 504 *ante*; Arkwright *v.* Nightingale, (1785) 1 W. P. C. 61.

(*m*) American Braided Wire Co. *v.* Thompson, (1888) 5 R. P. C. 696.

(*n*) United Telephone Co. *v.* Tasker, (1889) 6 R. P. C. 38.

(*o*) Edison *v.* Holland, (1888) 5 R. P. C. 483.

(*p*) Betts *v.* De Vitre, (1865) 34 L. J. Ch. 289, 291; S. C. 11 Jur. N. S. 9, 217; Seton, 4th ed. p. 354; Washburn and Moen Manufacturing Co. *v.* Patterson, (1884) 1 R. P. C. 157, 162; Tangye *v.* Stott, (1865) 14 W. R. 386; Frearson *v.* Loe, (1878) L. R. 9 Ch. D. 48, 67; Otto *v.* Steel, (1886) 3 R. P. C. 109, 120; Emperor of Austria *v.* Day, (1861) 3 De G. F. & J. 217; Young *v.* Fernie, (1866) L. R. 1 H. L. 63; Pemberton 4th ed. p. 484; Edison *v.* Holland, (1888) 5 R. P. C. 483.

Destruction or Delivery up of Infringing Articles.

delivered up or destroyed.(*q*) It is to be observed that the practice of the Court in granting orders for the delivering up or destruction of the defendant's goods is of modern growth and does not rest upon any statutory penalty of forfeiture for infringement. No forfeiture of goods can rest upon a grant of letters patent.(*r*) It would appear doubtful whether the Court has jurisdiction to make an order for the delivering up of the defendant's goods to the plaintiff, and it may very well be that a defendant whose goods are compulsorily taken or destroyed by the plaintiff, though under an order of the Court, has a right of action under s. 4 of the Statute of Monopolies in respect of an illegal forfeiture. The question does not appear to have been discussed in any of the decided cases where the Court has made an order for destruction or delivery up, and there is much to be said in favour of the right of action above referred to.(*s*)

In a case where the statement of claim prayed for the delivery up and destruction of all infringing articles in the power or control of the defendants, *Bacon*, V.C., declined to make the order at the trial, but reserved the question for consideration after an account of profits had been taken.(*t*)

Form of order.

The order for delivery up or destruction usually fixes a time within which the infringing articles are to be delivered up or destroyed.(*u*)

When an infringing article is composite.

Where a defendant is found to have infringed a patent for an invention consisting of a new combination of old parts, the Court will probably grant an injunction restraining the user of the infringing machines, but refuse to order their destruction, on the ground that the parts may be separated and used for other purposes, and the order will give liberty to the plaintiff to mark the infringing machines so as to be able to follow them at any time.(*x*)

Under the following circumstances, an order for delivery up was refused:—The infringing machines consisted of two distinct parts, one of which was an infringement of the patent, and the other was not; the machines had been manufactured

(*q*) Badische Anilin und Soda Fabrik *v.* Levinstein, (1883) L. R. 24 Ch. D. 176; Plimpton *v.* Malcolmson, Seton, 4th ed. p. 354.

(*r*) Waltham *v.* Austin, 8 Co. Rep. 125a, 127b; 2 Inst. 47; Horne *v.* Ivy, 1 Sid. 441; 1 Vent. 47; Hastings' Patent, Noy 183.

(*s*) But see Peck *v.* Hindes, (1898) 14 Tim. L. R. 164; 15 R. P. C. 113.

(*t*) Hocking *v.* Fraser, (1886) 3 R. P. C. 7.

(*u*) Otto *v.* Steel, (1886) 3 R. P. C. 120; Washburn and Moen Manufacturing Co. *v.* Patterson, (1884) 1 R. P. C. 191.

(*x*) Needham *v.* Oxley, (1878) 8 L. T. N. S. 604; 11 W. R. 852; Pemberton, 4th ed. p. 485; Seton, 4th ed. pp. 352, 353.

abroad and imported into this country, and the defendants dismantled them and kept the separate parts stored in a warehouse.(*y*) Also where the infringing part was a portion of a complicated apparatus the defendant was not ordered to deliver up the whole machine on his undertaking to remove the infringing part.(*z*)

Costs.

The destruction of an infringing article may cause a loss to the defendant considerably greater then the cost of such infringing article, as, for example, where the infringing article is used in combination with other things which do not infringe, and the article cannot be detached without destroying the whole machine—*e.g.*, the filament in an *Edison* incandescent electric lamp which was held to infringe the *Cheesborough* patent, and an order for the destruction of which was obtained.(*a*) This loss is part of the risk an infringer incurs when he invades a patentee's rights.

Loss caused to defendant.

Costs.

Subject to the Judicature Acts and the Supreme Court Rules, 1883, the costs of and incident to all proceedings in the Supreme Court are in the discretion of the Court or Judge, provided that where any action, cause, matter, or issue is tried with a jury, the costs shall follow the event, unless the Judge by whom such action, cause, matter, or issue is tried, or the Court, shall for good cause otherwise order.(*b*) Consequently the costs of an action for infringement of a patent are in the discretion of the Judge of any division of the Supreme Court in which the action is tried.

Discretion of Court or Judge.

On taxation, however, no costs will be allowed to either party in respect of any particular which the Court or a Judge has not certified as being reasonable and proper.(*c*) And in case the plaintiff succeeds in an action in respect of a patent, the validity of which has been certified by the Court or a Judge to have been questioned in a former action for infringement, he is entitled to have his full costs, charges, and expenses, as between solicitor and client, unless the Court or a Judge trying the case certifies that he ought not to have the same.(*d*)

Necessity for certificate of particulars, and validity.

(*y*) United Telephone Co. *v.* London and Globe Telephone and Maintenance Co., (1884) L. R. 26 Ch. D. 766, 776.

(*z*) Automatic Weighing Machine Co. *v.* Feasby, (1893) 10 R. P. C. 442.

(*a*) Edison *v.* Holland, (1888) 5 R. P. C. 459, 483.

(*b*) R. S. C. (1883) Ord. lxv. r. 1.

(*c*) 46 & 47 Vict. c. 57, s. 29, sub-s. 6; p. 650 *post*; Longbottom *v.* Shaw, (1889) 6 R. P. C. 513. This provision does not apply to the Court of the County Palatine of Lancaster, as that Court is not a Court within the meaning of 46 & 47 Vict. c. 57, s. 29 (6); see p. 618 *post*.

(*d*) 46 & 47 Vict. c. 57, s. 31; p. 650 *post*.

Costs.

In the words of Sir George *Jessel*, M.R.: "Where a plaintiff comes to enforce a legal right, and there has been no misconduct on his part, or omission or neglect which could induce the Court to deprive him of his costs, the Court has no discretion, and cannot take away the plaintiff's right to costs. There may be misconduct of many sorts: for instance, there may be misconduct in commencing the proceedings, or some miscarriage in the procedure, or any oppressive or vexatious mode of conducting the proceedings, or other misconduct which will induce the Court to refuse costs; but where there is nothing of the kind the rule is plain and well settled, and is as I have stated it." (*e*)

Ignorance does not exempt from liability to pay costs.

As we have seen, a plaintiff is not bound to apply to the defendant for the relief he seeks before commencing action,(*f*) and ignorance on the part of the defendant is no defence to an action for infringement.(*g*) Neither of these grounds will determine the Court to refuse the plaintiff his costs, if he succeeds in the action and is not otherwise disqualified.(*h*)

When defendant admits and undertakes to discontinue infringement.

Although a defendant admits infringement and promises to discontinue the acts complained of and not to repeat them, the plaintiff is not bound to rely on such promises, but may obtain the injunction of the Court or such other relief as may be necessary.(*i*) In such a case, if the defendant would avoid the costs of the action he must, at the time he admits the infringement, offer to pay all the costs incurred up to that period.(*k*)

Where the plaintiff failed to prove infringement, though the defendant admitted a discontinued infringement before action and offered to pay what was reasonable, the plaintiff was condemned in the costs of the action.(*l*)

A defendant who admits infringement must, in order to escape costs, if the plaintiff proceeds to an injunction, not merely promise not to repeat the infringement, but he must admit and offer to pay the amount of his liability. Thus, where a defendant had merely promised not to repeat the infringement, the

(*e*) Cooper *v.* Whittingham, (1880) L. R. 15 Ch. D. 504.

(*f*) p. 505 *ante*.

(*g*) p. 465 *ante*.

(*h*) Wittman *v.* Oppenheim, (1884) L. R. 27 Ch. D. 260; Upmann *v.* Forrester, (1883) L. R. 24 Ch. D. 231; Burgess *v.* Hateley, (1859) 26 Beav. 249; Cooper *v.* Whittingham, (1880) L. R. 15 Ch. D. 504; Davenport *v.* Rylands, (1865) L. R. 1 Eq. 302; Collins *v.* Walker, (1859) 7 W. R. 222.

(*i*) pp. 505, 506 *ante*.

(*k*) Burgess *v.* Hateley, (1859) 26 Beav. 249; Geary *v.* Norton, (1846) 1 De G. & S. 9, 12; Fradella *v.* Weller, (1831) 2 Russ & M. 247; Nunn *v.* D'Albuquerque, (1865) 34 Beav. 595; Colburn *v.* Simms, (1843) 2 Hare, 543; Jenkins *v.* Hope, (1895) 13 R. P. C. 57.

(*l*) Fletcher *v.* Glasgow Gas Co., (1887) 4 R. P. C. 386.

Costs.

plaintiff was held to be entitled not only to an injunction but to his costs of the suit.(*m*)

Again, defendants, who merely offered to remove certain infringing portions of a machine but gave no promise not to use them again and did not offer to pay the costs of the action already incurred, were ordered to pay the costs the plaintiff was put to in order to obtain an injunction.(*n*) And in an action in the Palatine Court, where infringing machines had been disused for five years previous to the commencement of the action, and had been removed from the defendant's premises, the plaintiffs obtained their costs on proof of the infringement, which was denied, and this although there was no threat on the part of the defendants to renew the infringement.(*o*) The Court of Appeal, however, held that in the absence of any evidence of an intention on the defendants' part to continue the wrongful acts an injunction ought not to have been granted, and dismissed the action, but, owing to the defendant's conduct of their case, without costs in the Court below, although they gave the defendants the costs of their successful appeal.(*p*)

When plaintiff's conduct is oppressive.

Oppressive conduct on the part of the plaintiff will induce the Court to deprive him of his costs, even though he succeed in the action. Thus, where a defendant at the hearing submitted to a perpetual injunction, and it appeared that the defendant had ignorantly infringed the patent, but had previously to the commencement of the action offered to deliver up to the plaintiff all profits he had made by selling the infringing articles, and to sell all such articles remaining in his possession to the plaintiff at a fair valuation, but the plaintiff nevertheless continued the action, the Court gave him no costs.(*q*)

When plaintiff withdraws action.

Where the plaintiff seeks leave by summons or otherwise to withdraw the action, the Court imposes such terms as to costs as under the circumstances seem reasonable.(*r*)

Separate issues.

It is provided by R. S. C., 1883, Ord. lxv. r. 2, that where issues of fact and law are raised upon a claim or counterclaim the costs of the several issues respectively, both in law and fact, shall, unless otherwise ordered, follow the event.

(*m*) Geary *v.* Norton, (1846) 1 De G. & S. 9.

(*n*) United Telephone Co. *v.* London and Globe Telephone and Maintenance Co., (1884) 1 R. P. C. 117.

(*o*) Proctor *v.* Bayley, (1889) 6 R. P. C. 106.

(*p*) 6 R. P. C. 538.

(*q*) Nunn *v.* D'Albuquerque, (1865) 34 Beav. 595.

(*r*) Boake, Roberts & Co. *v.* Stevenson, (1894) 12 R. P. C. 228; Wilcox and Gibbs' Sewing Machine Co. *v.* Janes, (1897) 14 R. P. C. 523; Bethell *v.* Gage, (1897) 14 R. P. C. 699.

Costs.

Issues abandoned at the trial.

Apportionment of costs.

The costs of issues raised by either party, but abandoned at the trial, must be borne by the party who raised them.(*s*)

In considering the question of the apportionment of costs in patent cases, it will be well to divide the decisions into two classes—I. Those in which the validity of the patent was either not contested, or was established; II. Those in which the patent was declared invalid.

I. *Where the plaintiff succeeds in upholding the validity of the patent, but fails to prove the fact of infringement, it appears to be the general rule that the Court will apportion the costs.*

Thus, in a case in which the plaintiff succeeded on the question of validity, and the defendant on that of infringement, *Bacon*, V.C., apportioned the costs, saying: "The costs of the suit, as far as relates to the futile attempt to dispute the plaintiff's right to a patent invention, must be borne by the defendant. The costs of the plaintiff's futile attempt to restrain the defendant from doing that which I think by law he is entitled to do, his patent not being an imitation or piracy of the plaintiff's, the plaintiff must pay him, and the one set of costs must be set off against the other."(*t*)

In an action brought for the infringement of two separate patents, the jury found some of the issues affecting the validity of the patents for the plaintiff and others for the defendant, and it was finally ordered "that the costs be left to abide the event of the several findings for the plaintiff and the defendant company respectively, in respect of the said two letters patent, and that the said costs be taxed on the higher scale, and that the plaintiff do recover nothing against the defendants, save and except the costs of the issues on which he has obtained judgment, and that, save as aforesaid, the defendant company do recover their costs of suit from the plaintiff.(*u*)

And in another instance the action was dismissed with costs, but the Court directed that the plaintiff should have his costs, which were incurred by reason of the defendant disputing the

(*s*) Thompson *v.* The American Braided Wire Co., (1889) 6 R. P. C. 518.

(*t*) Simmonds *v.* Hitchman, (1885) L. R. 29 Ch. D. 417; see also Automatic Weighing Machine Co. *v.* Knight, (1889) 6 R. P. C. 297; see also Sunlight Incandescent Gas Lamp Co. *v.* Incandescent Gas Light Co., (1897) 14 R. P. C. 776, 777.

(*u*) Westinghouse *v.* Lancashire and Yorkshire Ry. Co., (1884) 1 R. P. C. 229, 254.

validity of the patent.(*x*) In one case the Court of Appeal awarded the general costs to the defendant, but gave the costs of the issue of novelty, which was not decided, to neither side.(*y*)

Costs.

Apportionment of costs continued.

In an action in which the defendants appealed from a judgment for the plaintiff with costs, and the taxed costs were by consent paid into Court pending an appeal, the Court of Appeal, without going into any other question, decided the issue of infringement in favour of the defendants, and dismissed the appeal with costs. On a subsequent application by the defendants for the repayment of the costs paid by them into Court, the Vice-Chancellor of the Palatine Court held that the plaintiff was not entitled to an apportioned part of these costs, attributable to points other than infringement, on which he had succeeded at the trial; and that the costs must be paid out of court without waiting for the result of an appeal to the House of Lords.(*z*)

Where the House of Lords reversed the decision of the Court below on the issue of validity, and held that the patent was good, but upheld the finding that the defendant had not infringed, the appeal was dismissed, but no costs were given.(*a*)

In an action which was dismissed, on the ground of no infringement, without going into the validity of the patent, and costs were given to the defendant, but no certificate was asked for as to the reasonableness and propriety of the particulars of objections,(*b*) the plaintiff sought, without success, by taking out a summons to review the taxation, to set off the costs he had incurred by obtaining evidence to meet the defendant's objections.(*c*) The plaintiff's contention was that the defendant's particulars were "improper, vexatious, or unnecessary" within the meaning of R. S. C. Ord. lxv. 7, 27, sub-r. 20, and that he was, therefore, entitled to the costs occasioned by them. The Court, however, held that the taxing-master had rightly disallowed the defendant's costs of his particulars of objection, not because they were "improper, vexatious, or unnecessary," but simply because there had been no certificate, and it was a condition precedent, before the plaintiff could succeed, that he should show the costs of such

(*x*) Nordenfelt *v.* Gardner, (1884) 1 R. P. C. 61, 75.
(*y*) Needham *v.* Johnson, (1884) 1 R. P. C. 49, 59.
(*z*) Boyd *v.* Horrocks, (1889) 6 R. P. C. 528.
(*a*) Moore *v.* Bennett, (1884) 1 R. P. C. 129.
(*b*) p. 617 *post*.
(*c*) Garrard *v.* Edge W. N 1890, pp. 43, 68.

Costs.

Apportionment of costs continued.

particulars were disallowed on the ground that they were "improper, vexatious, or unnecessary."

Sometimes when the plaintiff succeeds on the issue of validity, but fails on the issue of infringement, though the plaintiff gets the chief part of the costs relative to validity, yet he does not get them all, the costs of some of the particulars of objections being given to the defendant on the ground that such particulars were reasonable and proper, and necessary for the purpose of defining the ambit of the claim.(*d*)

The proper form of order when the plaintiff is given the costs of the issue of validity, and the defendant the geneal costs of the action, was discussed in *Shoe Machinery Co.* v. *Cutlan.*(*e*)

II. *There is no general rule as to the apportionment of costs where the plaintiff fails to uphold his patent, but is successful on the issue of infringement.*

The Court has a discretion in the matter which is exercised according to the circumstances of each case.(*f*) It is proper for the Court, if, after hearing the evidence, it comes to the conclusion that issues were unnecessarily raised, to apportion the costs of those issues; but the Court will not apportion the costs of issues which have never been heard in consequence of a decision having been come to at the outset of the case against the validity of the patent.(*g*)

In some cases where the defendant has impeached the patent on more than one ground, but has not been successful on all, and the plaintiff has succeeded on the issue of infringement, the costs of the issues affecting the validity of the patent on which the defendant has failed have been given to the plaintiff, and the other costs of the action to the defendant.(*h*)

A rule was stated by *Fry*, J., in *Wegman* v. *Corcoran*,(*i*) to the effect that where the plaintiff fails on the issue of validity, but succeeds on other issues, the Court gives the general costs of the action to the defendant, but as regards certain issues raised by the one side or the other, the Court apportions the costs according to the success of the parties.

(*d*) Nobel's Explosives Co. *v.* Anderson, (1894) 11 R. P. C. 128.

(*e*) (2) (1896) 13 R. P. C. 148, 398; see also Sunlight Incandescent Gas Lamp Co. *v.* Incandescent Gas Light Co., (1897) 14 R. P. C. 775, 776.

(*f*) Kaye *v.* Chubb, (1887) 4 R. P. C. 289, 300, 303.

(*g*) Blakey *v.* Latham, (1889) 6 R. P. C. 184, 190.

(*h*) Pooley *v.* Pointon, (1885) 2 R. P. C. 167; Lawrence *v.* Perry, (1885) 2 R. P. C. 179; Lawrie *v.* Baker, (1885) 2 R. P. C. 213; Lister *v.* Norton, (1886) 3 R. P. C. 199.

(*i*) (1879) 27 W. R. 357.

Costs.

Apportionment of costs continued.

This rule was approved and applied by the Court of Appeal in *Badische Anilin und Soda Fabrik* v. *Levinstein.*(*k*) In this case *Bowen*, J., said: "I am of opinion, in this case, that the plaintiffs should have the costs occasioned by the issues raised by the particulars of breaches, and that in respect of all the other costs the costs in the action should follow the usual result, and be awarded to the successful party. It seems to me that without laying down any hard-and-fast line, or trying to fetter our discretion at a future period in any other case, we are acting on a sensible and sound principle, namely, the principle that parties ought not, even if right in the action, to add to the expenses of an action by fighting issues in which they are in the wrong. It may be very reasonable as regards their own interest, and may help them in the conduct of the action, that they should raise issues in which in the end they are defeated; but the defendant who does so does it in his own interest, and I think he ought to do it at his own expense." (*l*)

Other Judges have, however, held that a plaintiff who has failed to substantiate his patent, but has succeeded on the issue of infringement, may be deprived of his costs of that issue, on the ground that in the opinion of the Court the issue was not sufficiently distinguished from the rest of the case,(*m*) or that the costs of the issue were trifling,(*n*) or on the ground that there can be no infringement of an invalid patent, and that it is consequently impossible for the plaintiff to succeed on the issue of infringement if the patent is bad.(*o*) In one case where the infringement was admitted and the defendant succeeded on the ground of want of novelty he was awarded the costs of the anticipations proved and the plaintiff the costs of the issue of infringement, but no other costs.(*p*)

Certificate of particulars is necessary on taxation.

It is provided by s. 29 sub.-s. 6 of the Act of 1883 (*q*) that on taxation of costs regard shall be had to the particulars delivered by the plaintiff and the defendant, and they respectively shall not be allowed any costs in respect of any particular delivered by them unless the same is certified by the Court or

(*k*) (1885) L. R. 29 Ch. D. 366, 418, 420.

(*l*) (1885) L. R. 29 Ch. D. 419; see also Boyd *v.* Horrocks, (1889) 6 R. P. C. 152, 162; Cassel Gold Extracting Co. *v.* Cyanide Gold Recovery Syndicate, (1894) 11 R. P. C. 638; 12 R. P. C. 258, 303.

(*m*) Guilbert-Martin *v.* Kerr, (1887) 4 R. P. C. 23.

(*n*) Kay *v.* Chubb, (1887) 4 R. P. C. 289.

(*o*) Edison *v.* Holland, (1888) 5 R. P. C. 483; Blakey *v.* Latham, (1888) 6 R. P. C. 29; United Telephone Co. *v.* Harrison, (1882) L. R. 21 Ch. D. 720.

(*p*) Bennington *v.* Hill, (1891) 8 R. P. C. 327; *cf.* Westley Richards *v.* Perkes, (1893) 10 R. P. C. 194.

(*q*) p. 650 *post.*

Costs.

a Judge to have been proven or to have been reasonable and proper, without regard to the general costs of the case.

Where the plaintiff's particulars alleged four distinct breaches, but no evidence was given as to one of them, and the plaintiff obtained the costs of the action, the certificate was confined to the particulars which had been proved.(*r*)

Omission to ask for certificate at the trial.

If either party omits to ask at the trial for a certificate as to the reasonableness and propriety of his particulars, it is submitted that he may obtain it afterwards on summons in chambers,(*s*) or on motion in Court.(*t*)

Power of Court of Appeal and House of Lords to grant a certificate of particulars.

In the event of the Court of Appeal reversing the decision of the Court below, the Court of Appeal has power to and will grant a certificate as to proof of, or the reasonableness and propriety of, the particulars.(*u*) Where the Court of Appeal reversed the decision of the Court below as to the validity of a patent, and granted a certificate as to some of the particulars of objections, *Cotton*, L.J., said, in reference to s. 29 of the Act of 1883: "I do not think that the Court of Appeal is the Court pointed at in that section, nor that the Judge in the Court of Appeal is the Judge pointed at; it must mean the Judge of the High Court who hears the matter originally, or a Divisional Court of the High Court. But in the Court of Appeal we ought to make such order as in our opinion the Judge who heard the case ought to have made—the Judge from whom the appeal is. In this case we thought he ought to have dismissed the action, and then, of course, he ought to have considered what particulars were proven, or reasonable and proper. In our opinion we ought to do that, as he has not done it, and could not do it, having regard to the conclusion at which he arrived. That has really been done in several patent cases which have been before this branch of the Court, and, that being so, we ought in our opinion to grant a certificate stating what particulars were reasonable and proper." (*x*)

The House of Lords on the same principle has a similar jurisdiction.(*y*)

Court of the County Palatine of Lancaster.

The Court of the County Palatine of Lancaster is not a Court, nor is the Vice-Chancellor a Judge within the meaning of

(*r*) Cole *v.* Saqui, (1888) 5 R. P. C. 489, 497.

(*s*) Judic. Act, (1873) s. 39; R. C. S. (1883) Ord. xlv. rr. 2, 17, 18; Ord. liv. r. 1.

(*t*) Rowcliffe *v.* Morris, (1886) 3 R. P. C. 145.

(*u*) Cole *v.* Saqui, (1889) 6 R. P. C. 41, 45; Humpherson *v.* Syer, (1887) 4 R. P. C. 416.

(*x*) Cole *v.* Saqui, (1889) 6 R. P. C. 45.

(*y*) Morris *v.* Young, (1895) 12 R. P. C. 465.

Costs.

s. 29 sub.-s. 6 of the Act of 1883,(*z*) but it must be remembered that his Honour has power over the costs of particulars irrespective of any certificate.(*a*) It is his Honour's practice to certify the particulars in respect of which the parties are to receive costs or otherwise.(*b*)

Certificate as to particulars is granted in two distinct cases.

It is to be observed that the Act of 1883 (*c*) provides that the Court may grant the certificate as to particulars in two distinct cases—*i.e.*, (1) when the particulars have been proven, and (2) where in the opinion of the Court or a Judge they were reasonable and proper. Neither party to an action of infringement can, whether the action is brought to trial or is discontinued at an earlier step, be allowed the costs of his particulars on taxation unless he is provided with the certificate of the Court or a Judge as to them.(*d*) The provisions of s. 29 of the Act of 1883 as to certificates of particulars are different in this respect to those of the somewhat analogous section of the repealed Act of 1852, which were only applicable when there had been an actual trial in Court, and, consequently, under that Act, when the action was discontinued, or judgment was allowed to go by default, or the action was dismissed for want of prosecution, no certificates were given, but the costs of particulars were dealt with in the ordinary way.(*e*) Now, however, in all cases when the Court has not the materials necessary to enable it to grant the certificate, the successful party is, consequently, deprived of the costs of his particulars.(*f*)

Certificate when action is not tried out on all the issues raised.

The question arises whether, when the action is actually brought to a trial, but the case of the plaintiff breaks down on account of the patent being clearly proved to be void, or on an admission of one of the plaintiff's witnesses,(*g*) or on the evidence offered by the defendant, and the defendant is consequently not afforded an opportunity of proving his particulars, the Court can give a certificate that such particulars were reasonable and proper, and so enable him to obtain the costs of

(*z*) Proctor *v.* Sutton Lodge Chemical Co., (1888) 5 R. P. C. 184.

(*a*) Parnell *v.* Mort, Liddell and Co., (1885) L. R. 29; Ch. D. 325; 2 R. P. C. 55; Garnett *v.* Bradley, (1878) L. R. 3 App. Cas. 944.

(*b*) Cheetham *v.* Oldham, (1890) 7 R. P. C. 124; Horrocks *v.* Stubbs, (1886) 3 R. P. C. 240; Parnell *v.* Mort, Liddell and Co., (1885) L. R. 29 Ch. D. 325; 2 R. P. C. 55; see also 53 & 54 Vict. c. 23, s. 3.

(*c*) s. 29, sub-s. 6.

(*d*) Middleton *v.* Bradley, (1895) 12 R. P. C. 390.

(*e*) Batly *v.* Knock, (1875) L. R. 20 Eq. 632; Rothwell *v.* King, (1887) 4 R. P. C. 397; Greaves *v.* The Eastern Counties Ry. Co., (1859) 1 E. & E. 961; 28 L. T. Q. B. 290; Stevens *v.* Keating, (1850) 1 Mac. & G. 659.

(*f*) Middleton *v.* Bradley (1895) 12 R. P. C. 390; Mandleberg *v.* Morley, (1893) 11 R. P. C. 1; 12 R. P. C. 35; Wilcox and Gibbs' Sewing Machine Co. *v.* James, (1897) 14 R. P. C. 524.

(*g*) The Germ Milling Co. *v.* Robinson, (1886) 3 R. P. C. 254.

Costs.

Rule that Court will only certify such particulars as the materials before the Court enable it to say are reasonable and proper.

them.(*h*) The rule is that the Court will only certify with regard to such of the particulars as the materials before the Court at the time the certificate is asked for enable it to say that such particulars have either been proven or are reasonable and proper,(*i*) and where the Court disposes of the action on one point it will not hear the case further for the purpose of deciding whether the other particulars should be certified or not.(*k*)

The working of this rule in practice is well illustrated by the course pursued by the Court under the various circumstances hereafter detailed. Where the plaintiffs failed in their action on the ground of the invalidity of the patent being established by one of their own witnesses, judgment was given for the defendants without their being called upon to go into their defence, and the Judge held that he must decide which of the particulars of objection were reasonable and proper in regard to the case so far as it had gone, and a certificate was granted to the defendant in respect of those particulars only which the Judge specifically mentioned. It was also held that the plaintiffs not being entitled to any costs, they were not entitled to any certificate in respect of their particulars of breaches.(*l*) And where at the trial the plaintiff's case broke down on account of his first witness in cross-examination being unable to distinguish the alleged invention from a previous specification, and the action was accordingly dismissed, the defendant was allowed a certificate which was limited to the particulars involved in the decision of the Court.(*m*) Where a case broke down on account of the impossibility of supporting the first claim of the patent, and the action was dismissed without the defendants being called on, *Kay*, J., refused to give a certificate with regard to the particulars of objections, but gave costs on the higher scale and liberty to apply with regard to the costs of the particulars of objections.(*n*) On the other hand, in another case, where the same learned Judge at the end of the

(*h*) Longbottom *v.* Shaw, (1888) 5 R. P. C. 497; (1889) 6 R. P. C. 143.

(*i*) Mandleberg *v.* Morley (1895) 12 R. P. C. 35, and cases there referred to; Middleton *v.* Bradley, (1895) 12 R. P. C. 390; Wilcox and Gibbs' Sewing Machine Co. *v.* James, (1897) 14 R. P. C. 524; Bethell *v.* Gage, (1897) 14 R. P. C. 699; but see p. 621 *post*.

(*k*) Boyd *v.* Horrocks, (1889) 6 R. P. C. 162; Longbottom *v.* Shaw, (1889) 6 R. P. C. 143; Mandleberg *v.* Morley, (1895) 12 R. P. C. 35.

(*l*) The Germ Milling Co. *v.* Robinson, (1886) 3 R. P. C. 254.

(*m*) Griffin *v.* Feaver, (1889) 6 R. P. C. 396; see also Albo-Carbon Light Co. *v.* Kidd, (1887) 4 R. P. C. 535; Oddy *v.* Smith, (1888) 5 R. P. C. 503; Slazenger *v.* Feltham, (1889) 6 R. P. C. 130; Boyd *v.* Horrocks, (1889) 6 R. P. C. 152, 162.

(*n*) Rowcliffe *v.* The Longford Wire, Iron, and Steel Co., (1887) 4 R. P. C. 281, 288.

Costs.

plaintiff's case intimated that he would not call on the counsel for the defendant, and gave judgment in his favour, he not only refused a certificate in regard to the particulars of objections, but also refused to give liberty to apply.(*o*) On taxation of the costs in the latter case the taxing-master allowed the costs relating to or governed by the defendant's particulars, including the costs of the witnesses, but the Judge, on summons, varied the master's order by disallowing those costs, on the ground that the words of the Act are precise, and that as no certificate had been granted at the trial they could not be allowed.(*p*) *Kay*, J., in giving his decision, said: "There might well be a case where the matter was decided against the plaintiff without calling upon the defendant's counsel, and yet the Court, relying upon the evidence obtained by the defendant by cross-examining the witnesses, might think it right to look at the particulars of objections, and allow the costs of such particulars as were in fact made out by the cross-examination. I can quite understand that case occurring, and therefore I do not say that there might not be, in such a case as this, or in a similar case like that which I have just described, propriety in the Court looking into the particulars of objections, and saying whether they were reasonable or not, having regard to the specification." (*q*) Since these remarks were uttered there have been cases (*r*) in which the Court, being satisfied on the materials before it has granted the certificate as to particulars of objections, though the case was decided before the defendant had an opportunity of giving any evidence.

Though validity is not decided, objections may be certified on the ground that they were necessary to the decision of the ambit of the claim.

And the certificate has been given as to some of the defendant's objections, though the question of validity of the patent was not decided, on the ground that such particulars were necessary for the purpose of defining the ambit of the plaintiff's claim.(*s*) So also a certificate has been given with reference to the plaintiff's particulars of breaches, though the defendant did not appear at the trial.(*t*)

Action in respect of several patents.

When the action is brought in respect of the infringement of several patents, and succeeds as to some but fails as to others,

(*o*) Longbottom *v.* Shaw, (1888) 5 R. P. C. 497, 502.

(*p*) Longbottom *v.* Shaw, (1889) 6 R. P. C. 510; Garrard *v.* Edge, (1889) 6 R. P. C. 372, 563; (1890) 7 R. P. C. 139; but see Sunlight Incandescent Gas Lamp Co. *v.* Incandescent Gas Light Co., (1897) 14 R. P. C. 776.

(*q*) (1889) 6 R. P. C. 513.

(*r*) Heyes *v.* Hallmark, (1891) 9 R. P. C. 25; Lees *v.* West London Cycle Stores, (1892) 9 R. P. C. 300; Singer *v.* Rudge Cycle Co., (1894) 11 R. P. C. 463, 585.

(*s*) Jardine *v.* King, Mendham and Co., (1896) 13 R. P. C. 428.

(*t*) Pneumatic Tyre Co. *v.* Chisholm, (1896) 13 R. P. C. 488.

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the Court will certify as to the particulars on which either party has succeeded, but will refuse to certify as to the particulars on which he failed.(*u*)

Effect of certificate of validity given in a prior action.

It is provided by s. 31 of the Act of 1883 that "in an action for infringement of a patent the Court or a Judge may certify that the validity of the patent came in question; and if the Court or a Judge so certifies, then, in any subsequent action for infringement, the plaintiff in that action, in 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."(*x*)

When certificate of validity may be given.

The certificate may be given notwithstanding the fact that the patent has expired at the date of the judgment.(*y*)

Threats action.

As we have seen,(*z*) the validity of the patent may be called in question in an action brought to restrain the continuance of threats of proceedings in respect of infringements, but it is doubtful whether a certificate can be given in such an action under the above power.(*a*)

Petition for revocation.

Under the Act of 1852, which authorised the Court to certify that the validity of the patent had been questioned, and provided that in a subsequent (*b*) suit or action touching such patent a plaintiff armed with the certificate of the Court given in a previous action might recover treble costs, if he was successful, it was enacted that such certificate might be given in evidence in any proceeding by *scire facias* to repeal the patent.(*c*) It is to be observed, however, that there is no corresponding provision made by the Act of 1883 or any subsequent Act with regard to the certificate in reference to a petition for revocation of the patent, which is the modern substitute for the proceeding by *scire facias*.(*d*)

Power of Court of Appeal and House of Lords and Court of the County Palatine of Lancaster to grant a certificate of validity.

It is submitted that the Court of Appeal, if it reverses a decision of the Court below against the patent, has power to grant a certificate that the validity has come in question, though it is not a "Court" within the meaning of the section. It is the duty of the Court of Appeal to make such order as the Judge who heard the case ought to have made, and, in the event of the Court of Appeal reversing the decision below

(*u*) Brooks *v.* Lamplugh, (1897) 15 R. P. C. 33.

(*x*) 46 & 47 Vict. c. 57, s. 31. For forms of Certificate see Seton, 4th ed. p. 1661; Pemberton, 4th ed. p. 482.

(*y*) Sunlight Incandescent Gas Lamp Co. *v.* Incandescent Gas Light Co., (1897) 14 R. P. C. 776.

(*z*) p. 453 *ante*. (*a*) p. 458 *ante*.

(*b*) Bovill *v.* Hadley, (1864) 17 C. B. N. S. 435.

(*c*) 15 & 16 Vict. c. 83, s. 43.

(*d*) p. 389 *ante*.

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on the question of validity, it is presumed that a certificate would be granted, on the ground that the finding should have been the other way.(*e*) The House of Lords also for the same reason has a similar jurisdiction.(*f*)

Should the Court of Appeal or House of Lords not grant the certificate, application for one may be made to the Judge of the Court below who tried the case,(*g*) and in one instance the Court of Appeal granted no certificate, but gave the appellant leave to apply to the Judge below.(*h*)

The Court of the County Palatine of Lancaster is not a Court within the meaning of the Act of 1883,(*i*) but it is submitted that the Chancery of Lancaster Act, 1890,(*k*) gives power to the Vice-Chancellor, or the Court of Appeal on appeal from his judgment, to grant a certificate entitling the plaintiff to solicitor and client's costs if successful in a subsequent action.

Omission to ask for certificate of validity at the trial.

If a certificate that the validity of the patent was called in question is not asked for at the trial, it may probably be obtained by subsequent summons in chambers,(*l*) or on motion in Court.(*m*)

If a certificate be granted there is no appeal, as it is not a judgment or order against which an appeal lies.(*n*)

It seems that the grant of a certificate is discretionary in the Court or Judge.(*o*)

But in a case in which the result of the judgment was that the patent was invalid as regarded one claim, but that if the specification could be amended by omitting that claim the patent would be valid as to the remainder, *Stephen*, J., granted a certificate that the validity had come in question, but made no reference to the finding on the point, and his Lordship stated that he could not refuse to certify the fact of the validity having been questioned.(*p*)

Certificate when no evidence on issue of validity is offered.

It was held under the Act of 1835 that no certificate ought to be given when no evidence on the question of validity was

(*e*) R. S. C. (1883) Ord. lviii. r. 4; Cole *v.* Saqui, (1889) 6 R. P. C. 45; Humpherson *v.* Syer, (1887) 4 R. P. C. 416.

(*f*) Morris *v.* Young, 465.

(*g*) Cropper *v.* Smith, 2 R. P. C. 61.

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

(*i*) Proctor *v.* Sutton Lodge Chemical Co., (1888) 5 R. P. C. 184.

(*k*) 53 & 54 Vict. c. 23, s. 3.

(*l*) Judic. Act, (1873) s. 39; R. S. C. (1883), Orders liv. and lv.

(*m*) Rowcliffe *v.* Morris, (1886) 3 R. P. C. 145.

(*n*) Haslam *v.* Hall, (1888) L. R. 20 Q. B. D. 491; (1888) 5 R. P. C. 144; Cropper *v.* Smith, (1885) 2 R. P. C. 63.

(*o*) 46 & 47 Vict. c. 57, s. 31.

(*p*) Haslam *v.* Hall, (1888) 5 R. P. C. 28; Automatic Weighing Machine Co. *v.* Knight, (1889) 6 R. P. C. 113, 120; Badische Anilin und Soda Fabrik *v.* La Société des Usines du Rhône, (1897) 14 R. P. C. 892.

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offered, and judgment was entered for the plaintiff by consent;(*q*) but where the defendant offered evidence against the novelty of the invention, which failed, and was prevented from offering further evidence affecting the validity of the patent on other grounds, it was held that a certificate ought to be given.(*r*)

And under the Act of 1883, where a defendant by his pleadings denied the validity of the patent, but did not appear at the trial, *Kay*, J., holding that s. 31 of the Act of 1883 only applied when the patent is established in a case contested in Court, refused to grant a certificate; but (*s*) *Kekewich*, J., under similar circumstances, in the absence of authority to the contrary, granted the certificate,(*t*) and pointed out that if a defendant, by non-appearance at the trial, could deprive a successful plaintiff of the right to a certificate as to the validity of the patent, the plaintiff might be put to the trouble of proving it all over again. And *Day*, J., in a more recent case, followed the course adopted by *Kekewich*, J.(*u*) Also, where a case was settled by a compromise between the parties, *Collins*, J., granted the certificate on the ground that the validity had undoubtedly been brought in question, though the parties had arrranged between themselves how it was to be decided.(*x*)

Certificate of validity may be given though plaintiff fails on the issue of infringement.

It is not necessary that the plaintiff should be completely successful in the action to obtain a certificate of validity. The certificate has been given in many cases where the plaintiff, though successful on the issue of validity, has failed on that of infringement.(*y*)

Certificate where defendant admits validity on a certain construction of the specification.

There does not appear to be any case in which a certificate of validity has been given where the defendant has admitted the validity of the patent upon a certain specific construction of the specification found by the Court to be the true construction and to exclude the alleged infringement from the claim; and in such a case it is submitted that no certificate would be given.(*z*) If, however, the defendant should, besides admitting validity, subject to a proviso as to construction, alternatively

(*q*) Stocker *v.* Rodgers, (1843) 1 Car. & K. 99.

(*r*) Gillett *v.* Wilby, (1839) 1 W. P. C. 270.

(*s*) Peroni *v.* Hudson, (1884) 1 R. P. C. 261, 263; Stocker *v.* Rodgers, (1843) 1 Car. & K. 99.

(*t*) Haydock *v.* Bradbury, (1887) 4 R. P. C. 74.

(*u*) Edison-Bell Phonograph Corporation *v.* Edison Phonograph Co., (1893) 11 R. P. C. 33.

(*x*) Delta Metal Co. *v.* Maxim-Nordenfelt Guns and Ammunition Co., (1891) 8 R. P. C. 247.

(*y*) Tweedale *v.* Ashworth, (1890) 7 R. P. C. 426; 8 R. P. C. 49; 9 R. P. C. 121; Sunlight Incandescent Gas Lamp Co. *v.* Incandescent Gas Light Co., (1897) 14 R. P. C. 776.

(*z*) Morris *v.* Young, (1895) 12 R. P. C. 464, 465.

plead invalidity upon another construction, and succeed with reference to the special construction without arguing his case upon the other construction, it is submitted the Court might grant the certificate, though the case of validity was not contested in Court.(*a*) Costs.

Where a certificate of validity has been granted in a previous action, it will not usually be granted again at the conclusion of a subsequent action.(*b*) And if it is desired to claim solicitor and client's costs, the certificate ought, strictly speaking, to be pleaded in the subsequent action, though they may be given if the writ and statement of claim ask for them. (*c*)

An action commenced but not determined at the time a certificate in another action is obtained is not a subsequent action for infringement within the meaning of s. 31 of the Act of 1883, and the plaintiff cannot claim solicitor and client's costs on the production of the certificate and record of the first determined action.(*d*) Meaning of "subsequent action."

Under the Act 1852 the order on a motion for a new trial of an action subsequent to one in which a certificate of validity had been obtained was held not to be a "decree, decretal order or final judgment," and the plaintiff was not entitled to full costs.(*e*) It is submitted that such an order, or an order on motion to commit for breach of an injunction, would not be a "final order or judgment" within s. 31 of the Act of 1883, and, therefore, under the present practice the plaintiff could not on the strength of a certificate of validity claim solicitor and client's costs, if successful in resisting a motion for a new trial, or obtaining an order for committal for breach of an injunction.(*f*)

It is to be noticed that the Act of 1883 provides that a plaintiff possessed of a certificate that the validity of his patent has been questioned is, in a subsequent action on obtaining a final order or judgment, to have his costs as between solicitor and client, *unless the Court or a Judge trying the action certifies* Solicitor and client costs are not always given though a certificate of validity has been obtained in a prior action.

(*a*) Haydock *v.* Bradbury, (1887) 4 R. P. C. 74; Edison-Bell Phonograph Corporation *v.* Edison Phonograph Co. (1893) 11 R. P. C. 33; Delta Metal Co. *v.* Maxim-Nordenfelt Guns and Ammunition Co., (1891) 8 R. P. C. 247; Morris *v.* Young, (1895) 12 R. P. C. 465.

(*b*) Edison *v.* Holland, (1888) 6 R. P. C. 285.

(*c*) Pneumatic Tyre Co. *v.* Chisholm, (1896) 13 R. P. C. 488.

(*d*) Automatic Weighing Machine Co. *v.* Combined Weighing Machine Co., (1889) 6 R. P. C. 120; Automatic Weighing Machine Co. *v.* International Hygienic Society, (1889) 6 R. P. C. 480; Penn *v.* Bibby, (1866) L. R. 3 Eq. 308; Bovill *v.* Hadley, (1864) 17 C. B. N. S. 435.

(*e*) Bovill *v.* Goodier, (1866) Griff. L. O. C. 49.

(*f*) Spencer *v.* The Ancoats Vale Rubber Co., (1889) 6 R. P. C. 46, 48.

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that he ought not to have the same. Therefore, it is left to the discretion of the Court to deprive a successful plaintiff in a subsequent action of his full costs, if it is of opinion that he ought not to have them. The object of the enactment was to prevent patentees being put under the necessity of bringing repeated actions to determine their rights after the patent has been once established. There are many circumstances under which it might be improper that a plaintiff succeeding in a subsequent action should have solicitor and client costs, notably if it is proved that the first action was collusive(*g*) or vexatious,(*h*) or the defendant is otherwise able to discharge the burden which is on him of showing cause why he should not pay solicitor and client costs.(*i*)

The intention seems to be to protect patentees from being harassed by having to support their patents again after they have been contested and declared valid, and not to affect the question of the costs of the issue of infringement where the evidence before the Court is totally distinct from that which was presented in the former action, or there are other substantially new questions to be decided with reference to the patent or the specification.

For instance, where a certificate as to validity had been obtained, *Pearson*, J., in a subsequent action, refused to give full solicitor and client costs on the ground that the patent was attacked on grounds which were not raised in the prior proceedings, but he granted the plaintiff a fresh certificate of validity, specifying to what extent the patent had been questioned.(*k*) But *Romer*, J., gave solicitor and client costs where in the subsequent action the patent was unsuccessfully contested on a point of ambiguity of specification which was not raised on the former occasion.(*l*)

In a case under the Act of 1852, where the validity of the patent was subsequently contested on different grounds, Lord *Hatherley*, then Vice-Chancellor *Page Wood*, refused to give solicitor and client costs, on the ground that the former action was not conclusive as to the validity of the patent, for, after the plaintiff had obtained the judgment of the House of Lords in his favour, the Court of Queen's Bench directed a new trial,

(*g*) Davenport *v.* Rylands, (1865) L. R. 1 Eq. 309.

(*h*) Proctor *v.* Sutton Lodge Chemical Works, (1888) 5 R. P. C. 184.

(*i*) United Telephone Co. *v.* Patterson, (1889) 6 R. P. C. 142; United Telephone Co. *v.* St. George, (1886) 3 R. P. C. 339.

(*k*) Otto *v.* Steel, (1886) 3 R. P. C. 109, 120.

(*l*) Automatic Weighing Machine Co. *v.* Fearby, (1893) 10 R. P. C. 447.

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which, however, did not take place, in consequence of a compromise between the parties.(*m*)

Solicitor and client costs when defendant does not dispute validity.

The fact that a defendant does not deny the validity of the patent, but only disputes the question of infringement, will not necessarily induce the Court to deprive the plaintiff of full solicitor and client costs if he hold a certificate of validity;(*n*) but, on the other hand, though the plaintiff hold a certificate that the validity of his patent was questioned in a prior action he will not be awarded full solicitor and client costs in a subsequent action where the only question raised is one of infringement, and the necessity for the subsequent action arises is, in the opinion of the Court, from the lax manner in which the patentee's specification was drawn.(*o*)

Party and party costs.

It is of great importance to litigants who are unsuccessful that they should not be oppressed by having to pay an excessive amount of costs; and it is a rule that the costs chargeable under a taxation, as between party and party, are only those necessary to enable the adverse party to conduct the litigation; any charges merely for conducting litigation more conveniently may be called luxuries, and must be paid by the party incurring them.(*p*)

Scientific evidence and experts' fees.

When scientific evidence is necessary, proper fees to experts will be allowed;(*q*) but only the fees of experts which relate to qualifying to give evidence in the particular case and to attendance in Court for the purpose of giving evidence should be allowed. Fees which relate to experiments performed to educate an expert apart from the special case should be disallowed.(*r*)

Drawings and medals.

An allowance may also be made in respect of the preparation of drawings or models when they are required;(*s*) but the Court will not order such drawings and models to be given up to the party ordered to pay the costs of them.(*t*) If the drawings and models are not really necessary, no allowance

(*m*) Betts *v.* De Vitre, (1864) 11 Jur. N. S. 11.

(*n*) The United Telephone Co. *v.* Pattinson, (1889) 6 R. P. C. 140; Davenport *v.* Rylands, (1865) L. R. 1 Eq. 302, 308; Pneumatic Tyre Co. *v.* West London Rubber and Tyre Co., (1898) 15 R. P. C. 129.

(*o*) Automatic Weighing Machine Co. *v.* International Hygienic Society, (1889) 6 R. P. C. 480; Automatic Weighing Machine Co. *v.* National Exhibitions Association, (1891) 8 R. P. C. 352.

(*p*) Smith *v.* Buller, (1874) L. R. 19 Eq. 475.

(*q*) Smith *v.* Buller, (1874) L. R. 19 Eq. 473; Batley *v.* Kynock, (1875) L. R. 20 Eq. 632; Musgrave *v.* Hicks, (1886) 3 R. P. C. 49.

(*r*) Leonardt *v.* Kallé, (1895) 12 R. P. C. 306.

(*s*) Batley *v.* Kynock, (1875) L. R. 20 Eq. 632; Musgrave *v.* Hicks (1886) 3 R. P. C. 49; Horrocks *v.* Stubbs, (1886) 3 R. P. C. 221.

(*t*) Horrocks *v.* Stubbs, (1886) 3 R. P. C. 241.

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will be made in respect of them on taxation—*e.g.*, where drawings were only used for the purpose of being affixed to the margin of copies of evidence supplied to counsel, the costs of their preparation were disallowed, although the opposite party had asked for and been supplied with copies of them.(*w*)

Three Counsel.

The costs of three counsel may sometimes be allowed,(*x*) but this should only be done when the case is one of multifarious issues, and matters on which different minds might be properly employed, as it were dividing the labour among counsel; they should not be allowed in cases, though of great difficulty, where it is necessary for each counsel to get up the whole case.(*y*)

Shorthand notes.

A Judge has no power in the absence of arrangement to order shorthand notes of the evidence to be taken.(*z*) Where shorthand notes are taken it is the usual and proper course for the parties to agree beforehand that the costs of them shall be costs in the cause, or to make some other mutual arrangement as to them. When this is not done the Court will sometimes give the costs of the shorthand notes as part of the costs in the action, and the necessary application should be made at the trial.(*a*) But such an order is only made in exceptional cases.(*b*)

The costs of a shorthand note of a judgment appealed from will generally be allowed by the Court of Appeal.(*c*)

Inquiry as to damages.

Where a plaintiff succeeds in obtaining an inquiry as to damages or an account of profits, and also obtains the general costs of the action, the Court, as a rule, will not give the costs of the inquiry as well as general costs of the action, but will reserve them, in order that the Judge before whom the inquiry is directed may have full control over the costs, and see that they are not unreasonably exaggerated.(*d*)

(*w*) Smith *v.* Buller, (1875) L. R. 19 Eq. 473.

(*x*) Monnet *v.* Beck, (1897) 14 R. P. C. 850; Pneumatic Tyre Co. *v.* Ixion Patent Pneumatic Tyre Co., (1897) 14 R. P. C. 875; Badische Anilin und Soda Fabrik *v.* La Société Chimique des Usines du Rhône, (1897) 14 R. P. C. 892.

(*y*) Leonardt *v.* Kallé, (1895) 12 R. P. C. 306.

(*z*) Hilleary *v.* Taylor, (1887) L. R. 36 Ch. D. 262; Nobel's Explosives Co. *v.* Anderson, (1894) 11 R. P. C. 129.

(*a*) Earl De La Warr *v.* Miles, (1881) L. R. 19 Ch. D. 80; Bowen *v.* Centaur Cycle Co., (1891) 8 R. P. C. 113; Incandescent Gas Light Co. *v.* De Mare Incandescent Gas Light System, (1896) 13 R. P. C. 333; Incandescent Gas Light Co. *v.* Sunlight Gas Lamp Co., (1896) 13 R. P. C. 346; Monnet *v.* Beck, (1897) 14 R. P. C. 850; Pneumatic Tyre Co. *v.* Ixion Patent Pneumatic Tyre Co., (1897) 14 R. P. C. 875.

(*b*) *Ibid.*; Kelly *v.* Bayles, 18 L. R. 13 Ch. D. 693.

(*c*) Collyer *v.* Isaacs, (1882) 45 L. T. N. S. 567; 30 W. R. 71; London and South-Western Ry. Co. *v.* Groom, (1881) L. R. 20 Ch. D. 589; Woodward *v.* Sansom, (1887) 4 R. P. C. 178.

(*d*) Stark *v.* Midland Ry. Co., (1881) L. R. 16 Ch. D. 81; United Telephone Co. *v.* Fleming (2), (1886) 3 R. P. C. 282; Moss *v.* Malings, (1886) 3 R. P. C. 379; United Telephone Co. *v.* Faulkner, (1886) 3 R. P. C. 282 *n*; Cole *v.* Saqui, (1888) 5 R. P. C. 497; Needham *v.* Oxley, Seton 4th ed. p. 353.

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But where an undertaking and inquiry as to damages is directed on a successful application for an interim injunction, the usual order provides for the costs,(*e*) and they are not generally reserved.(*f*)

It is the duty of the officer of the Court before whom an inquiry as to damages or an account of profits is heard to take notes of the evidence, and if shorthand notes are taken no costs of them will in the absence of agreement between the parties be allowed.(*g*)

Costs on the higher scale.

It is provided (*h*) that costs on the higher scale may be allowed either generally in any cause or matter, or as to the costs of any particular application made or business done, in any cause or matter, if on special grounds arising out of the nature and importance or the difficulty or urgency of the case, the Court or a Judge shall, at the trial or hearing, or further consideration of the cause or matter, or at the hearing of any application therein, whether the cause or matter shall or shall not be brought to trial or hearing, or to further consideration (as the case may be), so order; or if the taxing officer, under directions given him for that purpose by the Court or a Judge, shall think that such allowance ought to be so made upon such special grounds as aforesaid.

Costs on the higher scale may be given by the Court of Appeal, although refused by the Court below; but the Court of Appeal does not usually allow them, there being no special reason for doing so.(*i*)

Where an action was of a complicated nature, the Court, considering that special industry and learning and much time and expense had been employed in preparing it for trial, directed the taxing-master to allow all or any part of the plaintiff's costs on the higher scale if he thought fit; (*k*) and costs on the higher scale have been allowed in many patent cases, on the ground that the case of the successful party being of exceptional difficulty has involved a protracted examination of witnesses, the calling of expert evidence, or the preparation of drawings and models,(*l*) whether the patent has been previously supported or

(*e*) Burdett *v.* Hay, (1863) 4 De G. J. & S. 41; Seton, 4th ed. p. 172.

(*f*) Rothwell *v.* King (2), 4 P. O. B. 76.

(*g*) Unguan *v.* Sugg, (1892) 9 R. P. C. 113.

(*h*) S. C. R. (1883) Ord. lxv. r. 9.

(*i*) Automatic Weighing Machine Co. *v.* Knight, (1889) 6 R. P. C. 310.

(*k*) Fraser *v.* Province of Brescia Steam Tramways Co., (1887) 56 L. T. N. S. 771; 3 Times R. 587.

(*l*) Westinghouse *v.* L. & Y. Ry. Co., (1884) 1 R. P. C. 103; Easterbrook, F. G. W. Ry. Co., (1885) 2 R. P. C. 212; Watling *v.* Stevens, (1886) 3 R. P. C. 43; Otto *v.* Steel, (1886) 3 R. P. C. 120; Wenham *v.* May, (1887) 4 R. P. C. 310; Kaye *v.* Chubb, (1887) 4 R. P. C. 289; Ellington *v.* Clark,

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not; though costs on the higher scale have been refused where complications of the case were due to the unfortunate wording of both an original and an amended specification,(*m*) and in many other cases.

Where costs on the higher scale have been asked for, on the ground that the defendant submitted to an injunction,(*n*) or that important questions were raised,(*o*) or that the defendant did not appear at the trial,(*p*) they have been refused; and it would appear that the fact that the damages claimed amount to a large sum is not sufficient reason for directing the costs to be taxed on the higher scale.(*q*)

Where an application is made at the trial for costs on the higher scale which is refused, the question may be reserved till after the taxation, and liberty given to apply, so that the successful party may have an opportunity of showing that he has suffered an injustice, if such be the fact, by the taxation having been made on the lower scale.(*r*)

Stay Pending Appeal.

Stay is not usual.

If the party who has been unsuccessful in a patent action intends to enter notice of appeal he may sometimes succeed in obtaining an order from the Court staying the proceedings on the judgment till the hearing and determination of the appeal,(*s*) though a stay is by no means the general rule.(*t*)

Application for a stay.

The application must in the first instance be made to the Court below and not to the Court of Appeal; (*u*) but if the

(1888) 5 R. P. C. 528; Edison *v.* Holland, (1888) 5 R. P. C. 459; Blakey *v.* Lathom, (1889) 6 R. P. C. 29; Automatic Weighing Machine Co. *v.* International Hygienic Society, (1889) 6 R. P. C. 475; Tweedale *v.* Ashworth, (1890) 7 R. P. C. 426; Farbenfabriken vorm F. Bayer and Co., (1891) 8 R. P. C. 389; Hopkinson *v.* St. James' and Pall Mall Electric Light Co., (1892) 10 R. P. C. 46; Edison-Bell Phonograph Co. *v.* Smith, (1894) 11 R. P. C. 161; Hookham *v.* Johnson, (1897) 14 R. P. C. 525; but see Leonardt *v.* Kallé, (1895) 12 R. P. C. 120.

(*m*) Wenham Gas Co. *v.* Champion Gas Lamp Co., (1890) 7 R. P. C. 313.

(*n*) Hudson *v.* Osgerby, (1884) 32 W. R. 566.

(*o*) Grafton *v.* Watson, (1884) 51 L. T. N. S. 141; Cardiff Steamship Co. *v.* Barwick, (1885) 53 L. T. N. S. 56.

(*p*) Peroni *v.* Hudson, (1884) 1 R. P. C. 261.

(*q*) Spettigue's Trusts, (1884) 32 W. R. 385; The Horace, (1884) L. R. 9 P. D. 86.

(*r*) Crampton *v.* The Patents Investment Co., (1888) 5 R. P. C. 282, 404.

(*s*) Adair *v.* Young, (1879) L. R. 11 Ch. D. 136; Woodward *v.* Sansom, (1886) 3 R. P. C. 366; Humpherson *v.* Syer, (1887) 4 R. P. C. 189; Proctor *v.* Bennis, (1887) 4 R. P. C. 363; Otto *v.* Steel, (1886) 3 R. P. C. 121.

(*t*) Edge *v.* Johnson, (1892) 9 R. P. C. 142; Lancashire Explosives Co. *v.* Roburite Explosives Co., (1895) 12 R. P. C. 483.

(*u*) Otto *v.* Lindford, (1880) L. R. 18 Ch. D. 394; Cropper *v.* Smith, (1883) L. R. 24 Ch. D. 305.

Court of First Instance refuse to make an order staying proceedings, an application may be made to the Court of Appeal, and an application of this nature is not properly an appeal motion, and need not be brought within twenty-one days after the refusal of the Court below.(*x*)

Stay Pending Appeal.

Sometimes, pending an appeal, the Court in its discretion will grant a stay of an injunction on the undertaking of the defendant to keep an account,(*y*) and where there is a special reason (*z*) the Court, in view of an appeal, orders the taxation of costs, and, if the appeal is not heard before the completion of the taxation, the money to be paid over on the personal undertaking of the solicitor to return it in the event of the appeal succeeding; (*a*) but though this is frequently done it is not the usual order.(*b*) Neither is it usual to stay an inquiry as to damages or the taking of an account pending an appeal,(*c*) though frequently a stay is granted in respect of an order for the delivery up or destruction of the defendant's goods.(*d*)

Circumstances which induce the Court to grant a stay.

Usually the costs of an application for an order to stay proceedings have to be borne by the party making it in any event; (*e*) but sometimes they are made costs in the appeal.(*f*) Where the plaintiffs obtained a judgment granting a perpetual injunction restraining infringement and an account of profits, and the defendant entered an appeal, and moved for an order staying proceedings under the order for an account, the Court thought that, under the circumstances, the proper course was to advance the appeal, but as the plaintiff thereby obtained a benefit the costs of the application should be costs in the appeal.(*g*)

Costs of application for a stay.

(*x*) Cropper *v.* Smith, (1883) L. R. 24 Ch. D. 305.

(*y*) Hocking *v.* Fraser, (1886) 3 R. P. C. 7; North British Rubber Co. *v.* Gormully, Jeffery and Co., (1896) 13 R. P. C. 691; 14 R. P. C. 283.

(*z*) Pneumatic Tyre Co. *v.* East London Rubber Co., (1897) 14 R. P. C. 590.

(*a*) Ticket Punch Register Co. *v.* Colley's Patents, (1895) 12 R. P. C. 10.

(*b*) Per Lindley, L.J., Badische Anilin und Soda Fabrik *v.* Johnson, (1897) 14 R. P. C. 418.

(*c*) Chadburn *v.* Mechan, (1895) 12 R. P. C. 135.

(*d*) English and American Machinery Co. *v.* Union Boot and Shoe Machine Co., (1894) 11 R. P. C. 142; Howes *v.* Webber, (1895) 12 R. P. C. 470.

(*e*) Cooper *v.* Cooper, (1875) L. R. 2 Ch. D. 493; Merry *v.* Nickalls, (1873) L. R. 8 Ch. App. Cas. 205.

(*f*) Adair *v.* Young, (1879) 11 Ch. D. 6.

(*g*) Adair *v.* Young, (1879) L. R. 11 Ch. D. 136.

APPENDIX.

APPENDIX.

STATUTE OF MONOPOLIES (1623).

[21 JAC. I. c. 3.]

An Act concerning Monopolies and Dispensations of Penal Laws and the forfeitures thereof.

FORASMUCH as your most excellent Majesty, in your royal judgment, and of your blessed disposition to the weal and quiet of your subjects, did, in the year of our Lord God one thousand six hundred and ten, publish in print to the whole realm, and to all posterity, that all grants of monopolies, and of the benefit of any penal laws, or of power to dispense with the law, or to compound for the forfeiture, are contrary to your Majesty's laws, which your Majesty's declaration is truly consonant and agreeable to the ancient and fundamental laws of this your realm: and whereas your Majesty was further graciously pleased expressly to command that no suitor should presume to move your Majesty for matters of that nature; yet nevertheless upon misinformations and untrue pretences of public good, many such grants have been unduly obtained, and unlawfully put in execution, to the great grievance and inconvenience of your Majesty's subjects, contrary to the laws of this your realm, and contrary to your Majesty's most royal and blessed intention, so published as aforesaid: For avoiding whereof, and preventing of 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, licences, charters, and letters patents 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,

All monopolies, &c., shall be void.

to dispense with any others, or to give licence or toleration to do, use, or exercise anything against the tenor or purport of any law or statute; or to give or make any warrant for any such dispensation, licence, or toleration to be had or made; or to agree or compound with any others for any penalty or forfeitures limited by any statute; or of any grant or promise of the benefit, profit, or commodity of any forfeiture, penalty, or 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 no wise to be put in use 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, licences, charters, letters patents, 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, licence, charter, letters patents, 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 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, licence, power, liberty, faculty, letters patents, proclamation, inhibition, restraint, warrant of assistance, or other matter or thing tending as aforesaid, and will sue to be relieved in or for any of the premises, that then and in every such case, the same person and persons shall and may have his and their remedy for the same at the common law, by any action or actions to be grounded upon this statute; the same action and actions to be heard and determined in the Courts of King's Bench, Common Pleas, and Exchequer, or in

any of them, against him or them by whom he or they shall be so hindered, grieved, disturbed or disquieted, or against him or them by whom his or their goods or chattels shall be so seized, attached, distrained, taken, carried away, or detained; wherein all and every such person and persons which shall be so hindered, grieved, disturbed, or disquieted, or whose goods or chattels shall be so seized, attached, distrained, taken, carried away, or detained, shall recover three times so much as the damages which he or they sustained by means or occasion of being so hindered, grieved, disturbed, or disquieted, or by means of having his or their goods or chattels seized, attached, distrained, taken, carried away, or detained, and double costs; and in such suits, or for the staying or delaying thereof, no essoin, protection, wager of law, aidprayer, privilege, injunction, or order of restraint, shall be in any wise prayed, granted, admitted, or allowed, nor any more than one imparlance: And if any person or persons shall, after notice given that the action depending is grounded upon this statute, cause or procure any action at the common law, grounded upon this statute, to be stayed or delayed before judgment, by colour or means of any order, warrant, power, or authority, save only of the Court wherein such action as aforesaid shall be brought and depending, or after judgment had upon such action, shall cause or procure the execution of or upon any such judgment to be stayed or delayed by colour or means of any order, warrant, power, 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.

He that delayeth an action grounded upon this statute incurs a *præmunire*.

16 Rich. II. c. 5.

5. Provided nevertheless, and be it declared and enacted, that any declaration before mentioned shall not extend to any letters patents and grants of privilege for the term of one and twenty years or under heretofore made, of the sole working or making of any manner of new manufacture within this realm, to the first and true inventor or inventors of such manufactures, which others at the time of the making of such letters patents and grants did not use, so they be not contrary to the law, nor mischievous to the State, by raising of the prices of commodities at home, or hurt of trade, or generally inconvenient, but that the same shall be of such force as they were or should be, if this Act had not been made, and of none other: and if the same were made for more than one and twenty years, that then the same for the term of one and twenty years only, to be accounted from the date of the first letters patents and grants thereof made, shall be of such force as they were or should have been

Letters patent to use new manufactures saved. *Repealed by Stat. Law Rev. Act*, 1863.

if the same had been made, but for term of one and twenty years only, and as if this Act had never been had or made, and of none other.

Exception of future letters patent.

6. Provided also, and be it declared and enacted, That any declaration before mentioned shall not extend to any letters patents and grants of privilege for the term of fourteen years or under hereafter to be made of the sole working or making of any manner of new manufactures within this realm, to the true and first inventor and inventors of such manufactures, which others at the time of making such letters patents and grants shall not use, so as also they be not contrary to the law, 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 accounted from the date of the first letters patent, or grant of such privilege hereafter to be made, but that the same shall be of such force as they should be if this Act had never been made, and of none other.

Grants confirmed by Act of Parliament saved.

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, or confirmed by any Act of Parliament now in force, so long as the same shall so 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, to compound for the forfeitures of any penal statute, depending in suit and question before them or any of them respectively, after plea pleaded by the party defendant.

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 patents, to them or any of them made or granted, or for or concerning any custom or customs used by or within them or any of them: or unto any 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 effects 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.(*a*)

(*a*) The remaining sections of this Act have been repealed by either the Statute Law Revision Act (1863), or the Patents, Designs, and Trade Marks Act (1883), and are, therefore, not printed here.

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. [25*th August* 1883.]

[N.B.—The portions of this Act which have been amended or repealed by subsequent Acts are printed in italics, and a reference is given to the amending or repealing Act in each case.]

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.

Division of Act into parts.

2. This Act is divided into parts, as follows:

Part I.—PRELIMINARY.
Part II.—PATENTS.
Part III.—DESIGNS.
Part IV.—TRADE MARKS.
Part V.—GENERAL.

Commencement of Act.

3. This Act, except where it is otherwise expressed, shall commence from and immediately after the thirty-first day of December one thousand eight hundred and eighty-three.

PART II.

PATENTS.

Application for and Grant of Patent.

Persons entitled to apply for patent.

4. (1) Any person, whether a British subject or not, may make an application for a patent.

(2) Two or more persons may make a joint application for a patent, and a patent may be granted to them jointly.(*a*)

Application and specification.

5. (1) An application for a patent must be made in the form set forth in the First Schedule to this Act, or in such other form as may be from time to time prescribed; and must be left at, or sent by post to, the Patent Office in the prescribed manner.

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

(3) A provisional specification must describe the nature of the invention, and be accompanied by drawings, if required.

(4) A complete specification, whether left on application or subsequently, must particularly describe and ascertain the nature of the invention, and in what manner it is to be performed, and must be accompanied by drawings, if required.(*c*)

(5) A specification, whether provisional or complete, must commence with the title, and in the case of a complete specification must end with a distinct statement of the invention claimed.

Reference of application to examiner.

6. The Comptroller shall refer every application to an examiner, who shall ascertain and report to the Comptroller whether the nature of the invention has been fairly described, and the application, specification, and drawings, (if any) have been prepared in the prescribed manner, and the title sufficiently indicates the subject-matter of the invention.

Power for Comptroller to refuse application or require amendment.

7. (1) *If the examiner reports that the nature of the invention is not fairly described, or that the application, specification, or drawings has not or have not been prepared in the prescribed manner, or that the title does not sufficiently indicate the subject-matter of the invention, the Comptroller may require that the application, specification, or drawings be amended before he proceeds with the application.*

(*a*) 48 & 49 Vict. c. 63, s. 5, p. 681 *post.*
(*b*) 48 & 49 Vict. c. 63, s. 2, p. 680 *post.*
(*c*) 49 & 50 Vict. c. 37, s. 2, p. 682 *post.*

(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.*(*d*)

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.(*e*)

(2) Unless a complete specification is left within that time the application shall be deemed to be abandoned.

Comparison of provisional and complete specification.

9. (1) Where a complete specification is left after a provisional specification, the Comptroller shall refer both specifications to an examiner for the purpose of ascertaining whether the complete specification has been prepared in the prescribed manner, and whether the invention particularly described in the complete specification is substantially the same as that which is described in the provisional specification.

(2) If the examiner reports that the conditions hereinbefore contained have not been complied with, the Comptroller may refuse to accept the complete specification unless and until the same shall have been amended to his satisfaction; but any such refusal shall be subject to appeal to the law officer.

(3) The law officer shall, if required, hear the applicant and the Comptroller, and may make an order determining whether and subject to what conditions, if any, the complete specification shall be accepted.

(4) Unless a complete specification is accepted within twelve months from the date of application, then (save in the case of

(*d*) 51 & 52 Vict. c. 50, s. 2, p. 684 *post*.
(*e*) 48 & 49 Vict. c. 62, s. 3, p. 682 *post*.

an appeal having been lodged against the refusal to accept) the application shall, at the expiration of those twelve months, become void.(*f*)

(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*, (*g*) 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.

Advertisement on acceptance of complete specification.

10. On acceptance of the complete specification the Comptroller shall advertise the acceptance; and the application and specification or specifications, with the drawings (if any), shall be open to public inspection.

Opposition to grant of patent.

11. (1) Any person may at any time within two months from the date of the advertisement of the acceptance of a complete specification give notice at the Patent Office of opposition to the grant of the patent on the ground of the applicant having obtained the invention from him, or from a person of whom he is the legal representative, or on the ground that the invention has been patented in this country on an application of prior date, *or on the ground of an examiner having reported to the Comptroller that the specification appears to him to comprise the same invention as is comprised in a specification bearing the same or a similar title, and accompanying a previous application, but on no other ground.*(*h*)

(2) Where such notice is given the Comptroller shall give notice of the opposition to the applicant, and shall, on the expiration of those two months, after hearing the applicant and the person so giving notice, if desirous of being heard, decide on the case, but subject to appeal to the law officer.

(3) The law officer shall, if required, hear the applicant and any person so giving notice, and being, in the opinion of the law officer, entitled to be heard in opposition to the grant, and shall determine whether the grant ought or ought not to be made.

(4) The law officer may, if he thinks fit, obtain the assistance of an expert, who shall be paid such remuneration as the law officer, with the consent of the Treasury, shall appoint.

Sealing of patent.

12. (1) If there is no opposition, or, in case of opposition, if the determination is in favour of the grant of a patent, the Comptroller shall cause a patent to be sealed with the seal of the Patent Office.

(2) A patent so sealed shall have the same effect as if it were sealed with the Great Seal of the United Kingdom.

(*f*) 48 & 49 Vict. c. 63, s. 3, p. 680 *post*.
(*g*) *Ibid.* (*h*) 51 & 52 Vict. c. 50, s. 4, p. 685 *post*.

(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.(*i*)

Date of patent.

13. Every patent shall be dated and sealed as of the day of the application: Provided that no proceedings shall be taken in respect of an infringement committed before the publication of the complete specification: Provided also, that in case of more than one application for a patent for the same invention the sealing of a patent on one of those applications shall not prevent the sealing of a patent on an earlier application.(*k*)

Provisional Protection.

Provisional protection.

14. Where an application for a patent in respect of an invention has been accepted, the invention may during the period between the date of the application and the date of sealing such patent be used and published without prejudice to the patent to be granted for the same; and such protection from the consequences of use and publication is in this Act referred to as provisional protection.

Protection by Complete Specification

Effect of acceptance of complete specification.

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

Patent.

Extent of patent.

16. Every patent when sealed shall have effect throughout the United Kingdom and the Isle of Man.

(*i*) 48 & 49 Vict. c. 63, s. 3, p. 680 *post*.
(*k*) 48 & 49 Vict. c. 63, s. 4, p. 681 *post*.

17. (1) The term limited in every patent for the duration thereof shall be fourteen years from its date. Term of patent.

(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.

(3) If, nevertheless, in any case, by accident, mistake, or inadvertence, a patentee fails to make any prescribed payment within the prescribed time, he may apply to the Comptroller for an enlargement of the time for making that payment.

(4) Thereupon the Comptroller shall, if satisfied that the failure has arisen from any of the above-mentioned causes, on receipt of the prescribed fee for enlargement, not exceeding ten pounds, enlarge the time accordingly, subject to the following conditions:

(*a*) The time for making any payment shall not in any case be enlarged for more than three months.

(*b*) If any proceeding shall be taken in respect of an infringement of the patent committed after a failure to make any payment within the prescribed time, and before the enlargement thereof, the Court before which the proceeding is proposed to be taken may, if it shall think fit, refuse to award or give any damages in respect of such infringement.

Amendment of Specification.

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. Amendment of specification.

(2) The request and the nature of such proposed amendment shall be advertised in the prescribed manner, and at any time within one month from its first advertisement any person may give notice at the Patent Office of opposition to the amendment.

(3) Where such notice is given the Comptroller shall give notice of the opposition to the person making the request, and shall hear and decide the case subject to an appeal to the law officer.

(4) The law officer shall, if required, hear the person making the request and the person so giving notice, and being in the opinion of the law officer entitled to be heard in opposition to the request, and shall determine whether and subject to what conditions, if any, the amendment ought to be allowed.

(5) Where no notice of opposition is given, or the person so giving notice does not appear, the Comptroller shall determine whether and

subject to what conditions, if any, the amendment ought to be allowed.

(6) When leave to amend is refused by the Comptroller, the person making the request may appeal from his decision to the law officer.

(7) The law officer shall, if required, hear the person making the request and the Comptroller, and may make an order determining whether, and subject to what conditions, if any, the amendment ought to be allowed.

(8) No amendment shall be allowed that would make the specification, as amended, claim an invention substantially larger than, or substantially different from, the invention claimed by the specification as it stood before amendment.

(9) Leave to amend shall be conclusive as to the right of the party to make the amendment allowed, except in case of fraud; and the amendment shall in all Courts and for all purposes be deemed to form part of the specification.

(10) *The foregoing provisions of this section do not apply when and so long as any action for infringement or other legal proceeding in relation to a patent is pending.*(*l*)

Power to disclaim part of invention during action, &c.

19. (1) In an action for infringement of a patent, and in a proceeding for revocation of a patent, the Court or a Judge may at any time order that the patentee shall, subject to such terms as to costs and otherwise as the Court or a Judge may impose, be at liberty to apply at the Patent Office for leave to amend his specification by way of disclaimer, and may direct that in the meantime the trial or hearing of the action shall be postponed.

Restriction on recovery of damages.

20. Where an amendment by way of disclaimer, correction, or explanation, has been allowed under this Act, no damages shall be given in any action in respect of the use of the invention before the disclaimer, correction, or explanation, unless the patentee establishes to the satisfaction of the Court that his 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 Licences.

Power for Board to order grant of licences.

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 licences on reasonable terms—

(*a*) The patent is not being worked in the United Kingdom; or

(*l*) 51 & 52 Vict. c. 50, s. 5, p. 685 *post*.

(*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 licences 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 transmission of patents, of licences under patents, and of amendments, extensions, and revocations of patents, and such other matters affecting the validity or proprietorship of patents as may from time to time be prescribed.

(2) The register of patents shall be *primâ facie* evidence of any matters of this Act directed or authorised to be inserted therein.

(3) Copies of deeds, licences, and any other documents affecting the proprietorship in any letters patent or in any licence 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.

(2) The Board of Trade may from time to time, if they think fit, with the consent of the Treasury, reduce any of those fees.

Extension of Term of Patent.

Extension of term of patent on petition to Queen in Council.

25. (1) A patentee may, after advertising in manner directed by any rules made under this section his intention to do so, present a petition to her Majesty in Council, praying that his patent may be extended for a further term; but such petition must be presented

at least six months before the time limited for the expiration of the patent.

(2) Any person may enter a caveat, addressed to the Registrar of the Council at the Council Office, against the extension.

(3) If her Majesty shall be pleased to refer any such petition to the Judicial Committee of the Privy Council, the said Committee shall proceed to consider the same, and the petitioner and any person who has entered a caveat shall be entitled to be heard by himself or by the counsel on the petition.

(4) The Judicial Committee shall, in considering their decision, have regard to the nature and merits of the invention in relation to the public, to the profits made by the patentee as such, and to all the circumstances of the case.

(5) If the Judicial Committee report that the patentee has been inadequately remunerated by his patent, it shall be lawful for her Majesty in Council to extend the term of the patent for a further term not exceeding seven, or in exceptional cases fourteen, years; or to order the grant of a new patent for the term therein mentioned, and containing any restrictions, conditions, and provisions that the Judicial Committee may think fit.

(6) It shall be lawful for her Majesty in Council to make, from time to time, rules of procedure and practice for regulating proceedings on such petitions, and subject thereto such proceedings shall be regulated according to the existing procedure and practice in patent matters of the Judicial Committee.

(7) The costs of all parties of and incident to such proceedings shall be in the discretion of the Judicial Committee; and the orders of the Committee respecting costs shall be enforceable as if they were orders of a division of the High Court of Justice.

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 a Court.

(3) Every ground on which a patent might, at the commencement of this Act, be repealed by *scire facias* shall be available by way of defence to an action of infringement and shall also be a ground of revocation.

(4) A petition for revocation of a patent may be presented by—

(*a*) The Attorney-General in England or Ireland, or the Lord Advocate in Scotland:

(*b*) Any person authorised 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.

27. (1) A patent shall have to all intents the like effect as against her Majesty the Queen, her heirs and successors, as it has against a subject.

(2) But the officers or authorities administering any department of the service of the Crown may, by themselves, their agents, contractors, or others, at any time after the application, use the invention for the services of the Crown on terms to be before or after the use thereof agreed on, with the approval of the Treasury, between those officers or authorities and the patentee, or, in default of such agreement, on such terms as may be settled by the Treasury after hearing all parties interested.

Legal Proceedings.

Hearing with assessor.

28. (1) In an action or proceeding for infringement or revocation of a patent, the Court may, if it thinks fit, and shall, on the request of either of the parties to the proceeding, call in the aid of an assessor specially qualified, and try and hear the case wholly or partially with his assistance; the action shall be tried without a jury unless the Court shall otherwise direct.

(2) The Court of Appeal or the Judicial Committee of the Privy Council may, if they see fit, in any proceeding before them respectively, call in the aid of an assessor as aforesaid.

(3) The remuneration, if any, to be paid to an assessor under this section shall be determined by the Court or the Court of Appeal or Judicial Committee, as the case may be, and be paid in the same manner as the other expenses of the execution of this Act.

Delivery of particulars.

29. (1) In an action for infringement of a patent the plaintiff must deliver with his statement of claim, or by order of the Court or the Judge, at any subsequent time, particulars of the breaches complained of.

(2) The defendant must deliver with his statement of defence, or by order of the Court or a Judge, at any subsequent time, particulars of any objections on which he relies in support thereof.

(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.

Certificate of validity questioned and costs thereon.

31. In an action for infringement of a patent, the Court or a Judge may certify that the validity of the patent came in question;

and if the Court or a Judge so certifies, then in any subsequent action for infringement the plaintiff in that action on obtaining a final order or judgment in his favour shall have his full costs, charges, and expenses as between solicitor and client, unless the Court or Judge trying the action certifies that he ought not to have the same.

Remedy in case of groundless threats of legal proceedings.

32. Where any person claiming to be the patentee of an invention, by circulars, 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.

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 proceedings to take any objection to a patent on the ground that it comprises more than one invention.

Patent on application of representative of deceased inventor.

34. (1) If a person possessed of an invention dies without making application for a patent for the invention, application may be made by, and a patent for the invention granted to, his legal representative.

(2) Every such application must be made within six months of the decease of such person, and must contain a declaration by the legal representative that he believes such person to be the true and first inventor of the invention.

Patent to first inventor not invalidated by application in fraud of him.

35. A patent granted to the true and first inventor shall not be invalidated by an application in fraud of him, or by provisional protection obtained thereon, or by any use or publication of the invention subsequent to that fraudulent application during the period of provisional protection.

Assignment for particular places.

36. A patentee may assign his patent for any place in or part of the United Kingdom, or Isle of Man, as effectually as if the patent were originally granted to extend to that place or part only.

Loss or destruction of patent.

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

Proceedings and costs before law officer.

38. The law officers may examine witnesses on oath and administer oaths for that purpose under this part of this Act, and may from time to time make, alter, and rescind rules regulating references and appeals to the law officers and the practice and procedure before them under this part of this Act; and in any proceeding before either of the law officers under this part of this Act the law officer may order costs to be paid by either party, and any such order may be made a rule of the Court.

Exhibition at industrial or international exhibition not to prejudice patent rights.

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.(*m*)

Publication of illustrated journal, indexes, &c.

40. (1) The Comptroller shall cause to be issued periodically an illustrated journal of patented inventions, as well as reports of patent cases decided by courts of law, and any other information that the Comptroller may deem generally useful or important.

(2) Provision shall be made by the Comptroller for keeping on sale copies of such journal, and also of all complete specifications of patents for the time being in force, with their accompanying drawings, if any.

(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.

(*m*) 49 & 50 Vict. c. 37, s. 3, p. 682 *post*.

41. The control and management of the existing Patent Museum and its contents shall, from and after the commencement of this Act, be transferred to and vested in the Department of Science and Art, subject to such directions as her Majesty in Council may see fit to give. Patent Museum.

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. Power to require models on payment.

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. Foreign vessels in British waters.

(2) But this section shall not extend to vessels of any foreign State of which the laws authorise 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.

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. Assignment to Secretary for War of certain inventions.

(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 authorised 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 authorised 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 same.

Existing Patents.

Provisions respecting existing patents.

45. (1) The provisions of this Act relating to applications for patents and proceedings thereon shall have effect in respect only of applications made after the commencement of this Act.

(2) Every patent granted before the commencement of this Act, or on an application then pending, shall remain unaffected by the provisions of this Act relating to patents binding the Crown, and to compulsory licences.

(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 application 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."

PART III.

DESIGNS.

Registration of Designs.

Application for registration of designs.

47. (1) The Comptroller may, on application by or on behalf of any person claiming to be the proprietor of any new or original design not previously published in the United Kingdom, register the design under this part of this Act.

(2) The application 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.

(3) The application must contain a statement of the nature of the design, and the class or classes of goods in which the applicant desires that the design be registered.

(4) The same design may be registered in more than one class.

(5) In case of doubt as to the class in which a design ought to be registered, the Comptroller may decide the question.

(6) The Comptroller may, if he thinks fit, refuse to register any design presented to him for registration, but any person aggrieved by any such refusal may appeal therefrom to the Board of Trade.

(7) The Board of Trade shall, if required, hear the applicant and the Comptroller, and may make an order determining whether, and subject to what conditions, if any, registration is to be permitted.

Drawings, &c., to be furnished on application.

48. (1) On application for registration of a design the applicant shall furnish to the Comptroller the prescribed number of copies of drawings, photographs, or tracings of the design, sufficient, in the opinion of the Comptroller, for enabling him to identify the design; or the applicant may, instead of such copies, furnish exact representations or specimens of the design.

(2) The Comptroller may, if he thinks fit, refuse any drawing, photograph, tracing, representation, or specimen which is not, in his opinion, suitable for the official records.

Certificate of registration.

49. (1) The Comptroller shall grant a certificate of registration to the proprietor of the design when registered.

(2) The Comptroller may, in case of loss of the actual certificate, or in any other case in which he deems it expedient, grant a copy or copies of the certificate.

Copyright in Registered Designs.

Copyright on registration.

50. (1) When a design is registered, the registered proprietor of the design shall, subject to the provisions of this Act, have

copyright in the design during five years from the date of registration.

(2) Before delivery on sale of any articles to which a registered design has been applied, the proprietor must (if exact representations or specimens were not furnished on the application for registration) furnish to the Comptroller the prescribed number of exact representations or specimens of the design; and if he fails to do so the Comptroller may erase his name from the register, and thereupon his copyright in the design shall cease.

Marking registered designs.

51. Before delivery on sale of any articles to which a registered design has been applied, the proprietor of the design shall cause each such article to be marked with the prescribed mark, or with the prescribed word or words, or figures, denoting that the design is registered; and if he fails to do so the copyright in the design shall cease, unless the proprietor shows that he took all proper steps to ensure the marking of the article.

Inspection of registered designs.

52. (1) During the existence of a copyright in a design, the design shall not be open to inspection except by the proprietor, or a person authorised in writing by the proprietor, or a person authorised by the Comptroller or by the Court, and furnishing such information as may enable the Comptroller to identify the design, nor except in the presence of the Comptroller, or of an officer acting under him, nor except on payment of the prescribed fee; and the person making the inspection shall not be entitled to take any copy of the design, or of any part thereof.(*n*)

(2) When the copyright in a design has ceased, the design shall be open to inspection, and copies thereof may be taken by any person on payment of the prescribed fee.

Information as to existence of copyright.

53. On the request of any person producing a particular design, together with its mark of registration, or producing only its mark of registration, or furnishing such information as may enable the Comptroller to identify the design, and on payment of the prescribed fee, it shall be the duty of the Comptroller to inform such person whether the registration still exists in respect of such design, and if so, in respect of what class or classes of goods, and stating also the date of registration, and the name and address of the registered proprietor.

Cesser of copyright in certain events.

54. If a registered design is used in manufacture in any foreign country and is not used in this country within six months of its registration in this country, the copyright in the design shall cease.

(*n*) 51 & 52 Vict. c. 50, s. 6, p. 685 *post*.

Register of Designs.

Register of designs.

55. (1) There shall be kept at the Patent Office a book called the Register of Designs, wherein shall be entered the names and addresses of proprietors of registered designs, notifications of assignments and of transmissions of registered designs, and such other matters as may from time to time be prescribed.

(2) The register of designs shall be *prima facie* evidence of any matters by this Act directed or authorised to be entered therein.

Fees.

Fees on registration, &c.

56. There shall be paid in respect of applications and registration and other matters under this part of this 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 shall from time to time direct.

Industrial and International Exhibitions.

Exhibition at industrial or international exhibition not to prevent or invalidate registration.

57. The exhibition at an industrial or international exhibition, certified as such by the Board of Trade, or the exhibition elsewhere during the period of the holding of the exhibition, without the privity or consent of the proprietor, of a design, or of any article to which a design is applied, or the publication, during the holding of any such exhibition, of a description of a design, shall not prevent the design from being registered, or invalidate the registration thereof, provided that both the following conditions are complied with, namely:—

(*a*) The exhibitor must, before exhibiting the design or article, or publishing a description of the design, give the Comptroller the prescribed notice of his intention to do so; and

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

Legal Proceedings.

Penalty on piracy of registered design.

58. During the existence of copyright in any design

(*a*) It shall not be lawful for any person without the licence or written consent of the registered proprietor to apply (*o*)

(*o*) 49 & 50 Vict. c. 37, s. 3, p. 682 *post*.

such design or any fraudulent or obvious imitation thereof, in the class or classes of goods in which such design is registered, for purposes of sale, to any article of manufacture or to any substance artificial or natural or partly artificial and partly natural; and

(*b*) It shall not be lawful for any person to publish or expose for sale any article of manufacture of any substance to which such design or any fraudulent or obvious imitation thereof shall have been so applied, knowing that the same has been so applied without the consent of the registered proprietor.

Any person who acts in contravention of this section shall be liable for every offence to forfeit a sum not exceeding fifty pounds to the registered proprietor of the design, who may recover such sum as a simple contract debt by action in any Court of competent jurisdiction.(*p*)

Action for damages.

59. Notwithstanding the remedy given by this Act for the recovery of such penalty as aforesaid, the registered proprietor of any design may (if he elects to do so) bring an action for the recovery of any damages arising from the application of any such design, or of any fraudulent or obvious imitation thereof for the purpose of sale, to any article of manufacture or substance, or from the publication, sale, or exposure for sale by any person of any article or substance to which such design or any fraudulent or obvious imitation thereof shall have been so applied, such person knowing that the proprietor had not given his consent to such application.

Definitions.

Definition of "design," "copyright."

60. In and for the purposes of this Act—

"Design" means any design applicable to any article of manufacture, or to any substance artificial or natural, or partly artificial and partly natural, whether the design is applicable for the pattern, or for the shape or configuration, or for the ornament thereof, or for any two or more of such purposes, and by whatever means it is applicable, whether by printing, painting, embroidering, weaving, sewing, modelling, casting, embossing, engraving, staining, or any other means whatever, manual, mechanical, or chemical, separate or combined, not being a design for a sculpture, or other thing within the protection of the Sculpture Copyright Act of the year 1814 (fifty-fourth George the Third, chapter fifty-six).

"Copyright means the exclusive right to apply a design to any

(*p*) 49 & 50 Vict. c. 37, s. 3, p. 682 *post*.

article of manufacture or to any such substance as aforesaid in the class or classes in which the design is registered.

Definition of proprietor.

61. The author of any new and original design shall be considered the proprietor thereof, unless he executed the work on behalf of another person for a good or valuable consideration, in which case such person shall be considered the proprietor, and every person acquiring for a good or valuable consideration a new and original design, or the right to apply the same to any such article or substance as aforesaid, either exclusively of any other person or otherwise, and also every person on whom the property in such design or such right to the application thereof shall devolve, shall be considered the proprietor of the design in the respect in which the same may have been acquired, and to that extent, but not otherwise.

PART IV.

TRADE MARKS.

Registration of Trade Marks.

Application for registration.

62. (1) The Comptroller may, on application by or on behalf of any person claiming to be the proprietor of a trade mark, register the trade mark.

(2) The application must be made in the form set forth in the First Schedule of 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*.(q)

(3) The application must be accompanied by the prescribed number of representations of the trade mark, and must state the particular goods or classes of goods in connection with which the applicant desires the trade mark to be registered.

(4) The Comptroller may, if he thinks fit, refuse to register a trade mark, but any such refusal shall be subject to appeal to the Board of Trade, who shall, if required, hear the applicant and the Comptroller, and may make an order determining whether, and subject to what conditions, if any, registration is to be permitted.

(5) The Board of Trade may, however, if it appears expedient, refer the appeal to the Court; and in that event the Court shall have jurisdiction to hear and determine the appeal, and may make such order as aforesaid.(q)

(q) 51 & 52 Vict. c. 50, s. 8, p. 686 *post*.

63. Where registration of a trade mark has not been or shall not be completed within twelve months from the date of the application, by reason of default on the part of the applicant, *the application shall be deemed to be abandoned.*(r) Limit of time for proceeding with application.

64. (1) *For the purposes of this Act, a trade mark must consist of or contain at least one of the following essential particulars :* Conditions of registration of trade mark.

(a) *A name of an individual or firm printed, impressed, or woven in some particular or distinctive manner ; and*

(b) *A written signature or copy of a written signature of the individual or firm applying for registration thereof as a trade mark ; or,*

(c) *A distinctive device, mark, brand, heading, label, ticket, or fancy word or words not in common use.*

(2) *There may be added to any one or more of these particulars any letters, words, or figures, or combination of letters, words or figures, or of any of them.*

(3) *Provided that any special and distinctive word or words, letter, figure, or combination of letters or figures or of letters and figures used as a trade mark before the thirteenth day of August one thousand eight hundred and seventy five may be registered as a trade mark under this part of this Act.*(s)

65. A trade mark must be registered for particular goods or classes of goods. Connection of trade mark with goods.

66. When a person claiming to be the proprietor of several trade marks which, while resembling each other in the material particulars thereof, yet differ in respect of (a) the statement of the goods for which they are respectively used or proposed to be used, or (b) statements of numbers, or (c) statements of price, or (d) statements of quality, or (e) statements of names of places, seeks to register such trade marks, they may be registered as a series in one registration. A series of trade marks shall be assignable and transmissible only as a whole, but for all other purposes each of the trade marks composing a series shall be deemed and treated as registered separately. Registration of a series of marks.

67. A trade mark may be registered in any colour,(t) and such registration shall (subject to the provisions of this Act) confer on the registered owner the exclusive right to use the same in that or any other colour.(t) Trade marks may be registered in any colour.

68. Every application for registration of a trade mark under this part of this Act shall as soon as may be after its receipt be advertised by the Comptroller.(u) Advertisement of application.

(r) 51 & 52 Vict. c. 50, s. 9, p. 686 *post*.
(s) 51 & 52 Vict. c. 50, s. 10, p. 686 *post*.
(t) 51 & 52 Vict. c. 59, s. 11, p. 687 *post*.
(u) 51 & 52 Vict. c. 50, s. 12, p. 687 *post*.

Opposition to registration.

69. (1) Any person may within *two months* (*x*) of the *first* (*x*) advertisement of the application, give notice in duplicate at the Patent Office of opposition to registration of the trade mark, and the Comptroller shall send one copy of such notice to the applicant.

(2) Within *two months* (*y*) after receipt of such notice or such further time as the Comptroller may allow, the applicant may send to the Comptroller a counter statement in duplicate of the grounds on which he relies for his application, and if he does not do so shall be deemed to have abandoned his application.

(3) *If the applicant sends such counter statement, the Comptroller shall furnish a copy thereof to the person who gave notice of opposition, and shall require him to give security in such manner and to such amount as the Comptroller may require for such costs as may be awarded in respect of such opposition; and if such security is not given within fourteen days after such requirement was made or such further time as the Comptroller may allow, the opposition shall be deemed to be withdrawn.*(*z*)

(4) *If the person who gave notice of opposition duly gives such security as aforesaid, the Comptroller shall inform the applicant thereof in writing, and thereupon the case shall be deemed to stand for the determination of the Court.*(*z*)

Assignment and transmission of trade mark.

70. A trade mark, when registered, shall be assigned and transmitted only in connection with the goodwill of the business concerned in the particular goods or classes of goods for which it has been registered, and shall be determinable with that goodwill.

Conflicting claims to registration.

71. Where each of several persons claims to be registered as proprietors of the same trade mark, the Comptroller may refuse to register any of them until their rights have been determined according to law, and the Comptroller may himself submit or require the claimants to submit their rights to the Court.

Restrictions on registration.

72. (1) Except where the Court has decided that two or more persons are entitled to be registered as proprietors of the same trade mark, the Comptroller shall not register in respect of the same goods or description of goods a trade mark identical with the one already on the register with respect to such goods or description of goods.

(2) (*a*) The Comptroller shall not register with respect to the same goods or description of goods a trade mark *so nearly resembling* (*a*) a trade mark already on the register with respect to such goods or description of goods as to be calculated to deceive.

Further restriction on registration.

73. It shall not be lawful to register as part of or in combination with a trade mark any words the exclusive use of which would by

(*x*) 51 & 52 Vict. c. 50, s. 13, sub-s. 1 & 2, p. 687 *post.*
(*y*) 51 & 52 Vict. c. 50, s. 13, sub-s. 3, p. 687 *post.*
(*z*) 51 & 52 Vict. c. 50, s. 13, sub-s. 4, p. 687 *post.*
(*a*) 51 & 52 Vict. c. 50, s. 14, p. 688 *post.*

reason of their being calculated to deceive or otherwise, be deemed disentitled to protection in a Court of justice, or any scandalous design.

Saving for power to provide for entry on register of common marks as additions to trade marks.

74. (1) Nothing in this Act shall be construed to prevent the Comptroller entering on the register, in the prescribed manner, and subject to the prescribed conditions, as an addition to any trade mark—

(*a*) In the case of an application for registration of a trade mark used before the thirteenth day of August one thousand eight hundred and seventy-five—

Any distinctive device, mark, brand, heading, label, ticket, letter, word, or figure, or combination of letters, words, or figures, though the same is common to the trade in the goods with respect to which the application is made;

(*b*) In the case of an application for registration of a trade mark not used before the thirteenth day of August one thousand eight hundred and seventy-five—

Any distinctive word or combination of words, though the same is common to the trade in the goods with respect to which the application is made;

(2) *The applicant for entry of any such common particular or particulars must, however, disclaim in his application any right to the exclusive use of the same, and a copy of the disclaimer shall be entered on the register.*(*b*)

(3) Any device, mark, brand, heading, label, ticket, letter, word, figure, or combination of letters, words, or figures, which was or were, before the thirteenth day of August one thousand eight hundred and seventy-five, publicly used by more than three persons on the same or a similar description of goods shall, for the purposes of this section, be deemed common to the trade in such goods.

Effect of Registration.

Registration equivalent to public use.

75. *Registration of a trade mark shall be deemed to be equivalent to public use of the trade mark.*(*c*)

Right of first proprietor to exclusive use of trade mark.

76. The registration of a person as proprietor of a trade mark shall be *primâ facie* evidence of his right to the exclusive use of the trade mark, and shall, after the expiration of five years from the date of the registration, be conclusive evidence of his right to the exclusive use of the trade mark, subject to the provisions of this Act.

(*b*) 51 & 52 Vict. c. 50, s. 16, p. 688 *post*.
(*c*) 51 & 52 Vict. c. 50, s. 17, p. 688 *post*.

Restrictions on actions for infringement, and on defence to action in certain cases.

77. A person shall not be entitled to institute any proceeding to prevent or to recover damages for the infringement of a trade mark unless, in the case of a trade mark capable of being registered under this Act, it has been registered in pursuance of this Act, or of an enactment repealed by this Act, or, in the case of any other trade mark in use before the thirteenth day of August one thousand eight hundred and seventy-five, registration thereof under this part of this Act, or of an enactment repealed by this Act, has been refused. The Comptroller may, on request, and on payment of the prescribed fee, grant a certificate that such registration has been refused.(*d*)

Register of Trade Marks.

Register of trade marks.

78. There shall be kept at the Patent Office a book called the Register of Trade Marks, wherein shall be entered the names and addresses of proprietors of registered trade marks, notifications of assignments and of transmissions of trade marks, and such other matters as may be from time to time prescribed.

Removal of trade mark after fourteen years unless fee paid.

79. (1) At a time not being less than two months nor more than three months before the expiration of fourteen years from the date of the registration of a trade mark, the Comptroller shall send notice to the registered proprietor that the trade mark will be removed from the register unless the proprietor pays to the Comptroller before the expiration of such fourteen years (naming the date at which the same will expire) the prescribed fee; and if such fee be not previously paid he shall at the expiration of one month from the date of the giving of the first notice send a second notice to the same effect.

(2) If such fee be not paid before the expiration of such fourteen years the Comptroller may after the end of three months from the expiration of such fourteen years remove the mark from the register, and so from time to time at the expiration of every period of fourteen years.

(3) If before the expiration of the said three months the registered proprietor pays the said fee together with the additional prescribed fee, the Comptroller may, without removing such trade mark from the register, accept the said fee as if it had been paid before the expiration of the said fourteen years.

(4) Where after the said three months a trade mark has been removed from the register for nonpayment of the prescribed fee, the Comptroller may, if satisfied that it is just so to do, restore such trade mark to the register on payment of the prescribed additional fee.

(*d*) 51 & 52 Vict. c. 50, s. 18, p. 688 *post*.

(5) Where a trade mark has been removed from the register for nonpayment of the fee or otherwise, such trade mark shall nevertheless for the purpose of any application for registration during the *five years* (*e*) next after the date of such removal, be deemed to be a trade mark which is already registered.(*e*)

Fees.

80. There shall be paid in respect of applications and registration and other matters under this part of this 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. Fees for registration, &c.

Sheffield Marks.

81. With respect to the master, wardens, searchers, assistants, and commonalty of the Company of Cutlers in Hallamshire, in the county of York (in this Act called the Cutlers' Company) and the marks or devices (in this Act called Sheffield marks) assigned or registered by the master, wardens, searchers, and assistants of the company, the following provisions shall have effect: Registration by Cutlers' Company of Sheffield marks.

(1) The Cutlers' Company shall establish and keep at Sheffield a new register of trade marks (in this Act called the Sheffield register):

(2) *The Cutlers' Company shall enter in the Sheffield register, in respect of cutlery, edge tools, or raw steel and the goods mentioned in the next sub-section, all the trade marks entered before the commencement of this Act in respect of cutlery, edge tools, or raw steel, and such goods in the register established under the Trade Marks Registration Act*, 1887, *belonging to persons carrying on business in Hallamshire, or within six miles thereof, and shall also enter in such register, in respect of the same goods, all the trade marks which shall have been assigned by the Cutlers' Company and actually used before the commencement of this Act, but which have not been entered in the register established under the Trade Marks Registration Act*, 1875.(*f*)

(3) An application for registration of a trade mark used *on cutlery, edge tools, or on raw steel, or on goods made of steel, or of steel*

(*e*) 51 & 52 Vict. c. 50, s. 19, p. 688 *post*.
(*f*) 51 & 52 Vict. c. 50, s. 20, sub-s. 1, p. 689 *post*.

and iron combined, whether with or without a cutting edge,(g) shall, if made after the commencement of this Act by a person carrying on business in Hallamshire, or within six miles thereof, be made to the Cutlers' Company:

(4) Every application so made to the Cutlers' Company shall be notified to the Comptroller in the prescribed manner, and unless the Comptroller within the prescribed time gives notice to the Cutlers' Company that he objects to the acceptance of the application, it shall be proceeded with by the Cutlers' Company in the prescribed manner:

(5) If the Comptroller gives notice of objection as aforesaid the application shall not be proceeded with by the Cutlers' Company, but any person aggrieved may appeal to the Court:

(6) Upon the registration of a trade mark in the Sheffield register the Cutlers' Company shall give notice thereof to the Comptroller, who shall thereupon enter the mark in the register of trade marks; and such registration shall bear date as of the day of application to the Cutlers' Company, and have the same effect as if the application had been made to the Comptroller on that day.

(7) *The provisions of this Act, and of any general rules made under this Act, with respect to application for registration in the register of trade marks, the effect of such registration, and the assignment and transmission of rights in a registered trade mark shall apply in the case of applications and registration in the Sheffield register; and notice of every entry made in the Sheffield register must be given to the Comptroller by the Cutlers' Company, save and except that the provisions of this sub-section shall not prejudice or affect any life, estate, and interest of a widow of the holder of any Sheffield mark which may be in force in respect of such mark at the time when it shall be placed upon the Sheffield register.*(h)

(8) Where the Comptroller receives from any person not carrying on business in Hallamshire or within six miles thereof an application for registration of a trade mark used *on cutlery, edge tools, or on raw steel, or on goods made of steel, or of steel and iron combined, whether with or without a cutting edge,*(i) he shall in the prescribed manner notify the application and proceedings thereon to the Cutlers' Company:

(9) At the expiration of five years from the commencement of this Act the Cutlers' Company shall close the Cutlers' register

(g) 51 & 52 Vict. c. 50, s. 20, sub-s. 2, p. 689 *post.*
(h) 51 & 52 Vict. c. 50, s. 20, sub-s. 3, p. 689 *post.*
(i) 51 & 52 Vict. c. 50, s. 20, sub-s. 2, p. 689 *post.*

of corporate trade marks, and thereupon all marks entered therein shall, unless entered in the Sheffield register, be deemed to have been abandoned:

(10) A person may (notwithstanding anything in any Act relating to the Cutlers' Company) be registered in the Sheffield register as proprietor of two or more trade marks:

(11) A body of persons, corporate or not corporate, may (notwithstanding anything in any Act relating to the Cutlers' Company) be registered in the Sheffield register as proprietor of a trade mark or trade marks:

(12) Any person aggrieved by a decision of the Cutlers' Company in respect of anything done or omitted under this Act may, in the prescribed manner, appeal to the Comptroller, who shall have power to confirm, reverse, or modify the decision, but the decision of the Comptroller shall be subject to a further appeal to the Court:

(13) So much of the Cutlers' Company's Acts as applies to the summary punishment of persons counterfeiting Sheffield corporate marks, that is to say, the fifth section of the Cutlers' Company Act of 1814, and the provisions in relation to the recovery and application of the penalty imposed by such last-mentioned section contained in the Cutlers' Company's Act of 1791, shall apply to any mark entered in the Sheffield register.(*k*)

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 building 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

(*k*) 51 & 52 Vict. c. 50, s. 20, sub-s. 4, p. 690 *post*.

may, in his absence, be done by or to any officer for the time being in that behalf authorised 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 the 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.

86. The Comptroller may refuse to grant a patent for an invention, or to register a design or trade mark, of which the use would, in his opinion, be contrary to law or morality.

Entry of assignments and transmissions in registers.

87. Where a person becomes entitled by assignment, transmission, or other operation of law to a patent, or to the copyright in a registered design, or to a registered trade mark, the Comptroller shall on request, and on proof of title to his satisfaction, cause the name of such person to be entered as proprietor of the patent, copyright in the design, or trade mark, in the register of patents, designs, or trade marks, as the case may be. The person for the time being entered in the register of patents, designs, or trade marks, as proprietor of a patent, copyright in a design or trade mark, as the case may be, shall, subject to (*l*) any rights appearing from such register to be vested in any other person, have power absolutely to assign, grant licences 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 be enforced in like manner as in respect of any other personal property.

Inspection of and extracts from registers.

88. Every register kept under this Act shall at all convenient times be open to the inspection of the public, subject to (*m*) such regulations as may be prescribed; and certified copies, sealed with the seal of the Patent Office, of an entry in any such register shall be given to any person requiring the same on payment of the prescribed fee.

(*l*) 51 & 52 Vict. c. 50, s. 21, p. 690 *post*.
(*m*) 51 & 52 Vict. c. 50, s. 22, p. 690 *post*.

Sealed copies to be received in evidence.

89. Printed or written copies or extracts, purporting to be certified by the Comptroller and sealed with the seal of the Patent Office, of or from patents, specifications, disclaimers, and other documents in the Patent Office, and of or from registers and other books kept there, shall be admitted in evidence in all Courts in her Majesty's dominions, and in all proceedings, without further proof or production of the originals.

Rectification of registers by Court.

90. (1) The Court may on the application of any person aggrieved by the omission without sufficient cause of the name of any person(*n*) 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 connection 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*) Cancel the entry or part of the entry of a trade mark on the register: Provided that the applicant accompanies his request by a statutory declaration made by himself, stating his name, address, and calling, and that he is the person whose name appears on the register as the proprietor of the said trade mark.(*o*)

Alteration of registered mark.

92. (1) The registered proprietor of any registered trade mark may apply to the Court for leave to add to or alter such mark in any particular, not being an essential particular within the meaning of this Act, and the Court may refuse or grant leave on such terms as it may think fit.

(2) Notice of any intended application to the Court under this

(*n*) 51 & 52 Vict. c. 50, s. 23, p. 690 *post*.
(*o*) 51 & 52 Vict. c. 50, s. 24, p. 690 *post*.

section shall be given to the Comptroller by the applicant; and the Comptroller shall be entitled to be heard on the application.

(3) If the Court grants leave, the Comptroller shall, on proof thereof and on payment of the prescribed fee, cause the register to be altered in conformity with the order of leave.

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 authorised 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 authorised 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.

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 of 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 or 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.

(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 rule 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.(*p*)

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

(*p*) 51 & 52 Vict. c. 50, s. 25, p. 690 *post*.

applicants; and such patent or registration shall have the same date as the *date of the protection obtained* (*q*) in such foreign State.

Provided that his application is made, in the case of a patent within seven months, and in the case of a design or trade mark within four months, from his applying for protection in the foreign State with which the arrangement is in force.

Provided that nothing in this section contained shall entitle the patentee or proprietor of the design or trade mark to recover damages for infringements happening prior to the date of the actual acceptance of his complete specification, or the actual registration of his design or trade mark in this country, as the case may be.

(2) The publication in the United Kingdom or the Isle of Man during the respective periods aforesaid of any description of the invention, or the use therein during such periods of the invention, or the exhibition or use therein during such periods of the design, or the publication therein during such periods of a description or representation of the design, or the use therein during such periods of the trade mark, shall not invalidate the patent which may be granted for the invention, or the registration of the design or trade mark.

(3) The application for the grant of a patent, or the registration of a design, or the registration of a trade mark under this 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 had 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 the State.

Provision for colonies and India.

104. (1) Where it is made to appear to Her Majesty that the legislature of any British possession has made satisfactory provision for the protection of inventions, designs, and trade marks, patented or registered in this country, it shall be lawful for Her Majesty from time to time, by Order in Council, to apply the provisions of the last preceding section, with such variations or additions, if any, as to Her Majesty in Council may seem fit, to such British possession.

(2) An Order in Council under this Act shall, from a date to be mentioned for the purpose in the Order, take effect as if its provisions had been contained in this Act; but it shall be lawful for Her Majesty in Council to revoke any Order in Council made under this Act.

(*q*) 48 & 49 Vict. *c.* 63, s. 6, p. 681 *post*.

Offences.

Penalty on falsely representing articles to be patented.

105. (1) Any person who represents that any article sold by him is a patented article, when no patent has been granted for the same, or describes any design or trade mark applied to any article sold by him as registered which is not so, shall be liable for every offence on summary conviction to a fine not exceeding five pounds.

(2) A person shall be deemed, for the purpose of this enactment, to represent that an article is patented or a design or a trade mark is registered, if he sells the article with the word "patent," "patented," "registered," or any word or words expressing or implying that a patent or registration has been obtained for the article stamped, engraved, or impressed on, or otherwise applied to, the article.

Penalty on unauthorised 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 connection 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 to be punishable on summary conviction may be prosecuted in the sheriff court.

Proceedings for revocation of patent in Scotland.

109. (1) Proceedings in Scotland for revocation of a patent shall be in the form of an action of reduction at the instance of the Lord Advocate, or at the instance of a party having interest with his concurrence, which concurrence may be given on just cause shown only.

(2) Service of all writs and summonses in that action shall be

made according to the forms and practice existing at the commencement of this Act.

Reservation of remedies in Ireland.

110. All parties shall, notwithstanding anything in this Act, have in Ireland their remedies under or in respect of a patent as if the same had been granted to extend to Ireland only.

General saving for jurisdiction of Courts.

111. (1) The provisions of this Act conferring a special jurisdiction on the court as defined by this Act, shall not, except so far as the jurisdiction extends, affect the jurisdiction of any court in Scotland or Ireland in any proceedings relating to patents or to designs or to trade marks; and with reference to any such proceedings in Scotland, the term "the Court" shall mean any Lord Ordinary of the Court of Session, and the term "Court of Appeal" shall mean any 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.

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 misdemeanor under this Act in the Isle of Man shall be imprisonment for any term not exceeding two years, with or without hard labour, and with or without a fine not exceeding one hundred pounds, at the discretion of the Court;

(3) Any offence under this Act committed in the Isle of Man which would in England be punishable on summary conviction may be prosecuted, and any fine in respect thereof recovered at the instance of any person aggrieved, in the manner in which offences punishable on summary conviction may for the time being be prosecuted.(*r*)

Repeal; Transitional Provisions; Savings.

Repeal and saving for past operation of

113. The enactments described in the Third Schedule to this Act are hereby repealed. But this repeal of enactments shall not—

(*r*) 51 & 52 Vict. c. 50, s. 26, p. 690 *post*.

repealed enactments, &c.

(*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 proceedings 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.(*s*)

Former registers to be deemed continued.

114. (1) The registers of patents and of proprietors kept under any enactment repealed by this Act shall respectively be deemed parts of the same book as the register of patents kept under this Act.

(2) The registers of designs and of trade marks kept under any enactment repealed by this Act shall respectively be deemed parts of the same book as the register of designs and the register of trade marks kept under this Act.

Saving for existing rules.

115. All general rules made by the Lord Chancellor or by any other authority under any enactment repealed by this Act, and in force at the commencement of this Act, may at any time after the passing of this Act be repealed, altered or amended by the Board of Trade, as if they had been made by the Board under this Act, but so that no such repeal, alteration or amendment shall take effect before the commencement of this Act; and, subject as aforesaid, such general rules shall, so far as they are consistent with and are not superseded by this Act, continue in force as if they had been made by the Board of Trade under this Act.

Saving for prerogative

116. Nothing in this Act shall take away, abridge or prejudicially affect the prerogative of the Crown in relation to the granting of any letters patent or to the withholding of a grant thereof.

General Definitions.

General definitions.

117. (1) In and for the purposes of this Act, unless the context otherwise requires—

"Person" includes a body corporate:

"The Court" means (subject to the provisions for Scotland, Ireland, and the Isle of Man) Her Majesty's High Court of Justice in England:

(*s*) 51 & 52 Vict. c. 50, s. 27, p. 691 *post*.

"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.(*t*)

SCHEDULES.

THE FIRST SCHEDULE.

FORMS OF APPLICATION, &c.

Form A.(*u*)

Form of Application.

Form B.(*u*)

Form of Provisional Specification.

Form C.(*u*)

Form of Complete Specification.

(*t*) 51 & 52 Vict. c. 50, s. 1, p. 684 *post*.

(*u*) For forms A, B, and C, the Board of Trade have, under the powers conferred by s. 101, sub-s. 2, of the Act, substituted the forms A, A1, A2, B and C, which will be found at pp. 744–751 *post*.

Form D.

Form of Patent.

[This form will be found at p. 741 *post.*]

Form E.

Form of Application of Registration of Design.

Form F.

Form of Application for Registration of Trade Mark.

THE SECOND SCHEDULE.

Fees on instrument for obtaining Patents and Renewal.

These fees are all included in the List of Fees given in the First Schedule to the Patent Rules, 1890; *see* p. 839 *post.*

THE THIRD SCHEDULE.

Enactments repealed.

21 James I. c. 3. [1623.]	The Statute of Monopolies. In part; namely,— Sections ten, eleven, and twelve.
5 & 6 Will. IV. c. 62. [1835.] In part.	The Statutory Declarations Act, 1835. In part; namely,— Section eleven.
5 & 6 Will. IV. c. 83. [1835.]	An Act to amend the law touching letters patent for inventions.
2 & 3 Vict. c. 67. [1839.]	An Act to amend an Act of the fifth and sixth years of the reign of King William the Fourth, intituled "An Act to amend the law touching letters patent for inventions."
5 & 6 Vict. c. 100. [1842.]	An Act to consolidate and amend the laws relating to the copyright of designs for ornamenting articles of manufacture.
6 & 7 Vict. c. 65. [1843.]	An Act to amend the laws relating to the copyright of designs.

7 & 8 Vict. c. 69.(x) [1844.] In part.	An Act for amending an Act passed in the fourth year of the reign of His late Majesty, intituled "An Act for the better administration of justice in His Majesty's Privy Council, and to extend its jurisdiction and powers." In part; namely,— Sections two to five.
13 & 14 Vict. c. 104. [1850.]	An Act to extend and amend the Acts relating to the copyright of designs.
15 & 16 Vict. c. 83. [1852.]	The Patent Law Amendment Act, 1852.
16 & 17 Vict. c. 5. [1853.]	An Act to substitute stamp duties for fees on passing letters patent for inventions, and to provide for the purchase for the public use of certain indexes of specifications.
16 & 17 Vict. c. 115. [1853.]	An Act to amend certain provisions of the Patent Law Amendment Act, 1852, in respect of the transmission of certified copies of letters patent and specifications to certain offices in Edinburgh and Dublin, and otherwise to amend the said Act.
21 & 22 Vict. c. 70 1858.]	An Act to amend the Act of the fifth and sixth years of Her present Majesty, to consolidate and amend the laws relating to the copyright of designs for ornamenting articles of manufacture.
22 Vict. c. 13. [1859.]	An Act to amend the law concerning patents for inventions with respect to inventions for improvements in instruments and munitions of war.
24 & 25 Vict. c. 73. [1861.]	An Act to amend the law relating to the copyright of designs.
28 & 29 Vict. c. 3. [1865.]	The Industrial Exhibitions Act, 1865.
33 & 34 Vict. c. 27. [1870.]	The Protection of Inventions Act, 1870.
33 & 34 Vict. c. 97. [1870.]	The Stamp Act, 1870. In part; namely,— Section sixty-five, and in the Schedule the words and figures, "Certificate of the registration of a design . . £5 0 0 And see section 65."
38 & 39 Vict. c. 91. [1875.]	The Trade Marks Registration Act, 1875.
38 & 39 Vict. c. 93. [1875.]	The Copyright of Designs Act, 1875.
39 & 40 Vict. c. 33. [1876.]	The Trade Marks Registration Amendment Act, 1876.
40 & 41 Vict. c. 37. [1877.]	The Trade Marks Registration Extension Act, 1877.
43 & 44 Vict. c. 10. [1880.]	The Great Seal Act, 1880. In part; namely,— Section five.
45 & 46 Vict. c. 72. [1882.]	The Revenue, Friendly Societies, and National Debt Act, 1882. In part; namely,— Section sixteen.

(x) *Note.*—Sections six and seven of this Act are repealed by the Statute Law Revision (No. 2) Act, 1874.

PATENTS, DESIGNS, &c., AMENDMENT ACT, 1885.

48 & 49 Vict. c. 63.

An Act to amend the Patents, Designs, and Trade Marks Act, 1883.

[14*th 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 Act, 1883 and 1885.

Amendment of s. 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 W. IV. c. 62.

Amendment of ss. 8, 9, and 12 of 46 & 47 Vict. c. 57.

3. Whereas under the principal Act a complete specification is required (by section eight) to be left within nine months, and (by section nine) to be accepted within twelve months, from the date of application, and a patent is required by section twelve to be sealed within fifteen months from the date of application; and it is expedient to empower the Comptroller to extend in 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 connection with such application, shall not at any time be open to public inspection or be published by the Comptroller.

Power to grant patents to several persons jointly.

5. Whereas doubts have arisen whether under the principal Act a patent may lawfully be granted to several persons jointly, some or one of whom only are or is the true and first inventors or inventor; be it therefore enacted and declared that it has been and is lawful under the principal Act to grant such a patent.

Amendment of s. 103 of 46 & 47 Vict. c. 57.

6. In sub-section one of section one hundred and three of the principal Act the words "date of the application" shall be substituted for the words "date of the protection obtained."

PATENTS ACT, 1886.

49 & 50 VICT. c. 37.

An Act to remove certain doubts respecting the construction of the Patents, Designs, and Trade Marks Act, 1883, so far as respects the drawings by which specifications are required to be accompanied, and as respects exhibitions. [*25th June*, 1886.]

46 & 47 Vict. c. 57.

WHEREAS by section five of the Patents, Designs, and Trade Marks Acts, 1883, specifications, whether provisional or complete, must be accompanied by drawings, if required, and doubts have arisen as to whether it is sufficient that a complete specification refers to the drawings by which the provisional specification was accompanied, and it is expedient to remove such doubts:

Be it therefore enacted by the Queen's Most Excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons in this present Parliament assembled, and by the authority of the same, as follows:

Short title and construction. 46 & 47 Vict. c. 57. 48 & 49 Vict. c. 63.

1. This Act may be cited as the Patents Act, 1886, and shall be construed as one with the Patents, Designs, and Trade Marks Acts, 1883 and 1885, and, together with those Acts, may be cited as the Patents, Designs, and Trade Marks Acts, 1883 to 1886.

The same drawings may accompany both specifications.

2. The requirement of sub-section four of section five of the Patents, Designs, and Trade Marks Act, 1883, as to drawings shall not be deemed to be insufficiently complied with by reason only that, instead of being accompanied by drawings, the complete specification refers to the drawings which accompanied the provisional specification. And no patent hitherto 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 a design, give the Comptroller the prescribed notice of his intention to do so:

And whereas it is expedient to provide for the extension of the said sections to industrial and international exhibitions held out of the United Kingdom, be it therefore enacted as follows:

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

PATENTS, DESIGNS, AND TRADE MARKS ACT, 1888.

51 & 52 VICT. c. 50.

An Act to amend the Patents, Designs, and Trade Marks Act, 1883.

[24*th December* 1888.]

46 & 47 Vict. c. 57.

WHEREAS it is expedient to amend the Patents, Designs, and Trade Marks Act, 1883, hereinafter referred to as the principal Act:

Be it therefore enacted by the Queen's Most Excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows:

Register of patent agents.

1. (1) After the first day of July one thousand eight hundred and eighty-nine a person shall not be entitled to describe himself as a patent agent, whether by advertisement, by description on his place of business, by any document issued by him, or otherwise, unless he is registered as a patent agent in pursuance of this Act.

(2) The Board of Trade shall, as soon as may be after the passing of this Act, and may from time to time, make such general rules as are in the opinion of the Board required for giving effect to this section, and the provisions of section one hundred and one of the principal Act shall apply to all rules so made as if they were made in pursuance of that section.

(3) Provided that every person who proves to the satisfaction of the Board of Trade that prior to the passing of this Act he had been *bonâ fide* practising as a patent agent shall be entitled to be registered as a patent agent in pursuance of this Act.

(4) If any person knowingly describes himself as a patent agent in contravention of this section, he shall be liable on summary conviction to a fine not exceeding twenty pounds.

(5) In this section "patent agent" means exclusively an agent for obtaining patents in the United Kingdom.

s. 7, as to applications.

2. For section seven of the principal Act the following section shall be substituted, namely:

"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. Amendments of 46 & 47 Vict. c. 57. s. 7, as to applications.

"2. Where the Comptroller refuses to accept an application or requires an amendment, the applicant may appeal from his decision to the law officer.

"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."

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. s. 9, as to disclosure of reports of examiners.

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." s. 11, as to opposition to grant of patent.

5. For sub-section ten of section eighteen of the principal Act the following sub-section shall be substituted, namely: s. 18, as to amended specifications.

"(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."

6. After sub-section one of section fifty-two of the principal Act the following words shall be added, namely: s. 52, as to inspection of designs.

"Provided that where registration of a design is refused on the ground of identity with a design already registered, the ap-

plicant for registration shall be entitled to inspect the design so registered."

s. 58, as to piracy of registered designs.

7. (1) In section fifty-eight of the principal Act the words "or cause to be applied" shall be added after the word "apply."

(2) To the same section the following words shall be added: "Provided that the total sum forfeited in respect of any one design shall not exceed one hundred pounds."

s. 62, as to application for registration.

8. (1) In sub-section two of section sixty-two of the principal Act for the words "the patent office in the prescribed manner" shall be substituted the words "such place and in such manner as may be prescribed."

(2) To the same section of the principal Act the following sub-section shall be added:

"(6) Where an applicant for the registration of a trade mark otherwise than under an international convention is out of the United Kingdom at the time of making the application he shall give the Comptroller an address for service in the United Kingdom, and if he fails to do so the application shall not be proceeded with until the address has been given.

s. 63, as to limit of time for proceeding with application.

9. In section sixty-three of the principal Act for the words "the application shall be deemed to be abandoned" shall be substituted the words "the Comptroller shall give notice of the non-completion to the agent employed on behalf of the applicant, and, if at the expiration of fourteen days from that notice the registration is not completed, shall give the like notice to the applicant, and if at the expiration of the latter fourteen days, or such further time as the Comptroller may in special cases permit, the registration is not completed, the application shall be deemed to be abandoned."

s. 64, as to fancy words.

10. (1) For section sixty-four of the principal Act the following section shall be substituted, namely:

"64. (1) For the purposes of this Act, a trade mark must consist of or contain at least one of the following essential particulars:

"(*a*) A name of an individual or firm printed, impressed, or woven in some particular and distinctive manner; or

"(*b*) A written signature or copy of a written signature of the individual or firm applying for registration thereof as a trade mark; or

"(*c*) A distinctive device, mark, brand, heading, label, or ticket; or

"(*d*) An invented word or invented words; or

"(*e*) A word or words having no reference to the character or quality of the goods, and not being a geographical name.

"(2) There may be added to any one or more of the essential particulars mentioned in this section any letters, words, or figures,

or combination of letters, words, or figures, or of any of them, but the applicant for registration of any such additional matter must state in his application the essential particulars of the trade mark, and must disclaim in his application any right to the exclusive use of the added matter, and a copy of the statement and disclaimer shall be entered on the register.

"(3) Provided as follows:

"(i) A person need not under this section disclaim his own name or the foreign equivalent thereof, or his place of business, but no entry of any such name shall affect the right of any owner of the same name to use that name or the foreign equivalent thereof:

"(ii) Any special and distinctive word or words, letter, figure, or combination of letters or figures, or of letters and figures used as a trade mark before the thirteenth day of August one thousand eight hundred and seventy-five, may be registered as a trade mark under this part of this Act."

s. 67, as to colours of trade marks.

11. In section sixty-seven of the principal Act the words "or colours" shall be added after the word "colour" in each place where that word occurs.

s. 68, as to advertisement of applications.

12. In section sixty-eight of the principal Act after the word Comptroller shall be added the words "unless the Comptroller refuse to entertain the application."

s. 69, as to opposition to registration.

13. (1) In sub-section one of section sixty-nine of the principal Act for the words "two months" shall be substituted the words "one month or such further time, not exceeding three months, as the Comptroller may allow."

(2) In the same sub-section the word "first" shall be omitted.

(3) In sub-section two of the same section for the words "two months" shall be substituted the words "one month."

(4) For sub-sections three and four of the same section the following sub-sections shall be substituted, namely—

"(3) If the applicant sends such counter-statement the Comptroller shall furnish a copy thereof to the person who gave notice of opposition, and shall, after hearing the applicant and the opponent, if so required, decide whether the trade mark is to be registered, but his decision shall be subject to appeal to the Board of Trade, who shall, if required, hear the applicant and the opponent and the Comptroller, and may make an order determining whether, and subject to what conditions (if any), registration is to be permitted.

"(4) The Board of Trade may, however, if it appears expedient, refer the appeal to the Court, and in that event the Court shall have jurisdiction to hear and determine the appeal, and may make such order as aforesaid.

"(5) If the applicant abandons his application after notice of opposition in pursuance of this section, he shall be liable to pay to the opponent such costs in respect of the opposition as the Comptroller may determine to be reasonable.

"(6) Where the opponent is out of the United Kingdom he shall give the Comptroller an address for service in the United Kingdom."

s. 72, as to restrictions on registration.

14. In sub-section two of section seventy-two of the principal Act, the following words shall be added at the beginning of the sub-section—namely, "except as aforesaid," and for the words "so nearly resembling," shall be substituted the words "having such resemblance to."

s. 73, as to restriction on registration.

15. In section seventy-three of the principal Act the word "exclusive" shall be omitted.

s. 74, as to additions to trade marks.

16. For sub-section two of section seventy-four of the principal Act the following sub-section shall be substituted, namely—

"(2) The applicant for registration of any such addition must, however, state in his application the essential particulars of the trade mark, and must disclaim in his application any right to the exclusive use of the added matter, and a copy of the statement and disclaimer shall be entered on the register.

"Provided that a person need not under this section disclaim his own name or the foreign equivalent thereof, or his place of business, but no entry of any such name shall affect the right of any owner of the same name to use that name or the foreign equivalent thereof."

s. 75, as to effect of registration.

17. For section seventy-five of the principal Act the following section shall be substituted, namely—

"Application for registration of a trade mark shall be deemed to be equivalent to public use of the trade mark, and the date of the application shall for the purposes of this Act be deemed to be, and as from the first day of January one thousand eight hundred and seventy-six to have been, the date of the registration."

Certificate as to exclusive use and costs thereon.

18. After section seventy-seven of the principal Act the following section shall be added, and numbered 77A, namely—

"In an action for infringement of a registered trade mark the Court or a Judge may certify that the right to the exclusive use of the trade mark 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 subsequent action certifies that he ought not to have the same."

19. (1) In sub-section five of section seventy-nine of the principal

Act, for the words the "five years" shall be substituted the words "one year."

Amendments of 46 & 47 Vict. c. 57, s. 79, as to removal of trade mark from the register.

(2) To the same sub-section the following words shall be added, namely: "Unless it is shown to the satisfaction of the comptroller that the non-payment of the fee arises from the death or bankruptcy of the registered proprietor, or from his having ceased to carry on business, and that no person claiming under that proprietor or under his bankruptcy is using the trade mark."

s. 81, as to Sheffield marks.

20. (1) For sub-section two of section eighty-one of the principal Act, the following sub-section shall be substituted:

"(2) The Cutlers' Company shall enter in the Sheffield register, in respect of metal goods, as defined in this section, all the trade marks entered before the first day of January one thousand eight hundred and eighty-nine in respect of metal goods either in the register established under the Trade Marks Registration Act, 1875, or in the register of trade marks under this Act, belonging to persons carrying on business in Hallamshire or within six miles thereof. The Cutlers' Company shall also, on request made in the prescribed manner, enter in the Sheffield register, in respect of metal goods, all the trade marks which shall have been assigned by the Cutlers' Company and actually used before the first day of January one thousand eight hundred and eighty-four, but which have not been entered in either of the said other registers."

38 & 39 Vict. c. 91.

(2) In sub-sections three and eight of the same section, for the words "on cutlery, edge tools, or on raw steel, or on goods made of steel, or of steel and iron combined, whether with or without a cutting edge," shall be substituted the words "on metal goods."

(3) For sub-section seven of the same section the following sub-section shall be substituted:

"(7) The provisions of this Act and of any general rules made under this Act with respect to the registration of trade marks, and all matters relating thereto, shall, subject to the provisions of this section, apply to the registration of trade marks on metal goods by the Cutler's Company, and to all matters relating thereto; and this Act and any such general rules shall, so far as applicable, be construed accordingly with the substitution of the Cutlers' Company, the office of the Cutlers' Company, and the Sheffield register, for the comptroller, the Patent Office, and the Register of Trade Marks, respectively; and notice of every entry, cancellation, or correction made in the Sheffield register shall be given to the comptroller by the Cutlers' Company: Provided that this section shall not affect any life estate and interest of a widow of the holder of any Sheffield mark which may be in force in respect of such mark at the time when it shall be placed upon the Sheffield register."

(4) To the same section the following sub-sections shall be added; namely—

(14.) For the purposes of this section the expression "metal goods" means all metals, whether wrought, unwrought, or partly wrought, and all goods composed wholly or partly of any metal.

(15.) For the purpose of legal proceedings in relation to trade marks entered in the Sheffield register a certificate under the hand of the master of the Cutlers' Company shall have the same effect as the certificate of the comptroller.

s. 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."

s. 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."

s. 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."

s. 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 connection 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 authorised 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 authorised 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."

Jurisdiction of Lancashire Palatine Court.

26. After section one hundred and twelve of the principal Act the following section shall be added and numbered 112A; namely,

"The Court of Chancery of the County Palatine of Lancaster shall, with respect to any action or other proceeding in relation to

trade marks the registration whereof is applied for in the Manchester office, have the like jurisdiction under this Act as her Majesty's High Court of Justice in England, and the expression 'the Court' in this Act shall be construed and have effect accordingly.

"Provided that every decision of the Court of Chancery of the County Palatine of Lancaster in pursuance of this section shall be subject to the like appeal as decisions of that Court in other cases."

Construction of principal Act.

27. The principal Act shall, as from the commencement of this Act, take effect subject to the additions, omissions, and substitutions required by this Act, but nothing in this Act shall affect the validity of any act done, right acquired, or liability incurred before the commencement of this Act.

Commencement of Act.

28. This Act shall, except so far as is by this Act otherwise specially provided, commence and come into operation on the first day of January one thousand eight hundred and eighty-nine.

Short title.

29. This Act may be cited as the Patents, Designs, and Trade Marks Act, 1888, and this Act and the Patents, Designs, and Trade Marks Acts, 1883 to 1886, may be cited collectively as the Patents, Designs, and Trade Marks Acts, 1883 to 1888.

INTERNATIONAL CONVENTION FOR THE PROTECTION OF INDUSTRIAL PROPERTY.

SIGNED AT PARIS, MARCH 20, 1883.

RATIFICATIONS EXCHANGED AT PARIS, JUNE 6, 1884.

I.

International Convention.

SA Majesté le Roi des Belges, Sa Majesté l'Empereur du Brésil, Sa Majesté le Roi d'Espagne, le Président de la République Française, le Président de la République de Guatemala, Sa Majesté le Roi d'Italie, Sa Majesté le Roi des Pays-Bas, Sa Majesté le Roi de Portugal et des Algarves, le Président de la République de Salvador, Sa Majesté le Roi de Serbie, et le Conseil Fédéral de la Confederation Suisse,

Egalement animés du désir d'assurer, d'un common accord, une complète et efficace protection à l'industrie et au commerce des nationaux de leurs Etats respectifs et de contribuer à la garantie des droits des inventeurs et de la loyauté des transactions commerciales, ont résolu de conclure une Convention à cet effet at ont nommé pour leurs Plénipotentiaires, savoir:

Sa Majesté le Roi des Belges: M. le Baron Beyens, Grand Officier de son Ordre Royal de Léopold, Grand Officier de la Légion d'Honneur, &c., son Envoyé Extraordinaire et Ministre Plénipotentiaire à Paris;

Sa Majesté l'Empereur du Brésil: M. Jules Constant, Comte de Villeneuve, Membre du Conseil de Sa Majesté, son Envoyé Extraordinaire et Ministre Plénipotentiaire près Sa Majesté le Roi des Belges, Commandeur de l'Ordre du Christ, Officier de son Ordre de la Rose, Chevalier de la Légion d'Honneur, &c.;

Sa Majesté le Roi d'Espagne: Son Excellence M. le Duc de Fernán-Nuñez, de Montellano et del Arco, Comte de Cervellon,

INTERNATIONAL CONVENTION FOR THE PROTECTION OF INDUSTRIAL PROPERTY.

SIGNED AT PARIS, MARCH 20, 1883.

RATIFICATIONS EXCHANGED AT PARIS, JUNE 6, 1884.

I.

International Convention.

HIS Majesty the King of the Belgians, His Majesty the Emperor of Brazil, His Majesty the King of Spain, the President of the French Republic, the President of the Republic of Guatemala, His Majesty the King of Italy, His Majesty the King of the Netherlands, His Majesty the King of Portugal and the Argaves, the President of the Republic of Salvador, His Majesty the King of Servia, and the Federal Council of the Swiss Confederation,

Being equally animated with the desire to secure, by mutual agreement, complete and effectual protection for the industry and commerce of their respective subjects and citizens, and to provide a guarantee for the rights of inventors, and for the loyalty of commercial transactions, have resolved to conclude a Convention to that effect, and have named as their Plenipotentiaries, that is to say:—

His Majesty the King of the Belgians: the Baron Beyens, Grand Officer of His Majesty's Royal Order of Leopold, Grand Officer of the Legion of Honour, His Majesty's Envoy Extraordinary and Minister Plenipotentiary at Paris, &c.;

His Majesty the Emperor of Brazil: M. Jules Constant, Count de Villeneuve, member of His Majesty's Council, His Majesty's Envoy Extraordinary and Minister Plenipotentiary at the Court of His Majesty the King of the Belgians, Commander of the Order of Christ, Officer of His Majesty's Order of the Rose, Chevalier of the Legion of Honour, &c.;

His Majesty the King of Spain: His Excellency the Duke de Fernan-Nuñez, de Montellano et del Arco, Count de Cervellon,

Marquis de Almonacir, Grand d'Espagne de Première Classe, Chevalier de l'Ordre Insigne de la Toison d'Or, Grand-Croix de l'Ordre de Charles III., Chevalier de Calatrava, Grand-Croix de la Légion d'Honneur, &c., Sénateur du Royaume, son Ambassadeur Extraordinaire et Plénipotentiaire à Paris;

Le Président de la République Française: M. Paul Challemel-Lacour, Sénateur, Ministre des Affaires Etrangères; M. Hérisson, Député, Ministre du Commerce; M. Charles Jagerschmidt, Ministre Plénipotentiaire de Première Classe, Officier de l'Ordre National de la Légion d'Honneur, &c.;

Le Président de la République de Guatemala: M. Crisanto Medina, Officier de la Légion d'Honneur, &c., son Envoyé Extraordinaire et Ministre Plénipotentiaire à Paris;

Sa Majesté le Roi d'Italie, M. Constantin Ressman, Commandeur de ses Ordres des Saints Maurice et Lazare et de la Couronne d'Italie, Commandeur de la Légion d'Honneur, &c., Conseiller de l'Ambassade d'Italie à Paris;

Sa Majesté le Roi des Pays-Bas: M. le Baron de Zuylen de Nyevelt, Commandeur de son Ordre du Lion Néerlandais, Grand-Croix de son Ordre Grand Ducal de la Couronne de Chêne et du Lion d'Or de Nassau, Grand Officier de la Légion d'Honneur, &c., son Envoyé Extraordinaire et Ministre Plénipotentiaire à Paris;

Sa Majesté le Roi de Portugal et des Algarves: M. Jose da Silva Mendes Leal, Conseiller d'Etat, Pair du Royaume, Ministre et Secrétaire d'Etat Honoraire, Grand-Croix de l'Ordre de Saint-Jacques, Chevalier de l'Ordre de la Tour et de l'Epée de Portugal, Grand Officier de la Légion d'Honneur, &c., son Envoyé Extraordinaire et Ministre Plénipotentiaire à Paris; M. Fernand de Azevedo, Officier de la Légion d'Honneur, &c., Premier Secrétaire de la Légation de Portugal à Paris;

Le Président de la République de Salvador; M. Torres-Caïcedo, Membre Correspondant de l'Institut de France, Grand Officier de la Légion d'Honneur, &c., son Envoyé Extraordinaire et Ministre Plénipotentiaire à Paris;

Sa Majesté le Roi de Serbie: M. Sima M. Marinovitch, Chargé d'Affaires par intérim de Serbie, Chevalier de l'Ordre Royal de Takovo, &c.;

Et le Conseil Fédéral de la Confédération Suisse: M. Charles-Edouard Lardy, son Envoyé Extraordinaire et Ministre Plénipotentiaire à Paris; M. J. Weibel, Ingénieur à Genève, Président de la Section Suisse de la Commission Permanente pour la Protection de la Propriété Industrielle:

Lesquels, après s'être communiqué leurs pleins pouvoirs respectifs,

Marquis de Almonacir, Grandee of Spain First Class, Chevalier of the Distinguished Order of the Golden Fleece, Grand Cross of the Order of Charles III., Chevalier de Calatrava, Grand Cross of the Legion of Honour, Senator of the Kingdom, His Majesty's Ambassador Extraordinary and Plenipotentiary at Paris, &c. ;

The President of the French Republic : M. Paul Challemel-Lacour, Senator, Minister for Foreign Affairs ; M. Hérrison, Deputy, Minister of Commerce ; M. Charles Jagerschmidt, Minister Plenipotentiary of the First Class, Officer of the National Order of the Legion of Honour, &c. ;

The President of the Republic of Guatemala : M. Crisanto Medina, Officer of the Legion of Honour, his Envoy Extraordinary and Minister Plenipotentiary at Paris, &c. ;

His Majesty the King of Italy : M. Constantin Ressman, Commander of His Majesty's Orders of Saints Maurice and Lazarus, and of the Crown of Italy, Commander of the Legion of Honour, Councillor of the Italian Embassy at Paris, &c. ;

His Majesty the King of the Netherlands : the Baron de Zuylen de Nyevelt, Commander of His Majesty's Order of the Netherlands Lion, Grand Cross of His Majesty's Grand Ducal Order of the Oaken Crown, and of the Golden Lion of Nassau, Grand Officer of the Legion of Honour, His Majesty's Envoy Extraordinary and Minister Plenipotentiary at Paris, &c. ;

His Majesty the King of Portugal and the Algarves : M. Jose da Silva Mendes Leal, Councillor of State, Peer of the Realm, Minister and Honorary Secretary of State, Grand Cross of the Order of St. James, Chevalier of the Order of the Tower and Sword of Portugal, Grand Officer of the Legion of Honour, His Majesty's Envoy Extraordinary and Minister Plenipotentiary at Paris, &c. ; M. Fernand de Azevedo, Officer of the Legion of Honour, First Secretary of the Portuguese Legation at Paris, &c. ;

The President of the Republic of Salvador : M. Torres-Caïcedo, corresponding member of the French Institute, Grand Officer of the Legion of Honour, his Envoy Extraordinary and Minister Plenipotentiary at Paris, &c. ;

His Majesty the King of Servia : M. Sima M. Marinovitch, Chargé d'Affaires of Servia *ad interim*, Chevalier of the Royal Order of Takovo, &c. ;

And the Federal Council of the Swiss Confederation ; M. Charles Edouard Lardy, Envoy Extraordinary and Minister Plenipotentiary, at Paris, &c. ; M. J. Weibel, Engineer at Geneva, President of the Swiss Section of the Permanent Commission for the Protection of Industrial Property :

Who, having communicated to each other their respective full

trouvés en bonne et du forme, sont convenus des Articles suivants :—

ARTICLE I.

Les Gouvernements de la Belgique, du Brésil, de l'Espagne, de la France, du Guatemala, de l'Italie, des Pays-Bas, du Portugal, du Salvador, de la Serbie, et de la Suisse sont constitutés à l'état d'Union pour la protection de la Propriété Industrielle.

ARTICLE II.

Les sujets ou citoyens de chacun des Etats Contractants jouiront, dans tous les autres Etats de l'Union, en ce qui concerne les brevets d'invention, les dessins ou modèles industriels, les marques de fabrique ou de commerce et le nom commercial, des avantages, que les lois respectives accordent actuellement ou accorderont par la suite aux nationaux.

En conséquence, ils auront la même protection que ceux-ci et le même recours légal contre toute atteinte portée à leurs droits, sous réserve de l'accomplissement des formalités et des conditions imposées aux nationaux par la législation intérieure de chaque Etat.

ARTICLE III.

Sont assimilés aux sujets ou citoyens des Etats Contractants les sujets ou citoyens des Etats ne faisant pas partie de l'Union qui sont domiciliés ou ont des établissements industriels ou commerciaux sur le territoire de l'un des Etats de l'Union.

ARTICLE IV.

Celui qui aura régulièrement fait le dépôt d'úne demande de brevet d'invention, d'un dessin ou modèle industriel, d'une marque de fabrique ou de commerce, daus l'un des Etats Contractants, jouira, pour effectuer le dépôt dans les autres Etats, et sous réserve des droit de tiers, d'un droit de priorité pendant les délais déterminés ci-après.

En conséquence, le dépôt ultérieurement opéré dans l'un des autres Etats de l'Union avant l'expiration de ces délais ne pourra être invalidé par des faits accomplis dans l'intervalle, soit, notamment, par un autre dépôt, par la publication de l'invention ou son exploitation par un tiers, par la mise en vente d'exemplaires du dessin ou du modèle, par l'emploi de la marque.

powers, found in good and due form, have agreed upon the following Articles:—

Article I.

The Governments of Belgium, Brazil, Spain, France, Guatemala, Italy, Holland, Portugal, Salvador, Servia, and Switzerland constitute themselves into a Union for the Protection of Industrial Property.

Article II.

The subjects or citizens of 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.

Les délais de priorité mentionnés ci-dessus seront de six mois pour les brevets d'invention, et de trois mois pour les dessins ou modèles industriels, ainsi que pour les marques de fabrique ou de commerce. Ils seront augmentés d'un mois pour les pays d'outre-mer.

Article V.

L'introduction par le breveté, dans le pays où le brevet a été délivré, d'objets fabriqués dans l'un ou l'autre des Etats de l'Union, n'entraînera pas la déchéance.

Toutefois le breveté restera soumis à l'obligation d'exploiter son brevet conformément aux lois du pays où il introduit les objets brevetés.

Article VI.

Toute marque de fabrique ou de commerce régulièrement déposée dans le pays d'origine sera admise au dépôt et protégée telle quelle dans tous les autres pays de l'Union.

Sera considéré comme pays d'origine le pays où le déposant son principal établissement.

Si ce principal établissement n'est point situé dans un des pays de l'Union, sera considéré comme pays d'origine celui auquel appartient le déposant.

Le dépôt pourra être refusé, si l'objet pour lequel il est demandé est considéré comme contraire à la morale ou à l'ordre public.

Article VII.

La nature du produit sur lequel la marque de fabrique ou de commerce doit être apposée ne peut, dans aucun cas, faire obstacle au dépôt de la marque.

Article VIII.

Le nom commercial sera protégé dans tous les pays de l'Union sans obligation de dépôt, qu'il fasse ou non partie d'une marque de fabrique ou du commerce.

Article IX.

Tout produit portant illicitement une marque de fabrique ou de commerce, ou un nom commercial, pourra être saisi à l'importation dans ceux des Etats de l'Union dans lesquels cette marque ou ce nom commercial ont droit à la protection légale.

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.

La saisie aura lieu à la requête soit du Ministère Public, soit de la partie intéressée, conformément à la législation intérieure de chaque Etat.

Article X.

Les dispositions de l'Article précédent seront applicables à tout produit portant faussement, comme indication de provenance, le nom d'une localité déterminée, lorsque cette indication sera jointe à un nom commercial fictif ou emprunté dans une intention frauduleuse.

Est réputé partie intéressée tout fabricant ou commerçant engagé dans la fabrication ou le commerce de ce produit, et établi dans la localité faussement indiquée comme provenance.

Article XI.

Les Hautes Parties Contractantes s'engagent à accorder une protection temporaire aux inventions brevetables, aux dessins ou modèles industriels, ainsi qu'aux marques de fabrique ou de commerce, pour les produits que figureront aux Expositions Internationales officielles ou officiellement reconnues.

Article XII.

Chacune des Hautes Parties Contractantes s'engage à établir un service spécial de la Propriété Industrielle et un dépôt central, pour la communication au public des brevets d'invention, des dessins ou modèles industriels et des marques de fabrique ou de commerce.

Article XIII.

Un office international sera organisé sous le titre de "Bureau International de l'Union pour la Protection de la Propriété Industrielle."

Ce bureau, dont les frais seront supportés par les Administrations de tous les Etats Contractants, sera placé sous la haute autorité de l'Administration Supérieure de la Confédération Suisse, et fonctionnera sous sa surveillance. Les attributions en seront déterminées d'un commun accord entre les Etats de l'Union.

Article XIV.

La présente Convention sera soumise à des révisions périodiques en vue d'y introduire les améliorations de nature à perfectionner le système de l'Union.

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 recognised 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 organised 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.

A cet effet, des Conférences auront lieu successivement, dans l'un des Etats Contractants, entre les Délégués des dits Etats.

La prochaine réunion aura lieu en 1885, à Rome.

Article XV.

Il est entendu que les Hautes Parties Contractantes se réservent respectivement le droit de prendre séparément, entre elles, des arrangements particuliers pour la protection de la Propriété Industrielle, en tant que ces arrangements ne contreviendraient point aux dispositions de la présente Convention.

Article XVI.

Les Etats qui n'ont point pris part à la présente Convention seront admis à y adhérer sur leur demande.

Cette adhésion sera notifiée par la voie diplomatique au Gouvernement de la Confédération Suisse, et par celui-ci à tous les autres.

Elle emportera, de plein droit, accession à toutes les clauses et admission à tous les avantages stipulés par la présente Convention.

Article XVII.

L'exécution des engagements réciproques contenus dans la présente Convention est subordonnée, en tant que de besoin, à l'accomplissement des formalités et règles établies par les lois constitutionnelles de celles des Hautes Parties Contractantes qui sont tenues d'en provoquer l'application, ce qu'elles s'obligent à faire dans le plus bref délai possible.

Article XVIII.

La présente Convention sera mise à exécution dans le délai d'un mois à partir de l'échange des ratifications et demeurera en vigueur pendant un temps indéterminé, jusqu'à l'expiration d'une année à partir du jour où la dénonciation en sera faite.

Cette dénonciation sera adressée au Gouvernement chargé de recevoir les adhésions. Elle ne produira son effet qu'à l'égard de l'Etat qui l'aura faite, la Convention restant exécutoire pour les autres Parties Contractantes.

Article XIX.

La présente Convention sera ratifiée, et les ratifications en seront echangées à Paris, dans le délai d'un an au plus tard.

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.

En foi de quoi les Plénipotentiaires respectifs l'ont signée et y ont apposé leurs cachets.

Fait à Paris, le 20 Mars, 1883.

(Signé)

(L.S.) BEYENS.
(L.S.) VILLENEUVE.
(L.S.) Duc DE FERNAN-NUÑEZ.
(L.S.) P. CHALLEMEL-LACOUR.
(L.S.) CH. HÉRISSON.
(L.S.) CH. JAGERSCHMIDT.
(L.S.) CRISANTO-MEDINA.
(L.S.) RESSMAN.
(L.S.) Baron DE ZUYLEN DE NYEVELT.
(L.S.) JOSE DA SILVA MENDES LEAL.
(L.S.) F. D'AZEVEDO.
(L.S.) J.-M. TORRES-CAÏCEDO.
(L.S.) SIMA M. MARINOVITCH.
(L.S.) LARDY.
(L.S.) J. WEIBEL.

II.

Final Protocol.

Au moment de procéder, à la signature de la Convention conclue, à la date de ce jour, entre les Gouvernements de la Belgique, du Brésil, de l'Espagne, de la France, du Guatemala, de l'Italie, des Pays-Bas, du Portugal, du Salvador, de la Serbie, et de la Suisse, pour la protection de la Propriété Industrielle, les Plénipotentiaires soussignés sont convenus de ce qui suit :

1. Les mots "Propriété Industrielle" doivent être entendus dans leur acception la plus large, en ce sens qu'ils s'appliquent non seulement aux produits de l'industrie proprement dite, mais également aux produits de l'agriculture (vins, grains, fruits, bestiaux, &c.), et aux produits minéraux livrés au commerce (eaux minérales, &c.).

2. Sous le nom de "Brevets d'Invention" sont comprises les diverses espèces de brevets industriels admises par les législations des Etats Contractants, telles que brevets d'importation, brevets de perfectionnement, &c.

3. Il est entendu que la disposition finale de l'Article II. de la Convention ne porte aucune attiente à la législation de chacun des Etats Contractants, en ce qui concerne la procédure suive devant les Tribunaux et la compétence de ces Tribunaux.

In witness whereof the respective Plenipotentiaries have signed the same, and have affixed thereto their seals.

Done at Paris, the 20th March 1883.

(Signed)

(L.S.) Beyens.
(L.S.) Villeneuve.
(L.S.) Duc De Fernan-Nuñez.
(L.S.) P. Challemel-Lacour.
(L.S.) Ch. Hérisson.
(L.S.) Ch. Jagerschmidt.
(L.S.) Crisanto-Medina.
(L.S.) Ressman.
(L.S.) Baron De Zuylen De Nyevelt.
(L.S.) Jose Da Silva Mendes Leal.
(L.S.) F. D'Azevedo.
(L.S.) J.-M. Torres-Caïcedo.
(L.S.) Sima M. Marinovitch.
(L.S.) Lardy.
(L.S.) J. Weibel.

II.

Final Protocol.

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. Le paragraphe 1er de l'Article VI. doit être entendu en ce sens qu'aucune marque de fabrique ou de commerce ne pourra être exclue de la protection dans l'un des Etats de l'Union par le fait seul qu'elle ne satisferait pas, au point de vue des signes qui la composent, aux conditions de la législation de cet Etat, pourvu qu'elle satisfasse, sur ce point, à la législation du pays d'origine et qu'elle ait été, dans ce dernier pays, l'object d'un dépôt régulier. Sauf cette exception, qui ne concerne que la forme de la marque, et sous reserve des dispositions des autres Articles de la Convention, la législation intérieure de chacun des Etats recevra son application.

Pour éviter toute fausse interprétation, il est entendu que l'usage des armoiries publiques et des décorations peut être considéré comme contraire à l'ordre public, dans le sens du paragraphe final de l'Article VI.

5. L'organisation du service spécial de la Propriété Industrielle mentionné à l'Article XII. comprendra, autant que possible, la publication, dans chaque Etat d'une feuille officielle périodique.

6. Les frais communs de Bureau International institué par l'Article XIII. ne pourront, en aucun cas, dépasser, par année, une somme totale représentant une moyenne de 2000 fr. par chaque Etat Contractant.

Pour déterminer la part contributive de chacun des Etats dans cette somme totale des frais, les Etats Contractants et ceux qui adhéreraient ultérieurement à l'Union seront divisés en six classes contribuant chacune dans la proportion d'un certain nombre d'unités, savoir :—

1e classe	25 unités.
2e classe	20 „
3e classe	15 „
4e classe	10 „
5e classe	5 „
6e classe	3 „

Ces coefficients seront multipliés par le nombre des Etats de chaque classe, et la somme des produits ainsi obtenus fournira le nombre d'unités par lequel la dépense totale doit être divisée. Le quotient donnera le montant de l'unité de dépense.

Les Etats Contractants sont classés ainsi qu'il suit, en vue de la répartition des frais :—

1e classe	France, Italie.
2e classe	Espagne.
3e classe	Belgique, Brésil, Portugal, Suisse.
4e classe	Pays-Bas.
5e classe	Serbie.
6e classe	Guatémala, Salvador.

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 organisation 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 representing an average of 2000 fr. for each Contracting State.

To determine the part which each State should contribute to this total of expenses, the Contracting States, and those which may afterwards join the Union, shall be divided into six classes, each contributing the proportion of a certain number of units, namely:—

1st class	25 units.
2nd class	20 „
3rd class	15 „
4th class	10 „
5th class	5 „
6th class	3 „

These co-efficients will be multiplied by the number of States in each class, and the sum of the result thus obtained will supply the number of units by which the total expense has to be divided. The quotient will give the amount of the unit of expense.

The Contracting States are classed as follows, with regard to the division of expense:—

1st class	France, Italy.
2nd class	Spain.
3rd class	Belgium, Brazil, Portugal, Switzerland.
4th class	Holland.
5th class	Servia.
6th class	Guatemala, Salvador.

L'Administration Suisse surveillera les dépenses du Bureau International, fera les avances nécessaires et établira le compte annuel, qui sera communiqué à toutes les autres Administrations.

Le Bureau International centralisera les renseignements de toute nature relatifs à la protection de la Propriété Industrielle et les réunira en une statisque générale qui sera distribuée à toutes les Administrations. Il procédera aux études d'utilité commune intéressant l'Union et rédigera, à l'aide des documents qui seront mis à sa disposition par les diverses Administrations, une feuille périodique, en langue Française, sur les questions concernant l'objet de l'Union.

Les numéros de cette feuille, de même que tous les documents publiés par le Bureau International, seront répartis entre les Administrations des Etats de l'Union, dans la proportion du nombre des unités contributives ci-dessus mentionnées. Les exemplaires et documents supplémentaires qui seraient réclamés, soit par les dites Administrations, soit par des Sociétés ou des particuliers, seront payés à part.

Le Bureau International devra se tenir en tout temps à la disposition des membres de l'Union, pour leur fournir, sur les questions relatives au service international de la Propriété Industrielle, les renseignements spéciaux, dont ils pourraient avoir besoin.

L'Administration du pays où doit siéger la prochaine Conférence préparera avec le concours du Bureau International, les travaux de cette Conférence.

Le Directeur du Bureau International assistera aux séances des Conférences et prendra part aux discussions sans voix délibérative. Il fera, sur sa gestion, un Rapport annuel, qui sera communiqué à tous les membres de l'Union.

La langue officiel du Bureau International sera la langue Française.

7. Le présent Protocole de Clôture, qui sera ratifié en même temps que la Convention conclue à la date de ce jour, sera considéré comme faisant partie intégrante de cette Convention, et aura même force, valeur et durée.

En foi de quoi, les Plénipotentiaires soussignés ont dressé le présent Protocole.

(Signé) BEYENS.
RESSMAN.
VILLENEUVE.
Baron DE ZUYLEN DE NYEVELT.
Duc DE FERNAN-NUÑEZ.
JOSE DA SILVA MENDES LEAL.
P. CHALLEMEL-LACOUR.
F. D'AZEVEDO.
CH. HÉRISSON.
J.-M. TORRES-CAÏCEDO.
CH. JAGERSCHMIDT.
SIMA M. MARINOVITCH.
CRISANTO-MEDINA.
LARDY.
J. WEIBEL.

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 centralise information of every kind relating to the protection of Industrial Property, and will bring it together in the form of a general statistical statement, which will be distributed to all the Administrations. It will interest itself in all matters of common utility to the Union, and will edit, with the help of the documents supplied to it by the various Administrations, a periodical paper in the French language dealing with questions regarding the object of the Union.

The numbers of this paper, as well as all the documents published by the International Office, will be circulated among the Administrations of the States of the Union in the proportion of the number of contributing units as mentioned above. Such further copies as may be desired, either by the said Administrations or by Societies or private persons, will be paid for separately.

The International Office shall at all times hold itself at the service of members of the Union, in order to supply them with any special information they may need on questions relating to the international system of Industrial Property.

The Administration of the country in which the next Conference is to be held will make preparations for the transactions of that Conference, with the assistance of the International Office.

The Director of the International Office will be present at the meetings of the Conferences, and will take part in the discussions, but without the privilege of voting.

He will furnish an annual Report upon his administration of the office, which shall be communicated to all the members of the Union.

The official language of the International Office will be French.

7. The present Final Protocol, which shall be ratified, together with the Convention concluded this day, shall be considered as forming an integral part of, and shall have the same force, validity, and duration as the said Convention.

In witness whereof, the undersigned Plenipotentiaries have drawn up the present Protocol.

(Signed) BEYENS.
RESSMAN.
VILLENEUVE.
Baron DE ZUYLEN DE NYEVELT.
Duc DE FERNAN-NUÑEZ.
JOSE DA SILVA MENDES LEAL.
P. CHALLEMEL-LACOUR.
F. D'AZEVEDO.
CH. HÉRISSON.
J.-M. TORRES-CAÏCEDO.
CH. JAGERSCHMIDT.
SIMA M. MARINOVITCH.
CRISANTO-MEDINA.
LARDY.
J. WEIBEL.

III.

Accession of Her Majesty's Government to the Convention signed at Paris, March 20, 1883.

The Undersigned, Ambassador Extraordinary and Plenipotentiary of her Majesty the Queen of the United Kingdom of Great Britain and Ireland to the French Republic, declares that her Britannic Majesty, having had the International Convention for the Protection of Industrial Property, concluded at Paris on the 20th March 1883, and the Protocol relating thereto, signed on the same date, laid before her, and availing herself of the right reserved by Article XVI. of that Convention to States not parties to the original Convention, accedes, on behalf of the United Kingdom of Great Britain and Ireland, to the said International Convention for the Protection of Industrial Property, and to the said Protocol, which are to be considered as inserted word for word in the present Declaration, and

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IV.

Declaration of Acceptance of Accession.

Sa Majesté la Reine du Royaume Uni de la Grande-Bretagne et d'Irlande ayant accédé à la Convention Internationale, relative à la protection de la Propriété Industrielle, conclue à Paris le 20 Mars 1883, et suivie d'un Protocol en date du même jour, en vertu de l'Acte d'Accession délivré par son Ambassadeur Extraordinaire et Plénipotentiaire près le Gouvernement de la République Française; acte dont la teneur suit ici, mot pour mot:—

(Here is inserted the text of No. III. in English.)

Le Président de la République Française a autorisé le Soussigné, Président du Conseil, Ministre des Affaires Etrangères, à accepter formellement la dite accession, y compris les réserves qui y sont contenues, concernant l'Ile de Man, les Iles de la Manche et toutes autre possession de Sa Majesté Britannique, s'engageant, tant en son nom qu'au nom des autres Hautes Parties Contractantes, à concourir à l'accomplissement des obligations stipulées dans la Convention et le Protocole y annexé, qui pourront concerner le Royaume Uni de la Grande-Bretagne et d'Irlande.

En foi de quoi, le Soussigné, dûment autorisé, a dressé le présent Acte d'Acceptation et y a fait apposer son cachet.

Fait à Paris, le 2 Avril 1884.

(L.S.) (Signé) JULES FERRY.

formally engages as far as regards the President of the French Republic and the other High Contracting Parties to co-operate on her part in the execution of the stipulations contained in the Convention and Protocol aforesaid.

The Undersigned makes this Declaration on the part of her Britannic Majesty with the express understanding that power is reserved to her Britannic Majesty to accede to the Convention on behalf of the Isle of Man and the Channel Islands, and any of her Majesty's possessions, on due notice to that effect being given through her Majesty's Government.

In witness whereof the Undersigned, duly authorised, has signed the present Declaration of Accession, and has affixed thereto the seal of his arms.

Done at Paris, on the 17th day of March 1884.

(L.S.) (Signed) LYONS.

IV.

Declaration of Acceptance of Accession.

Her Majesty the Queen of the United Kingdom of Great Britain and Ireland, having acceded to the International Convention relative to the Protection of Industrial Property, concluded at Paris, March 20, 1883, together with a Protocol dated the same day, by the Declaration of Accession delivered by her Ambassador Extraordinary and Plenipotentiary to the Government of the French Republic, the text of which Declaration is word for word as follows :—

(Here is inserted the text of No. III. in English.)

The President of the French Republic has authorised the Undersigned, President of the Council, Minister for Foreign Affairs, to formally accept the said Accession, together with the reserves which are contained in it concerning the Isle of Man, the Channel Islands, and all other possessions of her Britannic Majesty, engaging as well in his own name, as in that of the other High Contracting Parties, to assist in the accomplishment of the obligations stipulated in the Convention and the Protocol thereto annexed, which may concern the United Kingdom of Great Britain and Ireland.

In witness whereof the Undersigned, duly authorised, has drawn up the present Declaration of Acceptance, and has affixed thereto his seal.

Done at Paris, the 2nd April 1884.

(L.S.) (Signed) JULES FERRY.

PATENTS RULES, 1890.

By virtue of the provisions of the Patents, Designs, and Trade Marks Acts, 1883 to 1888, the Board of Trade do hereby make the following rules:—

Short Title.

Short title. 1. These rules may be cited as the Patents Rules, 1890.

Commencement.

Commencement. 2. These Rules shall come into operation from and immediately after the 31st day of March 1890.

Interpretation.

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.

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.

Forms.

Forms. Alterations. 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.(*a*)

Application. 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.(*b*)

Specification. (2.) The Form B (*c*) in such Schedule of provisional specification and the Form C (*d*) of complete specification shall respectively be used.

(*a*) pp. 744–751 *post.* (*b*) pp. 744–748 *post.*
(*c*) p. 750 *post.* (*d*) p. 751 *post.*

(3.) The remaining forms other than A, A1, A2, B, and C, set forth in the Second Schedule to these Rules, may, as far as they are applicable, be used in any proceedings under these Rules.(e) Other forms.

General.

7. The Patent Office shall be open to the public every week-day between the hours of ten and four, except on the days and times following :— Hours of business.

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.

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. Agency.

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. Statement of address.

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.* Size, &c., of documents.

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 Exercise of discretionary power by Comptroller. Notice of hearing.

(e) pp. 752–771 *post*.

the Comptroller. Statutory declarations and affidavits shall be in the form for the time being in use in the High Court of Justice.

Notice by applicant.

12. Within five days from the date when such notice would be delivered in the ordinary course of post, or such longer time as the Comptroller may appoint in such notice, the applicant shall notify in writing to the Comptroller whether or not he intends to be heard upon the matter.

Comptroller may require statement, &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.

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.

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:— Manner in which, and persons before whom, declaration is to be taken.

(*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.

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. Order of recording applications.

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.

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. Application for separate patents by way of amendment.

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.

20. An application for a patent by the legal representative of a person who has died possessed of an invention shall be accompanied Application by representative of deceased inventor.

by an official copy of or extract from his will, or the letters of administration granted of his estate and effects in proof of the applicant's title as such legal representative, and must be supported by such further evidence as the Comptroller may require.

Notice and advertisement of acceptance.

21. On the acceptance of a provisional or complete specification the Comptroller shall give notice thereof to the applicant, and shall advertise such acceptance in the official journal of the Patent Office.

Inspection on acceptance of complete specification.

22. Upon the publication of such advertisement of acceptance in the case of a complete specification, the application and specification or specifications with the drawings (if any) may be inspected at the Patent Office upon payment of the prescribed fee.

Application on Communication from Abroad.

Communication from abroad.

23. An application for a patent for an invention communicated from abroad shall be made in the form A 1 set forth in the Second Schedule to these Rules.

International and Colonial Arrangements.

24. The term "foreign application" shall mean an application by any person for protection of his invention in a foreign State or British Possession to which by any Order of her Majesty in Council for the time being in force the provisions of section 103 of the Patents, Designs, and Trade Marks Act, 1883, have been declared applicable.

25. An application in the United Kingdom for a patent for any invention in respect of which a foreign application has been made shall contain a declaration that such foreign application has been made and shall specify all the foreign States or British Possessions in which foreign applications have been made and the official date or dates thereof respectively. The application must be made within seven months from the date of the first foreign application, and must be signed by the person or persons by whom such first foreign application was made. If such person, or any of such persons, be dead, the application must be signed by the legal personal representative of such dead person, as well as by the other applicants, if any.

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.

Drawings for specifications.

30. The provisional or complete specification need not be accompanied by drawings if the specification sufficiently describes the invention without them, but if drawings are furnished, they should accompany the provisional or complete specification to which they refer, except in the case provided for by Rule 33. No drawing or sketch such as requires a special engraving for 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 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.

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.(*f*) 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 shown 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 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, 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.

Restrictions as to wood engravings.

Wood engravings, or representations of the invention, other than the drawings prepared as above described, will not be received, unless of such a character as to be suitable for reproduction by the process of photo-lithography.

Copies of drawings.

32. A *facsimile* of the original drawings, but *without* colour or Indian-ink washes, and prepared strictly in accordance with the regulations prescribed in Rule 31, must accompany the originals, and be marked "True copy."

Provisional

33. If an applicant desires to adopt the drawings lodged with his

(*f*) See Official Rules.

provisional specification as the drawings for his complete specification, he should refer to them as those "left with the provisional specification." drawings used for complete specification.

Opposition to Grants of Patents.

34. A notice of opposition to the grant of a patent shall be on Form D,(*g*) 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.

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. Applicant's evidence. 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.

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. Closing of evidence.

40. Either party making such application shall give notice thereof to the opposite party, who shall be entitled to oppose the application.

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 Notice of hearing.

(*g*) p. 752 *post*.

such appointment. If the applicant or opponent desires to be heard he must forthwith send the Comptroller an application on Form E.(*h*) The Comptroller may refuse to hear either party who has not sent such application for hearing. If neither party applies to be heard the Comptroller shall decide the case and notify his decision to the parties.

Disallowance of opposition in certain cases.

42. On the hearing of the case no opposition shall be allowed in respect of any ground not stated in the notice of opposition, and where the ground or one of the grounds is that the invention has been patented in this country on an application of prior date, the opposition shall not be allowed upon such ground unless the number and date of such prior application shall have been duly specified in the notice of opposition.

43. Where the ground of an opposition is that the applicant has obtained the invention from the opponent, or from a person of whom such opponent is the legal representative, unless evidence in support of such allegation be left at the Patent Office within the time prescribed by these Rules, the opposition shall be deemed to be abandoned, and a patent shall be sealed forthwith.

Decision to be notified to parties.

44. The decision of the Comptroller, after hearing any party who applies under Rule 41, shall be notified by him to the parties.

Certificates of Payment or Renewal.

Payment of fees of 50*l.* and 100*l.* for continuance of patent.

45. If a patentee intends at the expiration of the fourth or eighth year from the date of his patent to keep the same in force, he shall, before the expiration of such fourth or eighth year, as the case may be, subject as hereinafter provided, pay the prescribed fee of 50*l.* or 100*l.*, as the case may be.

As to patents granted before commencement of Act.

46. In the case of patents granted before the commencement of the said Acts, the above Rule shall be read as if the words "seventh year" were therein written instead of the words "eighth year."

Payment of annual fees in lieu of 50*l.* and 100*l.*

47. If the patentee intends to pay annual fees in lieu of the above-mentioned fees of 50*l.* and 100*l.*, he shall, before the expiration of the fourth and each succeeding year during the term of the patent, until and inclusive of the 13th year thereof, pay the prescribed fee.

The form J (*i*) in the Second Schedule, duly stamped, should be used for the purpose of this and the patent referred to in Rule 45.

Certificate of payment.

48. On due compliance with these Rules, and as soon as may be after such respective periods as aforesaid, or any enlargement

(*h*) p. 753 *post.* (*i*) p. 759 *post.*

thereof respectively duly granted, the Comptroller shall issue a certificate that the prescribed payment has been duly made.

Enlargement of Time.

Enlargement of time for payments.

49. An application for an enlargement of the time for making a prescribed payment shall state in detail the circumstances in which the patentee by accident, mistake, or inadvertence has failed to make such payment, and the Comptroller may require the patentee to substantiate by such proof as he may think necessary the allegations contained in the application for enlargement.

Extension of time for leaving and accepting complete specification.

50. An application for enlargement of time for leaving or accepting a complete specification shall state in detail in what circumstances and upon what grounds such extension is applied for, and the Comptroller may require the applicant to substantiate such allegations by such proof as the Comptroller may think necessary.

In other cases.

51. The time prescribed by these Rules for doing any act, or taking any proceeding thereunder, may be enlarged by the Comptroller if he thinks fit, and upon such notice to other parties, and proceedings thereon, and upon such terms, as he may direct.

Amendment of Specification.

Request for leave to amend.

52. A request for leave to amend a specification must be signed by the applicant or patentee (hereinafter in Rules 54, 55, and 58 called the applicant) and accompanied by a duly certified printed copy of the original specification and drawings, showing in red ink the proposed amendment, and shall be advertised by publication of the request and the nature of the proposed amendment in the official journal of the Patent Office, and in such other manner (if any) as the Comptroller may in each case direct.

Advertisement.

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 Licences.

Petition for compulsory grant of licences.

60. A petition to the Board of Trade for an order upon a patentee to grant a licence shall show 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,

Petitioner's evidence.

deliver to the patentee copies of the petition and of the affidavits or statutory declarations and other documentary evidence (if any) tendered in support thereof.

Patentee's evidence.

64. Within 14 days after the day of such delivery the patentee shall leave at the Patent Office his affidavits or statutory declarations in opposition to the petition, and deliver copies thereof to the petitioner.

Evidence in reply.

65. The petitioner within 14 days from such delivery shall leave at the Patent Office his affidavits or statutory declarations in reply,

and deliver copies thereof to the patentee; such last-mentioned affidavits or declarations shall be confined to matters strictly in reply.

Further proceedings.

66. Subject to any further directions which the Board of Trade may give, the parties shall then be heard at such time, before such person or persons, in such manner, and in accordance with such procedure as the Board of Trade may, in the circumstances of the case, direct, but so that full opportunity shall be given to the patentee to show cause against the petition.

Register of Patents.

Entry of grant.

67. Upon the sealing of a patent the Comptroller shall cause to be entered in the Register of Patents the name, address, and description of the patentee as the grantee thereof, and the title of the invention.

Request for entry of subsequent proprietorship.

68. Where a person becomes entitled to a patent, or to any share or interest therein, by assignment either throughout the United Kingdom and the Isle of Man, or for any place or places therein, or by transmission or other operation of law, a request for the entry of his name in the register as such complete or partial proprietor of the patent, or of such share or interest therein, as the case may be, shall be addressed to the Comptroller, and left at the Patent Office.

Signature of request.

69. Such request shall in the case of individuals be made and signed by the person requiring to be registered as proprietor, or by his agent duly 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 show 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 described, 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 the proprietor by its corporate name.

Entry of Orders of the Privy Council or of the Court.

74. Where an Order has been made by her Majesty in Council for the extension of a patent for a further term, or for the grant of a new patent, or where an Order has been made by the Court for the revocation of a patent or the rectification of the register, under section 90 of the Act of 1883, or otherwise affecting the validity or proprietorship of the patent, the person in whose favour such Order has been made shall forthwith leave at the Patent Office an office copy of such Order. The register shall thereupon be rectified, or the purport of such Order shall otherwise be duly entered in the register, as the case may be.

Entry of payment of fees on issue of certificate.

75. Upon the issue of a certificate of payment under Rule 48, the Comptroller shall cause to be entered in the Register of Patents a record of the amount and date of payment of the fee on such certificate.

Entry of failure to pay fees.

76. If a patentee fails to make any prescribed payment within the prescribed time or any enlargement thereof duly granted, such failure shall be duly entered in the register.

Entry of licences.

77. An attested copy of every licence 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 licence 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.

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. Certified copies of documents.

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 shown 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 Act, 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.

RULES REGULATING THE PRACTICE AND PROCEDURE ON APPEAL TO THE LAW OFFICERS.

I. When any person intends to appeal to the law officer from a decision of the Comptroller in any case in which such appeal is given by the Acts, he shall within fourteen days from the date of the decision appealed against file in the Patent Office a notice of such his intention.

II. Such notice shall state the nature of the decision appealed against, and whether the appeal is from the whole, or part only, and if so, what part of such decision.

III. A copy of such notice of intention to appeal shall be sent by the party so intending to appeal to the law officers' clerk, at Room 549, Royal Courts of Justice, London; and when there has been an opposition before the Comptroller, to the opponent or opponents; and when the Comptroller has refused to seal a patent on the ground that a previous application for a patent for the same invention is pending, to the prior applicant.

IV. Upon notice of appeal being filed, the Comptroller shall forthwith transmit to the law officers' clerk all the papers relating to the matter of the application in respect of which such appeal is made.

V. No appeal shall be entertained of which notice is not given within fourteen days from the date of the decision appealed against, or such further time as the Comptroller may allow, except by special leave, upon application to the law officer.

VI. Seven days' notice, at least, of the time and place appointed for the hearing of any appeal, shall be given by the law officers' clerk unless special leave be given by the law officer that any shorter notice be given.

VII. Such notice shall in all cases be given to the Comptroller and the appellant; and, when there has been an opposition before the Comptroller, to the opponent or opponents; and, when the Comptroller has refused to seal a patent on the ground that an application for a patent for the same invention is pending, to the prior applicant.

VIII. The evidence used on appeal to the law officer shall be the same as that used at the hearing before the Comptroller; and no further evidence shall be given, save as to matters which have occurred or come to the knowledge of either party, after the date of the decision appealed against, except with the leave of the law officer upon application for that purpose.

IX. The law officer shall, at the request of either party, order the attendance at the hearing on appeal, for the purpose of being cross-examined, of any person, who has made a declaration, in the matter to which the appeal relates, unless in the opinion of the law officer there is good ground for not making such order.

X. Any person requiring the attendance of a witness for cross-examination shall tender to the witness whose attendance is required a reasonable sum for conduct-money.

XI. Where the law officer orders that costs shall be paid by any party to another he may fix the amount of such costs, and if he shall not think fit to fix the amount thereof, he shall direct by whom and in what manner the amount of such costs shall be ascertained.

XII. If any costs so ordered to be paid be not paid within fourteen days after the amount thereof has been so fixed or ascertained, or such shorter period as shall be directed by the law officer, the party to whom such costs are to be paid may apply to the law officer for an order for payment under the provisions of section 38 of the Act.

XIII. All documentary evidence required, or allowed by the law officer to be filed, shall be subject to the same regulations, in all respects, as apply to the procedure before the Comptroller, and shall be filed in the Patent Office, unless the law officer shall order to the contrary.

XIV. Any notice or other document required to be given to the law officers' clerk, under these Rules, may be sent by a prepaid letter through the post.

HENRY JAMES, A.-G.
FARRER HERSCHELL, S.-G.

PATENT CASES BEFORE THE JUDICIAL COMMITTEE.

NOTE.—*The following Rules must be considered as repealed in so far as they are at variance with the Privy Council Rules*, 1898.(*a*)

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.

RULE I.

A party intending to apply by petition, under section 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.

RULE II.

A party intending to apply by petition, under section 4 of the said Act, shall, in the advertisements directed to be published by

(*a*) p. 731 *post*.

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.

Rule III.

Petitions under section 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*.

Rule IV.

All petitions must be accompanied with affidavits of advertisements having been inserted according to the provisions of section 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 petitioner.

Rule V.

All persons entering *caveats* under section 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 section 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.

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.

Rule VII.

Parties may have copies of all papers lodged in respect of any application under the said Act, at their own expense.

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.

Rule IX.

A party applying for an extension of a patent, under section 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 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.

PRIVY COUNCIL RULES, 1898.

ORDER IN COUNCIL.

Whereas by the 25th section of an Act of Parliament passed in the 46th and 47th years of her Majesty's reign, intituled "The Patents, Designs, and Trade Marks Act, 1883," it is amongst other things enacted that a patentee may, after advertising in manner directed by any rules made under the said section his intention to do so, present a petition to her Majesty in Council, praying that his patent may be extended for a further term, but such petition must be presented at least six months before the time limited for the expiration of the patent; that if her Majesty shall be pleased to refer any such petition to the Judicial Committee of the Privy Council the said Committee shall proceed to consider the same; and that it shall be lawful for her Majesty in Council to make from time to time rules of procedure and practice for regulating the proceedings on such petitions, and subject thereto such proceedings shall be regulated according to the existing *procedure and practice in patent matters of the Judicial Committee*:

And whereas her Majesty in Council has deemed it expedient to make rules for regulating proceedings in such petitions:

Her Majesty is therefore pleased by and with the advice of her Privy Council to approve of the several rules and regulations contained in the Schedule hereunto annexed, and to order as it is hereby ordered that on and after January 1, 1898, the same be respectfully observed.

Whereof all persons whom it may concern are to take notice and govern themselves accordingly.

C. L. PEEL.

THE SCHEDULE ABOVE REFERRED TO.

Rules to be observed in Proceedings before the Judicial Committee of the Privy Council under the Patents, Designs, and Trade Marks Act, 1883, section 25.

I.

A party intending to apply by petition under section 25 of the Act shall give public notice by advertising three times in the *London Gazette*, and once at least in each of three London newspapers.

If the applicant's principal place of business is situated in the United Kingdom, at a distance of fifteen miles or more from Charing Cross, he shall also advertise once at least in some local newspaper published or circulating in the town or district where such place of business is situated. If the applicant has no place of business, then, if he carries on the manufacture of anything made under his specification at a distance of fifteen miles or more from Charing Cross, he shall advertise once at least in some local newspaper published or circulating in the town or district where he carries on such manufacture. If he has no place of business and carries on no such manufacture, then, if he resides at a distance of fifty miles or more from Charing Cross, he shall advertise once at least in some newspaper published or circulating in the town or district where he resides.

The applicant shall in his advertisements state the object of his petition, and shall give notice of the day on which he intends to apply for a time to be fixed for hearing the matter thereof, which day shall not be less than four weeks from the date of the publication of the last of the advertisements to be inserted in the *London Gazette*. He shall also give notice that *caveats* must be entered at the Council Office on or before such day so named in the said advertisements.

II.

A petition under section 25 of the Act must be presented within one week from the publication of the last of the advertisements required to be published in the *London Gazette*.

The petition must be accompanied with an affidavit or affidavits of advertisements having been published according to the requirements of the 1st of these Rules. The statements contained in such affidavit or affidavits may be disputed upon the hearing.

The petitioner shall apply to the Lords of the Committee to fix a time for hearing the petition, and when such time is fixed the petitioner shall forthwith give public notice of the same by advertising once at least in the *London Gazette* and in two London newspapers.

III.

A party presenting a petition under section 25 of the Act must lodge at the Council Office eight printed copies of the specification: but if the specification has not been printed, and if the expense of making eight copies of any drawing therein contained or referred to would be considerable, the lodging of two copies only shall be deemed sufficient.

The petitioner shall also lodge at the Council Office eight 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. He shall also furnish three copies of the said balance-sheet for the use of the Solicitor to the Treasury, and shall upon receiving two days' notice give the Solicitor to the Treasury or any person deputed by him for the purpose reasonable facilities for inspecting and taking extracts from the books of account by reference to which he proposes to verify the said balance-sheet at the hearing, or from which the materials for making up the said balance-sheet have been derived.

All copies mentioned in this Rule must be lodged and furnished not less than fourteen days before the day fixed for the hearing.

IV.

A party intending to oppose a petition under section 25 of the Act must enter a *caveat* at the Council Office before the day on which the petitioner applies for a time to be fixed for hearing the matter thereof, and having entered such *caveat* shall be entitled to have from the petitioner four weeks' notice of the time appointed for the hearing.

The petitioner shall serve copies of his petition on all parties entering *caveats* in accordance with this Rule, and no application to fix a time for hearing shall be made without affidavit of such service.

All parties intending to oppose a petition shall within three weeks after such copies are served on them respectively lodge at the Council Office eight printed copies of the grounds of their objections to the granting of the prayer of the petition.

V.

Parties shall be entitled to have copies of all papers lodged in respect of any petition under section 25 of the Act at their own expense.

All such petitions and all statements of grounds of objection shall be printed in the form prescribed by the Rules which apply to proceedings before the Judicial Committee of the Privy Council. Balance-sheets of expenditure and receipts shall be printed in a form convenient for binding along with such petitions.

VI.

Costs incurred in the matter of any petition under section 25 of the Act shall be taxed by the Registrar of the Privy Council, or

other officer deputed by the Lords of the Judicial Committee of the Privy Council to tax the costs in the matter of any petition, and the Registrar or such other officer shall have authority to allow or disallow in his discretion all payments made to persons of science or skill examined as witnesses.

VII.

The Lords of the Committee may excuse petitioners and opponents from compliance with any of the requirements of these Rules, and may give such directions in matters of procedure and practice under section 25 of the Act as they shall consider to be just and expedient.

VIII.

The Lords of the Committee will hear the Attorney-General or other counsel on behalf of the Crown on the question of granting the prayer of any petition under section 25 of the Act. The Attorney-General is not required to give notice of the grounds of any objection he may think fit to take or of any evidence which he may think fit to place before the Lords of the Committee.

REGISTER OF PATENT AGENTS RULES, 1889.

For the purpose of giving effect to the provisions of the Patents, Designs, and Trade Marks Act, 1888, relating to the registration of patent agents, the Board of Trade, by virtue of the provisions of the said Act, hereby make the following Rules :—

Register to be kept.

1. A Register shall be kept by the Institute of Patent Agents, 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.

Contents of Register.

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 person, 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.,(*a*) with such variations as may be required.

Printed copies to be published annually, and to be evidence of contents of Register.

3. The Institute shall cause a correct copy of the Register to be, once every year, printed, under their direction, and published and placed on sale. Such correct copy shall, in the year 1889, be printed and published at as early a date as is possible, and in every year subsequent to the year 1889, shall be printed and published on the 31st day of January. A copy of the Register for the time being purporting to be so printed and published shall be admissible as evidence of all matters stated therein, and the absence of the name of any person from the Register shall be evidence, until the contrary is made to appear, that such person is not registered in pursuance of the Act.

Registrar.

4. The Institute shall appoint a Registrar, who shall keep the

(*a*) p. 772 *post*.

Register in accordance with the provisions of the Act, and these Rules, and, subject thereto, shall act under the directions of the Institute, and the Board of Trade.

Registration of persons who were patent agents prior to the passing of this Act.

5. A person who is desirous of being registered in pursuance of the Act, on the ground that prior to the passing of the Act he had been *bonâ fide* practising as a patent agent, shall produce or transmit to the Board of Trade a statutory declaration in the Form 2 in Appendix A.; (*b*) 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.

Final qualifying examination for registration.

6. Subject to the provisions of the Act in favour of every person who proves to the satisfaction of the Board of Trade that prior to the passing of the Act he had been *bonâ fide* practising as a patent agent, no person shall be entitled to be registered as a patent agent, unless he has passed, and produces or transmits to the Registrar a certificate under the seal of the Institute that he has passed, such final examination as to his knowledge of patent law and practice and of the duties of a patent agent as the Institute shall from time to time prescribe.

Exemption of pupils and assistants from preliminary examination.

7. Any person who has been for at least seven consecutive years continuously engaged as a pupil or assistant to one or more registered patent agents, and any person for the time being entitled to practise as a Solicitor of the Supreme Court of Judicature in England or Ireland, or as a law agent before the Court of Session in Scotland, shall be entitled to be registered without passing any examination other than the final examination provided for in the last preceding Rule. The Registrar shall before registering the name of any such person as a patent agent (in addition to the final examination certificate) require proof satisfactory to the Registrar that such person has been for at least seven consecutive years continuously engaged as such pupil or assistant, or is entitled to practise as such Solicitor or Law Agent.

Qualifications of persons generally for registration.

8. Any person who is not qualified under Rule 7 must, in order to be entitled to present himself for the final qualifying examination, be—

A person who has passed one of the preliminary examinations

(*b*) p. 772 *post*.

mentioned in Appendix B.,(*c*) or such other examination as the Institute shall, with the approval of the Board of Trade, by regulation prescribe.

Final qualifying examinations to be held by the Institute.

9. The Institute shall hold at least once in the year, commencing with the first day of July 1889, and in every other succeeding year, a final qualifying examination, which shall be the final qualifying examination required under Rules 6 and 7; and the Institute shall, subject to these Rules, have the entire management and control of all such examinations, and may from time to time make regulations with respect to all or any of the following matters, that is to say—

(*a.*) The subjects for and the mode of conducting the examination of candidates;

(*b.*) The times and places of the examinations, and the notices to be given of examinations;

(*c.*) The certificates to be given to persons of their having passed the examinations;

(*d.*) The appointment and removal of examiners, and the remuneration, by fees or otherwise, of the examiners so appointed; and

(*e.*) Any other matter or thing as to which the Institute may think it necessary to make regulations for the purpose of carrying out this Rule.

Corrections of names and addresses in Register.

10. The Registrar shall from time to time insert in the Register any alteration which may come to his knowledge in the name or address of any person registered.

Erasure of names of deceased persons.

11. The Registrar shall erase from the Register the name of any registered person who is dead.

Erasure of names of persons who have ceased to practise.

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

(*c*) p. 773 *post*.

this Rule, be deemed to have ceased to practise, and his name may be erased accordingly.

Erasure of names for non-payment of fees.

13. If any registered person shall not, within one month from the day on which his annual registration fee becomes payable, pay such fee, the Registrar may send to such registered person to his registered address a notice requiring him, on or before a day to be named in the notice, to pay his annual registration fee; and if such registered patent agent shall not within one month from the day named in such notice pay the registration fee so due from him, the Registrar may erase his name from the Register: provided that the name of a person erased from the Register under this Rule may be restored to the Register by direction of the Institute or the Board of Trade on payment by such person of the fee or fees due from him, together with such further sum of money, not exceeding in amount the annual registration fee, as the Institute or the Board of Trade (as the case may be) may in each particular case direct.

Registrar to act on evidence.

14. In the execution of his duties the Registrar shall, subject to these Rules, in each case act on such evidence as appears to him sufficient.

Erasure of incorrect or fraudulent entries.

15. The Board of Trade may order the Registrar to erase from the Register any entry therein which is proved to their satisfaction to have been incorrectly or fraudulently inserted.

Erasure of names of persons convicted of crimes, and persons found guilty of disgraceful conduct.

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 misdemeanor, 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.

Restoration of erased name.

17. (1.) Where the Board of Trade direct the erasure from the Register of a name of any person, or of any other entry, the name of the person or the entry shall not be again entered in the Register, except by order of the Board of Trade.

(2.) The Board of Trade may in any case in which they 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.

Inquiry by Board of Trade before erasure of name from Register.

18. For the purpose of exercising in any case the powers of erasing from and of restoring to the Registrar 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 Registrar 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.

Appeal to Board of Trade.

19. Any person aggrieved by any order, direction, or refusal of the Institute or Registrar may appeal to the Board of Trade.

Notice of appeal.

20. A person who intends to appeal to the Board of Trade under these Rules (in these Rules referred to as the appellant) shall, within fourteen days from the date of the making or giving of the order, direction, or refusal complained of, leave at the office of the Institute a notice in writing signed by him of such his intention.

Case on appeal.

21. The notice of intention to appeal shall be accompanied by a statement in writing of the grounds of the appeal, and of the case of the appellant in support thereof.

Transmission of notice of appeal to Board of Trade.

22. The appellant shall also immediately after leaving his notice of appeal at the Institute send by post a copy thereof with a copy of the appellant's case in support thereof addressed to the Secretary of the Board of Trade, 7 Whitehall Gardens, London.

Directions as to hearing of appeal.

23. The Board of Trade may thereupon give such directions (if any) as they may think fit for the purpose of the hearing of the appeal.

Notice of hearing of appeal.

24. Seven days' notice, or such shorter notice as the Board of Trade may in any particular case direct, of the time and place appointed for the hearing of the appeal shall be given to the appellant and the Institute and the Registrar.

Hearing and decision of appeal.

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.

Fees.

26. The fees set forth in Appendix C.(*d*) to these Rules shall be paid in respect of the several matters, and at the times and in the

(*d*) p. 838 *post*.

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.

Alteration of regulations.

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.

Report to Board of Trade.

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 registrations 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.

Definitions.

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 named is registered under the Act and these Rules.

Commencement.

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.

Title.

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.

FORM OF PATENT.(*e*)

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 by his solemn declaration 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 licence, full power, sole privilege, and authority, that the said patentee by himself, his agents, or licensees, and no others, may at all times hereafter during the term of years herein mentioned, make, use, exercise, and vend the said invention within our United Kingdom of Great

(*e*) This form appears as Form D. in the First Schedule to the Patents, Designs, and Trade Marks Act, 1883.

Modifications of this form are necessary to meet special cases, and at the Patent Office eight modified forms are kept in stock:

A. Grant to a single inventor.

B. Grant to several joint applicants, all being inventors.

C. Grant to importer.

D. Grant to several joint applicants only some of whom are inventors.

E. Grant to the legal representative of an inventor who has died possessed of an invention, in respect of which he has made an application.

EE. Grant to legal representatives of an inventor who has died possessed of an invention, in respect of which he has made an application.

F. Grant to a female applicant.

G. Grant to several joint applicants where one of the original applicants is dead.

Britain and Ireland, and Isle of Man, in such manner as to him or them may seem meet, and that the said patentee shall have and enjoy the whole profit and advantage from time to time accruing by reason of the said invention, during the term of fourteen years from the date hereunder written of these presents: And to the end that the said patentee may have and enjoy the sole use and exercise and the full benefit of the said invention, We do by these presents for us our heirs and successors, strictly command all our subjects whatsoever within our United Kingdom of Great Britain and Ireland, and the Isle of Man, that they do not at any time during the continuance of the said term of fourteen years either directly or indirectly make use of or put in practice the said invention, or any part of the same, nor in anywise imitate the same, nor make or cause to be made any addition thereto or subtraction therefrom, whereby to pretend themselves the inventors thereof, without the consent, licence or agreement of the said patentee in writing under his hand and seal, on pain of incurring such penalties as may be justly inflicted on such offenders for their contempt of this our Royal command, and of being answerable to the patentee according to law, for his damages thereby occasioned: Provided that these our letters patent are on this condition, that, if at any time during the said term it be made to appear to us, our heirs or successors, or any six or more of our Privy Council, that this our grant is contrary to law, or prejudicial or inconvenient to our subjects in general, or that the said invention is not a new invention as to the public use and exercise thereof within our United Kingdom of Great Britain and Ireland, and Isle of Man, or that the said patentee is not the first and true inventor thereof within this realm as aforesaid, these our letters patent shall forthwith determine, and be void to all intents and purposes, notwithstanding anything hereinbefore contained: Provided also, that if the said patentee shall not pay all fees by law required to be paid in respect of the grant of these letters patent, or in respect of any matter relating thereto at the time or times, and in manner for the time being by law provided; and also if the said patentee shall not supply or cause to be supplied for our service all such articles of the said invention as may be required by the officers or commissioners administering any department of our service in such manner, at such times, and at and upon such reasonable prices and terms as shall be settled in manner for the time being by law provided, then, and in any of the said cases, these our letters patent, and all privileges and advantages whatever hereby granted shall determine and become void notwithstanding anything hereinbefore contained: Provided also that nothing herein contained shall prevent the granting of licences in such manner and for such

considerations as they may by law be granted: And lastly, we do by these presents for us, our heirs and successors, grant unto the said patentee that these our letters patent shall be construed in the most beneficial sense for the advantage of the said patentee. In witness whereof we have caused these our letters to be made patent this one thousand eight hundred and and to be sealed as of the one thousand eight hundred and

SEAL OF PATENT OFFICE.

FORMS.(*b*)

PATENT.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

Form **A.**

(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 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 authorisation 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.

(*b*) The following forms A. to V. are contained in the Second Schedule to the Patent Rules 1890.

For the convenience of applicants, suggested forms of authorisation to an Agent and statement of address respectively are printed below :—

(1) *Where application is made through an Agent* (*Rule* 8).

_____

_____ hereby appoint _____

of _____

to act as _____ Agent in respect of the within application for a Patent, and request that all notices, requisitions, and communications relating thereto may be sent to such Agent at the above address.

_____ day of _____ 18

* _____ * To be signed by applicant or applicants.

_____

_____

_____

(2) *Where application is made without an Agent* (*Rule* 9).

_____

_____ hereby request that all notices, requisitions, and communications in respect of the within application may be sent to _____ at _____

_____ day of _____ 18_____

† _____ † To be signed by applicant or applicants.

_____

_____

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

PATENT.

Form A 1.

(To be accompanied by two copies of Form B. or of Form C.)

APPLICATION FOR PATENT FOR INVENTION 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

(b) Here insert title of invention.

am in possession of an invention the title of which is (b)

_____

_____

_____

(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)_____

_____

_____

_____

NOTE.—Where application is made through an Agent (Rule 8) the authorisation 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 authorisation 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.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

Form A 2.

APPLICATION FOR PATENT UNDER INTERNATIONAL AND COLONIAL ARRANGEMENTS.

(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*) _____ (*g*) Signature of applicant or of each of applicants.

To the COMPTROLLER,
Patent Office, 25 Southampton Buildings,
Chancery Lane, London, W.C.

To be issued with Form **A**, **A 1**, or **A 2**.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

Form **B**.

PROVISIONAL SPECIFICATION.

(To be furnished in Duplicate.)

(*a*) Here insert title as in declaration.

(*a*)_____

(*b*) Here insert name and full address and calling of applicant or applicants as in declaration.

(*b*)_____

do hereby declare the nature of this invention to be as follows:—(*c*)

(*c*) Here insert short description of invention.

NOTE.—No stamp is required on this document, which must form the commencement of the Provisional Specification; the continuation to be upon wide-ruled foolscap paper (but on one side only) with a margin of two inches on left hand of paper. The Provisional Specification and the "Duplicate" thereof must be signed by the applicant or his agent, on the last sheet, the date being first inserted as follows:

"Dated this_____ day of_____ 18____"

To the COMPTROLLER,
Patent Office, 25 Southampton Buildings,
Chancery Lane, London, W.C.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

Where provisional specification has been left, quote No. and date.
No. _____
Date _____

PATENT.

Form C.

COMPLETE SPECIFICATION.

(To be furnished in Duplicate—one unstamped.)

(a) _____

_____

_____

_____

(a) Here insert title as in declaration.

(b) _____

_____

_____

_____

_____

(b) Here insert name and full address and calling of applicant or applicants as in declaration.

do hereby declare the nature of this invention and in what manner the same is to be performed, to be particularly described and ascertained in and by the following statement:

(c) _____

_____

_____

_____

_____

_____

_____

_____

_____

_____

(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."

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.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

Form D.

FORM OF OPPOSITION TO GRANT OF PATENT.

(To be accompanied by an unstamped copy.)

* 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 _____

_____

_____

† Here state upon which of the grounds of opposition permitted by s. 11 of the Act the grant is opposed.

upon the ground †_____

_____

_____

_____

_____

_____

_____

_____

_____

_____

_____

_____

(Signed) ‡_____

‡ Here insert signature of oppouent.

To the COMPTROLLER,
Patent Office, 25 Southampton Buildings,
Chancery Lane, London, W.C.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

PATENT.

Form E.

FORM OF APPLICATION FOR HEARING BY THE COMPTROLLER.

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.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

Form F.

PATENT.

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.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

Form G.

PATENT.

FORM OF OPPOSITION TO AMENDMENT OF SPECIFICATION OR DRAWINGS.

(To be accompanied by an unstamped copy.)

* _____

_____

_____

_____

_____

* Here state name and full address of opponent.

_____

hereby give notice of objection to the proposed amendment of the specification or drawings of Letters Patent No. _____

of 188___ for the following reason : † _____

_____

_____

_____

_____

† Here state reason of opposition.

_____

_____

_____

_____

_____

_____

(Signed) _____

To the COMPTROLLER,
Patent Office, 25 Southampton Buildings,
Chancery Lane, London, W.C.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

Form H.

PATENT.

FORM OF APPLICATION FOR COMPULSORY GRANT OF LICENCE.

(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 licence to me by †

† Here state name and address of patentee, and number and date of his patent.

_____

_____

_____

_____

(Signed) _____

NOTE.—The petition must clearly set forth the facts of the case and be accompanied by an examined copy thereof. *See* Form next page.

To the COMPTROLLER,
Patent Office, 25 Southampton Buildings,
Chancery Lane, London, W.C.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

Form H 1.

FORM OF PETITION FOR COMPULSORY GRANT OF LICENCES.

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 licences on reasonable terms (e)

Your petitioner therefore prays that an order may be made by the Board of Trade (f)

or that the petitioner may have such other relief in the premises as the Board of Trade may deem just.

(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 s. 22 of the said Act, and show that it arises by reason of the default of the patentee to grant licences 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 s. 22, sub-ss. (a), (b), or (c), as the case may be.

(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.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

Form I.

PATENT.

FORM OF OPPOSITION TO COMPULSORY GRANT OF LICENCE.

* Here state name and full address.

* _____

_____

_____

hereby give notice of objection to the application of _____

_____

_____

_____

for the compulsory grant of a Licence under a Patent No. _____ of 188_____

(Signed) _____

To the COMPTROLLER,
Patent Office, 25 Southampton Buildings,
Chancery Lane, London, W.C.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

Form J.

APPLICATION FOR CERTIFICATE OF PAYMENT OR RENEWAL.

_____

_____ hereby transmit the fee prescribed for the continuation in force of *_____ Patent No. _____, of 18____ for a further period of _____

* Here insert name of patentee.

Name †_____

† Here insert name and full address.

Address _____.

To the COMPTROLLER,
Patent Office, 25 Southampton Buildings,
Chancery Lane, London, W.C.

(This part of the Form to be filled in at the Patent Office.)

CERTIFICATE OF PAYMENT OR RENEWAL.

PATENT.

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.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

PATENT.

Form K.

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*) _____

_____

_____

(*b*) Here insert full address, to which receipt is to be sent.

To the COMPTROLLER,
Patent Office, 25 Southampton Buildings,
Chancery Lane, London, W.C.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

Form L.

PATENT.

FORM OF REQUEST TO ENTER NAME UPON THE REGISTER OF PATENTS.

I (*a*)_____

_____

_____

(*a*) *Or* We. Here insert name, full address, and description.

hereby request that you will enter (*b*)_____ name (*c*) in the Register of Patents:—

(*b*) My *or* our.

(*c*) *Or* names.

(*d*)_____ claim to be entitled (*e*)_____

_____

(*d*) I *or* We.

(*e*) Here insert the nature of the claim.

of the Patent No._____ of 188_____, granted to (*f*)_____

_____

_____

(*f*) Here give name and address, &c., of Patentee or Patentees.

for (*g*)_____

_____

(*g*) Here insert title of the invention.

by virtue of (*h*)_____

_____

_____

_____

_____

_____

_____

(*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.

And in proof whereof I transmit the accompanying (*i*)_____

_____ with an attested copy thereof (*j*).

(*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.

I am,

Sir,

Your obedient Servant,

To the COMPTROLLER,

Patent Office, 25 Southampton Buildings,

Chancery Lane, London, W.C.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

Form M.

PATENT.

FORM OF REQUEST TO ENTER NOTIFICATION OF LICENCE IN THE REGISTER OF PATENTS.

SIR,

I hereby transmit an attested copy of a licence granted to me by_____

_____

under Patent No._____ of 188____, as well as the original licence for verification, and I have to request that a notification thereof may be entered in the Register.

I am,

Sir,

Your obedient Servant,

(a)_____

_____

_____

(a) Here insert full address.

To the COMPTROLLER,
Patent Office, 25 Southampton Buildings,
Chancery Lane, London, W.C.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

Form N.

PATENT.

APPLICATION FOR DUPLICATE OF PATENT.

Date_____

SIR,

I regret to have to inform you that the Letters Patent

dated *_____ No._____

granted to_____

* Here insert date, No., name, and full address of Patentee.

for an invention of †_____

† Here insert title of invention.

have been ‡_____

‡ Here insert the word "destroyed" or "lost," as the case may be.

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.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

PATENT.

Form 0.

NOTICE OF INTENDED EXHIBITION OF AN UNPATENTED INVENTION.

* 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.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

Form P.

PATENT.

FORM OF REQUEST FOR CORRECTION OF CLERICAL ERROR.

SIR,

I hereby request that the following clerical error (*a*) _____ (*a*) *or* errors.

_____

in the (*b*) _____

No. _____ of 18 ____, may be corrected in the manner shown in

red ink in the certified copy of the original (*b*) _____ (*b*) Here state whether in application, specification, or register.

_____

hereunto annexed.

Signature _____

Full Address _____

To the COMPTROLLER,
Patent Office, 25 Southampton Buildings,
Chancery Lane, London, W.C.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

PATENT.

Form Q.

CERTIFICATE OF COMPTROLLER-GENERAL.

PATENT OFFICE,
LONDON.

_____ 18____

I, _____, Comptroller-General of Patents, Designs, and Trade Marks, hereby certify

To * _____

_____

_____

* Here insert name and full address of person requiring the information.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

Form R.

PATENT.

FORM OF NOTICE FOR ALTERATION OF AN ADDRESS IN REGISTER.

SIR,

(a) _____ (a) Here state name or names and full address of applicant or applicants.

_____

_____

_____

hereby request that _____ address now upon the Register may be altered as follows:—

(b) _____ (b) Here insert full address.

_____

_____

_____

Sir,

Your obedient Servant,

To the COMPTROLLER,
Patent Office, 25 Southampton Buildings,
Chancery Lane, London, W.C.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

Form S.

PATENT.

FORM OF APPLICATION FOR ENTRY OF ORDER OF PRIVY COUNCIL IN REGISTER.

(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.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

Form T.

PATENT.

FORM OF APPEAL TO LAW OFFICER.

I, (*a*)_____of (*a*)_____

_____

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*) _____

_____

No. (*d*) _____of the year 18____(*d*)

Signature_____

Date_____

(*a*) Here insert name and full address of appellant.

(*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.

(*d*) Insert number and year.

N.B.—This notice has to be sent to the Comptroller-General at the Patent Office, London, W.C., and a copy of same to the Law Officer's Clerk at Room 549 Royal Courts of Justice, London.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

Form U.

PATENT.

FORM OF APPLICATION FOR EXTENSION OF TIME FOR LEAVING A COMPLETE SPECIFICATION.

SIR,

_____ hereby apply for extension of time for one month in which to leave a Complete Specification upon application.

_____ dated _____

The circumstances in and grounds upon which this extension is applied for are as follows (*a*) :—_____

(*a*) See Rule 50.

_____

_____

_____

_____

_____

_____

_____

_____

_____

Sir,

Your obedient Servant,

(*b*) _____

_____

(*b*) To be signed by applicant or applicants or his or their agent.

To the COMPTROLLER,
Patent Office, 25 Southampton Buildings,
Chancery Lane, London, W.C.

PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888.

Form V.

PATENT.

FORM OF APPLICATION FOR EXTENSION OF TIME FOR ACCEPTANCE OF A COMPLETE SPECIFICATION.

SIR,

_____ hereby apply for extension of time for _____ month _____ for the acceptance of the Complete Specification upon application No. _____ dated _____

The circumstances in and grounds upon which this extension is applied for are as follows (*a*):— _____

_____

_____

_____

_____

_____

_____

(*a*) See Rule 50.

_____

Sir,

Your obedient Servant,

(*b*) _____

_____

_____

_____

(*b*) To be signed by applicant or applicants or his or their agent.

To the COMPTROLLER,
Patent Office, 25 Southampton Buildings,
Chancery Lane, London, W.C.

M. E. HICKS-BEACH,
President of the Board of Trade.

31*st March* 1890.

APPENDICES TO PATENT AGENTS RULES, 1889.

Appendix A.

Form 1.

Form of Register.

Name.	Designation.	Address.	Date of Registration.

Form 2.

* *Form of Statutory Declaration.*

REGISTER OF PATENT AGENTS RULES, 1889.

I, *A.B.* [*insert full name, and in the case of a member of a firm add,* "a member of the firm of "] of , in the county of Patent Agent, do solemnly and sincerely declare as follows:

1. That prior to the 24th December 1888 I had been *bonâ fide* practising in the United Kingdom as a patent agent.

2. That I acted as patent agent in obtaining the following patents:

[*Give the official numbers and dates of some patents for the United Kingdom in the obtaining of which the declarant acted as patent agent.*]

3. That I desire to be registered as a patent agent in pursuance of the said Act.

And I make this solemn declaration conscientiously believing the same to be true and by virtue of the provisions of the Statutory Declarations Act, 1835.

Declared at

* A printed form of this declaration for use of applicants is now also on sale.

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 Examinations of the Civil Service Commissioners for admission to the Civil Service.

Appendix C.

(*List of Fees, see p. 838, post.*)

ASSIGNMENT OF LETTERS PATENT TOGETHER WITH THE BENEFIT OF FUTURE IMPROVEMENTS.

Parties. THIS INDENTURE, made the day of , 18 , BETWEEN A. B., of, &c. (hereinafter called the assignor), of the one part, and C. D., of, &c. (hereinafter called the assignee), of the other part.

Recitals. WHEREAS the assignor is the true and first inventor of an invention of [*title of invention*].

True and first inventor.

Patents. AND WHEREAS by letters patent dated the day of , 18 , and numbered , the sole and exclusive licence and authority of making, using, exercising, and vending in the United Kingdom of Great Britain and Ireland [*in the case of patents granted prior to* 1884, the Channel Islands] and the Isle of Man the said invention of improvements in, &c. [*title of invention*], were granted to the assignor, his executors, administrators, and assigns, for the term of fourteen years from the day of , 18 , subject to a condition for making void the same if the specification filed by the assignor were not a complete one and otherwise as therein provided [*or in the case of patents granted prior to* 1884, subject to the assignor filing a complete specification of the said invention, and otherwise as therein provided].

Agreement for sale. AND WHEREAS the assignor has agreed with the assignee to sell to him for the sum of £ the said invention and letters patent, and the exclusive benefit thereof, and of all extensions of the said letters patent; and also (subject to the provisions hereinafter contained) of all improvements or additions to the said invention or discoveries connected with the manufacture of , whether the same are now known or shall hereafter become or be made known to the assignor. NOW

Assignment. THIS INDENTURE WITNESSETH, that in pursuance of the said agreement, and in consideration of the sum of £ paid by the assignee to the assignor (the receipt whereof the assignor doth hereby acknowledge), the assignor as beneficial owner doth hereby assign unto the assignee ALL THOSE the said invention and letters patent, and the sole and exclusive benefit thereof, and of all extensions thereof, and of all rights, powers, emoluments, and advantages whatsoever under or in respect of the said letters patent, TO HAVE AND TO HOLD, use, exercise, and enjoy the said invention, letters patent, and

premises unto the assignee, his executors, administrators, and assigns, absolutely. AND the assignor doth hereby covenant with the assignee, his executors, administrators, and assigns, that, notwithstanding any thing by him the assignor done, omitted, or knowingly suffered, the said letters patent are now valid and subsisting, and not void or voidable. AND ALSO that he the assignor will from time to time, after making any improvement in or addition to the said invention, or any discovery in connection with the manufacture of , as well all improvements, additions, or discoveries as aforesaid (if any) now known or which may hereafter become or be made known to him, forthwith give notice thereof in writing to the assignee, his executors, administrators, or assigns, who shall be entitled to the sole and exclusive use and benefit thereof. AND ALSO WILL, as and when reasonably required by the assignee, his executors, administrators, or assigns, communicate and explain to him or them, or to his or their agents, such improvement, addition, or discovery, the assignee, his executors, administrators, or assigns, paying all costs, charges, and expenses (if any) thereby actually incurred. AND WILL, at the expense of the assignee, his executors, administrators, or assigns, if he or they shall so require, either alone or conjointly with the assignee, his executors, administrators, or assigns, apply for and obtain letters patent in respect of such improvement, addition, or discovery, and execute and do all such assurances and things as shall be necessary or convenient for vesting the same letters patent, and the sole and exclusive benefit thereof, in the assignee, his executors, administrators, or assigns, as by him or them shall be reasonably required. AND WILL, at the expense of the assignee, his executors, administrators, or assigns, execute and do all such assurances and things as shall be reasonably required for enabling him or them to obtain, hold, and enjoy the exclusive benefit of any extension of the terms comprised in the letters patent hereby assigned, or, as far as practicable, of any term which may be comprised in any letters patent which may hereafter be vested in the assignor, either solely or jointly with the assignee, his executors, administrators, or assigns, according to the covenant in this behalf hereinbefore contained.

Covenant as to validity.

Covenant to assign future improvements.

Covenant to assign extension of terms of patents.

In Witness, &c.

NON-ASSIGNABLE LICENCE TO USE AND EXERCISE A PATENTED INVENTION WITHIN A DISTRICT.

Parties.

THIS INDENTURE, made the day of , 18 , BETWEEN A. B., of, &c. (hereinafter called the licensor), of the one part, and C. D., of, &c. (hereinafter called the licensee), of the other part.

Recital of grant of patent.

WHEREAS, by letters patent dated the day of , 18 , and numbered , the sole and exclusive licence and authority of making, using, exercising, and vending in the United Kingdom of Great Britain and Ireland [*in the case of patents granted prior to* 1884, the Channel Islands], and the Isle of Man the said invention of improvements, &c. [*title of patent*], were granted to the licensor, his executors, administrators, and assigns, for the term of fourteen years from the date thereof [*in the case of patents granted prior to* 1884, from the day of , subject to the licensor filing a complete specification of the said invention and otherwise as therein mentioned], subject to the payment of the fees, and the conditions for making void the same, as therein provided.

Recital of agreement for licence.

AND WHEREAS the licensor has agreed to grant the licensee a licence to use and exercise the said invention within the district hereinafter described, upon the terms hereinafter appearing.

Grant of licence.

NOW THIS INDENTURE WITNESSETH that in pursuance of the said agreement, and in consideration of the royalties hereinafter reserved and made payable to the licensor, and the covenants on the part of the licensee hereinafter contained, the licensor doth hereby grant unto the licensee full liberty, licence, power, and authority, within the district, being [*define the district*], to use and exercise the said invention during the term of years from the date hereof, and to sell and dispose of all manufactured according to the said invention, when and as the licensee shall think fit, for his absolute use and benefit.

Covenants.

AND it is hereby mutually covenanted and agreed between and by the parties hereto as follows, namely:—

Payment of royalties.

1. The licensee shall, and will, pay to the licensor, his executors, administrators, and assigns, yearly during the said term of years, and so in proportion for any less time than a year, the sum of £ , as a fixed or minimum royalty in the nature of rent, by equal quarterly payments, on the day of , the

day of , the day of , and the day of in each year, the first of such payments to be made on the day of next; and shall, and will, also pay to the licensor, his executors, administrators, or assigns, in respect of every manufactured by the licensee according to the said invention, in every half-year of the said term, commencing on the day of and the day of , the royalty or sum of £ , to become due and to be paid at the end of {two calendar months after the expiration of the half-year during which the same shall have been manufactured or made as aforesaid.

Accounts.

2. The licensee shall, and will, at all times during the continuance of this licence, keep, at his usual place of business, all proper books of account, and make true and complete entries therein, at the earliest opportunities, of all particulars necessary or convenient for the purposes hereof, of all manufactured or made by him according to the said invention, and produce the said books to the licensor, his executors, administrators, or assigns, or his or their agent, at all reasonable times, for inspection and the taking of copies or extracts therefrom; and shall, and will, at his, the licensee's, own expense, obtain and give to the licensor, his executors, administrators, or assigns, or his or their agent, all such information as to any item or matter contained, or which ought to be contained, therein as shall be reasonably required.

Statements of accounts.

3. The licensee shall, and will, at the end of each half-year in the first paragraph mentioned, deliver or send to the licensor, his executors, administrators, or assigns, a statement in writing of the number of manufactured or made by the licensee in such half-year, and the amount of royalties payable in respect thereof, as in the first paragraph mentioned; and will, if and when required by the licensor, his executors, administrators, or assigns, but at the expense of the licensee, verify, or procure some suitable person in his employ to verify, the said statement, or any part or parts thereof, by statutory declaration.

Inspection of premises.

4. The licensor, his executors, administrators, or assigns, shall be at liberty, at any time during the continuance of this licence, to enter upon any factory or place of business of the licensee in which the manufacture of shall be carried on, at any reasonable hour of the daytime, to inspect the same, and the works thereof, and all manufactured, or in course of manufacture, in such factory or place.

Assistance from licensor.

5. The licensor shall, and will, whenever so required, give to the licensee such assistance and information respecting the said invention and the mode of working the same, and all processes connected there-

with, as may be necessary for enabling him to use and exercise the said invention to the greatest advantage.

Infringements. 6. In the event of the said letters patent being infringed during the continuance of this licence, the licensor, his executors, administrators, or assigns, shall, and will, after notice of such infringement, at his or their own costs, take all necessary proceedings for effectually protecting and defending the same; and in default of his or their so doing, the licensee shall be at liberty, by notice in writing given to or left at the usual or last known place of business or residence of the licensor, his executors, administrators, or assigns, to determine this licence.

Validity of patent. 7. The licensee shall not at any time during the continuance of this licence dispute the validity of the said letters patent.

Alienation. 8. The licensee shall not, without the written consent of the licensor, his executors, administrators, or assigns, first had and obtained, assign, mortgage, charge, or grant sub-licences in respect of, or otherwise deal or part with the possession or control of, this licence, or attempt so to do.

Termination. 9. This licence may be determined at any time after the first six calendar months by either party, on giving to the other party, or leaving at his usual or last known place of business or residence, three calendar months' previous notice in writing of his intention so to do; and, at the expiration of such notice, these presents, and all covenants, agreements, and provisions therein contained, shall cease and be void, but without prejudice to the remedies of either party for the recovery of any moneys then due to him hereunder.

In Witness, &c.

MORTGAGE OF LETTERS PATENT.

THIS INDENTURE, made the day of , 18 , Parties.
BETWEEN A. B. (hereinafter called the mortgagor, which expression shall include his executors, administrators, and assigns where the context so admits), of the one part, and C. D. (hereinafter called the mortgagee, which expression shall include his executors, administrators, and assigns where the context so admits), of the other part.
WHEREAS the mortgagor was the true and first inventor of certain improvements in, &c. [*title of invention*]. AND WHEREAS, by letters patent dated the day of , 18 , and numbered , the sole and exclusive licence and authority of making, using, exercising, and vending in the United Kingdom of Great Britain and Ireland [*in the case of patents granted prior to* 1884, the Channel Islands] and the Isle of Man the said invention of improvements, &c. [*title of invention*] were granted to the mortgagor for the term of fourteen years [*in the case of patents granted prior to* 1884, from the day of , subject to the mortgagor filing a complete specification of the said invention, and otherwise as therein mentioned] from the date thereof, subject to the payment of the fees and the conditions for making void the same as therein mentioned. AND WHEREAS the mortgagor has applied to the mortgagee for a loan of £ , and the mortgagee has agreed to lend to the mortgagor the said sum of £ upon having the repayment thereof, together with interest thereon at the rate hereinafter mentioned, secured in manner hereinafter appearing. NOW THIS INDENTURE WITNESSETH, that in pursuance of the said agreement, and in consideration of the sum of £ now paid by the mortgagee to the mortgagor (the receipt whereof the mortgagor doth hereby acknowledge), the mortgagor doth hereby covenant with the mortgagee that he, the mortgagor, will on the day of next [*first day for payment of interest*] pay to the mortgagee the sum of £ [*the sum advanced*], together with interest for the same in the meantime at the rate of per centum per annum from the date hereof. AND will, in case and so long as the said sum of £ or any part thereof shall remain unpaid, pay to the mortgagee interest for the same at the rate aforesaid by equal half-yearly [*or* quarterly] payments on the

Recitals.
True and first inventor.
Grant of patent.
Request for loan.
Covenant of repayment.

day of , &c. [*half-yearly or quarterly days*], in every year. AND THIS INDENTURE ALSO WITNESSETH, that, in further pursuance of the said agreement and in consideration of the premises, the mortgagor as beneficial owner doth hereby assign and transfer unto the mortgagee ALL THAT the said invention of improvements in, &c. [*title*], and the said letters patent for the same, and the full and exclusive benefit thereof (and of any and every improvement, extension, or renewal thereof), and the right to apply for and obtain an extension or renewal thereof, and all rights, powers, and benefits to the said invention and letters patent, belonging, To HOLD the said invention, letters patent, and premises unto the mortgagee, subject to the proviso for redemption hereinafter contained. PROVIDED ALWAYS, and it is hereby agreed and declared, that if the mortgagor shall pay to the mortgagee the sum of £ [*sum advanced*], together with interest for the same at the aforesaid rate of per centum per annum, on the day of next [*date of first payment of interest*], the mortgagee shall at any time thereafter, upon the request and at the cost of the mortgagor, reassign the said premises hereinbefore assigned, to the mortgagor, or as he shall direct. AND the mortgagor doth hereby covenant with the mortgagee that he, the mortgagor, will, so long as any money shall remain on the security of these presents, pay the fees required by law for keeping the said letters patent on foot one calendar month at least before the latest time allowed by law for payment of the same respectively, and will do all other acts and things as may be necessary to maintaining the said letters patent, and will send or deliver to the mortgagee the receipt for every such payment immediately after the same shall have been made. AND FURTHER, that he, the mortgagor, will from time to time, so long as any money shall remain on the security of these presents, use his best endeavours to discover any infringement now or hereafter to be made of the said letters patent, or any extension thereof, and communicate to the mortgagee every suspected or ascertained infringement aforesaid, and if, and when, required in writing by the mortgagee so to do, will either himself commence or take and prosecute or defend all legal or other proceedings necessary or suitable for the protection of the said letters patent, or the recovery of damages for, or restraining, the infringement thereof, or permit the mortgagee to take such proceedings, and, in the event of the mortgagor taking such proceedings will do everything in his power for the purpose of making such proceedings successful, and will, whatever the event of any such proceedings, pay on demand the costs of the mortgagee (if any) relating thereto, as between solicitor and client. AND FURTHER, that in case the mortgagor shall neglect

Assignment.

Habendum.

Covenants.

Payment of fees.

Infringements.

or refuse to make the payments aforesaid, or any of them, it shall be lawful for the mortgagee to pay the same. AND that all moneys and expenses (if any) paid by the mortgagee for or in respect of any renewal fees or other charges, or any proceedings or other matters aforesaid, together with interest for the same at the rate of per centum per annum from the time, or respective times, of the same having been made or expended, shall be repaid by the mortgagor to the mortgagee on demand, and shall in the meantime, and until repayment thereof, be charged on the premises hereby assigned. PROVIDED ALWAYS, and it is hereby agreed and declared, that at any time, or times, before the mortgagee shall have become entitled to exercise the power of sale vested in him by virtue of these presents and the statute in that behalf, it shall be lawful for the mortgagor himself to use and exercise the said invention without interruption from the mortgagee, and, in the name and as the attorney of the mortgagee, to grant licences for the use of the said invention and letters patent for such periods, and upon such conditions, as he shall think fit, but so that the mortgagor shall not be authorised to enter into any covenants in the name of the mortgagee, or to subject him to any personal liability, and so that no exclusive licence shall be granted without the consent in writing of the mortgagee, and so that on every such licence there be reserved the best rent or royalty that can conveniently be obtained without taking anything in the nature of a fine or a premium. AND it shall be lawful for the mortgagee, at any time, or times, after he shall have become entitled to exercise the power of sale aforesaid, to grant licences for the use of the said invention and letters patent for such periods, and upon such conditions, and in such manner as he may think fit, and in consideration of a sum, or sums, in gross, or any rents or royalties, or otherwise.

Power to mortgagee to pay fees.

Power to mortgagor to use invention.

Licences.

In Witness, &c.

ACTION OF INFRINGEMENT.

INDORSEMENT ON WRIT.(*a*)

The plaintiff's claim is for damages for the infringement of the plaintiff's patent.

And for an injunction to restrain the defendant from infringing the plaintiff's patent.

ANOTHER FORM.

1. For an injunction to restrain the defendant his servants and agents from infringing the plaintiff's letters patent dated the day of 18 and numbered

2. For damages for such infringement or at the option of the plaintiff an account of all profits derived by the defendant from such infringement.

3. For the delivery up to the plaintiff or the destruction of all articles in the possession of the defendant made in such infringement.

4. For costs.

STATEMENT OF CLAIM.(*b*)

Infringement. The defendant has infringed the plaintiff's patent No. 14,084 granted for the term of fourteen years from the 21st May 1880 for certain improvements in the manufacture of iron and steel whereof the plaintiff was the first inventor.

Injunction and damages. The plaintiff claims an injunction to restrain the defendant from further infringement and £100 damages.

Particulars of breaches are delivered herewith.

Place of trial Durham.

(Signed)

Delivered

(*a*) See R. S. C. 1883, Appendix A, part iii. sec. iv.
(*b*) R. S. C. 1883, Appendix C, Form 6.

ANOTHER FORM.

188 —K—No.

In the High Court of Justice
Queen's Bench Division
[*or* Chancery Division
Mr. Justice ——]

Writ issued

Between A. B.,

Plaintiff

and

C. D.,

Defendant.

STATEMENT OF CLAIM.

The defendant has infringed the plaintiff's patent No. of Infringement.
A.D. granted for the term of fourteen years from the
day of 18 for certain improvements in
whereof E. F. therein named was the true and first
inventor.

1. The plaintiff claims an injunction to restrain the defendant from further infringement. Injunction.

2. An inquiry as to the damages sustained by the plaintiff by reason of the infringement or at plaintiff's option an account of profits made by the defendant. Damages or account.

3. That the defendant may be ordered to pay to the plaintiff the amount so found to be due. Payment of amount found due.

4. That the defendant may be ordered forthwith to deliver up to the plaintiff to be destroyed all machines or apparatus made in infringement of the plaintiff's patent. Delivery up.

5. Costs. Costs.

(Signed)

Particulars of breaches are delivered herewith.

Delivered this day of 18 by
of solicitor for the plaintiff.

ANOTHER FORM.

18 —A—No.

In the High Court of Justice
Chancery Division
Mr. Justice ——
[*or* Queen's Bench Division].
Writ issued
Between A. B.,
Plaintiff
and
C. D.,
Defendant.

STATEMENT OF CLAIM.

Title. 1. The plaintiff is the registered legal owner of the letters patent dated the day of 18 and numbered for an invention of improvement in the manufacture of granted for the term of fourteen years from the date thereof to E. F.

2. The said letters patent were duly assigned to the plaintiff by an indenture dated the day of 18 and made between the said E. F. and the plaintiff. Notice of such assignment was entered on the Register of Patents on the day of 18 since which date the plaintiff has remained the sole registered owner of such letters patent.

Validity. 3. The said letters patent are good and valid and are and have been ever since the grant thereof of full force and effect.

Infringement. 4. Since the day of 18 and prior to the issue of the writ herein the defendant has infringed [*or* threatened to infringe] the said letters patent and has made sold supplied let on hire and used [*or* threatened to make sell supply let on hire and use] manufactured according to the invention in respect of which the said letters patent were granted and he threatens and intends to continue to do so unless restrained by the order of this honourable Court.

The plaintiff claims—

Injunction. 1. An injunction to restrain the defendant his servants agents and workmen during the continuance of the said letters patent from manufacturing selling supplying letting on hire or using any manufactured according to

or in the manner described in the complete specification filed previous to the grant of the said letters patent as therein recited or according to or in any manner only colourably differing from the same and generally from infringing the rights of the plaintiff in respect of such letters patent.

2. An account of all gains and profits made by the defendant by the manufacture sale supply letting on hire or use of such manufactured sold supplied let on hire or used by the defendant or by any person or persons by the order or for the use of the defendant and that the defendant may be ordered to pay the amount of such gains and profits to the plaintiff. Account.

3. Damages for the infringement of the said letters patent. Damages.

4. Delivery up to the plaintiff of all such aforesaid as are in the possession or power of the defendant. Delivery up.

5. Costs.

6. The plaintiff claims full costs charges and expenses as between solicitor and client. In an action brought by the plaintiff against G. H. for infringement of the said letters patent Mr. Justice —— certified that the validity of the said letters patent came in question. Costs as between solicitor and client.

7. Such further or other relief as the nature of the case may require. Further or other relief.

(Signed)

Particulars of breaches [*or* threatened breaches] are delivered herewith.

Delivered the day of 18 by of solicitor for the plaintiff.

PARTICULARS OF BREACHES.(*a*)

18 —A—No.

In the High Court of Justice
Queen's Bench Division
[*or* Chancery Division
Mr. Justice ——]

Between A. B. Plaintiff

and

C. D. Defendant.

(*a*) As to the objects and requisites of particulars of breaches, see pp. 512–517 *ante*.

Particulars of Breaches.

The following are the particulars of the breaches complained of in this action:

Infringements at divers times subsequent to the date of plaintiff's patent.

That the defendant has at divers times since the day of 18 and prior to the commencement of this action infringed the plaintiff's letters patent and the three claims thereof in manner following that is to say—

That the defendant has subsequently to the date of the plaintiff's patent manufactured and sold or fitted on board divers ships certain cold dry air refrigerating machines for preserving meat or other substances in which are arranged and combined together steam engines air compressing and air expansion apparatus in the improved manner described and claimed in the Queen's Printers' copy of the complete specification filed prior to the grant of the said letters patent as therein recited.

Specific infringements.

And also that in refrigerating machines made sold or fitted by the defendant pipes of considerable length are provided for the passage of compressed air (drawn from the refrigerating chamber) to the expansion cylinder and traversing the cooling chamber or some part thereof or some chamber in connection therewith in such manner that the moisture in the air is deposited in the pipes and can be drawn off before the air reaches the expansion cylinder.

Number and dates of other infringements not known to the plaintiff.

The defendant sold a cold dry air refrigerating machine for preserving meat or other substances to one E. F. of on the day of 18 . The exact number and dates of the defendant's infringements save as hereinbefore mentioned are not at present known to the plaintiff, but the plaintiff will claim to recover full compensation from the defendant in respect of all such infringements.

(Signed)

Delivered this day of 18 by of solicitor for the plaintiff.

DEFENCE.(*c*)

1. The defendant did not infringe the patent.
2. The invention was not new.
3. The plaintiff was not the first or true inventor.
4. The invention was not useful.

(*c*) R. S. C. 1883, Appendix D, sec. vi.

5. [*Denial of any other matter of fact affecting the validity of the patent.*]

6. The patent was not assigned to the plaintiff.

(Signed)

Delivered

ANOTHER FORM.

18 —A—No.

In the High Court of Justice
Queen's Bench Division
[or Chancery Division
Mr. Justice ——]

Between A. B. Plaintiff

and

C. D. Defendant.

DEFENCE.

The defendant says that—

1. He has not infringed the plaintiff's patent No. of A.D. Infringement.

2. The defendant contends that the invention which is described and claimed in [*the patentee's*] specification is one in which and that the as described in the said specification is not claimed by any of the claiming clauses thereof except when in combination with the invention as hereinbefore described and limited. The defendant sells and exports considerable numbers of and separately and not in the form of complete and they contend that such acts are not infringements of the said letters patent.

3. The alleged invention was not new. Novelty.

4. The alleged invention was not useful. Utility.

5. The alleged invention is not proper subject-matter for a patent. Subject-matter.

6. E. F. was not the true and first inventor of the alleged invention. True and first inventor.

7. The complete specification of the alleged invention does not particularly describe the nature thereof and in what manner the same is to be performed. Insufficiency of specification.

8. The said complete specification does not distinguish what parts of the alleged invention are new and what old.

9. The provisional specification of the alleged invention does not describe the nature thereof and the invention claimed in the said complete specification is an invention different from and larger than that described in the provisional specification. Variance of specifications.

Defendant an officer or servant of the Crown.

10. If the issues of the validity of the plaintiff's patent and the infringement thereof are found in the plaintiff's favour as the defendant is [*Director-General of Ordnance*] and an officer or servant of the Crown the plaintiff is not entitled to damages or an injunction but only to have the terms of the user of his invention agreed or in default of agreement settled by the Treasury under the provisions of sec. 27 of the Patents Designs and Trade Marks Act 1883.

(Signed)

Delivered the day of 18 by of solicitor for the defendant.

PARTICULARS OF OBJECTIONS.(*a*)

18 —A—No.

In the High Court of Justice
Queen's Bench Division
[*or* Chancery Division
Mr. Justice ——]

Between A. B. Plaintiff

and

C. D. Defendant.

Particulars of Objections.

Delivered by the Defendant with his Statement of Defence.

The following are the particulars of the objections on which the defendant relies in support of his defence—

True and first inventor.

1. The said E. F. referred to in the statement of claim was not the true and first inventor of the said invention.

2. The said [*patentee*] obtained the patent by misrepresentation in falsely alleging that he was the true and first inventor [*add details*].

3. The plaintiff is not in law the proprietor of the exclusive right to make and sell [*the articles complained of*] by reason that the exclusive right to make and sell such [*articles complained of*] was granted prior to the date of the said letters patent No. of 18 [*the plaintiff's patent*] to A. R. by letters patent No. of 18 . The grant of the said letters patent No. of 18 to A. R. owned previously to the 1st Jan. 1884, have been a ground of repealing the plaintiff's said letters patent No. of 18 by *scire facias* and is

(*a*) As to the objects and requisites of particulars of objections, see pp. 527–540 *ante*.

available by way of defence to this action under sec. 26 of the Patents Designs and Trade Marks Act 1883.

4. The alleged invention is not the proper subject-matter for a patent. Subject-matter.

5. The alleged invention is not useful. Utility.

6. The alleged invention was not new at the date of the said letters patent, having regard to the common and public knowledge at the date thereof. Common knowledge.

7. The alleged invention was published within this realm prior to the date of the said letters patent by the filing at the Patent Office of the following specifications— Publication of prior specifications.

(*a*) The specification of W. E. N. No. of the year 18 for "improvements in machinery or apparatus for producing ice and for general refrigerating purposes." The portions relied on are from page line to page line and page line to the end and the drawings therein referred to.

(*b*) The specification of C. W. S. No. of the year 18 for "improvements in refrigerating and producing ice and in apparatus or machinery for that purpose." The defendant relies upon the whole of this specification.

[*Add other specifications.*]

8. The alleged invention was published within this realm prior to the date of the said letters patent in the following printed books— Publication by prior books.

(*Title*) edition page line to line .
(*Title*) edition page line to page line .

[*Add other books.*]

9. The alleged invention was published within this realm prior to the date of the said letters patent in a report and drawings by C. W. S. Such report is dated the day of 18 and was published in London by being forwarded by the said C. W. S. (from his office in Westminster) on or about that date to H. W. B. of . Publication by prior reports and drawings.

The said report was further published in London by copies thereof having been forwarded about the date aforesaid to (amongst others) the following persons—

(*a*) W. H. T. of .
(*b*) J. L. of

[*Add others.*]

10. The alleged invention was published within this realm prior to the date of the said letters patent by the manufacture and sale [*or* erection *or* use *or* public exhibition] of machines similar Publication by prior machines.

to the machine described and claimed in the plaintiff's complete specification at the places and in the years hereinafter mentioned that is to say—

(*a*) By J. W. of at in 18 .

(*b*) By Messrs. H. H. & Co. of at in 18 .

[*Add others.*]

Other instances of publication.

11. [*Other instances of prior publication, e.g. oral communications.*]

Disconformity.

12. The provisional specification of the alleged invention does not describe the nature thereof and the invention claimed in the said complete specification [*as amended*] is an invention differing from and larger than that described in the said provisional specification and differs therefrom in the following particulars that is to say [*point out differences*].

Insufficiency of complete specification.

13. The complete specification of the alleged invention does not particularly describe the nature thereof and in what manner the same is to be performed, inasmuch as—

(*a*) The said complete specification does not distinguish what parts of the alleged invention are new and what parts thereof are old.

(*b*) The said complete specification contains false suggestions to wit that [*certain parts*] are described as useful and necessary whereas the said [*same parts*] are not of any utility and are not necessary.

(*c*) The said complete specification is ambiguous and calculated to mislead in that [*add particulars*].

(*d*) The said complete specification is insufficient by reason that it does not contain sufficient information to enable a workman skilled in the trade to [*add details*].

(*e*) The patentee did not state in the said complete specification the most beneficial method with which he was at the date of the said specification acquainted of carrying out the said invention to wit he did not state [*add particulars*].

Delivered this day of 18 by of solicitor for the defendant.

NOTICE OF MOTION FOR LEAVE TO AMEND A SPECIFICATION PENDING ACTION FOR INFRINGEMENT.

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 counsel on behalf of

the above-named the owner of the letters patent mentioned in the writ in this action, that he may be at liberty to apply at the Patent Office for leave to amend the specification filed in pursuance of the said letters patent by way of disclaimer, correction, or explanation, and that in the meantime the hearing of this action may be postponed. And that the said specification, when so amended as aforesaid, may be used in evidence on the hearing of the said action upon such terms as may seem fit to his lordship.

To [*the defendant*], and ,
of , his solicitor.

NOTICE OF MOTION FOR INTERLOCUTORY INJUNCTION.

TAKE NOTICE that this Honourable Court will be moved before his lordship, Mr. Justice ——, on the day , 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 [*patented articles*], made according to or in the manner described in the specification [or specifications], 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.

JUDGMENT AFTER TRIAL OF ACTION.

Order of Mr. Justice , dated day of , 18 .

18 —B—No.

In the High Court of Justice,
Chancery Division,
Mr. Justice ——

Wednesday, the day of 18 .

Between The B. A.

Plaintiffs

and

I. L.

Defendants.

This action coming on the day of and the day of , 18 , for trial before this Court, in the presence of counsel for the plaintiffs and defendants, and upon hearing the

Pleadings, &c. pleadings in the action the letters patent of the day of 18 , granted to J. H., therein mentioned, and the indenture of the day of 18 , also therein mentioned, and so much of the answer of the said defendant I. L. to the plaintiff's interrogatories as is contained in paragraphs 6, 8, &c., and the further answer of the said defendant I. L. read, and upon hearing the evidence of the several persons named in the schedule hereto on their examination taken orally before this Court upon the several days set opposite their names in the said schedule, and upon producing the several exhibits to such persons on their said examinations referred to in the third column of the said schedule;

Admissions. and the defendants by their counsel admitting that the dye analysed by Dr. William O., Professor I. D., Dr. J. B. G., and Professor W. E. A. was the Fast Blackley Red which was sold to A. S. B., as in the pleadings mentioned, and that the same was sold by the defendants; and upon hearing what was alleged by counsel for the plaintiff and defendants; and the Judge, for his assistance, having submitted certain questions to Professor R. for his opinion, and obtained from the said Professor R. certain reports thereon, dated respectively the day of , 18 , and the day of , 18 :

Action to stand for judgment. This Court did order that this action should stand for judgment, and, this action standing for judgment, this day, in the presence of counsel for the plaintiffs and defendants, and the particulars of objections of the defendants being deemed to be amended by the addition thereto of an objection that the alleged invention of J. H. J., in the pleadings named, was and is not proper subject-matter for

Injunction. which letters patent can be validly granted: This Court doth order that the defendants, I. L., J. L., and C., and J. L. L. and S., their servants, agents, and workmen, be restrained, during the continuance of the letters patent in the pleadings mentioned, from making, using, or putting in practice, or permitting to be made, used, or put in practice, the invention described in the specification of J. H. J., in the pleadings mentioned, or any part of the same invention, and from manufacturing, selling, or making any profitable use, or permitting the manufacture, sale, or profitable use, of any dyes or colouring matters being the same as "Fast Blackley Red" sold to A. S. B., in the pleadings mentioned, or any dyes or colouring matters made according to the said invention, or any part thereof, or by any process being a colourable imitation of the said invention, or any part thereof, and from in any manner infringing the rights and privileges granted by the said letters patent. And it is ordered

that an account be taken of all dyes or colouring matters being the same as the "Fast Blackley Red" sold to the said A. S. B. as aforesaid, or otherwise made in infringement of the said letters patent, which have been manufactured, or sold, or used by, or by the order or for the use or profit of, the defendants, or any of them; and also of the gains or profits made by the defendants, or any of them, by reason of such manufacture, sale, or use. And it is ordered that the defendants do, within fourteen days after the date of the Chief Clerk's Certificate, pay to the plaintiffs what shall be certified to be the amount of such profits made by the defendants respectively. And it is ordered that the defendants I. L., J. L., and C. and J. L. L. and S. deliver up to the plaintiffs, The B. A. and S. F., or in the presence of the plaintiffs or their agents destroy or otherwise render unfit for use, all dyes or colouring matters made or used by, or by the order or for the profit of, the defendants, or any of them, being the same as the "Fast Blackley Red" sold to the said A. S. B. as aforesaid, or otherwise made in infringement of the said letters patent, which are in the possession, custody, or power of the defendants, or any of them, or the servants or agents of them, or any of them, the particulars of such dyes or colouring matters to be verified by affidavit, but such delivery, destruction, or otherwise rendering unfit for use is not to be enforced before the of , 18 ; and in the event of the defendants electing to appeal, not until the appeal has been disposed of, or until further order, and in that case such dyes or colouring matters are to be deposited for safe custody at the office of M. A. and G. W. F., the defendants' solicitors, at No. P. S. M.

Account to be taken.

Delivery up.

And it is ordered that the plaintiffs do deposit with the Master of the Supreme Court the original shorthand-writers' notes of the and argument, and also all printed or written copies thereof in the possession or power of the plaintiffs, their solicitor, agent, and witnesses (to be verified by affidavit), the same to remain in Court until either there shall be an appeal, or until, by lapse of time or otherwise, it shall be determined that there shall be no appeal. And in the event of such appeal, the parties respectively are to be at liberty to apply for delivery out to them of so many copies of the said notes, or of the said printed or written copies, as they may require. And if, by lapse of time or otherwise, it shall be determined that there shall be no appeal, either of the parties are to be at liberty to make such application to the Court for the disposal of the said notes, and printed and written copies, as they may think fit. And it is ordered that a certificate be given pursuant to the Act of Parliament of 5th and 6th William IV. c. 83, s. 3, and the Act of the 15th and 16th Victoria, c. 83, that the validity of the said letters

Deposit of documents, &c.

Appeal.

Application.

Certificate of validity.

patent came in question at the trial of this action, and that the plaintiffs proved their particulars of breaches. And it is ordered that the said defendants do pay to the said plaintiffs their costs of this action, including the costs of transcribing and printing the shorthand-writers' notes, and the costs of Professor R.'s reports; such costs to be taxed by the Taxing Master.

Payment of costs.

JUDGMENT VARIED ON APPEAL.

Order of the Court of Appeal.

Dated 18 .

Court of Appeal. 18 —B—No. .

Saturday, the day of , 18 .

Mr. C., Regr.

Between B. A., &c.

Plaintiffs

and

I. L., &c.

Defendants.

Upon motion by way of appeal on the of November, and the of December 18 , made unto this Court by counsel for the defendants, from the judgment dated the June 18 , and upon hearing counsel for the plaintiffs, and upon reading the said judgment:

This Court did order that the said appeal should stand for judgment, and the same standing on the March 18 , and this day in the paper for judgment, in the presence of counsel on both sides:

Judgment reversed.

This Court doth order that the said judgment be reversed.

And it is ordered that the plaintiffs' action do stand dismissed.

Repayment of costs.

And it is ordered that the plaintiffs, B. A., &c., do repay the defendants, I. L., &c., the sum of £ , being the amount of the costs of the said judgment, already paid by the defendants to the plaintiffs.

Taxation of costs.

And it is ordered that it be referred to the Taxing Master to tax —(1) The defendants their costs of this action, other than their costs occasioned by the issue or issues raised by the Particulars of Breaches in the said judgment mentioned, and other than the defendants' costs of the motion on the November 18 , but including in the defendants' costs the costs of transcribing and printing the shorthand-writers' notes in the Court below, and the

cost of Professor R.'s report in the judgment mentioned; (2) The costs of the defendants occasioned by the said appeal, other than their costs occasioned by the issue or issues raised by the Particulars of Breaches aforesaid; and (3) The costs of the plaintiffs of the said action, as well in the Court of Appeal as in the Court below, occasioned by the issue or issues raised by the said Particulars of Breaches.

And it is ordered that such costs of the plaintiffs, and the sum of £ , the taxed costs of the plaintiffs of the motion made on the November 18 , in this action by the defendants, be set off against such costs by the defendants. And the Taxing Master is to certify to whom, after such set-off, the balance is due. Set-off.

And it is ordered that the party from whom such balance shall be certified to be due pay the amount thereof to the other party. Payment of balance.

CERTIFICATE OF VALIDITY.

I hereby certify, pursuant to the 31st section of the Patents, Designs, and Trade Marks Act, 1883 (46 & 47 Vict. c. 57), that upon the trial of this action, the validity of the letters patent, in the pleadings mentioned, dated the 28th November 1878, and numbered 4847, granted to F. J. C., amended by disclaimer allowed 12th November 1884, and now vested in the Edison and Swan United Electric Light Company, Limited, came into question.

Dated this 16th day of July 1888.

E. E. Kay.

ACTION TO RESTRAIN THREATS OF LEGAL PROCEEDINGS.

INDORSEMENT ON WRIT.

The plaintiff's claim is—

1. For an injunction to restrain the defendant 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, dated the day of , 18 , and numbered , or in respect of any article or articles, process or processes, alleged by the defendant to be an infringement of his said patent.

2. For damages in respect of such threats.

3. For costs.

STATEMENT OF CLAIM.

189 —A—No.

In the High Court of Justice
Queen's Bench Division
[*or* Chancery Division
Mr. Justice ——]

Between A. B.

Plaintiff.

and

C. D.

Defendant.

STATEMENT OF CLAIM.

1. On the day of 1898 the defendant by [*set out particulars*] claiming to be the patentee of an invention for [*state the title of the invention*] threatened the plaintiff with legal

proceedings in respect of the sale by the plaintiff of certain [*add particulars*] to [*add particulars*].

2. The sale of the said [*add particulars*] to which the said threats related was not in fact an infringement of any legal rights of the defendant.

3. The defendant issued the said threats falsely and maliciously and with the object of injuring the plaintiff and not *bonâ fide* in support of any patent or other right which he possesses.

4. Unless the defendant is restrained from publishing the said or similar threats the plaintiff will be greatly injured in his business.

The plaintiff claims—

1. An injunction to restrain the defendant from alleging by letters, circulars, advertisements or in any other manner that [*the articles in question*] constructed or sold by the plaintiff are constructed in infringement of the defendant's patent and to restrain the defendant from threatening the plaintiff or any of his customers with proceedings for infringement of any patents the property of the defendant in connection with the construction or sale by the plaintiff of any of the said [*the articles in question*].

2. An injunction to restrain the defendant from writing or forwarding to any customers of the plaintiff or to any other person any letters, documents or statements alleging that they are entitled to restrain the plaintiff from selling his [*the articles in question*] or that it is their intention to take any proceedings to restrain the plaintiff from selling his [*the articles in question*].

3. Damages.

4. A declaration that the [*the articles in question*] constructed and sold by the plaintiff are not infringements of any patent or other rights vested in the defendant.

DEFENCE.

189 —A—No.

In the High Court of Justice
Queen's Bench Division
[*or* Chancery Division
Mr. Justice ——]

Between A. B. Plaintiff.

and

C. D. Defendant.

DEFENCE.

1. The defendant denies that by the letters patent No. of or No. of or either of them referred to in paragraph of the statement of claim he threatened the plaintiff with any legal proceedings in respect of the sale by the plaintiff of [*the articles in question*] to [*the plaintiff's customer*] or in respect of any alleged sale of [*the articles in question*] or other inventions. The defendant does not and never did allege any such sale as aforesaid and he denies that the plaintiff in fact ever sold a [*the article in question*].

2. The invention referred to in paragraph of the statement of claim was the subject of letters patent granted to No. of 18 which expired in 18 . The defendant did not during the currency of the said letters patent claim and has not since the expiration of the said letters patent claimed to be patentee thereunder of the said invention the fact that the said letters patent had expired in 18 was well known to the persons to whom the letters complained of by the plaintiff were addressed.

3. The said letters were not written falsely or maliciously or with the object of injuring the plaintiff but were written *bonâ fide* under the circumstances hereinafter mentioned.

[*State the circumstances.*]

4. With regard to the invention referred to in paragraph of the statement of claim the said invention is the subject-matter of letters patent No. of 18 of which the defendant is the registered legal owner and the said letters are and always have been good and valid. Such threats having reference to the said letters patent as were in fact made by the defendant were made *bonâ fide* and with the intention of protecting his rights under the said letters patent.

5. The said has in fact infringed the defendant's said letters patent No. of in manner following that is to say [*add particulars*].

6. On the day of the defendant commenced an action [*add the title of the infringement action*] for the infringement of the said letters patent No. of . Such action is still pending and the defendant will rely on the same as an answer to this action.

REVOCATION OF LETTERS PATENT.

PETITION FOR REVOCATION.

In the High Court of Justice,
Chancery Division,
Mr. Justice ——

In the Matter of G. & G.'s Patent,
No. A.D. 18
and
In the Matter of the Patents, Designs, and
Trades Marks Act, 1883.

To Her Majesty's High Court of Justice

THE HUMBLE PETITION of S. S., of , in the City of London.

SHEWETH AS FOLLOWS :—

1. Your petitioner is an electrician, and the patentee of many inventions in connection with the production, distribution, and 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 specially 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 December 18 , 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 December 18 , your petitioner applied for and obtained a provisional protection, No. A.D. 18 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 accord-

ing to your petitioner's said invention, and the same have been shown to possess great advantages over other forms, and to be of great practical utility.

5. The sale and user of the said secondary generators made according to your petitioner's invention has recently been interfered with by a Limited Company named the National Company for the Distribution of Electricity by Secondary Generators (Limited). The said company claim to be entitled to restrain any person using any mode of electrical distribution by means of secondary generators, of whatever form or construction such generators may be.

6. The said claim of the aforesaid company purports to be based upon letters patent granted to L. G. and J. D. G., and numbered A.D. 18 . The invention in respect of which the said letters patent were granted was in no wise novel at the date of the same, and the said letters patent are and always have been of no force and validity by reason thereof and of the other matters set forth in the Particulars of Objection delivered herewith in pursuance of sec. 26 of the above-named Act.

7. The existence of the above-named letters patent claiming a wide and general monopoly of the system of distribution by means of secondary generators, which was known to and the property of the public at the date of the said letters patent, has been and is the cause of great injury to the public by preventing the sale of machines made according to your petitioner's invention, as well as those made by other inventors who likewise have made improvements in secondary generators and in the distribution of electricity thereby.

8. That the public are prejudiced by the above-mentioned general claim in the said letters patent, because consumers of electricity are not in general acquainted with the science of electricity and the technical application thereof, and are therefore unable to form an opinion as to the invalidity of the said letters patent, whereby the sale and use of improved secondary generators are wholly prevented.

9. The office of Mr. A. C. C. H., No. , , in the county of , is the place where the petitioner may be served with any petition or summons or notice of any proceedings or order of the Courts relating to the matters herein referred to.

Your petitioner therefore humbly prays for the revocation of letters patent No. A.D. 18 , 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.

S. Z.

It is intended to serve this petition on L. G., J. D. G., and the N. Co. for the Distribution of Electricity by Secondary Generators (Limited).

I hereby authorise the presentation to the High Court of Justice of the above written petition. Fiat of Attorney-General.

RICHARD E. WEBSTER,
Attorney-General.

ROYAL COURTS OF JUSTICE,
December 7th, 189 .

PROLONGATION OR EXTENSION OF LETTERS PATENT.

ADVERTISEMENT OF INTENTION TO PRESENT PETITION FOR PROLONGATION OR EXTENSION OF LETTERS PATENT.

In the Privy Council.

In the Matter of Letters Patent granted to
of , and bearing date the day
of 18 , and numbered .

Notice is hereby given, that it is the intention of
of , to present a petition to Her Majesty in Council praying that the term of the said letters patent may be extended. And notice is hereby further given, that on the day of inst., or on such subsequent day as the Judicial Committee of Her Majesty's Privy Council shall appoint for that purpose, application will be made to the said Committee that a day may be fixed for hearing the matter of the said petition, and any person or persons desirous of being heard in opposition to the said petition must enter a *caveat* to that effect in the Privy Council on or before the said day of next.

Dated this day of , 18 .

Solicitor for the Petitioner.

CAVEAT.

In the Privy Council.

In the Matter of Letters Patent granted to ,
of , and bearing date the day
of , and numbered .

Caveat issued on behalf of

Let nothing be done in reference to the above-mentioned patent without due notice to .

Dated this day of , 18 .

Solicitor for .

NOTICE OF OBJECTIONS TO EXTENSION OF TERM OF PATENT.

In the Privy Council.

In the Matter of Letters Patent granted to A. B., of , in the County of , for the Invention of "Improvements in the manufacture, &c.," bearing date the day of , 18 , and numbered .

In the Matter of the Petition o for an extension of the term of the said letters patent.

The grounds of objection of , of , to the granting of the prayer of the above-mentioned petition are the following—viz.

1. The alleged invention was not new at the date of the said letters patent. **Novelty denied.**

2. The alleged invention was not useful. **Utility denied.**

3. The alleged invention never has been, and is not likely to be, of great advantage to the public. **Merit denied.**

4. The petitioner has already received a full and adequate reward for the said alleged invention, and also large trade profits from the manufacture of under the monopoly created by the said letters patent. **Sufficient remuneration.**

5. If the petitioner has not been adequately rewarded, his want of proper remuneration has been caused by his own acts in not advertising and pushing the said invention, and in refusing to grant licences for the use of the same. **Laches of petitioner.**

6. The petitioner has permitted infringements of the said letters patent, and never brought actions to restrain such infringements. **Infringements.**

7. The allegations contained in the said petition are incapable of proof. **Allegations incapable of proof.**

Dated this day of , 18 .

Solicitor for

ADVERTISEMENT OF DAY FIXED FOR HEARING PETITION FOR PROLONGATION OR EXTENSION.

In the Privy Council.

In the Matter of Letters Patent granted to , of , and bearing date the day of 18 , and numbered .

Notice is hereby given, that their lordships, the Judicial Committee of the Privy Council, have appointed the day of , 18 , at half-past ten o'clock in the forenoon, for hearing the matter of the above petition.

Solicitor for the Petitioner.

PETITION FOR PROLONGATION OR EXTENSION OF LETTERS PATENT.

In the Privy Council.

Presented the day of , 18 .

To the Queen's Most Excellent Majesty in Council.

In the Matter of Letters Patent granted to R. R., formerly of No. , A. Road, now No. , H. Road, N. C., in the County of , Contractor, for the Invention of "A new or improved captain's bridge, constructed as a self-launching life-raft," dated the day of , 18 .

THE HUMBLE PETITION of the above-named R. R., formerly of No. , A. Road, now No. , H. Road, N. C., in the County of , Contractor.

SHEWETH:—

Invention. 1. That your petitioner, previously to the grant of the letters patent hereinafter mentioned, invented, after considerable personal application and cost, "A new or improved captain's bridge, constructed as a self-launching life-raft" (hereinafter called "the said invention"), which invention was and is of great utility, and therefore beneficial to the public.

Grant of letters patent. 2. That your Majesty was graciously pleased, by letters patent

under the Great Seal of the United Kingdom of Great Britain, bearing date the day of , 18 , to grant unto your petitioner R. R., his executors, administrators, and assigns, the sole privilege and authority to use the said invention within the said United Kingdom, the Channel Islands, and the Isle of Man for the term of fourteen years from the date of the said letters patent.

3. 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, particularly describing and ascertaining the nature of the said invention, and the manner in which the same was to be performed. Specification duly filed.

4. That your petitioner has not obtained any letters patent or brevets d'invention for his said invention in any foreign country. No foreign patent rights.

5. That your petitioner has expended large sums of money and devoted great pains and trouble while in health in endeavouring to introduce the said invention to the public and to bring the same into use. Expenditure, &c., on invention.

6. That your petitioner met with an accident while travelling on the South-Eastern Railway between London Bridge and Cannon Street on the 24th day of December, 1878, and in consequence thereof was confined to his bed until nearly the end of the year 1882. Accident to petitioner.

7. That your petitioner would have presented this his petition earlier, and about the 22nd day of October, 1886, when he called at the Privy Council Office for particulars as to presenting same; he was, however, unfortunately seized that day with a fit, and is only now able to attend to business. Cause of delay in presenting petition.

8. That your petitioner has, owing to his illness and other circumstances wholly beyond his control, failed to receive adequate benefit from his invention. Insufficient remuneration.

9. Your petitioner has no doubt that, if the term of the said letters patent should be extended, the said letters patent will become productive, and your petitioner will be able to obtain a fair reimbursement and remuneration commensurate with the great public value and importance of the said invention, and which his state of health will now allow him energetically to prosecute. Probability of invention becoming profitable.

10. That your petitioner's invention was tried practically, and with great success, in the month of February, 1883, on board H.M.S. *Polyphemus*, at Portsmouth, before Lord Northbrook and others, when the use of the invention for the saving of life was most amply demonstrated. Merits of invention.

Medals awarded for invention.

11. That your petitioner exhibited a model of his invention at the International Fisheries Exhibition held in London in 1883, when he was awarded a gold medal; and at the Naval and Submarine Engineering Exhibition held at the Agricultural Hall, Islington, in April, 1882, when he was awarded the first prize of 100 guineas.

Seven years' extension desired.

12. That your petitioner humbly submits that, under the circumstances of the case, an exclusive right of using and vending the said invention for the further period of seven years will not sufficiently reimburse and remunerate your petitioner.

Advertisements.

13. That your petitioner has given public notice by advertisements caused to be inserted the requisite number of times in the *London Gazette* and in other newspapers, pursuant to the statutes in that case made and provided, that it is his intention to apply to your Majesty in Council that the said letters patent may be extended for a further term.

Prayer.

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 this petition 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 you Majesty will be graciously pleased to grant to your petitioner a prolongation of the term by the said letters patent granted for the additional term of fourteen years, or for such term as to your Majesty shall seem fit.

And your petitioner will ever pray.

R. P. U.,
Solicitor for the Petitioner.

ANOTHER FORM.

In the Privy Council.

Presented day of , 18 .

To the Queen's Most Excellent Majesty in Council.

In the Matter of Letters Patent granted to W. A. M., late of , in the of , but now of and , in the of , for the Invention of "Improvements in apparatus for consuming smoke, promoting combustion, and feeding furnaces with fuel," bearing date the day of , 18 , No .

THE HUMBLE PETITION of W. M., of Nos. and , ,
in the of , , and of the
above-named W. A. M.

SHEWETH :—

1. That your petitioner the above-named W. A. M., previously to the grant of the letters patent hereinafter mentioned, invented, after considerable personal application and cost, certain "Improvements in apparatus for consuming smoke, promoting combustion, and feeding furnaces with fuel" (hereinafter called "the said invention"), which invention was and is of great utility and greatly beneficial to the public. Invention.

2. That your Majesty was graciously pleased, by letters patent under the Great Seal of the United Kingdom of Great Britain, bearing date the day of , 18 , to grant unto your petitioner W. A. M., his executors, administrators, and assigns, the sole privilege and authority to use the said invention within the said United Kingdom, the Channel Islands, and Isle of Man for the term of fourteen years from the date of the said letters patent. Grant of letters patent.

3. That your petitioner W. A. M., 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, particularly describing and ascertaining the nature of his said invention, and the manner in which the same was to be performed. Specification filed.

4. That your petitioner W. A. M. also obtained letters patent or brevets d'invention for his said invention in the Empire of France, dated the day of , 18 ; in the Dominion of Canada, dated the day of , 18 , and in the Kingdom of Norway, dated the day of , 18 . Foreign patent rights.

5. That letters patent, dated the day of , 18 , for the use of the said invention in the United States of America were also granted to your petitioner W. A. M., and one J. A., of Broadway, New York, to whom the said W. A. M. had by an agreement dated the day of 18 , agreed to grant an exclusive licence to make, use, and vend the said invention in the said United States at the royalty and upon the conditions in the same agreement mentioned. Your petitioner W. A. M. ultimately assigned one moiety of the last-mentioned letters patent to one E. H. A., of Boston, in the State of Massachusetts, in the United States aforesaid, your petitioner W. A. M. remaining the owner of the other moiety thereof. The said last-

mentioned letters patent were re-issued in the United States of America under date 18 .

Licences granted.

6. That by an indenture dated the day of , 18 , and made between your petitioner W. A. M. of the first part, and the said J. A. of the second part, after reciting that, by an assignment of even date, your petitioner had conveyed to the said J. A. an undivided half of his right in the said Canadian patent, your petitioner granted to the said J. A., his executors, administrators, and assigns, the exclusive licence to make, use, and vend the said invention in the Dominion of Canada at the royalty and upon the conditions in the same indenture mentioned.

7. That on the of , 18 , letters patent for the use of the said invention in the Empire of Austria were, on the nomination of your petitioner W. A. M., granted to a certain firm of B. N. & F., in consideration of a sum of £ by the last-named persons paid to your petitioner W. A. M., and an agreement on their part to pay to your last-named petitioner a royalty of £ per door, and a minimum yearly royalty of £ . The contract under which the said Austrian patent was obtained by the said B. N. & F. (which contract was dated in the year 18) provided for the obtaining by that firm of a patent or brevet d'invention for the use of the last-mentioned invention in Russia, but your petitioners have been unable to ascertain whether any such Russian patent was ever obtained. Your petitioners did not, nor did either of them, ever obtain any patent for the said invention in Russia. Your petitioners received from the said firm of B. N. & F. the aforesaid sum of £ , and a further sum of £ for royalties; but, except as aforesaid, they have not, nor has either of them, ever received any moneys from the last-mentioned firm.

Expiration of foreign patent rights.

8. That the said several letters patent or brevets d'invention for France, Canada, the United States of America, and Austria have all expired, or lapsed, or been abandoned. The said patent or brevet d'invention for Norway is still in force, but will expire on the day of , 18 .

Object of invention.

9. That the said invention relates to improvements in the means of consuming smoke and of effecting combustion in steam boilers, as also improvements in the means of supplying furnaces with fuel.

Expenditure, &c., on invention.

10. That your petitioner W. A. M. is a civil engineer, and he has for more than thirty years past devoted his attention to smoke-consuming apparatus, and has given much time and labour and expended very considerable sums of money in conducting experiments relating to the subject-matter of the said invention, and either alone, or with his then partner, one E. W., he obtained letters patent

for apparatus relating thereto, all of which last-mentioned letters patent have expired or become void.

Improvements produced by invention.

11. That previously to the time when your petitioner W. A. M. turned his attention to the subject, the smoke-consuming apparatus then known were ineffective on account of some of them failing to introduce the air to the furnaces in such a manner as to support combustion, and those apparatus which succeeded in consuming smoke diminished the efficiency of the fire and caused waste of fuel, and in some cases became destroyed by the action of the fire. These defects were sought to be remedied by an apparatus which was the subject of the letters patent dated , 18 , No. , granted to your petitioner W. A. M. and one J. P. This invention consisted of argand fire-bars, and the object was to cause an increased supply of atmospheric air to enter the furnace through the grate. This object, however, was not attained, by reason of the holes frequently becoming clogged with dross and clinker from the fire, rendering them useless as conductors of the air. Subsequently your petitioner W. A. M., and the said J. P., obtained letters patent of the , 18 , No. , for a contrivance which consisted in constructing the furnace with rocking bars. The object of the last-mentioned contrivance was to provide a means for keeping the surface of the grate free from the accumulations of dross, clinker, &c., and so to maintain a regular supply of air to the furnace from the ash-pit. This was sought to be accomplished by giving a rocking motion to the fire-bars. The system introduced by the last-mentioned letters patent proved to be defective in consequence of the fire-bars being necessarily too deep, and consequently impeding the passage of air and clogging the air spaces. In case the stoker neglected to frequently put these rocking bars in motion, they became fast, so that they could not be put in motion at all until the fire was out and the apparatus re-adjusted. Your petitioner W. A. M. then obtained letters patent of the , 18 , No. , for a contrivance the object of which was to secure lightness as well as strength, so that thin bars could be used. As these bars consisted of two parts, wrought and cast iron, and the parts had to be put together, the manufacture under this last patent was found to be too expensive.

Prior patents for allied but unsuccessful inventions.

12. That your petitioner W. A. M. also, in conjunction with one E. W., obtained provisional protection dated , 18 , and letters patent dated , 18 , for inventions connected with smoke-consuming apparatus, which, however, were not successful; and ultimately your petitioner W. A. M. invented the contrivance which was patented by the above-mentioned letters patent of day of , 18 , the subject of this

present petition. The general advantages of this invention are as follow :—It was found that the consumption of smoke could not be successfully carried out by the fire-bars, but that a proper admission of atmospheric air at the mouth of the furnace was required. The patent door the subject of the invention comprised in the last-mentioned letters patent accomplished that object. It secured a better control over the air admitted than any other system, and was easily manipulated. Being balanced, it would remain in whatever position it was set—a great advantage for marine purposes. The manner of consuming, or rather preventing, the smoke was by opening the door a few inches inward. This caused the atmospheric air to impinge on the fuel at the commencing point of combustion, causing the gases to be perfectly developed before leaving the furnace, an effect which may be compared with a glass chimney on a lamp.

Assignment of patent.

13. That by an indenture dated the day of , 18 , and made and executed between and by your petitioner W. A. M. of the one part, and your petitioner W. M. of the other part, your petitioner W. A. M., in consideration of the sum of £ , in the said indenture expressed to be paid by your petitioner W. M. to your petitioner W. A. M., assigned the said letters patent of the day of , 18 , to your petitioner W. M. for all the residue of the term of the said letters patent.

Non-payment of purchase-money.

14. That your petitioner W. M. is a son of your petitioner W. A. M., and at the date of the assignment was a clerk in the office of your last-named petitioner. That the sum of £ mentioned in the last-stated indenture was never paid by your petitioner W. M. to your petitioner W. A. M.; and the said assignment was, in fact, executed by your petitioner W. A. M. with the view to make a provision for his said son, your petitioner W. M., in the event of your petitioner W. A. M. dying during the continuance of the said letters patent, leaving his said son him surviving. That your petitioner W. M. is still in the employment of your petitioner W. A. M., and assists him in his business of a civil engineer, but does not participate in any profits thereof, and merely receives a salary. That the said letters patent of the day of , 18 , although vested under the assignment aforesaid in your petitioner W. M., are, and ever since the year 18 have been, worked for the sole benefit of your petitioner W. A. M.

Expenditure, &c., in endeavouring to introduce invention.

15. That your petitioner W. A. M. has expended large sums of money, and devoted great pains and labour, in endeavouring to introduce the said invention to the public, and to bring the same into use. That for this purpose your petitioners, or one of them, adver-

tised the said invention extensively, and personally undertook journeys to all parts of the country to visit various manufacturing towns and other places where it was likely the said invention would be taken up, and also employed travellers or agents to sell on commission fire-doors made according to the said invention, and also supplied such fire-doors free of expense to shipowners and manufacturers for the purpose of trial.

Insufficient remuneration.

16. That although, under the circumstances aforesaid, considerable numbers of fire-doors made according to the said invention comprised in the said letters patent of the day of , 18 , were sold, yet the necessary expenses of introducing the said invention as aforesaid were so great that it was only during the last year and nine months, or thereabouts, that is to say, the years 18 and 18 , that any profit was made from the said invention. In all other years since the date of the said letters patent, the working of the said letters patent, and the manufacture and sale of fire-doors made according to the said invention, resulted in losses, which far more than counter-balanced the profit of the years 18 and 18 aforesaid; and, on the whole, your petitioner W. A. M., instead of obtaining any profit from the said invention, has sustained a very considerable loss.

Only one licence granted in the United Kingdom.

17. That only one licence has ever been granted for the use of the said invention in the United Kingdom, that is to say, a licence to one J. B., of M. and O., which was granted by your petitioner W. A. M. in or about the month of , 18 . That the said licence was granted with a view to the establishment of the said J. B. as an agent for the sale of fire-doors made according to the said invention, but the business arising therefrom being very small and unprofitable to your petitioner, he in the month of , 18 , revoked the said licence. Your petitioner believes that the said J. B. made no profit whatever from his use of the said invention under the said licence.

Reasons for delay in public appreciation of invention.

18. That, at the time when your petitioners were endeavouring to introduce the said invention to the public, there were so many other inventions before the public having the same object as the said invention of your petitioner W. A. M. that it was very difficult to induce manufacturers and others te give a trial to any new invention; and further, the Acts for preventing smoke nuisance were not at that time so rigidly enforced as they are at present; and from these and other circumstances your petitioners experienced great difficulty in getting manufacturers and steam-users to give a trial to the said invention, and their endeavours to introduce the same to the public necessarily involved great expense on the part of your petitioners.

Utility of invention.

19. That of late the utility of the said invention has been generally acknowledged, and steam-users are now requiring that boilers made for them shall be fitted with fire-doors made according to the said invention, and compelling engineers to apply such fire-doors, and in consequence there has arisen a considerable demand (which is increasing) for fire-doors made according to the said invention. Moreover, the Lords Commissioners of the Admiralty have caused the boilers of ten of Her Majesty's ships to be fitted with the said fire-doors made according to the said invention; and your petitioner W. A. M. has supplied several of the said fire-doors for the boilers used at Her Majesty's Dockyard at Portsmouth, where they are now in use. Under the circumstances aforesaid, the working of the said letters patent and invention has resulted, during the last two years, in a considerable increase in the number of sales, with a diminution in the expenses of working.

Loss sustained by petitioner.

20. That, under the circumstances aforesaid, your petitioner W. A. M. has, notwithstanding his considerable outlay upon the said invention, been unable to obtain any profit thereupon, nor has he obtained any remuneration for his expense and labour in perfecting the same; but, on the contrary, he has sustained considerable loss in relation to the said invention, and it is only now, when the letters patent are about to expire, that the use of the said invention is becoming fully established and extending.

Probability of patent becoming productive.

21. That your petitioners have no doubt that, if the term of the said letters patent should be prolonged, the said letters patent will now become productive, and your petitioner W. A. M. will be able to obtain a fair reimbursement and remuneration commensurate with the great public value and importance of the said invention.

Seven years' extension asked for.

22. That your petitioners humbly submit that, under the circumstances of the case, an exclusive right of using and vending the said invention for the further period of seven years will not sufficiently reimburse and remunerate your petitioner W. A. M.

Advertisements.

23. That your petitioners have given public notice, by advertisements caused to be inserted the requisite number of times in the *London Gazette* and in metropolitan and country newspapers, pursuant to the statutes in that case made and provided, that it is their intention to apply to your Majesty in Council for a prolongation of the term of sole using and vending the said invention.

Prayer.

Your petitioners therefore humbly pray that your Majesty will be graciously pleased to take the case of your petitioners into your Royal consideration, and to refer the same to the Judicial Committee of your Majesty's most Honourable Privy Council, and that your petitioners may be heard before

such Committee by their counsel and witnesses, and that your Majesty will be pleased to grant to your petitioners a prolongation of the term of sole using and vending the said invention for the further and additional term of fourteen years, or for such other term as to your Majesty shall seem fit, and to grant new letters patent for the said invention to your petitioners for such term as to your Majesty shall seem fit, after the expiration of the first term originally granted by the existing letters patent hereinbefore mentioned according to the form of the statutes in such cases made and provided.

And your petitioners will ever pray, &c.

B. & R.,
Solicitors for Petitioners.

FORM OF ACCOUNTS WHICH MUST ACCOMPANY PETITION FOR PROLONGATION OR EXTENSION OF LETTERS PATENT.

IN THE PRIVY COUNCIL.

Re R. Patent, 18 , No.

STATEMENT OF RECEIPTS AND EXPENDITURE FILED ON PETITION FOR PROLONGATION OF PATENT.

Receipts.	£	s.	d.
18			
April Money received in prizes at exhibitions, viz. :—			
1st prize at Agricultural Hall, London . .			
Do. at the International Fisheries Exhibition			

Expenditure.	£	s.	d.
18			
April Taking out patent, making drawings, &c. .			
Making three working models, and exhibiting same at the London Tavern			
18			
June Exhibiting models at the Exhibition of Life Saving Apparatus at Liverpool . . .			
Dec. Exhibiting models at the Admiralty . .			
18			
April Paid Government stamp			
Paid patent agents' charges			
18			
May Exhibiting models at Fishmongers' Hall .			
18			
March Do. at United Service Institute . .			
May Do. do.			
Aug. Do. at the Royal Aquarium, when 1st prize silver medal was received			

		£	s.	d.
Nov.	Making two large working models of the *Princess Alice*, and exhibiting same to the jury at Woolwich, and at the Board of Trade Office, Poplar			
18				
April	Paid Government stamp			
	Paid patent agents' charges			
	Making eight working models to scale, and exhibiting same at the Naval and Submarine Exhibition at the Agricultural Hall, Islington, London—			
	Rent of space			
	Fitting up stand, &c.			
	Wages, attendance to show models			
	Carriage of models each way			
	Workmen's time and materials			
	Printing circulars, &c., in connection with same			
18				
April	Exhibiting models at Clarence House to H.R.H. the Duke of Edinburgh			
May	Do. do. at Admiralty to Sir Thomas Brassey			
	Do. do. to Sir Francis Sullivan			
	Carried forward			

Carried forward

		£	s.	d.
	Brought forward			
	Total Receipts	£		

		£	s.	d.
18	Brought forward			
July	Exhibiting models at Admiralty to Sir William Mends			
May to Oct.	Making eight improved large working models, and exhibiting same with others at the International Fisheries Exhibition, London—			
	Fitting up of stand and writing boards			
	Carriage of models			
	Attendants—			
	2 men for 6 months			
	1 man for 3 months			
	Making of models, workmen's time, and materials			
18				
	Taking models and exhibiting same in Germany—viz., Riel, Berlin, and Hamburg			
	Do. do. at Liverpool			
	Total Expenditure	£		

ANOTHER FORM OF ACCOUNTS WHICH MUST ACCOMPANY PETITION FOR PROLONGATION OR EXTENSION OF LETTERS PATENT.

18	*Receipts.*	£	s.	d.	£	s.	d.
	To Sale of 69 doors, as per press copy-book						
	Less discount . .						
	To Balance, being loss . .						
					£		

18	*Expenditure.*	£	s.	d.	£	s.	d.
	By Purchases of raw material for 69 doors, calculated to be at least						
	„ Trade expenses, as per cash-book, being one year's travelling—						
	Expenses of several travellers						
	Patent agents' charges .						
	Stationery . . .						
	Petty expenses for patterns, oil, and other trade expenses . ..						
	„ Commission, as per cash-book						
	„ Advertising						
	„ Wages of workmen . .						
	„ Rent, taxes, and lighting .						
	„ Bad debts						
					£		

The purchases for 18 , 18 , 18 , are calculated upon accounts in subsequent years. The actual vouchers for 18 , 18 , 18 , were destroyed when petitioner removed to new premises in F. Street, where room was very valuable, and, in consequence, old papers and books no longer considered necessary were not provided with room, but were destroyed. The above calculations for 18 , 18 , 18 , are based on actual accounts kept for ten years following.

18	*Receipts.*	£	s.	d.	£	s.	d.
	To Sale of 156 doors, as per press copy-book						
	Less discount						
	To Balance, being loss						

18	*Expenditure.*	£	s.	d.	£	s.	d.
	By Purchases of raw material for 156 doors, calculated to be at least						
	„ Trade expenses, as per cash-book, being one year's travelling—						
	Expenses of several travellers						
	Stationery						
	Patent agents' charges						
	Charges for patterns, oil, and other trade expenses						
	„ Commission, as per cash-book						
	„ Advertising						
	„ Wages of workmen						
	„ Rent, taxes, and lighting						
	„ Bad debts						

18	*Receipts.*	£	s.	d.	£	s.	d.
	To Sale of 301 doors, as per press copy-book						
	Less discount						
	To Balance, being loss						
					£		

18	*Expenditure.*	£	s.	d.	£	s.	d.
	By Purchases of raw material for 301 doors, calculated to be at least						
	„ Trade expenses, as per cash-book, being one year's travelling—						
	Expenses of several travellers						
	Law expenses incurred in recovering several debts						
	Patent fees						
	Stationery						
	Charges for patterns, oil, and other trade expenses						
	„ Commission, as per cash-book						
	„ Advertising						
	„ Wages of workmen						
	„ Rent, taxes, and lighting						
					£		

18	*Receipts*	£.	s.	d.	£	s.	d.
	To Sales of 254 doors as per press copy-book						
	Less discount						
	To Balance, being loss						
					£		

18	*Expenditure.*	£	s.	d.	£	s.	d.
	By Purchases of raw material for 254 doors, as per vouchers						
	„ Trade expenses, as per cash-book, being one year's travelling—						
	Expenses of several travellers						
	Law expenses incurred in recovering several debts						
	Bricklayers' work						
	Stationery						
	Charges for patterns, oil, and other expenses						
	„ Commission, as per cash-book						
	„ Advertising						
	„ Wages of workmen						
	„ Rent, taxes, and lighting						
					£		

18	*Receipts.*	£	s.	d.	£	s.	d.
	To Sale of 364 doors, as per press copy-book						
	Less discount						
	To Balance, being loss						
					£		

18	*Expenditure.*	£	s.	d.	£	s.	d.
	By Purchases of raw material for 364 doors, as per vouchers						
	„ Trade expenses, as per cash-book, being one year's travelling—						
	Expenses of several travellers						
	Bricklayers' work						
	Stationery						
	Charges for patterns, oil, and other trade expenses						
	„ Commission, as per cash-book						
	„ Advertising						
	„ Wages of workmen						
	„ Rent, taxes, and lighting						
					£		

18	*Receipts.*	£	s.	d.	£	s.	d.
	To Sale of 415 doors as per press copy-book						
	Less discount . . .						
	To Balance, being loss . .						
					£		

18	*Expenditure.*	£	s.	d.	£	s.	d.
	By Purchases of raw material for 415 doors, as per vouchers .						
	„ Trade expenses, as per cash-book, being one year's travelling—						
	Expenses of several travellers						
	Stationery . . .						
	Bricklayers' work . .						
	Charges for patterns, oil, and other trade expenses						
	„ Commission, as per cash-book						
	„ Advertising						
	„ Wages of workmen . .						
	„ Rent, taxes, and lighting .						
	„ Bad debts						
					£		

18	*Receipts.*	£	s.	d.	£	s.	d.
	To Sale of 473 doors, as per press copy-book						
	Less discount . . .						
	To Balance, being loss . .						
					£		

18	*Expenditure.*	£	s.	d.	£	s.	d.
	By Purchases of raw material for 473 doors, as per vouchers .						
	„ Trade expenses, as per cash-book, being one year's travelling—						
	Expenses of several travellers						
	Bricklayers' work . .						
	Stationery . . .						
	Charges for patterns, oil, and other trade expenses						
	„ Commission, as per cash-book						
	„ Advertising						
	„ Wages of workmen . .						
	„ Rent, taxes, and lighting						
	„ Bad debts						
					£		

18	*Receipts.*	£	s.	d	£	s.	d.
	To Sale of 365 doors, as per press copy-book						
	Less discount . . .						
	To Royalties—						
	England						
	America						
	To Balance, being loss . .						
					£		

18	*Expenditure.*	£	s.	d.	£	s.	d.
	By Purchases, as per vouchers, of raw material for 365 doors.						
	„ Trade expenses, as per cash-book, being one year's travelling—						
	Expenses of several travellers. . . .						
	Patent expenses (stamp) .						
	Stationery . . .						
	Bricklayers' work . .						
	Law expenses incurred in the recovery of several debts						
	Charges for patterns, oil, and other trade expenses						
	„ Commission, as per cash-book						
	„ Advertising						
	„ Wages of workmen . .						
	„ Rent, taxes, and lighting .						
					£		

18	*Receipts.*	£	s.	d.	£	s.	d.
	To Sale of 330 doors, as per press copy-book						
	Less discount . . .						
	To Royalties—						
	England						
	New York						
	Austria						
	To Balance, being loss . .						
					£		

18	*Expenditure.*	£	s.	d.	£	s.	d.
	By Purchases of raw material for 330 doors, as per vouchers .						
	„ Trade expenses, as per cash-book, being one year's travelling—						
	Expenses of several travellers						
	Stationery . . .						
	Bricklayers' work . .						
	Law expenses incurred in recovering several debts						
	Charges for patterns, oil, and other trade expenses						
	„ Commission, as per cash-book						
	„ Advertising						
	„ Wages of workmen . .						
	„ Rent, taxes, and lighting .						
					£		

18	*Receipts.*	£	s.	d	£	s.	d.
	To Sale of 325 doors, as per press copy-book						
	Less discount . .						
	To Royalties—						
	Austria						
	America						
	To Balance, being loss . .						
					£		

18	*Expenditure.*	£	s.	d.	£	s.	d.
	By Purchases of raw material for 325 doors, as per vouchers .						
	„ Trade expenses, as per cash-book, being one year's travelling—						
	Expenses of several travellers						
	Stationery . . .						
	Bricklayers' work . .						
	Charges for patterns, oil, and other trade expenses						
	„ Advertising, as per cash-book						
	„ Commission						
	„ Wages of workmen . .						
	„ Rent, taxes, and lighting .						
	„ Bad debts						
					£		

18	*Receipts.*	£	s.	d.	£	s.	d.
	To Sale of 311 doors, as per press copy-book						
	Less discount . . .						
	To Royalties—						
	England						
	To Balance, being loss . .						
					£		

18	*Expenditure.*	£	s.	d.	£	s.	d.
	By Purchases of raw material for 311 doors, as per vouchers .						
	„ Trade expenses, as per cash-book, being one year's travelling—						
	Expenses of several travellers						
	Stationery						
	Charges for patterns, oil, and other trade expenses						
	„ Commission, as per cash-book						
	„ Advertising						
	„ Wages of workmen . .						
	„ Rent, taxes, and lighting .						
	„ Bad debts						
					£		

18	*Receipts.*	£	s.	d.	£	s.	d.
	To Sale of 313 doors, as per press copy-book						
	Less discount . . .						
	To Royalties—						
	Austria						
	To Balance, being loss . .						
					£		

18	*Expenditure.*	£	s.	d.	£	s.	d.
	By Purchases of raw material for 313 doors, as per vouchers .						
	„ Trade expenses, as per cash-book, being one year's travelling—						
	Expenses of several travellers						
	Law expenses incurred in recovering several debts						
	Stationery . . .						
	Charges for patterns, oil, and other trade expenses						
	„ Commission, as per cash-book						
	„ Advertising . . .						
	„ Wages of workmen . .						
	„ Rent, taxes, and lighting .						
	„ Bad debts						
					£		

18	*Receipts.*	£	s.	d.	£	s.	d.
	To Sale of 411 doors, as per press copy-book						
	Less discount						
	To Royalties—						
	Austria						
					£		

18	*Expenditure.*	£	s.	d.	£	s.	d.
	By Purchases of raw material for 411 doors, as per vouchers						
	„ Trade expenses, as per cash-book, being one year's travelling—						
	Expenses of several travellers						
	Stationery						
	Charges for patterns, oil, and other trade expenses						
	„ Commission, as per cash-book						
	„ Advertising						
	„ Wages of workmen						
	„ Rent, taxes, and lighting						
	By Balance, being profit						
					£		

Receipts.	£	s.	d.	£	s.	d.
18						
(Eight months.)						
To sale of 181 doors, as per press copy-book, from January to August						
Less discount . . .						
				£		

Expenditure.	£	s.	d.	£	s.	d.
18						
(Eight months.)						
By Purchases of raw material for 181 doors, from January to August (eight months), as per vouchers						
„ Trade expenses, as per cash-book, being eight months' travelling—						
Expenses of several travellers						
Stationery . . .						
Charges for patterns, oil, and other trade expenses						
„ Commission, as per cash-book						
„ Advertising						
„ Wages of workmen . .						
„ Rent, taxes, and lighting for eight months (estimated) .						
„ Balance, being profit . .						
„ Balance brought down, value of plant and stock in 18 .						
„ Do. do. 18 .						
				£		

Summary.

Date.		Receipts.			Expenditure.			Profit.			Loss.		
		£	s.	d.	£	s.	d.	£	s.	d.	£	s.	d.
	18												
	18												
	18												
	18												
	18												
	18												
	18												
	18												
	18												
	18												
	18												
	18												
	18												
Jan. to Aug. (8 months)	18												
		£			£			£			£		

Stock £

£

Loss £

List of Firms supplied gratuitously with Furnace Doors.

						Cost.		
			£	s.	d.	£	s.	d.

ORDERS.

ORDER FOR REVOCATION OF LETTERS PATENT.

Re *Gaulard and Gibbs' Patent*, 4362, A.D. 1882
(*North, J., July* 9, 1888).

Upon the petition of S. Z. de F., in the
on the day of , 18 , preferred unto this Court, and upon hearing counsel for the petitioner and for the respondents, L. G. and J. D. G., and the N. Co. for the Distribution of Electricity by Secondary Generators, Limited, on the , 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 L. G. and J. D. G., be revoked. And it is ordered that the respondents L. G., J. D. G., and the N. Co. for the Distribution of Electricity by Secondary Generators, Limited, pay to the petitioner, S. Z. de F., his costs of the said petition, to be taxed by the taxing master on the higher scale.

SCHEDULE.

ORDER FOR FURTHER AND BETTER PARTICULARS OF OBJECTIONS.

Harris v. *Rothwell* (*Feb.* 13, 1886).

Upon, &c., this Court doth order that the defendant do on or before the day of , 1886, deliver to the plaintiff

further and better particulars in writing of his objections as to the validity of the letters patent on which he means to rely at the trial —viz.:

Portions of invention alleged to have been published.

1. By stating what portions of the plaintiff's invention are alleged to have been published prior to the date of the letters patent in each of the several publications in the particulars of objections mentioned by reference to the claiming clauses of the specification of the said patent.

Parts of prior publications relied on.

2. Also by stating more specifically the parts of the alleged publications relied on by the defendant in paragraph eleven of the said particulars of objections.

3. Also by stating more particularly the time and place of the alleged prior users.

Claim anticipated.

4. Also by stating, by reference to the claiming clauses of the specification of the plaintiff's patent, which portions of the said patent are alleged to be anticipated by each of such prior users.

Interrogatories.

And it is ordered that the plaintiff be at liberty to administer interrogatories for the examination of the defendant.

Costs.

And it is ordered that the costs of this application be costs in the action.

ORDER FOR LEAVE TO AMEND SPECIFICATION DURING ACTION OF INFRINGEMENT.

The Haslam Foundry and Engineering Company v. *Goodfellow and others* (*Kay, J., Dec.* 2, 1887).

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, and an affidavit of A. C., filed the 1st December 1887, and the exhibits therein referred to: it is ordered that the plaintiffs be at liberty to apply at the Patent Office for leave to further amend the specification of their patent, No. 1034 of the year 1877, 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 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 of this Court, with costs, to be taxed by the taxing master, and be paid by the plaintiffs, the Haslam Foundry and Engineering Company, Limited, to the defendants. And it is ordered that the costs of the defendants Messrs. G. & M., Messrs. L. & H., and Messrs. T. N. &

Son, 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, the Haslam Foundry and Engineering Company, Limited. And it is ordered that, in the event of this action proceeding, all other costs be reserved.

ORDER FOR LEAVE TO AMEND SPECIFICATION PENDING PETITION FOR REVOCATION OF PATENT.

Re *Gaulard and Gibbs' Patent* (*Kekewich, J., Nov.* 21, 1887).

Upon motion this day made unto this Court by counsel for L. G. and J. D. G., and the N. Company, the respondents to the petition preferred by the above-named S. Z. F., and upon hearing counsel for the said petitioner, an affidavit of the petitioner, S. Z. F., filed the day of , 18 , and an affidavit of J. D. G., filed the day of , 18 : this Court doth order that the applicants be at liberty forthwith to apply to amend their specification filed in pursuance of the above letters patent, No. of 18 , by way of disclaimer, the applicants undertaking to prosecute their proceedings with all diligence. And it is ordered that the petitioner be at liberty, within fourteen days after notice of the amendments made in the specification, either to amend his petition and the particulars of objection delivered by him, or to discontinue all proceedings thereunder. And it is ordered that the respondents L. G., J. D. G., and the N. Company do pay to the petitioner, S. Z. F., his costs of and consequent upon the presentation of his petition up to and including his costs of this motion. Costs to be taxed by the taxing master.

18 —A—No.

ORDER FOR INSPECTION.

The Haslam Foundry and Engineering Company, Limited v. *Goodfellow and others* (*Kay, J., April* 5, 1887).

Upon motion this day made unto this Court by counsel for the plaintiffs, and upon reading the writ issued in this action and affidavit of , &c. &c., and the plaintiffs by their counsel undertaking during the inspection hereinafter directed, or until further

order, not to threaten the defendants, Messieurs Goodfellow and Mathews, 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 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 [*scientific experts*] and solicitor, to inspect refrigerating machines manufactured and in course of manufacture by the defendants, Messieurs Goodfellow and Mathews, for the other defendants, or one of them, which are referred to in the said affidavit of R. M. in the said action of Goodfellow *v.* The Haslam Foundry and Engineering Company, Limited, 1887—G—573. And it is ordered that the costs of this application be costs in the action.

ORDER OF REFERENCE TO INDEPENDENT EXPERT FOR REPORT TO THE COURT DURING ACTION OF INFRINGEMENT.

Badische Anilin und Soda Fabrik v. *Levenstein.*(*a*)

The Court, being desirous of obtaining the opinion of Professor R. 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 February 25, 1878, No. 786, be supplied to the Professor.

SCHEDULE.

ORDER FOR EXPERIMENTS BEORE SCIENTIFIC EXPERT AND HIS REPORT TO THE COURT DURING ACTION OF INFRINGEMENT.

Edison and Swan United Electric Light Company, Limited v. *Holland and others* (*Kay, J., January* 1, 1888).

This Court, being desirous that experiments should be conducted as hereinafter mentioned, doth hereby order that experiments

(*a*) 2 P. O. R. 77.

confined to the repetition of experiments of which evidence has already been given before this Court on behalf of the plaintiff and defendants respectively upon the patent of , dated the day of , and numbered , be conducted before one of the following persons in the following rotation [*names of scientific experts*]. And the plaintiffs and defendants respectively are to repeat in the presence of the person before whom such experiments are conducted, and of two experts on each side, any of their said experiments of which evidence has been given as aforesaid which they may think fit, with the aid of assistants. Each side to choose the place at which its experiments shall be made. And it is ordered that such one of them the said before whom such experiments shall be conducted do report to the Court the nature and result of each experiment made before him.

FEES.

FEES IN REFERENCE TO THE REGISTRATION OF PATENT AGENTS.(*a*)

Nature of Fee.	When to be Paid.	To whom to be Paid.	Amount.
			£ s. d.
For registration of name of patent agent who had been *bonâ fide* in practice prior to the passing of the Act.	On application and before registration.	To the Registrar at the Institute.	5 5 0
For registration of name of any person other than as above.	Do. do.	Do.	5 5 0
Annual fee to be paid by every registered patent agent.	On or before November 30 of each year, in respect of the year commencing January 1st following.	Do.	3 3 0
On entry of a candidate for the final qualifying examination.	At time of entering name.	Do.	2 2 0

(*a*) This list forms Appendix C. to the Register of Patent Agents' Rules, 1889.

LIST OF FEES PAYABLE ON AND IN CONNECTION WITH LETTERS PATENT.(*b*)

Up to Sealing.

	£	s.	d.	£	s.	d.
1. On application for provisional protection	1	0	0			
2. On filing complete specification	3	0	0			
				4	0	0
or						
3. On filing complete specification with first application				4	0	0
4. On appeal from Comptroller to law officer. By appellant				3	0	0
5. On notice of opposition to grant of patent. By opponent				0	10	0
6. On hearing by Comptroller. By applicant and by opponent respectively				1	0	0
7. On application to amend specification:— 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 licence. By person applying				5	0	0
13. On opposition to grant of compulsory licence. By patentee				5	0	0

(*b*) This list forms the First Schedule to the Patent Rules, 1890.

		£	s.	d.
14.	On certificate of renewal :—			
	Before end of 4 years from date of patent .	50	0	0
15.	Before end of 7 years, or in the case of patents granted under the "Patents, Designs, and Trade Marks Act, 1883," before the end of 8 years from date of patent	100	0	0
	or in lieu of the fees of £50 and £100, the following annual fees :—			
16.	Before the expiration of the 4th year from the date of the patent	10	0	0
17.	„ „ 5th „ „	10	0	0
18.	„ „ 6th „ „	10	0	0
19.	„ „ 7th „ „	10	0	0
20.	„ „ 8th „ „	15	0	0
21.	„ „ 9th „ „	15	0	0
22.	„ „ 10th „ „	20	0	0
23.	„ „ 11th „ „	20	0	0
24.	„ „ 12th „ „	20	0	0
25.	„ „ 13th „ „	20	0	0
	On enlargement of time for payment of renewal fees :—			
26.	Not exceeding 1 month	3	0	0
27.	„ 2 months	7	0	0
28.	„ 3 months	10	0	0
29.	For every entry of an assignment, transmission, agreement, licence, or extension of patent .	0	10	0
30.	For duplicate of letters patent . . . each	2	0	0
31.	On notice to Comptroller of intended exhibition of a patent under section 39 . . . :	0	10	0
32.	Search or inspection fee . . . . . each	0	1	0
33.	For office copies . . . every 100 words (but never less than one shilling)	0	0	4
34.	„ of drawings, cost according to agreement.			
35.	For certifying office copies, MS. or printed, each	0	1	0
36.	On request to Comptroller to correct a clerical error . . . . . up to sealing	0	5	0
	after sealing	1	0	0
37.	For certificate of Comptroller under section 96 .	0	5	0
38.	For altering address in register	0	5	0

	£	s.	d.
39. For enlargement of time for filing complete specification, not exceeding one month . . .	2	0	0
40. For enlargement of time for acceptance of complete specification—			
Not exceeding one month	2	0	0
„ two months . . .	4	0	0
„ three months . . .	6	0	0

M. E. HICKS-BEACH,
President of the Board of Trade.

31*st March* 1890.

Approved:
R. E. WELBY,
For the Lords Commissioners of
Her Majesty's Treasury.

31*st March* 1890.

WAR OFFICE MEMORANDUM FOR INVENTORS.

WAR OFFICE,
January 1, 1886.

In consequence of the numerous claims for compensation for loss of time and for expenses incurred by private individuals in working out inventions of various kinds, as well as for rewards in consequence of the use of such inventions, the Secretary of State for War considers it necessary to make known the following regulations:—

(*a*) With regard to unpatented inventions—

(1) Persons who desire to submit any unpatented invention for consideration should do so by letter addressed to the Under Secretary of State for War. The letter should state the nature of the invention, and whether the person who offers it for consideration desires to make any claim to remuneration in connection with it. In the absence of such a statement, it will be assumed that no such remuneration is expected.

(2) Expenses incurred before the submission of an unpatented invention will not be considered to give a claim for repayment. No liability on behalf of the public will be recognised on account of loss of time or expenses incurred in connection with an invention after such submission, unless authority for such expenses has been previously given by letter, signed by one of the Under Secretaries of State, or the Director of Artillery; and the liability will be strictly confined to the limits of expenditure authorised in such letter.

(3) All claims for reward for an unpatented invention will be examined by a joint council of the Admiralty and War Office, to be held at the War Office, and if any payment be recommended by the council and approved by the Secretary of State for War, the sum will, with the concurrence of the Treasury, be included in the Estimates, but it will not be due to the claimant until after the vote is passed by the House of Commons.

(4) No claim for reward for an unpatented invention will be held to be established unless the invention has been adopted into the Service.

(*b*) With regard to patented inventions—

(5) By section 27 of the Patents, Designs, and Trade Marks Act, 1883, it is enacted as follows:—

"A patent shall have to all intents the like effect as against her Majesty the Queen, her heirs and successors, as it has against a subject.

"But the officers or authorities administering any department of the service of the Crown may by themselves, their agents, contractors, or others, at any time after the application, use the invention for the service of the Crown, on terms to be before or after the use thereof agreed on, with the approval of the Treasury, between those officers or authorities and the patentee, or, in default of such agreement, on such terms as may be settled by the Treasury after hearing all parties interested."

(6) Persons desiring to submit patented inventions should proceed on all points as laid down in paragraph (1).

(7) Should there be a statement to the effect that remuneration is expected in the event of the adoption and use of the invention by the Secretary of State for War, his agents, contractors, or others, and should there be such adoption and use, or an intention to adopt and use it, then in default of an agreement between the Secretary of State for War and the patentee, or his agent, as to the terms of remuneration, the Treasury will settle the terms after hearing all parties interested.

RALPH THOMPSON.

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