LETTERS PATENT FOR INVENTIONS.

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Sir John Hobkek Temple From the author.

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ABSTRACT OF REPORTED CASES

RELATING TO

LETTERS PATENT FOR INVENTIONS.

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PREFACE.

WITH a view to compress an abstract of the many long and complicated cases relating to patents for inventions within the limits of the present work, the writer has been careful to disentangle the real points in issue by a studied analysis of the decisions relating thereto, and has in every instance closely examined the specifications of the several patents now collected in the Library of the Patent Office.

It has been too much the practice, hitherto, to discuss the principles of law involved in a patent case without minute and trustworthy reference to the details of the particular invention as set forth by the express language of the specification and claim. But in order to understand the reasons which have influenced the Court or a jury in the decisions at which they have arrived, and in order to apply the principles involved in one case to the solution of a question arising in an analogous case, the patent itself must be before those dealing with the subject, or the arguments may be incorrectly founded, and the conclusion may be erroneous. The reference to a patent case is often eminently unsatisfactory, by reason that the statement of the invention or claim is given in general terms, and not in the words of the specification; from whence it may and often does arise that a proposition which is applicable to one existing state of facts is treated as if it were applicable to all other states of facts which come within the terms of a verbal definition, but are

really excluded from the primary meaning of the general proposition. One object of the present book has been to avoid this imperfect method of dealing with patent cases, and the plan which has been adopted may now be pointed out.

The pleadings are given, and the invention is described by following as closely as possible the language of the specification and by adding such information as may be necessary for its due comprehension. The claim is stated, together with the evidence at the trial, the direction of the judge, and the verdict or finding of the jury. Then follow the ulterior proceedings, which are extracted from the Reports, the only liberty taken being the allocation of detached sentences or parts of sentences, so as to cause the judgments of the learned judges to appear in each abstract as one continuous whole, though in an abbreviated form. Cases involving points of practice which have become obsolete are omitted; but some others, which might have been left out, are inserted as being of interest in recording the progress of patent law. Instead of an index, there is given a table of contents which may serve the purpose in view, and is so framed as to indicate to some extent the leading principles which govern the application of this branch of law. Having regard to the expected legislation upon patents for inventions, the cases before the Privy Council and caveats at the Great Seal have not been inserted.

T. M. GOODEVE.

GOLDSMITH BUILDING, TEMPLE:
July 1876.

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SUBJECT-MATTER OF A PATENT.

By stat. 21 Jac. I. cap. 3. sect. 6, all monopolies are rendered void except '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 patents or grant of such privilege hereafter to be made.'

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167 *Per* Lord Eldon, L.C.—Matter both of actual discovery and of useful discovery is the only proper subject for the protection of a patent.

108 *Per* Wood, V.C.—A thing of no value cannot be patented, but the invention must be a new and useful improvement in manufacture.

45 The word 'manufacture' commented on by Eyre, C.J.

94 The same by Pollock, C.B.

266 The same by Lord Westbury, L.C.

323 The same by Abbott, C.J.

180 *Per* Lord Kenyon, C.J. [referring to *J. Watt's* patent, A.D. 1769, No. 913].—I have no doubt in saying that this is a patent for a manufacture, which I understand to be something made by the hands of man.

45 Whether the manufacture be produced by accident or by art, is immaterial.

88 *Per* Tindal, C.J.—If the invention be new and useful to the public, it is not material whether it be the result of long experiments and profound research, or whether of some lucky thought, or of mere accidental discovery.

45 There cannot be a patent for a mere principle.

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46, 227 But for a principle embodied with corporeal substances so as to produce effects in any art, trade, or manual occupation there may be a patent.
69 Thus, *per* Lord Westbury, the refrigerating effect of air upon the sides of a tank for holding melted glass, is a thing for which, *per se*, no patent could be claimed; but an apparatus so constructed as to bring into operation the cooling property of atmospheric air, and to produce a useful effect, is the subject-matter of a patent.
128 *Cooke & Wheatstone's* patent (A.D. 1837, No. 7,390), so far as it related to the giving of duplicate signals at intermediate stations—supported, as showing the manner in which a principle might be carried out in practice.
189 *Per* Alderson, B.—There may be a patent for a principle coupled with the mode of carrying the principle into effect, provided both the principle and the mode of carrying it into effect have been discovered by the inventor.
227 A claim to every mode of carrying a principle into effect is the same thing as a claim to the principle itself.
210 *Minter's* patent (A.D. 1830, No. 6,034)—supported.
211 But afterwards upset, the claim being too large.
238 *Newton's* patent (A.D. 1843, No. 9,724)—supported, as embodying a new principle in a new construction.
48, 217 A new addition to an existing machine is the subject of a patent.
47, 61, 198 A new combination of old parts is the subject of a patent.
66 *Pochcron's* patent (A.D. 1866, No. 1,297) for an apparatus to be used in melting glass, consisting of:—(1), a tank; (2), a fire placed laterally to the tank; (3), the forming of a channel round the tank for the free circulation of atmospheric air—supported.
87 *Crane's* patent (A.D. 1836, No. 7,195) for applying a hot-air blast to the smelting of iron by anthracite coal—supported, as a new combination.
222 *Per* James, L.J.—The word 'combination' is not properly applied in *Crane* v. *Price*; but no judge has ever questioned the principle laid down by Tindal, C.J. in deciding that case, viz., 'That if the result produced by 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 is an invention or manufacture intended by the statute.'
80 Distinct improvements, for distinct purposes, are not to be classed together as parts of a combination.
89, 335 In point of law, there may be a valid patent for a combination which includes part of an invention already protected by a patent.
293 *Per* Lord Westbury, L.C.—A combination of known things

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which is attended with results of such utility and advantage to the public as to be rightly denominated 'a substantial improvement' is the subject of a patent.

319 *Per* Tindal, C.J.—Although one man has obtained a patent for a given object, there are many modes still open for other men of ingenuity to obtain a patent for the same object; there may be many roads leading to one place, and if a man has by dint of his own genius and discovery, after a patent has been obtained, been able to give to the public without reference to the former one, or borrowing from the former one, a new and superior mode of arriving at the same end, there can be no objection to his taking out a patent for that purpose.

102 *Per* Lord Westbury, L.C.—Where an invention is nothing more than a particular means to attain to a given result, which is well known, then the invention is for the means; and you cannot say that the invention of one set of means interferes with the invention of another, any more than you could say originally that there ought not to be patents granted for the invention of distinct means to an end. The discovery of a particular road to attain a particular end, does not at all interfere with the discovery of another road to attain that end.

167 *Per* Lord Eldon, L.C.—There may be a valid patent for a new combination of materials previously in use for the same purpose, or for a new method of applying such materials.

145 A new process may be the subject of a patent.

267 The word 'manufacture' comprehends a new process, or an improvement of an old process.

45 *Per* Eyre, C.J.—New processes in any art producing effects useful to the public are to be classed as manufactures.

94 Observation by Pollock, C.B. to the same effect.

317 *Swinborne's* patent (A.D. 1847, No. 11,975) for a process of manufacturing gelatine—supported.

324 A known substance, produced by a new process, is 'a new manufacture.'

330 *Willcox's* patent (A.D. 1862, No. 448)—supported, as a patent for a process and not for a product.

42 An invention for dispensing with one part of a double process may be patented.

47 *Per* Gibbs, C.J.—In point of law, it is necessary that the plaintiff should prove that this is a new and useful invention, in order to entitle himself to the present action [for infringement of a patent].

215 *Per* Alderson, B.—If an invention be of any use to the public, that is sufficient to support a patent.

158 In *Haworth* v. *Hardcastle*, the jury found that the invention was useful upon the whole, but that in some cases it was not useful; whereupon the Court inferred that the invention was useful in the generality of cases, and supported the patent.

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206 In *Hanton* v. *Parker* it was shown by experiments made in Court that the utility of the invention wholly failed, and the plaintiff was nonsuited.
214 Failure of utility in part of an invention. (*Morgan* v. *Seaward.*)
194 In *Lewis* v. *Marling*, a brush for raising the surface of cloth about to be shorn was claimed in the specification, but turned out to be useless; nevertheless the patent was sustained.
216 This case commented on by Parke, B.
265 *Per* Erle, C.J.—Although a patentee may have discovered how to use a known machine more beneficially than the owner knew, he cannot take a grant which virtually prohibits the owner from an existing right over his own property.
307 Judgment of Cresswell, J. to the same effect.
190 A more beneficial adjustment of the distance of certain working parts in a known machine is not the subject of a patent.
267 Every useful discovery is not the subject of a patent. The discovery must be shown to come within a fair extension of the meaning of the words, 'a new manufacture.'
219 *Per* Tindal, C.J.—Where unknown qualities possessed by a natural earth or stone, have, from the result of experiments, been applied to useful purposes of life, such application is a proper ground for a patent.
58. A new use of an old machine is not the subject of a patent.
59 *Per* Lord Campbell, C.J.—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. In all cases in which a patent has been supported, there has been some discovery, some invention. It has not been merely the application of old machinery, in the old manner, to an analogous substance. That cannot be the subject of a patent.
104 *Cutler's* patent (A.D. 1841, No. 9,140) for such an application, repealed by *sci. fa.*
152 *Wild's* patent (A.D. 1853, No. 651) for a new use of channelled iron in fishing or jointing rails for railways—not supported.
62 *Bush's* patent (A.D. 1841, No. 9,094) for a new use of a caisson for working under water—not supported.
180 *Horton's* patent (A.D. 1851, No. 13,436) for the use of channelled iron in forming hydraulic joints for gas-holders—not supported.
187 *Jordan's* patent (A.D. 1849, No. 12,824) for application of a timber coating to an iron frame in ships—not supported.
190 *Kay's* patent (A.D. 1825, No. 5,226)—not supported.
201 *Losh's* patent (A.D. 1830, No. 5,989) for the use of iron wheels on railways—not supported.
212 *Morewood's* patent (A.D. 1843, No. 9,720)—left in doubt.
240 *Ormson's* patent (A.D. 1857, No. 2,441) for casting a boiler of known form in one piece—not supported.

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248 A spherical sliding door to a spherical glass lamp, where a cylindrical sliding door has been previously fitted to a cylindrical lamp, is not the subject of a patent.
260 *Potter's* patent (A.D. 1842, No. 9,366) held to be bad, as not distinguishing an improvement included in the patent, and published before the date thereof.
326 *Willis's* patent (A.D. 1851, No. 13,538) for a new use of a double-beat valve in organs—not supported.
297 *Steiner's* patent (A.D. 1843, No. 9,860)—left in doubt so far as the proceedings were carried.
248 The application of a well-known tool to work previously untried materials is not the subject of a patent.
261 If the means essential for a novel application of an old thing be new, the patent may be supported. (*Pow* v. *Taunton.*)
252 *Penn's* patent (A.D. 1854, No. 2,114), for hard-wood bearings for propeller shafts—supported, notwithstanding an objection that it was merely a new application of an old thing.
270 The use of a new material to produce a known article is not the subject of a patent.
19, 124 If the invention be new in *England*, though practised beyond the sea before, a patent may be granted.
19 It does not lie upon the first importer of an invention to prove that its introduction was meritorious.
21 If a man keeps his invention shut up for twenty years, he may still have a patent for it.
3 A subordinate improvement, suggested by a servant who is employed to carry out experiments, may be embodied in a patent by his master, in a case where the invention is complete without reference to the improvement. (*Allen* v. *Rawson.*)
5 Relation of master and servant in *Rex* v. *Arkwright.*
14 The same in *Barker* v. *Shaw.*
38 The same in *Bloxam* v. *Elsee.*

Patents (not otherwise specially referred to) supported in respect of the Subject-matter.

7 *Johnson's* patent (A.D. 1860, No. 600).
29 *Betts's* patent (A.D. 1849, No. 12,415). The objection being that a claim for the manufacture of capsules out of the patented material was bad.
51 *Bovill's* patent (A.D. 1849, No. 12,636).
83 *Sievier's* patent (A.D. 1833, No. 6,366).
87 *Crane's* patent (A.D. 1836, No. 7,195).
170 *Hills's* patent (A.D. 1849, No. 12,867).
193 *Lewis, Lewis & Davis's* patent (A.D. 1818, No. 4,196).
237 *Newton's* patent (A.D. 1843, No. 9,724).
293 *Stead's* patent (A.D. 1838, No. 7,645).

Patents (not otherwise specially referred to) upset as claiming something not the Subject-matter of a valid grant.

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42 *Booth's* patent (A.D. 1852, No. 14,116). Claim:—'The making of gas direct from seeds,'—not in any mode pointed out in the specification, but generally.
58 *Brook & Hirst's* patent (A.D. 1856, No. 473).
208 *Metcalf's* patent (A.D. 1816, No. 4,065).
304 *Tetley's* patent (A.D. 1846, No. 11,081) held to be bad, both on this ground and also for want of novelty.
313 *Amet's* patent (A.D. 1856, No. 1,729), as claiming merely to substitute steel wire for whalebone in a known thing.
325 *White's* patent (A.D. 1864, No. 1,055) for sewing folds upon falls for bonnets in a specified manner.

TITLE OF PATENT.

Objections to the title over-ruled in the following Patents:—

18 *Berry's* patent (A.D. 1839, No. 8,194) for the daguerreotype process.
82 *Cook's* patent (A.D. 1840, No. 8,392), where Tindal, C.J. referred to the ruling in *Cochrane* v. *Smethurst*. (See page 81.)
117 *Derosne's* patent (A.D. 1830, No. 6,002). The objection being that the double process set forth in the title was not duly specified.
125 *Cooke & Wheatstone's* patent (A.D. 1837, No. 7,390).
135 *Sneath's* patent (A.D. 1831, No. 6,208).
167 *Hills's* patent, after disclaimer (A.D. 1849, No. 12,867).
208 *Mill's* patent (A.D. 1846, No. 11,266), after disclaimer.
225 *Neilson's* patent (A.D. 1828, No. 5,701).
239 *Nickels's* patent (A.D. 1842, No. 9,252). The objection being that in a patent for 'improvements' only one improvement was specified.
241 *Oxley's* patent (A.D. 1858, No. 776), where the patent was for 'improvements in the doors and sashes of carriages,' and the specification described improvements applicable to doors and windows generally.
293 *Stead's* patent (A.D. 1838, No. 7,645).
301 *Christ's* patent (A.D. 1827, No. 5,463).

Patents upset on objections founded on a comparison of the Title and Specification.

12 *Bainbridge's* patent (A.D. 1803, No. 2,693), where the consideration for the grant was not truly set forth.
38 *Gamble's* patent (A.D. 1801, No. 2,487) for the first machine for making paper.
60 *Brunton's* patent (A.D. 1813, No. 3,671).
65 *Campion's* patent (A.D. 1813, No. 3,682).
81 *Cochrane's* patent (A.D. 1813, No. 3,657).
89 *Croll & Richards's* patent (A.D. 1844, No. 10,096). Here the patentees specified an invention differing in part from that for which the

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patent had been granted; and, further, recited the title incorrectly in the specification.

133 *Felton's* patent (A.D. 1827, No. 5,512).

208 *Metcalf's* patent (A.D. 1816, No. 4,065).

214 *Galloway's* patent (A.D. 1829, No. 5,805).

323 *Wheeler's* patent (A.D. 1817, No. 4,112).

SPECIFICATION.

5 A specification is addressed to. persons having skill in the subject-matter thereof.

73, 167 Obligation in specifying (*per* Lord Eldon, L.C.).

6 A specification must not require those working under it to make any new inventions or additions.

214 *Per* Alderson, B.—It may call upon a workman to exercise all the actual existing knowledge common to the trade, but not to exercise his ingenuity or invention.

20, 318 It must define the invention so that an ordinary and skilful workman may carry it out.

320 Whether it has done so or not will be a question for the jury.

40 *Per* Abbott, C.J.—An inventor of a machine is allowed to call in aid the drawings which he annexes to the specification.

45 It is only necessary that the nature of the improvement should be understood, and *Watt's* patent for a steam-engine (A.D. 1769, No. 913) was held good without a drawing.

206, 300, 324 A specification must not leave anything to experiment.

220 *Per* Tindal, C.J.—People are not to 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 certain and easy procurement of the commodity for which the patent was granted.

227 Although a specification is bad when no beneficial result can be obtained without experiments, it is otherwise when experiments are only needed for producing that beneficial result in a higher degree.

119 Any ingredient set down for use must not be detrimental.

301 *Per* Lord Lyndhurst, L.C.—There must be the utmost good faith in a specification.

316 It must describe the invention in the clearest and most unequivocal terms of which the subject is capable.

145 *Per* Cresswell, J.—A patentee is bound to define his invention clearly in the specification, in order that the public may know with certainty what they may or may not do without incurring the risk of an action for an infringement of the patent.

306, 320 A specification must give the best information within the knowledge of the patentee.

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66, 141 It must not be ambiguous.
157 Nor equivocal.
90, 275, 316 Nor misleading.
6 The public have a right to demand a fair, full, and true discovery from one who gets so great a reward as a monopoly for fourteen years.
250 *Johnson's* patent for type metal (A.D. 1854, No. 817). Wood, V.C. held that a certain latitude in stating the proportions of the compound metal was permissible.
32 *Betts's* patent (A.D. 1849, No. 12,415)—supported on the ground that the proportions of lead and tin in the patented metal were sufficiently described by assigning the relative thicknesses of the plates of lead and tin before rolling. Such proportions are given rather as illustrations of the mode of user of the process than as definite *termini* which cannot be deviated from.
92 The public have a right to be put in possession of all that the patentee knows at the time of specifying.
48 There must be no fraudulent concealment.
6 *Per* Buller, J.—If a specification, in any part of it, be materially false and defective, the patent is against law, and cannot be supported.
93 The thing specified must be limited to the *bonâ fide* invention of the patentee.
268 Obligation in specifying where an invention is in part communicated from abroad.
84 Test of sufficiency of specification (*per* Tindal, C.J.).
284 *Medlock's* patent (A.D. 1860, No. 126) objected to, on the ground that the direction to take '*dry* arsenic acid' was insufficient; but Lord Westbury, L.C. over-ruled the objection.
20, 285 A specification which describes two ways of doing a thing, whereof one is impracticable, cannot be sustained.
305 A mistake may be corrected by reference to the specification itself.
18 *Berry's* patent (A.D. 1839, No. 8,194)—supported on this ground.
284 But errors which are only discoverable by experiment and further inquiry are fatal to the patent.
226 A statement which is erroneous and untrue will vitiate a specification.
40, 118 Introduction of *French* words into specifications drawn by foreigners. Patents supported.
220 *Per* Tindal, C.J.—If the specification [of *Muntz's* patent, A.D. 1832, No. 6,325] is not only difficult to understand, but is actually false and incorrect in the statement of proportions of zinc and copper, there is an end at once of the patent.
205 The omission of a material statement cannot be corrected by reference to the provisional specification.
190 *Per* Lord Cottenham, L.C.—The claim is not intended to aid the

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description, but is introduced for the security of the patentee, that he may not be supposed to claim more than he can support as an invention.

200 A specification may be good without a claim, and those matters which manifestly form no part of the invention need not be disclaimed.

211 The claim must not go beyond the invention.

242 Claim in *Oxley's* patent (A.D. 1858, No. 773) construed favourably for the patentee.

114, 277 After disclaimer the specification will be construed strictly.

265 But in *Ralston's* patent (A.D. 1858, No. 2,654, in part disclaimed), a claim to spiral grooves was held to include circular rings.

72 *Per* Lord Abinger, C.B.—A patentee should state what his invention is, what he claims to be new, and what he admits to be old.

307 *Per* Coleridge, J.—'If a specification includes what is old as well as what is new, the patentee must be taken to claim all, unless he makes it clearly appear that he does not claim that which is old.' Those parts which are notoriously old need not be disclaimed.

177 *Harrison's* patent (A.D. 1841, No. 8,818) upset for a breach of the above rule.

47 The like of *Bovill's* patent (A.D. 1811, No. 3,434).

204 The like of *McGregor's* patent (A.D. 1808, No. 3,189).

274 The like of *Saunders's* patent (A.D. 1825, No. 5,264).

299 *Martin's* patent (A.D. 1834, No. 6,688) upset for not distinguishing what acids and alkalis were claimed, and for not distinguishing those which would answer the purpose of the invention.

140 *Per* Lord Westbury, L.C.—The specification of a new combination or arrangement of machinery must assign the *differentia* thereof.

151 Or contain within itself the means of distinguishing the improvement. (See page 140.)

247 The specification of *Parkes's* patent (A.D. 1865, No. 2,615) read with a prior specification of same inventor (A.D. 1862, No. 1,876), and supported.

260 Any part of an improved machine which has been previously published should be distinguished.

227 *Per* Parke, B.—The construction of the specification belongs to the Court alone, whose duty it is to construe all such instruments, as soon as the true meaning of the words in which they are couched, and the surrounding circumstances, if any, have been ascertained as facts by the jury. (See page 309.)

171 This proposition commented on by Lord Westbury, L.C.

27 *Per* Lord Westbury, L.C.—Where two documents profess to describe an external thing, the identity of signification between the two documents containing the same description must belong to the province of evidence, and not to the province of construction.

158 *Per* Tindal, C.J.—There is no rule of law which requires the Court

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to make any forced construction of a specification, but it is to be construed consistently with the fair import of the language used.

299 Direction of Pollock, C.B. to the same effect.

237 It should not be scanned as if it were a plea specially demurred to.

272 *Per* Parke, B.—The Court is bound to read the specification so as to support the patent if it can be fairly done.

310 The rule in construing being:—'*ut res magis valeat quam pereat.*'

245 *Per* Pollock, C.B.—Where any expressions are ambiguous, we should endeavour to give effect to the intention; and, moreover, every patent should be expounded favourably to the patentee.

20 *Per* Cresswell, J.—The judge is to state what the specification orders to be done, and the jury are to say whether it would produce the result.

Questions of Construction arising on the Specifications of the following Patents:—

7 *Johnson's* patent (A.D. 1860, No. 600).

18 *Berry's* patent (A.D. 1839, No. 8,194).

48 *Bovill's* patent (A.D. 1846, No. 11,342).

51 *Bovill's* patent (A.D. 1849, No. 12,636).

114 *De la Rue's* patent (A.D. 1849, No. 12,904).

125 *Cook & Wheatstone's* patent (A.D. 1837, No. 7,390).

129 *Elliott's* patent (A.D. 1837, No. 7,508).

136 *Judkin's* patent (A.D. 1852, No. 413), after disclaimer.

147 *Goucher's* patent (A.D. 1848, No. 12,343).

167 *Hills's* patent (A.D. 1849, No. 12,867).

189 *Jupe's* patent (A.D. 1835, No. 6,788).

241 *Oxley's* patent (A.D. 1858, No. 776).

252 *Penn's* patent (A.D. 1854, No. 2,114).

263 *Ralston's* patent (A.D. 1858, No. 2,654), after disclaimer.

271 *Whitehouse's* patent (A.D. 1825, No. 5,109).

277 *Seed's* patent (A.D. 1846, No. 11,293), after disclaimer.

282 *Medlock's* patent (A.D. 1860, No. 126).

291 *Spencer's* patent (A.D. 1860, No. 120).

304 *Tetley's* patent (A.D. 1846, No. 11,081), both before and after disclaimer.

311 *Thomas's* patent (A.D. 1853, No. 1,026), after disclaimer.

313 *Trotman's* patent (A.D. 1852, No. 14,076).

317 *Swinborne's* patent (A.D. 1847, No. 11,975).

Comparison and Construction of Specifications by the Court in the following selected Cases:—

3 *Williams's* patent (A.D. 1840, No. 8,387), and *Robertson's* patent (A.D. 1838, No. 7,608).

22 *Betts's* patent (A.D. 1849, No. 12,415), and *Dobbs's* patent (A.D. 1804, No. 2,761).

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43 *Booth's* patent (A.D. 1852, No. 14,116), and *Heard's* patent (A.D. 1829, No. 5,771).
49 *Bovill's* patent (A.D. 1846, No. 11,342), compared with *Gordon's* patent (A.D. 1844, No. 10,165).
62 *Bush's* patent (A.D. 1841, No. 9,094), and *Cochrane's* patent (A.D. 1830, No. 6,018).
167, 170 *Hills's* patent (A.D. 1849, No. 12,857), compared with those of *Heard* (A.D. 1806, No. 2,941), *Croll* (A.D. 1840, No. 8,577), and *Laming* (A.D. 1847, No. 11,944).
177 *Harrison's* patent (Jan. 28, A.D. 1841, No. 8,818), and *Handcock's* patent (Dec. 18, A.D. 1840, No. 8,745).
218 *Muntz's* patent (A.D. 1832, No. 6,325), and *Collins's* patent (A.D. 1800, No. 2,390).
220 *Murray's* patent (A.D. 1866, No. 1,581), and *Dahlke's* patent (A.D. 1863, No. 49).
272 *Whitehouse's* patent (A.D. 1825, No. 5,109), and *Russell's* patent (A.D. 1824, No. 4,892).
307 *Tetley's* patent (A.D. 1846, No. 11,081), and *Ruthven's* patent (A.D. 1841, No. 8,896).
309 *Thomas's* patent (A.D. 1846, No. 11,464), and *Fisher & Gibbons's* patent (A.D. 1844, No. 10,424).
329 *Willcox's* patent (A.D. 1862, No. 448), and *Orr's* patent (A.D. 1867, No. 3,093).

Specifications of certain Patents which have been held sufficient.

250 *Johnson's* patent (A.D. 1854, No. 817). Held good on demurrer; the objection being that the proportions of tin and antimony in a patented type metal were not sufficiently stated.
7 *Johnson's* patent (A.D. 1860, No. 600)—supported by the Court before issues granted.
22 *Betts's* patent (A.D. 1849, No. 12,415). The objection being—that the proportions of lead and tin in the plated metal were not stated.
37 *Bickford's* patent (A.D. 1831, No. 6,159).
51 *Bovill's* patent (A.D. 1849, No. 12,636).
91 *Clegg's* patent (A.D. 1815, No. 3,968).
167, 170 *Hills's* patent (A.D. 1849, No. 12,867).
180 *J. Watt's* patent (A.D. 1769, No. 913). The objections being—that a patent for a steam engine with a separate condenser was a patent for a principle, and that the description was insufficient.
218 *Muntz's* patent (A.D. 1832, No. 6,325).
225 *Neilson's* patent (A.D. 1828, No. 5,701) for the application of the hot-blast in smelting iron.
245 *Parkes's* patent (A.D. 1865, No. 2,615)—supported by reference to prior patent of same inventor.
252 *Penn's* patent (A.D. 1854, No. 2,114).
262 *Poupard's* patent (A.D. 1859, No. 166).

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271 *Whitehouse's* patent (A.D. 1825, No. 5,109).
311 *Thomas's* patent (A.D. 1853, No. 1,026), after disclaimer.
317 *Swinborne's* patent (A.D. 1847, No. 11,975).

Specifications insufficient.

5 *Arkwright's* patent (A.D. 1775, No. 1,111).
47 *Brown's* patent (A.D. 1811, No. 3,434).
117 *Derosne's* patent (A.D. 1830, No. 6,002).
136 *Judkins's* patent (A.D. 1852, No. 413).
156 *Johnstone's* patent (A.D. 1844, No. 10,446).
204 *McGregor & Macfarlane's* patent (A D. 1808, No. 3,189).
204 *Macklean's* patent (A.D. 1857, No. 2,338).
263 *Ralston's* patent (A.D. 1858, No. 2,654), after disclaimer.
275 *Savory's* patent (A.D. 1815, No. 3,954).
282 *Medlock's* patent (A.D. 1860, No. 126).
298 *Martin's* patent (A.D. 1834, No. 6,688).
315 *Turner's* patent (A.D. 1781, No. 1,281).
323 *Wheeler's* patent (A.D. 1817, No. 4,112).

Relation between the complete and provisional Specifications.

136 *Judkins's* patent (A.D. 1852, No. 413).
230, 233 *Newall's* patent (A.D. 1855, No. 1,091).
252 *Penn's* patent (A.D. 1854, No. 2,114).
311 *Thomas's* patent (A.D. 1853, No. 1,026).
329 *Willcox's* patent (A.D. 1862, No. 448).
167 Variance between the deposit paper and the specification.
92 *Per* Lord Tenterden, C.J.—I do not see why time is allowed to the inventor to prepare his specification, unless it be to allow him to mature the mechanical parts of his invention.
241 Effect of provisional specification when abandoned.

Questions relating to Disclaimers.

136 *Judkins's* patent (A.D. 1852, No. 413).
208 Admissibility of disclaimer in evidence.
263 Function and validity of disclaimer in *Ralston's* patent (A.D. 1858, No. 2,654).
277 *Seed's* patent (A.D. 1846, No. 11,293).
311 *Thomas's* patent (A D. 1853, No. 1,026).

NOVELTY OF INVENTION.

237 *Per* Alderson, B.—In considering whether an invention is new, the proper mode is to take the specification and see whether the matter claimed *as a whole* is new. The question of novelty will depend on whether the whole taken together is new.
69 Test of novelty (*per* Lord Hatherley, L.C.)
88 *Per* Tindal, C.J.—If the invention be new and useful to the public,

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it is immaterial whether it be the result of profound research or of accidental discovery.

60, 166, 303, 308 If any material part of an alleged discovery fail in novelty, the patent is altogether void.

182 *Per* Lord Lyndhurst, L.C.—The notorious public use of an invention before the granting of letters patent, although it may have been discontinued, is sufficient to invalidate the grant.

73 *Per* Alderson, B.—Public use means a use in public so as to come to the knowledge of others than the inventor. And, *per* Lord Abinger, C.B.—It means a use and exercise in public, not by the public.

73 It need not appear that the invention was used up to the time of taking out the patent.

85 If the secret covered by a patent has been previously publicly communicated to the world by any one, there is an end of the patent.

182 *Per* Lord Lyndhurst, L.C.—If the machine be published in a book, distinctly and clearly described, corresponding with the description in the specification of the patent, though it has never been actually worked, is not that an answer to the patent?

85 The same by Tindal, C.J.

7 Evidence of prior publication in *Rex* v. *Arkwright.*

145 If a man has borrowed an invention from some other person, or taken it from a book, or learnt it from a specification, he is not the true and first inventor.

28 A barren general suggestion, not capable of practical operation, will not avoid, for want of novelty, an invention which involves a practical truth productive of beneficial results.

31 In order to anticipate a patent the anterior description should enable those who work under it, and are of competent mechanical skill, to arrive at the same result as if they followed the process contained in the subsequent patent.

171 *Per* Lord Westbury, L.C.—The prior knowledge of an invention to avoid a patent must be a knowledge equal to that required to be given by a patent.

22 Evidence of prior publication in *Betts* v. *Menzies.*

170 Evidence of prior publication in *Hills* v. *Evans.*

192 Evidence of prior publication in *Lang* v. *Gisborne.*

220 Evidence of prior user in *Muntz* v. *Foster.*

295 Observations (*per* Tindal, C.J.) on prior publication. (*Stead* v. *Williams.*)

296 The same by Parke, B. (*Stead* v. *Anderson.*)

241 *Oxley* v. *Holden.* Effect of provisional specification when abandoned.

217 The deposition (for sale) of patented articles in a warehouse, without actual sale, held not to be sufficient evidence of publication to defeat a claim for novelty of invention.

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25 *Betts's* patent (A.D. 1849, No. 12,415)—supported on the ground of novelty, although the patentee had manufactured large quantities of his capsules before the date of the patent.
30 In *Betts* v. *Neilson*, Lord Chelmsford, L.C. said that if the evidence established the fact that *Betts's* compound metal had, upon any occasion before the patent, been manufactured openly, not by way of experiment but in the course of business, although not a single piece of the material had been actually sold, he should hold that the patent was invalidated.
72 Where certain locks were made and sold in *England* (presumably for export) before being patented, Lord Abinger, C.B. was of opinion that the novelty of the invention was destroyed.
179, 327 Prior public sale.
164 *Per* Erle, J.—Where a manufacturer has used a process for profit, and has kept the method entirely secret, I am not prepared to say that another person could have a valid patent for the process. And, *per* Lord Campbell, C.J.—If a man makes a discovery, and uses it without taking out a patent, he need not suspend the use because another person subsequently makes the same discovery, and takes out a patent for it.
85 In *Cornish* v. *Keene*, Tindal, C.J. directed the jury:—If the defendants have shown that they practised the invention, and produced the same result in their factory before the time the patent was obtained, they cannot be prevented by the subsequent patent from going on with that which they have done.
142 A mere course of experiments for the purpose of producing a result which is not carried on to perfection, and which rests in unsuccessful experiment, will be no bar to a subsequent patent for the completed invention.
145 It will not be enough that learned persons in their studies had foreseen or found out a discovery that is afterwards patented.
85 *Per* Tindal, C.J.—A man may make experiments in his own closet for the purpose of improving any art or manufacture in public use; but if he does not communicate 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, may take out a patent for the invention; and it will be no answer to him to say that another person before him had made the same experiments, and therefore that he was not the first discoverer.
122 *Dollond's* patent (A.D. 1758, No. 721)—supported on this ground.
337 Great Seal refused, where the invention had been used in view of the public before application for a patent.
86 Whether a discovery has rested in experiment or has come into public use is a question for the jury.
21 *Thornton's* patent (A.D. 1841, No. 9,207)—supported, where a machine for making wire cards had been lent for an experimental trial.

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232 *Newall's* patent (A.D. 1855, No. 1,091)—supported, although there had been prior experimental user of the apparatus.
141 *Galloway* v. *Bleaden.*
185 *Jones's* patent (A.D. 1826, No. 5,415)—supported, where an experimental wheel made on the suspension principle (as subsequently patented) had been publicly used, but abandoned as useless.
320 *Walton's* patent (A.D. 1834, No. 6,584)—supported.
179 *Porter's* patent (A.D. 1838, No. 7,774)—not supported.
43 When the want of novelty appears distinctly on a comparison of two specifications, the Court will not submit the question of identity of the documents to the jury.
27 *Per* Wilde, B.—The Court can pronounce two identical descriptions to portray identical inventions; but when the descriptions are different, the identity in substance of the two inventions is a matter to be established by extrinsic evidence.
222 *Per* James, L.J.—I am not aware of any principle or authority upon which the exhibition of a useless machine, which turns out a failure, can be held to affect the right of a patentee who has made a successful machine, although there may be a degree of similarity between some of the details of the two machines.

Patents supported for Novelty of Invention.

1 *Williams's* patent (A.D. 1840, No. 8,387).
15 *Bateman & Moore's* patent (A.D. 1848, No. 12,032).
22 *Betts's* patent (A.D. 1849, No. 12,415).
51, 53 *Bovill's* patent (A.D. 1849, No. 12,636).
66 *Pocheron's* patent (A.D. 1866, No. 1,297).
87 *Crane's* patent (A.D. 1836, No. 7,195)—supported, although it included the subject-matter of another patent then running and in force.
141 *Galloway's* patent (A.D. 1835, No. 6,887).
184 *Kneller's* patent (A.D. 1828, No. 5,718).
194 *Lewis, Lewis & Davis's* patent (A.D. 1818, No. 4,196).
214 *Galloway's* patent (A.D. 1829, No. 5,805).
218 *Muntz's* patent (A.D. 1832, No. 6,325).
220 *Murray's* patent (A.D. 1866, No. 1,581).
225 *Neilson's* patent (A.D. 1828, No. 5,701).
235, 237 *Newton's* patent (A.D. 1843, No. 9,724).
252 *Penn's* patent (A.D. 1854, No. 2,114).
262 *Poupard's* patent (A.D. 1859, No. 166).
271, 272 *Whitehouse's* patent (A.D. 1825, No. 5,109).
318, 320 *Walton's* patent (A.D. 1834, No. 6,584).
331 *Young's* patent (A.D. 1850, No. 13,292).

Patents upset for want of Novelty.

42 *Booth's* patent (A.D. 1852, No. 14,116).
60 *Brunton's* patent (A.D. 1813, No. 3,671). Here the patent was for three improvements, whereof one was old.

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62 *Bush's* patent (A.D. 1841, No. 9,094).
65 *Campion's* patent (A.D. 1813, No. 3,682).
103 *Cutler's* patent (A.D. 1815, No. 3,873).
121 *Dobbs's* patent (A.D. 1838, No. 7,716).
131 *Else's* patent (A.D. 1779, No. 1,235).
142 *Gamble's* patent (A.D. 1839, No. 8,000).
144 *Campbell & Gibson's* patent (A.D. 1836, No. 7,228).
163 *Heath's* patent (A.D. 1839, No. 8,021), after prolongation.
179 *Porter's* patent (A.D. 1838, No. 7,774), where an anchor, similar to that patented, was sold in the regular way of business.
201 *Losh's* patent (A.D. 1830, No. 5,989).
202 *Brooman's* patent (A.D. 1850, No. 13,398).
206 *Macnamara's* patent (A.D. 1837, No. 7,324).
211 *Minter's* patent (A.D. 1830, No. 6,034).
259 *Potter's* patent (A.D. 1842, No. 9,366).
274 *Saunders's* patent (A.D. 1825, No. 5,264).
304 *Tetley's* patent (A.D. 1846, No. 11,081).
308 *Thomas's* patent (A.D. 1846, No. 11,464).
326 *Willis's* patent (A.D. 1851, No. 13,538).
327 *Zink's* patent (A.D. 1812, No. 3,519).

INFRINGEMENT.

319 *Per* Tindal, C.J.—Where a party has obtained a patent for a new invention, or a discovery he has made by his own ingenuity, it is not in the power of any other person, simply by varying in form or in immaterial circumstances the nature or subject-matter of that discovery, either to obtain a patent for it himself, or to use it without the leave of the patentee.
214 In *Morgan* v. *Seaward*, Alderson, B. directed the jury:—The question simply is, whether the difference consists merely in the substitution of what are called mechanical equivalents for the contrivances resorted to by the patentee. You are to look at the substance and not the mere form.
79 *Per* James, L.J.—In a patent for a combination there is, or may be, an essence or substance of the invention underlying the mere accident of form; and the invention may be pirated by a theft in a disguised or mutilated form. It will be a question of fact whether the alleged piracy is the same in substance and effect, or is a substantially new or different combination.
237 *Per* Pollock, C.B.—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 purpose for which the patentee has adapted his invention, and the jury are of opinion that the difference is merely colourable, it is an infringement.
16 *Per* Martin, B.—The law will not permit a person to take an article

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that has been patented, and to give a substitute in place of it, 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.
226 In *Neilson* v. *Harford*, Parke, B. directed the jury:—Though unquestionably what the defendants have done is a great improvement upon the apparatus constructed under this patent, it appears to me that it would be an infringement of it.
273 In *Russell* v. *Ledsam*, the Court of Exchequer held that the defendant's mode of welding the edges of iron tubes without a mandril, although in some respects an improvement on *Whitehouse's* patent (A D. 1825, No. 5,109), was in others the same, and was an infringement of it.
16 In *Bateman* v. *Gray*, Martin, B. directed the jury:—If you believe that the defendant's instrument was taken substantially from the plaintiffs', and that what he has produced is nothing more than a substitution of other and equivalent means for producing the same end, even though the means employed might be better than those of the plaintiffs, it is my duty to tell you that is an infringement of the patent.
199 A patent for a combination may be infringed by taking a part, provided it is a new and material part, of the combination. Also, the part must be new in itself, not merely in its application. (*Lister* v. *Leather*.)
200 But it must be applied to an analogous purpose.
325 The parts of a combination taken must themselves be new, or there is no infringement. (*White* v. *Fenn*.)
52 In *Bovill* v. *Keyworth*, Lord Campbell, C.J. said:—The defendants are liable for having used a material part of the process which was new for the same purpose as that mentioned in the specification, although they did not at the same time use all the parts of the process specified.
282 Judgment of Pollock, C.B. in *Sellers* v. *Dickinson*.
287 Judgment of Lord Campbell, C.J. in *Smith* v. *London and North-Western Railway Company*.
237 *Per* Alderson, B.—If an invention consists of something new, and a combination of that with what is old, then if an individual takes for his own and uses that which is the new part of the patent, that is an infringement of it. (*Newton* v. *Grand Junction Railway Company*.)
247 *Per* James, L.J.—To say that a patent for an entire combination is a valid patent for a part when that part would not of itself have been patentable, is, in my judgment, a *reductio ad absurdum* of the supposed principle in *Lister* v. *Leather*.
249 *Per* Willes, J.—The infringement of any part of a patented process is actionable, if the part of itself is new and useful, so that it

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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.
125, 329 Infringement by pirating part of an invention
146 Where a patent is for improvements, and one of them has been pirated, an action may be sustained.
80 Distinct improvements for distinct purposes are not to be classed together under the head of a combination. (*Clark* v. *Adie.*)
71 A new combination of machinery directed to a particular purpose is infringed by the adoption of the same combination for minister-ing to another and additional purpose. (*Cannington* v. *Nuttall.*)
69 Where an object the same as that patented is attained by the same process, introduced for the purpose of attaining it—there is an infringement.
189 In *Jupe* v. *Pratt*, Alderson, B. said:—If you have not only dis-covered a principle, but have also invented some mode of carry-ing that principle into effect, you are entitled to protect yourself from all other modes of carrying the same principle into effect, such modes being treated by the jury as a piracy of your inven-tion.
162 *Per* Parke, B.—There may be an indirect infringement as well as a direct one, though the intention of the party be perfectly innocent, and even though he may not know of the existence of the patent itself.
186 A man may make a patented article for his own amusement or as a model without infringing.
165 There is no infringement of a patent unless a saleable article is produced. (*Higgs* v. *Goodwin.*)
235 But the thing constructed may infringe without being separately prepared and vendible, as in the case of fitting a ship for the reception and laying of a telegraph cable. (*Newall* v. *Elliot.*)
50 The claim of invention in an action for infringement is that which the plaintiff is legally entitled to make.
280 *Per* Lord Wensleydale.—The opinion of scientific witnesses that one machine is a piracy of the other is of no consequence what-ever, for that is a question not in their province to decide. (*Seed* v. *Higgins.*)
In this case the models were before the Court, and the learned judges formed their own opinion as to the infringement.
116 Cases distinguished—where the judge is bound to submit the ques-tion of infringement to the jury.
183 In *Huddart* v. *Grimshaw*, the production of a piece of rope, having the essential qualities of that made according to plaintiff's patent, was held to be *primâ facie* evidence of infringement.
245 In *Palmer* v. *Wagstaffe*, where the patent was for the mode of making a candle with wicks which did not require snuffing, the

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simple production of a candle was held not to be evidence of infringement.

29 *Betts* v. *Neilson.* Infringement by the user of the patented article *in transitu* through *England.*

33 *Betts* v. *De Vitre.* Personal liability of directors of a company for infringement.

36 *Betts* v. *Willmott.* No evidence of infringement; the plaintiff being unable to show that the capsules in question had not been made and sold by his own house in *Paris.*

130 *Elmslie* v. *Boursier.* Infringement by importation and sale of patented articles.

322 The same in *Walton* v. *Lavater.*

331 An exclusive right to 'vend' is given by a patent.

144, 329 Infringement by sale of patented articles.

210 Exposure for sale.

242 User by offering patented articles for sale.

Evidence of Infringement in the following cases:—

1 *Allen* v. *Rawson* (where a drum was substituted for an endless apron in a felting machine).

15 *Bateman* v. *Gray.*

51 *Bovill* v. *Keyworth* (where a rotating upper millstone was substituted for a fixed upper millstone).

107 *Dangerfield* v. *Jones.*

114 *De la Rue* v. *Dickenson* (where the flaps of envelopes were blown down by jets of air for the purpose of being folded in a machine instead of being creased by separate folding instruments; and, further, where gum was taken from a reservoir instead of from the surface of an apron).

125 *Electric Telegraph Company* v. *Brett* (where the patent was for giving signals by electric currents transmitted through *metallic circuits*, and the infringement consisted in the use of a circuit, part of which was the earth itself).

142 *Gamble* v. *Kurtz* (where a patent for the use of iron retorts worked in combination for the manufacture of sulphate of soda was infringed by the use of two chambers, one of brick and the other of iron).

147 *Goucher* v. *Clayton.*

165 *Hill* v. *Thompson.*

173 *Hills* v. *Liverpool Gas Company* (where a patent for purifying gas by artificial hydrated oxide of iron was held to be infringed by the use of bog-ochre after it had been re-oxidised).

219 *Muntz* v. *Foster.* *Per* Lord Lyndhurst, L.C.—If the metals were originally combined in their greatest purity, the invasion is plain and direct. If they were purified in the course of the process,

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this, I think, would constitute a colourable invasion of the plaintiff's invention.

220 *Murray* v. *Clayton* (where, in adapting a brick-making machine, defendants made a transposition, and instead of moving the clay against the cutting wires, they moved the cutting wires against the clay).

230 *Newall* v. *Elliot* (where a telegraph cable was coiled around a cone of small vertical angle with a conoidal top, and defendants used a cylindrical core with a hemispherical cover).

235 *Newton* v. *Grand Junction Railway Company* (where a patent for soft metal bearings was infringed by rubbing a piece of tin on the inside of a brass bearing when sufficiently heated to melt the tin and produce a layer of soft metal).

263 *Ralston* v. *Smith* (where, in a machine for giving a *moiré antique* finish to fabrics, the patentee used a roller with from sixty-two to seventy-four circular grooves per inch, and defendant had a spiral groove on a similar roller with sixty-eight turns to the inch).

271 *Russell* v. *Cowley*.

272 *Russell* v. *Ledsam*.

281 *Sellers* v. *Dickinson* (where, in a patented apparatus for stopping a loom automatically when the shuttle remained in the shed, defendant adopted a material portion, viz., a friction break).

286 *Smith* v. *London and North-Western Railway Company* (where defendants imitated a mode of welding separate pieces to form an iron wheel by welding sectors to form the nave).

313 *Trotman* v. *Wood*.

329 *Wright* v. *Hitchcock*.

331 *Young* v. *Fernie*.

Cases where the Allegation of Infringement has not been sustained.

13 *Barber* v. *Grace* (where a patent for finishing hosiery by pressure between hot boxes was not infringed by the use of heated rollers).

48 *Bovill* v. *Pimm*.

78 *Clark* v. *Adie*. Sub-combination of parts.

97 *Curtis* v. *Platt*. Where different combinations of like elements are employed to produce a known result, the case should not be examined in a generic form without regard to the specific differences which exist between the two agents. It cannot be said that there ought not to be separate patents granted for the invention of distinct means to an end.

159, 160, 161 *Heath* v. *Unwin* (where a patent for the use of carburet of manganese in the manufacture of cast steel was held not to have been infringed by the use of coal tar and oxide of manganese).

202 *McCormick* v. *Gray* (where the patent was for a reaping machine, and the infringement consisted in the making and selling of a cutting blade similar to that used in the patented machine).

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212 *Morewood* v. *Tupper*—left in doubt.
245 *Parkes* v. *Stevens* (where the patent was for a globular lamp with a sliding door; and the Court held that the use of a sliding door in a lamp of different construction, but the same form, did not constitute an infringement).
277 *Seed* v. *Higgins* (where, after disclaimer, plaintiffs were restricted to the particular apparatus shown in the drawing).
324 *White* v. *Fenn* (where the infringement related to a part of the patent which was not new).

PARTICULARS OF BREACHES.

17 Sufficiency of particulars of breaches where the patented article (a cartridge) was made an exhibit.
124 Particulars of infringement refused.
134 Practice as to delivery of particulars of breaches.
224 In a patent suit the particulars of breaches, taken together with the bill, ought to give the defendant full and fair notice of the complaint made against him.
302 Sufficiency of particulars of breaches.

PARTICULARS OF OBJECTIONS.

53 Application for particulars of objections refused where issues were not granted.
134 But, *per* Jessel, M.R., the practice at law should be followed. Order for delivery of particulars of breaches, and of objections, in *Finnegan* v. *James*.
76 The particulars of objections under stat. 15 & 16 Vict. cap. 83, sect. 41, are confined to notices affecting the validity of the patent.
134, 186, 227 Sufficiency of notice of objections.
97, 176, 196, 213, 244 Sufficiency of particulars of objections.
111, 183, 243, 267 Admissibility of evidence under particulars of objections.
54, 252 Amendment of particulars of objections.
268 Leave given (by Wood, V.C.) to amend particulars of objections at the close of plaintiff's case.
111 But leave refused (by the same learned judge) under altered circumstances.

INSPECTION.

17 Inspection (of defendant's manufactory) refused where no necessity for it was shown.
31 Practice of Courts of Equity in granting an order for inspection.
47 Order by Lord Eldon, L.C. for inspection of defendant's machine.
89 Order to compel the production of a specimen of lace made by the patented machine—refused.

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109 Order made for the mutual inspection of machinery by plaintiff and defendant.
214 Order for inspection of machinery by plaintiffs and their witnesses.
251 Order for inspection and delivery of samples of type metal.
258 Conditions under which an inspection will be granted.
271 *Russell* v. *Cowley*. Mutual inspection by consent.
286 Order for inspection.
289 Inspection of books refused by the Court of Queen's Bench.
317 Inspection pending an action.

PRACTICE IN PATENT SUITS.

1 Rights of an agent for patentee.
4 Averment of novelty.
17 Practice as to inspection, particulars of breaches, and costs.
7, 53, 109 Practice as to granting issues.
213 Amendment of issues.
56, 249 Practice as to trial by jury.
174, 267 Practice as to interrogatories.
55, 95, 111, 117, 136, 223, 301 Discovery.
77 Recent patent.
143 The same. Affidavit of title.
11, 58 Considerations which guide the Court in granting an injunction or account, by Lord Langdale, M.R.
166 The same, by Lord Eldon, L.C.
23 The same, by Wood, V.C.
12, 124 The same, by Lord Cottenham, L.C.
21, 108, 229 Where there has been long exclusive enjoyment of a patent an injunction may go, until its validity is determined at law.
22 Injunction granted in *Betts* v. *Menzies*, after long exclusive enjoyment of the patent.
82, 97 Practice where possession of the patent has been disturbed.
109, 122, 229 The same where it has been undisturbed.
37, 81, 109, 151, 251, 267 Practice as to injunction.
46, 57 Practice where the proceedings at law are incomplete.
55 Practice where there are several infringers. *Laches*.
91 Separate proceedings against infringers.
135 Consolidation of suits against separate infringers.
58 Injunction refused for delay.
262 Practice where notice of motion for *interim* injunction is given immediately before the expiration of the patent. Account.
110 Practice in a suit where the patent has expired.
35 The same where a bill is filed just before the expiry of the patent.
288 Practice as to an account where there has been delay.
147 Estoppel.
150 Rights of joint owners of a patent.

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207 Rights of co-patentees.
28 Practice as to costs where a suit is abandoned.
29 Practice as to account or damages.
33 Account or damages, but not both. Practice as to costs.
33 Personal liability of directors of a company for infringement.
110, 256 Practice as to damages, and full costs.
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ABSTRACT

OF

PATENT CASES.

ADAMS *against* THE NORTH BRITISH RAILWAY COMPANY, A.D. 1873. } 29 L.T. N.S. 367. }

Practice in Patent Suits. Rights of an Agent for Patentee.

Suit to restrain from infringing a patent of 5th *Sept.* 1867, No. 2,520, to *A. V. Newton*, for 'improvements in safety valves for steam boilers' (a communication from abroad). It appeared, on the bill, that plaintiff was general agent for the owners of the patent. WICKENS, V.C. refused an injunction. Demurrer, for want of equity, allowed, with costs, including costs of the motion.

Per LORD SELBORNE, L.C.—This bill is not one to obtain the profits and royalties merely; it in fact alleges that there has been infringement, and asks for damages for the infringement, and an injunction to restrain future infringement. It is a patentee's bill, and it is filed by a man whose only right is against his own principals. There is nothing to constitute the plaintiff an assignee of the patent.

ALLEN *against* RAWSON, A.D. 1845. 1 C.B. 551.

Property of Inventor in Suggestions by his Servant. Comparison of Specifications. Novelty of Invention. Evidence of Infringement.

CASE for the infringement of a patent of 14th *Feb.* 1840, No. 8,387, to *T. R. Williams*, for 'improvements in the manufacture of felted fabrics.' Pleas: 1. Not guilty. 2. That the patentee was not the true and first inventor. 3. That the invention was not new. Issue.

The patent related to the manufacture of felt. Hitherto, in forming a layer or *bat* of wool to be subjected to the operation of felting, the practice had been to throw the wool, as taken from the carding machine, upon a hollow perforated cylinder. By exhausting air from within the cylinder, the wool, so projected, was caused to

adhere and collect itself in a layer upon the surface. The invention of *Williams* related to the formation of this *bat* in a different manner. The carded wool was taken direct from the carding engine, and received between two endless revolving aprons running at the same surface speed, and the sliver was caused to deposit itself layer over layer upon the upper apron, until a sufficient quantity had been accumulated. The felting or hardening was effected by passing the *bat* between a double tier of parallel rollers, each upper roller lying in the hollow between two adjacent lower rollers, and therefore pressing on two surfaces instead of one. The upper rollers were weighted, and driving gear was arranged for giving the rollers a reciprocating rotatory motion, but with a progressive motion added thereto, so that, on the whole, the *bat* was carried in a regular manner from end to end. This produced felting in a longitudinal direction, and, in order to increase the action, a system of *diagonal felting* was superadded. For this purpose, the cloth was fed into a second machine, similar to the first, except that the rollers which supplied the *bat* to the machine were placed diagonally to the feeding apron, and moved at a higher speed, whereby the cloth was fed upon the apron in a series of folds, arranged diagonally to the axes of the felting rollers, and the pressure took place in lines across the material. The specification described the machinery by reference to drawings, and in particular showed an arrangement for contracting the length of the machine by causing the upper apron to run to and fro in parallel lines between tightening rollers placed one above the other at each end of the machine; or otherwise, by using several aprons, forming a compound apron. It further described an arrangement of longitudinal guides for keeping the aprons distended. *Claim*: 'I claim the application of the double apron or aprons, or compound aprons, and rollers, for the production of *bats*, as herein described, from the long sliver, and the different means herein described for keeping these aprons, together with the *bats*, in a smooth and even condition.' Also: 'I claim the improved position of the rollers in the felting machine, for producing the double contact of each tier of rollers, and the combined reciprocating and progressive motion of these rollers, as well as the manner in which this motion is produced, as applied to the felting machine, and also the method of diagonal or cross felting, as effected by the feeding rollers as herein described.' There was a further claim relating to the use of soap and water in conjunction with rollers, as to which an objection was taken, but not sustained.

At the trial, defendant put in evidence (as anticipatory of the invention of diagonal felting) the specification of a patent of 4th

April, 1838, No. 7,608, to *W. A. Robertson*, for a method of felting diagonally by rollers, where the *bat* was passed longitudinally over a series of fixed semi-cylinders, and was hardened by the pressure of a large heavy rolling cylinder, which moved over the material sometimes longitudinally, and sometimes diagonally at an angle. It further appeared that one *Shaw*, a workman in the employ of a company of which *Williams* was a member, had suggested the use of the compound apron; and that one *Milner*, a workman in the same employ, had suggested the use of the longitudinal guides, both of which improvements were claimed.

The alleged infringement consisted in the adoption of machinery for hardening, which was substantially the same as that specified, except that defendant substituted a drum for the revolving apron.

ERLE, J. directed the jury:—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 the experiments arising from that employment, make valuable discoveries accessory to the main principle, and tending to carry that out in a better manner, such improvements are the property of the inventor of the original improved principle, and may be embodied in his patent; and, if so embodied, the patent is not avoided by evidence that the agent or servant made the suggestions of the subordinate improvement of the primary and improved principle. The learned judge further said:—That the improvement of *Shaw* was but a more convenient mode of carrying out the principle of the patentee, and that *Milner's* guide was one of those subordinate improvements, helping to carry out the general principle, which the patentee had a right to adopt. That the mode of diagonal felting described in *Williams's* specification was substantially different from that described in *Robertson's* specification. And he left it to the jury to say whether the substitution by defendant of the drum for the revolving apron was a colourable difference only, and a substantial infringement of *Williams's* patent. Verdict for plaintiff.

Rule for a new trial—on the grounds of misdirection by the learned judge, and that it was not left to the jury to say whether the present patent and that of *Robertson* were the same as to the method of diagonal felting—refused by the Court of Common Pleas.

Per COLTMAN, J.—On looking at the judge's notes, it appears that there was no evidence given to show that the two patents were the same; and standing as the question did nakedly on the two specifications, the construction of them, according to the authority of *Neilson* v. *Harford* (8 M. & W. 806), was for the judge, and not for the jury. We think, therefore, there is no ground for a rule on this point.

Rule nisi for a new trial on the ground that the patentee had no right to claim the improvements of *Shaw* and *Milner* as part of his invention, discharged by the Court of Common Pleas. (Tindal, C.J., Maule, Cresswell, Erle, JJ.)

Per TINDAL, C.J.—The real question is, whether or not the improvements suggested by *Shaw* and *Milner* were of such a serious and important character as to preclude their adoption by *Williams* as part of his invention. It would be difficult to define how far the suggestions of a workman employed in the construction of a machine are to be considered as distinct inventions by him, so as to avoid a patent, incorporating them, taken out by his employer. Each case must depend on 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. It seems to me that this was a matter much too trivial and too far removed from interference with the principle of the invention to produce the effect which has been contended for.

AMORY *against* BROWN, A.D. 1869. L.R. 8 Eq. 663.

Practice in Patent Suits. Averment of Novelty.

Suit to restrain from infringing a patent of 6th *Feb.* 1867, No. 331, to *C. E. Brooman* (a communication from abroad).

The bill stated the grant of the patent for an invention of a new method of manufacturing pearls, but contained no express allegation of novelty. Defendant, who appeared *in formâ pauperis*, objected that the pleading was defective; but JAMES, V.C. over-ruled the objection, and said:—'The allegation of the grant and the production of the letters patent throw upon the defendant the *onus* of disputing the novelty, and, therefore, I consider the bill sufficient without it. But even if such an averment had been necessary, I should not have allowed the defendant to take advantage of a mere technical objection of that sort, but I should have allowed the hearing to stand over until the defect had been remedied.'

ARKWRIGHT *against* NIGHTINGALE, A.D. 1785. Dav. Pat. Ca. 37; 1 Webs. Pat. Ca. 60.

Sufficiency of Specification. To whom it is addressed.

CASE for the infringement of a patent of 16th *Dec.* 1775, No. 1,111, to *R. Arkwright*, for 'certain instruments or machines which would be of public utility in preparing silk, cotton, flax, and wool

for spinning.' The patent related to improvements which form the foundation of the present mode of spinning cotton by machinery.

At the trial, five witnesses deposed that they had made the machine from the specification alone.

LORD LOUGHBOROUGH directed the jury:—There is no matter of favour can enter into consideration in a question of this nature. The law has established the right of patents for inventions; that law is extremely wise and just. One of the requirements is that a specification shall be enrolled, stating the nature of the invention: the object of which is, that after the term is expired the public shall have the benefit of the invention, but without that condition is complied with, the patentee forfeits all the benefit he derives under the Great Seal. The only objection in this case is, that the specification is not so intelligible that those who are conversant in the subject are capable of understanding it, and of perpetuating the invention when the term of the patent is expired. The clearness of the specification must be according to the subject-matter of it; it is addressed to persons in the profession having skill in the subject, not to men of ignorance; and if it is understood by those whose business leads them to be conversant in such subjects, it is intelligible.

Verdict for plaintiff.

REX *versus* ARKWRIGHT, A.D. 1785. Dav. Pat. Ca. 61; 1 Webs. Pat. Ca. 64.

Novelty of Invention. Sufficiency of Specification. Master and Servant. Obligation in Specifying. Prior Publication of Part of the Invention.

Sci. fa. to repeal the same patent. The specification stated:—That the invention, as drawn in a plan, was composed of the following particulars. No. 1. A beater or breaker of seeds, in which a wheel with teeth, by acting upon a lever raised the hammer, the lever being moveable upon a centre. No. 3. A *feeder* or piece of cloth with wool, flax, &c., spread thereon as in the drawing. (The drawing showed a roll without any central roller or axis.) No. 4. A crank and connecting rod for giving a vibrating motion to the comb which discharged the cotton from the carding cylinder. No. 5. A carding cylinder with fillet cards. No. 6. Rollers fixed to a wooden frame, the contents of No. 5, going through, became of the proper size. (This combination formed the well-known *drawing rollers* for drawing out or elongating the sliver of cotton. The two rollers were figured as of unequal size, but it was nowhere stated that the surface speed of one pair was different from that of the other pair.) No. 7. A cylindrical box for twisting the contents of No. 6. No. 8. A box, having a roller and bobbin inside for twisting the contents of No. 6.

No. 9. A spindle and flier, being fixed to No. 6, for twisting the contents thereof. A bobbin (shown on the spindle) for communicating by a band with No. 10 at a conical or regulating wheel which moved the bobbin quicker or slower as required. No. 10. A spindle with pulleys, and a conical or regulating wheel, which being fixed to No. 6, worked No. 7, No. 8, or No. 9. There was no separate claim.

At the trial, one *Hayes* deposed that he had made the drawing rollers in 1767, that in 1769 he made them like those used by defendant; one was fluted wood with an iron axis, the other the same, only covered with leather; that one *Kay*, a clockmaker, from *Warrington*, made him a small model. Then *Kay* deposed that, before the patent, he got the model from *Hayes* and showed it to defendant, who took him into his employ, whereupon he worked at the discovery found out by himself and *Hayes*. It appeared that the crank and connecting rod were invented by one *Hargreaves*, and were publicly used in 1773. It further appeared, although the specification was silent on the subject, that Nos. 3, 4, 5 were the material parts of a carding machine, and that Nos. 6, 7, 10 referred to a roving machine.

BULLER, J. directed the jury:—It is clearly settled as law, that a man, to entitle himself to the benefit of a patent for a monopoly, must disclose his secret, and specify his invention in such a way that others may be taught by it to do the thing for which the patent is granted; for the end and meaning of the specification is to teach the public, after the term for which the patent is granted, what the art is; and it must put the public in possession of the secret in as ample and beneficial a way as the patentee himself uses it. If the specification, in any part of it, be materially false and defective, the patent is against law, and cannot be supported. It has been truly said by the counsel that if the specification be such, that mechanical men of common understanding can comprehend it, to make a machine by it, it is sufficient; but then it must be such that mechanics may be able to make the machine by following the directions of the specification without any new inventions or additions of their own.

Here is a specification that states ten different instruments. Is there anything which states that these parts are for two machines, and how they are composed? About that the specification is totally silent. What is there in it that can lead you to say you must make use of three things for one of the machines and three for the other, and which three for one or the other? And even were it so, what is to become of the other four? If those are of no use, but to be thrown in merely to puzzle, I have no difficulty in saying, upon that ground alone, that the patent is void; for it is not that fair, full, true dis-

covery which the public have a right to demand from an individual who gets so great a reward as a monopoly for fourteen years together.

As to the other points, they are two; first, whether it is a new invention; and in the next place, whether it was an invention made by the plaintiff. As to No. 1, that is stated to be a beater or breaker of seeds; it is admitted that it is not a new discovery, for *Emerson's* book was produced, which was printed a third time in the year 1773, and that is precisely the same as this. Upon the part of the defendant there is no contradiction, and therefore I will pass it over as clear that it is not new. As to *Hayes* and *Kay*, there is no contradiction at all to the evidence they have given.

If upon any point you are of opinion with the prosecutor, you will find a verdict for him. Verdict for the Crown.

Rule for a new trial refused by the Court of King's Bench.

Per LORD MANSFIELD.—It is very clear to me, upon your own showing, that there is no colour for the rule; the ground of it is, if there is another trial, you may have more evidence. There is no surprise stated, no new discovery, but upon the material points in question you can give more evidence. A verdict has been found, which is satisfactory to the judge, and now you desire to try the cause again, only that you may bring more evidence. There is not a colour for it.

ARNOLD *against* BRADBURY, A.D. 1871. L.R. 6 Ch. 706.

Sufficiency of Specification. Practice as to granting Issues. Subject-matter of a Patent.

Suit to restrain from infringing a patent of 5th *March*, 1860, No. 600, to *J. H. Johnson*, for 'an improved ruffle and sewing machine' (a communication from abroad). Defendants admitted the infringement, but contended that the patent was invalid, and that its invalidity was apparent on the face of the specification. The answer stated:—'We are advised and submit that what is in fact claimed by the specification is the producing by machinery results which were before obtained by hand, but without any limitation as to the kind of machinery that may be used, and that the claims made by the specification are not the subject of a patent, and are so wide and general as to render the patent void.'

The patent related to machinery for producing ruffles or frills and gathered work. The gathers in a fabric were fed on by mechanism without being 'whipped' or scratched by a pointed instrument, as when formed by hand. The fabric was thereby uninjured. The mechanism for gathering might be used in combination with a

sewing machine. The gathered material was stitched, either by hand or by the sewing machine, to some plain fabric. The specification stated:—'The said invention relates to an improved ruffle, frill, or gathered fabric, and to the machinery for making the same. The apparatus used in producing this ruffle or gathered fabric consists of a peculiar mechanism for gathering and feeding one of the fabrics operated on, which peculiar mechanism is used in combination with a sewing machine, the latter being modified to receive the additional mechanism.' Then followed a description of the machine, and of the mode of using it, accompanied by drawings, whereof one showed 'a sufficient portion of a sewing machine to illustrate its operation.'

Claims: 1.—The production by machinery of ruffles, frills, and gathered work, and the simultaneous attachment of the same to a plain fabric by means of a single series of stitches, which serve both to confine and stitch the gathers, and also to secure one fabric to the other.

2. The production by machinery at one operation of gathered work, which is simply gathered and secured on itself by stitches.

3. The combination of mechanism for forming ruffles, plaits, and gathering with the mechanism of a sewing machine, for the purpose of simultaneously gathering fabrics, and attaching the same by stitches to another fabric, or for the purpose of making gathered work which is simply gathered and secured on itself at one operation.

WICKENS, V.C. directed that the question of granting issues should be postponed to the hearing. On appeal, the Lord Chancellor reversed this decision, and directed issues.

Per LORD HATHERLEY, L.C.—I am of opinion that I cannot determine this case in the mode in which it is sought by the defendants to be determined, from a simple inspection of this specification. A claim must be very large and very vague indeed to justify any Court in saying that it is impossible to sustain a patent based upon it. It is a singular fact that no case has been cited from our English law books of any claim being held to be too large on account of the greatness of the claim, independently of the external evidence. The case of *Jordan* v. *Moore* (L.R. 1 C.P. 624), was, perhaps, the nearest.

I am invited to consider the first head of claim as a general claim of all machinery that ever may be invented hereafter, which can perform the operation which is here described. But the inventor introduces the claims by saying that his object is to state what he considers novel in his invention. He does not say that he is going to distinguish it from all possible future inventions of other people. I read the first claim thus: the inventor claims the production, by

machinery, of that which has not been done by machinery before. He says he has invented an improved ruffle and frill, and he states in what the improvement consists, and he describes the machinery —he does not call it improved machinery—by which it is produced; and he says, 'I claim the producing of this by machinery, of which machinery I have given full details.'

The second head of claim is this: 'The production by machinery at one operation of gathered work, &c.' *Mr. Aston* says, that must be bad. I cannot come to any such conclusion. I cannot tell that the ruffle produced in this way, so as to be free from scratches, is not more durable and more elegant in its appearance than one which is subject to that defect. If the inventor produces a machine, and dispenses with a process which is avowed to be injurious, I cannot, in the absence of evidence, take upon myself to say that would not be the subject-matter of a patent.

The third head of claim is: 'The combination of mechanism for forming ruffles, &c. with the mechanism of a sewing machine, for the purpose, &c.' *Mr. Aston* objects that the patentee has not described the mode in which it is done, therefore either it is a thing so simple that it requires no explanation, and is not the subject-matter of a patent, or if it is not simple, he has not shown how it is to be done. The answer to this objection is, that it is simple enough when you have got the plaintiff's machine to apply to a sewing machine. The patentee gives a drawing showing how it is done; and the reason of the simplicity of the combination is, that he has invented a machine which is so easily combined with a sewing machine, that a simple drawing is sufficient to explain it.

It is unfortunate that the case has been brought on in this way. When the issues are tried, it may turn out, as in *Jordan* v. *Moore*, that, after all, there have been previous inventions so similar to those of plaintiff, that the patent is invalid; but that is no ground for my holding it to be *per se* too large.

AXMANN *against* LUND, A.D. 1874. L.R. 18 Eq. 330.

Injunction. Threatening Legal Proceedings. Estoppel of Licensee.

Suit to restrain defendant from threatening legal proceedings for the infringement of a patent. It appeared on the bill that, in 1864, defendant obtained a patent for improvements in manufacturing jewellery, and entered into partnership with plaintiff for working the patent. In 1868, plaintiff and defendant obtained a further joint patent for improvements in the same manufacture. In 1873, the partnership was dissolved. Defendant then issued

circulars, addressed to customers of plaintiff, which made no distinction between the two patents, and threatened legal proceedings for the infringement of an assumed patent right, being in the form adopted and jointly issued during the existence of the partnership. Plaintiff now denied the validity of the patent of 1864. Injunction granted.

Per MALINS, V.C.—As to whether the patent is valid or invalid, I give no opinion; that is not the question before me. If it is valid at all, the defendant is entitled to restrain any person from manufacturing any article covered by it. If it is invalid, he has no right to use these threats to the public, which are calculated, not only as to the plaintiff, but as to everybody else, to destroy business. The terms of the notice are, in my opinion, wholly unjustifiable. There are two patents; and though after the dissolution both partners had an equal right to use the patent of 1868, no distinction was drawn between the two patents in these notices.

It remains to be considered whether the plaintiff has conclusively bound himself to admit the validity of the patent. Now, undoubtedly during the continuance of the partnership, the plaintiff had by contract, as licensee, according to *Crossley* v. *Dixon* (10 H.L. Ca. 293), precluded himself from disputing the validity of the patent. But after its expiration he became at liberty, just as much as the rest of Her Majesty's subjects, to dispute its validity, subject, however, to be answerable in damages, in case the defendant establishes the validity of the patent in any proceedings against the plaintiff. The defendant declines to undertake to take proceedings at law to establish the validity of his patent, and I retain the opinion I expressed in *Rollins* v. *Hinks* (L.R. 13 Eq. 355), that as he will not follow up the rights he asserts, by proceeding to establish the validity of the patent, he ought to be restrained from circulating threats.

BACON *against* SPOTTISWOODE, A.D. 1839. 1 Beav. 382.

Practice in Patent Suits. Injunction. Account. Principles which guide the Court.

Suit to restrain from infringing a patent for improvements in the common *Argand* gas-burner. Bill filed in 1835. After the bill was put on the file, plaintiff did not move for an interlocutory injunction; but, upon the answers coming in denying the validity of the patent and the infringement, he filed a replication and went into evidence. It appeared that defendants, who represented a gas company, had made no profits by the sale of the burners, which had been supplied to their customers at the manufacturer's prices. At

the hearing plaintiff failed to make out a clear title. On the close of the argument LORD LANGDALE, M.R. said:—The bill alleges that the defendants have sold and used, it being the fact that they have sold for no profit, and it not appearing that they have used otherwise than by furnishing the burners to their customers. I am not prepared to say, that although the defendants have sold the burners without profit, yet that they have not derived a collateral profit from the use of them by their customers; that case, however, is neither alleged by the bill nor is it proved. I am of opinion that even if the plaintiff is entitled to an injunction he is not entitled to an account.

On the next day his Lordship delivered judgment, dismissing the bill with costs, and said:—When a cause of this kind is brought to a hearing, it is for the purpose of having an injunction made perpetual, or continued during the legal right of the plaintiff under his patent; and it appears to me that, however unusual the circumstance may be, the plaintiff is not precluded from asking for an injunction by the fact of his not having applied for it on interlocutory motion. The plaintiff, if he omits to move for an injunction at an early period of the cause, first shows that he does not consider the injunction as immediately necessary for the protection of his interest, and next imposes upon himself the obligation of making out a clear and unexceptionable title at the hearing.

I think that at the hearing of the cause the Court has to look at the facts produced in evidence, for the purpose of considering whether a perpetual injunction should then be granted. On an interlocutory order, it has to look at the facts produced in evidence, for the purpose of considering whether an injunction should be granted till the right can be tried or further investigated. It is truly said, that where a patent has been granted, and there has been an exclusive possession of some duration under it, the Court may interpose its injunction, without putting the party previously to establish the validity of his patent by an action at law; but this interposition must nevertheless depend, to a considerable extent, on the circumstances of the case and the nature of the defence. The Court is not bound to grant an injunction, merely because a patent has been granted and exclusively enjoyed for some time; and when the case is brought to a hearing, I apprehend that the plaintiff ought to show his title clearly, and that if he fails in that, and has not previously obtained an injunction, he will not be allowed to use the facts proved in the cause, as evidence of a *primâ facie* case giving him a right to further delay, for the purpose of enabling him to establish more satisfactorily the legal title upon which alone his equity is founded.

BACON *against* JONES, A.D. 1839. 4 Myl. & Cr. 433.

Practice in Patent Suits. Injunction. Account.

Suit to restrain from infringing the same patent. The bill was filed in 1835, and, as in the previous suit, plaintiff did not apply for an injunction, but filed a replication and went into evidence. The Master of the Rolls dismissed the bill with costs, the judgment in *Bacon* v. *Spottiswoode* deciding this suit also. Appeal, in *Bacon* v. *Jones* only, dismissed by the Lord Chancellor with costs.

Per LORD COTTENHAM, L.C.—The jurisdiction of this Court is founded upon legal rights: the plaintiff coming into this Court on the assumption that he has the legal right and the Court granting its assistance on that ground. When the application is for an interlocutory injunction, the Court may at once grant the injunction, *simpliciter*, without more—a course which, though perfectly competent to the Court, is not very likely to be taken where the defendant raises a question as to the validity of the plaintiff's title; or it may follow the more usual, and, as I apprehend, more wholesome practice, in such a case, of either granting an injunction, and at the same time directing the plaintiff to proceed to establish his legal title, or of requiring him first to establish his title at law, and suspending the grant of the injunction until the result of the legal investigation has been ascertained, the defendant in the meantime keeping an account.

When the cause comes to the hearing, the Court has also a large latitude left to it, and I am far from saying that a case may not arise in which, even at that stage, the Court will be of opinion that the injunction may properly be granted without having recourse to a trial at law. The Court may, at the hearing, do that which is the more ordinary course; it may retain the bill, giving the plaintiff the opportunity of first establishing his right at law. There remains a third course, the propriety of which depends on the circumstances of the case, viz., that of at once dismissing the bill.

BAINBRIDGE *against* WIGLEY, A.D. 1810. Parl. Rep. 197.

False Suggestion.

CASE for the infringement of a patent of 2nd *April*, 1803, No. 2,693, to *W. Bainbridge*, for 'certain improvements in the flageolet or English flute, whereby the fingering will be rendered more easy, and notes produced that never were before produced.'

At the trial it appeared that the instrument had been greatly improved, but that only one new note was produced. LORD ELLENBOROUGH said:—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 improvements, he gave new notes, when in fact he had given but one new note.

BAIRD and OTHERS *against* NEILSON, A.D. 1842. 8 Cl. & F. 726.

Agreement by Licensee. Estoppel.

Appeal from a decree of the Court of Session. It appeared that, in 1830, appellants obtained a licence from respondent, *J. B. Neilson*, to use his patent of 1st *Oct.* 1838 (*Scotland*), for the application of the hot blast in smelting iron, and thereupon proceeded to manufacture iron according to a certain process resembling that of the patentee. Disputes, and eventually litigation, arose between the parties, and it was agreed in 1833, that, in consideration of a sum of money to be paid by appellants, both parties should withdraw from litigation, and that a royalty of 1s. per ton should be paid by appellants for all the iron made by them according to the mode they had before adopted, or by any other mode within the patent. The agreement not being carried out, respondent instituted a suit to compel the performance of it. Appellants instituted a cross suit to suspend proceedings, on the ground that the process of smelting by heated air, as used by them, did not fall within the patent. The Court of Session held that, after the agreement, this defence could not be set up. On appeal to the House of Lords, decree affirmed, with costs.

Per LORD CAMPBELL.—What is the ground of the suspension? The only real ground alleged is that the use that has been made of the hot air has not been according to the patent. But the very object of the agreement was to put an end to that question, and on the construction of the agreement I am of opinion that there is no ground at all for the suspension.

BARBER *against* GRACE, A.D. 1847. 1 Ex. R. 339.

Evidence of Infringement. Two modes of doing the same thing.

CASE for the infringement of a patent of 8th *March*, 1836, No. 7,017, to *W. Bates*, for 'improvements in the process of finishing hosiery and other goods.' Plea: Not guilty. And several other pleas. Issue.

The specification stated:—'My invention consists in submitting hosiery and similar goods to the finishing process of a press heated by steam, hot water, or other fluid in the manner hereinafter mentioned.' The specification then described the apparatus by reference to drawings, and showed pressing boxes, having flat sides, which were filled with steam from a boiler, and were brought together by the ram of an hydraulic press. If preferred, screws or other well-known means might replace the hydraulic press, and hot water might be used in the place of steam. *Claim*: 'The submitting of hosiery and similar goods to the pressure of hot boxes or surfaces heated by steam, water, or other fluid, as above described.'

At the trial, it appeared that the alleged infringement consisted in pressing goods between cylindrical revolving rollers heated by steam. POLLOCK, C.B. directed the jury:—That they ought to find for defendant on the issue of not guilty, unless they were of opinion that the use of rollers was a mere colourable evasion of the patent. His Lordship also expressed an opinion that it was not. Verdict for defendant on the issue of not guilty, and for plaintiff on the remaining issues.

Rule nisi for a new trial discharged by the Court of Exchequer. (Pollock, C.B., Parke, Alderson, Rolfe, BB.)

Per POLLOCK, C.B.—This is obviously a discovery based upon a discovery. Rollers were adopted two or three years after boxes had been made the subject of a patent. Were the Court to hold that rollers are included in this patent, the effect of it would be that, if the party could have kept his process a secret in point of fact, and have given the public nothing but what they could gather from the specification, he might have had the exclusive use of rollers, under the protection of the law, for fourteen years, and at the end of that period the public would be wholly ignorant that rollers were capable of being used, and had been used, for such a process, or that they were the object of a patent. Upon looking at the description given of the machine, rollers are not in the most remote degree suggested as capable of being used. The figure represents an hydraulic press, by which two boxes heated by steam or hot water are made to meet, and between them the goods are to be placed. The pressure, as was observed by my brother Alderson during the argument, is to be continuous and not momentary, as it is in the case of rollers. It was contended by the plaintiff's counsel that the term 'boxes' includes rollers. A roller is a box in one sense of the word, but not, I think, in the sense used here. I am of opinion that rollers are not included in the specification.

Per PARKE, B.—It seems to me—and I own I feel not the least doubt about it—that this specification does not claim a general mode of applying hot surfaces to knitted fabrics, but that it is merely for the particular machine described in the specification, and that that particular machine has not been pirated by the defendant.

BARKER and HARRIS *against* SHAW, A.D. 1823. Holroyd, Pat. 60.

Master and Servant.

'In *Barker* and *Harris* v. *Shaw* (Cor. Holroyd, J., *Lancaster* 1823), which was an action for the infringement of a patent for an improved manner in making hats, one of the plaintiffs' men (*Thomas Walmsley*), whom they called as a witness, proved

that he himself invented the improvement which was the subject of the patent, whilst employed in their workshop. The plaintiffs were therefore held not to be the inventors, and were nonsuited.'

This case appears to have been cited under the name *Barber* v. *Walduck* (1 Car. & P. 567). But note, that there is a patent of 26th *July*, 1821, No. 4,574, to *T. Barker* (of *Oldham*, county *Lancaster*) and *J. R. Harris*, for 'improvements in clearing furs and wools, used in the manufacture of hats, from kemps and hairs.'

BATEMAN and MOORE *against* GRAY, A.D. 1853. 8 Ex. R. 906; Macrory's Pat. Ca. 93.

Evidence of Infringement. Novelty of Invention. Defective Pleading.

CASE for the infringement of a patent of 18th *Jan.* 1848, No. 12,032, to *J. F. Bateman* and *A. Moore*, for 'improvements in valves or plugs for the passage of water or other fluids.' Pleas: 1. Not guilty. 2. That plaintiffs were not the true and first inventors. 3. That the invention was not a new manufacture. Issue.

The patent related to a method of drawing off water from the *mains* in streets. For this purpose a light ball valve, either formed of, or coated with, indiarubber, was fitted inside an opening in the main pipe, and was forced up against its seat by the pressure of the water, so as to close the opening. A key, in the form of a hollow tube or stand-pipe, was locked by means of a catch to a socket in the valve-box, and was depressed by a screw, so as to force the ball valve downwards and allow the water to escape through the pipe. The specification described the apparatus by reference to drawings, and showed the method of applying and withdrawing the key.

Claims: (in substance)—*First.* The application for the purpose of drawing off water of a valve of less specific gravity than water, constructed of, or coated with, vulcanised indiarubber, or other elastic material, and which closes by the pressure of the water. *Secondly.* The application for similar purposes of a globular valve of the same or greater specific gravity than water, which, without mechanical aid, will close by the pressure of the water. *Thirdly.* The opening of valves by means of a key or tube, so applied as to force the valve open against the pressure of the water, and through which key or tube the fluid escapes, such tube being attached to the box of the valve without the aid of a screw.

At the trial, it appeared that the alleged infringement consisted in the use of a stand-pipe fitted with a ball valve and indiarubber seating, the valve being opened by a spindle inside the stand-pipe. It further appeared that both a stand-pipe and ball valve were well known before the date of the patent.

MARTIN, B. directed the jury:—If a person takes an invention of this kind and makes one like it, that is an infringement. It is my duty to tell you that the law will not permit a person to take an article that has been patented, and to give a substitute in place of it, 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. If you believe that the defendant's instrument, though he might have employed skill and knowledge upon it, was taken substantially from the plaintiffs, and that what he has produced is nothing more than a substitution of other and equivalent means for producing the same end, even though the means employed might be better than those of the plaintiffs, it is my duty to tell you that is an infringement of the patent. If that were not the law no patent would be safe. . . . . It seems to me that the true construction of the specification is, that the patent is for an improved method of opening valves and plugs for the passage of water. In my judgment, the claim is for the entire apparatus altogether, for the purpose of getting water from the main. It is for you to ask yourselves whether the invention, as specified—that is, the ball valve with the external adjuncts—was invented by the plaintiffs in the year 1848.

The jury found that each of the three separate parts was old, but that the invention was for the combination, and that it was new and useful. Verdict for plaintiffs.

Rule nisi for a new trial, on the ground of misdirection, discharged by the Court of Exchequer. (Pollock, C.B., Alderson, Platt, Martin, BB.)

Per POLLOCK, C.B.—It was contended that the claim in the specification was, that of the three parts of the machinery therein mentioned, each was new; and that the invention claimed was not the conibination, which alone the jury found to be new. This point was argued before us, and we are disposed to think there is much weight in the objection to the validity of the specification on this point. But we do not think it necessary to decide this question, because it does not arise on the present pleadings. The only issues on the record are the infringement (about which there is no doubt) and the novelty of the invention.

We think that what was the invention was a question for the jury, and that the production of the specification did not conclude it. It was evidence to be considered by the jury, but no more, that the plaintiffs had so described their invention. But it may be, even if the defendant's construction be the true one, that the invention was new as a combination, and yet the description of it in the specification erroneous. Now here the jury have clearly found the invention to

be that of a new combination of old parts; and if this be so, the real and true objection which was open to the defendant was that the plaintiffs had not complied with the condition in their patent, by truly and correctly describing it in the specification which they had filed. But this could only be taken advantage of by a plea to that effect. There was no such plea upon the record, so that the defendant cannot now avail himself of this objection.

BATLEY *against* KYNOCK, A.D. 1874–5. L.R. 19 Eq. 90, 229; L.R. 20 Eq. 632.

Practice in Patent Suits. Inspection. Particulars of Breaches. Costs.

Suit to restrain from infringing a patent of 4th *Oct.* 1865, No. 2,542, to *J.* and *J. F. Jones*, for improvements in cartridges for breechloading fire-arms.

The patent related to the manufacture of central-fire cartridges. The specification described the improvements as consisting in a combination of parts:—First, a tube or case of paper, cotton, wood pulp, &c.; then, a metal head, having a cup or chamber formed in one piece therewith, for the reception of a percussion cap; then, an anvil placed within the cap, for receiving the blow of a piston and causing the ignition of the fulminate. The anvil did not fill the cap, but gave passage along its sides for the flame to reach the body of the cartridge. The specification contained fifty-five figures, showing the construction of the cartridge, the forms of anvil, and the attachment of the head and cup. The claims, fifteen in number, related to the mode of making and arranging the several parts of the cartridge.

(1.) Plaintiff applied for an inspection of defendants' manufactory. BACON, V.C. refused an order, and said:—'I find that the charge made by the plaintiff is that the cartridges, the right of manufacturing which is vested in him exclusively, have been imitated and copied by the defendants; and if that fact can be made out, the plaintiff's case is clearly established. The mode of making that out is by examination of the cartridges. Upon the evidence before me there is no allegation by the plaintiff that the inspection is necessary for the purpose of his suit; and it is alleged by the defendants, and not contradicted, that no such necessity exists. I cannot, therefore, order the inspection. The costs to be costs in the cause.'

(2.) Plaintiff having delivered particulars of breaches, charging infringement by the making and selling of cartridges (whereof one was made an exhibit), having cases and metal heads, together with cups or chambers formed as described in the specification, defendants

moved for further and better particulars. BACON, V.C. refused the motion, with costs, and said:—'Here the very thing in dispute, which is no bigger than one's thumb, and is not a complicated machine, is made an exhibit. What ground therefore is there for the objection as to insufficiency of the particulars, when a plaintiff produces the exhibit, and says, "I hold in my hand the very article by which you infringe"? It would be only hampering the plaintiff to compel him to specify minutely the particular portions of his specification alleged to have been infringed; and I am of opinion that the defendants, by the pleadings and particulars of breaches, have had full, fair, and sufficient notice of the case intended to be raised against them.'

(3.) The trial of the issues was fixed for 19th *Feb.* 1875, and briefs were delivered. On 12th *Feb.* 1875, plaintiff obtained the common order at the Rolls, dismissing his bill, with costs. The costs were taxed as between party and party, and the taxing master reduced the allowance of remuneration to scientific witnesses, and also the charge for a model. On a summons that it might be referred to the master to review his taxation, BACON, V.C. refused the application, with costs, and said:—'The master has applied his discretion to the subject, and in no particular can I disturb his conclusion.'

BEARD *against* EGERTON, A.D. 1846–9. 2 Car. & K. 667; 3 C.B. 97; 8 C.B. 165; 19 L.J. C.P. 36.

Pleading, demurrer. Imported Invention. Title of Patent. Sufficiency of Specification. Obligation in Specifying.

CASE for the infringement of a patent of 14th *Aug.* 1839, No. 8,194, to *M. Berry* (a communication from a foreigner residing abroad), for 'a new *or* improved method of obtaining the spontaneous representation of images received in the focus of the *camera obscura*.' The declaration alleged that *M. Berry* was the true and first inventor of a new manufacture within this realm, to wit, &c. Pleas: 5. That one *Daguerre* invented the method which was the subject of the patent; that one *Niepce* practised the invention in *France*; that *Daguerre* and *Niepce* were *aliens*; that they retained *M. Berry*, as their agent, to procure letters patent in his own name, upon trust for their use and benefit; that *M. Berry* was no otherwise, than as aforesaid, the true and first inventor, whereby the letters patent were void. 10. That the title of the patent was 'a new *or* improved method, &c.,' and that therefore the patent was void. 12. That the specification was insufficient. Demurrer to pleas 5 and 10. Joinder in demurrer. Judgment for plaintiff by the Court of Common Pleas. (Tindal, C.J., Cresswell, Erle, JJ.)

Per TINDAL, C.J.—The cases decided before stat. 21 Jac. I. cap. 3, prove that grants by the Crown to persons who have brought any new trade within the realm were good at common law. And the exception contained in the 6th section of the statute was made in affirmance of the common law, introducing no other alteration than the restriction, in point of time, for which such grants might extend. It was argued that, to come within the statute, the person who takes out the patent should be the *meritorious* importer, not a mere clerk or servant or agent to whom the communication was made by the foreign inventor. No authority is cited for such distinction. We see no reason or principle which should prevent an *alien amy*, if the Crown thought proper, from receiving such a grant, either in his own name, or in the name of another in trust for him. In the case of *Chappel* v. *Purday* (14 M. & W. 318), the Court, in their judgment, assume it to be clear in point of law that a foreigner may hold a patent, if the Crown chooses to grant it to him.

[The learned judge here referred to a portion of the judgment delivered by *Pollock*, C.B. in the case cited, which was the following:—Under stat. 21 Jac. I. cap. 3, against monopolies, the 6th section, which leaves as they stand at common law all the letters patent, for fourteen years, of new manufactures granted to the first inventors, it has been decided that an *importer* is within the clause, and if the manufacture be new in the realm he is an inventor, and may have a patent, though he is not the assignee of the foreign inventor, and though he may be a foreigner himself, if the Crown chooses to grant him a patent. The authority for this is to be found in *Edgeberry* v. *Stephens* (2 Salk. 447).]

As to the 10th plea, we think the objection to the title of the patent is answered by reference to the decided cases of *Neilson* v. *Harford* (8 M. & W. 806) and *Nickels* v. *Haslam* (7 M. & G. 378).

The action now came to be tried on the remaining issues, the issue on the sufficiency of the specification being that on which the case turned.

The patent related to the so-called *Daguerreotype* process, consisting in the following operations:—1. The silver surface of a plate was cleansed with dilute nitric acid, dried by powder of pounce, and lightly rubbed with cotton wool. 2. The surface was rendered sensitive to the action of light by exposing it to the vapour of iodine. 3. It was transferred to the camera, and received the impression of an image. 4. The latent picture was developed by the vapour of mercury. 5. It was finally washed with a weak solution of hyposulphite of soda, and became fixed. The specification stated:—'The first part of the operation may be done at any time.

This will allow of a number of plates being kept prepared up to the last slight operation. It is, however, *considered indispensable, just before the moment of using the plates in the camera*, or the reproducing the design, to put, *at least once more, some acid on the plate*, and to rub it lightly with pounce, as before stated.' The specification further stated:—'After this second operation is completed, the plate is to be passed to the third operation, or that of the *camera obscura*. Whenever it is possible, the one operation should immediately follow the other; the longest interval between the two should not exceed one hour.'

At the trial it appeared that no picture could be taken if the plate were washed with acid after exposure to the iodine vapour. WILDE, C.J. was of opinion that the specification was bad, as directing acid to be applied just before the moment of using the plates in the *camera*, and directed a verdict for defendants on the issue on the 12th plea. Verdict for plaintiff on the other issues. Leave reserved.

Rule nisi to enter a verdict for plaintiff on the issue as to sufficiency of the specification made absolute by the Court of Common Pleas.

During the argument MAULE, J. said:—'If so much nicety of description were 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.

'If you describe in a specification two ways of doing a thing, and by one way it cannot be done, the specification is bad.'

Also, in reply to counsel, CRESSWELL, J. said:—'The judge is to state what the specification orders to be done, and the jury are to say whether it would produce the result.'

Per WILDE, C.J.—It is to be observed that, when the plate is not intended to be used immediately (and where it has previously been partially, but not entirely, prepared for the iodine), this last application of acid is still to *precede the second operation*. It is plain that the patentee did not intend any separate operation to intervene between the application of iodine and the introduction of the plate into the *camera*. This, we think, is the fair construction of the language of the specification; and, although there may, at first sight, be some appearance of obscurity in it, we think that is cleared away by a consideration of the whole, and that it is sufficiently plain to be understood by an operator of fair intelligence.

BEESTON *against* FORD, A.D. 1830. 2 Coop. Ch. Ca. 58.

Practice in Patent Suits. Long Enjoyment of Patent.

Per LORD LYNDHURST, L.C.—There may be considerable doubt as to the validity of a patent; still, if there has been a long exclusive enjoyment, the doctrine of the Court is that an injunction shall go to protect the patent, until the question of its validity is duly determined at law.

BENTLEY *against* FLEMING, A.D. 1844–5. 1 Car. & K. 587; 1 C.B. 479.

Experimental User of Machine before Patent granted.

CASE for the infringement of a patent of 21st *Dec.* 1841, No. 9,207, to *W. C. Thornton*, for 'improvements in machinery for making cards for carding cotton,' &c. Pleas: 1. Not guilty. 2. That plaintiff was not the true and first inventor. 3. That the invention was not new. Issue.

At the trial it appeared that, some five or six weeks before the grant of the patent, the inventor had lent the machine in question to one N., in order that he might try whether it would set the teeth of cards. The machine was placed in N.'s room in a mill, and men were constantly going backwards and forwards to and from the room. It also appeared that the machine had been in complete working order for some weeks before it was lent to N.

It was contended on behalf of defendant: (1) That the patent was avoided by the public use of the machine in a public room before the grant. (2) That a machine which was in complete working order for a long period before the grant was not the subject of a patent.

CRESSWELL, J. over-ruled both these objections, and said:—'There is no evidence that the machine was lent to N. for the purpose of giving it publicity. The evidence merely is that *Thornton* lent the machine to N., in order that he might discover whether it was worth while to take out a patent for it or not. And as to the second objection, you cannot contend that if a man were to keep his invention shut up in a room for twenty years, that circumstance merely would deprive him of his right to obtain a patent for it.'

Verdict for plaintiff.

The report in the C.B. series refers to a miscarriage in recording the verdict.

REGINA *versus* BETTS and STOCKER, A.D. 1850. 15 Q.B. 540.

Sci. fa. Joinder of co-patentees as defendants.

Sci. fa. to repeal a patent of 30th *Dec.* 1844, No. 10,449, to *W.*

Betts and *A. S. Stocker*, for improvements in the mode of stoppering bottles. The writ stated the grant of the patent to defendants, and suggested that they did not invent the supposed invention, and were not the true and first inventors thereof. Plea: (in abatement) by defendant *Betts*, that *Stocker* had assigned all his interest in the patent to *Betts* before the writ was sued out, and had not since any interest therein. General demurrer, and joinder. Judgment of *respondeat ouster* by the Court of Queen's Bench. (Lord Campbell, C.J., Patteson, Coleridge, Erle, JJ.)

Per LORD CAMPBELL, C.J.—This plea is clearly bad. The Crown has a right to call upon those who obtained the patent to show why it should not be cancelled. If the proceeding is, in any instance, an abuse of process, application may be made to the Court for its summary interference.

BETTS *against* MENZIES, A.D. 1857–62. 3 Jur. N.S. 357; 8 E. & B. 923; 1 E. & E. 990, 1,020; 10 H.L. Ca. 117.

Practice in Patent Suits. Injunction after long Enjoyment of Patent. Evidence of prior Publication. Misdirection of Judge. Novelty of Invention. Manufacture for sale before the Patent.

Suit to restrain from infringing a patent of 13th *Jan.* 1849, No. 12,415, to *W. Betts*, for 'a new manufacture of capsules, and of a material to be employed therein, and for other purposes.'

The patent related to a method of plating lead with tin, in imitation of tinfoil. For this purpose, ingots of lead were cast in plates about 30 inches long, 3 inches wide, $\frac{3}{4}$ inch thick. These strips were reduced by rolling to about $\frac{1}{4}$ inch in thickness. The tin was also cast and rolled into strips about $\frac{1}{20}$th the thickness of the lead, and of equal breadth therewith. A strip of tin was then folded over a strip of lead, so as to cover it completely on both sides, and the compound strip was passed between rolls, and subjected to a very considerable pressure. The two metals united perfectly by molecular cohesion, and their relative thicknesses were preserved during any subsequent lamination by rolling between polished rolls. When the material was reduced to the substance of tinfoil, the lead remained perfectly coated with tin, and the surface had a brilliant metallic lustre. If preferred, the lead could be coated on one side only. After describing the process of manufacture, and the precautions necessary for success, the specification stated:—'For the manufacture of capsules the material so prepared is cut into discs of the required size, and the manufacture is conducted as described in the specification of a patent of 16th *March*, 1843, No. 9,665, to *J. T. Betts*. I am aware that it has been proposed to cover lead with tin, by

applying the tin, when in a state of fusion, to the lead when adequately heated, but the adhesion of the two metals in my new material is produced by the agency of mechanical pressure.'

Claims: 1. '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. 2. The manufacture of capsules of the new material of lead and tin combined by mechanical pressure, as herein described.'

Defendant contended that the invention had been anticipated by a prior patent, viz., that of 4th *May*, 1804, to *T. Dobbs*, No. 2,761, for 'a new article of trade, which I denominate *Albion Metal*, and which I apply to the making of cisterns, linings for cisterns, covering and gutters for buildings, boilers, vats, coffin furniture, worms for distillers, and such other things as are required to be made of a flexible, a wholesome, or a cheap metallic substance.' The specification stated:—'I take a plate or ingot of lead and a plate of tin, of equal or unequal thicknesses, and laying them together, their surfaces being clean, pass them between the rolls of a flatting or rolling mill with what is technically termed a hard pinch, so as to make the metals cohere. If after the first passage the plates do not sufficiently cohere, I pass them a second or third time or more between the rolls, until a sufficient degree of cohesion is produced. After a plate of lead had been coated on one side with tin, it might, if desired, be doubled with the lead side inwards and rolled as before, so as to produce a plate of lead coated on both sides with tin. N.B. It will be useful, if not necessary, to have the rolls and the metals hot when the cohesion of the metals is to be effected by their passage between the rolls.'

Injunction granted, plaintiff to proceed forthwith to a trial at law.

Per WOOD, V.C.—As to enjoyment, there never was a clearer case than the present. It has been long undisputed, and it is clear, on the defendant's own evidence, that it is still a very valuable enjoyment.

I think that if a man sits down, and takes out a patent from his own conjectures, without ever having tried the experiment set forth in it, that will not invalidate a subsequent patent taken out and practically worked, especially when it turns out that the method described by the earlier patent is practically useless. Take, for instance, the electric telegraph. Many ingenious persons had talked of the means of communicating between two places by electricity, and had discussed the mode of carrying out that idea before Messrs. *Wheatstone* and *Cooke* showed a practically useful way of doing it. The law of this Court is, that where the patentee has had long enjoy-

ment, there he shall have an injunction to protect his rights until trial, even although his rights under his patent be doubtful; much more ought he to have the injunction here, when I have considerable doubts whether the fact of *Dobbs's* patent would affect the plaintiff's rights.

Action at law in pursuance of the order of the Court. Pleas: 1. That plaintiff was not the true and first inventor. 2. That the invention was not new. 4. That the specification was insufficient. Issue.

At the trial defendant gave in evidence the specification of the patent of 1804, No. 2,761, to *T. Dobbs.* It appeared that there had been no actual user of metal made under *Dobbs's* patent, but defendant relied upon the comparison of the two specifications, as showing that plaintiff's process was not new. Evidence was given on both sides as to the practicability of producing plaintiff's metal by following only the instructions given in *Dobbs's* specification.

Whereupon, LORD CAMPBELL, C.J. asked the jury, 'Whether by the specification of *Dobbs*, or anything done under it, there was made known to the world the process in the specification of the plaintiff.' The jury having hesitated for some time, he finally asked them, 'whether they thought that a person of ordinary skill, reading *Dobbs's* specification, and having no other information on the subject, could at once proceed to make *Betts's* metal.' The jury answered in the negative, whereupon the learned judge directed them to find for plaintiff on the issues upon the first and second pleas. Plaintiff had also a verdict on all the other issues.

(8 E. & B. 923.) Rule nisi for a new trial on the ground of misdirection, made absolute by the Court of Queen's Bench. (Lord Campbell, C.J., Wightman, Crompton, JJ.)

Per LORD CAMPBELL, C.J.—The way in which I first left it to the jury was, I think, right. Now, I think that though a mode of coating the lead with tin was described in each specification, yet if the plaintiff's specification described a new *modus operandi*, that would be a proper subject for a patent. I think that the test which I finally proposed was defective. That was a proper test only upon the question whether *Dobbs's* specification was good or bad. But the specification might be bad, and yet might disclose enough to show that what the plaintiff specified was not a novelty.

New trial of the same action. The pleadings were the same as before. Defendant again put in evidence the specification of a patent of 14th *May*, 1840, No. 2,761, to *T. Dobbs.* It now appeared that, owing to some unforeseen delay in obtaining the patent, plaintiff had manufactured a quantity of capsules according to his invention, but

this was done by his own workmen under strict injunction that none should be sold, and none were sold until after the patent had been granted. Witnesses also deposed that the patented material had been publicly used before 1849. The scientific evidence went to the same points as in the previous action, and was entirely contradictory on the one side and on the other.

ERLE, J. left it to the jury to say whether the invention was new, and he pointed out that *Dobbs's* specification comprised lead coated with tin by mechanical pressure; that the plaintiff's specification was not confined to any one particular proportion of lead and tin; and that the defendant was entitled to a verdict if the jury were of opinion that *Dobbs's* specification was sufficient to enable a competent person to produce the material subsequently patented by the plaintiff, or that the material had been both produced and used, or sold in public before 1849. The jury found that the new material had been made by pressure prior to the plaintiff's patent, but had not before then been publicly used or sold by a manufacturer in the way of his business. Verdict for plaintiff. Leave reserved.

(1 E. & E. 990.) Rule nisi to enter a verdict for defendant, on the grounds:—1. That plaintiff had manufactured large quantities of the capsules for sale before the date of the patent. 2. That plaintiff's invention, or some material part thereof, was included in *Dobbs's* specification. 3. That the specification was defective in not stating the proportions between the two metals. 4. And in not distinguishing the new from the old. Or for a new trial on the ground of misdirection, on the question raised as to the sufficiency of the specification in respect of the proportions of lead and tin, and that the verdict was against the evidence. Rule to enter a verdict for defendant made absolute by the Court of Queen's Bench (Lord Campbell, C.J., Wightman, Erle, Crompton, JJ.), and Rule for a new trial enlarged until after the judgment of the Court of Error on the previous points.

Per LORD CAMPBELL, C.J.—Upon the first point my opinion is clearly in favour of the plaintiff. I quite agree that if you look at the 6th section of the Statute of Monopolies, it abolishes monopolies altogether, and that there was no power in the Crown after that statute passed to grant monopolies, except with the conditions that are imposed by the reservation; but the reservation which must be relied on here is this, 'which others at the time shall not use.' Now others had not used this before the patent was granted. It was used only by the inventor, the patentee himself; for the use of it by the servants and mechanics whom he employed, must be considered his use; and therefore it was not used by others. But still, if it could

be shown that the effect was really to extend the term of the monopoly, that would be fatal. But Mr. *Hindmarch* has entirely failed in showing that, because any person might have used this manufacture lawfully until the patent was sealed and the fourteen years had begun to run, there was a period of more than fourteen years during which the monopoly existed. That period was not in the slightest degree exceeded.

I come now to the next objection. Notwithstanding *Dobbs's* patent, I am of opinion that it would have been open for another discoverer to have found out certain proportions in which the tin and lead might have been applied to each other, and a new mode of operating, whereby a beneficial result might be obtained. It seems to me that the proportions were not considered as uniformly essential, and that the patentee, by his specification, gives the proportions for the manufacture of the material for the capsules only; intimating, as I think very plainly, that where it was to be applied to other purposes, those proportions might infinitely vary. He claims as his invention the uniting these surfaces by rolling or other mechanical pressure. That is disclosed, and most amply, by *Dobbs*; and therefore I find that the plaintiff claims what *Dobbs* had before described. On that ground I think that the patent is bad.

The other judges concurred.

(1 E. & E. 1,020.) Error brought from the Court of Queen's Bench. Judgment affirmed by the Court of Exchequer Chamber. (Pollock, C.B., Williams, Willes, Keating, JJ., Martin, Bramwell, Channell, BB.)

Per WILLIAMS, J. (*dissentiente*).—I think that the judgment of the Court of Queen's Bench ought to be reversed. It appears to me that although *Dobbs* made public his notion that lead and tin might be usefully combined into a new material by mechanical pressure, yet inasmuch as he did not make known, or know, by what means that notion could be carried into effect, he, in fact, made no discovery, and was no inventor at all. I have yet to learn that the publication of a notion that a certain useful art may be discovered, without any information or knowledge of the means of discovery, is to preclude a subsequent first inventor of those means from taking out a patent for the entire art.

WILLES, J., concurred in this judgment.

(10 H.L. Ca. 117.) Error was then brought in the House of Lords. The judges were summoned, and Pollock, C.B., Wightman, Williams, Byles, Blackburn, JJ., and Wilde, B., attended. The Lord Chancellor proposed the following questions to the learned judges:—

1. Does it appear, on a comparison of the two specifications, that

a material part of *Dobbs's* specification is claimed by *Betts* in his specification?

2. If so, can the Court pronounce *Betts's* patent to be void, simply on the comparison of the two specifications, without evidence to prove the identity of the inventions, and also without evidence that *Dobbs's* specification described a practicable mode of producing the result, or some part of the result, described in *Betts's* patent?

There was some difference of opinion in the answers given to the first question, but all the learned judges concurred in answering the second question in the negative, WILDE, B. saying:—'The Court can pronounce two identical descriptions to pourtray two identical inventions; but when the descriptions are different, the identity in substance of the two inventions is a matter to be established by extrinsic evidence.'

Ordered.—That the judgment of the Court of Exchequer Chamber be reversed, and that the judgment or rule of the Court of Queen's Bench, so far as it orders that the verdict obtained in the said Court be set aside and a verdict entered for the defendant instead thereof, be also set aside.

Per LORD WESTBURY, L.C.—The answer of the learned judges to the second question involves two conclusions which are extremely material to the patent law. One is, that even if there is an identity of language in two specifications, and (remembering that those specifications described external objects) even if the language is *verbatim* the same, yet if there are terms of art found in the one specification, and also terms of art found in the other specification, it is impossible to predicate of the two with certainty that they describe the same identical external object, unless you ascertain that the terms of art used in the one have precisely the same signification and denote the same external objects at the date of one specification as they do at the date of the other.

In all cases where two documents profess to describe an external thing, the identity of signification between the two documents containing the same description must belong to the province of evidence, and not to the province of construction.

I pass on to the next conclusion, which is also of great importance to the law of patents, because it results from that opinion that an antecedent specification ought not to be held 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. Here we attain at length to a certain, undoubted, and useful rule. The effect of that opinion I take to be this, if your Lordships shall affirm it, that

a barren general description, probably containing some suggested information, or involving some speculative theory, cannot be considered as anticipating, and as therefore avoiding, for want of novelty, a subsequent specification or invention which involves a practical truth, productive of beneficial results, unless you ascertain that the antecedent publication involves the same amount of practical and useful information.

Now it will be evident, upon a comparison of these two specifications, that the one was a mere general suggestion, while the other is a specific, definite, practical invention. It is possible that a suggestion, such as that contained in the one, may lead to the discovery of the invention contained in the other. But it is this latter alone which really does add to the amount of useful knowledge; it is the latter alone which, by its practical operation, confers a benefit upon mankind within the meaning of the patent law.

In the present case, there was not only no evidence to show that that which is contained in *Dobbs's* specification was capable of practical operation, but in reality that conclusion was negatived by the verdict of the jury. It results, as a necessary consequence, that the decision of the Court of Queen's Bench and of the Court of Exchequer Chamber ought to be reversed.

Per LORD WENSLEYDALE.—I entirely agree with Mr. Justice Williams and Mr. Justice Willes in their opinion given in this case, that the mere publication 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.

BETTS *against* CLIFFORD, A.D. 1860. 1 J. & H. 74.

Practice as to Costs where a Suit is abandoned. Three Counsel allowed.

Suit to restrain from infringing the same patent. Motion for injunction ordered to stand over till after the trial of an action at law which was then pending, nothing being said about costs. Plaintiff abandoned his original action against defendants, and began a new one, which resulted in a verdict for defendants on the validity, and for plaintiff on the infringement. A rule for a new trial was afterwards refused by the Court of law. The bill was finally dismissed with costs, for want of prosecution. In taxing defendants' costs the master allowed the costs of opposing the motion for injunction, and the costs of bringing into Court a third counsel, who had been retained at law in the previous actions on the patent. On appeal, the master's decision was upheld.

BETTS *against* NEILSON, A.D. 1868–1871. 3 De G. J. & S. 82; L.R. 3 Ch. 429; L.R. 5 H.L. 1.

Evidence of Infringement. Evidence of prior Publication. User of patented Article. Sufficiency of Specification. Statement of Proportions. Subject-matter of a Patent. Practice as to Account, or Damages.

Suit to restrain from infringing the same patent by the user of certain capsules for covering the corks of bottles.

The defences raised were, (1) prior publication of the invention by *Dobbs*'s patent of 1804, No. 2,761; (2) prior user of the invention; (3) that the specification was bad in not stating the proportions of lead and tin; (4) that the manufacture of capsules from the patented material was not the subject-matter of a patent; (5) denial of the infringement.

As to the infringement, it appeared that defendants were the managers of Messrs. *Tennant*, brewers, in *Scotland*, and obtained capsules from a manufactory near *Nuremberg*. Plaintiff produced proof by a workman who was employed in the said manufactory, and saw the capsules made by a process not distinguishable from the patented process. On analysis, the proportions of lead and tin were found to differ from those stated in the patent. Defendants commonly sold the capsuled bottles to persons in *Glasgow*, but in some instances they sent the same to *England*, on their own account, for exportation.

Injunction granted, with account and inquiry as to damages.

(3 De G. J. & S. 82.) On appeal to the Lords Justices, judgment affirmed, with costs.

Per TURNER, L.J.—The liquid comes into this country in bottles, having upon them the patented article, or an article operating in precisely the same way, and so closely resembling the patented article that the use of it in *England* would be an infringement of the patent. I cannot say that the retaining upon the bottles when they are in this country the article so applied to them abroad does not constitute a use of the article in *England*. The case of *Caldwell* v. *Vanvlissengen* (9 Hare, 415) may be in some respects distinguishable from the present, but I think that it disposes of the present question. The distinction attempted to be drawn between that case and the present is this, that in that case there was an active use of the patented article; and here it is said, and I have no doubt truly said, that the use of the patented article is passive and not active. But it does not appear to me that the question whether the user is active or passive can have any bearing on the question whether the patented article is used or not.

(L.R. 3 Ch. 431.) On further appeal to the Lord Chancellor, judgment affirmed, with costs.

Per LORD CHELMSFORD, L.C.—I am of opinion that *Dobbs's* specification was not such a publication of the invention patented by the plaintiff as to invalidate his patent.

But the defendants say, that there is a great body of evidence to prove a use of the invention long prior to the date of the plaintiff's patent. If the evidence which I am about to examine establishes the fact that lead coated with tin by mechanical pressure, and capable of useful application, has upon any occasion been manufactured openly, not by way of experiment, but in the course of business, although not a single piece of the material was actually sold, I should hold that *Betts's* patent was invalidated.

His Lordship then proceeded to examine the evidence, and held that the defence on this ground entirely failed.

He then continued :—The infringement of a patent is a *tort*, and all persons who are in any way acting towards it are jointly answerable. I do not appreciate the distinction which was pressed upon me in argument between the active and passive use of a thing. In my opinion there was an active use of the capsules by those who first placed them upon the bottles, and by those who had them in their possession afterwards, with the power of either continuing or removing them.

His Lordship then examined the objection to the decree, on the ground that it ordered an account and also an inquiry as to damages, and stated that he should hold the decree of the Vice-Chancellor to be right in this respect.

(L.R. 5 H.L. 1.) Appeal to the House of Lords. The patent expired on 13th *Jan.* 1868, and the judgment of the Lord Chancellor was given on 8th *Feb.* 1868. By the expiry of the patent the injunction fell to the ground. There remained only the demand for damages, and the question of costs. Decree varied by striking out the order for an account, otherwise affirmed. Appeal dismissed, with costs.

Per LORD WESTBURY.—The question of user was argued at some length, but I think unnecessarily. The user which is admitted to have been made by the appellants of these foreign capsules is this, that, after having applied them to their bottles of beer, they have, in some cases, sent the bottles so capsuled to their agents in *England* for exportation from *England*. As soon as the bottles passed the border there was a user of the capsules by the appellants, and the capsule was performing its proper function during the whole time of the transit of the bottles through *England*, and their remaining in *England* until they were exported. There is here evidence of a user of the patented article prejudicial to the patentee, which is sufficient

in itself to justify and support the injunction and the direction as to damages; and it is not necessary to enter into the inquiry as to the extent to which this has been done, it being clearly proved, and in fact admitted, that it has been done to a certain extent, and in a manner that must have been injurious to the patentee.

In ordinary cases of pirated patents in *England*, Courts of Equity have been in the habit, where there is a difficulty in obtaining proof, of granting a limited order of access and inspection of the machinery possessed, or the manufacture carried on, by the individual who is charged with the piracy. The opportunity of doing that is not enjoyed by the respondent here by reason of the locality of the foreign manufacture. But the opportunity of describing the actual process pursued there was possessed by the appellants to the full extent, and they might have entirely rebutted the *primâ facie* evidence given by the respondent, if it was in their power to do so, by producing conclusive proof that the process of the foreign manufacture was substantially different from the process described in the respondent's patent. That, however, they have not done, nor have they assigned any satisfactory reason for not having done so.

The objection to the validity of the patent, on the ground of want of novelty, rests, first, on an old patent of *Dobbs*, which was granted in 1804. Your Lordships came to the decision that if you took *Dobbs's* specification in the one hand, and *Betts's* specification in the other, you could not upon a comparison of the two *per se*, arrive at the conclusion that the one anticipated the other. The point therefore has been conclusively settled by your Lordships' House, that the invention of the one taken *per se*, did not forestall or anticipate the invention of the other.

I will merely note for a moment some little difficulty that appears to have been felt about an opinion I expressed in the case of *Hills* v. *Evans* (31 L.J. Ch. 457), as to what it was necessary to find in the anterior publication. My opinion was that the antecedent process, if it be relied upon as forestalling the second, must be so clearly and distinctly described, that those who read it, bringing to it competent mechanical skill, would be enabled to work it out to the same result as that arrived at by the process contained in the subsequent patent. Lord Lyndhurst required for the anterior description of the machine that it should be distinctly and clearly described in a manner corresponding with the description in the specification.

Now that being the obligation lying upon those who appeal to a prior patent as having already given to the world the necessary and useful information which is contained more fully in the subsequent patent, the appellants have sought to discharge themselves of that

obligation by bringing two descriptions of evidence—one, the evidence of scientific witnesses, who, taking up in the years 1866 and 1867, when they were examined, the specification of *Dobbs*, have tried to work it in such a manner as to produce results substantially identical with the material of *Betts*, and therefore to prove that, in reality, it forestalled *Betts's* discovery. The other consists of evidence applicable to the fact of there having been in reality a prior user of *Betts's* process anterior to the patent.

I must say that when we come to examine the scientific evidence, I think I never met with a case where I was more pained to observe the manner in which the efforts of the men examined had all been directed, after their minds were fully informed of *Betts's* invention, to endeavour to strain the description of *Dobbs*, so as to include in the application made of *Dobbs's* design and *Dobbs's* processes, something which should approximate to the invention of *Betts*. Upon the evidence I have desiderated, but have been unable to find proof that by the process of *Dobbs*, without anterior lamination, which belongs to *Betts's* invention, there has been produced a material substantially identical with *Betts's* material, and capable of similar application.

We pass on to the other evidence which has been given of prior user. It appears that the proof of prior user has been reduced by the present appellants to what took place at four mills. The whole of this evidence was gone through by the Vice-Chancellor, and also by the Lord Chancellor. I entirely concur with the observations made by both those learned judges, namely, that the evidence was not to be relied on. That plain and distinct proof which might have been given, if the truth was so, is wholly wanting.

My Lords, that brings us to the consideration of the last two objections to this patent. If, it is said, a particular detailed process be claimed, the claim is defective and void, for the proportions of the ingredients used are not given. Now, in the first place, certain proportions are given by *Betts* in his patent, and they consist in the relative thickness of the lead and tin. But he assigns these relative proportions not as things which are in themselves unchangeable, but as being the best for the purpose which he desired to accomplish, and they are given rather as illustrations of the mode of user of the process, than as certain definite termini which could not be exceeded or diminished either on the one side or the other. I find, therefore, no objection to the validity of the patent on this ground.

The last objection to the patent 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 inde-

pendently of the process, nor the process independently of the product, the specification concludes with a claim of the manufacture of capsules out of the material. But the manufacture of capsules out of the material would be one purpose only to which the material could be applied; and if a claim to the material can be substantiated by the patent, the specification of a particular user of it, comprehended in the general user claimed, cannot for a moment be accepted as a ground for vitiating the patent.

I have only further to observe that the decree of the Court below directed not only an inquiry as to damages, but also an account of profits. The two things are hardly reconcilable, for if you take an account of profits, you condone the infringement. I therefore think, my Lords, that we were right in calling upon the respondent's counsel to elect between the two which he would adopt. He has adopted the inquiry as to damages, and the other, the account of profits, must be struck out of the decree. But that ought not to alter the result of this appeal, and I trust therefore that your Lordships will concur in the motion I have to make, that this appeal should be dismissed, with costs.

BETTS *against* DE VITRE, A.D. 1865–73. 34 L.J. Ch. 289; 11 Jur. N.S. 9; L.R. 3 Ch. 429; L.R. 6 H.L. 319.

Practice in Patent Suits. Account or Damages. Personal liability of Directors of a Company for Infringement. Costs.

Suit to restrain from infringing the same patent, brought against *Wimshurst's Metal Foil Company*, and its directors.

The case was tried by the Court without a jury, on the issues of validity and infringement, both of which were found for plaintiff, who prayed an account and inquiry as to damages.

WOOD, V.C. granted the injunction with the usual account, but (following the decree of Lord Westbury, L.C., in *Hills* v. *Evans*, 31 L.J. Ch. 457) allowed plaintiff to proceed at law for damages if he chose to waive the account. Subsequently, however, it was discovered that the decree drawn up in *Hills* v. *Evans* directed 'an account of profits made by the defendant by infringing the plaintiff's patent, and of such other compensation as was fit to be awarded to the plaintiff in respect of such infringement.' Whereupon his Lordship ordered an account, together with inquiry into damages, and granted the injunction with costs.

(11 Jur. N.S. 9.) Application was then made for costs as between solicitor and client, and that the directors should be made personally liable for the same. Full costs refused, but the directors held personally liable.

Per Wood, V.C.—As regards the point about the defendants being made personally liable for the costs, I really have no doubt on the subject. The case being distinctly stated and proved, I have not the least doubt that the decree must be against them, both as to the injunction and account, and that they must be decreed personally to pay the costs. I see no ground for exempting them from any possible penalty which the law may impose.

His Lordship then recapitulated the proceedings which had taken place in *Betts* v. *Menzies*, by stating that the judge gave his certificate at the trial that the right had come in question, and the verdict then was with the plaintiff; that after the judgment of the House of Lords, the Court of Queen's Bench directed a new trial, which, however, did not take place, in consequence of a compromise between the parties; and continued:—That being the only certificate I have, I think, regard being had to stat. 15 & 16 Vict. cap. 83, sec. 43, that where there is a wilful act against the rights of a patentee after he has obtained a verdict, and the certificate of a judge that his title came in question, all the world must be taken to know that if they infringe the patent, they infringe it with a liability for costs. That being the meaning of the Act of Parliament, I have not enough before me here to direct these costs to be paid as between solicitor and client.

(L.R. 3 Ch. 429.) On appeal to the Lord Chancellor, decree affirmed, and appeal dismissed, with costs.

Per Lord Chelmsford, L.C.—The alleged infringement of the plaintiff's patent took place in the company's works, and in the course of the performance of the proper duties in which the workmen were engaged. Those who have the control of the working are responsible for the acts of their subordinates, and it is not sufficient for them to order that the work shall be so done that no injury shall be occasioned to any third person. That, of course, must be avoided, whether orders to that effect are given or not; but the directors were bound to take care that their orders were obeyed, and if there was a violation of them, whether openly or secretly, they are liable for the consequences.

(L.R. 6 H.L. 319.) Appeal to the House of Lords. The decree of Lord Chelmsford, L.C. was the same as that pronounced in *Betts* v. *Neilson* (L.R. 3 Ch. 429). In *March*, 1871, the House of Lords varied the decree of the Court below in the latter case by striking out the double order for an account and inquiry as to damages, and put Mr. *Betts* to his election between the two. On 26th *Jan.* 1872, the solicitors for appellants informed the solicitors for respondent that they could no longer dispute the validity of the

patent or its infringement, and that they would withdraw the appeal and pay the costs up to that time, if respondent would consent to abandon the double claim to an account and damages, and would elect between the two; and that otherwise they should apply for the costs occasioned by his refusal. This proposal was not accepted, and the case went on; but appellants adhered strictly to their proposition, and stated the same to their Lordships.

Decree appealed from varied, with special directions as to costs.

Per LORD CAIRNS.—As I understand the order in *Neilson* v. *Betts*, if it decided anything it decided this, that, not by reason of any peculiarity in that particular case, not by reason of the inquiry as to damages being sufficient for that particular case as distinguished from other cases, but on the general principle that the recent power given to the Court of Chancery to grant an inquiry as to damages (see 21 & 22 Vict. cap. 27, sects. 2, 5), was not intended to be superadded to, and could not coexist with the old relief administered by the Court of Chancery of granting an inquiry as to profits, upon that ground your Lordships decided that the decree in that case should be varied; and, my Lords, that is a ground which applies not to that case alone, but to every case of an infringement of a patent.

The decree must be varied in the way it was varied in *Neilson* v. *Betts*. The only other question is, what is to be done with regard to the costs? It was brought home to the mind of the respondent that after the decision in *Neilson* v. *Betts* there was no longer anything to be argued in this case, or anything which your Lordships could attend to or listen to for a moment. The offer was then fairly made to reimburse all expense the respondent had incurred up to that time, and from that time forward it became, not a question of what the Court below had done, but a question of misconduct on his part in maintaining the defence to an appeal which, when it was narrowed to this one single point, he no longer ought to have maintained. My Lords, on this ground, which stands high and dry from the infringement of any rule of your Lordships' House, I entirely concur in the motion made by my noble and learned friend that in this case, according to the offer made by the appellants, they should pay the costs of the appeal up to 26th *Jan.* 1872, and from that date the costs of the appeal should be ordered to be borne by the respondent.

BETTS *against* GALLAIS, A.D. 1870. L.R. 10 Eq. 392.

Practice in a Suit where the Patent has expired.

Suit to restrain from infringing the same patent, for an account, and compensation in damages. Bill filed on 8th *Jan.* 1868. The

patent (extended for five years) expired on 13th *Jan.* 1868. No application had been made for an *interim* injunction. The validity of the patent was admitted. Bill dismissed, with costs.

Per JAMES, V.C.—I am of opinion that this bill cannot be sustained. I agree with every word which fell from Vice-Chancellor Wood in *Davenport* v. *Rylands* (L.R. 1 Eq. 302). But I think he never intended to give countenance to such an application as this, where the patent expired a few days after the bill was filed; and the plaintiff must have known it was utterly impossible he could have obtained any equitable relief before the patent expired. At the time of filing this bill there was a mere claim for damages.

BETTS *against* WILLMOTT, A.D. 1870–1. 18 W.R. 946; L.R. 6 Ch. 239.

Evidence of Infringement.

Suit to restrain from infringing the same patent. Plaintiff complained that defendant, a retail chemist, had sold a bottle of *Rimmel's* toilet vinegar, having a capsule similar to those manufactured under the patent. It appeared that plaintiff had capsule manufactories abroad, and he could not say that the capsule in question had not been made and sold by his own house in *Paris*. JAMES, V.C. dismissed the bill, without costs, neither side having, in his opinion, so conducted themselves as to become entitled to costs. Appeal from this decision dismissed, with costs.

Per LORD HATHERLEY, L.C.—When a man has purchased an article he expects to have the control of it, and there must be some clear and explicit agreement to the contrary to justify the vendor in saying that he has not given the purchaser his license to sell the article, or to use it whenever he pleases as against himself.

I am of opinion that, if the plaintiff cannot show that he has not himself sold the very article, the use of which he now seeks to prohibit, he cannot succeed by way of injunction in this Court any more than he would in an action at law.

BEWLEY *against* HANCOCK, A.D. 1855. 6 De G. Mac. & G. 391.

Construction of Agreement to work certain Patents.

Suit to obtain a declaration that a patent of 29th *July*, 1848, No. 12,223, to C. Hancock, for 'improvements in machinery for giving shape and configuration to plastic substances,' was subject to the trusts of a deed of 21st *Jan.* 1846, executed in pursuance of an agreement of 31st *May*, 1845, made between plaintiff, defendant, and two other persons, who were all interested in certain patents relating to the manufacture of gutta percha, whereby it was agreed

that all patents thereafter taken out by any of the parties 'in relation to the preparation and application of gutta percha, or the manufacture of any articles therefrom,' should be assigned to trustees, and held for their common benefit. STUART, V.C. made the decree as prayed. Appeal dismissed by the Lord Chancellor, with costs.

Per LORD CRANWORTH, L.C.—I do not doubt the accuracy of the proposition maintained at the bar, that there may be a wide distinction between a patent for the invention of any useful article of commerce, and a patent for the invention of machinery by which such an article may be manufactured. A discovery that the mixture of two or more simple substances in certain definite proportions will form a compound substance valuable for medical or other qualities, would afford a good ground for a patent. A discovery of some machinery whereby such a mixture may be more quickly or more effectually accomplished, might be the foundation of another patent, and instances might be almost indefinitely multiplied. When, however, we look at the subject-matter of this patent, it is plain that such a distinction never could be supported. Looking at the specifications of the patents clearly included in the agreement, it appears that they all, or almost all, describe as part of the invention the machinery by which the proposed manufacture is to be accomplished.

The defendant, however, contends that his patent is not within the agreement, because it is not a patent for the application or manufacture of gutta percha, but of plastic substances generally. This, however, is a distinction which it is impossible to maintain. The discovery had relation to the application and manufacture of articles from gutta percha, though it may be that it also had reference to the application and manufacture of articles from other substances. So far as it relates to gutta percha it is within the agreement, and so far as it relates to any other substances the defendant's rights are saved by the decree.

BICKFORD *against* SKEWES, A.D. 1837–9. 1 Webs. Pat. Ca. 211; 2 Coop. Ch. Ca. 59; 4 Myl. & Cr. 498; 1 Q.B. 938.

Practice in Patent Suits. Injunction. Action at Law. Sufficiency of Specification.

Suit to restrain from infringing a patent of 6th *Sept.* 1831, No. 6,159, to *W. Bickford*, for 'an instrument called the miner's safety fuse.' Injunction granted. Order for action at law.

'VICE-CHANCELLOR.—An order that the plaintiff shall undertake, in case it shall turn out that he is wrong, to compensate the defendant for injury in stopping his manufactory, is not usual.' *December*, 1838 (2 Coop. Ch. Ca. 59.

An application being made to compel plaintiff to proceed to trial

at an early date, LORD COTTENHAM, L.C. refused to make any order, and said:—If the patentee has been long in possession the Court will not look into the title, but will give credit to it until displaced by a trial at law, and will put the plaintiff upon proceeding to trial and exercise absolute control over the parties, according as they may or may not do that which the Court has directed.

Action at law. Plea: That the specification was insufficient. Issue.

The patent related to the manufacture of a *fuse*, formed of several strands of flax, hemp, &c., and enclosing within the interior a small core of gunpowder. The gunpowder was fed in by a funnel at the point where the strands were twisted into a cord. The specification 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 pyrotechnic manner of fireworks for the discharging of ordnance.'

At the trial, it appeared that gunpowder was, in fact, the material used by plaintiff; one witness, however, expressing an opinion that detonating powder would answer, but not so well as gunpowder. It was objected that the specification was bad as referring to other combustibles besides gunpowder, when gunpowder alone could be used; and also that the words 'flax, hemp, cotton, or other suitable material, spun, twisted, &c.,' were too vague, and might extend to materials which would not give effect to the invention, it being in evidence that glass fibres might be spun, but could not be employed for making the cord. COLERIDGE, J. left it to the jury to say, upon the evidence, whether the specification in its several parts sufficiently explained the invention. Verdict for plaintiff. Leave reserved.

Rule nisi for a new trial discharged by the Court of Queen's Bench.

BLOXAM *against* ELSEE, A.D. 1825–7. 1 Car. & P. 558; 9 Dowl. & Ry. 215; 6 B. & C. 169.

Master and Servant. Assignment by operation of Law. Drawings called in aid of description. Variance between Title and Specification. False Suggestion.

CASE for the infringement of two patents, viz., of 20th *April*, 1801, No. 2,487, for 'an invention of making paper in single sheets, without seam or joining, from 1 to 12 feet and upwards wide, and from 1 to 45 feet and upwards in length,' and of 7th *June*, 1803,

No. 2,708, for improvements and additions to the machine described in the first patent, each to *J. Gamble*. By stat. 47 Geo. III. cap. 131, the grants were enlarged, on condition that the patentee should enrol a further specification containing all improvements made in the machine (see No. 3068*, specification enrolled by *H. & S. Fourdrinier* and *J. Gamble*), and subject to the proviso, that if the patent should at any time become vested in or in trust for more than five persons, otherwise than by devise or succession, the privilege should cease and determine. Plea: Not guilty. Issue.

The patents related to the invention of a machine for making paper, which afterwards became the type of machinery in use at the present day. The specification of the patent of 1801 described the invention by reference to drawings, and showed an endless sheet made of copper wire (replacing the wire moulds used in making paper by hand) and supported by wooden rollers. A film of liquid pulp was continuously supplied to this copper sheet, and carried on thereby till it passed between two brass pressing cylinders, which squeezed out the water and so far dried the film of paper that it was capable of being at once rolled in a continuous sheet upon a light wooden roller. The specification stated:—'On both sides of the copper sheet are seen copper clasps, affixed at equal distances, and the said sheet is bordered on both sides with eel-skins, cut into strips or ribands.' This edging to the endless web determined the width of the paper. There was also a description of a machine for pressing the recently made paper by passing it on to an endless cloth and compressing it by a roller.

The specification of the patent of 1803 stated:—'Instead of limiting the breadth of the piece by the facing or edge of eel-skin attached to the edge of the circulating piece (or web), I do limit the said breadth by two gauges, one on each side, consisting of pieces of wood.' The gauges were then described. The specification enrolled under the Act of Parliament (No. 3068*) stated:—'The width of the paper is determined by two pieces of wood, set edgeways upon the web.' It went on to describe the dimensions of the pieces (which were about 4 feet in length), and the adjustment of them. One was placed over the web on each side thereof, and an endless strap carried on revolving pulleys ran between the guide and the web at the same surface velocity as the web. Additional guides and straps were placed underneath, so as to grasp the web and prevent the liquid pulp from running over its edge. The machine described in the final specification was greatly improved in construction, and was competent to manufacture paper of varying widths.

At the trial, it appeared that *Gamble* had obtained his knowledge

from one *Didot*, an *alien enemy*, whose trustee he was at the time of taking out the patent. Also that the improvements mentioned in the third specification were made by one *Donkin*, an engineer, employed by the patentee and his partner for the purpose of bringing the machine to perfection. It was objected that improvements so made were not the invention of the patentee and could not be claimed as such. It further appeared, on the evidence of Mr. *Donkin*, that the machine described in the first specification would work to one width only, and it was objected that the first and subsequent grants were therefore void for false suggestion. It also appeared that, upon the bankruptcy of the patentee in 1810, his creditors, exceeding five in number, had proved under the commission, and an objection was taken on this ground, but was over-ruled.

An objection being further raised that the patent was void as being held in trust for an *alien enemy*, ABBOTT, C.J. said:—'I shall reserve that point.'

The specification contained references to *French* words, e.g., '*vice of pression*' for '*adjusting screw*,' '*centimetres*' for '*inches*;' but it appeared that although these terms would not be understood by *English* mechanics, yet that a skilful workman could construct the machine by the aid of the drawings annexed to the specification, and his Lordship observed:—'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 drawings, the one will explain the other sufficiently to enable a skilful mechanic to perform the work, such a specification is sufficient.' His Lordship then left it to the jury to say whether the invention was useful, and whether the defendant had infringed; and further observed that by the 6th section of the Act of Parliament the final specification was to be taken as a substitute for the former specifications, and if good (which it was) that would cure all defects and omissions in the former ones. Verdict for plaintiff. Leave reserved.

Rule for a new trial on the ground that the patent was void, as being vested in trust for more than five persons, refused by the Court of King's Bench. (Abbott, C.J., Bayley, Holroyd, Littledale, JJ.).

Per ABBOTT, C.J.—I am clearly of opinion that the proviso can be construed only as applying to acts of the parties by which the interest in the patent shall be divested, and does not apply to an assignment by operation of law, which is the effect of a commission of bankruptcy. The assignees represent the bankrupt by operation of law.

Rule nisi for a new trial, granted on the remaining objections taken at the trial, but made absolute on the ground that the specification of the original patent was insufficient.

Per ABBOTT, C.J.—I think one of the objections which has been taken in this case is valid, and must prevail, and consequently it is not necessary to give any opinion upon the others. By the patent it appears 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 is granted. The consideration for the grant is 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 has failed in part, and the grant is consequently void, and a defendant in an action for infringement has a right to say that it is so. If the representation be (as I think it is) that paper of various widths may be obtained from one and the same machine, I must look to the evidence to discover whether the patentee was possessed of a machine, or of the invention of a machine, capable of accomplishing this object. And, unfortunately, the evidence shows that he was not. The patentee was at the time possessed of one machine, and one only, and this 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. If the first machine had been capable of working at different degrees of width, though clumsily and imperfectly, the latter machine would have been an improvement of it; but as the first, whether considered as existing actually or in theory, was wholly incapable of this, the latter machine does not in this respect furnish an improvement of anything previously existing, but an addition of some new matter not existing or known at the date of the first patent, and which, nevertheless, is therein represented as existing or known, and which cannot but be considered an important part of the representation then made, and of the consideration for the grant. If the first grant was void, the subsequent grants by the patent and by the statute must fall to the ground, as having nothing to support them. I think myself compelled therefore to yield to this objection. If, however, the law in this respect should not be in the opinion of my learned Brothers that which I own it has appeared to me to be, still there must be a new trial, because the question ought to have been left to the jury. I do not think it necessary to give any opinion on the point about the *alien*.

BOOTH *against* KENNARD, A.D. 1856–7. 1 H. & N. 527; 2 H. & N. 84.

Subject-matter of a Patent. Novelty of Invention. Claim too large.

CASE for the infringement of two patents, viz., of 12th *Nov.* 1850, No. 13,334, and of 8th *May*, 1852, No. 14,116, each to *G. R. Booth*, for 'improvements in the manufacture of gas.' Plea 8: That the alleged invention or inventions were not, nor was either of them, the subject of a patent. Issue.

The patent of 1850 related to the manufacture of gas from oil. The oil was projected directly upon the incandescent surface of a retort, and the soot which formed and impeded the conversion into gas was burnt out at intervals.

The patent of 1852 related to the manufacture of gas direct from seeds containing oil. One apparatus described was a perforated vessel for holding the material, the whole being enclosed in a retort heated by a furnace. *Claim:* 'The making gas direct from seeds and matters herein named, for practical illumination, instead of making it from oils, resins, or gums, which had been previously extracted from such substances.'

POLLOCK, C.B. directed the jury:—That the invention comprised in the patent of 1852 was not the subject-matter of a patent. Verdict for defendant on 8th issue, so far as it related to the patent of 1852.

Error on bill of exceptions to this direction. Judgment of *venire de novo* by the Court of Exchequer Chamber. (Cockburn, C.J., Coleridge, Wightman, Erle, Williams, and Crompton, JJ.)

Per COCKBURN, C.J.—We all think that the direction of the Lord Chief Baron was erroneous, and that there must be a *venire de novo*. The patent claims the making gas directly from seeds and other oleaginous substances, instead of making it from oils. By this means, the patentee gets rid of one of two processes. Previously to the date of the patent, gas had been obtained by a particular apparatus from oils, which were first separated from the substances containing them by pressure. The patentee has discovered that the first process may be dispensed with. That is a useful invention, and the patent is sustainable if the invention is new.

New trial of same action. Pleas: 1. Not guilty. 2. That plaintiff was not the true and first inventor. 3. That the invention was not new. 6. That the specification was insufficient. 8. As to patent of 1852, that the invention was not a new manufacture. Issue.

At the trial, defendant put in evidence the specification of a patent of 12th *Feb.* 1829, No. 5,771, to *E. Heard*, wherein the patentee claimed the distilling of gas from a variety of substances, and *inter*

alia, 'from beech-nuts, or mast, cocoa-nuts, and all others abounding in oil.' POLLOCK, C.B. directed a verdict for defendant on the issues as to novelty and sufficiency of the specification of the patent of 1852. Verdict accordingly. Leave reserved.

Rule nisi to set aside the verdict, and enter a verdict for the plaintiff, discharged by the Court of Exchequer.

Per POLLOCK, C.B.—We think that *Heard's* specification clearly shows that as a general fact (viz., making gas direct from seeds and other oily matters) the invention was not new, and it was decided in *Bush* v. *Fox* (5 H.L. Ca. 707) that where the want of novelty appeared distinctly from documents or written instruments, such as a prior patent or specification, it was for the Court to take notice of the identity of the two supposed inventions, and the want of novelty therefore in the second. That *Heard* had discovered and had communicated to the world that gas might be made direct from nuts and other oily and fatty substances, appears to us to be quite clear from his specification enrolled. We think that it was not necessary to submit this to the jury, and take their opinion on it. It is, we think, the plain meaning of the written document, and we think it is for the Court to construe it; and as this is part of the invention claimed by the plaintiff in his second patent, we think that the plaintiff's invention is so far not new, and therefore that the invention as a whole cannot be claimed as new.

We are also of opinion that the claim is too large, and cannot be supported. It is a claim to make gas direct from seeds—not in any mode pointed out in the specification, but generally. After the publication of *Heard's* specification, no patent could be taken out for the process generally, though a patent might be taken out for a particular method of doing it. We think the plaintiff's second patent was not for any particular method of doing it, but for the doing of it by any method; and we think that even if it had been new (which it turns out not to be), such a mode of specifying and claiming the invention cannot be sustained as a good specification.

BOULTON AND WATT *against* BULL, A.D. 1793–9. 2 H. Bl. 463; 3 Ves. 140; Dav. Pat. Ca. 162.

Sufficiency of Specification. Drawing or Model not essential. Subject-matter of a Patent. Practice in Patent Suits. Injunction.

Suit to restrain from infringing a patent of 5th *Jan.* 1769, No. 913, to *J. Watt*, for 'a new invented method of lessening the consumption of steam and fuel in fire-engines.' The term of the patent was extended by stat. 15 Geo. III. cap. 61, to a period of

twenty-five years. Injunction granted. Action at law in the Court of Common Pleas. Plea: Not guilty. Issue.

The patent related to the invention of a separate condenser for steam-engines, at that time called *fire-engines*. Previously, the practice had been to admit steam and cold water alternately into the cylinder of a steam-engine, and a great waste of fuel was the result. The invention of *Watt* consisted in condensing the steam in a separate vessel, and in keeping the cylinder as hot as the steam which entered it. The specification did not describe the actual construction of an engine, but stated:—'My method of lessening the consumption of steam, and consequently fuel, in fire-engines *consists in the following principles*. *First*. That vessel in which the powers of steam are to be employed to work the engine, which is called the cylinder in common fire-engines, and which I call the steam-vessel, must, during the whole time the engine is at work, be kept as hot as the steam that enters it. (1) By enclosing it in a case of wood or other materials that transmit heat slowly; (2) by surrounding it with steam or other heated bodies; (3) by suffering neither water nor any other substance colder than steam to enter or touch it during that time. *Secondly*. In those engines that are to be worked wholly or partially by condensation of steam, the steam is to be condensed in vessels distinct from the cylinders, though occasionally communicating with them. These vessels I call *condensers*, and whilst the engines are working they ought to be kept as cool as the air in the neighbourhood by the application of water or other cold bodies. *Thirdly*. Whatever air or other elastic vapour is not condensed by the cold of the condenser, and may impede the working of the engine, is to be drawn out of the steam-vessels or condensers by means of pumps wrought by the engines themselves or otherwise.' There was no drawing annexed to the specification, nor was there any separate claim.

At the trial, it appeared that the title of the Act of Parliament for extending *Watt's* patent, was 'An Act for vesting in *James Watt*, engineer, &c., the sole use and property of certain steam-engines, commonly called fire-engines, of his invention,' &c. The jury found that the specification was sufficient to enable a mechanic acquainted with fire-engines to construct an engine capable of producing the effect of lessening the consumption of fuel and steam upon the principle invented by *Watt*. Verdict for plaintiffs, subject to a case stated for the opinion of the Court of Common Pleas. The questions for the opinion of the Court were—(1) Whether the patent was good in law, and continued by the Act of Parliament above mentioned; (2) Whether the above specification of plaintiff, *James Watt*, was, in point of law, sufficient to support the patent.

The main objection was that the patent was for a principle. The Court was divided, and no judgment was given. Eyre, C.J. and Rooke, J. supported the patent, but Heath and Buller, JJ. were of opinion that there ought to be judgment for defendant.

Per ROOKE, J.—As to the objection of the want of a drawing or model, that at first struck me as of great weight. But I have satisfied my mind thus: infringement or not is a question for the jury; in order to decide this case they must understand the nature of the improvement or thing infringed. If they can understand it without a model I am not aware of any rule of law which requires a model or drawing to be set forth, or which makes void an intelligible specification of a mechanical improvement merely because no drawing or model is annexed.

Per BULLER, J.—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 new production from those elements, and not for the elements themselves. This brings us to the true foundation of all patents, which must be the manufacture itself, and so says the statute (21 Jac. I. cap. 3). Whether the manufacture be with or without principle, produced by accident or by art, is immaterial. In most of the instances of the different patents mentioned by my brother *Adair*, the patent was for the manufacture, and the specification rightly stated the method by which the manufacture was made; but none of them go the length of proving that a method of doing a thing, without the thing being done, or actually reduced into practice, is a good foundation for a patent.

Per EYRE, C.J.—It was admitted in the argument at the bar that the word '*manufacture*' in the statute (21 Jac. I. cap. 3) was of extensive signification, that it applied not only to things made, but to the practice of making, to principles carried into practice in a new manner, to new results of principles carried into practice. Let us pursue 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. 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.

An improper use of the word '*principle*' in the specification set forth in this case has, I think, served to puzzle it. Undoubtedly there can be no patent for a mere principle: but for a principle so far embodied and connected with corporeal substances as to be in a condition to act and to produce effects in any art, trade, mystery, or manual occupation, I think there may be a patent. The substance of the invention is a discovery that the condensing the steam out of the cylinder, and protecting the cylinder from the external air, and keeping it hot to the degree of steam heat, will lessen the consumption of steam. This is no abstract principle, it is in its very statement clothed with practical application; it points out what is to be done in order to lessen the consumption of steam. It can hardly be supposed that a workman capable of constructing a fire-engine would not be capable of making such additions to it as should be necessary to enable him to execute that which the specification requires him to do. This difficulty is put an end to, because the jury have found that a workman can execute the improvement in consequence of the specification. Some machinery, it is true, must be employed, but the machinery is not of the essence of the invention, but incidental to it.

Supposing the difficulty upon the patent itself and the specification to be got over, the Act of Parliament remains to be considered. The objection, stated in the strongest manner, would amount to this, that the Act continues a patent for a machine when, in fact, the patent is for a process. The specification calls a method of lessening the consumption of steam in fire-engines a *principle*, which it is not; the Act calls it an *engine*, which perhaps also it is not; but both the specification and statute are referable to the same thing, and when they are taken with their correlative are perfectly intelligible. I am therefore of opinion that the Act has continued this patent.

Upon motion, LORD LOUGHBOROUGH, L.C. directed another action at law, and refused to dissolve the injunction, or to impose any terms in bringing the action, saying:—'I cannot put the patentees upon the acceptance of terms that, upon collateral reasons, they think may be disadvantageous to the exercise of the right *of which they are in full possession*; neither can I put them out of possession upon the difference of opinion of the Court. It is of notoriety that this fire-engine has been erected in many parts of the country with great advantage.'

For the second action, see *Hornblower* v. *Boulton* (8 T.R. 95).

BOVILL *against* MOORE, A.D. 1815–6. 2 Coop. Ch. Ca. 56; Dav. Pat. Ca. 361; 2 Marsh. R. 211.

Inspection of Machinery. Sufficiency of Specification. Obligation in Specifying. An Improvement must be distinguished. A Patent for a new combination of old parts is valid.

Suit to restrain from infringing a patent of 24th *April*, 1811, No. 3,434, to *J. Brown*, for 'a machine for the manufacture of bobbin lace or twist net.' Order for a trial at law and an inspection.

Per LORD ELDON, L.C.—There is no use in this Court directing an action to be brought, if it does not possess the power to have the action properly tried. The manufactory of the defendant is carried on in secret. The evidence of the piracy at present, is the bobbin lace made by the defendant. The witnesses say that this lace must have been manufactured by the plaintiff's machine, or by a machine similar to it in principle. This is obviously, in a great measure, conjecture. No Court can be content with evidence of this description. There must be an order that plaintiff's witnesses shall be permitted, before the trial of the action, to inspect the defendant's machine and to see it at work.

Action at law in pursuance of the order of the Court. Plea: Not guilty. Issue.

The patent related to a method of interlacing and twisting the longitudinal or warp threads and the diagonal or bobbin threads in lace weaving. The specification stated:—'My invention consists, as represented by the drawings hereto annexed, and as hereinafter described.' Then followed a description of the entire machine. There was no separate claim.

At the trial, it appeared that up to the point at which the bobbin in *Brown's* machines travelled round a longitudinal thread to form the twist, the operation was the same as that in previous machines, but beyond that point it was different. It was therefore contended that the patent should have been for an improvement only, and not for the entire machine. It further appeared that a contrivance used in the patented machine for preventing entanglement of the threads had not been described in the specification.

GIBBS, C.J. directed the jury:—In point of law, it is necessary that the plaintiff should prove that this is a new and useful invention, in order to entitle himself to the present action,—that, I think, he has satisfactorily done. The next question is, whether the specification would enable a workman of common skill to make the machine. Upon the evidence adduced to you, I think there is no doubt it would.

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. If Mr. *Brown*, since he obtained his patent, has discovered an improvement, he may apply that improvement, and his patent will not be affected by his using his own machine in that improved state; but if at the time when he obtained his patent he was apprised of this more beneficial mode of working, and did not by his specification communicate this more beneficial mode of working to the public, that will have been a fraudulent concealment from the public, and that will render his patent void. If you think that he has invented an engine which consists of a perfectly new conformation of parts, though all the parts were used before, yet he will be entitled to support his patent for a new machine. If a combination of a certain number of parts existed up to a given point before, and Mr. *Brown's* invention sprung from that point, and added other combinations to it, then I think his specification, stating the whole machine as his invention, is bad. You will say, first, whether you think there is any fraudulent concealment in the specification, and next, if there was not, whether you think he has, in his specification, described an invention to a greater extent than the proof goes to establish. If he inadvertently did not state the whole in his specification, he must answer for his inadvertence; but it might be a subsequent discovery.

The jury found, that the combination of the parts up to the crossing of the threads was not new. Verdict for defendant.

Rule for a new trial refused by the Court of Common Pleas. (Gibbs, C.J., Dallas, Park, JJ.)

Per DALLAS, J.—As to the law, it is quite clear that if the invention set up be an addition, the patent must be for that addition only, as in the case of the invention of a particular movement of a watch.

Per PARK, J.—The law was most fully and most correctly laid down to the jury by his Lordship. Nor is this new doctrine; for in *Rex* v. *Else* (Bull. N.P. 76) Mr. Justice Buller held that the patent must not be more extensive than the invention, and therefore that, if the invention consisted of an addition or improvement only, a patent for the whole machine was void.

BOVILL *against* PIMM and RANDS, A.D. 1856. 11 EX. R. 718.

Novelty of Invention. Construction of Specification. Evidence of Infringement.

CASE for the infringement of a patent of 18th *Aug.* 1846, No. 11,342, to *G. H. Bovill*, for 'improvements in manufacturing wheat and other grain into meal and flour.' Pleas: 2. That plaintiff was not the true and first inventor. 3. That the invention was not a new manufacture. 4. That the specification was insufficient. 5. Not guilty. Issue.

The patent related to the use of a blast of air thrown between millstones in grinding flour. In the old system of grinding wheat between millstones, a large quantity of the finest flour was produced on first crushing the grain; but this flour did not at once pass away, and was, in fact, continually reground with the unreduced particles before it was discharged at the edge of the running stone. It followed not only that the flour was overground, but also that it became heated to such an extent that its quality was deteriorated. The patentee closed the eye of the running stone, and sent a blast of air, under pressure, into the cavity at the centre of the stones; this blast passed through the space between the stones and carried away all the finest particles of meal as soon as they were formed. Thus the stones performed their legitimate function of grinding only the unreduced particles, the grist being discharged in a cool state and ready for immediate dressing. The specification showed the method of closing the eye of the running stone by a plate of iron or leather, and of introducing a blast of air into the central cavity.

Another mode of carrying out the invention was also described, which consisted in the application of a set of ventilating screw vanes, placed in an air chest at the centre of the running stone, and sucking down a current of air for sustaining a similar blast. The wheat, as well as a quantity of air, passed through the ventilating screw, which virtually replaced the separate plate and blower used in the primary combination. If preferred, the ventilator might be placed in the bed stone.

Claims: 1. Closing the eye of the running stone, and combining therewith a blast of air, above the pressure of the atmosphere, at or near the centres of millstones, so that the pressure of the air is sustained to carry out the meal from between the grinding surfaces, as produced.

2. The application of ventilating screws or vanes for blowing and sustaining the necessary blast of air between the grinding surfaces of millstones, as herein described.

At the trial, defendants put in evidence the specification of a patent of 30th *April*, 1844, No. 10,165, to *R. Gordon*, for a like invention. Here a blast of air was set up by a revolving fan, and the current was discharged at the eye of the bed-stone. The eye, however, was not closed. The alleged infringement consisted in the use of an apparatus constructed according to a patent of 19th *Dec.* 1851, No. 13,867, to *C. Rands*, who left a circular chamber in the centre of the stones, and placed therein a revolving fan with radial arms, which forced a blast of air from the centre outwards.

POLLOCK, C.B. directed a verdict for plaintiff on all issues except the 5th; on that for defendants. Leave reserved.

Rule nisi to enter a verdict for plaintiff on the 5th issue discharged by the Court of Exchequer; and rule for a new trial, on the ground that the verdict was against the evidence, suspended till the result of an appeal (if any) was known.

Per POLLOCK, C.B.—After this patent of *Gordon's* no one could claim exclusively the use of a fan or the introduction of a current of air (above the pressure of the atmosphere) at the eye of a millstone by means of such a fan. The next patent is that of the plaintiff; and an attempt was made to show that the first part had been infringed. It was argued by the plaintiff's counsel that the first part of the plaintiff's invention was performed by the second, and that the ventilating screw, by driving the air in one direction, viz., inwards, and thereby preventing it from escaping, was, in fact, 'a closing of the eye.' We think it is really an abuse of language to call what is done in the second part of the invention a 'closing of the eye,' because the air is compelled to go in one direction only; but the claim to close the eye in the plaintiff's specification must be understood to mean closing it *actually*, physically, and in the manner shown in the drawing; and if it be said that the first claim does not refer to the drawing, and may therefore include closing the eye (if in any sense that can be called closing), the answer is that *Gordon* has done that before; his current of air as much closed the eye as *Bovill's*, and the patent would therefore be void for claiming an invention already published by another.

The question then remains, is the invention of the defendant *Rands* within the second part of the patent and specification of the plaintiff? and we are of opinion that it is not. It appears to us that, where a subject is not new, as this certainly was not, viz., 'the cooling of substances undergoing the process of grinding,' any patent taken out for a method of performing the operation is substantially confined to that method, and cannot be extended to other methods obviously different, because they involve some common principle applied to the common object, and may apparently be described by the same general phrase. *Bovill's* invention can be described, no doubt, in terms so vague and general as to include *Rands's* method, but then, also, it would include *Gordon's*, whose patent was taken out some years before. We think that the patents, as they appear before us, are respectively independent original improvements.

We think the claim of invention in the action must be considered as the claim which the plaintiff is legally entitled to make; and then the question between the parties arises on the plea of not guilty,

which also raises the question as to the extent of the Queen's grant to the plaintiff, and to what extent that goes and how much it embraces; in other words, what is the true meaning and construction of the specification? We think this is a question of law where the facts are not disputed. If the verdict be entered for the plaintiff by the Court of Appeal, then the rule for a new trial will be made absolute, but in the meantime it must stand over.

BOVILL *against* KEYWORTH and SEELY, A.D. 1857. 7 E. & B. 725.

Subject-matter of a Patent. Sufficiency of Specification. Evidence of Infringement.

CASE for the infringement of a patent (in part disclaimed) of 5th *June*, 1849, No. 12,636, to *G. H. Bovill*, for 'improvements in manufacturing wheat and other grain into flour.' Pleas: 1. Not guilty. 4. That the invention was not a new manufacture. 6. That the specification was insufficient. Issue.

The patent related to an improvement of great value to millers which consisted in the combination of a blast of air between the millstones used in grinding corn, with an exhausting apparatus attached to the chamber in which the stones were enclosed. The exhaust-pipe carried away the dust or stive into a separate chamber, where the same was deposited, and the finely-ground flour fell into its proper receptacle. The top stone was fixed, and the lower one rotated. The specification stated:—'I introduce a pipe to the millstone case from a fan or other exhausting machine, so as to carry off all the warm dusty air blown through between the stones to a chamber. And this part of my invention relates only to sucking away the *plenum* of dusty air forced through the stones, and not to employing a sufficient exhausting power to induce a current of air between the millstones, without the blast, this having been before practised.'

Claims: (as amended by disclaimer) 1. Fixing the top stone, and causing currents of air either by exhaustion or pressure to pass between the grinding surfaces of millstones when the top stone is so fixed, and the introduction of the ventilating pipes in the stones, as herein described.

2. Exhausting the dusty air, when the same has been blown through the grinding surfaces of the millstones, from the cases or chambers receiving the meal as herein described.

At the trial, it appeared that the alleged infringement consisted in the use of apparatus similar to that specified, except that the *lower stone* was *fixed*, and the upper one rotated. Defendants gave in evidence the specification of a patent of 11th *Feb.* 1846, No.

11,084, to *A. V. Newton*, for drawing a current of air between the stones by an exhausting apparatus. Verdict for plaintiff.

Rule nisi to enter a verdict for defendants or for a new trial discharged by the Court of Queen's Bench. (Lord Campbell, C.J., Coleridge, Wightman, Erle, JJ.)

Per LORD CAMPBELL, C.J.—The whole of the plaintiff's process, if the combination be new, is certainly the subject of a patent; and so would the part (No. 2) be, if taken separately. The combination of the *exhaust* with the blast so as to carry off the warm dusty air blown through between the stones to a chamber above, while the pure flour, in a dry condition, without the stive, descended into a chamber below, added to the quantity and improved the quality of the flour produced in grinding.

Still, if the specification does not point out the mode by which this part of the process is to be conducted, so as to accomplish the object in view, it would be the statement of a principle only, and the patent would be invalid. But we are of opinion that the specification cannot be pronounced, in point of law, to be bad in this respect, and that the evidence adduced at the trial shows it to be quite sufficient. The specification says:—'And this part of my invention relates only to sucking away the *plenum* of dusty air forced through the stones, and not to employing a sufficient exhausting power to induce a current of air between the millstones without a blast.' The exhaust is to be proportioned to the *plenum* caused by the blast, care being taken not to introduce the inconvenient current of air, against which a caution is given. How can a judge take upon himself to say that this may not be enough to enable a workman of competent skill to construct the machinery? According to the evidence, the specification was abundantly sufficient for this purpose.

The defendants contend that the patent was granted for one process comprising several successive and connected parts, the use of fixed upper millstones being one of them. We do not think it necessary to give any positive opinion upon this question, for, supposing the patent to be for a combination, consisting of several parts for one process, we are of opinion that the defendants are liable in this action for having used a material part of the process which was new for the same purpose as that mentioned in the specification, although they did not at the same time use all the parts of the process specified.

The defendants admit that they used the part of the process (No. 2) as described in the specification; and they rest their defence on the fact that they did so only in a mill with a rotating upper millstone. We are of opinion that they cannot lawfully use No. 2 for the same purpose by substituting a rotating upper millstone for

a fixed upper millstone, or by resorting to any other equivalent for any other separate part of the process specified. This case seems to us to be governed by *Lister* v. *Leather* (8 E. & B. 1,004), and therefore that there ought to be judgment for the plaintiff.

BOVILL *against* HADLEY, A.D. 1864. 17 C.B. N.S. 435.

Practice as to Certificate for Costs.

CASE for the infringement of the same patent (extended for five years). At the trial a compromise was made upon terms that there should be a verdict for 40s., and costs, *with all usual certificates.* The certificate of the judge, under stat. 15 & 16 Vict. cap. 83, sect. 43, given in a former trial of *Bovill* v. *Keyworth*, was then handed in to Erle, C.J., who endorsed on the record a certificate whereby plaintiff became entitled to full costs.

Rule nisi to deprive plaintiff of full costs made absolute by the Court of Common Pleas. (Erle, C.J., Williams, Willes, Byles, JJ.)

Per WILLES, J.—The compromise put an end to the case. The plaintiff could not have full costs under stat. 15 & 16 Vict. cap. 83, sect. 43, without putting the record and the certificate in the former action in evidence.

BOVILL *against* GOODIER, A.D. 1865–7. L.R. 1 Eq. 35; L.R. 2 Eq. 195; 36 L.J. Ch. 360.

Practice in Patent Suits. Issues. Novelty of Invention. Prior Publication. Amendment of Particulars of Objection.

Suit to restrain from infringing the same patent (extended for five years). The answer raised the questions of novelty, prior user, sufficiency of specification, and infringement; but the Court refused to direct issues. Replication filed, when plaintiff applied for particulars of objections to be relied on at the hearing. ROMILLY, M.R. refused the application, and said that this decision must not be taken to apply to cases where issues had been granted; in such cases he had himself ordered particulars of objections to be furnished.

Hearing of the suit. It appeared that after plaintiff had recovered judgment against *Keyworth*, in the previous action, he proceeded against other infringers, all of whom submitted. In 1863 the patent was extended for five years.

Defendant now sought to prove the invalidity of the patent by reason of the expiration in 1860 of a certain *French* patent; but the Court refused to entertain the objection on the ground that it had not been raised by the pleadings. It appeared that three *French* patents, alleged to have anticipated the invention, had been described in a book deposited in the library of the *British Museum* and sold by a bookseller in *London* before the date of the patent.

Injunction granted, and issue at law directed as to novelty only; defendant to deliver, within seven days, particulars of objections to be relied on at the trial of the issue.

Per LORD ROMILLY, M.R.—The history of the plaintiff's invention is an instance of the troubles which, in the present state of the law, await a successful inventor. The patent in question was taken out by the plaintiff in *June*, 1849. Since then he has been engaged in constant and expensive litigation up to 1863, when the patent was prolonged by the Privy Council for five years. This, however, has not produced any termination to the litigation, of which the present suit is an instance. Much of this is incidental to the nature of things. The claim of having made an invention is not to preclude others from using an old process and old machines; nor ought the fact that one person who has infringed the patent was ignorant of the want of novelty, to preclude another person from showing that the invention had before been known and been in use. The consequence is that, in almost every instance, the patentee has to establish his case from the beginning against any fresh person who chooses to impugn the patent and to contest its validity.

His Lordship here stated his opinion that the *French* patents differed essentially from that of the plaintiff, and expressed his concurrence with the judgment in *Bovill* v. *Keyworth* (7 E. & B. 725). He then proceeded:—I am of opinion that I cannot properly compel the defendant to submit to the decision of the Court of Queen's Bench, or to acquiesce in any opinion I may have formed. He was no party to the suit of *Bovill* v. *Keyworth*, he is not bound by the proceedings in that case, and many cases are on record where, after the plaintiff has established the validity of the patent in one case, it has been decided to be invalid in a second. I think myself bound by the authorities to direct an issue to try whether the plaintiff is the first and true inventor of the processes described in his specification. I direct no issue as to the utility of the invention, or as to the sufficiency of the specification.

Trial of the issue of novelty in the Common Pleas. New trial of the same issue, directed by the Master of the Rolls. Defendant now applied for leave to deliver further particulars of prior user and publication of the alleged invention. Order made by LORD ROMILLY, M.R., who said:—'The object was that the real facts should be put in issue, and no technical difficulties should be allowed to obstruct this. If any new facts were discovered they might be brought forward, but not by surprise, and on giving proper notice to the other side. The defendant must deliver new particulars within a fortnight. Costs to be costs in the cause.'

BOVILL *against* CRATE, A.D. 1865. L.R. 1 Eq. 388.

Practice where there are several Infringers. Laches.

Suit to restrain from infringing the same patent (extended for five years). It appeared that plaintiff was aware of the infringement in *August*, 1864, but did not file a bill until *July*, 1865. Also that eighty-nine persons had combined together for the purpose of infringing plaintiff's patent. Injunction refused on the ground of delay. Account ordered. The costs to be costs in the cause.

Per WOOD, V.C.—I do not think the plaintiff is put in so great a difficulty as he alleges with reference to filing bills. He might take this course:—After getting information of case after case of infringement, he might select that which he thought the best in order to try the question fairly, and proceed in that case to obtain his interlocutory injunction. He might write at the same time to all the others who were *in simili casu*, and say to them: 'Are you willing to take this as a notice to you that the present case is to determine yours? Otherwise, I shall proceed against you by way of interlocutory injunction; and if you do not object on the ground of delay, I do not mean to file bills against all of you at once. Am I to understand that you make no objection of that kind? If you do not object, I shall file a bill against only one of you.' I do not think any Court could complain of a patentee for taking the course I am suggesting.

BOVILL *against* SMITH, A.D. 1866. L.R. 2 Eq. 459.

Practice in Patent Suits. Discovery.

Suit to restrain from infringing the same patent (extended for five years). The bill stated a variety of proceedings, both at law and in equity, in which plaintiff had obtained perpetual injunctions and recovered damages against infringers, and charged that the defences as to prior user and failure of novelty relied on by defendant were identical with some of those already disproved, as would appear if discovery were made. Accordingly, plaintiff interrogated defendant as follows:—1. Who does defendant allege to have been the true and first inventor? 2. When, where, and in what manner does defendant allege that plaintiff's invention, or any part thereof, was publicly used before the date of the patent? Defendant declined to answer fully, and plaintiff excepted. WOOD, V.C. over-ruled the exceptions, and said that the plaintiff was not entitled to inquire generally into the way in which the defendant shaped his case, though he might have asked if his process was the same as that used by A. B., or any one person specifically named, who had been a defendant in some former suit.

BOVILL *against* HITCHCOCK, A.D. 1868. L.R. 3 Ch. 417.

Practice as to Trial by Jury in Patent Suits.

Suit to restrain from infringing the same patent (extended for five years). Application, that certain questions of fact might be tried by the Court with a special jury, refused by ROMILLY, M.R. On appeal to the Lords Justices, decision affirmed.

Per LORD CAIRNS, L.J.—If the Court thinks it best that a question should be tried before a jury, a jury can be had; but if, in the opinion of the Court, a trial without a jury is preferable, neither party can claim a jury as a matter of right.

BOVILL and ANOTHER *against* FINCH, A.D. 1870. L.R. 5 C.P. 523.

Divisibility of grant of Patent after Prolongation.

CASE for the infringement of the same patent (prolonged for five years). The declaration stated the grant of the patent for *England* in *June*, 1849, the prolongation of the term, and the filing of a disclaimer. Pleas: 14. As to the infringement after prolongation, averring the grant and expiration of separate patents for *England*, *Scotland*, and *Ireland*, the prolongation by new letters patent, and that the letters patent for Scotland were and always had been void by reason of prior public user in *Scotland*.* 15. A similar plea alleging that the Scotch patent was void on account of prior user in *England*. Demurrer, and joinder. Judgment for plaintiffs by the Court of Common Pleas. (Keating, Montague Smith, Brett, JJ.)

Per MONTAGUE SMITH, J.—It must be taken, for the purpose of the demurrer, that the original *Scotch* patent is bad for want of novelty, and the question is, whether the grant is divisible, and may be sustained so far as it extends the term of the *English* patent. It has no doubt been decided that letters patent are wholly void where part of the invention claimed is not new, on the principle stated by Parke, B. in *Morgan* v. *Seaward* (2 M. & W. 544), viz., that 'the consideration for the grant is the novelty of all; and the consideration failing, or in other words, the Crown being deceived in its grant, the patent is void.' See also *Hill* v. *Thompson* (2 Taunt. 375), *Brunton* v. *Hawkes* (4 B. & Ald. 541). The distinction between these decisions and the present case is, that in them the want of novelty in a part of the invention affected the grants throughout their whole territorial limit; whereas in the present case it only affects the grant so far as *Scotland* is concerned. We do not, how-

* By the operation of stats. 15 & 16 Vict. cap. 83, and 16 & 17 Vict. cap. 115, sect. 7, the new letters patent were sealed with the Great Seal of the United Kingdom, and had effect throughout *Scotland* and *Ireland*.

ever, deem it necessary to decide what would be the effect of the want of novelty in one kingdom in the case of an original grant for the three kingdoms under one seal, because we think this grant of an extended term in the three original patents is divisible. We think, notwithstanding that the new letters patent are in one instrument, they ought to be regarded as granting three separate prolongations of three distinct patents; and that as a consequence, although the prolongation may be invalid as to the *Scotch* grant, by reason of the want of novelty in *Scotland* at the time of the original letters patent, it may be good as to the *English* grant; or, in other words, that the grant for each country may stand or fall by itself.

There being nothing to show any want of novelty, or other failure of consideration for the prolongation of the term of the *English* patent, or that the Crown was deceived in any way as to that patent, we think the judgment on this demurrer should be for the plaintiffs.

BOWMAN *against* TAYLOR and OTHERS, A.D. 1834. 2 Ad. & E. 278; 1 Webs. Pat. Ca. 292.

Estoppel of licensee.

COVENANT. The declaration, after setting out so much of the recitals in the deed as stated that plaintiff had invented certain improvements in looms, and had obtained letters patent for the same, stated that plaintiff had agreed with defendants to let them use the said invention on certain terms. Pleas: 1. Setting out the patent, and averring that the invention was not new. 2. That plaintiff was not the true and first inventor. 3. That no sufficient specification was enrolled, whereby the patent became, and was at the time of making the indenture, void and determined. Demurrer, and joinder. Judgment for plaintiff by the Court of King's Bench. (Lord Denman, C.J., Taunton, Patteson, Williams, JJ.)

Per LORD DENMAN, C.J.—The plaintiff contends that these pleas are bad because the defendants are estopped by their deed from pleading them. It is answered, as to the first plea, that it is not inconsistent with the deed; but we think it is so, and if not, that it is no defence. So, as to the second plea, the answer is the same as that just given. The third plea puts a fact in issue in direct contradiction to the recital of the deed.

BRIDSON *against* MCALPINE, A.D. 1845. 8 Beav. 229.

Practice in Patent Suits. Injunction.

Suit to restrain from infringing a patent of 26th *May*, 1838, No. 7,653. Action at law. Verdict for plaintiff, and tender of bill

of exceptions. Motion for injunction ordered to stand over until bill of exceptions disposed of. Account in the meantime.

Per LORD LANGDALE, M.R.—There are many cases in which it is not clear either that the patent is legally valid or that it has been infringed. It depends on the degree of doubt which exists on these questions whether the Court will grant the *interim* injunction. In such cases it will cautiously consider the degree of convenience and inconvenience to the parties by granting or not granting the injunction. According to the doubt which may exist in the mind of the Court upon the facts, and according to the degree of inconvenience to the parties, the Court, not thinking fit to grant the injunction at the time, may take one of several courses: it may either refuse to grant the injunction simply, or it may refuse it on the terms of the party undertaking to keep an account, or it may direct the motion to stand over, on the terms of the plaintiff proceeding to a trial at law. When it has been determined that the plaintiff must first establish his right at law, the Court does not generally interfere with the mode of trying the legal question, though in some instances it may require the parties to make the necessary admissions of fact in order to facilitate the trial. I must, however, qualify this by saying that in cases of overwhelming mischief the Court has authority to interfere at any time.

BRIDSON *against* BENECKE, A.D. 1849. 12 Beav. 1.

Practice in Patent Suits. Injunction refused for delay.

Injunction to restrain from infringing the same patent, refused on the ground of delay. It appeared that plaintiff discovered the alleged infringement in *Jan.* 1848, but did not file a bill until 30th *Dec.* 1848.

Per LORD LANGDALE, M.R.—I think that a party coming for the assistance of this Court to protect a legal right, not absolutely established against the party who is alleged to have infringed it, ought to come at an early period. The rule of this Court is very strict, that you must apply in proper time.

BROOK *against* ASTON, A.D. 1857. 8 E. & B. 478; 28 L.J. Q.B. 175.

Subject-matter of a Patent. New use of an old Machine.

CASE for the infringement of a patent of 23rd *Feb.* 1856, No. 473, to *C. Brook* and *J. Hirst*, for 'improvements in finishing yarns of wool or hair, and in the finishing of woven fabrics.' Pleas: 3. That the invention was not new. 4. That it was not the working or making of any manufacture for which letters patent could by law be granted. Issue.

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. *Claim*: 1. '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.'

At the trial, defendant put in evidence the specification of a patent (in part disclaimed) of 25th *Nov.* 1853, No. 2,745, to *W. L. Brook* and *C. Brook*, for certain improvements in finishing cotton and linen yarns, and in the machinery connected therewith. The 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 sizeing, as in common use, and thence to the finishing end of the machine.' LORD CAMPBELL, C.J. left the case to the jury. Verdict for plaintiff. Leave reserved.

Rule nisi to enter a nonsuit, on the ground that the invention was not new, and was not the subject of a patent, made absolute by the Court of Queen's Bench. (Lord Campbell, C.J., Coleridge, Wightman, JJ.)

Per LORD CAMPBELL, C.J.—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. 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.

Per COLERIDGE, J.—I am of the same opinion. It is admitted that the mere application of old machinery is not the subject of a

patent. Reading the plaintiff's claim, and then reading the former specification, we find the processes the same in principle and detail. The threads are kept separate, and are operated on in the same way; the only difference being that one is applied to cotton and linen only, and the other to wool and hair.

(28 L.J. Q.B. 175.) Error brought in the Court of Exchequer Chamber. (Cockburn, C.J., Williams, Crowder, Willes, JJ., Martin, Bramwell, Watson, Channell, BB.) Judgment affirmed.

Per COCKBURN, C.J.—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 sizeing 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 on 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.

Per MARTIN, B.—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* (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.

Per BRAMWELL, B.—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.

BRUNTON *against* HAWKES, A.D. 1820–1. 4 B. & Ald. 541.

Failure of Novelty in part of an Invention renders a Patent void.

CASE for the infringement of a patent of 26th *March*, 1813, No. 3,671, to *T. Brunton*, for 'improvements in the manufacture of ships' anchors, windlasses and chain cables.' Plea: Not guilty. Issue.

The patent related to three separate improvements.

1. *Ships' anchors.*—Heretofore each arm of an anchor had been separately welded to the shank. The specification described a different manufacture. The two arms were formed in one piece, having a conical opening in the centre, through which the shank

was passed, the coned end of the shank being welded to the arm-piece. The patentee relied, for strength, on the impossibility of drawing a thick conical piece of iron through the smaller aperture of a conical opening into which it was fitted.

2. *Chain cables.*—Here each link was oval, and was stayed across the centre by a pin, the ends of which spread out so as not to pierce and weaken the link.

3. *Windlasses.*—This improvement was unimportant.

At the trial, it appeared that the plaintiff's method of constructing anchors had been applied before the date of the patent to the construction of *adze* or *mushroom* anchors used in mooring stationary light-vessels, but was new as applied to the anchors of ships.

The alleged infringement related to the improvement in chain cables, which was of great value. ABBOTT, C.J. left it to the jury to say whether the inventions both as to the chain and anchor were new and useful, and the jury found in the affirmative. Verdict for plaintiff.

Rule nisi for a new trial, on the ground that the patent was void for want of novelty in one head of invention, made absolute by the Court of Queen's Bench. (Abbott, C.J., Bayley, Best, JJ.)

Per ABBOTT, C.J.—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 precisely the mode by which the shank of the mushroom anchor is united to the top. 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 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, where 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 which affects the anchor; and, if the patent had been taken out for that alone, I should have had no hesitation in declaring that it was bad. It is quite clear that a patent granted by the Crown cannot extend beyond the consideration of the patent. The consideration is the entirety of the improvement of the three

things; and, if it turns out that there is no novelty in one of the improvements, the consideration fails in the whole, and the patentee is not entitled to the benefit of that other part of his invention.

Per BEST, J.—The consideration to induce the King to grant the patent, was the statement made by the plaintiff in his petition, that there had been three inventions, when, in fact, there had been only two. The united consideration on which the whole grant was made is therefore void; and, consequently, the grant itself is void. I am therefore of opinion that there ought to be a new trial.

BUSH *against* FOX and OTHERS, A.D. 1852. 9 Ex. R. 651; Macrory's Pat. Ca. 152; 5 H.L. Ca. 707.

Novelty of Invention. Publication by prior Patent.

CASE for the infringement of a patent of 21st *Sept.* 1841, No. 9,094, to *W. Bush*, for 'improvements in the means of, and apparatus used for, building and working under water.' Plea 3. That the invention was not a new manufacture. Issue.

The patent related to the use of a hollow cylinder or caisson, divided horizontally into compartments, and employed for constructing foundations under water. The lowest chamber formed a diving-bell, from which water was excluded by air under pressure, and there were trunks or passages, provided with valves, for the purpose of affording access to the lowest chamber without much loss of compressed air. The specification described the caisson, with its air-pumps and valves, by reference to drawings, and explained the manner in which the materials excavated were raised from one compartment to another, as well as the filling up of the shell with concrete when sunk to a sufficient depth. *Claim*: 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.'

At the trial, it appeared that the alleged infringement consisted in the use of hollow cylinders or piles, acting on the principle of excluding water by compressed air, and forming, when sunk and filled with brickwork and concrete, the foundations for the piers of *Rochester* Bridge. Each cylinder was closed by a cover at the top and was built up in lengths, so that one end rested on the bed of the river, and the other end remained above the surface of the water. This construction made it, in effect, a species of elongated diving-bell into which air was forced by pumps, so as entirely to exclude the water. Two small chambers, provided with valves, and called air-locks, were attached to the cylinder cover, whereof one was for the

passage of the workmen and the other for the raising of the materials excavated.

Defendants put in evidence the specification of a patent of 20th *Oct.* 1830, No. 6,018, to Lord *Cochrane* for a similar invention, consisting of a cylinder filled with compressed air and provided with an ante-chamber and valves for the entrance and exit of the workmen. The specification stated:—'My invention consists in an apparatus for compressing air into, and retaining the air so compressed within, the interior capacity of subterranean excavations, sinkings, or mines, in order that the additional elasticity given to the included air may counteract, in part or wholly, the tendency of superincumbent water, or of such superincumbent earth as is rendered semi-fluid by admixture with water, to flow by gravitation into such excavations. And which apparatus, at the same time that it is adapted to retain the said included air in a state of compression in order to prevent or diminish the *influx of water* or of *semi-fluid earth*, is also adapted to allow workmen to carry on their ordinary operations of excavating, sinking, and mining, and to allow a ready passage to and fro from the said space.'

Plaintiff was called, and admitted that what defendants had done at *Rochester* Bridge was the same as Lord *Cochrane's* invention, except that Lord *Cochrane's* worked on land, and defendants' worked in water. POLLOCK, C.B. said:—'If that is the only difference, I am of opinion that the cause is at an end.' Another witness having given evidence to the same effect, the learned judge directed the jury:—'I think a man cannot, if he has applied 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 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. Both the plaintiff and the other witness emphatically say that the invention consists in the application, and not in the novelty of the thing itself; in other words, that the only novelty is in the application of the apparatus. I think that a patent cannot be taken out for such an application.' Verdict for defendants on third issue; the jury discharged as to the other issues.

Error on bill of exceptions to the above direction.

In the course of the argument, MAULE, J. said:—'Assuming that the machine itself is old, the learned judge held that the mere new application is not a new manufacture, and therefore not the subject of a patent, and my present opinion is, that on the evidence he was right in so directing the jury.'

Judgment affirmed by the Court of Exchequer Chamber. (Coleridge, Maule, Cresswell, Erle, Williams, Crompton, JJ.)

On appeal to the House of Lords, the judges were summoned, when Alderson, Martin, Bramwell, BB., Coleridge, Wightman, Erle, Cresswell, Williams, Crompton, and Crowder, JJ. attended. The question proposed for the learned judges was, whether, looking at the record, the direction given by the Lord Chief Baron was right in point of law. Answered in the affirmative, the judges being all of one opinion. Judgment for defendants in error, with costs.

Per LORD CRANWORTH, L.C.—From the time that I understood what the facts of this case were, I really have entertained no doubt whatever upon the question whether or not the direction of the Lord Chief Baron was right. I am not, indeed, clear that the Lord Chief Baron might not have gone much further, and that, even if there had not been any evidence at all, he might not have directed the jury to find for the defendants; because, I think, it was for the Court to compare the two specifications together, and, comparing the two together, it appears to me perfectly clear that the material part of the plaintiff's invention was involved in the invention of Lord *Cochrane.*

The evidence of the plaintiff himself and a witness having been given, the Lord Chief Baron said, that if the jury believed that evidence, the invention was not an invention of any manner of new manufacture; it was not new at least in the material part of it, the mode of putting up the caisson so as to supply the workmen with air. My Lords, I entirely concur in the opinion which the learned judges have, without any hesitation, given to your Lordships, that that direction was perfectly right, and, consequently, that there is no foundation for this proceeding in error.

CALDWELL *against* VANVLISSENGEN AND OTHERS, A.D. 1851. 9 Hare 415.

Practice in Patent Suits. Aliens restrained from Infringing an English Patent in England.

Motion for injunction to restrain defendants, who were subjects of the King of *Holland*, from using on board their ships, within the dominions of *England*, a screw propeller made according to an *English* patent assigned to plaintiff. Injunction granted.

Per TURNER, V.C.—It is part of the duty of this Court to protect property pending litigation; but when it is called upon to exercise that duty, the Court requires some proof of title in the party who calls for its interference. In the case of a new patent, this proof is wanting: the public, whose interests are affected by the patent, have had no opportunity of contesting the validity of the patentee's title, and the Court therefore refuses to interfere until his right has been established at law. But in a case where there has been long enjoy-

ment under the patent (the enjoyment, of course, including use), the public have had the opportunity of contesting the patent; and the fact of their not having done so affords, at least *primâ facie*, evidence that the title of the patentee is good; and the Court therefore interferes before the right is established at law.

I take the rule to be universal, that foreigners are in all cases subject to the laws of the country in which they may happen to be. It is to be considered, then, what are the laws of this country with reference to the rights of patentees. According to our laws and constitution, the Crown, I apprehend, has at all times exercised a control over the trade of the country. The statute of James did not create, but controlled, the power of the Crown in the granting of patents. Patentees therefore have always derived and still derive their rights, not from the statute, but from the grant of the Crown. And, undoubtedly, this grant gives to the grantee a right of action against persons who infringe upon the sole and exclusive right purported to be granted by it. Foreigners coming into this country are, as I apprehend, subject to actions for injuries done by them, whilst here, to the subjects of the Crown. Why then are they not to be subject to actions for the injury done by their infringing upon the sole and exclusive right which I have shown to be granted in conformity with the laws and constitution of this country? And if they are subject to such actions, why is not the power of this Court, which is founded upon the insufficiency of the legal remedy, to be applied against them as well as against the subjects of the Crown? It was said that the prohibitory words of the patent were addressed only to the subjects of the Crown; but these prohibitory words are in aid of the grant and not in derogation of it; and they were probably introduced at a time when the prohibition of the Crown could be enforced personally against parties who ventured to disobey it. The language of this part of the patent does not, therefore, appear to me to alter the case.

CAMPION *against* BENYON, A.D. 1821. 6 B. Moo. 71; 3 Brod. & Bing. 5.

Title too large. Novelty of Invention. Obligation in Specifying.

CASE for the infringement of a patent of 13th *April*, 1813, No. 3,682, to *R. Campion*, for 'an improved method of making and manufacturing double canvas and sail-cloth, with hemp and flax, or either of them, *without any starch whatever*.' Plea: Not guilty. Issue.

The patent related to a manufacture of sail-cloth with double warp threads. Each warp thread was composed of two yarns, first

untwisted, and then twisted into a single thread of double size. No starch was used in the process. The specification stated:—'I do hereby describe and ascertain the nature of my said invention and the manner in which the same is to be performed as follows; that is to say, my new and improved method of making double canvas and sail-cloth *without any starch whatever*, consists in,' &c. Then followed a description of the process. There was no separate claim.

At the trial, it appeared that double sail-cloth had been made without starch before the patent. It was objected that the patent was void, by reason that plaintiff claimed to make sail-cloth without starch, which had been done before. DALLAS, C.J. left the case to the jury. Verdict for plaintiff.

Rule nisi to set aside the verdict and enter a nonsuit made absolute by the Court of Common Pleas. (Dallas, C.J., Park, Burrough, Richardson, JJ.)

Per DALLAS, C.J.—Every patent being a monopoly, that is, an infringement of public right, and having for its object to give the public warning of the precise extent of the privilege conferred on the patentee, the Court 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 time I first read this patent down to the present day, I thought that the object of the patentee 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.

CANNINGTON *against* NUTTALL, A.D. 1871. L.R. 5 H.L. 205.

Evidence of Infringement. Combination of Parts.

Suit to restrain from infringing a patent (in part disclaimed) of 7th *May*, 1866, No. 1,297, to *A. Pocheron*, for 'improvements in the manufacture of glass.' The cause was tried before the Master of the Rolls and a jury on the issues of novelty and infringement. Verdict for plaintiff. Application for a new trial refused. On appeal GIFFARD, L.J. ordered a new trial on the ground of misdirection. On further appeal to the House of Lords, order discharged and judgment of the Court below affirmed, with costs of the motion before the Lord Justice.

The patent related to a method of melting glass without the use of pots. Prior to this invention, a glass furnace or kiln consisted of a hollow truncated cone of large dimensions, having in its interior space a low covered chamber provided with a series of separate flues or chimneys placed around it. A fire-place occupied the centre of the inner chamber or *dome*, and *caves* or air passages extended throughout the subterranean area, and gave a supply of air to the furnace. A number of fire-clay pots, for holding the glass, were placed inside the dome; one pot standing in the space between two adjacent flues. The heated gases from the fire surrounded the pots, and passed through the flues into the main chimney formed by the external cone. The floor of the furnace was called a *siege* or *bank*. As the pots were quite close to the central fire, they were exposed to the danger of being cracked by currents of cooler air passing through the fire-bars; or they might yield from the too intense heat of the flame. The fracture of a pot caused the most serious difficulties. The provisional specification stated:—'My invention consists in the suppression of the fire-clay pots or crucibles in general use, and placing the materials to be melted in the oven or kiln itself.' The complete specification stated:—'My improvements *consist in* the suppression of the fire-clay pots or crucibles hitherto in use, and *in placing* the materials to be fused or melted within the furnace itself, the usual inner form of the lower part of which is modified by doing away with the sieges or banks, and the general levelling of the bottom. The lateral sides are constructed of a hollow form, in such wise that a current of refrigerating or cooling air may be made to circulate around and prevent any excessive heating of the sides which are to retain or enclose the materials in fusion.' The drawings showed (1) a basin or tank for holding the materials, (2) two gratings or fire-places situated on opposite sides of the tank, (3) air spaces or channels surrounding the tank on all sides and allowing the free circulation of air. There was no separate claim.

The patentee subsequently filed a disclaimer which stated:—'Whereas I have been advised that the specification may be held to claim generally the suppression of the fire-clay pots and the placing the materials to be fused within the furnace itself, and, as I do not wish to make any such extended claim to invention, but desire to limit my claim to the forming the sides of the tank or chamber, containing the glass-making materials, hollow, in such wise that a current of refrigerating air may circulate and prevent any excessive heating of the sides which retain or enclose the fused materials, I,

for this reason, wish to disclaim and do hereby disclaim all parts of the said specification which claim the suppression of the fire-clay pots, and placing the materials to be fused in the furnace itself.' The verbal alterations were then specified, viz., the substitution of '*have reference to*,' for '*consist in*,' also of '*to placing*,' for '*in placing*,' and after the words '*levelling of the bottom*' the introduction of the words '*to which separately I make no claim; but according to my invention*,' whereby the last passage read thus: 'but according to my invention the lateral sides are constructed,' &c.

The alleged infringement consisted in the use of a furnace constructed according to a patent of 15th *July*, 1867, No. 2,075, to *F. D. Nuttall*, for improvements in the construction of glass furnaces wherein the patentee described the objects of his invention as being, (1) to economise fuel, (2) to obtain any desired temperature, (3) to render the most important parts of glass-makers' furnaces more durable. The specification showed, (1) a tank with a fire-place on either side thereof, (2) air tubes passing through the flame from each fire, and supplying heated air for the more perfect combustion of the gases, (3) narrow air passages, conveying air from the cave along either side of the tank, and at the back of the fire-bridge, for admixture with the current passing through the air tubes at points just above the bridge. It was apparent that the air passing along these passages would be heated, and also that it would *pro tanto* cool the sides of the tank.

In directing the jury, the MASTER OF THE ROLLS said:—'If a person takes well-known processes from a great number of sources, and a great many inventions, and adapts them all together to a perfectly new combination, for a perfectly new purpose, their previous use is not, in my opinion, an anticipation of the patent. Mr. *Bramwell* has pointed out that the most vulnerable part of the tank would be that which lies between the hot fused mass in the tank and the furnace which created the heat, and that the great object was to make some interval there by which the heat could not be communicated through to the tank, and by that means allow the glass, when in a state of fusion, to escape. That appears to have been the principal object of *Pocheron's* invention.' Then the learned judge described it, and said further:—'Every one of those things separately is anticipated by these patents, but that does not, in my mind, prevent the validity of a patent for their combination.'

In delivering the judgment of the House of Lords, LORD HATHERLEY, L.C. said:—'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

practical 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 now combined into one valuable whole for the purpose of effecting the object you have in view?

'What the respondent has done is this: he has not carried the hollow all round the tank, but he carries up, by means of what is technically called a split bridge, a space between the fire and the tank. Certainly there is not the same circular belt of air which there appears to be in *Pocheron's* invention; but, at the vulnerable points, the air is supplied and is running up, and it is performing the very purpose for which in *Pocheron's* patent air is introduced. Now, my Lords, I apprehend that in that point of view it is a plain infringement of *Pocheron's* patent. I apprehend the point is this, that if you find the air applied at the most vulnerable point, where it is most wanted for the purpose of cooling, the mere circumstance that it is not done in exactly the same way, or that it is not carried all round, does not touch the question of the infringement of the essence of the invention. If the same object is attained by the same process which is here introduced, and introduced for the purpose of attaining it, then I apprehend that the infringement has taken place.'

Per LORD WESTBURY.—The object of the patent was to secure an apparatus which should consist of three principal ingredients or parts. A tank first, instead of the pots; then the fire placed laterally to the tank instead of immediately beneath it. Then the third and principal part of the apparatus was this—the forming of a channel all around the tank, in order that the atmospheric air might circulate freely. These were the three principal objects which were to be united together, and the apparatus resulting from the union of the three was the improved apparatus to be used in the manufacture of glass.

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. The invention consisted in the things I have mentioned. All these things were embodied by Mr. *Pocheron* in his original specification, and they are well described in very few words in the provisional specification.

I come now to the original specification under the patent, and I must confess that I think it was a very unnecessary amount of nervous timidity with regard to this specification which led to the disclaimer. It is impossible to read the original specification, before the disclaimer, without observing that the object is to describe an apparatus or combination. It is the apparatus, the machine, the combination of the separate parts, which is the subject of the invention, and which constitutes the merit of the discovery. Originally Mr. *Pocheron* had said that his improvements consisted *in* the suppression of the fire-clay pots, and *in* placing the material to be fused or melted within the furnace itself. That preposition '*in*' appears to have led to some misapprehension, and accordingly it was the cause of the subsequent disclaimer.

Here I must pause for a moment, because, unfortunately, the Lord Justice did not observe where the disclaimer begins, and he has confounded the introductory part, or the reason for the disclaimer, with the disclaimer itself. What the Lord Justice did, was this: He read as part of the disclaimer, and as belonging to the disclaiming part of the amended specification, the following words: '*I desire to limit my claim* to the forming of the sides of the tank or chamber, containing the glass-making materials, hollow, in such wise that a current of refrigerating air may circulate and prevent any excessive heating of the sides which retain or enclose the fused materials.' These words limiting the claim are, when rightly understood, no more than this: the patentee says, 'In the introductory part of my specification there are two things which, I think, are erroneously represented as part of the invention, but the remaining third thing is correctly represented as a discovery, and is part of the invention.' Then, if the Lord Justice had observed what that discovery was, namely, *the introduction of the atmospheric air*, he would at once have been conducted in his mind to the mechanical arrangement made for the purpose of effecting that object, and he would have found that mechanical arrangement to be a part of the entire combination, a part of the whole furnace or kiln, which is described in both the original and amended specifications as the improved furnace or kiln, which is the subject of the patent, and is, in point of fact, the discovery of the patentee. If the matter had originally been carefully examined, it would have been seen from the very nature of the thing itself that the merit of the invention must

lie in the improved kiln or furnace, constituted mainly of the three integral parts that I have described, and which are all brought into correlative action for the purpose of getting a better manufacture of glass. In the three taken together, and not in any one of the three taken separately, lies the utility, and lies the novelty of the invention.

I have now only to advert for a moment to the question of infringement. Say the counsel for the respondent, 'You are greatly mistaken in supposing that we have the same object as you have. Your combination has for its object the keeping cool the material portion of the furnace or kiln, the combined machine, which would be liable to be destroyed by heat. Our combination, on the contrary, is intended to intensify the heat. These channels which you describe as an imitation of your channels have nothing at all to do with refrigeration. They conduct the atmospheric air in a heated state to the top of the furnace, and then they inject oxygen by means of the heated atmospheric air into the products of combustion. That has the effect of greatly augmenting the intense heat of the furnace below, and usefully consumes the smoke and vapour of the furnaces.'

I do not mean to deny that that may possibly be an improvement upon the appellant's combination. But we all very well know that if you are obliged to adopt a combination of machinery which originally is directed to one purpose, before you can make it minister to another and additional purpose, the user of it for this additional purpose is an infringement of the patent which first introduced that combination, and we find this sort of infringement to be substantially admitted in the argument.

Mr. *Webster* says, 'In conducting the air through my channels in order to make it arrive at the top of the furnace, and then projecting it into the mass of vapour and flame that I find there, I cannot deny but that in that process I do *pro tanto* cool the sides of the furnace.' But then we find that the sides are cooled just where the cooling process is required. If there had been no intention to pirate the invention these channels for the air might have been conducted behind the furnace, or they might have been brought in at an elevation above the sides of the tank, but instead of that we find that the channels are placed exactly where refrigeration is required. There can be no doubt that there is refrigeration; and there can be no doubt that if there be any merit in the respondent's discovery, it is a thing added to the process of the appellant. It embodies the appellant's apparatus, and therefore becomes in law a piracy of his invention.

CARPENTER *against* SMITH, A.D. 1841–2. 1 Webs. Pat. Ca. 530; 9 M. & W. 300.

Public Use of an Invention.

CASE for the infringement of a patent (in part disclaimed) of 18th *June*, 1830, No. 5,880, to *J. Carpenter* and *J. Young*, for 'improvements in locks.' Plea 3: That the invention was not new as to the public use thereof in *England* at the time of the grant. Issue.

At the trial, it appeared that several years before the date of the patent, a model of a lock, similar to plaintiff's, was brought from *America*, and that seven and a half dozens of locks were then made from this model by a manufacturer in *Birmingham*, presumably for export to *America*. Also that a lock, similar to plaintiff's, had been in use for sixteen years on a gate belonging to one *Davies*, and adjoining a public road. LORD ABINGER, C.B. directed the jury:—It is required as a condition of every patent that a patentee shall set forth in his specification a true account and description of his patent or invention, and it is necessary in that specification 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, why 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 turns out to be old, or the combinati itself not new.

I think 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 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. Now '*public use*' means this—that the use of it shall not be secret, but public. Therefore, if a man invents a thing for his own use, whether he sells it or not—if he invents a lock and puts it on his own gate, and has used it for a dozen years, that is a public use of it. Now we come to the second case. Here you have an article, manufactured by an *English* manufacturer and sold; and in my opinion if it was sold even for the assumed purpose (of which there is no legal evidence) of being sent to *America*, I cannot but think that would be a de-

struction of the novelty of the plaintiff's invention. Where a model is sent to a workman who sells seven and a half dozen, and sells them at a certain price, I must say I think the invention was used and publicly exercised. Verdict for defendant.

Rule for a new trial, on the ground of misdirection, refused by the Court of Exchequer. (Lord Abinger, C.B., Alderson, Gurney, BB.)

During the argument counsel quoted the summing-up of Patteson, J. in *Jones* v. *Pearce* (1 Webs. Pat. Ca. 124), to the effect that, 'if the wheel was used openly in public, so that everybody might see it, and the use had continued *up to the time of taking out the patent*, undoubtedly that would be a ground to say that the invention was not new.' Whereupon ALDERSON, B. said:—'That is the very same principle of law as was laid down by my Lord in the present case; the only restriction I should put upon it would be, that it need not appear that the machine was used up to the time of taking out the patent.'

Lewis v. *Marling* (10 B. & C. 22) was also quoted by counsel.

Per ALDERSON, B.—I have not the least doubt that that is the right construction of the law which my Lord has put upon it. 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. If the plaintiff's doctrine is correct, it would follow that, if Mr. *Davies* were to change his lock to another gate, he would be liable to an action for the infringement of the plaintiff's patent. The case of *Lewis* v. *Marling* went to the very extreme point of the law.

Per LORD ABINGER, C.B.—I was counsel in *Lewis* v. *Marling* and in *Jones* v. *Pearce*, and I recollect that those cases proceeded on the ground of the former machines being, in truth, mere experiments, which altogether failed. The public use and exercise of an invention means a use and exercise in public, not by the public. I have always entertained the same opinion on the subject.

CARTWRIGHT *against* EAMER, A.D. 1800. *Cited* 14 Ves. 131, 136.

Test of Sufficiency of Specification.

Per LORD ELDON.—The question is, whether the specification be such that a mechanist can make the machine from the description there given. The patent is to be considered as a bargain with the public, and the specification therefore is to be construed on the same principle of good faith as that which regulates all other contracts. If therefore the disclosure be such that the invention can be communicated to the public, the statute is satisfied.

CHAMBERS *against* CRICHLEY, A.D. 1864. 33 Beav. 374.

Estoppel.

Suit to restrain from infringing a patent. It appeared that, in 1862, defendant assigned all his share in the patent to plaintiff. He now insisted that the patent was invalid. Injunction granted.

Per ROMILLY, M.R.—I do not intend to express my opinion as to the validity of the patent. I will assume, for the purpose of my judgment, that it is worth nothing at all. But it is certain that the defendant sold and assigned that patent to the plaintiff as a valid one, and having done so, he cannot derogate from his own grant.

CHANTER *against* LEESE and OTHERS, A.D. 1838–9. 1 Webs. Pat. Ca. 295; 4 M. & W. 295; 5 M. & W. 698 (In Ex. Ch.).

Consideration for a Licence.

ASSUMPSIT. The declaration stated that by an agreement which recited that plaintiff was possessed of certain patents, plaintiff licensed defendants to use the same on payment of an annuity of 400*l.* Pleas: 2. That the invention of an improvement in furnaces was not new, whereby the patent became void. 3. That the said improvement was not invented by plaintiff, whereby the patent became void, as plaintiff well knew. Demurrer to 2nd and 3rd pleas, and joinder. Judgment for defendants by the Court of Exchequer.

Per LORD ABINGER, C.B.—The declaration is founded on the contract, and nothing but the contract. In the present case it does not appear to the Court that the defendants ever accepted or enjoyed any part of the patents which were the consideration of their agreeing to pay 400*l.* a year to the plaintiff, nor that the sum they so agreed to pay can in any manner be apportioned among the different patents which they might have had, the possession of all and each being an entire consideration. The plea therefore impeaching that consideration, is a good plea to avoid the whole contract as it appears on the record.

Error brought in the Court of Exchequer Chamber. Judgment affirmed.

Per TINDAL, C.J.—Here it is plain that the enjoyment of all the six patents is the consideration for every part of the defendants' promise, and that the annuity to be paid is neither apportioned by the contract nor capable of being apportioned by a jury. We see that the consideration is entire, and the payment to be made by the defendants is entire; we see also a failure of the consideration, which, being entire, by failing partially, fails entirely; and it follows that no action can be maintained for the money.

CHANTER *against* DEWHURST and ANOTHER, A.D. 1844. 12 M. & W. 823.

Licence valid without Seal.

ASSUMPSIT to recover a sum of money due under a licence not under seal, granted by plaintiff to defendants for the use of a patented furnace. Plea: *Non assumpserunt.* Issue.

At the trial, defendants put in evidence the letters patent granted to plaintiff, wherein all persons were strictly commanded not to 'make use or put in practice the said invention, without the license, consent, or agreement of the said *J. Chanter* (the patentee) his executors, administrators or assigns, in writing, under his or their hands and *seals*,' &c.; and it was objected that the licence, not being under seal, was void. ALDERSON, B. refused to nonsuit. Verdict for plaintiff. Leave reserved.

Rule nisi to enter a nonsuit discharged by the Court of Exchequer. (Pollock, C.B., Parke, Alderson, Rolfe, BB.) During the argument ALDERSON, B. said:—'To grant a licence not under seal may be a contempt of the Crown, but does not exempt the man to whom it is granted, and who derives a benefit from it, from paying the price of it.'

Per PARKE, B.—The doubt in this case arises, not because it can be considered necessary to have a licence under seal to use every patent article that may be sold in a shop, but because we have to consider whether the plaintiff could give the power to use the article in question without complying with the terms of the letters patent as to the mode of granting it. It is difficult to give effect to all the words of the patent.

Per ALDERSON, B.—The plaintiff permits the defendants to make the machine for themselves, and to use it for themselves, and in my opinion a licence for this purpose need not be under seal.

CHANTER *against* JOHNSON and ANOTHER, A.D. 1845. 14 M. & W. 408.

Written Licence, addition of Seal to. Evidence. Stamp.

ASSUMPSIT. The declaration stated that defendants were indebted to plaintiff in 33*l.* for the licence to use a furnace made according to certain patents, whereof plaintiff was owner. Plea: *Non assumpserunt.* Issue.

At the trial, plaintiff tendered in evidence a document, purporting to be a licence from plaintiff to defendants, for the use of the patented furnace, in consideration of the payment of 33*l.* The document was under seal, but not stamped, and was given as in pursuance of defendants' application for a licence *in writing*. WIGHTMAN, J. was of opinion that this document was a deed, and was inadmissible without a stamp; he, however, refused to nonsuit, but reserved leave to defendants to move to enter a nonsuit; and proof

having been given of the supply of the furnace to and its use by defendants, plaintiff had a verdict, damages 33*l.*

Rule nisi to enter a nonsuit, or for a new trial on the ground of misdirection. It was contended that, the document in question having been rejected, plaintiff had proved no written licence, and defendants were entitled to a new trial. Rule made absolute for a new trial by the Court of Exchequer.

Per PARKE, B.—The contract of the defendants was to pay the plaintiff a certain sum for a licence in writing, and I do not see any evidence of that contract having been waived or altered, and another substituted for it. But then the licence was rejected at the trial for want of a stamp, and the question therefore arises whether any stamp was necessary. The defendants say the instrument is a deed and ought to be stamped as such: but that is not so; it does not purport to be sealed and delivered as a deed; it rather resembles an award, or a warrant of a magistrate, which, though under seal, are not deeds.

CHOLLET *against* HOFFMAN, A.D. 1857. 7 E. & B. 686.

Validity of Assignment without Registration. Notice of Objections.

CASE for the infringement of a patent of 12th *Nov.* 1850, No. 13,338, to *E. Masson.* The declaration alleged that the patent was duly assigned to the plaintiff. Plea 6: That the patent was not assigned as alleged. Issue.

At the trial, it appeared that the assignment had not been registered pursuant to stat. 15 & 16 Vict. cap. 83, sect. 35. The notice of objections raised no question as to the validity of the assignment. LORD CAMPBELL, C.J. directed a verdict for defendant on the 6th issue.

Rule nisi for a new trial, on the ground of misdirection, discharged by the Court of Queen's Bench. (Lord Campbell, C.J., Wightman, Erle, Crompton, JJ.)

Per LORD CAMPBELL, C.J.—The stat. 15 & 16 Vict. cap. 83, sect. 35, provides that, till the entry of assignment has been made in the register of proprietors, the grantee of the letters patent 'shall be deemed and taken to be the sole and exclusive proprietor thereof.' Therefore, if *Masson* had sued for the alleged infringement, he must have been deemed and taken to be the sole person who had a right to sue; and an issue upon any plea denying his title must have been found in his favour. But the defendant could not be liable to be sued at the same time for the same infringement by the grantee and by the assignee of the letters patent. We, at present, give no opinion upon the question whether and how far the entry of the

assignment, when made, will refer back; but supposing that it might refer back to the execution of the indenture, till the entry is made no legal interest passed by the indenture, and nothing beyond a right to have the title completed.

The only other point made by the plaintiff was that the defendant was precluded from insisting on the want of registration of the assignment, because it was not specifically mentioned in his notice of objections. The requirements of the late statute, as to notices by the defendant, are clearly confined to notices affecting the validity of the patent.

CLARK *against* FERGUSSON, A.D. 1859. 1 Giff. 184.

Practice in Patent Suits. Recent Patent.

Suit to restrain from infringing a patent of 12th *April*, 1859, No. 910, to *W. Clark*, for 'an improved safety block, to be used in lowering ships' boats.'

It appeared that plaintiff, before specifying, agreed with defendants that they should manufacture the patent block. An improvement was then suggested by one *Nash*, a foreman of defendants', and plaintiff was requested to insert the same in his specification, as well as to share the profits of the patent with defendants. Plaintiff declined the proposal, whereupon *Nash* applied for and obtained a patent for his improvement. The alleged infringement consisted in working under *Nash's* patent.

Injunction granted until further order.

Per STUART, V.C.—This is not a case in which the plaintiff's title is disputed. The litigation has been occasioned by the plaintiff's refusal to embody his plan with the alleged improvement made by the defendants' servant. It is not a mere matter of course, because a patent is recent, to call on the patentee to establish his rights at law before he can obtain relief in this Court. It is in the discretion of the Court to require a plaintiff to assert his rights at law or otherwise, according to the nature of the case.

CLARK *against* ADIE, A.D. 1873. 21 W. R. 456, 764.

Injunction. Rights of a Licensee.

Motion to restrain defendant from issuing circulars interfering with plaintiff's right, as licensee, to the free sale of certain horse-clippers. It appeared that defendant was patentee of an improved form of horse-clipper, and that he agreed by letter to license plaintiff to work under his patent. Pending the settlement of certain disputes as to collateral matters, defendant issued circulars to customers of plaintiff, threatening legal proceedings if they pur-

chased horse-clippers without certain distinguishing marks thereon. Injunction granted. On appeal, motion dismissed by the Lords Justices, with costs.

Per JAMES, L.J.—The trade of a licensee of a patent is not to be stopped pending the settlement of disputes as to certain collateral matters.

CLARK *against* ADIE, A.D. 1873–5. L.R. 10 Ch. 667.

Evidence of Infringement. Sub-combination of parts.

Suit to restrain from infringing a patent of 22nd *Oct.* 1869, No. 3,076, to *J. R. Grayson*, for 'improvements in apparatus for clipping or shearing horses.'

The specification described the instrument or clipper by reference to drawings, and showed a flat 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 under surface. A thin plate of steel, with V-shaped cutters, traversed to and fro over the comb, being guided by stems 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 of the clipper were pivoted on a strong stem, set in a square hole in the comb-plate, and secured by a nut on the screwed end of the stud; one of these handles worked the cutter, and the other took its bearing at the rear of the comb-plate, and was capable of being set and clamped in different positions to suit the convenience of the operator. At the end of the working handle a sliding block was pivoted, having slots corresponding with those on the cutter, and the cutter was connected with the block by two short pins. Each guiding stem was fixed to the comb at one end, and was screwed at the other end, so that the adjustment between 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. *Claim*: '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 manner that the apparatus may be adjusted to numerous angles or positions to suit the varying surface of the animal, 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 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, and 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. BACON, V.C. granted an injunction. On appeal to the Lords Justices, the bill was dismissed, with costs.

Per JAMES, L.J.—The claim of *Grayson* is in the most general terms, and it has obviously been so framed in order to escape the danger which might be lurking in some existing machine or patent, if any thing or any part or parts more definite or more limited had been claimed. [His Lordship then read the above claim, and said it was obvious that *Clark's* instrument did not answer that description.] Nor is it so pretended; but it is alleged that, although the general arrangement, construction, and combination of parts have not been copied, there is a subordinate combination—part of the entire combination—which has been transferred from *Grayson* to *Clark*, and that under the supposed doctrine of *Lister* v. *Leather* (8 E. & B. 1,004) the plaintiff is entitled to treat as an infringement the use of that subordinate combination.

It has been strongly contended before us, that whenever there is a patent for a combination, that patent gives protection, not indeed to every distinct thing that enters into the combination, but to every combination, arrangement, and aggregate of two or more of those distinct things, even although such subordinate combination is not expressly or impliedly claimed in the specification.

This, in our opinion, is so startling a violation of every principle of patent law, that we doubt whether we could follow any authority short of the House of Lords in applying such a doctrine.

A patent for a new combination or arrangement is to be entitled to the same protection, and on the same principles, as every other patent. The patent is for the entire combination, but there is, or may be, an essence or substance of the invention underlying the mere accident of form; and that 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. The

principle is really very plain, as it seems to us. A combination or accumulation of three improvements is a totally distinct thing from a combination or accumulation of two of them—as distinct as a partnership of A, B, and C is from a partnership of A and B. If a man really wants to patent not only the whole but something less than the whole of what he calls 'a new arrangement, construction, and combination of parts,' he must clearly show that he claims that something less—of course perilling his patent if that something less is not a novelty.

But it appears to us that even if *Lister* v. *Leather* were the true exposition of the law, and had the full meaning and extent for which the plaintiff's counsel has contended, it would be impossible to apply that case to the case before us. Combination and subordinate or partial combination, are terms really not applicable to such improvements in such an apparatus as that now before the Court. The 'general arrangement, construction, and combination' is not a combination in any sense except that in which every one of the several improvements may be said to combine with every other in making the machine a better one. *Parva componere magnis*: take a screw steamship in which the whole locomotive apparatus is one which by means of fuel set on fire under a boiler full of water at one end sets in motion a screw at the other end. Improvements may be made in every part of that apparatus, but it would be absurd to talk of a combination of an improved steam generator, of an improved arrangement for economising the steam, and of an improved method of attaching and moving the screw.

So here it appears absurd to talk of a combination of the means of adjusting the handle of the cutter with the other parts. As to the supposed subordinate combinations, there is, no doubt, in *Grayson's* patent a combination of the teeth of the comb made parallel and cut like a musical-box comb, with the angular cutter made like that of a reaper, because they are combined to effect a clean sharp cut. But there is no combination between them and the arched or convex cutter-bar, or between them or the latter and the parallel motion on the strong fixed stems. They are all improvements, but they are distinct improvements for distinct purposes, as much as those in the case supposed of a marine steam engine.

To examine particularly the things which are supposed to be taken from *Grayson* by *Clark*, the convex or arched cutter-bar is really not to be found anywhere in the written specification, and, although it may be found in the drawings, it was clearly no part of the invention which was present to the mind of the inventor; or, if it was, he has wilfully omitted to describe a material part of his in-

vention. Again, the strong fixed stems cannot be brought into any conceivable sub-combination of parts. They have their own independent function of making the whole machine stronger and less likely to get out of order. As jurymen, giving our verdict on that which is, after all, a question of fact, we find that *Adie's* clipper is not a piratical appropriation of *Grayson's* invention, and consequently we hold that the plaintiff's bill ought to have been dismissed with costs.

COCHRANE *against* SMETHURST, A.D. 1816. 2 Coop. Ch. Ca. 57; 1 Stark. R. 205.

Title of Patent too large. Practice in Patent Suits.

Suit to restrain from infringing a patent of 3rd *March*, 1813, No. 3,657, to *Sir T. Cochrane*, for 'an invented method of more completely lighting cities, towns, and villages.'

The patent related to a glazed street lamp, having an eduction chimney for the escape of vitiated air, together with pipes or apertures for conducting a supply of air directly to the flame. The principle was that of *Argand's* lamp. The specification stated:—That the object of the invention would be more clearly understood by contrasting the construction of the present street lamps with lamps proposed to be formed according to the principles and adaptation of the improvements.

Injunction refused by LORD ELDON, L.C., who directed an action at law, and said that the rule of the Court was that an injunction should not be granted, unless the Court entertained no doubt respecting the validity of the patent. His mind here was far from satisfied. It rather inclined against the plaintiff. If it inclined as much in his favour, he, nevertheless, would not say that the injunction ought to go. He had considerable difficulty about the specification. He would grant no injunction until the result of the action was seen.

Action at law. Plea: Not guilty. Issue.

At the trial, LE BLANC, J. directed the jury:—The patent cannot be sustained. The plaintiff has obtained his patent, not for an improved street lamp, but for an improved method of lighting cities, towns, and villages; but from the specification it appears that the invention consists in the improvement of an old street lamp by a new combination of parts known before. The patent therefore is too general in its terms; it should have been obtained for an improved street lamp, and not for an improved mode of lighting cities, towns, and villages. Plaintiff nonsuited.

COLLARD *against* ALLISON, A.D. 1839–40. 4 Myl. & Cr. 487.

Practice in Patent Suits where possession of Patent has been disturbed.

Suit to restrain from infringing a patent for an improvement in the manufacture of pianofortes. The patent had been in existence for twelve years. Defendant disputed the validity of the patent, and stated facts to show that the possession under it had not been undisturbed. LORD LANGDALE, M.R. refused to grant an injunction, and directed an action at law. On appeal, order affirmed.

Per LORD COTTENHAM, L.C.—For the purpose of protecting the right until the trial should have been had, I ought to have very satisfactory evidence of exclusive possession. The result is that this case, in my opinion, wants that evidence of exclusive possession upon which Lord Eldon acted in *Hill* v. *Thompson* (3 Meriv. 622), and that there is so much doubt as to the novelty of what is claimed, and as to the validity of a patent for such a manufacture, that I do not feel that I ought to interfere. It is obvious, however, that the question should be immediately tried.

COOK *against* PEARCE, A.D. 1843–4. 8 Q.B. 1,044, 1,054.

Title of Patent.

CASE for the infringement of a patent of 22nd *Feb.* 1840, No. 8,392, to *W. Cook*, for 'improvements in carriages.' Plea 6. Setting out the specification, and averring that the title was too large, whereby the patent became void. Issue.

The patent related to a method of fixing folding shutters in carriages, and was applicable to the fitting of a certain class of shutters, having three hinged folds, which closed up and were known in the trade as *German* shutters. As to the 6th issue, the jury found:—That the invention was not an invention of improvements in carriages generally, but of certain improvements in adapting *German* shutters to those carriages only in which *German* shutters were used, and whether or not, &c. Verdict for plaintiff on remaining issues. The special verdict was argued in the Court of Queen's Bench. (Denman, C.J., Williams, Coleridge, Wightman, JJ.) Judgment for defendant.

Per LORD DENMAN, C.J.—We are unable to distinguish *Cochrane* v. *Smethurst* (1 Stark. R. 205) from the present case, or to discover any reason why, if the patent in that case were vitiated by being too general in its terms, this patent can be sustained.

Error brought in the Exchequer Chamber. (Tindal, C.J., Coltman, Erskine, Maule, JJ., Parke, Alderson, Gurney, Rolfe, BB.) Judgment for plaintiff *non obstante veredicto*.

Per TINDAL, C.J.—The words 'improvements in carriages' do not necessarily import 'in all carriages,' but may be held to be satisfied by an invention of improvements in some carriages only. The mere vagueness of the title appears to us to be an objection which may well be taken on the part of the Crown before it grants the patent, but to afford no ground for avoiding the patent after it has been granted. If such title did not agree with the specification when enrolled, or if there had been any fraud practised on the Crown in obtaining the patent with such title, in those cases the patent might undoubtedly be held to be void.

In *Cochrane* v. *Smethurst*, the extreme generality of the title far exceeds that now under consideration; but that case was never moved in the Court of Queen's Bench, and its authority cannot be rated higher than that of the opinion of the learned judge who tried the cause. We think therefore that, as in the present case, no more is objected than mere vagueness and generality in the title of the patent; without any evidence leading to the inference of fraud upon the Crown, or prejudice to the public, enough has not been shown to avoid the patent.

COPELAND *against* WEBB, A.D. 1862. 11 W. R. 134.

Practice in Patent Suits. Two Patents for the same Invention.

Suit to restrain from infringing a patent. It appeared that both plaintiff and defendant had severally obtained patents for the same invention, and defendant claimed to be working under his own patent. Injunction refused. Account ordered.

Per KINDERSLEY, V.C.—This is a case which I should certainly have sent to be tried by a Court of law if the recent statute (25 & 26 Vict. cap. 42. sect. 1) had not prevented my doing so. It appears that both plaintiff and defendant have obtained patents for doing precisely the same thing. If the defendant's patent cannot stand with the plaintiff's, then the plaintiff ought to take steps to set it aside, which he might do by *scire facias*.

CORNISH and SIEVIER *against* KEENE and ANOTHER, A.D. 1835–6.
1 Webs. Pat. Ca. 501; 3 Bing. N.C. 570.

Subject-matter of a Patent. Novelty of Invention. Evidence of prior Publication. Evidence of sufficiency of Specification. Prior Experiments.

CASE for the infringement of a patent of 17th *Jan.* 1833, No. 6,366, to *R. W. Sievier* for 'improvements in the manufacturing of elastic fabrics, applicable to various purposes.' Pleas: 3. That the invention was not new. 4. That it was not an improvement in manu-

facturing elastic fabrics applicable to useful purposes. 5. That the specification was insufficient. Issue.

The patent related to the manufacture of elastic cloths, by interweaving strands of ordinary indiarubber. The specification stated:—That the invention comprised three objects, the *third* being to produce cloth of cotton, flax, &c., in which should be interwoven elastic strands of indiarubber. These strands were first covered by winding filaments tightly round them by an ordinary covering machine, and were then arranged as warp threads and stretched to their utmost tension. Additional warp threads of cotton, flax, &c. were combined with the indiarubber strands. The cloth was then woven in the ordinary manner. It was next subjected to the action of heat, whereby the indiarubber contracted and became elastic, the non-elastic threads forming a limit beyond which extension was impossible, and the relative admixture of materials determining the degree of elastic pressure. There was no separate claim.

TINDAL, C.J. directed the jury:—I think, upon the specification, very little question arises, because not only persons of skill and science read it, and say that it was intelligible to them to make the manufacture from, but also two or three witnesses were called who actually made it without any instruction but the specification. No person was called who stated that he could not understand it, or had been misled by it, or incurred expense in endeavouring to copy or imitate it, or stated that he was unable to understand what was meant by it.

It is a circumstance in the case that the cloth is found useful for surgical purposes. The patent, however, is not taken out for that purpose, and it would not be sufficient, in order to maintain the patent on the ground of its being an improvement, to show that it was an improvement in surgical cases for bandages only, because the patent is not confined to that; but they must prove also that it is generally an improvement with respect to the general uses of that fabric or manufacture which was intended.

We are now approaching the real question in contest; that is, whether it is a new discovery of which the patentee was the first inventor, or whether it was known and practised in *England* before, and at the time of obtaining the patent in question. 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 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. It will be a question for you to say, whether, upon the evidence that you have heard, you are satisfied that the invention was or was not in public use and operation at the time the letters patent were granted. 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, may take out a patent, 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, many rivals that may be running on the same road at the same time, and the first who 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. On the part of the plaintiffs the evidence is, as it necessarily must be, of a negative character. You cannot prove a negative strictly—you can only do so by exhausting the affirmative instances of it, by calling persons who have never heard of it or seen it; and the more those persons are in the way of hearing of it or seeing it, if it had existed, the stronger is that exhausting evidence, if I may so call it, in its effect and value with the jury.

Undoubtedly if you could show under the hand of the plaintiffs or anybody's hand that the secret had been publicly communicated to the world, which was intended to be covered by the subsequent patent, there is an end of that patent.

If it was generally known and practised, and not merely as a matter of experiment and trial kept secret by the party, and thrown away as the result of that which was of no use to the public, the patent is gone; or if the defendants have shown that they practised it and produced the same result in their factory before the time the patent was obtained, they cannot be prevented by the subsequent patent from going on with that which they have done.

Verdict for plaintiffs.

Rule nisi to enter a nonsuit on the ground that the invention was not the subject of a patent, and for a new trial on the grounds that the verdict was against the evidence, and that since the trial

defendants had found a patent of 14th *Nov.* 1832, No. 6,334, to *J. V. Desgrande* for a like invention, discharged by the Court of Common Pleas. (Tindal, C.J. Gaselee, Vaughan, Bosanquet, JJ.)

Per TINDAL, C.J.—The first objection is that the invention is not the subject-matter of a patent. The question therefore as to this point is, does it come under the description of 'any manner of new manufacture' which are the terms employed in the statute of James. That it is a manufacture can admit of no doubt; it is a vendible article produced by the hand of man, and of all the instances that would occur to the mind when inquiring into the meaning of the terms employed in the statute perhaps the very readiest would be that of some fabric or texture of cloth. The use of elastic threads or strands of indiarubber, previously covered by filaments wound round them, was known before; the use of cotton or other non-elastic material was also known before; but the placing them alternately side by side together as a warp, and combining them by means of a weft, when in extreme tension and deprived of their elasticity, appears to be new; and the result—viz., a cloth, in which the non-elastic threads form a limit up to which the elastic threads may be stretched, but beyond which they cannot, and therefore cannot easily be broken—appears a production altogether new. It is a manufacture at once ingenious and simple. It is a web combining the two qualities of great elasticity and a limit thereto.

The second objection to the verdict is, that it is against the evidence. The question raised for the jury was this: whether the various instances brought forward by the defendants amounted to proof that, at the time of taking out the patent, the manufacture was in public use in *England*; or whether it fell short of that point, and proved only that experiments had been made in various quarters, and had been afterwards abandoned. This question is, from its nature, one of considerable delicacy; a slight alteration in the effect of the evidence will establish either the one proposition or the other, and the only proper mode of deciding it is by leaving it to the jury. We see no reason to be dissatisfied with the conclusion at which they arrived.

With respect to the third ground upon which the rule was obtained, without entering into the question whether the invention for which the patent in dispute was taken out was or was not described in the specification of *Desgrande*, we think it sufficient to observe, that this specification was not enrolled till *May*, 1833, whereas the article made under the plaintiffs' patent was publicly made and sold upon the London market, to a very large extent, in *March* and *April* of the same year. And although the specification

of *Sievier's* patent was not enrolled till *July*, 1833, we think the mere fact of the enrolment of *Desgrande's* specification after the plaintiffs' patent was sealed, and his discovery known upon the market, does not of itself, alone, afford any proof whatever of the want of novelty in the manufacture made under the plaintiffs' patent.

CRANE *against* PRICE and OTHERS, A.D. 1840–2. 4 M. & G. 580; 1 Webs. Pat. Ca. 377.

Subject-matter of a Patent. Novelty of Invention.

CASE for the infringement of a patent of 28th *Sept.* 1836, No. 7,195, to *G. Crane*, for 'an improvement in the manufacture of iron.' Pleas: 3. Setting out the specification, and averring that the said improvement was not a new manufacture within the statute. 5. Stating the grant of an existing patent to *J. B. Neilson*, and averring that the user of the hot blast as described was a user of *Neilson's* invention, whereby the patent was void. Issue.

The patent related to the use of anthracite or stone coal, in conjunction with a hot-air blast, for the smelting of iron. The specification stated that the preferable temperature for the blast was 600° Fahr. *Claim*: 'The application of anthracite or stone coal, combined with the using of hot-air blast in the smelting and manufacture of iron.'

TINDAL, C.J. was of opinion that there was nothing to leave to the jury, and directed a verdict for plaintiff, subject to a special case. After argument, the Court of Common Pleas directed a verdict for plaintiff on all issues, except the 5th; on that for defendants; and notwithstanding such verdict gave judgment for plaintiff. (Tindal, C.J., Erskine, Coltman, Maule, JJ.)

Per TINDAL, C.J.—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 is an invention or manufacture intended by the statute, and may well become the subject of a patent. There are numerous instances of patents which have been granted where the invention

consisted in no more than the use of things already known, the acting with them in a manner already known, the producing those effects already known, but producing those effects so as to be more economically or beneficially enjoyed by the public. It will be sufficient to refer to a few instances, in some of which the patents have failed on other grounds, but in none on the objection that the invention itself was not the subject of a patent. The learned judge then referred to *Hall's patent* (1 Webs. Pat. Ca. 97), *Derosne's patent* (1 Webs. Pat. Ca. 152), *Hill's patent* (3 Meriv. 629), *Daniell's patent* (Godson. Pat. 274), and continued :—

It was objected, in the course of the argument, that the quantity or degree of invention was so small, that it could not become the subject of a patent; that the person who had procured a licence to use the hot-air blast under *Neilson's* patent had a full right to subject to that blast coal of any nature whatever, whether bituminous or stone coal. If the invention be new and useful to the public it is not material whether it be the result of long experiments and profound research, or whether of some sudden and lucky thought, or of mere accidental discovery.

The Case of Monopolies (*Darcy* v. *Allin*, Noy. R. 173) states the law to be, 'that where any man by his own charge or industry, or by his own wit or invention, doth bring a 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, in such cases the king may grant to him a monopoly-patent for some reasonable time.' If the combination now under consideration be, as we think it is, a manufacture within the statute of James, there was abundant evidence in the cause that it had been a great object and desideratum, before the granting of the patent, to smelt ironstone by means of anthracite coal, and that it had not been done before; indeed, no evidence was called on the part of the defendants to meet that which the plaintiff brought forward.

With respect to the issue raised by the 5th plea, it is impossible to find any substantial or real distinction between the hot-air blast and the machinery and apparatus described in *Neilson's* specification, and that described and referred to in the plaintiff's. On the 5th issue, therefore, we think the verdict should be entered for the defendants.

Then arises the question whether the plaintiff is or is not entitled to judgment notwithstanding the verdict upon the 5th issue. Undoubtedly, if the second patent claims, as part of the invention described in it, that which was the subject-matter of a patent then in force, it would be void. But in this case there is an express dis-

claimer as to any part of the invention of the use of the hot-air blast which was covered by *Neilson's* patent. The specification expressly says:—'I take the whole of the invention already well known to the public, and I combine it with something else.' It was further argued that, in point of law, no patent can be taken out which includes the subject-matter of a patent still running and in force. No authority was cited to support this position; and the case (*Lewis* v. *Davis*, 3 C. & P. 502) in which Lord Tenterden held, that where an action was brought for an infringement of improvements in a former patent granted to another person, and still in force, the plaintiff must produce the former patent and specification at the trial, affords a strong inference that the second patent was good. The case also of *Harmer* v. *Playne* (11 East, 101) is a clear authority to the same point; and upon reason and principle there appears to be no objection. We think that judgment must be given for the plaintiff.

CROFTS *against* PEACH, A.D. 1836. 2 Hodge R. 110.

Inspection.

CASE for the infringement of a patent for making lace by machinery. Rule, to compel the production of a specimen of lace made by the patent machine, refused by the Court of Common Pleas. (Tindal, C.J., Park, Vaughan, Bosanquet, JJ.)

Per TINDAL, C.J.—The object of this application is to ascertain the evidence which the plaintiffs will produce at the trial. The defendants may plead that the invention is not new, if that is the fact. The specification gives the necessary information.

CROLL *against* EDGE, A.D. 1847–50. 9 C.B. 479.

Variance between the Title and Specification.

CASE for the infringement of a patent of 7th *March*, 1844, No. 10,096, to *A. A. Croll* and *W. Richards*, for 'improvements in the manufacture of gas for the purpose of illumination, and in apparatus used when transmitting and measuring gas.' Pleas: 2. *Non concessit.* 4. That the specification was insufficient. 6. That the invention specified was another and a different invention from that for which the patent was granted, whereby the patent became void. 7. That the invention was not an improvement in the manufacture of gas. Issue.

The patent related to improved methods:—(1) of manufacturing gas; (2) of setting and heating retorts; (3) of making retorts by pressing clay into moulds; (4) of measuring gas.

At the trial, it appeared that the specification as enrolled recited a patent for 'improvements in the manufacture of gas for the purpose

of illumination, and in apparatus used *therein and* when transmitting and measuring gas;' and it was contended, on behalf of the defendant, that the insertion of the words 'therein and' extended substantially the grant of the Crown, whereby the patent was rendered void. Verdict for defendant on 4th, 6th, and 7th issues; the jury discharged as to the other issues. Leave reserved.

Rule nisi to enter a verdict for plaintiff discharged by the Court of Common Pleas.

Per MAULE, J.—The patent was properly described in the declaration as a patent for 'improvements in the manufacture of gas for the purpose of illumination, and in the apparatus used when transmitting and measuring gas.' A specification was enrolled, reciting the grant of a patent, with the additional words 'therein and,' interpolated between 'used' and 'when.' The insertion is slight as to the number of words, but it adds most materially to the meaning of the sentence, and extends substantially the grant of the Crown. The title did not profess to comprehend improvements in any apparatus used in making gas. The patentees, in representing to the Crown the nature of the invention which they had discovered, did not give the Crown notice that they claimed the exclusive use of any apparatus for making gas. When the body of the specification is looked at, one main part of the patentees' claim consists of what may be, and probably is, a new mode of manufacturing clay retorts—an apparatus used in the manufacture, and not in the transmitting and measuring of gas. No patent at all has been granted to them for that. It seems to us that they have specified for a more extensive and a different patent from that which was granted to them. We therefore think the specification insufficient, and that the objection properly arises on the 6th plea. Probably, *non concessit*, or the 4th plea, would equally raise the defence.

CROMPTON *against* IBBOTSON, A.D. 1828. Dan. & L. 33.

Specification bad for misleading.

CASE for the infringement of a patent of 1st *Nov.* 1820, No. 4,509, to *T. B. Crompton*, for 'improvements in drying and finishing paper.' 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.'

At the trial, one of plaintiff's witnesses 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.' BAYLEY, J. nonsuited plaintiff.

Rule nisi to set aside the nonsuit refused by the Court of King's Bench.

Per LORD TENTERDEN, C.J.—The patent was obtained for the discovery of a proper conducting medium. The plaintiff found after repeated trials that nothing would serve the purpose except the cloth described in his specification, yet he says that the cloth may be of any suitable material, and merely that he prefers the particular kind there mentioned. Other persons, misled by the specification, may be induced to make experiments which the patentee knows must fail; the public therefore has not the full and entire benefit of the invention—the only ground on which the patent is obtained. In *Turner* v. *Winter* (1 T. R. 602) a patent was held void on the ground of an ambiguity in the specification like the present.

CROSSKILL *against* EVORY, A.D. 1848. 10 L.T. 459.

Practice in Patent Suits. Separate proceedings against Infringers.

Suit to restrain from infringing a patent of 8th *Sept.* 1841, No. 9,082, to *W. Crosskill*, for improvements in machinery for rolling and crushing land. It appeared that plaintiff had already brought two separate actions against infringers, and had in each case established the validity of his patent. LORD LANGDALE, M.R. nevertheless ordered an action at law, saying that he did not think he could bind the defendant by proceedings which had taken place between the plaintiff and other parties.

CROSSLEY *against* BEVERLEY, A.D. 1829. 3 Car. & P. 513; 1 Russ. & M. 166 *n.*; 1 Webs. Pat. Ca. 106.

Validity of Patent where Improvements are made before specifying. Sufficiency of Specification. Extent of Protection by Injunction.

CASE for the infringement of a patent of 9th *Dec.* 1815, No. 3,968, to *S. Clegg*, for an 'improved gas apparatus.' Plea: Not guilty. Issue.

The patent related to apparatus for 'extracting inflammable gas by heat from pit coal, tar, or *other substance* from which gas or gases capable of being employed for illumination can be extracted by heat.' It also related to a *water-meter* for measuring the supply of gas. The meter was formed of a hollow wheel, divided into chambers, and partly immersed in water. The flow of gas filled one chamber while another was being emptied, and caused the wheel to rotate on its axis, so as to record and measure the quantity of gas which passed through the apparatus.

At the trial, it appeared that gas could not be made from oil by the plaintiff's apparatus, although oil would produce an inflammable

gas. The inventor, Mr. *Clegg*, was called, and stated that he had invented some of the mechanical parts which were described in the specification at times subsequent to the date of the patent, but that during this interval he had in his mind a general idea of the whole apparatus. It was objected that the gas-making apparatus was incomplete for want of a condenser.

Lord Tenterden, C.J. said:—In reading this specification it is clear that the words 'other substance' coupled with the words 'pit coal and tar,' mean other substance *ejusdem generis*. One must understand this person to speak of things which were known and used at the time. He could not possibly mean oil gas; it had never been used because of the great expense. A workman who was capable of making a gas apparatus would know that he must put in a condenser. The specification does not tell you to leave it out. There is nothing in that. Verdict for plaintiff.

Rule for a new trial, on the ground that the specification was for an invention differing from that for which the patent was granted, refused by the Court of King's Bench. (Lord Tenterden, C.J., Bayley, Littledale, JJ.)

Per Lord Tenterden, C.J.—It appears that the person's mind was directed to the invention, and that in the interval between the taking out of the patent and the enrolling of the specification he perfects it in some of the mechanical parts. The question is, Will that make his patent void? No case has so decided, and it would be a very great hardship if it were so. Indeed, I do not see why any time is allowed to the inventor to prepare his specification, unless it be to allow him to mature the mechanical parts of the invention.

Per Bayley, J.—It is not only the duty of the inventor to state what he knew at the time of the patent, but the public have a right to be put in possession of all that he knows at the time of the specification.

(1 Russ. & M. 166, *n.*) Suit to restrain from infringing the same patent. It appeared that the patent was about to expire, and that defendant had accumulated a large stock of patented gas-meters, ready to be thrown on the market as soon as the monopoly was at an end. Lord Lyndhurst, L.C. granted an injunction to restrain the sale of such meters both before and after the term limited by the grant of the patent.

Crossley *against* The Derby Gas Company, A.D. 1829-38.
4 L.J. Ch. 25; 3 Myl. & Cr. 428.

Practice in Patent Suits. Extent of Protection granted to a Patentee.

Suit to restrain from infringing the same patent. It appeared

that the bill was filed on 28th *Nov.* 1829, and that the patent expired on 9th *Dec.* 1829. Injunction granted by the Vice-Chancellor, who directed the account to be carried back for six years from the date of filing the bill. On appeal, decree affirmed with costs.

Per LORD BROUGHAM, L.C.—It was objected that the Court would not interfere just on the eve of the expiration of a patent and grant an injunction which would only last a week. The point has never yet been decided; but I am of opinion that the Court would interfere, even after a patent has expired, to restrain the sale of articles manufactured previous to its expiration, in infringement of a patent right; and that a party would not be allowed to prepare for the expiration of a patent by illegally manufacturing articles, and immediately after its expiration to deluge the market with the produce of his piracy; thus reaping the reward of his improbous labour. The Court would, I say, in such a case restrain him from selling them even after the expiration of the patent.

The report in Myl. & Cr. refers to matters of computation in carrying out the order of the Court.

CROSSLEY and OTHERS *against* POTTER and OTHERS, A.D. 1853.
Macrory's Pat. Ca. 240.

Subject-matter of a Patent. Sufficiency of Specification. Parol Evidence of Patentee.

CASE for the infringement of a patent of 28th *Dec.* 1842, No. 9,573, to *T. Thompson*, for 'improvements in weaving figured fabrics.' Plea 3. That the specification was insufficient. Issue.

The patent related to apparatus for inserting and withdrawing the wires used in weaving terry fabrics. The specification stated:—'The operation will be better understood by reference to the accompanying drawings, which represent *parts of a loom for weaving coach lace.* It then described the mechanism as applied to weaving coach lace,' and went on to say, 'I do not intend to confine myself to narrow goods only, as this improved means of weaving *may also be adapted to the production of carpets.*' *Claim* (in substance): The weaving of terry fabrics by means of tags or wires attached to moveable arms, such arms being shifted at intervals and made to introduce and withdraw the wires.

At the trial, it appeared that a loom, made as specified, could not be adapted for the weaving of carpets by a mere widening of the parts; also, that a carpet loom made by plaintiffs according to the patent had certain parts (alleged to be well known) added thereto, in order to make it available for carpet weaving. At the close of plaintiffs' case, POLLOCK, C.B. was of opinion that the action was not

maintainable, if, upon the evidence as it then stood, the jury should find that the invention, as specified, was not capable of coming into practical use for the weaving of carpets. To guide the jury the learned judge proceeded to discuss this evidence, observing:—'The truth appears to me to be this, that the patent is very much like what has often been attempted, viz., to take out a patent for a principle, which the law will not allow. Any man who takes out a patent must take it for a manufacture. It is very true that patents are continually taken out for what are called *methods* or *processes*; but the real object of the patent, the real end that is secured by the statute, the matter that is alone mentioned in it capable of being made the subject of a patent, is a new manufacture; and everybody who takes out a patent under the name of a process, really takes it out for that which is the result of the process, for the thing that is manufactured, or the process by which it is produced. Whatever principle you have invented or applied, you must have it embodied in some machine or manufacture distinctly, in order that other ingenious and enterprising members of the community may distinctly know what it is they are prohibited from doing. This patent is taken out for the making of coach lace, carpets, and velvets of all sorts, and it must be competent to do all and every part of that work by the means stated in the specification; otherwise the patent is not good.

'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, cannot, in my judgment, be supported.'

The jury consulted together, but did not agree, and the case proceeded.

The patentee then was examined, and was asked what the invention was for which he had taken out a patent. Question objected to; but the learned judge ruled that it was admissible, and said:—'The specification shows the invention that is specified, but there must be some mode of getting at the fact of what the invention really was. The specification cannot be conclusive evidence when it may be fraudulently prepared.' It then appeared that *Thompson* was the inventor of a loom for weaving coach lace, and knew nothing about carpet weaving. Before specifying, he sold the patent to other parties, who drew the specification, and described the machinery as being applicable to the weaving of carpets as well as of coach lace.

POLLOCK, C.B. directed the jury:—The direction I shall give you is simply that, if you believe the evidence of Mr. *Thompson*,

your verdict should be for the defendants, who have merely used in carpet weaving something like what is described in the specification. 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.

Verdict for defendants.

CROSSLEY *against* STEWART, A.D. 1863. 1 N.R. 426.

Practice in Patent Suits. Discovery.

Suit to restrain from infringing a patent for the manufacture of looms. Plaintiffs interrogated defendant as to the sums of money received by the sale of looms made in infringement of the patent, and required discovery as to the names and addresses of the persons to whom such looms had been sold. It appeared by the answer that looms had been sold to persons residing at *Leipsic*, but no information was given as to their names and addresses. The answer being excepted to, WOOD, V.C. said that the answer sought might lead to important discoveries by the plaintiffs in regard to the infringement of their patent. The interrogatory must be answered, except, of course, as to looms manufactured in foreign countries, and sold to persons residing there.

CROSSLEY and OTHERS (*Appellants*) *against* DIXON (*Respondent*). } A.D. 1863. 10 H.L. Ca. 293. }

Estoppel of Licensee.

Suit to restrain from infringing certain patents. Appeal from an order of the Lords Justices. It appeared that respondent agreed verbally with appellants to be supplied by them with carpet looms constructed according to certain patents of which they were owners, and to pay royalties for the use of the inventions incorporated therein. Respondent afterwards used other carpet looms, upon which appellants claimed a royalty as embodying the patent inventions; and this user constituted the infringement complained of. Respondent denied—(1) that the agreement amounted to a licence; (2) that the patents were valid; (3) that there had been any infringement. WOOD, V.C. made a decree in favour of appellants, directing an inquiry only on the question of infringement. The Lords Justices retained the decree, but ordered the appeal to stand over till after appellants had brought 'any action they might be advised.' On appeal to the House of Lords, the decree of the Vice-Chancellor was affirmed, with a verbal alteration limiting the

declaration under that decree, and the order of the Lords Justices was discharged, with costs.

Per Lord Westbury, L.C.—The agreement subsists at the present moment, and the respondent is using the machines which he so bought, and is recognising his relation as licensee of the appellants by paying the appellants the royalty, a payment that can be attributed to nothing but the patent rights, in respect of which these machines have been constructed.

Now the first contention on the part of the respondent is this, that, notwithstanding that relation continues, he is at liberty to deny the title of the appellants to the ownership of the inventions for the use of which he is thus paying a royalty. We are all very well aware that that is a proposition inconsistent with the law, as it would be equally inconsistent with the ordinary reason and good sense of mankind. But then it appears that the respondent has obtained from a different quarter other machines which are apparently, according to the evidence, identical in construction and principle with the machines supplied to him by the appellants; and in respect of the user of these latter machines, it is contended, on the part of the respondent, that he is at liberty to affirm that those machines are no invasion of the plaintiff's patent—(1) because he denies the validity of the patent; (2) because he affirms that the machines are different in construction and principle from the machines so made and supplied to him by the appellants. Now, my Lords, assuming that the second set of machines is identical in construction with the first, it would be impossible to hold that the obligation not to deny the appellants' patent right would not extend to the second set of machines so long as he continues to use the first set of machines, which is the fact at present. That is equally a question of law, and a question of ordinary principle.

The whole decree of the Vice-Chancellor is of course founded upon the continuance of the existing relation of licensor and licensee; for it is an idle distinction which is attempted to be set up by the respondent that he made an agreement and did not take a licence. But that licence being the foundation of the claim, and being of course determinable by the respondent at pleasure, I would submit that this general declaration ought to have been qualified by the introduction, after the words 'the defendant is not entitled,' of some such words as these, 'whilst he continues to use the machines bought of the plaintiffs under the agreement, or during the continuance of the agreement between the defendant and the plaintiffs.' But that alteration ought not, as I humbly submit to your Lordships, to affect the question of costs.

CURTIS and OTHERS *against* CUTTS, A.D. 1839. 8 L.J. Ch. 184; 2 Coop. Ch. Ca. 60.

Practice in Patent Suits where Enjoyment of Patent is not exclusive.

Suit to restrain from infringing a patent for making wire cards. *Ex parte* injunction granted by the Vice-Chancellor, who declined, on the coming in of the answer, to dissolve the injunction. The answer denied the novelty of the invention and the enjoyment under the patent, which had been in force for nearly fourteen years, but admitted the infringement, and alleged that the specification was imperfect and fraudulent. On appeal, injunction dissolved, with liberty to bring an action.

LORD COTTENHAM, L.C. said:—The bill does not state such a case as to justify the granting of an injunction. The answer disputes the validity of the letters patent, and states that the alleged invention is not new, and that the specification is imperfectly set forth; on the other hand, the plaintiffs contend that there has been a long possession and enjoyment under the patent.

This Court gives credit, no doubt, to long enjoyment under letters patent, until it is proved that they are bad; but then there must be not only enjoyment, but exclusive enjoyment under them. (*Hill* v. *Thompson*, 3 Meriv. 622.) The allegations in the answer negative the exclusive enjoyment claimed by the plaintiffs. I think the right course is not to restrain the defendant, but to give the plaintiffs the opportunity to try the question at law.

The report in Coop. Ch. Ca. is the following:—'The rule upon which the Court acts in granting an injunction where the validity of the patent alone is disputed, requires not merely that there shall have been possession and enjoyment under the patent, but that such possession and enjoyment shall have been undisturbed and exclusive. Here the answer negatives an exclusive possession of the privilege to make the machines. It states that since the patent was granted, persons not claiming under the patent have manufactured machines upon the principle sought to be protected by it. There is an end, therefore, of the case of exclusive possession and enjoyment.'

CURTIS *against* PLATT, A.D. 1863. 8 L.T. N.S. 657; 33 L.J. C.P. 255; 11 L.T. N.S. 245; 35 L.J. Ch. 852; L.R. 1 H.L. 337.

Sufficiency of Particulars of Objections. Practice as to Costs where an Action is abandoned. Evidence of Infringement. Mechanical Equivalents.

Suit to restrain from infringing a patent of 10th *Nov.* 1854, No. 2,393, to *J. Wain*, for improvements in 'mules.' The particulars of objection alleged—(1) prior user of the invention by certain specified persons, and by others who were not specified; (2) prior

user by thirteen persons or firms, from A.D. 1825 downwards, giving merely the places of residence of the persons referred to; (3) prior publication in books, &c., with a general reference.

WOOD, V.C. ordered defendant to furnish better particulars under the second and third heads only, and said that as to the first point, the Court would know perfectly well how to protect the plaintiff from the effect of a surprise. As to the second point, he was quite clear that the particulars ought to be amended. The object of having these statements reciprocally furnished by the parties, was that each might know what were the particular instances of breach, or of prior user, or publication, on which the other intended to rely. He felt sure that in this case the defendants would be able to give with more precision the date of user and the place of use of the machines to which they referred, and so far as these facts were concerned, they were bound to give the plaintiff all the information they themselves had. On the third point, they must, instead of giving a general reference, state the particular work or document, and the volume of that work in which the alleged prior publication was to be found. Costs to be costs in the cause.

(33 L.J. C.P. 255.) The report refers to the allowance of costs in preparing for the trial of an action for infringement of the same patent, where plaintiff discontinued before issue joined, and without having given notice of trial. The master, in taxing defendant his costs, refused to allow such as were incurred in preparing for trial.

Rule nisi for the master to review his taxation, discharged by the Court of Common Pleas. (Willes, Byles, Keating, JJ.)

(11 L.T. N.S. 245.) The report carries on the history of the suit. The patent related to improvements applicable to mules constructed according to a patent of 12th *Oct.* 1849, No. 12,805, to *R. Lakin* and *W. H. Rhodes*, and the object of the invention was to effect certain changes in the action of the mule without the intervention of an eccentric boss, and rods and levers, as described in the patent of *Lakin* and *Rhodes*. The specification described the apparatus by reference to drawings, and showed a solid shaft, running completely through a hollow shaft, called a *change* shaft, on which were cams intended to be rotated at certain periods. The solid shaft was the driver, and at the extreme end of it was placed a *catch* or clutch-box made in two halves, one half being attached to a spiral spring, and capable of sliding along the solid shaft but revolving with it, the other half being keyed to the hollow shaft. The action of the spring brought the two halves together, and the hollow or *cam* shaft would thereby rotate until they were separated. The intervals of separation or rest were produced by the pressure of a sliding pin,

moving in a hole bored through the boss of one half of the clutch-box, and sufficiently long to disengage the driving half when pushed against it. A disc or plate at the back of the driven half of the clutch-box was provided with two projecting circular inclines, intended to press the loose pin sufficiently to liberate the clutch-box. This plate had a large opening or slot in the centre to admit the hollow shaft, and could be moved vertically up and down through a small space by the action of a lever arm. The pin was shown in the drawing as resting on the lower incline, and forcing the clutch-box out of gear. The motion of the carriage then depressed the plate, and the pin fell off the incline, whereby the spring brought the two halves of the clutch-box together, and the cam shaft rotated, until the pin came upon the upper incline, and brought it to rest. After an interval the lever raised the plate, and the action was renewed.

Claims: 1. The novel construction, combination, and application of mechanism, as hereinbefore described, whereby one half of the clutch-box, hereinbefore and in the said specification of *Lakin* and *Rhodes* described, *or any mechanical equivalent therefor*, is connected with and acts upon cams for effecting changes in the action of the mule, direct, and without the intervention of such eccentric boss, and rods, levers, or other mechanical agents combined therewith, as are described by *Lakin* and *Rhodes*, in their said specification.

2. The arrangement and combination of the lever described, and the parts connected therewith, for causing the *catch* box to be put into gear, and also the means or mode described of giving motion to the *change* shaft.

It should be noted that the mechanism of the clutch-box, and of an incline with a pin for disengaging its two halves, was part of the patent of *Lakin* and *Rhodes*, whose specification showed the change shaft, on which were fitted two halves of a clutch-box. To the half which revolved loose an eccentric boss was fixed, and there was a sliding pin passing through the boss. During the revolution of the clutch-box this pin was brought against a fixed incline, and was forced outwards against the driving half of the clutch-box so as to press it away from engagement with the other half.

The alleged infringement consisted in the use of machinery constructed according to a patent of 13th *April*, 1860, No. 922, to *J. Platt*, for a method of giving intermittent motion to the cam shaft of mules. In this apparatus one half of a clutch-box rode loose upon the cam shaft, and the other half was capable of sliding on the shaft, but revolved with it. To this latter half was affixed a plate, having upon its face a number of recesses (four being shown), which gave the required changes. At the end of each reeess was an incline. A

pin at one end of the arm of a rocking lever actuated by a tumbler, entered the recess, and ran up the incline as the shaft rotated. One half of the clutch-box was pressed against the other half by a spiral spring, which held the two parts together until the pin came upon the incline and separated them by the pressure caused thereby. The cam shaft then stopped in a definite position, determined by the end of the recess, and did not rotate again until the action of the tumbler withdrew the pin and allowed it to fall into the next recess, and to set up another period of rotation.

At the trial, before Wood, V.C. without a jury, his Honour found on the fifth issue—viz. whether defendant had infringed the patent of *Wain*—in favour of defendant, and on the remaining four issues as to the validity of the patent in favour of plaintiff. The cause came before the Lord Chancellor on motion by plaintiff, to alter the finding on the fifth issue, or for a new trial, with cross motion by the defendant as to the remaining issues. Decree affirmed; appeal dismissed with costs; cross appeal, by consent, dismissed without costs.

Per Lord Westbury, L.C. — For the efficient agency of this machine (*a mule*) it has been found necessary that there should be a shaft with cams upon it, and it has also been found necessary that there should be some means of arresting the shaft, staying the shaft once or twice, or even four times, during a single rotation, thereby producing breaks or pauses for spaces of time in the rotatory motion of the shaft. These pauses or breaks have been at various times attempted to be produced in various ways. Mr. *Roberts* had one mode, namely, by the operation of a wheel with spaces. That proving not adequate to the end, another mode was discovered of breaking the rotatory motion, producing pauses in the rotation by the operation of a clutch-box. The application of that to the shaft was made, as far as I am informed, in the first instance by the patent of *Lakin* and *Rhodes*. Mr. *Wain* then applied himself to what he denominates 'an improvement upon the patent of *Lakin* and *Rhodes*.' Now it has been vigorously contended before me, that I am not to take Mr. *Wain's* invention as he himself describes it, and that I ought not to allow him to be limited to his own description of its being an improvement; that I ought to take his invention as containing in itself a new and original principle. I cannot so take it. I must take Mr. *Wain's* patent as being specific mechanism, directed to a certain end that was previously well known, directed to facilitate a certain result, the benefit of which had long been discovered, directed to produce in a more simple and easy manner a particular operation of the clutch-box, which was itself only a means to an end. I cannot but think that in patents of this description the doctrine of mecha-

nical equivalents is not by any means applicable. The thing itself is nothing more than a particular agent for attaining a certain end, and if Mr. *Wain* was entitled to a patent for the particular agency by which he effected, in a more convenient manner, the opening and shutting of the clutch-box, any other person is on the same principle entitled also to a patent for the means of effecting the same result, provided those means are not a colourable evasion of Mr. *Wain's* patent, or provided those means do not embody Mr. *Wain's* patent with an improvement.

Mr. *Wain's* desire was to bring the clutch-box into action more than once during the rotation of the shaft. At a short distance from one of the discs of the clutch-box he put a plate upon the solid shaft, which plate was not fixed as the plate in *Lakin* and *Rhodes'* patent, but admitted of being moved upon the shaft vertically up and down. On that plate he raised not one incline, which *Lakin* and *Rhodes* had done, but two inclines. Upon this plate he in like manner, as in the case of *Lakin* and *Rhodes*, causes a moveable pin to rotate, but it does not rotate always in the same circle, but rather in the arcs of two circles, the circle being varied by the vertical elevation of the plate, which I have already described. The pin is brought into operation upon the clutch-box twice by means of two inclines. It is, in truth, nothing in the world more than a new arrangement of original elements, all of which were to be found in the patent of *Lakin* and *Rhodes*. Its merit consists in that new arrangement. I consider, therefore, the pin, the incline, and a plane which inclines upon it, to be common elements, out of which any inventor was at liberty to make or construct a machine at the time when *Wain's* patent was granted, and of necessity, therefore, at the time when *Platt's* patent was granted. Mr. *Platt*, although to a certain extent he avails himself of the same elements, yet puts them in a different combination, he makes their effect upon the clutch-box different, and he makes the result different. It has been urged upon me that Mr. *Wain's* invention is capable of, or might be made to produce, a result co-extensive and co-equal with *Platt's* invention. If it is so, all I can say is that Mr. *Wain* has not given to the world the benefit of a description of the mode by which that may be effected. I think it a very material thing, as the Vice-Chancellor also did, that, in comparing the two things together, the result and the work done by *Platt's* patent are double, and if double, doubly more beneficial than the work done by *Wain's* patent. Now the mode in which Mr. *Platt* effects the end desired has been by putting upon the shaft a rotating plane, which is bodily connected and joined on to the proximate disc of the clutch-box. Upon this rotating plane Mr. *Platt* has also put the inclines,

which were matters of common knowledge, but instead of having one incline, as in *Lakin* and *Rhodes'* patent, instead of having two inclines as in *Wain's*, he has four inclines. He divides the circle into four portions or arcs, and one incline is in each arc of that circle. Mr. *Platt's modus operandi* is this:—he arrests the rotatory motion of the plane by insertion of a projection at the end of the arm of a lever, which lever moves up and down, so as to present the arm which stops the rotatory motion of the plane successively. Being arrested, the pressure produced overcomes the lateral pressure of a helical spring coiled round the shaft, and the action of that spring being overcome, the pressure withdraws the disc of the clutch-box. When the pin is released the rotating plane resumes its rotatory motion, and there is produced a withdrawal of one disc of the clutch-box from the other four times, and the withdrawal by a force, by a combination of agents, and by a repetition of agency, which are different altogether from the force, the combination, and the agency of *Wain's*. It is said that is a colourable difference, because it is precisely the same thing whether you make the pin rotate upon a plane, or whether you make the plane rotate upon the pin. Now it is very well to cut off the case from all the *differentia*, and to present the case in that generic form without the specific differences that exist between the two agents; but this is a case of specific difference. It is the case of a particular mechanical combination; it is the case of certain well-known things being put together in such a manner as to produce the same result, and it is impossible for me to say that the combination which Mr. *Platt* has made is substantially the same combination that Mr. *Wain* has made. If the invention be, as I have already described, nothing more than a particular means to attain to a given result which is certainly well known, then the invention is for the means, and you can no more prevent the invention of one distinct set of means being interfered with, you can no more say that it interferes with the invention of another, than you could say originally that there ought not to be patents granted for the invention of distinct means to an end.

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 that 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 road to go to *Brighton* by *Croydon*, another man shall not have a road to go to *Brighton* by *Dorking*. They are roads and means

of attaining the end, and unless you can prove that one is a colourable imitation of the other, or unless you can prove that one bodily incorporates the other, with merely an addition, it is impossible to say they shall not be co-existent subjects of contemporaneous patents. I must therefore entirely affirm the judgment of the Vice-Chancellor.

(35 L.J. Ch. 852; L.R. 1 H.L. 337.) On appeal to the House of Lords, the decree was affirmed, and the appeal dismissed with costs. A cross appeal was also, by consent, dismissed without costs.

At the hearing a preliminary objection was taken that an appeal on the fifth issue, viz. whether the respondents had been guilty of infringement, was not permissible under the provisions of stat. 21 & 22 Vict. cap. 27, sect. 3; but LORD CHELMSFORD, L.C. said:—'The Court of Chancery knows no distinction between orders founded on questions of law and those upon matters of fact; and the words of the third section applying generally to any orders made upon an application for a new trial, and there being nothing in the fifth section which can be considered as creating any distinction between the different kinds of trial, whether with or without a jury, the regular course of appeal in both cases must equally be open to both parties, and therefore the present appeal is not incompetent.'

His Lordship then discussed the question of infringement, and expressed his opinion that the decree ought to be affirmed.

Per LORD CRANWORTH.—It was said that *Wain* claims not only his own specific mechanism but also '*any mechanical equivalent therefor*.' And every part of *Platt's* machine is, it was said, if not identical with, at all events only a mechanical equivalent for *Wain's* machinery. There are, however, two answers to this argument. In the first place the claim as to mechanical equivalents, according to the fair construction of the specification, relates only to the clutch-box; and, secondly, the principle which protects a patentee against the use by others of mechanical equivalents is inapplicable to a case like the present, where the whole invention depends entirely on the particular machinery by means of which a well-known object is attained. If, indeed, the mechanical equivalent used was merely a colourable variation of that for which it was substituted the case might be different; but here I see no ground for holding that any parts of *Platt's* contrivances are mere colourable variations from those patented by *Wain*.

REX *versus* CUTLER, A.D. 1816. 1 Stark. R. 354.

Novelty of Invention.

Sci. fa. to repeal a patent of 6th *Jan.* 1815, No. 3,873, to *J. Cutler*, for 'improvements applicable to fire-places, stoves, &c.'

The patent related to a mode of feeding the fire in an ordinary open grate, by a supply of coal from below. The contrivance consisted in placing a coal-box with a moveable bottom below the grate and raising the bottom by means of a rack and pinion, so as to bring up the coals. The specification stated:—'My invention doth consist in constructing fire-places and stoves in such manner that the fuel necessary to support combustion shall be given to the part in combustion at the lower part of, or beneath the same.'

At the trial, it appeared that, before the patent, two manufacturers had publicly exhibited stoves in which the fuel was raised up from below. In one of these, a deep grate, filled with coals, was raised gradually above the level of a door or screen, and the combustion of the fuel was limited to the exposed portion of the grate.

LORD ELLENBOROUGH was of opinion that the principle on which the two grates were constructed, was identical with that described in the terms of the specification, which was for a mode of supplying fuel from below, and there was nothing predicated in the specification of raising the fuel from below the grate; it was merely for elevating a supply of fuel from below, and that the defendant had confined himself, by thus summing-up the extent of his invention, to the benefit of this principle. Verdict for the Crown.

REGINA *versus* CUTLER and OTHERS, A.D. 1847–9. 14 Q.B. 372, *n*; Macrory's Pat. Ca. 124.

Novelty of Invention. Misdirection by Judge. Subject-matter of a Patent.

Sci. fa. to repeal a patent of 6th *Nov.* 1841, No. 9,140, to *J. Cutler*, for 'improvements in the construction of the tubular flues of steam boilers.' Suggestions:—9. That the invention was not new; 10. That it was not the working of any manner of manufacture; 12. The like of the part thirdly claimed; 13. The like of the part fourthly claimed; 14. That the invention was of no use; 15. That the specification was insufficient. Traverse. Issue.

The patent related to the manufacture of welded iron tubes. The specification stated:—'I take a strip of hammered iron or steel, bevil the opposite edges, and bend it into a cylindrical shape. At the mouth of the furnace I place the end of a draw bench, upon this bench I place two stops, and against these stops a die, or dies, or a pair of grooved rolls of the required size for the tube. A mandril is then passed through the die or the groove of the rolls.' It went on to say that the tube was then heated to a welded heat, and was drawn either through the dies or grooved rollers, while supported within by the mandril. Another mode was by hammering on a mandril, and after-

wards drawing through dies or grooved rollers as before. The next part of the invention was a mode of coating an iron tube, made as described, with a tube of copper, or brass; but the specification stated:—'I do not claim the making coated tubes as above described, this part of my invention relating to *the application of coated tubes* in constructing tubular flues for steam boilers.' The manufacture of the several tubes, either coated or otherwise, was described by reference to drawings. *Claims*: 1. The mode of welding iron or steel tubes by drawing through dies or grooved rolls on mandrils. 3. The *application* of either iron or steel tubes, when coated with copper, brass, or other alloys of copper, in the construction of tubular flues of steam boilers. 4. (In substance) the application of welded iron or steel tubes, drawn through a circular hole or die, or between rollers, and over a mandril for the like purpose.

At the trial, evidence was given that the mode of making tubes by drawing through dies over a mandril was impracticable. The mode by drawing between grooved rollers and over a mandril had not been tried, but witnesses stated that in their judgment it was not practicable. Defendants called evidence in contradiction.

Lord Denman, C.J. directed the jury:—There is an objection that it is stated that the tubes may be made either by drawing them through dies or between grooved rollers, and it is said that the dies will not produce the effect. But, in my opinion, if either of these modes is practicable, and if it is proved to be useful and new, as to this part of the invention it seems to me that the patent will be good; and you are to form your opinion on the evidence—is it useful, is it new?

With regard to the third and fourth claims, in which the defendant claims the application of tubes on the construction of tubular flues, it appears to me that he has no right to take out a patent for the mere application of particular things to any particular purpose. I think Lord Abinger's illustration is a striking one, and applicable to the present case—'It is like sweeping a carpet of a new manufacture with an old broom.' And, in general terms, I think that the application of an article to produce any particular result, the party having no claim either to the mode of producing the article, or to the mode of applying it for attaining that result, forms no ground for a patent. The jury found that the whole of the invention was new and practicable. Verdict for defendants.

Rule nisi for a new trial on the ground of misdirection made absolute by the Court of Queen's Bench. (Lord Denman, C.J., Coleridge, Wightman, Erle, JJ.)

Per Lord Denman, C.J.—The fifteenth suggestion was that the

specification did not particularly ascertain and describe the nature of the invention. The hammers to be applied to the iron tube are described, and on the bench are to be placed two stops for dies, or a pair of grooved rolls. A mandril is then pressed through the dies, or between the grooves of the rolls. On the trial, there was evidence that neither the dies nor the grooved rolls would do the work here assigned to them; and I told the jury that if either of those methods were proved to be satisfactory, the patent might be good, notwithstanding the imperfection of the other.

The case of *Lewis* v. *Marling* (10 B. & C. 22) had been quoted as establishing that doctrine. But the Court there only said that the claim of some part of a machine which turned out to be useless did not vitiate a patent. This is very different from describing a part of a machine as capable of co-operating in the work, when, in fact, it is incapable, even though at the same time other means are described, which might be effectually employed. For the reader of the specification, relying upon it, might use the former in constructing his machine, which would fail of its purpose from being too accurately made according to the patentee's instructions. The rule must, therefore, be absolute for a new trial.

Second trial of the same action. The pleadings were the same as before.

WIGHTMAN, J. directed the jury to find for the Crown on the 10th, 12th, and 13th issues, and said:—'The 3rd and 4th claims raise questions of law, whether what was claimed was a manufacture within the meaning of the statute. Now I entertain a strong opinion on this question, as to whether a mere application can be the subject of a patent; for when once you have got a material you may apply it as you think fit.' Verdict accordingly.

No further proceedings were taken.

CUTLER *against* BOWER, A.D. 1848. 11 Q.B. 973.

Pleading. Demurrer. Estoppel. Consideration for a Licence.

COVENANT on an indenture by which plaintiff covenanted to pay defendant a sum of money for the purchase of one moiety of a patent of 6th *Nov.* 1841, No. 9,140, to J. *Cutler*, for improvements in the tubular flues of steam boilers, the recitals of the deed stating the grant of the patent, and also the grant, by another indenture, of an exclusive licence to defendant to use the same. Defendant pleaded in several pleas that plaintiff was not the first inventor, that the invention was not new, and that the specification was insufficient, and the patent void. Replication: *estoppel*, by the indenture of

licence. General demurrer, and joinder. Judgment for plaintiff by the Court of Queen's Bench.

Per LORD DENMAN, C.J.—Many cases were cited upon the question *estoppel*, but we think it unnecessary to give any opinion on that question, as an objection was taken to the pleas of the defendant, which we think must prevail; and which, consequently, renders any question as to the validity of the replication immaterial.

The defence set up by the pleas is failure of consideration, that of the patent is invalid, and that the defendant is not bound by his covenant to pay the money, which appears by the deed to be the purchase money for a patent which, it is said, turns out to be worthless. But it appears to us that there are two decisive objections to this defence. The first is, that there not having been any eviction, the consideration does not wholly fail. And in the next place, the supposed defence could only be available in case the covenant upon which the action was brought was a dependent covenant, to be performed only if some condition is observed by the other party; but in this case the covenants of the plaintiff relating to the patent, and that of the defendant for payment of the purchase money, are wholly independent of each other; and each party may recover against the other for a breach of their respective covenants. There is no plea of fraud or eviction.

DANGERFIELD *against* JONES, A.D. 1865. 13 L.T. N.S. 142.

Novelty of Invention. Utility essential. Evidence of Infringement.

Suit to restrain from infringing a patent of 5th *March*, 1864, No. 561, to *W. Dangerfield*, for 'an improved mode of and apparatus for bending wood for the handles of walking sticks, umbrellas, and other purposes.'

The specification stated:—'The invention consists principally in a novel mode of applying heat to the wood for the purpose of softening the fibres, and then bending the stick and securing it by a clamp.' It then described the apparatus (by reference to drawings) as being a vice for holding a stick, placed close to a hollow mandril, round which the bending took place. A jet of gas was lighted inside the mandril, the heat of which set the fibres of the wood, so that the bending became permanent. The stick was, in the first instance, softened by moist sand, and was secured *in situ* on the mandril by a strip of steel. *Claim*: 'The application of a flame of gas or other combustible fluid, for softening the fibres of the wood while being bent, in combination with a clamping apparatus for securing the wood until its fibres are set.'

Defendants denied the validity of the patent, and alleged that

they had themselves, before the patent, adopted a mode of bending sticks round a solid mandril by the aid of a strip of steel and a jet of gas, the difference being that the flame played outside the steel band instead of inside the mandril.

Wood, V.C. granted an injunction and account, and said:—When it is stated that, because wood is bent by coachmakers and others in a variety of ways by the application of heat, you cannot have a patent for the application of heat to the bending of walking sticks, that is the same sort of reasoning which was pressed ineffectually upon the Court with reference to an invention for an improvement in navigation. It was said that the operation of a propelling power by presenting a screw surface to the action of water was nothing new, that it was like the action of a windmill with reference to the wind. That reasoning, however, did not succeed. If, having a particular purpose in view, you take the general principles of mechanics, and apply one or other of them to a manufacture to which it has never been before applied, that is a sufficient ground for taking out a patent, provided that the Court sees that that which has been invented is new, desirable, and for the public benefit. A mere trifling matter or a thing of no value will not do, inasmuch as the whole theory of the patent law is based upon the assumption that it is something of real value. You must show that you have invented something useful—a new and useful improvement in manufacture.

Davenport *against* Richard, a.d. 1860. 3 L.T. N.S. 503.

Practice in Patent Suits. Long Enjoyment of Patent.

Suit to restrain from infringing patents of 13th *Nov.* 1851, No. 13,809, to *W. Smith*, *W. Dickinson*, and *T. Peake*, and of 9th *Dec.* 1856, No. 2,916, to *T. Peake*, for improvements in the manufacture of chenille. It appeared that the patentees were the first to manufacture chenille by machinery. The first patent was assigned to plaintiff on 2nd *June*, 1852, and the assignment was not registered. An objection that the title was incomplete was overruled, stat. 15 & 16 Vict. cap. 83, sect. 35, not taking effect until 1st *Oct.* 1852. Wood, V.C. granted an injunction, with order for an action at law, and said that wherever there was reasonable *primâ facie* case of infringement, the length of time for which the patentees had had the exclusive enjoyment of the invention, as in the present case for nine years, influenced the Court in granting an injunction. The specifications, as he conceived, were sufficiently precise, but that was a question of law which would be open for consideration hereafter.

DAVENPORT *against* JEPSON, A.D. 1862. 1 N.R. 173; 307.

Practice in Patent Suits. Injunction. Inspection.

Suit to restrain from infringing the patent of 1851, No. 13,809. Injunction granted by WOOD, V.C. On appeal, order affirmed.

Per KNIGHT BRUCE, L.J.—Though the motion before the Vice-Chancellor was only an interlocutory application, yet it was impossible to forget the recent Act of Parliament (25 & 26 Vict. cap. 42) prohibiting this Court from sending cases to be tried by a Court of Common Law, and consequently the defendant was entitled to have the question of the validity of the patent raised, even on this interlocutory motion. After an analysis of the evidence his Lordship said that, in his opinion, there was a valid patent which had been infringed, and that there was a case for an injunction.

Per TURNER, L.J.—After much consideration I have arrived at the conclusion that the Act (25 & 26 Vict. cap. 42) has not deprived this Court of any of its powers. It simply declares that this Court should not send away any case to be tried elsewhere. The powers of this Court are not limited by the Act, nor its procedure affected, yet to say that to grant injunctions on interlocutory motions in patent cases was no longer right, was to limit the powers of this Court and to alter its procedure.

The order made by WOOD, V.C. on motion in this cause is extracted *verbatim* in 1 N.R. 307, and provides, *inter alia*, for the mutual inspection of machinery by plaintiff and defendant.

DAVENPORT *against* GOLDBERG, A.D. 1865. 2 H. & M. 282.

Practice in granting issues in Patent Suits. Long Enjoyment of Patent.

Suit to restrain from infringing the same patent. It appeared that in 1860 plaintiffs filed a bill against a person named *Richard* for infringing their patent. An action at law was ordered, and plaintiffs were nonsuited by Hill, J. on the ground that the specification was insufficient; the nonsuit was set aside by the Court of Queen's Bench, and plaintiffs signed judgment and obtained a decree. Afterwards, in 1862, plaintiffs filed a bill against *Jepson*, when a decree was made for a perpetual injunction. In the present suit, defendant put in issue everything which had been contested in *Davenport* v. *Jepson*. On motion for a special jury to determine certain disputed questions of fact, WOOD, V.C. refused to grant issues on the questions of novelty and invention, but put the plaintiffs to prove the infringement before a jury, and said:—

No person is entitled to come here and say, 'I raise such and such a question and ask for a jury *ex debito justitiæ*,' although there

are certain classes of cases in which the course of the Court is, if the matter be new, not to decide important disputed questions of fact without the assistance of a verdict. On the question of infringement, I must take it that there is such a *bonâ fide* contest of fact on that point that I ought to send that question to a jury if the defendant desire it.

The case is reduced to this: that the plaintiffs have had thirteen years' user of this patent, twice disputed, and their right in each case established—once at law, and once in this Court. In what position would a patentee be placed if he is to try his right *ab initio* against every separate infringer *in infinitum*? That certainly is a view of his rights which has never been adopted by this Court. If the defendant thinks he can get rid of the patent, he had better proceed by *scire facias* to repeal or annul it: if he does not choose to take that course, but simply disregards it and stands on his defence, I must take the validity of the patent as already sufficiently established against him.

DAVENPORT *against* RYLANDS, A.D. 1865. L.R. 1 Eq. 302.

Practice in Patent Suits. Damages. Full Costs.

Suit to restrain from infringing the same patent. The bill sought an injunction, an account of all *chenille* manufactured by plaintiff's process without license, and an inquiry as to damages. It appeared that the bill was filed on 8th *Nov.* 1864, and that the patent expired on 13th *Nov.* 1865, before the hearing. WOOD, V.C. granted an injunction, and inquiry as to damages, and said:—'I was somewhat impressed with the notion that in order to award damages at the hearing, the Court must have jurisdiction to grant an injunction. But I think that would be a narrow construction to put upon this beneficial Act (21 & 22 Vict. cap. 27). I think the sound view of the whole case is, that I ought to exercise the jurisdiction granted to me by the Act, that I ought to consider myself as having had jurisdiction at the time the bill was filed, for the purpose of ultimately giving relief pursuant to the Act, and therefore I shall direct an inquiry as to what damage the plaintiff has sustained; and I shall give the plaintiff the costs up to the hearing.'

Application was then made for costs as between solicitor and client under stat. 15 & 16 Vict. cap. 83, sect. 43, which was opposed on the ground that the validity of the patent had not been in issue. WOOD, V.C. granted the application, and said:—'The statute provides that the plaintiff shall have his full costs, unless the judge shall certify that he ought not. There are many circumstances under which it might be improper that the plaintiff should have costs.

The judge may think the first action to have been collusive, or he may think the case an improper one. Many instances may be suggested; but the object of the enactment was to prevent patentees being put under the necessity of bringing repeated actions to determine their rights after the principle has been once established.'

DAW *against* ELEY, A.D. 1865. 2 H. & M. 725; L.R. 1 Eq. 38; L.R. 3 Eq. 496.

Discovery. Admissibility of Evidence under Notice of Objections. Breach of Injunction. French and English Patents for the same Invention.

Suit to restrain from infringing a patent of 4th *Sept.* 1861, No. 2,203, to *F. E. Schneider*, for 'improvements in cartridges for breech-loading fire-arms, and in the machinery for manufacturing the same.' The bill interrogated defendants, requiring:—5. A description of all machines similar to plaintiff's made or used for six years before the date of the patent. 6. Asking for the names and addresses of all persons to whom they had sold breech-loading cartridges since 1st *Jan.* 1855, together with prices. 8. Requiring a statement of the size of the wire used in making their breech-loading cartridges, with the names of the persons from whom and the places from which they had purchased such wire, from *Jan.* 1855, to the present time. Defendants denied the novelty of the invention, and set forth that they had used a machine somewhat similar to that specified, but had discontinued the user before the date of the patent. They submitted that they were not bound to answer the interrogatories. Plaintiff excepted to the answer, but WOOD, V.C. over-ruled all the exceptions, with costs, and said:—'Is the defendant in a patent case obliged to set out all the machines he has used before the date of the patent? The discovery is either wholly immaterial to the issue or else it is a defence for want of novelty. Are you entitled to ask them the names of the witnesses whom they intend to produce to establish their case? There is no valid distinction between that question and the interrogatory which has not been answered in this case. The 8th interrogatory is out of all rule. The plaintiff has no right to inquire into the defendants' case with intent merely to get at an answer to the question, "How are you prepared to prove your case?"'

(L.R. 1 Eq. 38.) At the hearing defendants tendered evidence of prior user not specified in the particulars of objection, the excuse being that such evidence had not come to their knowledge until after the cause was in the paper. WOOD, V.C. refused to admit the evidence, and said:—'The statute is plain, and the objection to its admission is substantial and not merely technical. I cannot

conceive any more beneficial enactment than that contained in stat. 15 & 16 Vict. cap. 83, sect. 41, which directs that the place and the manner of the alleged prior user must be stated in the particulars of objections on which the defendant means to rely at the trial, but goes on to provide that, although it cannot be done in the course of the trial, it shall be competent for a judge at Chambers to allow the particulars to be amended on such terms as he shall think fit. In *Renard* v. *Levinstein* (13 W.R. 229) I gave the defendant leave, on payment of the costs occasioned by the application, to amend his particulars of objection, as the lesser of the two evils, being of opinion that I might do the plaintiffs themselves considerable injury if I were to refuse the application to amend, and thus occasion the expense and inconvenience of an application for a new trial. All I can do now is to shut out this evidence, leaving the defendants to make such application as they may be advised.'

(L.R. 3 Eq. 496.) The report carries on the history of the proceedings in this suit.

The patent related, *inter alia*, to the formation of a cartridge having a recess or chamber at the rear end for the reception of a percussion-cap. The cap was filled up with an anvil, formed of a short length of grooved wire, and was fired by the blow of a hammer. The anvil was supported by the base of the recess sufficiently for the ignition of the detonating charge, and the flame passed along the grooved sides of the anvil, and entered the body of the cartridge through an opening in the base of the recess. The drawings annexed to the specification showed a percussion-cap having an anvil with four grooves placed inside it, and showed also the construction of a cartridge with the chamber for the reception of the cap. The specification stated:—'It is not essential that the anvil should be cylindrical, or that it should have four longitudinal cuts or grooves formed in it, as shown, as it may be formed of other transverse sections, so long as it is made to fill as nearly as may be the cap, and has cuts or grooves formed in it.' *Claim*: 1. The manufacture of cartridges described with reference to figs. 3, 4, &c. (distinguishing the figures).

It appeared that in 1855 a central-fire cartridge was invented by one *Pottet*, a *Frenchman*, but was not patented in this country. *Pottet's* anvil consisted of a thin plate of metal placed inside a percussion-cap received into a recess at the base of the cartridge.

The case came on for hearing in *Nov.* 1865, when BACON, V.C. was of opinion that plaintiff's patent was not invalidated by reason of *Pottet's* invention, and gave judgment for plaintiff. The decree for an injunction was drawn up on 27th *Jan.* 1866.

About this date proceedings were instituted in *France* by defendants for the purpose of annulling a *French* patent of *Feb.* 1858, granted to *F. E. Schneider*, for central-fire cartridges, and upon which invention the *English* patent was founded. In *Feb.* 1866, *Schneider's* patent of 1858 was annulled by the tribunals in *Paris*, and in *June*, 1866, an appeal from this decision was dismissed by the Superior Court.

On 24th *March*, 1866, a patent for improvements in central-fire breech-loading cartridges was granted to *W. T. Eley* (No. 880). The specification stated:—'This invention relates to improvements in central-fire breech-loading cartridges, according to which an anvil is placed in the percussion-cap of the cartridge in *two or more* parts, by means of which the flame from the percussion powder passes between the several parts of the anvil, as well as round the sides, before escaping through the hole in the centre of the chamber.' The drawing showed an anvil formed of two thin strips of metal with pointed ends, placed in juxtaposition within the cap. The backs of the strips, which were in contact, were somewhat rounded, and there was abundant passage for the flame of the detonating powder.

Plaintiff now moved to commit defendants for a breach of the injunction of 1866. Defendants put in evidence an official copy of the judgment of *déchéance* of the *French* patent in 1866, and the judgment of rejection of appeal by the Superior Court. Motion refused, with costs.

Per Wood, V.C.—The *French* patent of *Schneider*, and all rights under it, are gone, and if it is identical with the *English* patent, it follows, as a necessary result, that the *English* patent is gone also. It comes, then, simply to the consideration of the two patents. Because certain parts of the *English* patent are identical with the *French* patent, it does not follow, as a necessary result, under stat. 15 & 16 Vict. cap. 83, sect. 25, that, when the *French* patent is determined, the rest of the *English* patent which is not identical is void also. The effect of that section is to strike out of the *English* patent that which, up to a certain time, the foreign patent has covered, but ceases any longer to cover. Now, upon the question of identity, I have no doubt. No difference can possibly be drawn between the two things. That being so, it does appear to me that the injunction terminates here from the moment that the *French* Court decides that the *French* patent has come to an end.

It is of comparatively little importance for me to consider whether or not there has been an actual infringement by the defendants. As in *Seed* v. *Higgins* (8 H.L. Ca. 550), where the

plaintiff was confined very narrowly to his exact specification, in consequence of the anterior invention of another; so here *Schneider*, in consequence of *Pottet's* previous discovery, must be confined to very narrow limits, viz., that of securing the anvil by the particular mode in which he has described it. The defendants have now taken *Pottet's* anvil and doubled it, and in doing so they have not pursued the plaintiff's course of action, but have deliberately rejected it. It appears to me that they have hit on a process by which they arrive at the same result without bringing themselves within those narrow limits to which the plaintiff must be confined. Upon the special merits, infringement or no infringement, this is not a case in which I ought to commit, or make an order equivalent to committal, by making the defendants pay the costs of this motion.

DE LA RUE and OTHERS *against* DICKENSON and OTHERS, A.D. 1857. 7 E. & B. 738; 3 K. & J. 388.

Evidence of Infringement. Subject-matter of a Patent. Sufficiency of Specification. Practice in Patent Suits. Discovery.

Suit to restrain from infringing certain patents, viz., of 17th *March*, 1845, No. 10,565, to *E. Hill* and *W. De la Rue*, and of 19th *Dec.* 1849, No. 12,904, to *W. De la Rue*, for 'improvements in the manufacture of envelopes.' Action at law in pursuance of order of the Court. Pleas: 1. Not guilty. And as to first patent: 4. That the invention was not the subject-matter of a patent. 5. That the specification was insufficient. And like pleas as to second patent. Issue.

The specification of the first patent stated the invention to consist:—(1) In improved machinery for cutting paper for the making of envelopes; (2) in arranging machinery for folding over the flaps of envelopes; and it described the folding machine (about which the contest arose) by reference to drawings. The envelope, or *blank*, was first creased by being pressed by means of a plunger into a hollow box, the platform at the bottom of which was lifted or depressed, as required. The specification stated that thus far the general character of the machine was not new. On the sides of the box were four folder flaps, shaped like the flaps of the envelope, but somewhat smaller in size. The plunger was so arranged that two opposite sides moved out of the way after the creasing, and allowed the folders to press down and fold two of the flaps; the same thing was then done with the two remaining sides of the plunger and the corresponding flaps, and the operation was complete. The folders came down in succession, each being moved somewhat in advance of its neighbour, so as to imitate the folding of an envelope by hand. *Claim*: 'The so arranging

machinery that the flaps of envelopes may be folded thereby as described.'

The specification of the second patent described one part of the invention as consisting in apparatus for applying to the flaps of an envelope the gum or cement necessary for causing three of the four flaps of the envelope to adhere together. The apparatus consisted of an endless revolving apron mounted on rollers, and running in one part of its course below the surface of some liquid gum in a reservoir. The apron was thus wetted with gum, and an instrument, having projecting surfaces of the size and shape of the parts of the flaps requiring to be gummed, dropped upon the apron, took away some gum, and transferred it to the envelope. *Claim*: 'The application of gum or cement to the flaps of envelopes by apparatus acting in the manner of surface printing, in contradistinction to the application of gum or cement direct from a fountain.'

At the trial, it appeared that the alleged infringement consisted in folding and gumming envelopes according to a patent of 28th *Feb.* 1849, No. 12,493, to *A. F. Rémond.* It appeared that defendants' plunger was furnished with four inclined planes, placed underneath its edges at different angles to the horizon. As soon as the plunger had creased the envelopes it was raised up, and four jets of air blew the flaps inward; the plunger now descended, and the inclined planes acted successively on each flap in the right order, so as to complete the folding, after which the envelope was discharged from the bottom of the box instead of from the top, as in plaintiffs' machine. As to the gumming, the case was, that defendants used an instrument with projecting surfaces, corresponding to the parts of the envelope requiring to be gummed, but they dipped the same directly into liquid gum, instead of deriving the supply from the surface of an apron. LORD CAMPBELL, C.J. directed the jury:—That there might be an infringement of the first patent by an apparatus for folding the flaps of envelopes, although the paper was not held down during the operation. Also, that a mode of applying gum to the flaps of envelopes after the manner of surface printing might be an infringement of the second patent, although the printing instrument took the gum directly from the reservoir. His Lordship also ruled that the questions of infringement were for the jury; and that there was sufficient evidence to go to the jury. The jury stated that, in their opinion, the folding machine and gumming apparatus of defendants were imitations of plaintiffs' two inventions. Verdict for plaintiffs. Leave reserved.

Rule nisi for a new trial discharged by the Court of Queen's Bench. (Lord Campbell, C.J., Coleridge, Erle, JJ.)

Per LORD CAMPBELL, C.J.—After carefully considering the specifications, we think that the claim in each is for described means of conducting a useful process, resulting in a valuable manufacture; and that the specification shows distinctly what portions of those means are claimed as new, and what portions are allowed to be old.

The defendants contend that the judge, at the close of the plaintiffs' case, ought to have determined by his own authority that there had been no infringement. We consider, however, that the doctrine contended for is contrary to principle, would render it impossible to administer the law of patents, and is by no means to be deduced from *Unwin* v. *Heath* (5 H.L. Ca. 505), or any of the other decisions referred to. There may well be a case where the judge may and ought to take upon himself to say that the plaintiff has offered no evidence to be left to the jury to prove infringement, as if there were a patent for a chemical composition, and the evidence was that the defendant had constructed and used a machine for combing wool. But if the evidence has a tendency to show that the defendant has used substantially the same means to obtain the same result as specified by the plaintiff, and scientific witnesses have sworn that the defendant actually has used such means, the question becomes one of fact, or of fact mixed with law, which the judge is bound to submit to the jury. There can be no doubt that such evidence was adduced by the plaintiffs.

The defendants, therefore, are confined to the contention that the verdict was against the evidence. The plaintiffs fold the flaps in succession by folding instruments most ingeniously actuated by cams. The defendants likewise use folding instruments, inserted in the inverted box of the plunger; and the stroke of the descending plunger, making these folding instruments, called projections, touch the different flaps in succession, folds them finally in the same manner, although not in the same order. Whether the two modes of folding by the cams and the plunger be essentially different or substantially the same, we think was a pure question of fact for the jury, and we cannot say that the jury were wrong in the conclusion at which they arrived. The folding being a material part of the plaintiffs' process of manufacturing envelopes, it is not necessary to determine whether their claim extended to the rest of the process: but we would observe that, generally speaking, as the manufacture which is the result of the process invented and patented is the ultimate object in view, the purpose of the patent laws is to protect all that is new in this process, if it be described, although not expressly claimed.

With respect to the patent of 1849, for gumming the envelopes, the jury expressed a clear opinion that the defendants' was a colourable imitation of the plaintiffs', and we think that this conclusion was fully warranted by the evidence. We are of opinion that the defendants might be guilty of infringement without using an intermediary surface, and that, without what is strictly called 'surface printing,' they might apply gum to the flaps of envelopes by operations acting *in the manner of surface printing*, in contradistinction to the application of gum direct from a fountain containing the gum.

(3 K. & J. 388.) While the action was pending defendants put in an answer to plaintiffs' interrogatories, which sought for an account of all envelopes and envelope-making machines in defendants' possession, as well as discovery as to the purchase or hire of such machines, and as to the stock of envelopes made therewith. Defendants admitted the possession and use of such machines, but denied infringement, and submitted that they were not bound to answer further. Exceptions were taken to the answer, but WOOD, V.C. ordered them to stand over till the hearing, and said:—'The rule on which the plaintiffs rely, that a defendant electing to answer must answer fully, is no doubt a rule sufficiently well-established. In a patent case, if the plaintiff once establishes the fact of an infringement, his right to a decree involving full discovery of all matters of the nature of those here inquired after is clear; everything therefore showing, or merely tending to show, the fact of infringement, must, of course, be set forth in the answer, to the full extent of the interrogatories. But here all the discovery required by the interrogatories in question *assumes* the fact of infringement, and will be obtained under the decree at the hearing, as a matter of course, provided the fact of infringement be then established. While, on the other hand, if the fact be not established at the hearing, the whole of the discovery required will be utterly immaterial.'

DEROSNE *against* FAIRIE, A.D. 1835. 5 Tyr. 393; 2 Cr. M. & R. 476; 1 Webs. Pat. Ca. 154.

Sufficiency of Specification. Title of Patent.

CASE for the infringement of a patent of 29th *Sept.* 1830, No. 6,002, to *C. Derosne*, for 'improvements in extracting sugar and syrups from cane juice and other substances containing sugar, and in refining sugar and syrups.' Pleas: 3. That the specification was insufficient. 4. That no specification was enrolled. Issue.

The patent related to a process for freeing syrup of sugar from colouring matter by filtration through charcoal. The specification

stated:—'The invention consists in a means of *discolouring* syrups of every description, by means of charcoal produced by the distillation of *bituminous schistus* alone, or mixed with animal charcoal, or even of animal charcoal alone.' It then described the operation, and the precautions to be observed. It further referred to juices or liquids '*which had been baked* for extracting the sugar,' and concluded by stating:—'The carbonisation of bituminous schistus has nothing particular; it is produced in closed vessels, as is done for producing animal charcoal, only it is convenient before the carbonization to separate from the bituminous schistus the sulphurets of iron which are mixed with it.'

At the trial, it was admitted that the patentee, who was a foreigner, had incorrectly used the word 'baked,' when he should have said 'before crystallisation'—*i.e.* before the process was completed. He had also used the word 'discolour' in the sense of depriving of colour—'*decolorer*.' But the objections raised on these grounds were not pressed. It was not, however, made clear upon the evidence whether bituminous schistus was or was not capable of being purified from the sulphurets of iron with which it was admixed, so as not to impart colour to the solution. LORD ABINGER, C.B. directed the jury to find for plaintiff or defendant according as they were of opinion that the description of bituminous schistus was sufficient or insufficient, so that all the world could or could not use it. Verdict for plaintiff. Leave reserved.

Rule nisi to enter a nonsuit, on the grounds, (1) of a variance between the title and specification (the title being for extracting and refining sugar, and the specification referring only to the removal of the colour); (2) that the specification was insufficient. Rule made absolute by the Court of Exchequer for a new trial on the second ground of objection. (Lord Abinger, C.B., Parke, Bolland, Alderson, BB.)

Per LORD ABINGER, C.B.—One objection to the plaintiff's specification is rested on the ground that it does not set forth that double process which one would expect from the title of the patent. We do not think that the question necessarily arises at present, or that it calls for an ultimate decision, because we think, on consideration, that the double process or both the branches of the invention mentioned in the patent are sufficiently described in the specification. The word 'improvements' was relied on as being in the plural number, but that is of no consequence, because the plaintiff may mean every part of his process to be treated as an improvement, forming together a series.

Upon the main point, however, that respecting the bituminous

schistus, nothing that I have heard has removed my original impression that there was no evidence to show that this process, carried on with bituminous schistus in combination with any iron whatsoever, would answer at all. The plaintiff has himself declared that in that bituminous schistus which he himself furnished, the whole iron was extracted, and it appears that it was admitted by counsel that the presence of iron would not only be disadvantageous but injurious. I am therefore of opinion that, without considering whether or not the patent would be avoided by the patentee's keeping secret the means requisite to extract the iron from the bituminous schistus, he has not shown in this case that what he has described in the patent could be used as so described, without injury to the matter going through the process.

Under all the circumstances we think 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 this process with advantage; and as he has not done that, the defendant is entitled to a nonsuit; but at the same time, as it is alleged that the plaintiff may, on a new trial, supply the defect of proof as to the schistus by other evidence, we are desirous that the patent, if a good one, should not be affected by our judgment, and think it right to direct a new trial.

Per ALDERSON, B. — A specification must state one or more methods which can be followed, for the purpose of accomplishing and carrying into effect the invention. One of the methods stated in this case is the application of a filter, composed of charcoal, formed by the distillation or carbonisation of bituminous schistus. It must, therefore, be shown that the purpose will be accomplished by following that method. Certainly if any admission was made that the presence of iron would be a detriment to the operation, without confining that admission to its being a less perfect mode of exhibiting the experiment than would otherwise be the case, that undoubtedly would be a ground for a nonsuit.

DIXON *against* THE LONDON SMALL ARMS COMPANY, A.D. 1875.
L.R. 10 Q.B. 130.

Infringement by Sale for the Public Service. Rights of the Crown.

CASE for the infringement of several patents relating to the manufacture of rifled fire-arms. Referred to an arbitrator, who stated a case for the opinion of the Court of Queen's Bench. It appeared that plaintiff was managing director of a company engaged in the manufacture of the *Martini-Henry* rifle under certain patents. Defendants were also engaged in manufacturing fire-arms, and they

tendered for the supply, for the public service, of several thousand *Martini-Henry* rifles, upon terms (*inter alia*) that the contractors should be protected by the War Department against patentees in the manufacture of the arms to be contracted for. This tender was accepted by the Secretary of State for War, and the rifles were made and delivered accordingly. It was conceded that such manufacture and sale would have infringed the plaintiff's patent rights had the rifles been consigned otherwise than for the use of the Crown. The question raised, was whether plaintiff was entitled to recover against defendants for the infringement. Judgment for plaintiff by the Court of Queen's Bench. (Cockburn, C.J., Mellor, Lush, Archibald, JJ.)

Per COCKBURN, C.J.—The Crown is not before the Court, as was the case in *Feather* v. *The Queen* (6 B. & S. 257). This is a case in which subject and subject are before the Court as litigants. One subject complains of his right having been invaded, which the other most undoubtedly has invaded, unless it has been done by a lawful command of the Crown. It is said that this is a matter which the Crown has power to authorise. That might be the case if the party manufacturing the article were the servant or the immediate agent of the Crown, and not an independent contractor; but here the defendants are independent of the Crown, they are not called upon to enter into this contract if they do not please, it is their own act and at their own option; and on these grounds I think they ought to pay the patentee compensation for the use of his invention.

Per MELLOR, J.—I was party to the judgment in *Feather* v. *The Queen*, and I may say that no member of the Court ever contemplated the extension of that doctrine beyond the limit there laid down.

Per LUSH, J.—The claim set up by the defendants is a right to infringe a patent and manufacture the patented article for their own profit, in order to enable them to sell the article when so manufactured to the Government. That is, I think, beyond the scope of the privilege which the Crown enjoys.

Per ARCHIBALD, J.—These are proceedings against a company who infringe the plaintiff's patent right, in order to carry out the contract to supply and deliver these rifles to the Crown. It is said that a part of the contract is, that they are to be supplied on the terms that the defendants are to be protected against the patentee. I do not myself consider that the indemnity is a part of the contract which is referred to in the special case; but even if it were, it would make no difference. No doubt if this contract stipulated that these persons were to be employed as servants of the Crown at a salary or wages, just as

if they were in the workshop of the Crown, that would be a different case. The rifles then would be manufactured by the Crown, and there would be a substantial difference between such a contract and the present; for this contract might have been performed by supplying articles manufactured long before the date of the contract. I do not think this case falls within the principle of *Feather* v. *The Queen*.

DOBBS *against* PENN, A.D. 1849. 3 EX. R. 427.

Novelty of Invention. Subject-matter of a Patent.

CASE for the infringement of a patent of 30th *June*, 1838, No. 7,716, to *W. Dobbs*, for 'improvements in the construction of racks and pulleys for window blinds.' Pleas: 1. That plaintiff was not the true and first inventor. 2. That the invention was not new. 3. That it was not the working of any manner of manufacture. Issue.

The patent related to a method of adjusting the tension pulley of a roller window blind by means of a screw clamp capable of sliding along a so-called *box* or *case*, which was, in fact, a slit tube. The specification described the contrivance by reference to drawings, and also the method of forming the slit tube by drawing a strip of thin metal through the hollow frustum of a cone, and afterwards through a draw-plate. *Claim*: 'The making such boxes or cases by means of drawing strips of thin metal through a cone and through a draw-plate, and the *adaptation* of tubes so made as boxes or cases for the slides of bell-pulls and other useful purposes; and further, the contrivance for fixing the stud of the pulley by means of a clamp and screw as above described.'

At the trial, defendant gave in evidence the specification of a patent of 15th *Jan.* 1810, No. 3,293, to *T. Bayley*, for the application of a screw (instead of a rack and spring) to the moveable slide in sliding pulleys for window blinds, closely resembling that of plaintiff, and consisting of a grooved frame, having a slide inside the groove, with a small covering plate, called an *escutcheon*, outside, the two pieces being clamped to the frame by a screw carrying on its spindle the tension pulley of the window blind. The specification stated:—'I sometimes make my sliding pulleys without an *escutcheon*.'

An objection was raised that the application of drawn metal tubes to the 'cases' of window blinds and other useful purposes was not subject of a patent. PATTESON, J. left the case to the jury.

Verdict for plaintiff.

Rule nisi for a new trial made absolute by the Court of Exchequer.

Per PARKE, B.—Two objections were made by my brother

Tulfourd; one was, that the mode of making the slides of drawn metal could not be the subject of a patent, on which it is unnecessary for us to say anything; for the other, which was that part of the alleged invention was not new, is, we think, insuperable.

If the escutcheon be absent, the invention of *Bayley* differs from the plaintiff's in no one respect, except in the mode of attaching the screw to the slide by means of a nut, which is quite immaterial. We think there must be a new trial, as the part of the invention which relates to the screw is not new.

DOLLOND *against* ——, A.D. 1776. Cited 2 H. Bl. 470, 487; 1 Parl. Rep. 182; 1 Webs. Pat. Ca. 43.

First Publisher of an Invention.

CASE for the infringement of a patent of 19th *April*, 1758, No. 721, to *J. Dollond*, for 'a new method of making the object-glasses of refracting telescopes.' The patent related to the construction of an achromatic object-glass, formed by the union of lenses of crown and flint glass respectively; whereof the crown glass lens was convex, the flint glass lens concave. The refractive power of the crown lens exceeded that of the flint lens, but its dispersive power (called *refrangibility*) was less. The specification stated:—'There remains a difference of refraction by which the image is formed, without any difference of refrangibility to disturb the vision.'

At the trial, it was proved that one Dr. *Hall* had made such glasses in 1720, but had not disclosed the secret. The patent was supported.

(2 H. Bl. 470.) In referring to this case BULLER, J. said:—'The objection to *Dollond's* patent was that he was not the inventor of the new method of making object-glasses, but that Dr. *Hall* had made the same discovery before him. But it was holden 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.'

DUDGEON *against* THOMSON, A.D. 1874. 30 L.T. N.S. 244.

Practice in Suits where the Enjoyment of Patent has been undisturbed.

Suit to restrain from infringing a patent of 7th *March*, 1866, No. 699, to *G. T. Bousfield* (a communication from abroad by *R. Dudgeon*), for 'an apparatus used in expanding boiler tubes.'

It appeared that in 1873 plaintiff obtained the affirmation by the Court of Session in *Scotland* of an interdict restraining defendant (who was proprietor of a like patent of later date) from using the patented invention. The question of novelty was not raised in these proceedings. JESSEL, M.R. granted an injunction until the hearing

of the cause, and said :—'The Court can 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 the defendant himself, there is no reason to doubt the validity of the patent. I shall grant the injunction asked for on all these grounds. The patent is *eight* years old, as old as the patent in *Betts* v. *Menzies* (3 Jur. N.S. 357), where it was said that where the patentee has had long enjoyment he shall have an injunction to protect his rights until trial, even although his rights under his patent be doubtful. It has been urged that the question of novelty was not raised in *Scotland*, or was not decided, but that must have been because a plea of want of novelty was not put in; or, if put in, was waived. I cannot regard the decision of the Court of Session on a patent for the *United Kingdom* as the decision of a foreign Court. Besides, the defendant *Thomson* was not in the ordinary position of an infringer asserting want of novelty, for he was the proprietor of a subsequent patent, which has been decided to be an infringement of the plaintiff's patent, and so is in a worse position than an ordinary defendant who might have acted ignorantly.'

DUNNICLIFF and BAGLEY *against* MALLET, A.D. 1860. 7 C.B. N.S. 209.

Validity of Assignment of part of a Patent.

CASE for the infringement of a patent of 11th *June*, 1850, No. 13,122, to *J. D. Dunnicliff* and *J. W. Bagley*, for 'improvements in lace and other weavings.' The declaration recited the grant of the patent, and certain indentures of assignment whereby the interest in one portion of the patent became wholly vested in plaintiffs. Plea in abatement: Non-joinder of other parties jointly interested with plaintiffs in a distinct portion of the patent. Judgment for plaintiffs by the Court of Common Pleas. (Erle, C.J., Crowder, Byles, JJ.)

Per ERLE, C.J.—The main question is, whether an assignment of part of a patent is valid. I incline to think that it is. It is every day's practice for the sake of economy to include in one patent several things which are in their nature perfectly distinct and severable. It is also every day's practice by disclaimer to get rid of part of a patent which turns out to be old. Being, therefore, inclined to think that a patent, severable in its nature, may be severed by the assignment of a part, I see no reason for holding that the assignee of a separate part which is the subject of infringement may not maintain an action.

Per CROWDER, J.—I see no reason to doubt that an assignment of a separate and distinct part of a patent is valid. No authority has been cited to the contrary, and in practice these assignments are common.

EDGEBERRY *against* STEPHENS. 2 Salk. 447.

First Importer of an Invention.

'A grant of a monopoly may be to the first inventor by the 21 Jac. I.; and if the invention be new in *England*, a patent may be granted, though the thing was practised beyond the sea before; for the statute speaks of new manufactures within this realm; so that if they be new here, it is within the statute; for the Act intended to encourage new devices useful to the kingdom, and whether learned by travel or study, it is the same thing. Agreed by Holt and Pollexfen.'

THE ELECTRIC TELEGRAPH COMPANY *against* NOTT, A.D. 1846–7. } 11 Jur. 273; 2 Coop. Ch. Ca. 41; 4 C.B. 462. }

Practice in Patent Suits. · Injunction. Considerations which guide the Court. Particulars of Infringement.

Suit to restrain from infringing three several patents—viz., of 12th *June*, 1837, No. 7,390; of 21st *Jan.* 1840, No. 8,345, to *W. F. Cooke* and *C. Wheatstone*, each, in substance, for improvements in giving signals at distant places by means of electric currents; and of 8th *Sept.* 1842, No. 9,465, to *W. F. Cooke*, for a like invention. Injunction refused, with leave to bring an action at law. On appeal to the Lord Chancellor, order affirmed.

Per LORD COTTENHAM, L.C.—I have not departed from the principles laid down by any of my predecessors, that where the application to the Court is to protect and assist a legal right, it becomes the Court to be extremely cautious in administering its equitable jurisdiction by way of injunction; and that such caution is requisite for two reasons; first, because if the legal right ultimately fail, or if the acts complained of turn out to be no violation of the legal right, the Court then has interfered without any authority whatever, the authority being merely derivative from the legal right, and in aid and protection of it; secondly, and principally, because in this Court there is no comparison between the evil of an error in refusing an injunction, and the evil of an error in granting an injunction.

The doctrine as to the Court declining to interfere in general, until the legal right is established, is open to one exception. The exception is this: that where a patent has existed for some time,

and there has, during this time, been a user under the patent, it is an assertion of a title against all the world. If, during this time, the patent has been exclusively enjoyed, it is strong corroborative evidence of the validity of the patent. The Court has in such case assumed the validity of the patent. The Court has acted as if the patent were valid, supposing that there was nothing else in question but the validity of the patent—no question of infringement. The Court has given so much sanction to the right asserted by the patent as to aid and protect it, till the patent be proved to be invalid.

Three separate actions at law were then brought, one on each patent. It appeared that the alleged infringement consisted in the use of an apparatus combining the several inventions.

Rule nisi for particulars in writing of the alleged infringements discharged by the Court of Common Pleas. Costs to be costs in the cause.

Per WILDE, C.J.—It may be impossible for the plaintiffs to point out which of the several heads of invention they charge the defendant with having imitated; it may be that the invention consists in the combination only. Seeing, therefore, that that which is required must necessarily very much embarrass the plaintiffs, and not being satisfied that there is any probability of surprise on the defendant for want of it, or that they do not possess an adequate amount of information on the subject, though I entertain no doubt as to the power of the Court to grant it, I am of opinion that this is, at all events, not a case for the exercise of that power.

THE ELECTRIC TELEGRAPH COMPANY *against* BRETT and LITTLE,
A.D. 1851. 10 C.B. 838.

Evidence of Infringement. Limitation by Title of Patent. Construction of Specification. Infringement by pirating part of an Invention. Subject-matter of a Patent.

CASE for the infringement of a patent of 12th *June*, 1837, No. 7,390, to *W. F. Cooke* and *C. Wheatstone*, for 'improvements in giving signals and sounding alarums in distant places by means of electric currents transmitted through *metallic circuits*.'

The declaration recited the patent, and certain indentures of assignment of the same to plaintiffs, and alleged that defendants had used and counterfeited the invention. Pleas: 1. Not guilty. 12. That the invention was not a new manufacture within the statute. 14. That it was not an improvement in giving signals through *metallic circuits*. And other pleas putting in issue the title of plaintiffs. Issue.

The patent related to the so-called *Five-needle* Telegraph appa-

ratus, which was tried on the *Great Western Railway*, but was speedily abandoned, and gave place to other systems founded upon it. The specification described the apparatus by reference to drawings, and showed it to consist of five galvanometer needles, mounted on horizontal axes upon a board, and having twenty letters of the alphabet arranged thereon in a lozenge-shaped figure. The needles were caused to deflect either to the right or left, *between stops*, by the agency of electric currents, which were directed by suitable keys, and the convergence of any pair of needles upon a letter indicated that such letter was being signalled. The method of arranging the conducting wires, batteries, and recording apparatus was explained, and was substantially that which has existed ever since. The apparatus required six separate conducting wires, viz., one for each of the five needles, and a sixth, or *return wire*, to bring the current back to the primary station. The specification stated:—'That, if required, duplicates of the same apparatus were to be provided at any intermediate places between the two termini, where simultaneous and like signals were required to be given.' It then described the arrangement of the conducting wires, and stated that the apparatus before the operator, as well as the duplicates at the distant and intermediate places, would all exhibit the same signals at the same time.

Claims: 1. 'We wish it to be understood that we make no claim to the application of the multiplying coils of conducting wires herein described (meaning thereby the galvanometer coils and magnetic needles), but the improvement in 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 direction for pointing out on a vertical dial the signification of the signals.' 2. (In substance.) The combining several needles so as to give siguals by determinate angular motions. 5. (In substance.) The improvement whereby the complete apparatus for giving signals and sounding alarums, as described, may have duplicates of such apparatus at intermediate places between the two ends, all such duplicates operating simultaneously with each other.

At the trial, it appeared that the alleged infringement consisted in working under a patent of 11th *Feb.* 1847, No. 11,576, to *A. Brett* and *C. Little*, for improvements in electric telegraphs. In defendants' apparatus, a light divided ring magnet was suspended on a fine centre parallel to a flat reel of coiled conducting wire, and was made to swing a little either to the right or left by electric currents, pro-

perly directed, and passing through the coil. In the act of swinging, the ring pushed indicating needles, centred on pivots, also to the right or left, and produced a result resembling that given by an ordinary galvanometer coil and needle. The signals consisted in combinations of movements of the indicating needles, to the right or left, and in this way a telegraphic communication could be kept up by a single wire, while intermediate stations could both send and receive signals. It having been discovered by *Steinheil*, subsequently to the year 1837, that a return wire was unnecessary, and that the earth would complete the circuit, defendants used no return wire, but buried the ends of short lengths of wire, at opposite termini, in the ground, and in this way worked with a circuit, part only of which was metallic, the remainder being the substance of the earth itself.

WILDE, C.J. left the case to the jury, who found :—3. That the magnetic ring and indicator used by defendants was a different instrument from plaintiffs' needles. 4. That the sending of signals to intermediate stations was plaintiffs' invention. 5. That the angular motions of needles in vertical planes and on horizontal axes in combination with stops was the invention of plaintiffs. Verdict for plaintiffs. Leave reserved.

Rule nisi for a new trial, or to set aside the verdict on these findings, discharged by the Court of Common Pleas.

Per CRESSWELL, J.—The first objection was, that the patent of the plaintiffs 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*,' no infringement had been made by the defendants, or, indeed, could be made, as long as the circuit they used was not metallic throughout, but to a substantial extent *non-metallic*. 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 defendants 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 improvements in the *mode* of doing something by a known process, is sufficient to entitle the claimant to a patent for his improvements, when applied either to the process as known at the time of the claim, or to the same process altered and improved by discoveries not known

at the time of the claim, so long as it remains identical with regard to improvements claimed, and their application.

The second objection was, in substance, that the plaintiffs' patent was for a system of giving signals by means of *several wires and converging needles* pointing to letters, whereas the defendants had used *one wire*, and had made signals by counting the deflection of a needle or needles, which was found by the jury to be a different system from that of the plaintiffs. This objection appears to us to be founded on a wrong construction of the specification, which, we think, shows the patent not to be for a system of giving signals, but for certain distinct and specified improvements comprehending those now in question, the system being described only for the purpose of explaining the improvements claimed.

Another objection was that the breach in the declaration, being that the defendants had used and counterfeited '*the invention*' of the patentees, was not supported by evidence of the use or counterfeiting of part only. But on looking at the specification, which explains what the invention is, it appears to consist of nine specified improvements; and the declaration, in speaking of the said invention, is to be considered as if it charged the using, &c., of the said nine improvements, and is sufficiently proved by showing that one of them has been used.

With regard to the objection as to the claim to the verdict (on the issue of not guilty) regarding vertical needles, on considering the finding of the jury with regard to defendants' instrument (finding 3), in conjunction with the claim in the specification, it may be doubtful whether the plaintiffs can claim the verdict on this ground. But it appears to us that the use of duplicate apparatus at intermediate stations, which the jury have found a new invention, and which was undoubtedly used by the defendants, entitles the plaintiffs to retain their verdict.

It was insisted also 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 a duplicate apparatus at each station; and that this is a fit subject of a patent. If, as was mentioned on the argument, the defendants have intermediate stations to *send* as well as to *receive* communications, it is a very important improvement, for which the inventors may probably be entitled to a patent, though they may not be entitled to use it, unless by the licence of the patentees of the less perfect invention on which their own is grounded.

ELLIOTT *against* TURNER, A.D. 1845. 2 C.B. 446; 462, *n.*

Misdirection by Judge. Construction of Specification.

COVENANT on an indenture of licence by plaintiff to defendant for the manufacture of buttons according to a patent of 14th *Dec.* 1837, No. 7,508, to *W. Elliott.* The issue was, whether certain buttons made by defendant were made under the licence.

At the trial, it appeared that the specification stated:—'The third part of my invention being the application (to the covering of buttons) of such fabrics only wherein the ground or face of the ground thereof is produced by a warp of *soft or organzine silk*, such as is used in weaving satin and the classes of fabrics produced therefrom.' COLTMAN, J. directed the jury:—That unless the silk were organzine, it was not within the patent. Verdict for defendant.

Error brought on bill of exceptions to this ruling. Judgment of *venire de novo* by the Court of Exchequer Chamber. (Parke, Alderson, Rolfe, Platt, BB., Patteson, Williams, Coleridge, Wightman, JJ.)

Per PARKE, B.—The word *or*, in its ordinary and proper sense, is a disjunctive particle, and the meaning of the term '*soft or organzine*' is, properly, either one or the other; and so it ought to be construed, unless there be something in the context to give it a different meaning, or unless the facts properly in evidence, and with reference to which the patent must be construed, should show that a different interpretation ought to be made. The learned judge should not have told the jury *absolutely* that soft and organzine silk were the same; he should have stated that the words were *capable* of being so construed if the jury were satisfied that at the date of the patent only *one* description of soft silk, and that organzine, was used in satin weaving; but otherwise, that the proper and ordinary sense of the words was to be adopted, and the patent held to apply to every species of soft silk as well as to organzine silk.

Second trial of the same action, and verdict for plaintiff.

ELLWOOD and OTHERS *against* CHRISTY and OTHERS, A.D. 1864–5. 17 C.B. N.S. 754; 18 C.B. N.S. 494.

Assignment by Executors before Registration of Probate. Account.

CASE for the infringement of a patent for an improved hat or helmet for hot climates. Plaintiffs also prayed a writ of injunction and account. It appeared that plaintiffs claimed under an assignment by the executors of the patentee under the circumstances following:—On 3rd *Dec.* 1862, probate of the will was granted; on 5th *Feb.* 1863, the executors assigned the patent to plaintiffs; and

on 10th *April*, 1863, they registered the probate, but delayed to register the assignment until 14th *April*, 1863.

At the trial, it was submitted that the executors had no title to convey at the time of making the assignment (see stat. 15 & 16 Vict. cap. 83, sect. 35), and that plaintiffs could not maintain the action. ERLE, C.J. over-ruled the objection. Verdict for plaintiffs. Leave reserved.

Rule for a new trial refused by the Court of Common Pleas. (Erle, C.J., Byles, Keating, JJ.)

Per ERLE, C.J.—There is nothing whatever in this point. If the plaintiffs had commenced their action before they had completed their title, by registering the probate, the case would probably have been different.

Motion for a rule, in the terms of that granted in *Walton* v. *Lavater* (8 C.B. N.S. 162), for an account 'of all profits of which the plaintiffs have been deprived by means of the infringement in the declaration mentioned,' and for payment of the same. Rule made absolute for an account of profits made by defendants by means of the infringement, from the date of registration of the assignment.

Per WILLIAMS, J.—It does not appear from the report of *Walton* v. *Lavater* that the Court absolutely sanctioned the amended form of rule. The matter was not contested.

Per WILLES, J.—We do not decide that the plaintiffs could not recover in the cause any damages they may have sustained. All we decide is that such damages can only be recovered at the hands of a jury, and not by means of an account taken before the master under stat. 15 & 16 Vict. cap. 83, sect. 42.

ELMSLIE *against* BOURSIER, A.D. 1869. L.R. 9 Eq. 217.

Infringement by Importation and Sale of Patented Articles.

Suit to restrain from infringing a patent for the manufacture of sheet tin. It appeared that defendant had consigned to a *London* agent several parcels of tinfoil, manufactured in *Paris*, according to the patented invention. Decree for injunction, and account as prayed, with an inquiry as to damages, and the costs of the suit; following the decree in *Betts* v. *Neilson* (L.R. 3 Ch. 429). But see the judgment of the House of Lords in *Betts* v. *Neilson* (L.R. 5 H.L. 27), where the decree for an account and inquiry as to damages was made alternative.

Per JAMES, V.C.—I am of opinion, in this case, that the obtaining from abroad and selling in this country an article manufactured according to the specification of a patent, is a violation of the privileges granted by the letters patent.

REX *versus* ELSE, A.D. 1785. Bull. N.P. 76; Dav. Pat. Ca. 144.

Novelty of Invention.

Sci. fa. to repeal a patent of 29th *Oct.* 1779, No. 1,235, to *A. Else*, for 'a certain new manufacture of lace, called *French* or wire-ground lace, which is much stronger than any hitherto invented.' The specification stated the invention to be 'mingling a fine thread of silk or other such material with thread, flax, hemp, cotton, which has usually been worked in a stocking-frame, which addition gives strength, firmness, and durability to the work. The manner of working the same is such as is common in making *open work*.' There was no separate claim.

At the trial, it appeared that, prior to the patent, silk and cotton thread had been used together and mixed upon the same frame for making lace. Defendant's counsel admitted this to be the fact, but said he could show that the mixed thread was inadequate for making lace.

BULLER, J. said:—'It will be to no purpose. The patent claims the exclusive liberty of making lace composed of silk and cotton thread mixed, not of any particular mode of mixing it; and therefore, as it has been proved that silk and cotton thread were before mixed on the same frame for lace in some mode or other, the patent is clearly void.' Verdict for the Crown.

FEATHER, *suppliant*, *against* THE QUEEN, A.D. 1865. 6 B. & S. 257.

Right of the Crown to use a Patented Invention.

Petition of right, alleging that suppliant, *R. B. Feather*, was grantee of a patent of 26th *Nov.* 1852, No. 884 (in part disclaimed), for an invention of improvements in the construction of ships, and that the commissioners for executing the office of Lord High Admiral of the *United Kingdom* had infringed the patent right, by the construction and use of a ship for the service of the Crown called the *Enterprise*, to the damage of the suppliant of 10,000*l*. The Crown, after setting out the patent, specification, and disclaimer, demurred to the petition of right. Judgment for the Crown.

The patent was in the usual form, and contained, *inter alia*, the clause that the letters patent should be 'taken, construed, and adjudged in the most favourable and beneficial sense for the best advantage of' the patentee. There was also a proviso, on the part of the Crown, that 'if the said *R. B. Feather*, his executors, administrators, or assigns, should not supply or cause to be supplied for our service all such articles of the said invention as he or they shall be required to supply by the officers or commissioners administering the department of our service for the use of which the same shall be re-

quired, in such manner, at such times, and at and upon such reasonable prices and terms as shall be settled for that purpose by the said officers or commissioners requiring the same, that then and in any of the said cases these our letters patent, and all liberties and advantages whatsoever hereby granted, shall utterly cease, determine, and become void, anything hereinbefore contained to the contrary thereof in anywise notwithstanding.'

Per COCKBURN, C.J.—On the demurrer to this petition of right two questions present themselves for our determination: first, whether, by the effect of the letters patent, the Crown is excluded from the use, except with the assent of the patentee, of the invention protected by the patent; secondly, whether, if the foregoing question be answered in the affirmative, a petition of right can be maintained by the suppliant against the Crown for the infringement of his patent right.

It is true that the patent gives to the patentee the sole privilege of making, using, exercising, and vending the invention; but, on the other hand, there are no express words to take away from the Crown the right of using the invention. The statute of James was only declaratory of the common law, and these grants of monopoly in respect of inventions are not by force of the statute, but by virtue of the prerogative. They are therefore subject to the rule of construction applicable to grants of this nature.

It appears to us that the assumption of a contract between the Crown and the patentee is altogether fallacious. The grant of the patent is simply an exercise of the prerogative, in which—the ground on which alone the grant of a monopoly is justifiable being that the invention shall be made available to the public—the Crown annexes as a condition of the grant that the true nature of the invention, and the manner in which it can be used, shall be fully and unreservedly disclosed. It was insisted that the concluding clause of the letters patent—namely, that such letters patent are 'to be taken, construed, and adjudged in the most favourable and beneficial sense for the best advantage of the grantee'—was strong enough to show that the stricter rule of construction usually prevailing with reference to grants from the Crown ought not to be applied to patents for invention. We, however, think that this clause ought not to have this effect. We think its true purpose and effect is that pointed out by Mr. *Hindmarch*, in his valuable work on patents, pp. 72, 73, namely, that of preventing the want of certainty which ordinarily exists in the description of an invention in a patent, prior to the specification, from avoiding the grant for uncertainty.

Another argument arising on the terms of the patent was founded,

on the clause which provides that the patentee shall supply the patented article, if required, for the service of the Crown, upon reasonable terms, which provision it was contended necessarily implied that the Crown could not itself have manufactured or prepared the article. We think that to give this clause by implication the operation for which Mr. *Bovill* contended, would be directly to violate the rule of construction, which, according to the authorities, should be applied to grants from the Crown, and which prohibits any effect being given by implication, adversely to the Crown, beyond what is clearly expressed in the grant.

The infringement of a patent right constitutes a tort or wrong, in the proper sense of the term; and, as no wrongful act can be alleged against the Crown, we are of opinion that, even if our decision on the first question had been in favour of the suppliant, a petition of right to the Crown would not be open to him as a means of redress.

FELTON *against* GREAVES, A.D. 1829. 3 Car. & P. 611.

Sufficiency of Specification. Title of Patent too large.

CASE for the infringement of a patent of 28th *June*, 1827, No. 5,512, to *J. Felton*, for 'a machine for an expeditious and correct mode of giving a fine edge to knives, razors, scissors, and other cutting instruments.' Plea: Not guilty. Issue.

The specification stated:—'My invention consists 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 manner explained.' Then followed a description and drawing, which showed two parallel circular files, with alternate ridges and hollows, the ridges of one fitting into the recesses of the other; the ridges only being files. The specification went on to say:—'The cylinders may be of steel or any other suitable metal or hard material.' *Claim*: 'The machine hereinbefore described for the purposes aforesaid.'

At the trial, it appeared that the machine was useful in the sharpening of knives, but that one of the rollers used for giving an edge to scissors ought to be smooth; also that if *Turkey* stones were used for both rollers, the machine could be applied for sharpening scissors. LORD TENTERDEN, C.J. was of opinion that the specification was bad, and said:—'I cannot find that the scissor sharpener is described as having the two rollers different. With respect to constructing the rollers with *Turkey* stone, I cannot find that it is anywhere stated in the specification that *Turkey* stones used on both sides will do for scissors.' Plaintiff nonsuited.

FINNEGAN *against* JAMES, A.D. 1874. L.R. 19 Eq, 72.

Practice in Patent Suits. Particulars of Breaches; and of prior User.

Suit to restrain from infringing a patent. Plaintiff filed interrogatories requiring defendants to set forth particulars specifying the names and addresses of the persons by whom, the places where, the dates at, and the manner in which plaintiff's invention was alleged to have been used before the date of the patent. Defendants having declined to furnish the required particulars, plaintiff filed exceptions.

At the hearing, defendants submitted that they ought not to be compelled to put in a further answer until particulars of breaches had been delivered.

JESSEL, M.R. allowed the exceptions, and said that he saw no reason why the practice as to furnishing particulars should be confined to cases in which the Court directed issues. In his opinion the practice at law ought to be followed as closely as circumstances would permit. The exceptions would be allowed; but the plaintiff must deliver particulars of the breaches complained of, and the defendants would have fourteen days from the time of such delivery to put in a further answer. Costs to be costs in the cause.

FISHER *against* DEWICK, A.D. 1838. 4 Bing. N.C. 706; 1 Webs. Pat. Ca. 264; *Cited* 8 Q.B. 1056.

Notice of Objections. Title of Patent.

CASE for the infringement of a patent of 31st *Dec.* 1831, No. 6,208, to *W. Sneath*, for 'improvements in machinery for the manufacture of bobbin net-lace.' The defendant delivered a notice of objections, under stat. 5 & 6 Will. IV. cap. 83, sect. 5, stated in the most general terms, *e.g.*: 4. 'That if any part [of the improvements] were new, the same was useless and unnecessary, and not the ground of any patent at all.' 6. 'That the said improvements, or some of them, had been publicly and generally used long before the granting of the said letters patent.'

Rule nisi to rescind an order for better particulars discharged by the Court of Common Pleas. (Tindal, C.J., Park, Vaughan, Coltman, JJ.)

Per TINDAL, C.J.—The object of the statute was not to limit the defence, but to limit the expense to the parties, and more particularly to prevent the patentee from being upset by some unexpected turn of evidence. Under the 5th section, therefore, it was intended that the defendant should give an honest statement of the objections on which he means to rely. The present particulars are so vague that they can scarcely have been furnished with any other object

than to mislead. For instance, the objection that if any part be new, the same is useless and unnecessary: the defendant should have pointed out what part. That the improvements, or some of them, had been used long before: the defendant should have pointed out which. If he would, in the *Scotch* phrase, *condescend* upon the parts to which he objects, there would be an end of the difficulty.

The objections next came before TINDAL, C.J. at Chambers, on a summons for further amended particulars, but the questions raised were unimportant.

The report in the Q.B. series contains the following observation made by Pollock, A.G., in the course of his argument:—

'In *Fisher* v. *Dewick*, tried before Coltman, J., the patent was for improvements in machinery for making bobbin net-lace. Sir J. Campbell, for 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 where that addition was not wanted; and he said the title should have been "for a mode of making spots in bobbin net-lace." But the learned judge overruled the objection; and the Court of Common Pleas supported his ruling; 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.'

FORSYTH *against* RIVIERE, A.D. 1819. Chit. Prerog. Cr. 182.

Priority of Invention.

CASE for the infringement of a patent of 11th *April*, 1807, No. 3,032, to *A. J. Forsyth*, for giving fire to artillery and fire-arms.

Verdict for plaintiff.

ABBOTT, C.J. held that if several simultaneously discover the same thing, the party who first communicates it to the public is entitled to the benefit of it.

FOXWELL *against* WEBSTER, A.D. 1863. 2 Drew. & Sm. 250; 4 De G. J. & S. 77.

Practice in Patent Suits. Consolidation of Suits against different Infringers.

Suit to restrain from infringing a patent (in part disclaimed) of 16th *Oct.* 1852, No. 413, to *C. T. Judkins*, for 'improvements in machinery or apparatus for sewing or stitching.' It appeared that plaintiff was assignee of the patent, and that he had filed 134 bills against separate defendants. Four motions were now made by four groups of defendants, amounting in the whole to seventy-seven, the substance being that the suits should be consolidated, and that either one suit selected by plaintiff should be prosecuted, and pro-

ceedings in the remainder stayed, or else that the validity of the pat. should be tried once for all, and the time for answering be enlarged, each defendant reserving his own defence on the ground of non-infringement. KINDERSLEY, V.C. dismissed the motion, but without prejudice to any application after answer, with a view to regulating the course of the proceedings, and said:—'A patentee has no right to join as defendants any number of persons infringing, not even two. Now here the plaintiff has filed 134 bills against 134 different persons, who, he alleges, are infringing; and it is said, How can it be necessary to file so many bills? But it is a settled rule of this Court that if a person wishes to obtain an injunction he must not sleep upon his right; he must come to the Court speedily; and if in this case the plaintiff had proceeded against one or more of the persons alleged to be infringing, and had abstained from filing bills against the others, his remedy by injunction against them would have been prejudiced. It would be in vain for him to say that he was waiting the result of a trial against some others. The fact that there are 134 suits does not affect the duty of each defendant to answer the interrogatories addressed to him, and which will or may give the plaintiff the benefit of a decree. The defendants have come too soon.'

On appeal, LORD WESTBURY, L.C. suggested:—'That the defendants should file affidavits stating their objections to the validity of the patent, and giving full information of every machine made, used, or sold by them, and whence obtained, and when used, and full discovery of the profits derived therefrom, undertaking also to pay a royalty in respect of each machine, if the validity of the patent and its infringement should be established.' This course was agreed to, on condition that defendants would furnish verified models of every machine so made, used, or sold by them respectively. His Lordship then made an order directing an issue as to the validity of the patent (certain defendants being selected as representatives), the result to be binding on plaintiff and all parties to the motions. The trial to take place by consent before his Lordship without a jury. All particulars of objections to the patent under stat. 15 & 16 Vict. cap. 83, sect. 41, to be delivered within a fortnight.

FOXWELL *against* BOSTOCK, A.D. 1864. 4 De G. J. & S. 298.

Sufficiency of Specification. Obligation in specifying where the Patent is for an improved Machine. Validity of Disclaimer.

Trial before WESTBURY, L.C. without a jury, and under the order made in the previous case, of the issue as to the validity of plaintiff's patent.

The patent related to a form of sewing machine, wherein a single shaft with three cams upon it gave the three principal movements—viz., 1. The movement of the needle; 2. The movement of the shuttle; 3. The feed-motion of the cloth. And it was the disposition of these three cams upon one shaft which formed the invention.

The specification stated:—'My invention relates to an improved arrangement and combination of machinery for sewing or stitching by a needle and shuttle, and of regulating the supply of thread so as to keep it at a proper tension, with a means of enabling the mechanism to accommodate itself to different thicknesses of thread.' It then proceeded to describe the machine by reference to drawings, Figs. 1, 2, 3, giving side and front elevations and a plan of the entire machine, and showing the action of the cams. It also described the regulation of the supply of thread of different thicknesses, and the construction of a spring-presser for holding down the work. The drawings were incomplete.

Claim: 'The combination and arrangement of the various parts of machinery for sewing or stitching with the use of a needle and shuttle, the methods of regulating the supply of thread to the needle and shuttle, the arrangement of accommodating the machinery to the different thicknesses of the thread or silk, and the means of preventing the material rising or missing the stitch when different thicknesses present themselves.'

On 15th *April*, 1853, plaintiff, *D. Foxwell*, being assignee of the patent, filed a disclaimer and memorandum of alteration, in which the several drawings were amended and corrected, so as to form sufficient drawings for the specification. The description of the machine was amended, as was also the description of the three subordinate improvements—viz., the method of supplying the thread, the arrangement for different thicknesses, and the means of preventing the material rising. But the amended *claim* was: 'I claim as new and of my invention the combination and arrangement of the various parts of machinery for sewing and stitching, with the use of a needle and shuttle.'

An objection was taken that the patent was bad, on account of a variance between the provisional and complete specifications; but Westbury, L.C. thought the objection removed by disclaimer, and that, speaking generally, the provisional and complete specifications ought not so to differ that the nature of the invention described in the one should be materially different from that described in the other. His Lordship then proceeded to give judgment, and said:—The patent was granted for 'improvements in machinery or apparatus for sewing or stitching,' and by the original specifi-

cation they were described as consisting of '*an improved arrangement and combination of machinery for sewing or stitching by a needle and shuttle;*' and also, separately, of means for regulating the supply of the silk or thread, for accommodating the machinery to different thicknesses of thread or silk; and, thirdly, for preventing the material rising, or the missing of the stitch. Then those three last-mentioned operations and the machinery for effecting them are treated in the original specification, and also by the disclaimer, as separate improvements, and as not forming part of that combination of machinery which is the principal subject of the patent. That patent and the original specification and disclaimer all assume this as being the case, and treat these three separate arrangements as being something which may be excised and eliminated without prejudice to the rest of the invention. But as the rest of the invention is the combination of machinery, those three parts could not have formed part of that combination, for if they had done so they could not have been disclaimed; unless, indeed, the patent and the original specification had treated them both as separate inventions, and also as integral parts of the combination, which is not pretended by the plaintiff to have been the case; and if it had been pretended could not have been maintained. The consequence, then, is this:—That the combination of machinery now described in the amended specification is different from the combination of machinery described in the original specification, and for which the patent was granted.

The question then arises—Is the patent void, or is the disclaimer void? And to this question it is not easy to find an answer. There is no express enactment in stat. 5 & 6 Will. IV. cap. 83, that the disclaimer, if it transgresses the statutory limit, by extending the exclusive right, shall be void to all intents and purposes; and unless it be so, it must remain enrolled with and always accompany the letters patent in the specification. It might be proper to hold that the disclaimer is inoperative for the excess only, where that excess is clearly distinguishable; and this is the course which I have been most anxious to take in the present case. But I have found it impossible so to do.

It is, in my judgment, clear that the mechanical arrangements for effecting the auxiliary inventions are left intentionally in their corrected and amended form, as integral parts of that combination of machinery to which the patent, by the operation of the disclaimer, is intended to be confined. The result is, not only that the combination in the amended specification is different from the combination in the original specification, but also that there is no specification remaining of that invention for which the patent was granted.

But there is another and more material objection to the sufficiency of the specification. The patent is for 'improvements in machinery or apparatus for sewing or stitching,' and the specification describes the invention as consisting in 'an improved arrangement and combination of machinery for sewing or stitching by a needle and shuttle.' The words, '*improved arrangement*,' or '*improved combination*,' indicate the nature of the invention. But it is the duty of the patentee particularly to describe and ascertain his improvements in his specification, for it is the improvements which constitute the invention. The plaintiff's counsel contend that this is done by the drawings and the description of the drawings; but the drawings and the description thereof exhibit and describe an entire machine, and the composition and working of its several constituent parts, without in any manner indicating where the improvement lies, or in what it consists. It must follow that an accurate knowledge of the construction of all needle and shuttle machines, which were known and used in *England* at the date of this patent, is necessary, in order to discover the differences and novelties that existed in this improved combination. The law requires that the specification should be intelligible to a workman of ordinary skill and information on the subject. A new combination or improved arrangement of machinery, therefore, should be so described as that a person of ordinary knowledge on the subject may be able at once, on reading the specification, to perceive the invention, and the manner in which it is to be performed. It is not sufficient to say that a person possessed of all the knowledge existing at the time of the patent on the subject of sewing machines, will discern the improvement. That is more than the law requires.

The difficulty of the plaintiff arises entirely from the character which he has thought fit to give to his alleged invention, and the manner in which he has described it. His counsel had no difficulty at the bar in describing his improvement. They stated it to consist of an arrangement of three cams on one shaft, by the direct action of which the three principal motions in a needle and shuttle machine—viz., the needle movement, the shuttle movement, and the feed movement—are effected; and the plaintiff's evidence was directed to show that this arrangement formed the novelty and utility of the patent. But this clear and simple statement is not to be found anywhere in the specification. The argument is, that this is not necessary where the patent is for a combination. But I think that both on principle and authority it is most necessary that the specification should ascertain the improvement when the patent is for an improved—that is, for a new—combination. If a combination of machi-

nery for effecting certain results has previously existed and is well known, and an improvement is afterwards discovered, consisting, for example, of the introduction of some new parts, or an altered arrangement in some particular of the existing constituent parts of the machine, such improved arrangement or combination may be patented; but it would be contrary to the spirit of the patent law and of the decided cases to permit a patent to be taken out for a new combination, and the whole machine to be described and specified as a new invention, without in any manner distinguishing or marking the improvement by the introduction or addition of which the improved arrangement or the improved combination is in reality produced. The term, '*combination of machinery*,' which has become a favourite form of words with patentees, is nothing but an extended expression of the word '*machine*.' It is the word '*machine*' writ large; and as a patent for an improved machine, in the specification of which the improvement was not particularly stated and described, would hardly be attempted to be supported, so neither in my judgment can the patent for an improved arrangement or combination be supported, in the specification of which there is nothing to distinguish the new from the old. It is true that the case of *Harmar* v. *Playne* (11 East. 101) was held to be an exception to this rule, but *exceptio probat regulam*. In that case a patent was taken out for a machine; the inventor afterwards discovered an improvement, and he took out a second patent for an improved machine, and in the specification of that second patent he described the whole machine, without distinguishing the improvement; and the objection was that the specification was insufficient, and the patent bad; but inasmuch as in the second patent he had recited the first patent, and the specification under it, it was held that that recital being in immediate comparison with the new specification, furnished *in gremio* of the new patent the means of distinguishing the new from the old.

I must therefore lay down the rule, which is consistent with and in reality a mere sequence from the decided cases, that in a patent for an improved arrangement or new combination of machinery, the specification must describe the improvement and define the novelty otherwise and in a more specific form than by the general description of the entire machine; it must, to use a logical phrase, assign the *differentia* of the new combination. This obligation flows directly from the condition of the patent; it is part of the condition of the patent that the specification shall particularly describe and ascertain the invention. With that condition this specification, in my judgment, fails to comply. If the disclaimer

were treated as void, and the case were remitted to the original specification, I should be of opinion for the same reasons that that also was insufficient. I must therefore declare that the specification of this patent is insufficient, and that the patent is void in law.

His Lordship then ordered a stay of proceedings in all the causes, with costs against plaintiff, including the costs of the order, with liberty to defendants in the other causes to move to dismiss the respective bills against them for want of prosecution.

GALLOWAY and ANOTHER *against* BLEADEN, A.D. 1839.
1 Webs. Pat. Ca. 521.

Novelty of Invention. Prior experimental User.

CASE for the infringement of a patent of 18th *Aug.* 1835, No. 6,887, to *E. Galloway*, for 'improvements in paddle wheels for propelling vessels.' Pleas: 3. That the invention was not particularly described by the specification. 4. That the invention was not new. Issue.

The patent related to a mode of constructing the floats of paddle wheels so as to lessen their concussion with the water, and to diminish the drag of water behind the wheel. Each float was formed of a series of narrow bars placed at an angle to the radius of the wheel and arranged in a *cycloidal* curve. This curve was traced out by a point in the circumference of an imaginary circle, centred on the paddle shaft, and rolling on the surface of the water. The specification stated:—That the bars forming a paddle float would in this way enter the water at the same point, or very nearly so, whereby the amount of displaced water would be diminished, and the loss of power as well as the concussion consequent upon the use of the common radial float would be obviated. It further described the invention to consist in affixing the portions of floats or paddles according to the arrangements herein described.

At the trial, Mr. *Field*, the engineer, deposed that in 1833 he had made a model of a paddle wheel with divided floats placed in a cycloidal curve, and had exhibited the same at the Admiralty; that he had fitted a small steamer on the *Thames* with such a wheel; that it had answered well, but was taken off after a few weeks' trial; that in 1835 he had constructed an apparatus for experimenting with various paddle wheels, chiefly cycloidal wheels; that the experiments went on from *April* till *July*, 1835, no secrecy whatever being observed; on the contrary, persons were invited to come and see the trials.

TINDAL, C.J. directed the jury:—If there is a want of clearness in the specification so that the public cannot afterwards avail themselves of it; much more, if there is any studied ambiguity in it, so as

to conceal from the public that of which the patentee is, for a term, enjoying the exclusive benefit, no doubt the patent itself would be completely void.

The main point in this case is, whether this improvement was new as to the public use and exercise thereof in *England*. A mere experiment, or a mere course of experiments, for the purpose of producing a result which is not brought to completion, but begins and ends in uncertain experiments, is not such an invention as should prevent another person, who is more successful and pursues with greater industry the chain in the line that has been laid out for him by the preceding inventor, from availing himself of it, and having the benefit of it; therefore the main point in this case is, whether all that is allowed to have been done by Mr. *Field* rested in experiment, and unsuccessful experiment, not conducted to its full result, or whether it was a complete discovery of that which now forms the subject-matter of the patent. Verdict for plaintiffs.

GAMBLE *against* KURTZ, A.D. 1846. 3 C.B. 425.

Evidence of Infringement. Novelty of Invention.

CASE for the infringement of a patent (in part disclaimed) of 14th *March*, 1839, No. 8,000, to *J. C. Gamble*, for 'improvements in apparatus for the manufacture of sulphate of soda, muriatic acid, chlorine, and chlorides.' Pleas: 1. Not guilty. 2. That the plaintiff was not the true and first inventor. 3. That the invention was not new. Issue.

The patent related to the manufacture of sulphate of soda. The specification described the apparatus by reference to drawings, and showed two decomposing chambers A, A, placed upon opposite sides of a central or finishing chamber B, but connected therewith by short passages. The operation consisted in placing equal weights of common salt and sulphuric acid in the chambers A, A, and exposing the material to a regulated temperature, which liberated a quantity of muriatic acid gas. The partially decomposed residuum was then pushed into the retort B, and roasted at a high temperature, until its conversion into sulphate of soda became complete. Receivers were also arranged for the condensation of the muriatic acid gas.

The specification stated:—'Instead of the brick furnaces hitherto employed I have found that *iron retorts* may be advantageously substituted.' *Claim*: 'I do not claim the exclusive use of iron retorts, but I claim as my invention iron retorts worked in connection with each other as above described. I claim the use of receivers so arranged that the acid can pass from one to the other.'

At the trial, it appeared that before the patent the common prac-

tice had been to use a single chamber only. But evidence was adduced of the user at *Berwick* of two chambers connected by an inclined spout about twelve feet long, through which the material was passed from one to the other for the final roasting. Similar evidence was given of prior user at *Manchester*. Defendant also put in evidence the specification of a patent of 13th *Oct.* 1836, No. 7,208, to *T. Lutwyche*, for an apparatus to be used in making sulphate of soda, consisting of a decomposing chamber with two floors on a different level for the two stages of the operation. The alleged infringement consisted in the use of two chambers, one of iron, the other of brick, connected by an opening, through which the materials were transferred from the one to the other.

Verdict for plaintiff on all issues except the second and third, as to which the jury found:—That the alleged invention of the use of two chambers, with separate furnaces, was not new, but that the plaintiff's mode of connecting them was new. Leave reserved.

Rule nisi to enter a verdict for defendant on second and third issues made absolute by the Court of Common Pleas.

Per COLTMAN, J.—We are clearly of opinion that the verdict for the plaintiff on the issue of not guilty must stand. The material of which the chambers are composed not being of the essence of the invention, the patent right might be invaded though the chambers used by the defendant were not of the material mentioned in the plaintiff's specification.

The other question depends upon what is the true nature of the plaintiff's claim as an inventor. It was contended that he claimed the use of two retorts in connection with the whole of the apparatus for condensing the muriatic acid gas. But the words of the specification are 'in connection with each other.' We can give no other meaning to this than that the plaintiff claimed, as part of his invention, the use of two chambers with separate furnaces, worked in connection with each other, so that the materials might be decomposed in one, and then removed to and roasted or finished in the other. The jury having found that the evidence did not establish this claim, the verdict on the special finding must be entered for the defendant.

GARDNER *against* BROADBENT, A.D. 1856. 2. Jur. N.S. 1041.

Affidavit of title in Patent Suits. Recent Patent.

Suit to restrain from infringing a patent. Motion to dissolve an *ex parte* injunction. It appeared that plaintiff had bought the patent, and his affidavit merely stated that the patent had been duly recorded, and that he believed it was valid. The patent had run for

little more than a twelvemonth. STUART, V.C. dissolved the injunction with costs, but without prejudice to the bringing of an action, and said:—'When the plaintiff applied for an injunction, his affidavit ought to have stated clearly and distinctly that he believed that the patentee, from whom he purchased the patent, was the original and true inventor, and that he believed that the invention had not been practised at the time the patent was granted. That was necessary, because the injunction asked for was to protect a legal title, which legal title ought to be sworn to, and the facts supported before the Court. There was no law of this Court which prevented a patentee by the *recency* of his patent from applying for an injunction *ex parte*: and he wished it to be understood that the law of the Court was that laid down by Lord Eldon in the case of *The Universities of Oxford and Cambridge* v. *Richardson* (6 Ves. 689).'

GIBSON and CAMPBELL *against* BRAND, A.D. 1842.
1 Webs. Pat. Ca. 627; 4 M. & G. 179; 4 Scott N.R. 844.

Evidence of Infringement. Novelty of Invention. Obligation in Specifying. Infringement by sale of Patented Articles. Patent for a Process.

CASE for the infringement of a patent of 19th *Nov.* 1836, No. 7,228, to *J. G. Campbell* and *J. Gibson*, for 'a new and improved process or manufacture of silk, &c.' The declaration alleged that defendant had directly and indirectly *made, used, and put in practice* the said invention. Pleas: 1. Not guilty. 2. That plaintiffs were not the true and first inventors. 3. That the invention was not new. Issue.

The patent related to a method of preparing and spinning silk waste in combination with wool or flax. The specification stated eight heads of invention, *e.g.*—1. Discharging the gum from silk waste. 2. Dyeing the material. 4. Spinning silk waste of long fibre in combination with flax of the same length of fibre. 6. The application of the improved process to the throstle machine on the principle of the long ratch for spinning silk waste. 7. Certain improvements in the throstle machine whereby its utility is augmented in spinning silk waste. *Claim*: 'We restrict our claims to the eight general heads of invention before mentioned, all of which we believe to be new, and of great public utility.'

At the trial, evidence was adduced contradicting the novelty, both of the process and of the machinery.

It further appeared that defendant had ordered silk waste to be spun by certain parties in *England*, by a process similar to that patented, and had received and sold the silk so spun. TINDAL, C.J. directed the jury:—A man may publish to the world that which is

perfectly new in all its uses, 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 act of another, from the labours and assiduity or ingenuity of another, should be the man who was to receive the benefit of another's skill. It would not be sufficient to destroy this patent to show that learned persons in their studies had foreseen or had found out this discovery that is afterwards made public, or that a man in his private warehouse had by various experiments endeavoured to discover it and failed, and had given it up.

If the defendant has sold an article of exactly the same fabric, made in the same manner as that for which the patent was taken out, such sale may be considered as a using of the invention within the terms of the declaration.

The jury found for plaintiffs on all issues except the second and third, and as to these the finding was:—That the invention was not new, but was an improved process, and not a new combination.

Rule nisi to enter a verdict for defendant on the second and third issues made absolute by the Court of Common Pleas. (Tindal, C.J., Coltman, Erskine, Cresswell, JJ.)

Per TINDAL, C.J.—The proof that an order had been given by the defendant, in *England*, for the making of silk by the same process as the plaintiffs', which order had been executed in *England*, is enough to satisfy the allegation in the declaration—that the defendant made, used, and put in practice the plaintiffs' invention—though the silk was, in fact, made by the agency of others.

It is not necessary, on this occasion, 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. Lord C.J. Eyre seems to be of that opinion in *Boulton* v. *Bull* (2 H. Bl. 493). I confess I feel it impossible to apply the language of the specification otherwise than to a substantive claim to an invention of a new machine, or a new combination of the parts of an old machine; the jury, however, have by their special finding negatived both, and, upon the evidence, I see no reason to be dissatisfied with that finding.

Per COLTMAN, J.—I am not prepared to say that a new process may not be considered a manufacture within the meaning of the statute (21 Jac. I. cap. 3).

Per CRESSWELL, J.—A party who obtains a patent is bound clearly to define in his specification what it is he claims to be 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 an infringement of the patent. (See 4 Scott N.R. 490.)

GILLETT and ANOTHER *against* WILBY, A.D. 1839. 9 Car. & P. 334; 1 Webs. Pat. Ca. 270.

Evidence of Infringement. Practice as to Certificate for Costs.

CASE for the infringement of a patent of 21st *Dec.* 1836, No. 7,266, to *S. Gillett* and *J. Chapman*, for 'improvements in cabs.' Plea 2. That the alleged improvements were not new. Issue.

At the trial, it appeared that the specification described five improvements, and it was contended that plaintiffs were bound to show that all of them had been imitated, but COLTMAN, J. directed the jury:—The plaintiffs must make out to your satisfaction that the whole of the improvements were new, and that some of them have been pirated. It is not necessary that they should all have been used, but they must be shown to be all new; and if they are all new, and the defendant has infringed any one of them, it will be sufficient to support the action, and it is not necessary that he should have infringed them all. Verdict for plaintiffs.

There being a plea that the invention was not new, the judge certified under stat. 5 & 6 Will. IV. cap. 83, sect. 3, that the validity of the patent came in question.

GILLETT *against* GREEN, A.D. 1841. 7 M. & W. 347; 1 Webs. Pat. Ca. 271.

Practice as to Certificate for Costs.

CASE for the infringement of a patent, where after verdict a certificate was given by the judge under stat. 5 & 6 Will. IV. cap. 83, sect. 3. On the trial of a second action for infringing the same patent, the above certificate was put in evidence, but no application was made to the judge to certify under stat. 3 & 4 Vict. cap. 24, sect. 2, that the action had been brought to try a right.

Rule to tax plaintiff his treble costs refused by the Court of Exchequer. (Parke, Alderson, Gurney, Rolfe, BB.)

Per PARKE, B.—It is said that the Lord Chief Baron has still the power of certifying; but that is not so: the statute expressly directs that the plaintiff shall not recover costs where the damages are under 40s., unless the judge shall 'immediately afterwards certify' that the action was brought to try a right, &c. It may even be a question whether the judge could grant the certificate after another cause had been called on.

GOUCHER *against* CLAYTON and OTHERS, A.D. 1864–5.
11 Jur. N.S. 107, 462; 34 L.J. Ch. 239.

Estoppel. Construction of Specification. Evidence of Infringement.

Suit to restrain from infringing a patent (extended for three years) of 25th *Nov.* 1848, No. 12,343, to *J. Goucher*, for 'a machine for thrashing corn and other grain.' The patent related to an improved form of beater in thrashing machines. The specification stated:—'I construct a thrashing machine with grooves or channels in the surfaces of the beater, such grooves or channels being of suitable dimensions to allow the corn and straw to lodge therein and pass through, without being injured by the surfaces between and by which the corn is beaten out and separated.' The drawing showed the beater, constructed of six longitudinal bars, supported on arms or spokes, so as to form an open cylindrical frame. Each bar was of iron, bound round with iron wire in a spiral, the spaces between the convolutions of the wire forming the grooves or channels on the bar. The specification went on to say:—'I prefer that the roof should be perforated, so as to admit of the passage of grain and chaff.' *Claim*: 'My invention of a thrashing machine, in which the surface of the beaters is grooved or channelled, and the roof perforated, as above described.'

It appeared that in 1854 plaintiff took proceedings at law against a certain firm, *Clayton & Co.*, for infringing his patent. The firm submitted to a judgment in the action, and took a licence for five years (afterwards extended to seven years) 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. Defendants raised the issues of want of novelty and insufficiency of the specification. An objection was taken that defendants were estopped, both as having been licensees, and by reason of the judgment at law, from disputiug the validity of the patent. WOOD, V.C. said that he thought the defendants were not estopped from denying the validity of the plaintiff's patent, and in any case he could not prevent the defendants, who were not parties to the action at law, from setting up this defence.

A supplemental bill was also filed, and it appeared by the answer that defendants had sold two thousand of plaintiff's beaters since the expiration of the licence, and that many of them had been exported to *Austria*. Defendants also denied their liability to pay a royalty on any beaters supplied by way of renewal to thrashing machines.

At the hearing, WOOD, V.C. decreed an account of all beaters furnished by defendants by way of renewal and for exportation,

and said:—'It appears to me that what the plaintiff really claims is an improved beater for thrashing machines. He has not described the perforation of the roof as his invention, but all he says is, that he prefers the perforated roof. The defendants have made a number of these beaters without reference to any machine, to supply the foreign market in *Austria*. It was not contended that that had been done under the licence; but the argument has been upon the authorities, that the making of parts of an invention in this country, and the exportation of those parts, do not constitute an infringement of a patent for a complicated machine, because those single parts do not make the machine—the patented article—and the making of those parts in itself is lawful. That might be so in those cases where the whole patent was for a new combination of machinery, every part of the machinery being old. In the case I have before me, the beater is the whole thing claimed, as I have held on the construction of the patent; and therefore the making of the beater is a distinct and plain invasion of the patent, and in that respect the plaintiff will be entitled to an account.

GREAVES *against* THE EASTERN COUNTIES RAILWAY COMPANY, A.D. 1859. 1 E. & E. 961.

Practice as to Costs.

CASE for the infringement of a patent. Notice of trial was given and countermanded, whereupon defendants, after notice, entered a suggestion, and signed judgment. On taxation, the master disallowed all items relating to the particulars of objections which had been duly delivered under stat. 15 & 16 Vict. cap. 83, sect. 41.

Rule nisi for the master to review his taxation made absolute by the Court of Queen's Bench. (Lord Campbell, C.J., Erle, Crompton, Hill, JJ.)

Per LORD CAMPBELL, C.J.—The defendants here would be clearly entitled, under the statute of *Gloucester*, to the costs of preparing these particulars and evidence in support of them. Then is there anything in stat. 15 & 16 Vict. cap. 83 to deprive them of these costs? I think not. Sect. 43 applies only to cases where there has been a trial: where there has been no trial, as in the present case, the law stands as it did before.

THE GROVER and BAKER SEWING MACHINE COMPANY *against* MILLARD, A.D. 1861–2. 8 Jur. N.S. 713.

Estoppel of Licensee.

Suit to restrain from infringing a patent of 10th *Aug.* 1852, No. 14,256, to *E. J. Hughes*, for 'improvements in sewing machines.'

Defendant, who was a licensee of the patent under plaintiff, withdrew from the jurisdiction of the Court, without answering the bill, whereupon plaintiff obtained an order to make the bill *pro confesso*.

At the hearing, it appeared that plaintiffs had, after the filing of the bill, failed to support the validity of the patent in an action at law; nevertheless, WOOD, V.C., on the authority of *Smith* v. *Scott* (6 C.B. N.S. 771) and *Noton* v. *Brooks* (7 H. & N. 499), granted a perpetual injunction with costs, and made the decree absolute.

HALL *against* CONDER and OTHERS, A.D. 1857. 2 C.B. N.S. 22, 53.

Breach of Agreement. Estoppel.

Declaration for breach of an agreement which recited that plaintiff had *invented* a method for the prevention of boiler explosions and had obtained a patent for the same, and by which plaintiff made over to defendants one-half of the patent. Plea 2. That the invention was wholly worthless and of no public utility, and was not new, and that plaintiff was not the true inventor thereof. Demurrer and joinder. Judgment for plaintiff by the Court of Common Pleas. (Cockburn, C.J., Cresswell, Williams, JJ.)

Per WILLIAMS, J.—The plaintiff professed to have *invented* a method for the prevention of boiler explosions. It is not alleged that he was guilty of any fraud. Why should we assume that the plaintiff meant to assert that the patent was indefeasible, and that the defendants purchased on that understanding, rather than that each knowing what the invention was, and having equal means of ascertaining its value, they contracted for the patent, such as it was, each acting on his own judgment? We think that the latter was the true nature of the contract, and that there was no warranty, express or implied. Here the plaintiff was capable of fulfilling all he had contracted to. The defendants might have had all they contracted to receive, and were therefore bound to pay.

(2 C.B. N.S. 53.) Error brought in the Court of Exchequer Chamber. Judgment affirmed.

HALL *against* JARVIS and BOOT, A.D. 1822. 1 Webs. Pat. Ca. 100.

Subject-matter of a Patent. Evidence of Infringement.

CASE for the infringement of a patent of 3rd *Nov.* 1817, No. 4,178, to *S. Hall*, for 'a method of improving every kind of lace or net.' Plea: Not guilty. Issue.

The patent was for burning off the superfluous fibres from lace or net without injuring the fabric. The patentee described a system of rollers for feeding on the lace, and passing it rapidly over a series of gas jets placed in a line underneath a chimney, which drew the

flame of the gas through the meshes of the fabric, and removed the superfluous fibres. The chimney was required for creating a sufficient draught. The specification stated:—'I do not *claim* the exclusive use of any apparatus or combination of machinery, except in connection with and in aid of the application of the flame of inflammable gas to the purposes above described.'

At the trial, it appeared that the flame of charcoal, paper, wood shavings, and common pit coal had been in use before the date of the patent for the purposes of singeing fibres from silk, cotton, or lace sleeves; but for this purpose the articles had been placed on a wooden sleeve-board, and the flame had not been drawn through the meshes, but simply projected upon the fabric by a pair of bellows, and it was objected plaintiff was not entitled to a monopoly of the use of gas flame. As to the infringement, it appeared that defendant, *Boot*, had a *gassing* machine on his premises, where the gas-fittings had been tampered with, and gas had been consumed in excess of that required for lighting purposes. Also that lace left with defendants had been dressed and returned in the state to which it would have been brought by the application of plaintiff's process. Counsel for defendants having stated that he should prove that the flame of charcoal or oil had been previously forced through the interstices of lace by a pair of bellows, ABBOTT, C.J. said:—'The proving that will not affect the question.' His Lordship then said to the jury:—'There can be no doubt, gentlemen, your verdict must pass against both the defendants.' Verdict for plaintiff.

HANCOCK *against* BEWLEY, A.D. 1860. Johns. 601.

Rights of Joint Owners of a Patent. Account.

Suit to obtain an account of profits made by defendants in working certain patents relating to gutta-percha, which were vested by deed in trustees for plaintiff, together with defendant, *Bewley*, and two other persons. It appeared that plaintiff had, for several years, worked the patents on his own account, in competition with defendants. WOOD, V.C. dismissed the bill, and said:—'The plaintiff contends, as a general principle, that persons who are part owners of a patent are not individually entitled to work it on their own account, but are subject to render an account of profits in some shape to their co-owners; and he says that the defendants ought to account for their profits, and ought not to be allowed to continue working the patents for their own benefit. There is much to be said on this side of the question, but the plaintiff is debarred by his own acts from raising the contention.'

HARMAR *against* PLAYNE, A.D. 1807. 14 Ves. 130; 11 East. 101; Dav. Pat. Ca. 311.

Sufficiency of Specification. Practice in Patent Suits. Injunction.

Suit to restrain from infringing a patent of 29th *March*, 1794, No. 1,982, to *J. Harmar*, for 'improvements in a machine for raising a shag on woollen cloths, and cropping and shearing them.' The patent recited that *J. Harmar* had obtained letters patent on 20th *March*, 1787 (No. 1,595), for an invention of a machine for raising a shag upon woollen cloths; and further, that he had invented considerable improvements in the said machine. It was admitted that the improvements so referred to were included in the descriptive part of the specification of the second patent, but that the nature thereof would only appear by comparison of the two specifications.

On motion for injunction, LORD ELDON, L.C. ordered the hearing to stand over for the parties to agree upon a case to be stated for the opinion of a Court of law, and said:—'I do not say that a case might not exist, where possession might be distinctly proved, and yet there might be such strong doubt whether the specification was not bad in law, that the Court would *brevi manu* interfere, and put an end to the injunction; and if I am to decide upon the inclination of my own opinion, where the practice is differently represented, and considerable doubt may be raised in argument, I think it is difficult to support this specification. The question to be tried will be, whether a patent for a machine with a due specification having been granted, and a subsequent patent being granted for improvements, it is competent in law to represent in the specification that the latter patent was granted, not for improvements, but for the machine; carrying forward that idea, and describing the new invention as one entire machine; not as improvements, contradistinguished from the original machine. I adhere to the law as I stated it in the case of *Cartwright* v. *Eamer*' (cited 14 Ves. 131).

The question for the opinion of the Court of King's Bench (Lord Ellenborough, C.J, Bayley, Le Blanc, JJ.) was, whether the proviso in the letters patent of 29th *March*, 1794, had been duly performed by the enrolment of the specification thereof. Answered in the affirmative.

LORD ELLENBOROUGH, C.J. said:—'The difficulty which presses most is, whether this mode of making the specification be not calculated to mislead a person looking at it, and induce him to suppose that the term for which the patent is granted may extend to preclude the imitation of other parts of the machine than those for which the new patent is granted, when he can only tell by comparing it with some other patent what are the new and what are the old parts;

and if this may be done by reference to one, why not by reference to many other patents, so as to render the investigation very complicated? I feel impressed by the observation of my brother Le Blanc, that the trouble and labour of referring to and comparing the former specification with the latter would be fully as great if the patentee only described in this the precise improvements upon the former machine. Reference indeed must often be necessarily made in these cases to matters of general science, or the party must carry a reasonable knowledge of the subject-matter with him, in order clearly to comprehend specifications of this nature.'

Cited, *Foxwell* v. *Bostock* (4 De G. J. & S. 298).

HARWOOD and ANOTHER *against* THE GREAT NORTHERN RAILWAY COMPANY, A.D. 1860. 2 B. & S. 194; 222; 11 H.L. Ca. 654.

Subject-matter of a Patent. New use of an old thing.

CASE for the infringement of a patent of 16th *March* 1853, No. 651, to *C. H. Wild*, for 'improvements in fishes or fish-joints for connecting the rails of railways.' Pleas: 1. Not guilty. 2. That the patentee was not the true and first inventor. 3. That the specification was insufficient. 4. That the invention was not new. 5. That it was not the subject-matter of a patent. Issue.

The provisional specification stated:—'In securing the joints of rails it has been found advantageous to attach pieces of iron to each side of the rails by means of bolts and nuts, and such pieces of iron are commonly called fishes. My invention consists in forming a recess or groove in one or both sides of each fish, so as to reduce the quantity of metal at that part, and to be adapted to receive the square heads of the bolts which are thus prevented from turning round when the nuts are being screwed on.' The specification described the invention by reference to drawings, and showed the grooved fish secured by bolts and nuts at the joint of two rails, the bolts having square heads fitting into the recess, and the nuts being kept clear of the groove by means of a washer. *Claim* 1: 'The constructing fishes for connecting the rails of railways with a groove adapted for receiving the heads of the bolts or rivets employed for securing such fishes, and the application of such fishes for connecting the rails of railways in the manner hereinbefore described.'

At the trial, it appeared that before *Wild's* patent the bolts for fish-joints had been made with squared necks or with squared heads fitting into corresponding recesses, but had never been made with a groove along the outer surface for the double purpose of receiving the square heads of the bolts and of rendering the fish lighter for equal strength of metal. Also, that in the year 1847, a timber bridge

of considerable span, known as the *Hackney Bridge*, had been constructed by Mr. *Brunel* on the *South Devon Railway*. In this bridge horizontal beams of timber were laid from each pier and were united at the centre by scarf joints. Channel iron bars were laid underneath the beams along their whole length and across the joints for the purpose of giving additional strength, and these bars were secured by bolts with square heads fitting into the groove of the channel iron. A piece of plate iron was also laid for some feet along the upper surface of the beams and covered the joint, being secured by the bolts which held the channel iron. It further appeared that in other timber bridges constructed by Mr. *Brunel*, beams of timber had been laid horizontally upon each other, and that channel iron bars had been employed for strengthening such beams, being bolted along the under side by square-headed bolts passing through the beams and secured by nuts; the groove of the iron bar effecting the double purpose of preventing the heads of the bolts from turning round and of giving greater additional transverse strength with the same weight of metal. The jury found:—1. That the channelled irons upon railway bridges, independent of the *Hackney Bridge*, were used before the patent for the double purpose of obtaining increased strength and preventing the bolt-heads from turning round, but that they were not used for the purpose of fishing. 2. That the fastening of the scarf joint at the *Hackney Bridge* was a fishing of that joint, but that the use of the channelled iron arose from its being already there for fastening together the beams and the iron, and was not adopted by Mr. *Brunel* with reference to the special advantages in fishing contemplated by *Wild's* patent. COCKBURN, C.J. directed a verdict for plaintiffs. Leave reserved.

Rule nisi to enter a verdict for defendants on the ground that the invention was not the subject-matter of a patent, or for a new trial on the ground of misdirection with respect to the use of grooved iron in the *Hackney Bridge*, discharged by the Court of Queen's Bench. (Cockburn, C.J., Hill, Blackburn, Crompton, JJ.)

Per COCKBURN, C.J.—It appears to me that *Wild* was entitled to take out a patent for his invention. It is true that the use of grooved plates of iron with bolts with heads and screws, the heads of the bolts being fixed in the groove, had previously been applied to the purpose of connecting and fastening timbers placed vertically upon one another, or placed horizontally side by side. *Wild*, however, proposed to apply the contrivance to what is called *fishing*, that is, the fastening timbers placed together in a wholly new and different position—viz., longitudinally, end to end, in contact with each other. In this case I think the purpose for which these things had been used

is sufficiently distinct to warrant us in holding that *Wild's* invention may be the subject of a patent. The second point is, whether by the previous user of this mechanical contrivance there has been an anticipation of *Wild's* invention, which prevents him from sustaining his patent. On this part of the case the question is, whether the accidental use of a piece of machinery (forming part or the whole of a mechanical contrivance which may be applied afterwards to some ulterior purpose), without any intention of producing the result, is such a user of the invention as prevents a patent from being taken out by another person; and this turns upon what is the meaning of stat. 21 Jac. I. cap. 3, sect. 6. Clearly the statute means what others have invented, and used *knowingly*, for the same purpose for which the person who afterwards comes forward as the inventor, and obtains a patent, intends to use it. I go the length of saying, that even if this had been done upon a railway, it would not have prevented a subsequent patent from being taken out.

Per BLACKBURN, J.—A man cannot be said to '*use*' a manufacture in the sense in which the word must be understood in the statute of James, and as it would be ordinarily understood, when accidentally, and without any knowledge or intention, he produces that which, if it were knowingly and intentionally done, and for the purpose of trade, would be a manufacture.

On appeal to the Court of Exchequer Chamber (Pollock, C.B., Channell, Wilde, BB., Williams, Willes, and Byles, JJ.), judgment reversed, and rule made absolute to enter a verdict for defendants upon the pleas denying the novelty of the invention and that it was the subject-matter of a patent.

Per WILLES, J. (in delivering the judgment of the Court)—In our opinion, quite independent of the use of the grooved iron for fishing in the *Hackney Bridge*, the use of grooves in pieces of iron for holding materials together by means of bolts and nuts had been given to the world, together with all its advantages, before the date of *Wild's* patent; and *Wild's* alleged invention was a mere application of that old contrivance in the old way, to an analogous subject, without novelty or invention in the mode of applying such old contrivance to the new purpose. And an application such as this does not make a valid subject-matter for a patent. See *Tetley* v. *Easton* (2 C.B. N.S. 706); *Brook* v. *Aston* (8 E. & B. 478, s.c. in error 28 L.J. Q.B. 175.)

On appeal to the House of Lords, the judges were summoned, and Williams, Blackburn, Keating, Shee, JJ., and Channell, Piggott, BB. attended. Two of the learned judges (viz., Blackburn, Shee, JJ.) were of opinion that the verdict should be for plaintiffs, and

that there should not be a new trial, but the remaining four judges were of the contrary opinion. Judgment of the Court of Exchequer Chamber affirmed, and appeal dismissed with costs.

Per LORD WESTBURY, L.C.—The question is simply this: whether the channelled iron, which was undoubtedly a fish (and one of the objects of the channel was to receive the square heads of the bolts and prevent their turning), is not in truth substantially the same thing as a grooved plate with a recess hollowed out in its own plane, instead of a hollow being effected by flanges placed on either side of the plate. Regarding the patent as limited to a claim for fishes of a particular configuration, I cannot for a moment doubt that the channelled iron, having the same object and being capable of the same application, substantially involves the fish-plate made with a grooved hollow in the manner which I have attempted to describe.

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. The channelled iron was applied in a manner that was notorious, and the application of it to a vertical fish would be no more than the application of a well-known contrivance to a purpose exactly analogous or corresponding to the purpose to which it had been previously applied.

HASSALL *against* WRIGHT and OTHERS, A.D. 1870. L.R. 10 Eq. 509.

Right to sue on a Licence before Registration.

Suit to restrain from infringing a patent granted to defendant *Wright*. It appeared that on 5th *Feb.* 1867, *Wright* granted by deed an exclusive licence to plaintiff for the use of the invention. The deed was not registered (see stat. 15 & 16 Vict. cap. 83, sect. 35) until *May*, 1870, after delivery of notice of motion in the suit. In *Jan.* 1870, *Wright* licensed other parties, who were made co-defendants in the suit, and their licence was not registered. A preliminary objection was taken that the non-registration of the deed of *Feb.* 1867 was a bar to plaintiff's right to sue. MALINS, V.C. overruled the objection, and said:—'It is quite true that in the Court of Queen's Bench it has been decided that where the assignee of a patent sues at law (before the registration of the assignment) for the infringement of the patent a third person, not the grantor, he is unable to maintain his suit; because the Act of Parliament says,

that until the assignment is registered the original patentee must be deemed to be the owner of the patent. But even there the Court of Queen's Bench reserved the question of right as between the grantor and grantee; they do not say there is no title, they assume that he may be entitled to maintain a suit on having his title perfected. That is the express language of Lord Campbell in giving judgment, and he says it is not necessary to decide the question whether the registration relates back. I should say, under the circumstances here, it has relation back, and gives a title to the licensee *ab initio*.'

HASTINGS *against* BROWN, A.D. 1853. 1 E. & B. 450.

Sufficiency of Specification.

CASE for the infringement of a patent of 21st *Dec.* 1844, No. 10,446, to *C. Johnstone*, for 'certain improved arrangements for raising ships' anchors and other purposes.' Plea 5. That the specification was insufficient. Issue.

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. The specification stated:—'That the scallop shell was 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, figure 2, merely showed an indented V groove. *Claim*: 'The new form of scallop shell (as shown in figure 2) in conjunction with the arrangements hereinbefore described.'

At the trial, it appeared that before the date of the patent no cable holder was known which would hold chains of different sizes, and the invention claimed as a novelty was the application of a single windlass to different sizes of chain cable. It also appeared that a windlass capable of holding a chain cable of a given size was not new. It was contended, on behalf of defendant, that the specification was insufficient, it being doubtful whether the claim was for holding a chain of a given size, or for holding chains of different sizes. LORD CAMPBELL, C.J. left the case to the jury.

Verdict for plaintiff. Leave reserved.

Rule nisi to enter a nonsuit made absolute by the Court of Queen's Bench. (Lord Campbell, C.J., Coleridge, Wightman, JJ.)

Per LORD CAMPBELL, C.J.—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. That is not done by this specification. The claim is for an invention by which a single windlass may raise

cables of different diameter, which is allowed to be a great improvement. But is that pointed out by the specification? The words are, at best, equivocal. If he claims for a windlass that is fitted for one cable only, of whatever size, there is no novelty: and the vice of the specification is that it does not assert that more can be done by the invention. The title tells us nothing. The words of the specification are 'a chain cable of any size.' '*A*' applies to one only; at all events the phrase is capable of that meaning; and the specification, if it be equivocal, is bad. I see nothing in the words, or in the drawing, that necessarily indicates the contrivance to be for fitting more than one cable. You might make a windlass according to the drawing which would do no more than that. The specification therefore is bad, and there must be a nonsuit.

Per COLERIDGE, J.—The law is admitted. If the specification upon a fair interpretation be equivocal, it is insufficient. The specification does not say that the windlass, framed as described, will hold cables of different sizes: yet it is necessary to show that this was in the patentee's mind. If it was, the expression is strange. It is very doubtful whether the words could mean that; but at all events they bear the other meaning equally well.

HAWORTH *against* HARDCASTLE, A.D. 1834. 1 Bing. N.C. 182; 1 Webs. Pat. Ca. 480.

Utility of Invention. Construction of Specification.

CASE for the infringement of a patent of 19th *April*, 1823, No. 4,780, to *W. Southworth*, for 'an apparatus adapted to facilitate the drying of calicoes.' Plea: Not guilty. Issue.

The specification stated:—'My invention consists in the application of certain machinery to perform the operation of hanging wet calicoes over a series of staves in a drying-house, and of removing the same after they have been dried;' and went on to say, 'I arrange the rails or staves near to the upper part of the drying-house.' It then described the operation of hanging the cloths in loops upon rails, and of taking them up again, and referred to drawings which showed a travelling carriage containing the cloths and running on beams through the whole length of the drying-house. *Claim* (in substance): The application of the machinery described for drying calicoes, which machinery is adapted by means of revolving and traversing cylinders situated over a series of stationary rails or staves arranged in drying-houses in such manner that the calicoes may be caused to hang down in long loops upon the staves: the said machinery being adapted for taking up and removing the said calicoes after being dried.

At the trial, it appeared that rails for drying cloths, similar to those mentioned in the specification, were in common use before the date of the patent; also, that the machine failed in taking up certain cloths stiffened with clay. It was contended, on behalf of defendant, that the patentee had claimed the invention of the rails or bars, which were old, whereby the patent became void; also, that the invention was of no use. ALDERSON, J. left the case to the jury. The jury found:—That the invention was new, and useful upon the whole, but that the machine was not useful in some cases for taking up goods. Verdict for plaintiff. Leave reserved.

Rule nisi to enter a nonsuit discharged by the Court of Common Pleas. (Tindal, C.J., Park, Gaselee, Alderson, JJ.)

Per TINDAL, C.J.—After stating that the machine was useful upon the whole, the expression that, in some cases, it was not useful to take up the cloths, appears to us to lead rather to the inference that, in the generality of cases, it is found useful; and if the jury think it useful in the general, because some cases occur in which it does not answer, we think it would be much too strong a conclusion to hold the patent void. We think that the patentee does not claim, as part of his invention, either the 'rails and staves,' or the placing them at the upper part of the building. The use of the rails and staves for this purpose was proved to have been so general before the granting of this patent, that it would be almost impossible, *à priori*, to suppose that the patentee intended to claim what he could not but know would have avoided his patent. There can be no rule of law which requires the Court to make any forced construction of the specification, so as to extend the claim of the patentee to a wider range than the facts warrant; on the contrary, such construction ought to be made as will, consistently with the fair import of the language used, make the claim of invention co-extensive with the new discovery of the grantee of the patent.

HAYNE and ANOTHER *against* MALTBY, A.D. 1789. 3 T.R. 438; 1 Webs. Pat. Ca. 291.

Estoppel.

Declaration, for breach of covenant, setting out so much of the recitals of the deed as stated that plaintiffs were the assignees of a patent for a machine to be fixed to a common stocking-frame for making point-net, and averring that plaintiffs had granted permission to defendant to use one stocking-frame with the patent invention attached thereto. Pleas: 3. Setting out the patent, that no specification was enrolled. 4. That the invention was not new. 5. That it was not discovered by the patentee. Demurrer and joinder.

Judgment for defendant by the Court of King's Bench. (Lord Kenyon, C.J., Ashurst, Buller, Grose, JJ.)

Per Lord Kenyon, C.J.—The plaintiffs, pretending to derive a right under the patent, assigned to the defendant part of that right on certain terms; and notwithstanding that the facts now disclosed show that they have no such privilege, they still insist that the defendant shall be bound by his covenant, though the consideration of it is fraudulent and void. But it is said the defendant is estopped in point of law from saying that the plaintiffs had no privilege to confer; but the doctrine of estoppel is not applicable here. The person supposed to be estopped is the very person who has been cheated and imposed upon.

Heath *against* Unwin, A.D. 1842–43. 10 M. & W. 684; 2 Webs. Pat. Ca. 216.

Evidence of Infringement. Use of Chemical Equivalents.

CASE for the infringement of a patent of 5th *April*, 1839, No. 8,021, to *J. M. Heath*, for 'improvements in the manufacture of iron and steel.' Plea: Not guilty. Issue.

The patent related to the use of carburet of manganese in the manufacture of cast steel. The specification stated:—'I declare the nature of my invention to be (4) the use of carburet of manganese in any process whereby iron is converted into cast steel. I propose to make an improved quality of cast steel by introducing into a crucible bars of common blistered steel, broken into fragments, or mixtures of cast and malleable iron, or malleable iron and carbonaceous matters along with from *one to three per cent.* of their weight of carburet of manganese, and exposing the crucible to the proper heat for melting the materials, which are, when fluid, to be poured into an ingot mould in the usual manner.' *Claim* 4: 'The employment of carburet of manganese in preparing an improved cast steel.'

At the trial, it appeared that the object of the invention was to render *cast steel* more easy to weld and more malleable than it had hitherto been. Shortly after the enrolment of the specification, plaintiff proposed to substitute portions of coal tar and black oxide of manganese for the carburet of manganese, and sent to defendant, who was his agent at *Sheffield*, small parcels of these materials to be called '*Heath's* composition' and supplied to the manufacturers at a reduced rate. Defendant, however, soon ceased to act as agent for plaintiff, and began to manufacture cast steel with coal tar and black oxide of manganese. This was the alleged infringement for which the action was brought.

It further appeared that carburet of manganese was formed by

exposing a mixture of carbon and oxide of manganese to a high temperature. LORD ABINGER, C.B. said :—'The materials or elements of carburet of manganese, as used by the defendant, being out of all proportion cheaper than the carburet itself, the use of such materials in the said composition is a new discovery or invention, and not within the letters patent. Further, there is no sufficient evidence of the formation of carburet of manganese during the process adopted by the defendant, that is, of the use of carburet of manganese in the manufacture of steel within the meaning of the specification.'

Plaintiff nonsuited.

HEATH *against* UNWIN, A.D. 1844. 2 Webs. Pat. Ca. 218; 13 M. & W. 583.

Evidence of Infringement. Use of Chemical Equivalents.

Second action between the same parties for the infringement of the same patent. Plea: Not guilty. Issue.

At the trial, it appeared that the invention enabled manufacturers to produce malleable *welding cast steel* suitable for cutlery from low-priced *British* iron, which had not been done before; that prior attempts to use oxide of manganese had failed, because the manganese caused the melting-pots to give way; that as soon as plaintiff found out that the separate elements of carburet of manganese—viz., carbon and manganese—would answer as well as the compound substance, he supplied them in that form. Also, scientific chemists deposed that carburet of manganese was formed from carbon and oxide of manganese in the melting-pot at a temperature below that at which steel fused, and it was estimated that the ingredients used by defendant, as mentioned in the former case, gave about *one-half per cent.* of carburet of manganese for combination during the fusion of the metal.

Witnesses for defendant deposed that black oxide of manganese was commonly used for cleansing iron ores; also that they had used carbon with this oxide as an experiment, and occasionally in the course of trade, before 1839. Also, that crucibles for melting steel were made of clay and coke dust, so that carbon was always present when oxide of manganese was used. PARKE, B. directed the jury:—If they (viz., two of the witnesses) used the oxide and carbon only by way of experiment, that would not affect the novelty of the invention; but if they used them in the regular course of their trade before the date of the plaintiff's patent, then his invention cannot be new. The jury found:—That defendant had infringed; and that, although he might not have used *one per cent.* of carburet, the words in the specification, from *one to three per cent.*, gave a latitude as to the quantity to be used. Verdict for plaintiff.

Rule nisi to enter a verdict for defendant on first issue made absolute by the Court of Exchequer. (Parke, Alderson, Gurney, Rolfe, BB.)

Per PARKE, B.—There was no intention to imitate the patented invention; and we do not think the defendant can be considered to be guilty of an indirect infringement, if he did not intend to imitate at all. (But see observations of the same learned judge in the next case.)

HEATH *against* UNWIN, A.D. 1850. 2 Webs. Pat. Ca. 228; 12 C.B. 522; 5 H.L. Ca. 505.

Evidence of Infringement. Use of Chemical Equivalents discovered after grant of Patent.

Third action between the same parties for infringement of the same patent. (Issue directed by the Court of Chancery.) Plea: Not guilty. Issue.

At the trial, CRESSWELL, J. ruled (see previous case):—That the use of oxide of manganese and carbonaceous matter was not an infringement of the patent. Verdict for defendant.

Error on bill of exceptions to this ruling. Judgment of *venire de novo* by the Court of Exchequer Chamber. (Platt, B., Wightman, Erle, Crompton, JJ.; *dissentientibus* Alderson, B., Coleridge, J.)

Per CROMPTON, J.—I think there was abundant evidence from which the jury might have found that the carburet was first formed in the crucible from the materials, so as to be in the distinct state of carburet before the use of it in the manufacture of steel commenced, and that after its formation it was used as a carburet of manganese in the process of converting the iron into steel; and I think from such a state of facts it was competent for the jury to find that the patent had been infringed by the defendant.

Per ERLE, J.—I am of opinion that a patent for the use of a substance is infringed by the use of a chemical equivalent for that substance, known to be so at the time of the use, if used for the purpose of taking the benefit of the patent and of making a colourable variation therefrom. If the patent was for the use of soda in a process, and, by subsequent analysis, sodium and oxygen were discovered to be the elements of soda, the use of sodium and oxygen in the patented process for the purpose of being equivalent to soda in that process, would appear to me to be an infringement, although the analysis of soda was subsequent to the patent.

Per ALDERSON, B.—There is no evidence that oxide of manganese and carbon were known to be, at the time of the specification—which time and not the time of the use is the material time to look at—

exactly and under all circumstances an equivalent in chemistry to carburet of manganese. The plaintiff did not then know it, nor did any one else then know it. If they know it now, it is in consequence of a new discovery alone, for which no patent has been taken out, and no specification enrolled. I apprehend that nothing is an equivalent now which would not have been one immediately after this specification was enrolled. The knowledge of the equivalents must be the knowledge the world had before these experiments, now called infringements, were first made.

Appeal to the House of Lords, when the judges were summoned, for the purpose of stating their opinion on the following question (in substance):—Whether there was evidence for the jury of an infringement of the patent by the use of oxide of manganese and carbonaceous matter in the manufacture of cast steel? Crowder, Crompton, Williams, Erle, Cresswell, Wightman, JJ., and Platt, B., answered in the affirmative; and Maule, J., Pollock, C.B., Parke, Alderson, BB. answered in the negative.

Per CROMPTON, J.—If a new process of which the patentee and all others were ignorant at the time of the specification is found out afterwards, the exercise of such new process may be an infringement, provided it is substantially the same with or includes the patented invention. The knowledge or intention of the party infringing is now most properly admitted to be immaterial.

Per CRESSWELL, J.—The claim being general, and the evidence in support of the action tending to show that the defendant had used carburet of manganese in the manufacture of steel by causing it to be first formed in the pot and afterwards mixed with the steel, I think the case is not one where an equivalent has been used, but the thing itself; and if the thing itself was used, although the defendant was not aware of it, he has still infringed the patent.

Per PARKE, B.—In delivering the judgment of the Court of Exchequer in a former stage of this case, I stated the opinion of the Court to be that there would be no indirect infringement if the defendant did not intend to imitate at all. That part of the judgment has been justly objected to in *Stevens* v. *Keating* (*not reported* as to this point), and no doubt we were in error in that respect. There may be an indirect infringement, as well as a direct one, though the intention of the party be perfectly innocent, and even though he may not know of the existence of the patent itself.

THE LORD CHANCELLOR then delivered the judgment of the House of Lords.

Per LORD CRANWORTH, L.C.—There is no evidence whatever tending to prove that, at the date of the patent, it was known to

persons acquainted with the subject of manufacturing steel, that coal tar and oxide of manganese would be chemical equivalents for the carburet of manganese claimed by the plaintiff. Indeed, it is obvious that the discovery of such equivalents was made after the use of the carburet, as a distinct metallic substance, had been some short time in operation. It was itself a most valuable discovery, and would have legitimately formed the subject of a new patent.

On the short ground that the invention claimed is the use of a particular metallic substance—namely, carburet of manganese—in certain definite proportions, according to the weight of the steel under fusion, and that no such substance, nor any equivalent for it, known to be such at the date of the specification, was used by the defendant, I think that there was no evidence of infringement, and so that the ruling of the learned judge at the trial was correct.

HEATH *against* SMITH, A.D. 1854. 3 E. & B. 256.

Prior User of the Patented Invention.

CASE, brought by the administratrix of the patentee, for infringement of the same patent (extended for seven years). Plea 4. That the invention was not new, but had been publicly used in *England* before the date of the patent. Issue.

At the trial, it appeared that before the patent five firms had practised a process identical with that patented. The operation had been conducted openly by three of the parties, but secretly by the other two. All the five firms had sold the steel so manufactured in the usual way of business. ERLE, J. expressed his opinion that, if this evidence was believed, the invention was not new; and, the truth of it being admitted, his Lordship directed a verdict for defendant on the fourth issue, and for plaintiff on the remaining issues. Verdict accordingly.

Rule nisi for a new trial, on the ground of misdirection, discharged by the Court of Queen's Bench. (Lord Campbell, C.J., Wightman, Erle, JJ.)

Per LORD CAMPBELL, C.J.—This was not a mere experiment; a perfect manufactured article was produced for profit by hundreds of tons. As to two of these firms, it appeared that they did not disclose the method, but the other three firms made no attempt at concealment, but carried on the trade just like any other handicraft by which bread was to be earned; all the workmen and other persons successively employed knew of the method.

Per ERLE, J.—As to secrecy, three of the firms practised no concealment whatever. That of itself is ground enough for discharging the rule. I should, however, be disposed to go further. 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. But for the purpose of the present case, it is enough to say that there has been an user without any concealment.

LORD CAMPBELL, C.J. added:—I wish it to be clearly understood that if we had held this patent valid, the five firms would all have been liable to an action for exercising the invention after the patent had been taken out. Now see what that comes to. If any man makes a discovery and uses it without taking out a patent, and does not announce it by sound of trumpet or calling in the public as spectators, he must suspend the use of his discovery if another person subsequently makes the same discovery, and takes out a patent for it. That would be the consequence of the principle for which the plaintiff is driven to contend.

HIGGS *against* GOODWIN, A.D. 1858. E. B. & E. 529; 27 L.J. Q.B. 421.

Evidence of Infringement. Subject-matter of a Patent.

CASE for the infringement of a patent (in part disclaimed) of 28th *April*, 1846, No. 11,181, to *W. Higgs*. Title (after disclaimer), 'Treating chemically the collected contents of sewers and drains in cities, towns, and villages, so that the same may be applicable to agricultural and other useful purposes.' Pleas: 1. Not guilty. 3. That the undisclaimed part of the invention was not new. 4. That it was not the subject-matter of a patent. Issue.

The patent related to a method of precipitating, by means of hydrate of lime, the solid animal and vegetable matter held in suspension in sewage water. The specification described the arrangement of tanks and apparatus, and stated:—'For the purpose of precipitating the animal and vegetable matter contained in the sewage water, I prefer to employ hydrate of lime which, so far as I know, is the cheapest and most effective chemical agent for effecting this purpose.' *Claim*: 'The precipitation of animal and vegetable matter from sewage water by means of the chemical agent hereinbefore described.'

At the trial, it appeared that the alleged infringement was committed by the Local Board of Health at *Hitchin*, who separated the greater part of the organic matter from sewage water by filtration, and afterwards deodorised the liquid by the admixture of hydrate of lime. The refuse sediment was not sold, but was carted away by persons who were paid for removing it. ERLE, J. directed the jury:—That if the chemical agent was applied with a knowledge that it would precipitate the matter left in the sewage water, the

board must be considered to have applied it for that purpose, although their object was to deodorise, and not to precipitate; and that they had, in that case, infringed the patent, although the greater part of the sewage matter had been separated by filtration from the water before the hydrate of lime was used. Verdict for plaintiff. Leave reserved.

Rule nisi for a new trial, on the grounds that the invention was not the subject-matter of a patent, and that there was no evidence of infringement. During the argument, LORD CAMPBELL, C.J. said:—'There may be a patent for producing by precipitation a saleable article, but if that be so, there is no infringement.' Also ERLE, J. said:—'The intention to produce profitable matter is of the essence of the patent.' Rule made absolute by the Court of Queen's Bench. (Lord Campbell, C.J., Coleridge, Erle, Crompton, JJ.)

Per LORD CAMPBELL, C.J.—There is no evidence of infringement.

Per CROMPTON, J.—As to the objection that the patent is void for want of novelty, I am much inclined to say that the patent may be supported. Here is a process producing a new result, that is, manure in a particular form. It can hardly be said that there cannot be a patent for that.

HILL *against* THOMPSON and FORMAN, A.D. 1817–18. 8 Taunt. 375; 3 Mer. 622; 1 Webs. Pat. Ca. 232.

Practice in Patent Suits. Novelty of Invention. Evidence of Infringement.

Suit to restrain from infringing a patent of 26th *July*, 1814, No. 3,825, to *A. Hill*, for 'an invention of improvements in the smelting and working of iron.'

The patent related to a process of manufacturing bar iron, free from the defect of being *cold short*, by the use of lime. The specification stated:—'And my improvements do further consist in *the use and application of lime to iron*, subsequently to the operations of the blast furnace, whereby that quality in iron, from which the iron is called "cold short," is sufficiently prevented, and by which such iron is rendered more tough when cold.' The proportions of lime, mine-rubbish, and slags, to be admixed for the blast furnace, were then described, and the further treatment by lime in the refinery and puddling furnaces was detailed. The specification contained no separate claim, but again stated:—'I do further declare that *I have discovered* that the admixture of lime will sufficiently prevent that quality in iron from which the iron is called "cold short," and will render such iron more tough when cold; and I do for this purpose add a portion of lime, to be regulated by the quality of the iron to be operated upon.'

Lord Eldon, L.C. ordered an action at law, with an account, and said:—'The principle upon which the Court acts in cases of this description is the following: Where a patent has been granted, and there has been an exclusive possession of some duration under it, the Court will interpose its injunction, without putting the party previously to establish the validity of his patent by an action at law. But where the patent is but of yesterday, and, upon an application being made for an injunction, it is endeavoured to be shown in opposition to it that there is no good specification, or otherwise that the patent ought not to have been granted, the Court will not, from its own notions respecting the matter in dispute, act upon the presumed validity or invalidity of the patent, without the right having been ascertained by a previous trial, but will send the patentee to law, and oblige him to establish the validity of his patent in a Court of law, before it will grant him the benefit of an injunction.'

Action at law in pursuance of the order of the Court. Plea: Not guilty. Issue.

At the trial, it appeared that the alleged infringement consisted in the manufacture of pig-iron, by mixing cinders with mine-rubbish, and in the application of quicklime in the subsequent processes. But it also appeared that defendants did not work by plaintiff's specification, but used different proportions. Evidence was adduced of the user of lime for making pig-iron from slags and mine-rubbish before the patent. Verdict for plaintiff.

Rule nisi to enter a nonsuit made absolute by the Court of Common Pleas. In granting the rule the Court were of opinion that a book, *Aikin's Dictionary*, which lay open on the table during the trial, should be considered as having been made use of at the trial, both parties having referred to it. This book was published in 1807, and contained the following passage:—'*Rinman* says, that cast-iron, which by the common treatment would yield cold-short bar, may be made to afford soft malleable iron by fusing it with a mixture of equal parts of lime and scoria.'

Per Dallas, J.—The application of lime in some way, for the purpose proposed, instead of being a secret unknown before, was as public as it could be rendered by a work of extensive circulation, and had been more or less in actual use in this country, so that the present patent would in effect operate as an abrogation of vested and existing rights. On this part of the case I will only further remark, that if any part of the alleged discovery, being a material part, fail (the discovery in its entirety forming one entire consideration), the patent is altogether void. In every view of the subject, therefore, the claim to invention and novelty fails.

Motion to revive the injunction. Defendants having stated their intention to move for a new trial, the motion was ordered to stand over. Account as before.

Per LORD ELDON, L.C.—In his directions to the jury, the judge has stated it as the law on the subject of patents—first, that the invention must be novel; secondly, that it must be useful; and, thirdly, that the specification must be intelligible. I will go further, and say, that not only must the invention be novel and useful, and the specification intelligible, but also that the specification must not attempt to cover more than that which, being both matter of actual discovery and of useful discovery, is the only proper subject for the protection of a patent. And I am compelled to add that, if a patentee seeks by his specification any more than he is strictly entitled to, his patent is thereby rendered ineffectual, even to the extent to which he would be otherwise fairly entitled. On the other hand, there may be a valid patent for a new combination of materials previously in use for the same purpose, or for a new method of applying such materials. But, in order to its being effectual, the specification must clearly express that it is in respect of such new combination or application, and of that only, and not lay claim to the merit of original invention in the use of the materials.

HILLS *against* LAMING, A.D. 1853. 9 EX. R. 256.

Estoppel of Licensee.

Declaration for breach of covenant in a deed which recited that plaintiff was grantee of certain patents for improvements in purifying coal-gas, and by which he had given permission to defendants to work the same on certain terms. Pleas: 1. That the said patents were not, nor was either of them, a good and valid patent. 2. That the inventions, &c., were not, nor was either of them, new. 3. That the plaintiff was not the first inventor of the alleged inventions. Demurrer, on the ground that defendant was estopped from questioning the patents. Joinder. Judgment for plaintiff by the Court of Exchequer. (Pollock, C.B., Alderson, Platt, BB.)

PARKE, B. said:—'The case is similar to that of *Bowman* v. *Taylor* (2 Ad. & E. 278).'

HILLS *against* THE LONDON GAS COMPANY, A.D. 1857–60.
27 L.J. Ex. 60; 5 H. & N. 312.

Misdirection by Judge. Variance between Deposit Paper and Specification. Sufficiency of Specification. Subject-matter of a Patent. Title after disclaimer.

CASE for the infringement of a patent (in part disclaimed) of 28th *Nov.* 1849, No. 12,867, to *C. F. Hills*, the amended title being

'an improved mode of purifying coal-gas.' Plea 1. That the invention was not new. Issue.

The patent related to a method of purifying coal-gas from sulphuretted hydrogen. For this purpose *sesqui-oxide of iron* was mixed with sawdust so as to become porous, and was placed upon perforated shelves in a closed chamber; the gas under purification was passed through the mixture, which arrested the sulphuretted hydrogen and formed free sulphur and water. *Thus*, $Fe_2 O_3 + 3 H S = 2 Fe S + 3 H O + S$. As soon as the material had absorbed all the sulphuretted hydrogen which it could take up (or when it became black), a current of fresh air was drawn through the purifying chamber, whereby a second chemical change was effected. The black proto-sulphide of iron became again the red sesqui-oxide, and sulphur was deposited. *Thus*, $2 Fe S + 3 O = Fe_2 O_3 + 2 S$. The material could be used some fifteen or twenty times before it became over-clogged with free sulphur.

Claims (in substance): 1. The purifying of coal-gas from sulphuretted hydrogen, &c., by 'passing it through the *precipitated or hydrated oxides of iron*, from whatever source obtained,' and made into a porous material by being mixed with sawdust, &c. 2. Repeatedly renovating or re-oxidising the said purifying materials by the action of air, whenever they cease to absorb sulphuretted hydrogen, so that they may be used over and over again to purify the gas.

At the trial, defendants put in evidence the specification of a patent of 4th *Nov.* 1847, No. 11,944, to *R. Laming*, for improvements in purifying coal-gas, one part of which related to the use of carbonates of iron for this purpose. A witness deposed that the oxide of iron employed by plaintiff was formerly known as carbonate of iron, and was commonly sold under that name. Also that carbonate of iron could only be preserved in sealed vessels, as it changed to the hydrated sesqui-oxide on exposure to the air. Thereupon, POLLOCK, C.B. said he was satisfied that the carbonate of iron described by *Laming* was the same substance as the oxide of iron referred to by the plaintiff, and directed a nonsuit.

Rule nisi for a new trial on the ground of misdirection made absolute by the Court of Exchequer. (Pollock, C.B., Martin, Bramwell, Channell, BB.)

(5 H. & N. 312.) New trial of the same action. Pleas: 1. Not guilty. 2. That plaintiff was not the true and first inventor. 3. That the invention was not new. 4. That the specification was insufficient. 5. That the invention was not the subject-matter of a patent. 6. That the invention specified was different from that for which the patent was granted. Issue.

At the trial, it appeared that all precipitated oxides of iron, which were necessarily artificial, were competent to absorb sulphuretted hydrogen from coal-gas at ordinary temperatures; but that the native hydrated oxides of iron could not be practically used for this purpose. Defendants relied on the specification of *Laming's* patent already mentioned, where the material employed was *chloride of calcium*, produced by decomposing muriate of manganese, iron, or zinc; the specification stating:—'The oxides or carbonates which result are useful for the purification of the gas, and need not be removed.'

The defendants also put in evidence (1) the specification of a patent of 29th *July*, 1840, No. 8,577, to *A. A. Croll*, for (*inter alia*) improvements in purifying coal-gas. The material employed for absorbing sulphuretted hydrogen was *black oxide of manganese*, which substance was renovated, from time to time, by roasting it in an oven at a red-heat. The specification stated:—'The same effect may be produced by the application of the oxides of zinc and the oxides of iron, and treated precisely in the same way as above described.'

It further appeared that the deposit paper, left with the law officer, stated the fifth particular of invention as being 'for absorbing sulphuretted hydrogen, and other gases, into porous bodies, and renovating them again, either by heat, or taking off the atmospheric pressure.' The jury found:—That the whole invention, and each part, was new, and that, whether aptly described in the deposit paper or not, it was the plaintiff's invention. Verdict for plaintiff.

Rule to enter a verdict for the defendants on the sixth issue refused by the Court of Exchequer. (Pollock, C.B., Bramwell, Watson, BB.)

Per POLLOCK, C.B.—The Queen's grant, in terms, includes the invention specified. It may be that the Attorney-General may say the Crown has been deceived in this matter, but I do not think any one else can.

Rule nisi to enter a verdict for defendants discharged by the Court of Exchequer (Pollock, C.B., Bramwell, Watson, Channell, BB.), and rule for a new trial on the ground that the verdict was against the evidence also discharged. (Watson, Bramwell, BB.; *dissentiente* Pollock, C.B.)

Per BRAMWELL, B.—Upon the argument before us Mr. *Grove* has put forward a consideration not adverted to at the trial. He said:—'It is true that *Croll* said *oxides of iron*, and it may be that he meant *all oxides*. Take it to be so, that is not such a statement as precludes invention and discovery by the plaintiff, because there are many oxides, the hydrated and anhydrous, the natural and artificial, some of which will and some will not answer the purpose, and therefore it

is a matter of invention and experiment to see which will.' We concede to Mr. *Grove's* argument, that upon the mere comparison of these two instruments, *Croll* has not anticipated the plaintiff, so as to preclude him as a matter of law from being the discoverer of this invention.

The next question is upon the patent of *Laming*. Now *Laming* specifies for the use of chloride of calcium; he claims chloride of calcium, and says he uses it with the oxide of iron, which is produced in the preparation of the chloride. We cannot say, as a matter of law, that *Laming* anticipated the plaintiff. The question was left to the jury, and they have found a verdict for the plaintiff.

The next objection was that the plaintiff's specification was insufficient on this ground. He says, 'I use the hydrated or precipitated oxides.' It was said that included all hydrated oxides, and, inasmuch as some of the native hydrated oxides would not do, the plaintiff's specification was bad. It appears to us, upon looking at the specification, that the plaintiff uses those as equivalent expressions, because he says 'hydrated or precipitated,' and that oxide of iron may be conveniently 'prepared' for those purposes, and so on, and consequently he means such hydrated oxides as are precipitated.

Then it is said that the mere application of the hydrated oxide of iron to absorb sulphuretted hydrogen from coal-gas is not the subject of a patent, that property of it being previously well known. With that we do not agree. If a man were to say, 'I claim the use of hydrated oxide of iron for the purifying of coal-gas,' without saying how it was to be applied, it is possible the objection might be well founded; but here the plaintiff says, 'I claim it in the manufacture of gas in the way I have described,' and he shows how it may be used. Therefore this objection fails.

The sixth objection, that the title as amended by disclaimer is not such as to include the invention of the plaintiff, appears to me to be an unfounded one, and was not much pressed in the argument.

HILLS *against* EVANS, A.D. 1861–2. 31 L.J. Ch. 457; 4 De G. F. & J. 288.

Evidence of prior Publication. Sufficiency of Specification. Account or Alternative Action for Damages.

Suit to restrain from infringing the same patent. Defendant relied on the patents of *Croll* and *Laming* before referred to, and put in the specification of a patent of 12th *June*, 1806, No. 2,941, to *E. Heard*, for obtaining inflammable gas from pit coal. Injunction granted with costs.

Per LORD WESTBURY, L.C.—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, and requires generally the aid of the light derived from what are called surrounding circumstances. It is therefore an admitted rule of law that the explanation of the words or technical terms of art, the phrases used in commerce, and the proofs and results of the processes which are described (and in a chemical patent the ascertainment of chemical equivalents)—that all these are matters of fact upon which evidence may be given, contradictory testimony may be adduced, and upon which undoubtedly it is the province and the right of a jury to decide.

His Lordship then commented on the judgment of Lord Cranworth, L.C., in *Bush* v. *Fox* (5 H.L. Ca. 707), and stated his conclusion, as borne out by the uniform practice at *Nisi Prius*, to be:—That although the construction of the specification clearly is matter of law, yet if there be two specifications to be compared in order to arrive at a question of fact, the right of drawing the inference of fact from the comparison belongs to the jury, and is a question of fact and not a question of law. His Lordship continued:—I was extremely desirous to ascertain in the course of the argument if any clear rule had 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. 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.

I have now to examine the general specifications, which, it is alleged, contain the plaintiff's invention. The first specification is

that of *Heard*, and the patent was granted in the year 1806. The proposition of the patentee is that all oxides of iron possess an affinity for sulphuretted hydrogen; he does not limit himself to 'oxides of iron,' for he says, 'iron, manganese, zinc, copper, lead,' &c. With regard to the greater number of these substances, the proposition is clearly, from the evidence, untrue, and therefore there is here what I have denominated apparent generality, giving no specific knowledge, no practical rule of application, but furnishing suggestions which might give a direction to inquiry. That is not such information as will be sufficient to support a patent. It adds nothing to the real stock of practical knowledge of mankind, and ought not to derogate from the validity and the benefit of a subsequent invention.

The next specification is that taken out by Mr. *Croll* in the year 1840. Mr. *Croll* says that the third part of his invention consists in the application of black oxide of manganese to remove sulphuretted hydrogen from coal-gas, and he describes a mode of restoring its purifying powers, by roasting it in an oven to expel the sulphur. He proceeds to say that 'the same effect may be produced by the application of the oxides of zinc and oxides of iron, and heated precisely in the way described.' This, therefore, is a proposition that 'the oxides of iron,' that is, 'all the oxides of iron,' may be applied in a manner which will admit of the same effect being produced. Now it is an admitted fact that that proposition is untrue; it is a clear result, therefore, that the proposition would only mislead the individual who relied upon it. It requires further invention and discovery to modify and restrain it within the true limits of fact.

I now come to the specification of *Laming*. The specification of *Laming* speaks of a particular agent in the purification of coal-gas—viz., chloride of calcium; and it describes a mode of producing that purifying agent, which would leave a residuum in which would be found hydrated oxide of iron, the application of which is the patented invention of the plaintiff. With regard to this residuum all that Mr. *Laming* says is:—'In such cases the oxides or carbonates which result are useful for the purification, and need not be removed.' His only proposition is that it is not detrimental to the use or agency of the chloride of calcium, but will rather assist and promote its operation. But that is a perfectly different thing from the discovery that the hydrated oxide of iron altogether superseded and rendered unnecessary the chloride of calcium.

I cannot find in any one of these patents a clear, distinct, and definite indication of the admittedly beneficial discovery which was afterwards made by the plaintiff.

The last subject of argument was, whether the plaintiff's specifica-

tion was itself open to a similar objection, viz., in using words in a sense too general for the actual truth. The particular words are in the plaintiff's specification, that he makes use of 'hydrated or precipitated oxides,' and it is said that 'precipitated' is there opposed to 'hydrated,' and that there are some hydrated oxides that would not answer the purpose, and that therefore the plaintiff's specification is bad for too great generality, and for inaccuracy. This objection was met in the Court of Exchequer by treating the word 'precipitated' as narrowing and correcting the generality of the word 'hydrated.' I prefer rather to rest upon the explanation, that if the word 'hydrated' be taken by itself, and be considered as including more than 'precipitated oxides,' it must still be confined to those hydrated oxides that are artificial, and there is no proof or suggestion that there is any known artificial hydrated oxide that will not answer the purpose.

Upon every ground therefore I arrive at the conclusion that the plaintiff's patent must be held to have been conclusively established at law. I grant the injunction as prayed in the third paragraph of the prayer. Considering the case as falling altogether under the provisions of the statute of 1852 (15 & 16 Vict. cap. 83, sect. 43), I direct the plaintiff's costs of the whole suit to be taxed as between solicitor and client, save that part of the bill which is founded on the agreement of *November*, 1860, and except the costs of the application to the Lords Justices and the hearing before them, as to which I give no costs to either party. That will be the whole of the decree, unless the plaintiff prefers, instead of the account, to have liberty to bring an action at law for damages, which he may take in lieu of the account. If not, I direct the account as prayed.

HILLS *against* THE LIVERPOOL GAS COMPANY, A.D. 1863.
9 Jur. N.S. 140.

Evidence of Infringement.

Suit to restrain from infringing the same patent by the use of a certain natural product found in *Ireland*, and known as *bog-ochre*. It appeared that the substance in question contained a large proportion of native hydrated oxide of iron, and that, when applied to the purification of gas, it absorbed sulphuretted hydrogen, and could be revivified by the action of atmospheric air as described in plaintiff's specification. WOOD, V.C. granted an injunction, but the LORD CHANCELLOR varied the order so as to restrain defendants from using bog-ochre in any other than its native or primitive state, and directed an account of all profits made by the user of such material in any other than its native state.

Per LORD WESTBURY, L.C.—With many of the observations of the Court of Exchequer in *Hills* v. *London Gaslight Company* (5 H. & N. 312) I cannot concur, but I do concur in the conclusion, that by the terms hydrated or precipitated oxides the plaintiff intends to denote such oxides only as were artificially prepared or obtained. But this is not the character of bog-ochre as it is primarily employed by the defendants. The ochre is used by the defendants as dug from the bog, and even if it be a hydrated oxide of iron formed by precipitation, it is clear that it is a native, that is, a naturally formed oxide, and whilst used in that state must, by the very condition by which the plaintiff's patent was supported, be held not to be included in the plaintiff's specification. I cannot grant an injunction to restrain the defendants from using bog-ochre in its natural state. The more material question still remains. The principal impurity from which it is desirable to cleanse the gas is sulphuretted hydrogen. The plaintiff discovered that when the sulphuret of iron is exposed to the atmosphere in such a manner as to cause the atmospheric air thoroughly to permeate and pervade the mass, the sulphur is driven off and precipitated, the iron is re-oxidised by taking up new oxygen from the air, and thus a new hydrated oxide is, by this application of a natural agent, artificially obtained. This new oxide I hold to be an oxide artificially prepared and obtained, although it is the result of the natural properties of the air, because those properties are guided and directed to this end by human agency and design. I hold that whilst the defendants employ the *bog-ochre* in its natural state, they use a native oxide of iron, which, whether it be hydrated only, or hydrated and precipitated, is not within the plaintiff's patent, and no injunction can be granted against the use of it; but when they use the ochre after it has been re-oxidised, they use a material which is within the plaintiff's patent, being an artificial hydrated oxide; and this I restrain them from employing.

HOFFMAN *against* POSTILL, A.D. 1869. L.R. 4 Ch. 673.

Practice as to Interrogatories in Patent Suits.

Suit to restrain from infringing a patent for a brick-kiln. Defendant filed interrogatories referring to certain specifications of prior patents—*e.g.*, 'Are not those sliding doors colourable variations of, or a mechanical equivalent for, the divisions or walls with openings (as referred to in a specification mentioned) between each compartment in the kiln?' 'Is there not, *therefore*, in this arrangement a continual reciprocal action of the kilns or oven?' By the 11th interrogatory the plaintiffs were questioned as to proceedings taken by them in *Saxony* for the infringement of their patent. By the 12th interrogatory

they were required to set forth a certain correspondence relating to their patent. By the 14th interrogatory to set forth descriptive particulars of the alleged infringements. Plaintiffs denied the similarity of the improvements referred to, and declined to answer more fully, or to give further particulars of infringement. Exceptions over-ruled by JAMES, V.C. Appeal to the Lords Justices, when the order was discharged, except so far as it over-ruled the exceptions relating to the 11th and 12th interogatories.

Per SELWYN, L.J.—A certain latitude must always be allowed in seeking discovery, and accordingly we have examined these exceptions with reference to the general rule, that the person who is bound to answer must answer fully. The fallacy of the argument which has been addressed to us is apparent, because it depends mainly upon these two propositions. *First*, that wherever there is a question relating to a matter of fact, and that question is so stated as to refer to any of the subject-matters of a specification or other written document, then the plaintiffs are not bound to answer. I think that is erroneous. The *second* proposition is this, that the discovery sought relates exclusively to the case made by the plaintiffs against the defendant in this suit. If it could be shown that it was not material to the case of the defendant, then, of course, it would be a good objection to the interrogatory; but, in truth, the case of the defendant is that the plaintiffs' patent is invalid, and everything that is material to show that is part of the defendant's case, and he is entitled to discovery as to all the matters of fact which are or may be material to his case.

Take, for instance, the question—'Are not those sliding doors, &c.' It is, in my judgment, a question of fact whether they are mechanical equivalents for the other contrivance which is there mentioned. That being so, I think the defendant was entitled to an answer to that question. I will take one other instance—'Is there not, *therefore*, in this arrangement, &c.' It is quite true that the word 'therefore,' as used in that sentence, does connect the question with what is mentioned in the specification, but it is nevertheless a question of fact, and a question which, in my judgment, the plaintiffs are bound to answer.

Per GIFFARD, L.J.—The defendant has a right to ask all questions which are fairly calculated to show that the patent is not a good patent, or that what the plaintiffs allege to be an infringement is not an infringement. It is almost impossible, where you have antecedent publications or patents, which are alleged to destroy the novelty of the succeeding patent, whether it be in examining the parties by interrogatories or in examining witnesses, to avoid the

necessity of referring to these documents, and asking a variety of questions respecting them, some of which are more proper for the Court, but many of which are absolutely essential in order to enable the Court to come to a proper conclusion as to the legal effect of the different specifications.

HOLLAND *against* FOX, A.D. 1854. 1 C. L. R. 440; 3 E. & B. 977.

Particulars of Objections. Account.

CASE for the infringement of a patent for improvements in manufacturing umbrellas. The particulars of objections delivered pursuant to stat. 15 & 16 Vict. cap. 83, sect. 41, stated prior user of the invention 'at *Sheffield*, *Birmingham*, and *London*.'

Rule nisi for further and better particulars made absolute by the Court of Queen's Bench. (Lord Campbell, C.J., Coleridge, Erle, Crompton, JJ.)

Per LORD CAMPBELL, C.J.—We are all of opinion that this particular is illusory. The names of persons are not required to be stated by the Act, but the manufactory or place where the invention has been used may be described by name or other description.

(3 E. & B. 977.) The cause proceeded to trial, and plaintiff had a verdict with 40*s.* damages. Plaintiff then obtained a rule absolute in the first instance ordering defendant to account for all articles made in breach of the patent before and since the commencement of the action (see stat. 15 & 16 Vict. cap. 83, sect. 42).

Rule nisi to discharge the above rule. It appeared on the affidavits that after the issuing of the writ a negotiation took place between the parties respecting a licence, and that in *July*, 1853, defendant had notice to account for profits, but that he continued to use the invention and to make profits thereby until two days after the trial—viz., 17th *Dec.* 1853, when he ceased the manufacture. Rule, so far as it ordered an account of profits, accruing after notice as above, made absolute by the Court of Queen's Bench. (Lord Campbell, C.J., Coleridge, Wightman, Erle, JJ.)

Per LORD CAMPBELL, C.J.—All the loss which the plaintiff sustained prior to the commencement of the action, and all the loss for which damages could have been given to him by the jury, must be considered to be compensated by the sum, however small, which they awarded to him. Objection is made that we have now no jurisdiction to order any account, the words of stat. 15 & 16 Vict. cap. 83, sect. 42, being, 'It shall be lawful for the Court in which such action is pending,' and the defendant arguing that this action is no longer pending in this Court. But we think the action is pending till final

judgment has been pronounced and entered up. The defendant having admitted that, after being charged with the infringement of the plaintiff's patent, and *after notice* that he would be held liable to account for the profits, he did make large profits by continuing to infringe the plaintiff's patent; and as no part of such profits could have been awarded by way of damages to the plaintiff; we think that the defendant may be considered as trustee of these profits for the plaintiff, and we order that the defendant render an account of these profits, and pay over the amount to the plaintiff.

HOLMES *against* THE LONDON and NORTH-WESTERN RAILWAY COMPANY, A.D. 1852. 12 C.B. 831; Macrory's Pat. Ca. 4.

Sufficiency of Specification. Novelty of Invention. The Specification must distinguish what is new.

CASE for the infringement of a patent of 28th *Jan.* 1841, No. 8,818, to *W. C. Harrison*, for 'an improved turning-table for railway purposes.' Pleas: 1. Not guilty. 3. That the invention was not new. 4. That the specification was insufficient. Issue.

The patent was for a turn-table, constructed so that the weight of the load bore upon a central pin, instead of being supported by rollers at the edge of the table. Previously it had been the practice to support the platform on a set of friction rollers placed near the periphery, and there was a central pin, not bearing any part of the weight, but merely acting as a guide to keep the structure in its place. The object of *Harrison's* invention was to diminish the resistance of friction. The platform was a rigid trussed table, and its whole weight was thrown upon a central pivot. There was (1) an upright post resembling a crane post and terminating in a pivot which supported the table; (2) a massive ring, called a roller case, encircling the base of the post and carrying friction rollers; (3) *vertical supending rods* to attach the roller case to the table; (4) oblique struts or support arms carried from the ring to the outer edge of the table. The specification described the whole apparatus as constituting the invention, and stated that the oblique arms would transfer all the stress from the outer side of the plate through the arms on to the suspending rods, and bring the weight directly on to the top of the post, the effect being that the table would move very much more lightly and easily than with the rollers round the circle in the ordinary manner. *Claim*: 'The improved turning-table hereinbefore described.'

At the trial, the defendants put in evidence the specification of a patent of 18th *Dec.* 1840, No. 8,745, to *E. R. Handcock*, which related to a turn-table pivoted on a central post. In this construction

(1) a coned pivot threw the weight of the table upon an upright central post; (2) a cylindrical shell or jacket encircled the post, and rotated on loose friction collars; (3) oblique stay bars were carried from the bottom of the jacket to points near the periphery of the table. The specification stated that the effect of these stay bars was to give a general support and stability to the platform. The patentee had, however, failed to see the importance of connecting the cylindrical jacket rigidly with the plate, and there was consequently no equivalent for the vertical suspending rods, and nothing analogous to a trussed beam.

JERVIS, C.J. directed the jury:—I think you will agree with me that the pivot is old; the radiating arms are old; the roller case is the same as the bottom of the jacket in *Handcock's* turn-table; that the rollers are the same as the collars, or equivalent to them; but that the suspending rods are new and useful, and that upon the evidence they are useful in equalising the pressure; and therefore the combination of three old things and one new one, A, B, C, and D, forms a new quality E, therefore there will be a novelty. Verdict for plaintiff. Leave reserved.

Rule nisi to enter a verdict for defendants on fourth issue made absolute by the Court of Common Pleas. (Jervis, C.J., Maule, Williams, Talfourd, JJ.)

Per JERVIS, C.J.—The jury found that the post, the arms, and everything except the suspending rods was old. In order to make his specification good, either for an improvement of an old machine, or for a new combination, *Harrison* should have said:—'My principle is to suspend the revolving platform on a post, with braces, arms, and supports;' and then going through *Handcock's* patent and describing all that is old, he should have gone on to say—'To this I add suspending rods for the purpose of bringing the bearing on to the centre of the table.' No one can read this specification without seeing that the patentee supposes the arms to be new, as well as the suspending rods. In short, that all is new except the table, the rails, and the catches, which, by means of the suspending rods, he converts into a new and improved suspended turn-table. That being so, he clearly does not, in my opinion, comply with the rule which requires the patentee distinctly to state what is new and what is old. In my judgment the specification is insufficient.

Per MAULE, J.—I am of the same opinion. All these parts are described together without making any distinction between the one and the other; all are described indiscriminately as comprising the invention. The true meaning of the specification is that there is as much novelty in one part as in another. No doubt *Harrison* drew

his specification without reference to *Handcock's* patent, and *bonâ fide* believing that the whole of what he was describing was his own invention. It is equally plain that the whole was not his invention.

HONIBALL *against* BLOOMER, A.D. 1854. 2 Webs. Pat. Ca. 199; 10 Ex. R. 538.

Novelty of Invention. Prior Public Use.

CASE for the infringement of a patent of 15th *Aug.* 1838, No. 7,774, to *W. H. Porter* (extended for six years), for 'improvements in anchors.' Plea: That the patentee was not the true and first inventor. Issue.

The specification stated:—'My invention relates to a mode of constructing the arms of an anchor, and applying them to the shank by means of an axis.' The drawing shewed the shank with two cheeks for receiving the arms, made of sufficient strength to hold a pin or axis, which was secured *in situ* by a split cotter. The end of the shank was marked *a*, the arms were marked *d*, the pin was *e*, and there were two horns or projections on the outside of each arm respectively marked *f*. The specification concluded by saying:—'I am aware that anchors have been made with arms capable of movement in the shank. I do not, therefore, claim the same generally.' *Claim*: 'The mode of constructing and combining the parts *a*, *d*, *e*, *f*, as above described.'

At the trial, one *Logan* was called, who deposed that in 1826 he had made an anchor identical in construction with *Porter's* anchor. That he sold the same for use in a steam-vessel called the *William Huskisson*, in the ordinary way of business, and that after ten years it was returned to him by a certain steam-boat company.

MARTIN, B. said:—'I think if that anchor of Mr. *Logan's* was sold in the regular way of business, although it turned out a failure, as possibly it may have been, this patent cannot be supported. I think myself that if it was really an experiment, that if Mr. *Logan* had put this anchor, having invented or manufactured it, on board a steam-boat for the purpose of trying whether it would answer, and it did not answer, and then it was returned on that ground, then I do not think that would interfere with the patent.' Plaintiff nonsuited.

The first particular in the notice of objections was thus proved, but plaintiff made no application to the judge for a certificate under stat. 15 & 16 Vict. cap. 83, sect. 43. On taxation, the master allowed the costs of the witness called in support of the first objection, as being part of the costs in the cause, but he refused to allow the costs of the remaining objections.

Rule nisi for the master to review his taxation discharged by the Court of Exchequer. (Pollock, C.B., Parke, Alderson, Platt, BB.)

HORNBLOWER and MABERLY *against* BOULTON and WATT (*in error*), A.D. 1799. 8 T.R. 95; Dav. Pat. Ca. 221.

Sufficiency of Specification.

CASE (being the sequel of the proceedings in *Boulton & Watt* v. *Bull*) brought by defendants in error, against plaintiffs in error, for infringement of *James Watt's* patent of 1769, No. 913. Plea: Not guilty. Issue. Verdict for plaintiffs below, and judgment by the Court of Common Pleas. Error brought in the King's Bench. Judgment for defendants in error.

Per LORD KENYON, C.J.—The principal objection made to this patent by the plaintiffs in error is, that it is a patent for a philosophical principle only, neither organised nor capable of being organised, and if the objection were well founded in fact it would be decisive; but I do not think it is so. No technical words are necessary to explain the subject of a patent; as Lord Hardwicke said upon another occasion—There is no magic in words. The questions here are: Whether, by looking at the patent, explained as it is by the specification, it does not appear to be a patent for a manufacture? and: Whether the specification is not sufficient to enable a mechanic to make the thing described? The jury have not indeed answered those questions in the affirmative in terms, but they have impliedly done so by finding a general verdict for the plaintiffs below. By comparing the patent and the manufacture together, it evidently appears that the patentee claims a monopoly for an engine or machine, composed of material parts, which are to produce the effect described, and that the mode of producing this is so described as to enable mechanics to produce it.

I have no doubt in saying that this is a patent for a manufacture, which I understand to be something made by the hands of man.

HORTON *against* MABON, A.D. 1862–3. 12 C.B. N.S. 437; 16 C.B. N.S. 141.

Subject-matter of a Patent.

CASE for the infringement of a patent of 2nd *Jan.* 1851, No. 13,436, to *J. Horton*, for 'improvements in the construction of gas-holders.' Plea 3. That the invention was not a new manufacture. Issue.

The patent related to a method of constructing the water cup, or hydraulic joint, which connects the several portions of a telescopic gas-holder. Instead of forming this joint, or water trough, by riveting strips of plate iron to lengths of angle iron, the patentee employed lengths of rolled channel iron which were curved to the circular form of the gas-holder. *Claim* 3: 'The mode herein shown

and described of constructing the hydraulic cups or joints of gas-holders in which the top or bottom of the hydraulic joint or valve is formed of plates of iron made or bent into a cup shape, so as to admit of the joint being attached to the gas-holder without the necessity of employing angle iron and double sets of rivets.'

At the trial, it appeared that rolled channel iron was in common use before the date of the patent. ERLE, C.J. directed the jury:—That the invention was not the subject-matter of a patent. Verdict for defendant. Leave reserved.

Rule nisi to enter a verdict for plaintiff discharged by the Court of Common Pleas. (Erle, C.J., Willes, Byles, Keating, JJ.)

Per ERLE, C.J.—This is in fact a claim for the application of double angle iron to the formation of hydraulic joints to telescopic gas-holders. It appears that those who had heretofore constructed telescopic gas-holders formed the hydraulic joints by riveting two pieces of angle iron to a plate which formed the top or bottom of the cup. It was perfectly apparent and palpable that double angle iron would answer the same purpose, and save two rows of rivets, and consequently much additional labour. The whole claim of the patentee therefore amounts to this—he informs the manufacturers of gas-holders that by the use of an article well known in the iron trade much labour and expense may be spared. This clearly is not the subject of a patent. It is nothing more than the application of a known instrument to purposes analogous to those to which it had before been applied. This is not a claim for a new article, or for an improved article, but only for a cheaper way of using known materials.

(16 C.B. N.S. 141.) On appeal to the Court of Exchequer Chamber (Cockburn, C.J., Crompton, Blackburn, Mellor, JJ., Martin, Channell, Pigott, BB.), judgment affirmed.

THE HOUSEHILL COMPANY *against* NEILSON, A.D. 1843.
1 Webs. Pat. Ca. 673; 9 Cl. & F. 788.

Misdirection by Judge as to prior Public User.

Appeal to the House of Lords, from a judgment of the Court of Session in Scotland, disallowing a bill of exceptions tendered by appellants, who were defenders in the Court below. The action was brought for the infringement of a *Scotch* patent for the application of the *hot-air blast* in smelting iron, granted to *J. B. Neilson.*

Exception 11. In so far as the Lord Justice Clerk directed the jury, in point of law, that the proof of prior use of the patent invention (1) must be public, (2) must have been continued, not abandoned, (3) must have continued to the time when the patent was granted,

not to the very exact period, but that it must have been known and used as a useful thing at the time.

(Webs. Pat. Ca. 718, *n.*) During the argument LORD LYNDHURST, L.C. observed:—'If the machine be published in a book distinctly and clearly described, corresponding with the description in the specification of the patent, though it has never been actually worked, is not that an answer to the patent? It is continually the practice on trials for patents to read out of printed books without reference to anything that has been done.' And LORD BROUGHAM said:—'It must not be a foreign book, but published in *England*.'

Judgment reversed upon the eleventh exception, and affirmed upon the others. *Venire de novo*. No costs to either side.

Per LORD LYNDHURST, L.C.—I never heard it before questioned that the notorious public use of an invention before the granting of the letters patent, though it may have been discontinued, is sufficient to invalidate the letters patent.

Per LORD CAMPBELL.—When we come to the eleventh exception, I most sincerely regret that we are bound to allow it. To suppose there may have been a prior use of the invention, of the perfected invention, for which the letters patent are granted, and that such prior use, publicly known, will not vitiate the patent, if it has been abandoned but a few weeks before the date of the patent, strikes us in this part of the country with astonishment. That certainly is not the law as we have ever understood it.

HUDDART *against* GRIMSHAW, A.D. 1803. Dav. Pat. Ca. 265; 1 Webs. Pat. Ca. 85.

Evidence of Infringement.

CASE for the infringement of a patent of 25th *April*, 1793, No. 1,952, to *J. Huddart*, for 'a new mode of making great cables and other cordage so as to attain a greater degree of strength by a more equal distribution of the strain upon the yarns.' Plea: Not guilty. Issue.

The patent related to a method of twisting yarns into a strand in such a manner that each separate yarn should bear the same strain. Hitherto, it had been the practice to stretch a number of yarns side by side before twisting them into a strand, whereby some of the yarns took one position and some another, those near the outside being in a state of tension while those in the inside were puckered up. The specification stated:—'The substance of this invention is the making of strands in which all the yarns shall be disposed in concentric cylindrical layers about a centre yarn. Each yarn is passed through a corresponding hole in a register plate. The holes are on the

circumferences of concentric circles round a central hole, and the yarns are then passed through a cylindrical tube. The strand thus formed is drawn forward by a screwing motion through the tube.' In this manner each yarn was retained in the position determined by the register plate, and a strand was formed of a series of concentric layers under equal tension, each ready to bear its due share of any tensile strain.

At the trial, Mr. *J. Rennie*, the engineer, deposed that, upon experiment, a piece of the patent rope bore a load of seventeen and a quarter tons and broke all at once, whereas a piece of common rope of the same size bore only about eight and a half tons, and snapped on the outside first, and so on successively towards the centre; he should have no difficulty in constructing the necessary machinery for making a rope upon Mr. *Huddart's* plan by looking at the patent and specification. In order to prove the alleged infringement plaintiff produced a piece of rope made by defendant. Mr. *Rennie* dissected the piece of rope, and found the external yarn to be two inches longer than the strand, the second shorter than the first, the third half an inch shorter than the second, and expressed his belief that the rope in question had been made on Mr. *Huddart's* method. Defendant called no witnesses.

LORD ELLENBOROUH, C.J., directed the jury:—Mr. *Rennie* says, I know of no other mode than Mr. *Huddart's* for producing this effect, and in proportion as that is deviated from, the strands will be worse; this piece of rope (the defendant's) exhibits to the eye that regular gradation of length in the different shells which he should expect to find in Mr. *Huddart's* invention. I should state that this is certainly what is called *primâ facie* evidence of its having been made by that method, when one sees it agree in all its qualities; when it is produced with a rope actually made upon Mr. *Huddart's* plan, it is *primâ facie* evidence, till the contrary is shown, that it was made upon his method, and therefore, supposing this patent in full force and a valid one, it is reasonable, fair evidence, in the absence of contrary evidence, to presume that it was made that way. Upon cross-examination, he says it would be a lucky hit if such a rope was made without the perforated plate; it could not be done otherwise than by chance.

Verdict for plaintiff.

HULL *against* BOLLARD, A.D. 1856. 1 H. & N. 134.

Evidence admissible under Particulars of Objections.

CASE for the infringement of a patent for a mill-stone. Plea 2. That the invention was not new. Issue.

The particulars of objections (stat. 15 & 16 Vict. cap. 83, sect. 41)

stated:—'That the improvements, &c., were not new, and that the same had been generally known, and *publicly used in corn-mills*, for many years previously.'

At the trial, the defendant tendered evidence of prior user at certain mills in *Cheshire*. MARTIN, B. received the evidence. Plaintiff nonsuited.

Rule nisi for a new trial, on the ground that this evidence was inadmissible, discharged by the Court of Exchequer. (Pollock, C.B., Martin, B.) During the argument POLLOCK, C.B. said:—'The substance of the particulars is that the invention has been used generally all over *England* in corn-mills for grinding corn. It cannot be said that it does not in some degree point out both place and manner, though if there had been an application for better particulars, I should not have held it sufficient.'

Per POLLOCK, C.B.—We are of opinion that if the evidence is within the literal meaning of the words of the particulars, however general the statement, the evidence should be received at the trial. If the particulars are too general, it is the business of the parties who mean to object to them to bring the case before a judge at chambers, and procure an order for better particulars. It is true that the statute (15 & 16 Vict. cap. 83, sect. 41) contains a proviso that the *place* or *places* at which the invention is alleged to have been used shall be stated, but that proviso does not prevent particulars, not containing such statement, from being available, if not objected to on that ground before the trial.

HULLETT *against* HAGUE, A.D. 1831. 2 B. & Ad. 370.

Novelty of Invention.

CASE for the infringement of a patent of 27th *Nov.* 1828, No. 5,718, to *W. E. Kneller*, for 'improvements in evaporating sugar.' Plea: Not guilty. Issue.

The patent related to a method of evaporating water from a solution of sugar, by blowing air into the liquid. The specification showed 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 be all in the same horizontal plane, whereby the fluid would exert the same pressure at each orifice.

At the trial, defendant put in evidence the specification of a patent of 9th *May*, 1822, No. 4,674, to *R. Knight* and *R. Kirk*, 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. Verdict for plaintiff.

Rule nisi to enter a nonsuit refused by the Court of King's Bench.

Per LORD TENTERDEN, C.J.—I cannot forbear saying, that I think a great deal too much critical acumen has been applied to the construction of patents, as if the object was to defeat, and not to sustain them. It is evident that the object of the two patents is the same. But the mode of effecting that object is different.

JONES *against* PEARCE, A.D. 1832. 2 Coop. Ch. Ca. 58; 1 Webs. Pat. Ca. 121, 122.

Evidence of Infringement. Unsuccessful Experiments. Practice in Patent Suits. Injunction. Account.

Suit to restrain from infringing a patent of 11th *Oct.* 1826, No. 5,415, to *T. Jones*, for 'improvements in wheels for carriages.' Motion for injunction ordered to stand over till after trial of action at law. Account in the meantime.

Action at law, in pursuance of the above order. Plea: Not guilty. Issue.

The patent related to the application of the suspension principle to the wheels of carriages, whereby the weight pressing on the axle was hung from the upper part of the rim of the wheel, instead of being supported by the spokes from below in the usual manner. *Claim*: 'Substituting suspending rods, made of iron or other suitable metal, in lieu of spokes, by which suspending rods I hang the weight or load from that part of the wheel which happens to be uppermost, and prevent any support by the rods under the axle-tree.'

At the trial, it appeared that a pair of wheels on the suspension principle had been made for Mr. *Strutt* in 1814, and applied to a cart used for carrying stones on the public roads. As to the infringement, plaintiff's foreman deposed that he saw at defendant's premises a pair of gig-wheels, made like plaintiff's on the suspension principle. PATTESON, J. directed the jury:—If this wheel, constructed by Mr. *Strutt's* order in 1814, was used openly in public, so that everybody might see it, and the use had continued up to the time of taking out the patent,* undoubtedly that would be a ground to say that the plaintiff's invention was not new. But if you are 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,

* See observations on this direction in *Carpenter* v. *Smith*, *supra*, page 73.

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 is no reason for saying that the plaintiff's patent is not good. It seems the defendant has constructed a wheel on the suspension principle; that alone would not make it an infringement of the plaintiff's patent, because the suspension principle may be applied in various ways; but if you think it is applied in the same way, then the want of two or three circumstances in the defendant's wheel which are contained in the plaintiff's specification would not prevent his recovering in this action for infringement. It would be quite a different thing if it was shown that the defendant had his communication long before with Mr. *Strutt*, and had taken up Mr. *Strutt's* invention, and had constructed something like it without any knowledge of the plaintiff's patent, and had actually borrowed it from Mr. *Strutt's*, which was good for nothing; it would be the hardest possible thing to say that this was an infringement of the plaintiff's patent.

In reply to a question from the jury, the learned judge further said:—The terms of the patent are, 'without leave or license, make, &c.' Now, if he did actually make these wheels, his making them would be a sufficient infringement of the patent, unless he merely made them for his own amusement or as a model.

Verdict for plaintiff.

JONES *against* BERGER, A.D. 1843. 5 M. & G. 208; 1 Webs. Pat. Ca. 544.

Sufficiency of Notice of Objections.

CASE for the infringement of a patent for improvements in manufacturing starch. The notice of objections, under stat. 5 & 6 Will. IV. cap. 83, sect. 5. alleged:—3. That the invention had been used before the date of the patent, 'by persons engaged in finishing lace at *Nottingham* and elsewhere.'

Rule nisi to amend the above particulars made absolute by the Court of Common Pleas. (Tindal, C.J., Erskine, Maule, Cresswell, JJ.)

Per TINDAL, C.J.—With regard to the third objection, I think if the words, 'and elsewhere,' are struck out, that there will be no objection to its present form. The patent in this case is for making starch generally, and the notice of objections does limit the user to a particular class of persons, namely, those engaged in the trade of lace-making, in a particular place—*Nottingham*; and it is quite as open to the plaintiff as it is to the defendant to make inquiries in that place among that class of persons.

JONES *against* LEES, A.D. 1856. 1 H. & N. 189.

Pleading. Demurrer. Covenant in a Licence.

COVENANT. The declaration, after setting out so much of the recitals in the deed as stated that plaintiff had invented certain improvements in slubbing and roving machines, and had obtained a patent for the same, averred that plaintiff had granted a licence to defendant to use the invention, and that defendant had covenanted not to make or sell any slubbing or roving machines without the invention applied thereto. Plea (in substance): That the invention was worthless, by reason whereof defendant was unable to use or vend the invention, or to use the licence, wherefore he made and vended machines without the invention applied. Demurrer, and joinder.

During the argument, it was contended that the covenant was void, as being in restraint of trade. Judgment for plaintiff by the Court of Exchequer. (Pollock, C.B., Alderson, Bramwell, BB.)

Per POLLOCK, C.B.—Our judgment must be for the plaintiff. The plea is substantially a plea to the damages only. Then, with respect to the declaration, it would be a very mischievous decision if we were to hold that a contract which, it may be presumed, was reasonable at the time it was entered into, might be construed as a contract in restraint of trade, because something more useful than the subject-matter of it had been invented.

JORDAN *against* MOORE, A.D. 1866. L.R. 1 C.P. 624.

Subject-matter of a Patent.

CASE for the infringement of a patent of 2nd *Nov.* 1849, No. 12,824 (extended for seven years), to *J. Jordan*, for 'certain improvements in the construction of ships.' Plea 4. That the invention was not a manufacture for which letters patent could by law be granted. Issue.

The patent related to the construction of ships with an iron frame and an external covering of wood. The specification stated:—'For carrying out my *first* improvement, a suitable iron frame is to be constructed, to which an external covering of timber planking for the sides, bilges, and bottoms will be fastened by means of rivets, bolts, or any suitable fastening. I make no claim to the shape of the iron used in the frame, as it may be constructed of angle iron, T iron, flat or bar iron, or iron of any suitable shape. The vessel may have one or more thicknesses of timber planking. For carrying out my *sixth* improvement, to construct an iron frame adapted to an external covering of timber planking for the sides, bilges, and bottoms, and for a timber keel, timber stem, and timber stern-post,

I make an iron plate form the keel-plate, laid the whole length of the bottom of the vessel, and continued up the stem and stern. To this plate I fasten the keel, stem, and stern post, made of timber, as described (previously). Across the keel-plate iron ribs are to be fastened, and floorings of iron are to be fastened to the iron ribs. On the top of the flooring I place the keelson, made with plate and angle iron, in the form of an inverted arch, to keep the ends of the vessel from drooping.' The drawings attached to the specification showed the construction of the frame-work, as covered with timber planking, described under the sixth head.

Claims: 1. 'The construction of ships with an *iron frame*, combined with an external covering of timber planking for the sides, bilges, and bottoms. 6. The construction of iron frames for ships adapted to an external covering of timber planking for the sides, bilges, and bottoms, as described.'

At the trial, it appeared that before the date of the patent the construction of ships with a combination of wood and iron was well known; that frames partly of iron and partly of wood had been coated with iron; and that iron coating had been placed on iron frames. Several specifications of prior patents were put in.

BYLES, J. left it to the jury to say whether at any time before the date of *Jordan's* patent any ship had been constructed with a complete iron frame, and an external coating of timber planking for the sides, bilges, and bottoms. Verdict for plaintiff. Leave reserved.

Rule nisi to enter a verdict for defendant, on the ground that the invention comprised under the first claim was not the subject-matter of a patent, made absolute by the Court of Common Pleas. (Erle, C.J., Willes, Byles, Keating, JJ.)

Per BYLES, J.—It was contended by the counsel for the defendant that the expression, 'iron frame,' in the first claim, was not confined to an iron frame such as that specified in the sixth claim, but comprehended whatever might, according to the ordinary use of language, be called 'an iron frame' for a ship. And on a careful consideration of the specification, we are of that opinion. The first claim is, according to our construction, a claim for planking with timber any iron frame of a ship.

Then arises the main question in the cause—iron and wood being both of them materials long used for the construction of the frame and coating of vessels—can the application of wooden planking to the iron frame of a vessel (without any peculiarity in the nature of that planking) be the subject of a patent. We think it cannot. It is not only the substitution of one well-known and analogous material for another, that is, wood for iron, to effect the same pur-

pose, on an iron vessel, but it is the application of the same 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. In this view of the case the recent decision of the House of Lords in *Harwood* v. *Great Northern Railway Company* (35 L.J. Q.B. 27) appears to us to be in point, and decisive for the defendant.

JUPE *against* PRATT, A.D. 1837. 1 Webs. Pat. Ca. 145.

Construction of Claim.

CASE for the infringement of a patent of 11th *March*, 1835, No. 6,788, to *R. Jupe*, for 'an improved expanding table.' Plea 3. Setting out the specification, and averring that it was insufficient. Issue.

The patent related to the construction of an expanding table, made in segments, which opened out by diverging from one common centre, the intermediate space being filled up by the insertion of additional pieces or leaves. The specification contained twenty-three drawings, illustrating various methods of subdividing tables, and of moving the segments in grooved guides, which radiated from a centre; and concluded by stating:—'I do not claim the various parts of the table separately; nor do I confine myself to the precise manner of moving the sections of the surface of the table. But I declare that my invention consists in constructing the same so that the sections of which the unexpanded table is composed may diverge from a common centre, and the table be enlarged by inserting leaves in the openings caused by the divergence as herein described.'

At the trial, defendant called no witnesses, but it appeared that, before the date of the patent, one *Gillow* had invented an expanding telescopic table which opened out in one line, the intermediate space being filled by leaves. The alleged infringement consisted in dividing a table into four parts, and applying *Gillow's* construction for expanding it. Verdict for plaintiff.

Rule nisi for a new trial made absolute by the Court of Exchequer. (Lord Abinger, C.B., Bolland, Alderson, BB.)

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

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

'I should entertain great doubt whether anything more is claimed here than an expanded table, and whether the contrivance is any part of the invention.'

KAY *against* MARSHALL, A.D. 1836–41. 1 Myl. & Cr. 373; 2 Webs. Pat. Ca. 36; 1 Beav. 535; 5 Bing. N.C. 492; 8 Cl. & F. 245.

Practice in Patent Suits. Demurrer. Subject-matter of a Patent.

Suit to restrain from infringing a patent of 26th *July*, 1825, No. 5,226, to *J. Kay*, for 'new and improved machinery for preparing and spinning flax,' &c.

The patent related to a process of macerating flax and spinning it at a short reach when in a wet state. The specification, however, stated:—'My invention consists in new machinery for macerating flax, and in improved machinery for spinning the same.' The drawing showed a set of cans, perforated for the admission of water, and placed in a trough of water before an ordinary flax-spinning frame. These cans were filled with rovings of flax, which were left to soak for several hours, and the wet sliver was then led between ordinary retaining and drawing rollers before being spun. The specification stating:—'I place the drawing rollers only two and a half inches from the retaining rollers, and this constitutes the principal improvement in the said spinning machinery.' *Claim*: 'What I claim as my invention in respect of new machinery for preparing flax are the macerating vessels and the trough of water; and in respect of improved machinery for spinning flax, I claim the placing of the retaining and drawing rollers nearer to each other than they have ever before been placed, say, within two and a half inches from each other, for the purpose aforesaid.'

The bill stated the grant of the patent, and that plaintiff had duly enrolled a specification wherein he had described and ascertained the nature of his invention. Demurrer for want of equity. SHADWELL, V.C. ordered the demurrer to stand over, with liberty to plaintiff to bring an action. On appeal to the Lord Chancellor the order was discharged, and the demurrer over-ruled.

Per LORD COTTENHAM, L.C.—Upon the face of the bill the plaintiff alleges that he did by his specification do all that his patent required him to do. What follows is merely the *claim*, not intended to be any description of the means by which the invention is to be performed, but introduced for the security of the patentee, that he may not be supposed to claim more than he can support as an inven-

tion. It is introduced (particularly in the case of a patent for an improvement) lest the patentee should have inadvertently described something which is not new, in order to render his description of the improvement intelligible. The claim is not intended to aid the description, but to ascertain the extent of what is claimed as new. It is not to be looked to as the means of making a machine according to the patentee's improvements. If, therefore, the specification as containing the description be sufficiently precise, it cannot be of any consequence that expressions are used in the claim which would be too general if they professed to be part of the description.

Feigned issue at law in pursuance of the order of the Court. Verdict for plaintiff, with an endorsement on the *postea* to the effect that, before the patent, flax, hemp, and other fibrous substances were spun with machines with slides whereby the reach was varied according to the length of staple or fibre. That in cotton spinning the reach varied from seven-eighths of an inch to an inch and a quarter, in flax spinning from four to nine inches, and in worsted from five to fourteen inches. That before the patent it was not known that flax could be spun by maceration at two and a half inches.

On application, LORD LANGDALE, M.R. stated a case for the opinion of the Court of Common Pleas, who (Tindal, C.J., Vaughan, Bosanquet, Erskine, JJ.) certified that plaintiff's patent was not valid in law.

Per TINDAL, C.J.—The patentee, in describing the new and improved machinery for spinning which constitutes one part of his patent, informs the public that he places the drawing rollers only two and a half inches from the retaining rollers, and that this constitutes the principal improvement in the said spinning machinery. Now, whether a patent can by law be taken out for placing the retaining rollers and the drawing rollers of a spinning machine (which machine was itself known and in use before), within two inches and a half of each other, under the circumstances stated in the case, is the real question between the parties; and we think it cannot. 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 that distance, 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 part of what is claimed is not properly the subject of a patent, or is not new, the whole must be void.

The case now came on to be heard on further directions, when the bill was dismissed with costs. On appeal to the House of Lords, judgment affirmed with costs.

Per LORD COTTENHAM, L.C.—All the variation which the plaintiff introduced into the ordinary spinning machine, which he claims as his invention, is fixing the rollers at two and a half inches distance from each other. It is not, as was argued at the bar, one invention, viz., the macerating of flax, and using flax so macerated with a particular machine. Another mode has been adopted of macerating the flax. If the patent be good so far as the spinning machine is concerned, the existence of the patent deprives the defendants and all the rest of the world of the right of using the ordinary spinning machine in the form in which they had a right to use it before the patent was granted. That is not the object of the patent: if the plaintiff has discovered any means of using the spinning machine which the world had not known before, the benefit of that he has a right to secure to himself by means of a patent; but if this mode of using the spinning machine was known before—and the endorsement upon the *postea* states that it was known before—then the plaintiff cannot deprive others of having the benefit of that which they enjoyed before.

LANG *against* GISBORNE, A.D. 1862. 31 Beav. 133.

Evidence of prior Publication.

Suit to restrain from infringing a patent for a self-registering target constructed in such a manner that an electric current should indicate the particular segment struck by the bullet. It appeared that four copies of a book by *V. du Moncel*, published in *France*, and containing an account of a like invention by one *De Brettes*, had been sold in *London* before the date of the patent. One of these copies was purchased for the library of the University of *Cambridge*. Injunction refused. Costs reserved.

Per ROMILLY, M.R.—I am of opinion that a publication takes place when the inventor of any new discovery, either by himself or by his agents, makes a written description of it and prints it in a book and sends it to a bookseller's to be published in this country. I think that as soon as the work is offered for sale in the public shop of a bookseller in this country, that becomes a publication of the invention. Here I have it proved that a public library in one of the large universities of *England* had actually bought the book. [His Honour then examined the evidence, and came to the conclusion that *De Brettes'* invention was identical with that of the plaintiff.] The real and only question is whether the fact of *V. du Moncel's* book

having been sent to this country and publicly exposed for sale in an ordinary bookseller's shop, and bought by several persons, and among others by a public library, amounts to a publication of the invention here; because so long as it remained in *France* it was not a publication. I have already expressed my opinion, and it follows that I cannot treat this as a valid patent.

LAWES *against* PURSER and OTHERS, A.D. 1856. 6 E. & B. 930.

Pleading. Demurrer. Consideration for a Licence.

Action for money payable by defendants to plaintiff on account of royalties under an agreement for the use of a certain patent. Plea: That the patent was void, and that defendants had a right to make and sell the articles without plaintiff's permission. Demurrer, and joinder. Judgment for plaintiff by the Court of Queen's Bench. (Lord Campbell, C.J., Coleridge, Wightman, Erle, JJ.)

Per LORD CAMPBELL, C.J.—I am of opinion that the defendants, not denying that they have used the invention under the agreement, cannot set up this defence. No fraud is alleged, no renunciation of the permission, warning the plaintiff that the defendants meant to claim to use the invention in their own right, is averred. I think it would be contrary to all principle to hold this plea good.

Per WIGHTMAN, J.—It is clear that the agreement has been acted upon; and the defence is that, the patent being invalid, there is, as it is said, no consideration; but it seems to me that the defendants had, in fact, all that they bargained for. It may very well be that the discovery that the patent was invalid was only made at the time of the plea pleaded; and it is clear to me that enjoyment by permission of the patentee, while the patent was supposed to be valid, is consideration. The point is very nearly the same as that in *Taylor* v. *Hare* (1 B. & P. N.R. 260).

Per ERLE, J.—It is my opinion that the defendants are bound by their promise, they having had the consideration they bargained for.

LEWIS and ANOTHER *against* DAVIS, A.D. 1829. 3 Car. & P. 502.

Subject-matter of a Patent.

CASE for the infringement of a patent of 15th *Jan.* 1818, No. 4,196, to *J. Lewis*, *W. Lewis*, and *W. Davis*, for 'improvements in shearing machines for shearing woollen and other cloths, the same being further improvements on a patent obtained by *J. Lewis* for an improved shearing machine, dated the 27th *July*, 1815.' Plea: Not guilty. Issue.

The patent related to a method of shearing cloth by a triangular

steel cutting wire bent round a cylinder in the form of a spiral. The specification described the machine by reference to drawings, whereof one showed the cylinder and cutting wire adapted for shearing cloth from list to list. It also stated:—'A narrow strip of plush is fixed on the surface of the cylinder parallel to the cutting wire to answer the purpose of a brush for raising up the wool which is to be shorn off the cloth; or, instead of the plush, bristles may be inserted into the cylinder.' There were flat springs and a steel bar for directing and pressing the cloth against the cutting edges. *Claims*: 1. 'The application of the flat springs and bar for directing and pressing the cloth to be shorn against the cutting edges. 2. The application of the triangular steel wire on the cylinder. 3. The application of a proper substance fixed on the cylinder to brush the surface of the cloth to be shorn. 4. The described method of shearing cloth from list to list by a rotatory cutter.'

At the trial, LORD TENTERDEN, C.J. required the production of the previous patent of 1815. It appeared that the alleged infringement consisted in making a machine with rotatory cutters for shearing from list to list, but that defendant had not infringed any of the first three claims of invention; also that the old method of shearing from list to list was by machinery carrying shears. It further appeared that rotatory cutters for shearing lengthways, or from end to end, were not new at the date of the patent, and evidence was adduced to show that plaintiffs' improvements were useful.

LORD TENTERDEN, C.J. directed the jury:—It is not material whether a machine made under the patent of 1815 is useful or not, as it is shown that the plaintiffs' machine is highly useful. The case stands thus: it appears that a rotatory cutter to shear from end to end was known, and that cutting from list to list by means of shears was also known. However if, before the plaintiffs' patent, the cutting from list to list and the doing that by means of rotatory cutters were not combined, I am of opinion that this is such an invention by the plaintiffs as will entitle them to maintain the present action.

Verdict for plaintiffs. In the ensuing term a rule for a new trial was moved for and refused.

LEWIS and ANOTHER *against* MARLING, A.D. 1829. 4 Car. & P. 52, 57; 10 B. & C. 22; 1 Webs. Pat. Ca. 490.

Partial failure of Utility. Novelty of Invention.

CASE for the infringement of the same patent. Plea: Not guilty. Issue.

At the trial, it appeared that when two or more cutting wires were fixed on the cylinder, the brush described in the previous abstract

was not required and was not used. Also that, in 1811, a specification had been enrolled in *America* for a machine to shear cloth from list to list by rotatory cutters; that a model of this machine was brought to *England*, and there exhibited to three or four persons; that workmen were employed to construct a machine from the *American* specification, but that no such machine was ever completed. Also that the manufacturer who commenced to construct the *American* machine had become a purchaser of plaintiffs' machines.

It was objected that the patent was void by reason of claiming the plush for raising the wool, which was useless. LORD TENTERDEN, C.J. over-ruled the objection. Verdict for plaintiffs with 200*l.* damages.

(10 B. & C. 22.) Rule for a new trial, on the grounds (1) that the brush was of no use, (2) that shearing from list to list by rotatory cutters was not new, refused by the Court of King's Bench. (Lord Tenterden, C.J., Bayley, Parke, JJ.)

Per LORD TENTERDEN, C.J.—As to the objection on the ground that the application of a brush was claimed as part of the invention, it does not appear that the patentee says the brush is an essential part of the machine, though he claims it as an invention. I agree that if the patentee mentioned that as an essential ingredient in the patent article, which is not so, nor even useful, and whereby he misleads the public, his patent may be void; but it would be very hard to say that this patent should be void because the plaintiffs claim to be the inventors of a certain part of the machine not described as essential, and which turns out not to be useful. Several of the cases already decided have borne hardly on patentees; but no case has hitherto gone the length of deciding that such a claim renders a patent void, nor am I disposed to make such a precedent.

I told the jury that if it could be shown that the plaintiffs had seen the model or specification, that might answer the claim of invention; but there was no evidence of that kind, and I left it to them to say whether it had been in public use and operation before the granting of the patent. They found it had not, and I think there is no reason to find fault with their verdict.

Per PARKE, J.—The patent is for several things, one of which then supposed to be useful is found out not to be so; but there is no case deciding that a patent is on that ground void, though cases have gone the length of deciding that if a patent be granted for three things, and one of them is not new, it fails *in toto*. The prerogative of the Crown as to granting patents was restrained by the statute 21 Jac. I. cap. 3, sec. 6, to cases of grants 'to the true and first inventors of manufactures, which others at the time of granting the patent shall not use.' The condition, therefore, is that the thing shall be new,

not that it shall be useful; and although the question of its utility has been sometimes left to a jury, I think the condition imposed by the statute has been complied with when it has been proved to be new. There was no evidence of the use of such a machine [as the plaintiffs'] before the grant of the patent, and 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 intc use.

LISTER and DONNISTHORPE *against* LEATHER, A.D. 1858. 8 E. & B. 1004.

Evidence of Infringement. Protection of part of a new Combination. Sufficiency of Particulars of Objections.

CASE for the infringement of patents (each in part disclaimed) of 20th *March*, 1850, No. 13,009, to *S. C. Lister* and *G. E. Donnisthorpe*, and of 2nd *Feb.* 1852, No. 13,950, to *S. C. Lister* and *T. Ambler*, for 'improvements in combing wool.' Pleas (as to patent of 1850): 1. Not guilty. 3. That plaintiffs were not the true and first inventors. 4. That the invention was not new. 5. That the specification was insufficient. And like pleas as to patent of 1852. Issue.

The particulars of objections (see stat. 15 & 16 Vict. cap. 83, sect. 41) alleged prior publication of the invention by the specifications of divers patents, stating only the names of the patentees. On order for better particulars, defendant amended by further stating that the patents relied on had been granted 'to plaintiffs and each of them respectively, between 1st *Jan.* 1840, and 20th *March*, 1850.' At the trial, ERLE, J. ruled that this was not a sufficient compliance with the order, and refused to admit in evidence the specification of a patent granted to plaintiffs in 1849. The Court of Queen's Bench supported this ruling.

The patents related to improvements on a patent of 25th *Feb.* 1846, No. 11,103, to *J. Heilmann*, for a new method of combing wool. According to *Heilmann's* patent, the fleece of wool as fed into the combing machine was detached and broken asunder while being nipped or held either between bars or between a delivering roller and a guide plate. Each end of the portion was combed successively, the long and short fibres being separated; the long ones being united into one sliver and the short ones into another, and so passed out ready for drawing and roving.

The specification of the patent of 1850, No. 13,009, stated that one part of the invention consisted of improvements in arranging apparatus by which the mode of preparing wool by taking hold of, drawing out, detaching and strengthening by mechanical means, successive small quantities of fibrous material, as described in a previous patent of 1849 (No. 12,712), might be more advantageously

carried into effect. It described the machine by reference to drawings, and showed a series of gill combs for bringing forward the wool. A tuft was then drawn out by the nipping action of a bar upon an endless travelling apron and was cleaned by combing at one end. A porter brush detached the half-cleaned tuft and deposited it on a comb, which speedily became filled with wool ready to be drawn off and deposited in a cleaned state on a travelling apron, the noil and dirt being left on the opposite side of the comb. There was no separate claim.

The specification of the patent of 1852 stated :—'Fifthly, our invention relates to transferring wool from one set of carrying combs to another.' It then showed an arrangement of link work, consisting of a short revolving crank and a reciprocating arm connected by a link which was produced beyond its point of connection with the crank and carried a comb. By the revolution of the crank this comb swept to and fro through a given space, and lifted a tuft of wool from one fixed comb and deposited it upon another. *Claim* : 'The various improvements herein described in the processes of preparing and combing wool and other fibrous materials.'

At the trial, it appeared that plaintiffs had purchased *Heilmann's* patent of 1846, and had amended the specifications (of 1850 and 1852) with the intention of disclaiming any portions of that invention which might be contained therein.

The alleged infringement of the patent of 1850 consisted in the transferring a half-cleaned tuft by means of a porter instrument on to a comb for the purpose of drawing it off and completing the combing according to plaintiffs' process.

The alleged infringement of the patent of 1852 consisted in the use of a comb rotating on a cylinder which lashed into the feed during its ascent, detached a tuft, and deposited it on another comb by its descent during each revolution.

The patent of 1849, No. 12,712, was tendered in evidence under the notice of objections ; but ERLE, J. refused to admit it, being of opinion that the amended notice before referred to was not a sufficient compliance with the order for better particulars.

Verdict for plaintiffs.

Rule nisi for a new trial, on twenty-one grounds of objection, discharged by the Court of Queen's Bench. (Lord Campbell, C.J., Coleridge, Wightman, Erle, JJ.)

Per LORD CAMPBELL, C.J.—The object of the manufacture is to remove the noil, or dirt, and short fibres from wool, and to make the long fibres into a sliver, from which the thread is spun ; and this object was originally effected by a lashing process, at first by hand, and then by a series of mechanisms improved by inventors ; then with a

nipping process instead of lashing invented by *Heilmann* in 1846; and his process was followed by improvements by other inventors down to the process claimed by the plaintiffs as their invention in 1850. In this process a tuft is detached from the lap of wool by nipping, and the tail half of the tuft is cleaned in detaching; then this tuft is placed in such a position that by drawing off the head half is also cleaned and a good sliver is procured. The process combines five movements of the wool to be made in a certain order—viz., 1. carrying in; 2. detaching; 3. transferring; 4. depositing; 5. carrying out—each producing a certain change, and the total of the changes resulting in a product of a good sliver from uncombed wool; and the mechanism combines all the subordinate mechanisms that make these movements in their order. The patent is for the whole combination of mechanism for performing the whole process as described in the specification.

In respect of this invention (*Heilmann's*) two questions were raised, one of fact for the jury, that is: Was the plaintiffs' invention, taken as a whole, substantially the same as *Heilmann's*? and one of law for the Court, in respect of *Heilmann's* nipping process. With respect to the plaintiffs' invention being substantially the same as *Heilmann's*, the jury saw the two machines, and thought them substantially different; and we have also considered them and do not think that the jury have come to a wrong conclusion. Then was there misdirection in respect of this issue? The jury were told in the common form on this point, 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. In this there was no misdirection.

With respect to the issue on the infringement of the patent of 1850, the evidence was that the defendant used *Crabtree's* machine in which a tuft was detached by a comb lashing into feed carried in by porcupine rollers, and was cleaned as to its tail half by carding surfaces. This part of the process was said to be substantially different from the part of the plaintiffs' process relating to the first half of the tuft. But with respect to the transferring the tuft, so half cleaned by a porter instrument, and placing it on a comb for carrying it out, the evidence for the plaintiffs was strong to show that this material part of the process used by the defendant was identically the same with that specified by the plaintiffs in 1850; and that the combination of mechanism used by the defendant for performing this part of the process was substantially the same as that described in the plaintiffs' specification in 1850. The law was laid down that the plaintiffs' patent was for the whole combination, for the whole process as speci-

fied; but that the defendant might be guilty of an infringement without using that whole combination for that process. Objections have been raised to this part of the summing-up in many shapes; the substance of all being, that the taking of a part is either no infringement of a patent for a whole, or, if it is, the patent for the whole is void unless every part is new. But all the points made for the defendant here were made and over-ruled in the three cases which decide that a patent for a whole combination may be infringed by taking a part, provided it is a new and a material part, of the combination. His Lordship then proceeded to comment on the cases (*Sellers* v. *Dickinson*, 5 Ex. R. 312; *Newton* v. *Grand Junction Railway*, 5 Ex. R. 331; *Smith* v. *London and North-Western Railway Company*, 2 E. & B. 69.) and continued:—We cite these cases at length because the principle in all is the same as that laid down to the jury in the present case, and they establish 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, without any express claim of particular parts, and notwithstanding that parts of the combination are old.

With respect to the infringement of the patent of 1852: the comb of the defendant rotated on a cylinder, and in ascending lashed into the feed and detached a tuft, and in descending deposited it on a carrying-out comb. The plaintiffs' comb performed precisely the same action and with the same effect. As to the last half of the process, namely, that relating to the head of the tuft, the variation of form was that the plaintiffs' comb did by oscillation what the defendant's comb did by rotation with two semi-axial turns. The jury found for the infringement; and we see no valid objection either to their finding or to the summing-up. Another ground for a new trial was the rejection of the office copy of the plaintiffs' specification in 1849 tendered by the defendant. After a summons, a judge made an order on defendant to give the names and dates of the specifications of the plaintiffs intended to be used, or that they should be excluded. The defendant then gave notice for all the plaintiffs' specifications between 1840 and 1850, and contended at the trial that this was a compliance with the order. The judge ruled that it was not. On this ruling we see no mistake of law.

On appeal to the Court of Exchequer Chamber (Pollock, C.B., Williams, Willes, JJ., Martin, Bramwell, Watson, BB.), judgment affirmed.

Per WILLIAMS, J.—It was argued before us, on behalf of the appellant, that, if a patent be taken out for a combination of *a*, *b*, and *c*, it could not be infringed by using a combination of *b* and *c*

only. We are of opinion that the answer to this inquiry turns altogether upon what *a*, *b*, and *c* are, how they contribute to the object of the invention, and what relation they bear to each other. Cases may possibly be suggested where the use of *b* and *c* might not be an infringement of the patent; but more easily cases may be put where the use of *b* and *c* would be an infringement of the patent. Whether in this case it was so or not would depend on the facts of the case, and may be more a question of fact for the jury than of law for the Court of Appeal. But the facts are not before us, and we think the Court was right in deciding that the use of a subordinate part of the combination might be an infringement of the patent if the part so used was new (by which we understand new in itself, or in its effect, not merely in its application) and material.

It may be that a combination is not distinctly and expressly claimed in either of these patents. But neither a claim nor a disclaimer is essential to a specification; that which appears to be the invention, or a part of it, will be protected, though there be no claim; and those matters which manifestly form no part of the invention need not be disclaimed.

LISTER *against* EASTWOOD, A.D. 1864. 9 L.T. N.S. 766.

Infringement by User of part of a Combination.

CASE for the infringement of two patents for combing wool, viz., of 20th *March*, 1850, No. 13,009, and of 24th *Feb.* 1851, No. 13,532. The cause was tried before Erle, C.J., when the jury found for defendant.

Rule for a new trial—on the ground of misdirection by the learned judge in telling the jury that, if defendant had taken a new and material part of plaintiff's combination, it was necessary that the part so taken should be used for precisely the same purposes in order to constitute it an infringement of the plaintiff's patent—refused by the Court of Common Pleas.

Per WILLIAMS, J.—The Chief Justice proceeded to tell the jury that in order to constitute an infringement the defendant must not only have taken a new and material part of the combination, but must also have applied it to a purpose similar or analogous to that which the plaintiff's combination was intended to effect. We are of opinion that this was a correct exposition of the law. It is true that in the judgment of the Court in *Lister* v. *Leather* (8 E. & B. 1004) this qualification of the doctrine was not superadded in express terms, but it appears to us to flow inevitably from the principles on which that doctrine was founded.

LOSH *against* HAGUE, A.D. 1838. 1 Webs. Pat. Ca. 200.

Subject-matter of a Patent. New use of an old thing.

Suit to restrain from infringing a patent (in part disclaimed) of 31st *Aug.* 1830, No. 5,989, to *W. Losh*, for 'improvements in the construction of wheels for carriages *to be used on railways*.' Injunction granted by SHADWELL, V.C., plaintiff undertaking to bring an action at law.

Action accordingly. Plea 3. That plaintiff was not the true and first inventor. Issue.

The specification stated:—'The spokes, the rims or felloes, and the tires of wheels constructed according to my improvements, are to be made wholly of malleable iron.' *Claim* 3: 'The making the wheels of carriages to be used on railways with wrought-iron spokes, having elbow bends at the outer ends to form feet, which ends are joined by welding either to a complete ring of wrought-iron, around which a hoop of wrought-iron tire is to be fixed, or else to a hoop of wrought-iron tire made of sufficient strength in manner hereinbefore described.'

At the trial, defendant put in evidence the specification of a patent of 24th *Sept.* 1808, No. 3,169, to *J. Paton*, for 'improvements in the construction of wheels for carriages,' which stated:—'1. Instead of making my wheels of wood I make the stocks or naves of wrought-iron. 2. In place of wood spokes I insert spokes made of wrought-iron. 5. I make the *fillys*, or the external circle that the tire fixes on, of iron or other metal, and make them and the spokes of one solid piece, or fix the *fillys* to the spokes with rivets, screws, and nuts.'

LORD ABINGER, C.B., directed the jury:—It does appear to me that Mr. *Losh* claims a wrought-iron circumference as part of the *modus operandi* of making his wheel. If you are of that opinion, if you think he substantially claims the wrought-iron periphery as part of his improvement, and you think that that wheel with the wrought-iron periphery has been made before, and made substantially in the same manner, the defendant will be entitled to your verdict.

The learned counsel has stated to you that Mr. *Losh* has taken out his patent to use his wheels on railways. He says the wheels made by Mr. *Paton*, or by the other workmen who were called as witnesses, were never applied to railways at all. There is some nicety in considering that subject. The learned judge then discussed the case of *Hall v. Jarvis* (1 Webs. Pat. Ca. 100), and continued:—That was the application of a new contrivance to the same purpose; but it is a different thing when you take out a patent for applying a new contrivance to an old object, and applying an old contrivance to a

new object—that is a very different thing. In the case the learned counsel put, he says, if a surgeon goes into a mercer's shop and sees the mercer cutting velvet or silk with a pair of scissors with a knob to them, he, seeing that, would have a right to take out a patent in order to apply the same scissors to cutting a sore, or a patient's skin. I do not quite agree with that law. I think if the 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 this subject is this: that you cannot have a patent for applying a well-known thing which 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? I must own, therefore, that it strikes me, if you are of opinion that this wheel has been constructed by the persons who have been mentioned long before the plaintiff's patent, that although there were no railroads then to apply them to, and no demand for such wheels, yet the application of them to railroads afterwards by Mr. *Losh* will not give effect to his patent. That is my opinion on the law, and on that I am bound to direct you substantially.

Verdict for defendant on third issue.

McCORMICK *against* GRAY, A.D. 1861. 7 H. & N. 25.

Evidence of Infringement. Novelty of Invention.

CASE for the infringement of a patent of 7th *Dec.* 1850, No. 13,398, to *R. A. Brooman*, for 'improvements in agricultural machines' (a communication from abroad). Pleas: 1. Not guilty. 2. That plaintiff was not the true and first inventor. 6. That the invention was not a new manufacture within the statute. Issue.

The patent related to a form of reaping machine provided with a gathering reel for bringing the straws into position, and having also holding fingers and a cutting blade. The specification stated:—'The fingers hold the straws from yielding with the lateral action of a cutting blade; and for better accomplishing this object they are formed of a shape like a spear-head, which causes the straws to slide into the spaces between them, and, as the inclined edges of the roots of the fingers form an acute angle with the edge of the knife, the

cutting through of the straws is sure to be effected by the reciprocating movement of the knife blade.' A drawing attached to the specification showed the cutting blade, which was a strip of steel having serrated teeth formed either upon a straight or an indented edge. *Claim*: 'The construction of reaping or grain cutting and gathering machines, according to the improvements described; that is to say, the constructing and placing of holding fingers, cutting blades, and gathering reels respectively, as before described, and the embodiment of those parts as so constructed and placed, all or any of them in machines for reaping purposes, whether such machines are constructed in other respects as before described, or however else the same may in other respects be constructed.'

At the trial, it appeared that the alleged infringement consisted in making and selling knives or cutting blades similar to those of plaintiff. Defendant put in certain volumes of the *Franklin Institute*, containing the specifications of prior patents for improvements in reaping machines. Verdict for plaintiff, subject to a case stated.

The questions for the opinion of the Court were:—1. Whether the publications referred to in the notice of objections entitled the defendant to a verdict on the second and sixth issues. 2. Whether the making and selling by defendant of the knives or pieces of steel was an infringement of the patent. Judgment for defendant by the Court of Exchequer. (Pollock, C.B., Martin, Bramwell, Channell, BB.)

Per POLLOCK, C.B.—I am of opinion that our judgment ought to be for the defendant. I agree with the observation of my brother Martin that the plaintiff's invention is substantially an embodiment of the machine for cutting grain mentioned in the 10th volume of the *Franklin Institute*, published in the year 1845. It seems to me that the description of that machine is sufficient to render the subject-matter of the plaintiff's patent not a new invention; at least it shows that the plaintiff ought not to have claimed each of the three materials—viz., the holding fingers, the cutting blades, and the gathering reels. It may be that if a person made a reaping machine with a cutting blade like the plaintiff's, that would be an infringement of his patent; but a blade is not, in my judgment, a machine, and the making it will do no harm to the plaintiff until it is adapted to a reaping machine.

Per MARTIN, B.—If our judgment depended on the question whether the making by the defendant of the cutting blade was an infringement of this patent, I should not be prepared at present to concur. However, it is not necessary to express an opinion on that point, because it is clear that this patent is void for want of novelty.

Per BRAMWELL, B.—There is no difference between making a thing with one intent and another. If a man may do a thing, he may do it with whatever intent. If the blade is used in some machine not the same as that described in the patent, the patent is not infringed. I am satisfied that the defendant is entitled to a verdict on the plea of not guilty.

Per CHANNELL, B.—I do not understand that the patentee claims the invention of cutting blades *simpliciter*, but only when placed in a machine of this description. That being the construction which I put on the specification, it seems to me that there has been no infringement of the patent.

MACFARLANE *against* PRICE, A.D. 1816. 1 Stark. R. 199.

A Specification must distinguish the new from the old.

CASE for the infringement of a patent of 29th *Dec.* 1808, No. 3,189, to *M. McGregor* and *W. Macfarlane*, for 'improvements in umbrellas.' Plea: Not guilty. Issue.

The patent related to the construction of folding umbrellas, and the specification contained several drawings, whereof one represented the contrivance pirated, being a method of inserting a stretcher into a whalebone socket. There was no distinction drawn as to what was new or what was old. Plaintiff nonsuited.

LORD ELLENBOROUGH, C.J. said:—'The patentee in his specification ought to inform the person who consults it, what is new and what is old. He should say, "My improvement consists in this;" describing it by words if he can, or if not by reference to figures. But here the improvement is neither described in words nor by figures; and it would not be in the wit of man, unless he were previously acquainted with the construction of the instrument, to say what was new and what was old. Then it is said that the patentee may put in aid the figures; but how can it be collected from the whole of these in what the improvement consists?'

MACKELCAN *against* RENNIE, A.D. 1862. 13 C.B. N.S. 52.

Sufficiency of Specification.

CASE for the infringement of a patent of 8th *Sept.* 1857, No. 2,338, to *G. J. Mackelcan*, for 'improvements in floating docks.' Plea: That the specification was insufficient. Issue.

The patent related to the construction of a floating dock intended to be sunk sufficiently for the reception of a ship, and then floated so as to lift the ship out of the water. 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.' 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. *Claim*: 'The arrangement and combination of all the parts of my floating dock as represented and described.'

At the trial, it appeared that floating docks constructed of timber were well known before the patent, and that plaintiff's invention consisted in constructing such docks of iron. There being, however, no mention of iron in the complete specification, ERLE, C.J. ruled that the provisional specification could not be prayed in aid for the purpose of supplying a defect in the complete specification, and plaintiff was nonsuited.

Rule for a new trial, moved for by plaintiff in person, on the ground of misdirection, refused by the Court of Common Pleas. Plaintiff submitted that the drawings annexed to the specification sufficiently showed to the eye of an engineer that the structure was intended to be of iron, it being impossible that the geometrical lines employed could have any other meaning.

Per WILLIAMS, J.—The plaintiff in this case had obtained a patent for 'improvements in floating docks.' In the course of the trial, it appeared that the construction of floating docks was not novel. The plaintiff then alleged that his invention did not consist in the construction of floating docks, but in the application of iron so as to form air-tight and water-tight chambers.

The Lord Chief Justice was of opinion, that, inasmuch as there was no mention of iron in the complete specification, the plaintiff had not complied with the conditions of the letters patent by duly describing the nature of his invention, and in what manner it was to be carried into effect; and accordingly he directed a nonsuit to be entered. We are all of opinion that he was quite right in so doing. The complete specification, taken by itself, confessedly did not make any such claim as suggested. It has, however, been urged by the plaintiff, that, if it be read with the provisional specification, it will be found substantially to contain that claim. But even if the specification can be so read (which we do not admit) we are of opinion that it discloses no such claim, and therefore that the nonsuit was right. We think it right to add that it must not be inferred that the Court entertains an opinion that the alleged invention, even if it were appropriately claimed, could properly be the subject of letters patent. We wish not to be supposed to sanction such a notion.

MACNAMARA *against* HULSE, A.D. 1842. Car. & M. 471; 2 Webs. Pat. Ca. 128, *n.*

Novelty of Invention. Sufficiency of Specification.

CASE for the infringement of a patent of 15th *March*, 1837, No. 7,324, to *R. Macnamara*, for 'improvements in paving roads.' Pleas: 2. That plaintiff was not the true and first inventor. 4. That the specification was insufficient. Issue.

The specification stated:—'My invention consists in an improved method of cutting or forming stone *or other suitable material*, for paving roads;' and described the blocks by reference to figures which showed that the upper surface of a block was rectangular, and that the sides were bevelled in two halves; the angle of the bevel not being stated. *Claim*: 'The mode of forming stones to the figure shown for the purpose of producing better paving of roads as described.'

At the trial, defendant put in evidence the specification of a patent of 10th *Nov.* 1825, No. 5,287, to *J. J. A. McCarthy*, for paving blocks which had two bevels inwards and two bevels outwards on the same side, one over the other, whereby it was apparent that plaintiff's block could be made from *McCarthy's* block by cutting it into two halves along the angle of the bevel, and placing the pieces end to end. The alleged infringement consisted in the use of single bevelled blocks; two of defendant's blocks, when placed in juxtaposition, making one of the patented blocks.

At the trial, LORD ABINGER, C.B. observed:—'It will be for the jury to say whether any particular angle of the bevel is essential, or whether any angle whatever is useful or beneficial. If the specification leave it to experiment to determine what is the proper angle, it is not good; but if any angle is a benefit, it will do.' And his Lordship finally said:—'I think that the words "any other suitable material" include a wood pavement, though probably the plaintiff never contemplated it. You can make the plaintiff's block by cutting *McCarthy's* block into two, and you can make the defendant's block by cutting *McCarthy's* block into four, and there is an end of the originality. I think so, and probably the jury think so too.'

Verdict for defendant on the second issue: the jury discharged as to the other issues.

MANTON *against* PARKER, A.D. 1814. Dav. Pat. Ca. 327; 1 Webs. Pat. Ca. 192, *n.*

Total failure of Utility.

CASE for the infringement of a patent of 6th *July*, 1803, No. 2,722, to *J. Manton*, for a 'new invented hammer for the locks of fowling-pieces.' Plea: Not guilty. Issue.

The specification stated that the object of the invention was to let the air out of the barrel while ramming down the wad. For this purpose the part next the touch-hole was hollowed out so as to form a receiver and was perforated with a small hole; also the seat of the hammer was grooved, 'so as to let the air pass through but not the powder.' The receiver thereby filled with powder, and the gun was less liable to hang fire.

At the trial, it appeared, from experiments made in Court, that powder passed through the perforated lip as well as air. Plaintiff nonsuited.

THOMPSON, C.B. said:—'The powder passes through the same hole as the air. It seems to me, therefore, that the utility of this invention and the purpose of this patent wholly fail.'

MATHERS *against* GREEN, A.D. 1865. 34 Beav. 170; L.R. 1 Ch. 29.

Rights of Co-patentees.

Bill for the purpose of enforcing plaintiff's rights in two patents, viz., of 20th *Dec.* 1861, No. 3,201, and of 31st *Dec.* 1861, No. 3,263, each granted to *T. Green*, *W. Green*, and *R. Mathers*, for 'improvements in lawn mowing machines.'

Plaintiff contended that the intention, at the time of taking out the patents, was that the three grantees should have a joint interest therein. This was denied by defendants, and there was conflicting evidence as to the facts. ROMILLY, M.R. was of opinion that plaintiff was entitled to all such rights as flowed from his being one of three joint owners of each of the patents, and ordered defendants to account for one-third of any profits arising therefrom. On appeal to the Lord Chancellor the bill was dismissed with costs.

Per LORD CRANWORTH, L.C.—Where a grant of a patent has been made to two or more as joint inventors, it is dangerous for any Court to allow one of the grantees to set up a title against the others, founded on mere parol evidence, or inference from doubtful contract. The grantee who, in such a case, claims an exclusive right ought to obtain written evidence on the subject.

The right conferred is a right to exclude all the world, other than the grantees, from using the invention. But there is no exclusion in the letters patent of any one of the patentees. There is no principle, in the absence of contract, which can prevent any persons not prohibited by statute from using any invention whatever. Is there then any implied contract where two or more persons jointly obtain letters patent that no one of them shall use the invention without the consent of the others, or if he does, that he shall use it for their joint benefit? I can discover no principle for such a doctrine.

REX *versus* METCALF, A.D. 1817. 2 Stark. R. 249.

Variance between Title and Specification.

Sci. fa. to repeal a patent of 30th *Sept.* 1816, No. 4,065, to *J. Metcalf*, for 'a tapered hair or head brush.'

The specification stated:—'I cut hair in lengths about one inch and a quarter long, which I mix with my hands by shaking it together as unevenly as possible.' It went on to describe the mode of attaching to the stock, by means of wires, the hairs so cut and mixed.

At the trial, it appeared that the patented brushes had bristles of unequal lengths mixed indiscriminately together. *Scarlett*, for defendant, suggested that by compressing the bristles in each tuft of hairs the effect would be to make them converge to a point, and that the brushes were known by the description 'tapering' in the trade; but LORD ELLENBOROUGH, C.J. said:—'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, which did not remove the difficulty, LORD ELLENBOROUGH advised the jury to find that it was not a tapering but only an unequal brush. Verdict for the Crown.

Rule for a new trial refused by the Court of King's Bench.

REGINA *versus* MILL, A.D. 1850–1. 10 C.B. 379; 14 Beav. 312.

Admissibility of Disclaimer in Evidence. Title of Patent after Disclaimer.

Sci. fa. to repeal a patent of 29th *June*, 1846, No. 11,266, to *W. Mill*, for 'improvements in instruments used for writing and marking, and in the construction of inkstands.'

The patent was for a variety of improvements. *Claims* 1, 2, 3, 4, referred to pencils and penholders; *claim* 5, to pens; *claim* 6, to 'a particular mode of notching pens;' *claims* 7 and 8, to instruments for marking devices, &c.; *claims* 9, 10, and 11, to inkstands. After issue joined defendant filed a disclaimer, under stat. 5 & 6 Will. IV. cap. 83, sect. 1, of the 5th, 6th, 7th, and 8th claims of invention.

At the trial, it appeared that the 6th claim of invention was not new; but the disclaimer, excising that claim, was tendered in evidence. WILDE, C.J. doubted whether it was admissible, and directed a verdict for the Crown. Leave reserved.

Rule nisi to enter a verdict for defendant, on the ground that the disclaimer was admissible in evidence, and sufficient, when admitted,

to sustain the patent, made absolute by the Court of Common Pleas. (Jervis, C.J., Maule, Williams, Talfourd, JJ.)

Per JERVIS, C.J.—I think that upon the true construction of stat. 5 & 6 Will. IV. cap. 83, sect. 1, the disclaimer is to be read as part of the patent and specification, as from the time when the patent is granted.* Reading the disclaimer with the specification, we find that the defendant has obtained letters patent for three kinds of invention, upon which he founds eleven different heads of claim. Some of these turn out not to be new. These the defendant disclaims; and, reading the disclaimer with the specification, it will appear that no claim is made in respect of those parts. But it is said, that, if this be so, the patent is void, for the patent is granted for three things, and there is a specification which only covers two of them.† But, assuming that the patent stands for the first five claims and the last three, it seems to me that the specification complies with the title. The title is 'for improvements in instruments used in writing and marking, and in the construction of inkstands,' and the specification, as amended by disclaimer, describes improvements in instruments used in writing and marking,—viz., pens and pencils, and improvements in the construction of inkstands.

Per MAULE, J.—The spirit of the Act (5 & 6 Will. IV. cap. 83) seems to be this,—that where there are objections that go only to a small and insignificant part of a patent, which, if sustained, would defeat it altogether, the patentee may relieve himself from the difficulty by a disclaimer. Then, inasmuch as a party against whom an action may have been brought for an infringement, may, by means of such disclaimer, be deprived of a good defence, that difficulty is met by the proviso. But, in the case of a *scire facias*, the proviso not applying, the general spirit of the enactment prevails, which is, that where a disclaimer has been allowed by the competent authority, and has been duly enrolled, it is to have the same validity as if it had formed part of the original specification. In *scire facias*, the patentee is passive. The prosecutor complains of the badness of the patent; all he wants is that it may be cancelled or amended; and that may be a sufficient reason for excepting the case of a *scire facias* out of the proviso.

(14 Beav. 312.) Application for liberty to sue on a bond for securing costs to defendant in the previous case. It appeared that the prosecutor continued the proceedings after disclaimer by the patentee, and that he ultimately failed. Order made to give leave to

* See now stat. 15 & 16 Vict. cap. 83, sect. 39, restricting actions for infringements committed before disclaimer.

† The special instruments for marking devices being omitted.

bring an action on the bond to recover costs subsequent to the disclaimer.

Per LORD LANGDALE, M.R.—I think that after the disclaimer the prosecutor was bound to know that the patent was good, and ought then to have discontinued the action. From that period he ought therefore to pay the costs in the action.

MINTER *against* WELLS, A.D. 1834. 1 Cr. M. & R. 505; 1 Webs. Pat. Ca. 127.

Subject-matter of a Patent.

CASE for the infringement of a patent of 9th *Nov.* 1830, No. 6,034, to *J. Minter*, for 'an improvement in the construction of chairs.'

The patent related to a reclining chair, the seat and back being constructed of two levers in combination, so arranged that a pressure on the back was counterbalanced by the weight on the seat, whereby a person could rest with the back at different inclinations. *Claim*: '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.'

At the trial, it appeared that a self-adjusting leverage had not been before applied to the construction of chairs. ALDERSON, B. directed the jury:—The plaintiff, in order to establish his right, must show that the invention is new and that it is useful, and that the specification is such that an ordinary workman could make a machine which would answer the purpose which the patent was intended to accomplish. Verdict for plaintiff.

Rule nisi to enter a nonsuit, on the ground that the patent was bad as claiming a principle in mechanics, refused by the Court of Exchequer. (Lord Lyndhurst, C.B., Parke, Alderson, Gurney, BB.)

Per LORD LYNDHURST, C.B.—Every invention of this kind must include the application of some principle; and here the application of the principle of the lever to the construction of a reclining chair constitutes the machine, the invention of which the plaintiff claims. He does not, as it is asserted, claim the principle in the summing-up of his specification, but he claims the invention of applying that principle in a certain manner and by certain machinery.

MINTER *against* WILLIAMS, A.D. 1835. 4 A. & E. 251.

Exposure for Sale.

CASE for the infringement of the same patent. The declaration set out the letters patent whereby the Crown granted to plaintiff the

sole privilege to 'make, use, exercise, and vend' the said invention, and forbade all persons to 'make, use, or put in practice' the same without his license, and alleged that defendant did without license 'expose to sale divers chairs' in breach, &c. General demurrer and joinder. Judgment for defendant by the Court of King's Bench. (Patteson, Williams, Coleridge, JJ.)

Per PATTESON, J.—It cannot be doubted, notwithstanding the authorities referred to, that there is a great distinction between vending and exposing to sale.

Per COLERIDGE, J.—The count alleges that the defendant, without the plaintiff's license, 'exposed to sale' divers chairs intended to imitate and resemble, and which did imitate and resemble, his invention. Do these words necessarily import the *vending* spoken of in the granting part of the patent? I certainly think not. A mere exposure to sale—that is, with intent to sell, or for the purpose of selling—is not only not equivalent to a sale, but, as regards the patentee, may be attended with wholly different consequences.

MINTER *against* MOWER, A.D. 1837. 6 A. & E. 735; 1 Webs. Pat. Ca. 138.

The Claim must not go beyond the Invention.

CASE for the infringement of the same patent. Plea 2. That the plaintiff was not the true and first inventor. Issue.

At the trial, it appeared that one *Browne* had, before the patent, invented a chair on the same principle, although encumbered with additional parts. The finding of the jury was:—That *Browne* was the inventor of the machine, and found out the principle, but not the practical purpose to which it was now applied, and that the plaintiff made that discovery. Verdict for plaintiff. Leave reserved.

Rule nisi to enter a nonsuit made absolute by the Court of King's Bench. (Lord Denman, C.J., Patteson, Williams, JJ.)

Per LORD DENMAN, C.J.—The specification thus concludes:—'What I claim as my invention is 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.' Now it was perfectly clear, upon the evidence, that this description applies to *Browne*'s chair, though that was encumbered with some additional machinery. The specification therefore claimed more than the plaintiff had invented, and would have actually precluded Mr. *Browne* from continuing to make the same chair that he had made before the patentee's discovery. We are therefore of opinion that the patent cannot be sustained.

MOREWOOD and ANOTHER *against* TUPPER and ANOTHER, A.D. 1855. }
3 C. L.R. 717. }

Evidence of Infringement. Subject-matter of a Patent.

CASE for the infringement of a patent of 4th *May*, 1843, No. 9,720, to *E. Morewood* and *G. Rogers*, for 'an improved process for coating metals.' Plea: Not guilty. And several other pleas. Issue.

The patent related to the manufacture of so-called galvanised iron plates, being in fact iron plates coated with zinc. The specification described the operation by reference to drawings, and showed a pot for holding fused metal with a pair of rollers completely immersed below the surface thereof. The plate of iron was introduced between the rollers and was immediately bent upwards by a third roller placed close to the mouth of the first pair, the result being that it came out above the surface of the molten metal, and was easily removed. The specification stated:—'In place of using two rollers, one roller, or simply a bar, may be used for causing the plates as they are introduced below the metal to be ensured descending to the same extent.' *Claim* 2: 'The mode of coating iron or other metal by causing sheets or other suitable surfaces thereof to pass between rollers in contact with metal kept molten in a suitable pot, and also the causing sheets of metal to be passed under a bar placed below the surface of molten metal as above described.'

At the trial, it appeared that the alleged infringement consisted in the use of a bath of molten zinc, having a bar placed across it dipping two or three inches into the molten metal. Sal-ammoniac was placed on one side of the bar, and sand, &c., on the other side, and the plate to be coated was dipped into the bath on the sal-ammoniac side, passed below the bar, and removed on the other side. POLLOCK, C.B. directed the jury:—That if the bar was placed simply for the separation of the fluxes, there was no infringement. Verdict for defendants on the issue on not guilty. Leave reserved.

Rule nisi for a new trial, on the grounds of misdirection and of the verdict being against evidence, made absolute by the Court of Exchequer. (*Pollock*, C.B., *Parke*, *Alderson*, *Martin*, BB.)

Per POLLOCK, C.B.—There was some evidence of cases of long plates so passed by the defendants as to make it doubtful whether complete immersion would always take place if the partition were away. We think such cases would be strong evidence from which a jury might, and perhaps ought, to find that to be an infringement of the plaintiffs' patent; for there the partition effects both the separation of the fluxes, and also complete submersion, which latter was, in truth, one of the main objects of the plaintiffs' patent. This, per-

haps, was not left with sufficient distinctness to the jury; and we think there ought to be a new trial to ascertain whether there has been an infringement in that class of cases. Then the question arises, whether it can be established affirmatively that the bar alone, placed below the surface of the molten metal, may properly be the subject of a patent? We cannot all of us at present come to the conclusion that this is clearly the subject of a patent, or that it is not. In such a case we ought to grant a new trial.

MORGAN *against* FULLER, A.D. 1866. L.R. 2 Eq. 296, 297.

Practice in Patent Suits. Amendment of Issues. Particulars of Objections.

Suit to restrain from infringing a patent for improvements in carriages. The replication was filed, and an order made for the trial of certain issues, when defendant sought to amend by adding further issues of fact not suggested by the answer. Application refused with costs.

Summons adjourned from chambers for further and better particulars of objections, the objections alleging:—1. Prior user of the invention 'by carriage builders *generally* throughout Great Britain.' 2. Prior user 'by carriage builders *generally*.' 3. Prior user 'by various carriage builders, *in or near London, in or near Liverpool, Manchester, Southampton, and in or near* various other of the principal towns of *Great Britain*,' and 'amongst other carriage builders by Messrs. *Thorn*, of *Great Portland Street, London*.' 4. Prior user of the mode described in the specification in 'various mechanical combinations applied to various matters and purposes.' 5. That 'parts' of the combination claimed had not been invented by the plaintiff. 6. That 'parts' of the said combination, if so invented, were not particularly described. Order made. Costs to be costs in the cause.

Per WOOD, V.C.—Applying the principle of *Fisher* v. *Dewick* (4 Bing. N.C. 706) to this case, the first objection must go out altogether. The second must go also, as being, if possible, worse than the first. With regard to the third, there is no doubt a reasonable and intelligible objection stated, but it is too general, and I should be disposed to tie the defendant down to specify the sort of carriage in which the alleged prior user took place if he could not give the name of the manufacturer. This would bring the case in conformity with *Jones* v. *Berger* (5 M. & G. 208). The fourth objection is also too vague. Objections 5 and 6 must also be struck out as not being specific enough to raise distinct issues.

The real object is to secure to both parties a fair trial, and with that view I must allow this motion.

MORGAN and ANOTHER *against* SEAWARD and OTHERS, A.D. 1835–7.]
2 M. & W. 544; 1 Webs. Pat. Ca. 167.]

Inspection. Novelty of Invention. Sufficiency of Specification. Failure of Utility in part of Invention.

Suit to restrain from infringing a patent of 2nd *July*, 1829, No. 5,805, to *E. Galloway*, for 'improvements in steam-engines and in machinery for propelling vessels,' &c.

The patent related:—(1) To a method of obtaining rotatory motion in a steam-engine. (2) To a method of feathering the floats of paddle-wheels.

Ex parte injunction dissolved, order for action at law, and an account. Plaintiffs and their witnesses to be at liberty to inspect at all seasonable times, and with notice, the paddle-wheels or machinery relating to paddle-wheels.

Action at law in pursuance of this order. Pleas: 2. That the specification was insufficient. 3. That the invention was not an improvement in steam-engines. 5. That it was not new, and that the patentee was not the true and first inventor. 6. That it was of no use to the public. Issue.

At the trial, it appeared that before the date of the patent one *Curtis* made for plaintiff, *Morgan*, two pair of paddle-wheels on the construction afterwards patented by *Galloway*. The workmen employed were under an injunction of secrecy, and no strangers were admitted to see the wheels. After a short time the wheels were taken to pieces, and sent abroad for the use of the *Venice* and *Trieste* Steam Company, of which *Morgan* was managing director. The wheels were sold to the company, but the vendor's name did not transpire. *Morgan* and *Curtis* then employed an attorney, who solicited the patent, which was granted to *Galloway* and assigned to *Morgan*.

ALDERSON, B. directed the jury:—The plaintiffs complain of the defendants for infringing their patent. Upon that subject the question would be simply, whether the defendants' machine was only colourably different, that is, whether it differed merely in the substitution of what are called mechanical equivalents for the contrivances which are resorted to by the patentee. You are to look to the substance and not to the mere form, and if it is in substance an infringement, you ought to find that it is so. If in principle it is not the same, but really different, then the defendants cannot be said to have infringed the patent.

The specification ought to be framed so as not to call upon a person to have recourse to more than those ordinary means of knowledge (not invention) which a workman of competent skill in his art and trade may be presumed to have. You may call upon him

to exercise all the existing knowledge common to the trade, but you cannot call upon him to exercise anything more. You have no right to call upon him to tax his ingenuity or invention. . . . Further, 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. . . . The specification of a patent must not merely suggest something that will set the mind of an ingenious man at work, but it must actually and plainly set forth what the invention is, and how it is to be carried into effect.

The first question in this case will be whether you think the steam-engine was a useful invention; if it was of any use. I think if it was of different construction from any other steam-engine, and of any use to the public, then that is sufficient. Verdict for defendants on third, fifth, and sixth issues. Leave reserved.

Rule nisi to enter a verdict for plaintiffs on the fifth issue made absolute by the Court of Exchequer, and rule nisi to enter judgment for plaintiffs on the third and sixth issues, *non obstante veredicto*, discharged.

Per PARKE, B.—The first question in this case is whether the verdict for the defendants on the fifth plea ought to be set aside. The word '*manufacture*' in the statute must be construed in one of two ways: it may mean the machine when completed, or the mode of constructing the machine. If it mean the former, undoubtedly there has been no use of the machine, as a machine, in *England*, either by the patentee himself or any other person. If it be construed to be the mode of 'constructing the machine' there has been no use or exercise of it in *England* in any sense which can be called public. The wheels were constructed under the direction of the inventor, by an engineer and his servants, with an injunction of secrecy, on the express ground that the inventor was about to take out a patent, and that injunction was observed: and this makes the case, so far, the same as if they had been constructed by the inventor's own hands, in his own private workshop, and no third person had seen them while in progress. The operation was disclosed, indeed, to *Morgan*, the plaintiff; but there is sufficient evidence that *Morgan* at that time was connected with the inventor, and designed to take a share of the patent. A disclosure of the nature of the invention to such a person, under such circumstances, must surely be deemed private and confidential. The only remaining circumstance is that *Morgan* paid for the machines with the privity of *Galloway*, on behalf of the *Venice* and *Trieste* Steam Company, of which he was the managing director; but there was no proof that he paid more than the price of the machines as for ordinary work of that description; and the jury

would also be well warranted in finding that he did so with the intention that the machine should be used abroad *only*, by this company, which, as it carried on its transactions in a foreign country, may be considered as a foreign company; and the question is, whether this solitary transaction, without any gain being proved to be derived thereby to the patentee or the plaintiff, be a use or exercise in *England* of the mode of construction, in any sense which can be deemed a use by others, or a public use, within the meaning of the statute and the patent. We think not.

Another question is, whether this patent, which suggests that certain inventions are *improvements*, is avoided if there be *one* which is not so. We feel obliged to hold that the patent is void upon the ground of fraud on the Crown, without entering into the question whether the utility of each and every part of the invention is essential to a patent, where such utility is not suggested in the patent itself as the ground of the grant. That a false suggestion of the grantee avoids an ordinary grant of lands or tenements from the Crown is a maxim of the common law, and such a grant is void, not against the Crown merely, but in a suit against a third person. 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* (8 Taunt. 375) and *Brunton* v. *Hawkes* (4 B. & Ald. 541); for although the statute invalidates a patent for want of novelty, and consequently by force of the statute the patent would be void so far as related to that which was old, yet the principle on which the patent has been held to be void altogether is, that the consideration for the grant is the novelty of all, and the consideration failing, or, in other words, the Crown being deceived in its grant, the patent is void and no action maintainable upon it. We cannot help seeing on the face of this patent, as set out in the record, that an improvement in steam-engines is suggested by the patentee, and is part of the consideration for the grant; and we must reluctantly hold that the patent is void for the falsity of that suggestion. In the case of *Lewis* v. *Marling* (10 B. & C. 22) this view of the case, that the patent was void for a false suggestion, does not appear by the report to have been pressed upon the attention of the Court, or been considered by it. The decision went upon the ground that the brush was not an essential part of the machine, and that want of utility did not vitiate the patent; and besides the improvement by the introduction of the brush is not recited in the patent itself as one of the subjects of it, which may make a difference. We are therefore of opinion that the defendant is entitled to our judgment on the third issue. This view of the case makes it unnecessary to

consider the effect of the finding on the last issue as amended by the judge's notes, that *part* of this invention is not useful. 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. And we do not mean to intimate any doubt as to the validity of a patent for an entire machine or subject which is, taken altogether, useful, though a part or parts may be useless, always supposing that such patent contains no false suggestion.

MORRIS *against* BRANSON, A.D. 1776. Bull. N.P. 76; 1 Webs. Pat. Ca. 51.

Patent for Addition to an existing Machine.

CASE for the infringement of a patent of 28th *March*, 1764, No. 807, to *J. Morris*, for a machine for a set of needles to be applied to a stocking frame for making oylet-holes.

At the trial, the question was whether an addition to an old stocking frame was the subject of a patent. LORD MANSFIELD said:—'If the general question of law, viz., that there can be no patent for an addition, be with the defendant, that is open upon the record, he may move in arrest of judgment, but that objection would go to repeal almost every patent that ever was granted.' There was a verdict for plaintiff with 500*l.* damages, which was acquiesced in.

MULLINS *against* HART and OTHERS, A.D. 1852. 3 Car. & K. 297.

Novelty of Invention.

CASE for the infringement of a patent for a method of manufacturing penholders.

At the trial, it appeared that, before the patent, defendants had manufactured penholders according to the method subsequently claimed by plaintiff, and that the penholders in question had been deposited in their warehouse for sale, but no sale was proved. JERVIS, C.J. held that there was sufficient evidence of publication to defeat plaintiff's claim of novelty in the invention. Verdict for defendants.

MUNTZ and OTHERS *against* VIVIAN and WALKER, A.D. 1840. 2 Webs. Pat. Ca. 87.

Practice in Patent Suits. Evidence of Infringement.

Suit to restrain from infringing a patent of 22nd *Oct.* 1832, No. 6,325, to *G. F. Muntz*, for 'an improved manufacture of metal plates for sheathing the bottoms of ships.'

The specification stated:—'I declare my invention to consist in making plates for sheathing of an alloy of zinc and copper in such

proportions and of such qualities as, while it enables the manufacturer to roll the metal into sheets less difficult to work, renders the sheathing less liable to oxidation than ordinary copper, though it oxidates sufficiently to keep the bottom of the vessel clean. I take that quality of copper known in the trade as "*best selected copper*" and that quality of zinc known in *England* as "*foreign zinc*," and melt them together in the proportion of fifty per cent. of copper to fifty per cent. of zinc, and sixty-three per cent. of copper to thirty-seven per cent. of zinc, both which extremes and all intermediate proportions will roll at a red heat; but as too large a quantity of copper increases the difficulty of working the metal, and too large a quantity of zinc renders the metal too hard when cold, and not sufficiently liable to oxidation to effect in the best manner the intended purpose, I prefer the alloy to consist of sixty per cent. of copper to forty per cent. of zinc.' The specification then described the operation of casting the ingots and rolling the sheets. *Claim*: 'The manufacture of metal plates of an alloy of copper and zinc in such proportions as will enable the manufacturer to roll the said alloy while at a red heat into sheets fit for the sheathing of ships, and will be sufficiently ductile to dress close to the bottoms of such vessels, at the same time that it is more durable than copper sheathing and oxidates sufficiently to keep the said bottoms clean.' On motion for an injunction it appeared that defendants manufactured sheets of an alloy of copper and zinc within the proportions specified, but they rolled them cold. SHADWELL, V.C. said that it was impossible not to see that the rolling hot was a material feature in the invention; and as the defendants did not roll hot he would not grant the injunction. No further proceedings were taken.

MUNTZ *against* FOSTER and OTHERS, A.D. 1843–4.
2 Webs. Pat. Ca. 92, 93, 96.

Practice in Patent Suits. Evidence of Infringement. Novelty of Invention. Evidence of prior User. Sufficiency of Specification.

Suit to restrain from infringing the same patent. Defendants relied on the anticipation of the invention by the specification of a patent of 23rd *April*, 1800, No. 2,390, to *W. Collins*, which related to the manufacture of sheathing for ships by alloying zinc with other metals, and classified the sheathing as being red, yellow, or white. The specification described the yellow sheathing as containing more zinc than the red, and as having greater ductility, so that it would bear rolling at a low red heat. It stated:—'100 parts of copper and 80 of zinc afford a good composition, but the proportions may be varied, and other metallic substances added, provided the

property of bearing mechanical pressure when heated is not destroyed.' It appeared that plaintiff had been in possession of his patent for eleven years, and there was no proof that *Collins*'s invention had ever come into general use. Plaintiff relied on the extreme purity of the metals, as to which *Collins*'s specification was silent, and defendants, on the other hand, alleged that *best selected* copper had been made extensively in the last century and in precisely the same manner as that referred to in plaintiff's specification. Defendants insisted that they worked under *Collins*'s specification; but analysis showed that their sheathing was composed of copper and zinc of the greatest purity, and in the same proportions as those of plaintiff. KNIGHT BRUCE, V.C. granted an injunction and ordered an action at law. Appeal motion dismissed by the Lord Chancellor, with costs.

Per LORD LYNDHURST, L.C.—As to the infringement, it is said that the defendants work according to *Collins*'s specification, and carefully abstain from working according to the specification of the plaintiff. The analysis proves that their compound consists, not of ordinary copper and zinc, but of those metals in their greatest purity, and in the proportions recommended in the plaintiff's specification. If they were originally combined in this state the invasion is plain and direct. If they were purified in the course of the process, this, I think, would constitute a colourable invasion of the plaintiff's invention.

Action at law in pursuance of the order of the Court. The pleas are not stated in the report, but defendants denied the infringement, the novelty of the invention, the sufficiency of the specification, and that the invention was the subject-matter of a patent. Issue.

At the trial, defendants relied on the defences indicated, but the report gives no summary of the evidence. TINDAL, C.J. directed the jury:—If the defendants had actually made some small experiment for the purpose of ascertaining what the proportions or properties of the different alloys would come to, that would scarcely have been said to be a making in violation of the patent; but you must ask yourselves whether the making of a quantity which amounts to 10 tons, I think, and of which the cost would be something like the sum of between 700*l.* and 800*l.*, could have been made for any other purpose at the time than the purpose of sale. If such were the case, there is no doubt that would be an infringement of the patent.

His Lordship then discussed the nature of the invention and said:—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 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 proper ground of a patent.

His Lordship next examined the evidence of prior user, and continued:—I do not think that the circumstance 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.

His Lordship finally considered the sufficiency of the specification and said:—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. There is an objection that the invention cannot be made in one or two of the different proportions of zinc and copper which are specified. If such is the fact, if the specification is not only difficult to understand, but is actually false and incorrect in that particular, there would be an end at once of the patent.

The only further objection is, that *hot rolling* is made an essential part of the plaintiff's invention, and is not new. I cannot understand that if the invention consists of various parts, *i.e.*, of the compound of the plates, and he states as he goes along that it will roll hot—and the subject of it is to make an alloy for sheathing—the rolling of it hot, that being known before, will invalidate the patent. I cannot think it will do so. Verdict for plaintiff.

MURRAY *against* CLAYTON, A.D. 1872–3. L.R. 7 Ch. 570; L.R. 15 Eq. 115; 21 W.R. 498.

Evidence of Infringement. Mechanical Equivalents. Practice in carrying out decree for Injunction. Breach of Injunction.

Suit to restrain from infringing a patent of 8th *June*, 1866, No. 1,581, to *C. H. Murray*, for 'improvements in machinery for making bricks.'

The specification stated:—'This invention of improvements in machinery for making bricks relates more particularly to the mechanical appliances for cutting the clay, as it passes out of the exit aperture, into bricks of the desired shape and dimensions.' To this end a strip of clay sufficient to form from eight to twelve bricks was first cut off from a slab delivered by the kneading machine by means of a vertical

wire attached to a reciprocating frame. The lump, so separated, was next pushed by a series of separate pistons against a row of fixed vertical wires and divided into bricks. The pistons carried the bricks beyond the dividing wires and deposited them on a tray so that they could be removed without any handling. The machine was described by reference to drawings. *Claim*: 'The arrangement and construction of parts herein set forth for cutting clay into bricks. I claim particularly cutting the clay into the form of bricks by forcing the clay forwards by means of a pushing board against a series of fixed wires, so arranged that the clay is forced past the wires on to a movable board provided with handles, so that twelve or any convenient number of bricks may be removed at the same time.'

Defendants relied upon an anticipation of the invention by a machine for making bricks patented on 6th *Jan.* 1863, No. 49, by *J. G. Dahlke*. This machine was constructed with a set of rollers covered by an endless belt for bringing the stream of clay, as expressed by a moulding machine, upon a frame. Between the belt and the frame a knife or wire passed so as to sever a rectangular slab, and the frame carrying this slab was then moved in a transverse direction, thereby passing the clay between wires which divided it into bricks by severing portions in lines perpendicular to the first cut. Defendants further relied on a machine made by themselves and exhibited at their works in 1861, being an improvement on a machine invented by one *Sachsenberg*.

The alleged infringement consisted in the use of a brick-making machine in which the lump of clay for making eight to twelve bricks was first cut off by a wire mounted on a guide having a centre of motion below the table, so that the wire swept out a part of a circle instead of moving vertically. The clay was then placed opposite a frame carrying a series of vertical wires which divided it into bricks, the wires being carried through the clay by the movement of the frame.

Bacon, V.C. dismissed the bill with costs; but the Lords Justices, on appeal, reversed this decision and granted a perpetual injunction.

Per James, L.J.—I am of opinion that the plain meaning of the specification is that the plaintiff claims the machine. The claim is not to any particular part. It is a claim for the entire machine, produced by the arrangement and construction of the parts set forth.

That, then, being the claim, let us see whether it has been in any manner anticipated. It is quite clear to my mind that the invention of *Dahlke* is a thing so substantially different in its principle and all its details from that of the plaintiff, that if it were made to-day for the first time it could not be considered as an infringement of the plaintiff's

patent. We now come to deal with the machine which the defendants say was used in their works. We have seen it worked here in Court, and no doubt in one sense it is an efficient machine; it does cut off the three bricks, but that is all that it does. There is nothing whatever to countervail the evidence that it is practically quite useless. I am not aware of any principle or authority upon which the exhibition of a useless machine, which turns out a failure, can be held to affect the right of a patentee who has made a successful machine, although there may be a degree of similarity between some of the details of the two machines.

His Lordship then referred to *Crane* v. *Price* (4 M. & G. 580) and said:—No doubt this case has been questioned, and if I may be permitted to say so, with all respect to the very powerful tribunal which decided that case, I have never been satisfied with the decision. That, however, is simply because I could not see how the word 'combination' could be properly applied to the introduction of a particular kind of fuel into a machine which had been patented for the use of every kind of fuel in the making of iron; and neither I, nor, so far as I am aware, any other judge has ever questioned the principles upon which that case was decided and which are thus laid down in the judgment of the Court delivered by Chief Justice Tindal:—'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 is an invention or manufacture intended by the statute, and may well become the subject of a patent.' His Lordship then stated his reasons for differing from the learned Vice-Chancellor and said:—We have now to determine whether the defendants' machine is an infringement of the plaintiff's patent,—whether it is a reproduction of the plaintiff's machine with colourable alterations, with the use of what have been called '*mechanical equivalents*.' It appears to me that the defendants have simply made a transposition, that is, that instead of moving the clay against the wires, they have made the wires move against the clay. That is exactly the case of a colourable variation.

I am of opinion that there should be a decree for a perpetual injunction, with the usual consequential direction as to the account to be taken.

(L.R. 15 Eq. 115.) Defendants being ordered to file an affidavit stating the number of brick-cutting machines made by them since the date of the patent, 'and the names and addresses of the persons to whom the same respectively have been sold, and the names of the agents concerned in the transactions,' filed an affidavit containing

only a statement of the number of machines made since the patent, and took out a summons to vary the order by omitting the above clause marked with inverted commas.

Order varied by striking out so much of the clause as required the names of the agents to be given. No costs to either side.

Per BACON, V.C.—The decree is in the plainest possible terms. It directs an inquiry as to what compensation is to be paid by the defendants in respect of the damage sustained by the plaintiff by reason of the defendants' infringement of the plaintiff's letters patent. As a matter of course, in prosecuting that inquiry, the plaintiff is entitled to have from the defendants the fullest possible discovery. Among other things the plaintiff is entitled to that which the order gives him—the names and addresses of persons to whom machines were sold; and if the order had stopped there I should have thought that no objection could successfully have been made to it. Then follow these words—'and the names of the agents concerned in the transactions,' of which I can make no sense, and which do not seem in the slightest degree necessary for working out the right which the plaintiff has under the decree.

(21 W.R. 498.) Motion to commit defendant, *Clayton*, for breach of the injunction already granted. It appeared that defendant used a brick-making machine differing chiefly from that of plaintiff in that the bricks, when made, were transferred by the hand of a workman, and not automatically by the action of the machine itself. BACON, V.C. refused the motion, and the Lords Justices dismissed an appeal from this decision with costs.

Per JAMES, L.J.—Possibly the plaintiff is in a difficulty experienced by every patentee of a combination. We were of opinion that the plaintiff's combination of known parts had produced a new result, or an old result in a more economical and more perfect form, making better bricks and cheaper bricks than had ever been produced before. We thought the whole combination—the plate, the wires, and the movable board to which by mechanical pressure the whole mass of bricks and the clay divided into bricks was at once removed, so that the human hand had nothing whatever to do with it between the cutting and the board—that that whole combination was a meritorious invention; and possibly the result might show that he might have claimed a specification more particularly directed to some smaller combination than the combination of the three, but his combination was a combination of three parts. What the defendant is doing is a combination of two out of those three parts, with another part which consists in using the hand or human pressure for producing the same result; that is substituting human power for the mechanical

power which the plaintiff is using in an essential and material part of it, and I am of opinion that the Vice-Chancellor is right in saying that the defendant has not committed any breach of our injunction. The motion will be refused with costs.

NEEDHAM *against* OXLEY, A.D. 1863. 1 H. & M. 248; 8 L.T. N.S. 604.

Practice in Patent Suits. Particulars of Breaches. Certificates.

Suit to restrain from infringing a patent for machinery for expressing liquids or moisture from substances. The bill stated that, upon inspection of a machine supplied by defendant to the *Westminster Brewery*, plaintiff had ascertained that the only difference between defendant's machine and that of plaintiff consisted in the placing of wire gauze between certain cloths and slabs used in plaintiff's machine, and in boring holes in the said slabs.

A jury trial before the Court having been directed, plaintiff delivered particulars of breaches specifying:—A machine or filter press for yeast, constructed by defendant, and supplied by him to Messrs. *Thorne, Westminster Brewery*, and in use there. Also a machine or press for clay, constructed by defendant, and supplied by him to Messrs. *Granger & Co., Worcester*. And the like of other machines constructed by defendant for persons named in the particulars. Summons for better particulars, adjourned into Court, and refused with costs.

Per WOOD, V.C.—The particulars, together with the bill, appear to me to give sufficient information. The object in having these particulars delivered is to give the defendant fair notice of what is the complaint against him, not to tie the plaintiff down to the precise terms of any verbal definition, or to make the trial of the issue turn upon a point of form. Full and fair notice the defendant is entitled to; but I should be very sorry to introduce anything like special pleading into the practice of this Court, or to allow verbal criticism to interfere with a determination of the merits of the contest.

The jury having found a verdict for plaintiff on all the issues, application was made (1) that the machines found to be an infringement of the patent might be destroyed; (2) for an inquiry as to damages; (3) for a certificate for a special jury; (4) for a certificate as to the validity of the patent. WOOD, V.C. said that he could not order the destruction of these machines; the patent being for a combination, the defendant might still use for other purposes the several parts of his machine. The machines should be marked in some way so as to enable the plaintiff at any time to follow them.

His Lordship refused an inquiry as to damages, as they were not asked for when they might have been conveniently assessed by the jury, and the plaintiff would be sufficiently compensated by receiving the profits made by the defendant on an account to be taken; and he further said that the costs of the suit would include the costs of the special jury. The certificate of validity would be given. Stat. 15 & 16 Vict. cap. 83 had only made provision for trials at common law; but he thought the same rule might be followed here.

NEILSON and OTHERS *against* HARFORD and OTHERS, A.D. 1841.
1 Webs. Pat. Ca. 295; 8 M. & W. 806; 2 Coop. Ch. Ca. 61.

Novelty of Inventions. Sufficiency of Specification. Title of Patent.

In a suit (*Neilson* v. *Thompson*, 1 Webs. Pat. Ca. 275) to restrain from infringing a patent of 11th *Sept.* 1828, No. 5,701, to *J. B. Neilson*, for 'an invention for the improved application of air to produce heat in fires, forges, and furnaces.' LORD COTTENHAM, L.C. had dissolved an injunction granted by the Vice-Chancellor and had ordered an action at law with an account. Action accordingly. Pleas: 3. That the invention was not new. 4. That the specification was insufficient. Issue.

The patent related to the application of the so-called *hot blast* to the smelting of iron. The specification stated:—'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 to a considerable temperature. It is better to be kept to a 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.

At the trial, defendants put in evidence the specification of a patent of 2nd *Jan.* 1828, No. 5,596, to *T. Botfield*, for a method of supplying air to a blast furnace, which showed an iron smelting furnace placed close beside a lofty chimney stack, and connected by horizontal air passages with a supplemental furnace. The chimney was adapted for the purpose of drawing air from the supplemental and through the smelting furnace. The air so drawn in would of necessity be heated, and it was stated that an ordinary blowing apparatus might also be employed to assist the draught. The alleged

infringement consisted in passing air through a series of arched pipes, and raising its temperature to 600° or 700° Fahr.

PARKE, B. directed the jury:—Half a century ago, or even less, within fifteen or twenty years, there seems to have been very much a practice with both judges and juries to destroy the patent right, even of beneficial patents, by exercising great astuteness in taking objections, either as to the title of the patent, but more particularly as to the specification, and many valuable patent rights have been destroyed in consequence of the objections so taken. Within the last ten years or more, the Courts have not been so strict in taking objections to the specification, and they have endeavoured to hold a fair hand between the patentee and the public; being willing to give 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 that proviso which is introduced into the patent for their advantage. If the patent be a good patent, and if the specification be free from the objections that are raised to it, and is to be understood in the sense claimed by the plaintiffs, . . . though unquestionably what the defendants have done is a great improvement upon what would be the species of machinery or apparatus constructed under this patent, it appears to me that it would be an infringement of it.

We come now to the specification. My impression of the meaning of this specification is, that the patentee claims the discovery of heating air in any vessel of any size, provided it is a closed vessel, and exposed to heat between the blowing apparatus and the furnace. He states the size and form of the vessel to be immaterial. My strong opinion is, that that clause is an incorrect statement, and an untrue one, and therefore my opinion certainly is, as at present advised, that that being clearly untrue vitiates this specification, and prevents the patent from being a good patent. Nevertheless I shall ask your opinion, whether, notwithstanding the introduction of that clause into the specification, such persons as would be likely to work under the patent would, by their own judgment and good sense, correct that error in the patent. You are not to ask yourselves the question whether persons of great skill—a first-rate engineer, or a second-class engineer, as described by Mr. *Farey*—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 to the subject.

Another point is, whether the invention can be used beneficially, taking it in its simplest form. If in order to use it beneficially at all experiments were necessary, then the specification would be void. If the simplest form would be productive of benefit, it appears to me that the specification is good. If experiments are only necessary in order to produce the greatest beneficial effect, in that case, I think, the patent is not void.

The jury found:—That the shape and form of the vessel were material to the heating of the air, but that a person would not be misled by the misstatement in the specification. Verdict for defendant on fourth issue, and for plaintiff on remaining issues. Leave reserved.

Rule nisi to enter a verdict for plaintiff on fourth issue made absolute by the Court of Exchequer. (Lord Abinger, C.B., Parke, Alderson, Rolfe, BB.)

During the argument ALDERSON, B. observed:—'If you claim every shape, you claim a principle. There is no difference between a principle to be carried into effect in any way you will, and claiming the principle itself. You must detail some specific mode of doing it. Then the rest is a question for the jury.'

It was contended that the objection to the specification taken by the learned judge at the trial—viz., 'that it was calculated to deceive'—was not sufficiently raised by the notice of objections.

Per PARKE, B.—In the first place it was contended that the objection to the specification, on which I proceeded at the trial, was not sufficiently raised by the notice. But we all think it was. At *Nisi Prius* the only question for the judge is, whether the language of the notice fairly includes the objection taken.

Then we come to the question itself, which depends on the proper construction to be put on the specification. The construction of all written instruments belongs to the Court alone, whose duty it is to construe all such instruments, as soon as the true meaning of the words in which they are couched, and the surrounding circumstances, if any, have been ascertained as facts by the jury; and it is the duty of the jury to take the construction from the Court, either absolutely, if there be no words to be construed as words of art or phrases used in commerce, and no surrounding circumstances to be ascertained; or conditionally, where those words or circumstances are necessarily referred to them. Taking then the construction of this specification on ourselves, we think that the plaintiff does not merely claim a principle, but a machine embodying a principle, and a very valuable one. We think the case must be considered as if, the principle being well known, the plaintiff had first invented a

mode of applying it by a mechanical apparatus to furnaces; and his invention then consists in this—the interposing a receptacle for heated air between the blowing apparatus and the furnace.

In this specification, after stating that air heated up to a red heat may be used, but that it is not necessary to go so far to produce a beneficial effect, he proceeds to state that the size of the receptacle will depend on the blast necessary for the furnace, and gives directions as to that. Then he adds, 'the shape of the receptacle is immaterial to the effect, and may be adapted to local circumstances.' It is this part of the specification which has raised the difficulty. At the trial, I construed this passage as meaning that the shape was immaterial to the degree of effect in heating 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 Lord 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. His Lordship referred to the use of the word '*effect*' in the specification as equivalent to '*beneficial effect*,' and continued:—It is not unreasonable, we think, to construe the word '*effect*,' in the sentence on which this question turns, in a similar way, and to hold it to mean an assertion by the patentee, that though the size of the vessel must be regulated as directed, yet the shape of the air vessel is immaterial to the effect; that is to say, any shape will produce a beneficial effect, and may be adapted to the local circumstances. Now, if this be so, it still casts upon him the necessity of proving, to the satisfaction of the jury, that any shape in which the air vessel could be reasonably expected to be made by a competent workman would produce a beneficial effect, and be a valuable discovery. We are bound, as to this point, by the finding of the jury, who have arrived at this conclusion of fact.

There is another point as to the title of the patent. The title is for the '*improved application of air*.' Though that is ambiguous, it is sufficiently explained by the specification, and is not at variance with it, as was the case in *Rex* v. *Wheeler* (2 B. & Ald. 345).

On motion to revive the injunction in the several cases on this patent, LORD LYNDHURST, L.C. allowed the same, as being almost of course after judgment in an action at law, and said:—'The whole question turns on the meaning of the word "*effect*" in the specifi-

cation, as to the sense in which that word was used by the patentee; and I think that the construction put upon it by the Court of Exchequer is a reasonable and proper construction, and that it would be difficult, consistently with the rules of law, by which an instrument must be construed taking it altogether, to have put another construction on the instrument.'

NEWALL *against* WILKINS, A.D. 1851. 17 L.T. 20.

Practice as to Certificate for Costs.

CASE for the infringement of a patent, in which the validity of the patent came in question. Verdict for plaintiff. Counsel thereupon tendered the record of a former trial in which the patent was affirmed in order to obtain treble costs under stat. 5 & 6 Will. IV. cap. 83, sect. 3. It was objected that the record should have been given in evidence before verdict; but LORD CAMPBELL, C.J. said:—'I shall admit the evidence, and it appears to me that the proper course has been pursued. The defendant's case ought not to be prejudiced by the admission of the evidence at the trial.'

NEWALL *against* WILSON, A.D. 1852. 2 De G. M. & G. 282.

Practice in Patent Suits. Injunction after long Enjoyment of Patent.

Suit to restrain from infringing a patent of 7th *Aug.* 1840, No. 8,594, to *R. S. Newall*, for 'improvements in wire ropes and in machinery for making such ropes.'

It appeared that the patent had been in force for twelve years, and had been the subject of four different suits, all of which had terminated favourably for the patentee. Also that, in 1850, defendant had incorporated a part of plaintiff's invention in a certain patent, but had not put the same to practical use. The validity of plaintiff's patent was now impeached on some new facts.

Injunction refused by ROMILLY, M.R. On appeal, the Lords Justices granted an injunction and ordered an action at law.

Per KNIGHT BRUCE, L.J.—The first question upon this motion is, whether the letters patent, on which the plaintiff grounds his case, have been shown to be bad in law. In my opinion they have not. Has there been enjoyment under it? Beyond all question there has during several years. While the patent has existed, the plaintiff's exclusive right has been actively asserted, and has in several instances been submitted to. There has been, I think, considering the various proceedings which have taken place, a sufficiency of enjoyment to bring the case within the principle enunciated by Lord Eldon in the well-known cases of *Harman* v. *Playne* (14 Ves. 130), and *Hill* v. *Thompson* (3 Meriv. 622).

Per LORD CRANWORTH, L.J.—It is clear that the plaintiff claimed exclusive enjoyment, and proceeded against parties who interfered with that enjoyment, and that those proceedings were always practically successful, and in one instance, at least, successful by being carried to the utmost extent. This seems to me to make out the case of exclusive enjoyment.

Looking at the defendant's specification, I cannot say that it is, of necessity at least, at variance with the plaintiff's patent; but I should be very slow to hold that a party was bound to proceed by *scire facias*, or that it is to be held that he has not had exclusive possession of his own patent because he does not proceed by *scire facius* to repeal other letters patent, if the other patentees do not act upon the latter.

NEWALL *against* ELLIOT and GLASS, A.D. 1858. 4 C.B. N.S. 269.

Evidence of Infringement. Variance between Complete and Provisional Specifications. Prior Experimental User.

Suit to restrain from infringing a patent of 14th *May*, 1855, No. 1,091, to *R. S. Newall*, for 'improvements in apparatus for laying down submarine telegraph wires.' The matters in dispute were referred to an arbitrator, who made an award, and further stated a case for the opinion of the Court.

The patent related to the stowage and paying out of submarine telegraph cables. The specification stated:—'This invention consists of apparatus combining and acting in the following manner. The cable is passed round a cone, or if it is a long cable round several cones, so that the cable in being drawn 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 cable passes over a pulley above the cone, and on to a break-wheel, round which it takes several turns to obtain sufficient holding, and from the break-wheel it passes over the stern of the vessel.' The drawings showed the cone, which was truncated and did not deviate much from the cylindrical form, together with the pulley overhead and the break-wheels. The specification went on to state:—'When the cable is to be laid I place over the cone an *apex* or top which is conoidal, as shown (the drawing showed a short conoidal head placed on the flat top of the truncated cone), and around this I suspend *several rings* of iron by means of cords, so as to admit of adjustment at various heights over the cone. The use of these rings is to prevent the bight of the rope from flying out when going at a rapid speed. The two rings nearest the coil are lowered to about six and twelve inches respectively from the coil (the drawing showed four rings arranged

in gradations of size, the smallest being at the top, and acting as a mouth-piece for the exit of the cable, which was thus carried close over the conoidal top of the cone).' *Claims*: 1. 'Coiling the wire or cable round a cone. 2. The supports placed cylindrically outside the coil round the cone. 3. The use of rings in combination with a cone as described.' The provisional specification said nothing about the rings or the use thereof, but gave a general description of the invention, which was copied *verbatim* in the complete specification, and is quoted above. (This invention consists, &c.)

It appeared, on the case, that before the patent the practice had been to coil submarine cables in oval or elliptical coils adapted to the form of the hold; that such coils were occasionally supported by stays where they did not abut against the sides of the vessel, and that, except in two instances, they had not been supported from inside. In one case guano bags had been placed inside the coil, and in the other a cylindrical core was introduced, but such external and internal supports were removed before laying the cable.

On 18th *Dec.* 1854, plaintiff contracted with the Government to lay a submarine cable between *Varna* and *Balaklava*. A vessel named the *Argus* sailed with a coil stowed as described in plaintiff's specification, and the apparatus employed for laying the cable was the same as that specified, the whole operation being completed on 26th *April*, 1855.

It further appeared, that the alleged infringement consisted in the coiling by defendants in *May*, 1856, of a submarine cable about a cylindrical core placed in the hold of a vessel called the *Propontis*. The core had a rounded or hemispherical cover at the top, and the coil was supported by vertical supports arranged in a circle or outside cylinder. The cylinder with the hemispherical top assisted the paying out and diminished the tendency of the cable to kink, though not so perfectly as plaintiff's apparatus. Defendants did not use any ring or rings as described in the specification.

The arbitrator found that plaintiff was the first to use an outside cylinder (that is, vertical supports arranged in a circle and fixed to the vessel,) in combination with a cone or internal cylinder about which the cable was coiled, the cable as it payed out passing up against the cylinder. He also made an award, declaring that the patent was not illegal or void, and directing compensation for the use of plaintiff's apparatus on board the *Propontis*.

The questions raised by the special case for the opinion of the Court of Common Pleas were:—(1) Whether there was evidence of infringement; (2) Whether there was a fatal variance between the provisional and complete specifications, in that the former omitted.

all mention of the rings claimed by the latter document; (3) Whether there had been any publication of the invention before the patent; (4) Whether the patent was avoided by a user for profit before the grant. On all these points the Court gave judgment for plaintiff.

Per BYLES, J.—The substitution by the defendants of a cylinder having a *domed* or hemispherical top for the cone in the plaintiff's apparatus—both the plaintiff's and the defendants' apparatus being used for the same purpose and in nearly the same manner—is, in our judgment, not only evidence, but strong evidence, to support the arbitrator's finding.

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 (15 & 16 Vict. cap. 83) 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 (sect. 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 (sect. 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 only describe, but particularly ascertain it. We therefore think that the 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.

The third objection was that the plaintiff's invention had been disclosed and published before the date of the letters patent. But a necessary and unavoidable disclosure to others, and as here appears, if it be only made in the course of mere experiments, is no publication; although the same disclosure, if made in the course of a profitable use of an invention previously ascertained to be useful, would be a publication. *In re Adamson* (25 L.J. Ch. 456). The answer to the third objection therefore depends on the fourth and last and main objection, which was this:—That the use of the apparatus for profit before the date of the letters patent, was a use which avoided the patent. The true question—looking at the decision of the arbitrator—seems to be this: Is an experiment performed in the presence of

others, which not only turns out to be successful, but actually beneficial in the particular instance, necessarily a gift of the invention to the world? We think it is not. In the case under consideration, experiments on dry ground are found to be indecisive. The decisive experiment still remains to be made on a large scale and in deep water. An opportunity presents itself in the course of a Government contract. The experimenter is obliged either to experiment in a way that may turn out to be useful in the particular instance, or else not to make any efficient and decisive experiment at all. The coincidence of an experiment with actual immediate profit or advantage from it, if successful, is unavoidable. If indeed the plaintiff in the present case had on other and subsequent voyages used his apparatus, and unnecessarily delayed his application for a patent, he would have given his invention to the public.

NEWALL *against* ELLIOT and GLASS, A.D. 1863–4. 1 H. & C. 797; 10 Jur. N.S. 954.

Evidence of Infringement. Variance between Complete and Provisional Specifications.

CASE against same defendants, for another infringement of the same patent. Pleas: 1. Not guilty. 2. *Non concessit.* 3. That plaintiff was not the true and first inventor. 4. That the specification was insufficient. 5. That the invention specified was not that for which the patent was granted. 6. That the invention was not new. 7. That it was not the subject-matter of a patent. Plaintiff joined issue on all the pleas, and further replied to 3rd, 4th, 5th, 6th, and 7th pleas, by way of estoppel, setting out the agreement for reference to an arbitrator as mentioned in the last case, and the award and judgment in favour of plaintiff on like issues then respectively raised. Issue: also demurrer to special replication, and joinder in demurrer. Judgment for defendants by the Court of Exchequer.

(10 Jur. N.S. 954.) At the trial, it appeared that the alleged infringements occurred on board three vessels, viz., the *Queen Victoria*, the *Rangoon*, and the *Malacca*, which were prepared for laying a submarine cable between *Rangoon* and *Singapore*. While these ships were being fitted for sea, WOOD, V.C. granted an injunction to prevent their sailing. This injunction was dissolved by the Lords Justices, but an order for inspection was affirmed. From the evidence of plaintiff's witnesses who made the inspection it appeared that in the *Queen Victoria* a strong framework of upright pieces of timber formed a cylindrical core on which the cable was coiled, and the coil itself was surrounded by a firmly-supported casing of wood,

and held down at the top by other timbers. The *Queen Victoria* got ashore, and her cable was transferred to the *Rangoon*, in which vessel a *ring*, similar to those used by plaintiff in paying out, was found on the inspection. The *Rangoon* and *Malacca* laid down their cables between *Malta* and *Alexandria*, the internal supports of the cable being cut down during the paying out; and plaintiff contended that a *British* ship was a portion of *British* territory, and that there was infringement by what was done at *Malta* and *Alexandria* on board these vessels.

It further appeared that in 1854 a cable had been shipped on board the *Persia*, and was coiled in two coils round rectangular framings or cores, being supported on the outside in part by the sides of the vessel, and in part by strong upright supports. The jury found in answer to a question put to them by POLLOCK, C.B., that on board the *Persia* there had been used as an external support a series of uprights strongly fastened to the bottom of the deck, and placed cylindrically outside the coil, but that the apparatus was not used for paying out. Verdict for plaintiff. Leave reserved.

Rule nisi to enter a verdict for defendants on first issue made absolute by the Court of Exchequer. Rule for a new trial suspended, and rule discharged on the other objections, viz., that the invention was not new, that it was not the subject of a patent, and that there was a variance between the complete and provisional specifications.

Per POLLOCK, C.B.—I think there is nothing in the objection that the specification discloses a different invention from the provisional specification. The object of the statute, which requires a provisional specification, is nothing more than a legislative recognition of the custom which called upon every patentee, when he applied for the patent, to give some notion of what his invention was. An application was made to me when I was Attorney-General 'for an improvement in locomotion.' I refused it, as too wide, and I have no doubt that the object of the Act of Parliament was not to ascertain the entirety of the invention, but the identity of the invention.

The patentee of a combination is bound to state what parts of the combination he claims to be new, or what parts of the combination he has taken from that stock of knowledge which is common to all mankind. On the present occasion the introductory words are:—'This invention consists of apparatus combined and acting in the following manner.' Then he describes how it acts. Then he says, 'I claim as my invention, *first*, coiling the wire or cable round a cone.' In that he was perfectly right. '*Second*, the supports placed cylindrically outside the coil round the cone.' The jury found that what he professed to do by the second part of his invention had been done

before on board the *Persia*. I think if he claimed the supports placed cylindrically outside the coil round the cone, no other person could use a 'core.' I use the term to avoid the use of either 'cone' or cylinder.' No other person could use a cylindrical support all round any core, if that was originally his invention; and he does not claim it as round the cone—he claims it round whatever is used for the purpose of supporting the coil of wire. His Lordship added that in his opinion the verdict ought to be entered for the defendants upon the question of novelty as well as that of infringement.

Per BRAMWELL, B.—First of all, as to what took place in *Malta*, I am clearly of opinion, without going into any elaborate consideration of how far the vessel of a country is the territory of a country, the doctrine cannot be carried so far as to make anything done on board an infringement of letters patent, which are in their terms limited to the *United Kingdom*, the *Channel Islands*, and the *Isle of Man*. We have to consider whether the defendants have made what the plaintiff has patented. To my mind it is clear they have not; because it must be conceded that, independently of intention, they have not done it; and surely intention cannot make what they have done an infringement in making the plaintiff's apparatus, which, without that intention, would not be an infringement.

One point was pressed by Mr. *Cleasby*, which I confess I have great difficulty in understanding, that this is not the subject of a patent because the thing is not prepared and vendible—because, for the convenience of buyer and seller, instead of being ready made and afterwards fitted up in the ship, it is fitted into the ship by the owner of the ship, or the user of the ship, when he uses it. I confess I am unable to understand that. It seems to me to be an argument equally good to say that you could not have a patent for a smoke-jack, because the size of the smoke-jack depends upon the size of the chimney, and because it is more convenient that it should be put up by a country smith.

NEWTON *against* THE GRAND JUNCTION RAILWAY COMPANY, A.D. 1850.
5 Ex. R. 331.

Novelty of Invention. Evidence of Infringement.

CASE for the infringement of a patent of 15th *May*, 1843, No. 9,724, to *W. E. Newton*, for 'improvements in the construction of boxes for the axles of carriages, and for the bearings or journals of machinery (a communication).' Pleas: 1. Not guilty. 2. That the invention was not new. 3. That the specification was insufficient. Issue.

The patent related to a method of lining the bearings of revolv-

ing axles in machinery. The specification stated that the inner part of the boxes for the support of gudgeons or axles were to be lined with a compound metal composed of fifty parts tin, five antimony, and one copper. To prepare the boxes for this composition they were to be cast with projecting rims or fillets along their edges and ends, the object being to keep the soft metal lining in its place, and the interior of the boxes was to be cleaned or tinned in the usual manner. In boxes thus prepared, the heating and abrasion, which were so apt to occur in boxes ordinarily constructed, did not take place, and their durability was consequently increased. (The explanation being that the soft metal was incompetent to take up the motion of heat by friction.) *Claim* (in substance): The constructing the boxes within which the journals or axles of machinery run with rims or fillets along their edges and at their ends as herein set forth; and lining such boxes with a metallic composition of which tin is the basis for the purpose herein described.

At the trial, it appeared the alleged infringement consisted in rubbing a stick of tin on the interior of a brass bearing while heated, so as to deposit a lining of the soft metal on the surface of the brass. The layer so formed was left thick at the middle and fined off at the edges, but no ridge or fillet was employed to confine the tin within the bearing. CRESSWELL, J. directed the jury:—That they must take the whole of that for which the patent was granted, including the fillets within the outer case, as well as the lining with tin and the soft metal, and say whether the invention was new. Also, that if a patent was granted for a new combination of several things known before, that did not prevent any one from using those parts which were old. That it was for the jury to say whether the part here used by the defendants was substantially the same thing as the plaintiff's invention. Verdict for plaintiff.

Rule nisi for a new trial, on the ground of misdirection, discharged by the Court of Exchequer. (Pollock, C.B., Alderson, Rolfe, BB.)

Per POLLOCK, C.B.—It appears to me that in substance what the patentee claims is the lining of these boxes with an alloy of tin, having certain provisions, partly mechanical and partly chemical, for keeping the lining in its place. That the mode adopted by the plaintiff is partly chemical it is impossible to doubt, because he first tins the inside before the alloy is introduced; and the evidence was that by means of that tinning the alloy is made to unite with the hard metal, which it would not otherwise do. Therefore I think the jury were correctly told they were to consider whether the invention as a whole was new, not whether it was new as to every part.

It was argued 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 purpose 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.

Per ALDERSON, B.—In considering whether the invention is new, the proper mode is to take the specification altogether and see whether the matter claimed *as a whole* is new. Now the whole which may be new as claimed, may consist in some degree of old parts and in some degree of new parts. The question of novelty, however, will depend on whether the whole taken together is new, though it may in part consist of old parts, provided the patentee does not claim the old parts, but only the combination of them and the new.

Then as to the infringement, there, undoubtedly, the question is altogether altered. A person cannot infringe that part of the patent which is old, because the public cannot be prevented from using that which they had before used in that state. If the invention consists of something new, and a combination of that with what is old, then if an individual takes for his own and uses that which is the new part of the patent that is an infringement of it.

Per ROLFE, B.—The defendants' counsel discussed and scanned the language of the specification in the same sort of spirit as if it were a plea or replication specially demurred to. That is not the spirit in which a specification should be inspected. The proper mode is to construe it and see what is the good sense of it, and whether that which the patentee claims as his invention is there distinctly and clearly explained.

NEWTON *against* VAUCHER, A.D. 1851. 6 Ex. R. 859.

Novelty of Invention. Subject-matter of a Patent.

CASE for the infringement of the same patent. Pleas: 1. Not guilty. 2. That the plaintiff was not the true and first inventor. 3. That the invention was not new. 4. That the invention was not a manufacture within the statute. Issue.

At the trial, the specification of a patent of 8th *Sept.* 1838, No. 7,800, to defendant, *J. U. Vaucher*, was put in which related to a method of packing the pistons of hydraulic engines by soft

metallic packing. The metal packing was composed of forty parts of tin, sixty of zinc, and four of antimony, and was cast in grooves running round the pistons. It was contended, on the part of defendant, that plaintiff's invention was comprised in the above description, and that his patent was therefore void for want of novelty. PLATT, B. was of the contrary opinion, and left the case to the jury.

Verdict for plaintiff.

Rule nisi for a new trial, on the ground of misdirection, discharged by the Court of Exchequer. (Parke, Alderson, Platt, Martin, BB.)

Per PARKE, B.—The only question is, whether the plaintiff's invention is contained in the defendant's, and is old, and that question must depend upon a comparison between the specifications of the plaintiff's patent of 1843, and of the defendant's of 1838. The specifications are to be read in connection with their titles. After the date of the defendant's patent it was discovered that soft metal could be used beneficially, not merely for the purpose of excluding air and water, but that it produced this remarkable effect, that where there was pressure upon it, friction was in a great degree diminished. I think the discovery by the person under whom the plaintiff claims is not merely the discovery of a new principle, but of a new principle embodied in a new machine. Then, that being so, if the plaintiff claims a patent for that new principle embodied in a new machine, and that only for the purpose of diminishing friction, and the application of it is only to cases where there is pressure as well as motion, that patent is perfectly good; but if he has also claimed in it the application of soft metal to all cases of stuffing, to exclude fluids of every description, his patent in that respect is for an old invention and is void. The question is now reduced to that single point. I entertained some doubt during the argument whether the plaintiff's patent is simply for the application of soft metal for the purpose of preventing friction where there is pressure and motion, or whether it is not also for the application of soft metal in cases of stuffing rods for the purpose of excluding air, water, or other fluid. If the determination of the question depended solely upon the specification, and the title of the patent were not read, I should have been inclined to think that the plaintiff claimed both; but if the specification and the title be read together (and the specification is always taken to be an exemplification of the thing for which the patent is obtained), it is clear that the plaintiff's claim is confined to bearings in cases where there is pressure with motion. Had it not been for the title of the patent, by which the plaintiff appears to me to confine his invention to bearings, there would be strong reason to contend that he applied it also to cases in which rods or bars were to slide. But

reading the specification in conjunction with the title, I think the plaintiff's patent does not extend so far, and consequently that it is not void upon that ground.

Per ALDERSON, B.—The plaintiff, by his specification, describes a mode of forming a lining of soft metal which bears the pressure, and which endures swift motion upon its surface without the evolution of heat by friction, and this he does by rims of hard metal with soft metal between the rims. It seems to me to be a very reasonable subject-matter for a patent, and that it is essentially different from the defendant's patent.

Per MARTIN, B.—It is obvious, from his (the defendant's) specification, that he never had the least idea that soft metal would be of the slightest utility in diminishing friction.

NICKELS *against* HASLAM, A.D. 1844. 7 M. & G. 378; 8 Scott N.R. 97.

Variance between Title of Patent and Specification.

CASE for the infringement of a patent of 10th *Feb.* 1842, No. 9,252, to *C. Nickels*, for 'improvements in the manufacture of plaited fabrics.' Plea: Setting out the specification and averring that no other had been enrolled, whereby the patent was void. General demurrer, and joinder.

The patent related to a method of manufacturing plaited fabrics in stripes alternating with ordinary woven fabric. The specification stated:—That the warp should be wound on two warp beams, whereof one was lightly and the other heavily weighted. *Claim*: 'The mode of weaving plaited fabrics by dividing the warp into separate parts, and causing them to be delivered at different speeds as the weaving with the weft proceeds.' This was the only improvement specified.

It was objected that the specification did not support the title; but the Court of Common Pleas (Tindal, C.J., Coltman, Cresswell, JJ.) gave judgment for plaintiff.

Per TINDAL, C.J.—Here the objection is only to the title, as describing the patent to have been granted for improvements in a certain manufacture, whereas the specification discloses only one improvement. 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 patent, the objection being merely to the title of the patent without fraud upon the Crown or detriment to the public.

NOTON and OTHERS *against* BROOKS, A.D. 1861. 7 H. & N. 499.

Estoppel of Licensee.

Action for non-payment of royalties for the use of a patent. Pleas: 3. That the alleged invention was not a new manufacture, by reason whereof the patent was void. 4. That the patentees were not the true and first inventors, by reason, &c. Demurrer, and joinder. Judgment for plaintiffs by the Court of Exchequer. (Pollock, C.B., Bramwell, Channell, Wilde, BB.)

During the argument POLLOCK, C.B. said:—'The defendant agrees to pay the plaintiffs a royalty, if they will allow him to use their patented invention, and he does use it; how then can he turn round and say that it is worthless? The plaintiffs claim the remuneration for the permission to do that which the defendant has done. So long as the term of the patent lasts, if the defendant chooses to work under it, he must pay the stipulated price.'

Also BRAMWELL, B. said:—'The consideration for the promise to pay is the permission to use the invention.'

OLDHAM *against* LONGMEAD, A.D. 1789. *Cited* 3 T.R. 439, 441.

Estoppel.

Per LORD KENYON, C.J.—In the case of *Oldham* v. *Longmead*, the patentee had conveyed his interest in the patent to the plaintiff, and yet in violation of his contract he afterwards infringed the plaintiff's right, and then attempted to deny his having any title to convey; but I was of opinion that he was estopped by his own deed from making that defence.

ORMSON *against* CLARKE, A.D. 1862–3. 13 C.B. N.S. 337; 14 C.B. N.S. 475.

Subject-matter of a Patent.

CASE for the infringement of a patent of 19th *Sept.* 1857, No. 2,441, to *H. Ormson*, for 'an improvement in the manufacture of cast tubular boilers.' Pleas: 1. Not guilty. 7. That the invention was not a manufacture within the statute. Issue.

The invention related to a mode of constructing tubular boilers after a pattern well known at the date of the patent—viz., a boiler by one *Weeks*, which consisted of a row of vertical tubes terminating at the top and bottom in two horizontal hollow rings; the rings being cast with sockets, and the tubes being put in afterwards. In the patented boiler, the lower ring, the upright tubes, and part of the upper ring were cast in one piece. The specification stated:—'My invention consists in causing the upright tubes and the lower

hollow ring (which connected the tubes together at their lower ends) to be all cast at one time, and thus to form one casting.'

Claim: 'The casting a boiler, such as is described, in one piece.'

At the trial, ERLE, C.J. left the case to the jury. Verdict for plaintiff. Leave reserved.

Rule nisi to enter a verdict for defendant, on the ground that the invention was not the subject-matter of a patent, made absolute by the Court of Common Pleas. (Erle, C.J., Williams, Byles, Keating, JJ.)

Per ERLE, C.J.—Tubular boilers, such as those in question, are perfectly well known, and have long been used for the heating of horticultural buildings. The product therefore is not new; the only novelty is the casting in one piece that which used formerly to be cast in several pieces. I am of opinion that that is not the subject for which a patent can be taken out. The new mode probably requires more skill in the workman than the old one; but there is no claim for any novelty in the process of casting.

On appeal to the Court of Exchequer Chamber (Pollock, C.B., Crompton, Blackburn, Mellor, JJ., Martin, Bramwell, Channell, BB.) judgment affirmed.

Per POLLOCK, C.B.—I think it is extremely likely that this is a very useful improvement, and if the patent had been taken out for an improved mode of casting tubular boilers in one piece, probably it might have been sustained. The only question reserved for us is, whether there could be a patent for a boiler cast in one piece as described. We are all clearly of opinion that that is not the subject of a patent.

OXLEY *against* HOLDEN, A.D. 1860. 8 C.B. N.S. 666.

User by offering patented articles for sale. Construction of Specification. Effect of Provisional Specification when abandoned.

Action to recover royalties payable under an agreement for the use of a patent of 10th *April*, 1858, No. 776, to *J. Oxley*, for 'improvements in the doors and sashes of carriages.' Pleas: 2. Never indebted. 3. That the patent was void, whereby defendant obtained no advantage under the agreement. Issue.

The patent related:—(1) to the application of elastic pads for preventing the windows of carriages from rattling; (2) to a mode of holding a window by metal fittings, consisting of a pin and a slotted plate. The specification described the invention by reference to drawings, and stated:—'I have shown my invention as applied to railway carriage doors and window fittings, although equally applicable to the doors and windows of any other carriages, or in any

position where windows and doors are subject to jar and vibration.' *Claims*: 1. 'The construction of elastic pads as herein described. 2. The mode of applying vulcanised indiarubber or elastic material to sliding window frames. 3. The metal fittings and the mode of applying the same described herein.'

At the trial, it appeared that on 17th *March*, 1858, plaintiff obtained provisional protection for an invention of indiarubber pads to be applied to the windows of carriages (No. 549). On 10th *April*, 1858, he obtained provisional protection for three heads of invention, whereof one comprised the above-mentioned indiarubber pads. The application of 17th *March* was thereupon abandoned, and that of 10th *April* was carried to completion. It further appeared that defendant had made about half a dozen of the studs and plates, and that his traveller had offered them for sale to divers persons, but had not sold any. BYLES, J. directed the jury that this was in point of law as much a user of the patent as if there had been an actual sale of the articles. The jury found:—That the elastic pads were new; that the stud and plate was old, but that its application in the way described was new; and that defendant manufactured the patented articles for sale and offered to sell them. Verdict for plaintiff, damages 50*l*. Leave reserved.

Rule nisi to enter a verdict for defendant on the grounds, (1) That the metal fittings were claimed apart from the mode of applying them, and were not new. (2) That the specification went beyond the title. (3) That the filing of the provisional specification of 17th *March*, 1858, amounted to a dedication of the invention to the public, and rendered the subsequent patent void. And for a new trial on the ground of misdirection by the judge in telling the jury that the exhibition of patented articles for the purpose of obtaining orders, though none were obtained and no articles sold, was a user of the patent. Rule discharged by the Court of Common Pleas.

Per ERLE, C.J.—The principal objection depends upon the construction to be put upon these words: 'I claim the metal fittings and the mode of applying the same described herein as the second part of my invention.' If the true construction is that the metal fittings are claimed separately from the mode of applying the same, the patent is void for want of novelty, the jury having found that the metal fittings by themselves are old, but that the mode of applying them is new. Then, are the metal fittings claimed separately? We think not. In respect of the first part of the invention, consisting of elastic pads, and the mode of applying them, the patentee has subdivided his invention into a claim for the pads, and a separate claim for the mode of applying them. If he had meant the

same with respect to his second invention he would naturally have used the same form. If 'the metal fittings' are taken to mean all metal fittings consisting of two plates adjusted with stud and slot, such a claim would be futile, as plates so adjusted are notoriously old. The patentee must have intended that the patent should be valid.

The second ground of objection was, that the specification claimed more than the patent. The invention specified and claimed is truly an improvement in the doors and windows of carriages, not the less because it is also applicable to other doors and windows. It seems to us reasonable that the claim should be construed with reference to the title, and confined accordingly to the doors and windows of carriages.

The third objection was, that the provisional specification relating to the elastic pads, delivered in on the 17th of *March*, rendered in operative the provisional specification delivered in on the 10th of *April*, and therefore rendered void the patent granted on the 10th of *October* and founded on the specification of the 10th of *April*, which was either void *ab initio* or became void on the 17th of *September*, when, it is contended, the invention specified on the 17th of *March*, and afterwards abandoned, became dedicated to the public. But we are of opinion that a provisional specification abandoned does not become public by abandonment. The statute (15 & 16 Vict. cap. 83, sect. 29) authorises the publication; but, until that event, it is not public.

Furthermore, although the first provisional specification may afford an objection either to receiving a second patent for the same invention or to granting a patent for the invention after the first specification has expired, there is no principle of law, and no enactment, making the patent void if it is so granted.

All the objections to the validity of the patent, in our opinion, fail. It therefore becomes unnecessary to consider whether the relation between the parties to the licence created any obstacle against the defendant as to disputing the validity of the patent.

PALMER *against* COOPER, A.D. 1853. 9 Ex. R. 231.

Evidence admissible under Particulars of Objections.

CASE for the infringement of a patent for 'improvements in the manufacture of candles by gymping their wicks.' Plea: Not guilty. Issue. The particulars of objections, delivered under stat. 15 & 16 Vict. cap. 83, sect. 41, alleged prior user of candles having gymped wicks, by Messrs. *Palmer*, of *London*, by *Joseph Morgan*, of *Manchester*, and other persons similarly described.

At the trial, evidence of prior user of candles with *coiled* wicks was tendered, and objected to on the ground that the user of this kind of candle had not been specified in the notice, and that the place of user was not mentioned therein. POLLOCK, C.B. admitted the evidence. Verdict for plaintiff. Leave reserved.

Rule nisi for a new trial on the ground of the improper reception of evidence made absolute by the Court of Exchequer. (Pollock, C.B., Parke, Alderson, Platt, BB.) On the argument of the rule it was contended that the particulars of breaches could be called in aid of the particulars of objections; but PARKE, B. said :—'The plaintiff's particulars allege a user *after the date of the patent.*'

Per PARKE, B.—The 41st section peremptorily requires that the particulars of objection should state where the invention was used, and in what manner it was used or published before the date of the patent.

Per ALDERSON, B.—There is no statement whatever of the place in these particulars, although in one of them the parties are named, and the manner in which the invention had been used.

PALMER *against* WAGSTAFFE and ANOTHER, A.D. 1853. 8 Ex. R. 840; 9 Ex. R. 494.

Sufficiency of Particulars of Objections. Evidence of Infringement.

CASE for the infringement of a patent (in part disclaimed) of 25th *March*, 1840, No. 8,445, to *W. Palmer*, for 'improvements in the manufacture of candles.' Plea: Not guilty. Issue.

The particulars of objections under stat. 15 & 16 Vict. cap. 83, sect. 41, alleged prior user of the invention by plaintiff and other persons mentioned at certain places specified, 'and by candle makers generally in *London* and the vicinity thereof.'

Rule nisi for better particulars discharged by the Court of Exchequer. (Alderson, Platt, Martin, BB.)

Per ALDERSON, B.—A defendant may rely either on a specified user by certain persons named, or on a general user by all persons at a particular place. In the former case, if he proves a user by any one of the persons named, that will support his objection; but, if he rests his case on a general user, proof of a user by one person will not do. In fact, the plaintiff has no reason to complain of the generality of the statement, for the more general it is, the more the defendant must prove under it.

The specification related (after disclaimer) to a mode of manufacturing candles by the application of two or more wicks arranged so as to bend outwards in definite directions during the burning, and stated:—'I have observed that in consuming *plaited* wicks of candles,

that surface of the wick where the strands proceed upwards from the outer edges towards the centre is the direction towards which the wick bends.' Then followed a description of a method of placing the wicks *in situ* in the empty mould, with the proper side outwards, by the aid of a wire. *Claim* 2. 'The mode of manufacturing candles by the application of two or more plaited wicks, as herein described.'

At the trial, plaintiff produced a candle, purchased at defendants' manufactory, in which the wicks bent outwards during the burning. POLLOCK, C.B. left it to the jury to say whether the candle made by defendants was an infringement of plaintiff's patent. Verdict for plaintiff. Leave reserved.

Rule nisi to enter a verdict for defendants on the issue raised by the plea of not guilty made absolute by the Court of Exchequer. (Pollock, C.B., Alderson, Platt, Martin, BB.)

Per POLLOCK, C.B.—I think that a patent or specification should be construed in the sense in which the patentee intended, and that, if any expressions are ambiguous, we should endeavour to give effect to the intention, and moreover that every patent should be expounded favourably to the patentee. Taking the patent to be for the mode of making the candle, if any other person can discover a method of producing the same effect by a totally different means, he has a right to do so. That being the case, the plaintiff was bound to give some evidence that the defendants had infringed the patent by making a candle in the same way.

Per PARKE, B.—I agree that in construing a patent a fair and liberal construction ought to be put upon it, and that we must look to what the real intention of the inventor was. With respect to this patent, the only conclusion which I can come to is that the plaintiff claims the particular mode of making the candle, not the candle itself. Then the only question is, whether the simple production of a candle with a plaited wick, which turns outwards, is of itself evidence of an infringement of the plaintiff's patent. I am of opinion that it is not, and that some evidence ought to have been given that the defendants' mode of making the candle was an infringement of the plaintiff's.

PARKES *against* STEVENS, A.D. 1869–70. L.R. 8 Eq. 358; L.R. 5 Ch. 36.

Subject-matter of a Patent. Evidence of Infringement. Sufficiency of Specification.

Suit to restrain from infringing two patents, viz., of 26th *June*, 1862, No. 1,876, and of 10th *Oct.* 1865, No. 2,615, each to *J. Parkes*, for 'improvements in lamps.' Trial before the Court without a jury

on the following issues:—1. Whether the invention was new. 2. Whether it was useful. 3. Whether it was the subject of a patent. 4. Whether the specification was sufficient. 5. Whether the patent had been infringed.

The patent of 1865 related to a form of globular glazed lamp constituting an improvement on the patent of 1862. The specification, No. 2,615, stated:—'The object of the improvements is to produce a glazed lamp the frame of which shall throw little or no shadow, and yet at the same time possess the requisite strength and facilities for cleaning.' The lamp was then described by reference to drawings, which showed it as being spherical in form, with three metal rings for supporting the panes, one ring occupying the middle or equatorial line, and the other two being placed near the top and bottom. The panes were segments of a sphere, separated by longitudinal strips of metal. The door was formed of a light framework of metal containing one pane of glass, and was opened by being slid on the surface of the globe so as to overlap the adjoining pane.

Claim: 'The arrangement and combination of parts hereinbefore described and represented in the drawings annexed in the manufacture of railway-station and other lamps.'

It appeared that the alleged infringement consisted in the use of a globular lamp with a sliding door. Also that cylindrical lamps with sliding doors were in public use before the date of the patent. Verdict for defendant on issue as to infringement, and for plaintiff on remaining issues.

Per JAMES, V.C.—My verdict on the first three issues is in favour of the plaintiff; but the defendant contends that the specification is not sufficient, and relies for this objection on the judgment of Lord Westbury in *Foxwell* v. *Bostock* (4 De G. J. & S. 298), to the effect that a patent for the improvement of a machine must with sufficient distinctness describe the particular part of the machine which is alleged to be improved, and the particular improvement for which the protection is claimed. I need not say that I should feel myself bound by that decision, if I did not, which I do, most entirely concur in the judgment. It is obvious that a patentee does not comply, as he ought to do, with the condition of his grant if the improvement is only to be found like a piece of gold mixed up with a great quantity of alloy, and if a person desiring to find out what was new, and what was claimed as new, would have to get rid of a large portion of the specification by eliminating from it all that was old and commonplace, all that was the subject of other patents and other improvements, bringing to the subject, not only the knowledge of an ordinary skilled artisan, but of a patent lawyer or agent.

After all, the question of sufficiency of specification is not a question of law; it is a question really of fact in each particular case. In this case, I am of opinion that the patentee has a right to have his specification of 1865 read with his specification of 1862; and, reading them together, I do not think any maker of lamps would have any substantial difficulty in ascertaining what was claimed under the general description of the 'arrangement and combination of parts hereinbefore described, &c.' But the patent being for the arrangement and combination of parts so as to form an entire lamp, and not being for, or claiming to be for, any particular part, the last question arises, is the introduction into a lamp (which is not alleged in any other respects to have adopted any part of the plaintiff's arrangement and combination) of a sliding door an infringement? The plaintiff's counsel have contended that it is, on the authority of the case of *Lister* v. *Leather* (8 E. & B. 1,004). The authority of this case has been pressed upon me as if it really established this, which would be a most startling proposition, that a patent for a combination or arrangement would be a distinct patent for everything that was new and material and that went to make up the combination. The marginal note, if read hastily, is calculated to give some colour to that contention. But if the judgment be read, it will be found to give no warrant whatever for such, I must call it, baseless notion.

But the principle of that case has no application whatever to the present case. Even if there had been any sufficient novelty or merit in the substitution of a sliding door, I should have held that that was no part of an invention for producing 'a glazed lamp, the flame of which shall throw little or no shadow, and yet at the same time possess the requisite strength, and also facilities for lighting and cleaning.' The sliding door has nothing to do with the shadow, has nothing to do with the strength, and gives no facilities for lighting or cleaning. That ought to have been the subject of a distinct claim if it was intended to have been, and could have been, protected. But I am clearly of opinion that there can be no patent right in the substitution of a slide for a hinge. It was hardly contended before me that the introduction of that alone would have been sufficient to sustain a patent; but it was gravely contended that because it was, as alleged, a novel part of a novel combination and arrangement, it was protected. To say that a patent for an entire combination is a valid patent for a part, when that part would not of itself have been patentable, is in my judgment a *reductio ad absurdum* of the supposed principle in *Lister* v. *Leather*. My verdict on the issue as to infringement will be for the defendant.

(L.R. 5 Ch. 36.) Motion for a new trial by way of appeal. Defendant also moved for a new trial as to the validity of the patent. Both motions dismissed with costs.

Per LORD HATHERLEY, L.C.—As to the validity of the second patent, which has been disputed, there is a clear line marking off the old from the new. Then as to the other issue, whether the subject-matter of the patent is new, I think, from the exhibits, as well as from the evidence, that this was a new and ingenious method of making a lighter description of lamp, both lighter in appearance, and lighter in the sense of transmitting light, than any which had been previously contrived. Then as regards the door, the question arises whether there is an infringement. In order to arrive at a sound conclusion on that branch of the subject, we must consider whether this door is really new; and the best way of testing that, no doubt, is that which the Vice-Chancellor has adopted—by asking whether, upon the evidence, it could by itself have been the subject of a valid patent. It was argued before me that the sliding door was in itself a novelty as applied to a spherical lamp; but many instances were given of glass in the shape of a cylinder having been made to slide over glass, and it is impossible to say that a sliding door can be the subject of a patent because it is spherical and not cylindrical.

THE PATENT BOTTLE ENVELOPE COMPANY *against* SEYMER, A.D. 1858. 28 L.J. C.P. 22.

Evidence of Infringement. Subject-matter of a Patent.

CASE for the infringement of a patent of 29th *Aug.* 1854, No. 1,892, to *J. Seithen*, for 'improvements in the manufacture of cases or envelopes for covering bottles.' Pleas: 1. Not guilty. 6. That the said invention was not an invention for improvements in the manufacture of envelopes for bottles. Issue.

The patent related to a method of forming cases of rush or straw for the protection of bottles. For this purpose equal lengths of straw or rush were tied together at one end, and passed over the mould of a bottle. The material was then tied tightly round the mould at the part intended to form the base of the envelope. A ring, actuated by a treadle, and large enough to slide over the material thus tied down, was raised from below so as to bend the straw back and allow of its being tied again at the extreme end above the neck. The specification described the operation, and contained a drawing of the apparatus. *Claim*: 'The combination of mechanism, and the making of envelopes for bottles as herein described.'

At the trial, it appeared that the alleged infringement consisted

in the making of straw envelopes for bottles by tying together lengths of straw, placing the same on a mould resembling a bottle, and interweaving them by passing a string over and under alternate portions. WILLES, J. was of opinion that there was no evidence of infringement, and directed a nonsuit. Leave reserved.

Rule nisi to set aside the nonsuit discharged by the Court of Common Pleas.

Per WILLES, J.—We are of opinion that this rule ought to be discharged. The plaintiffs' specification clearly shows that the patent is not for bottle envelopes, but for a mode of making them. The defendant's method resembles the plaintiffs' in the product, which is not the subject of the patent, and in one material particular only, viz., the use of the model or mandril; and the question is, whether such use constitutes an infringement of the plaintiffs' patent. The infringement of any part of a patent process is actionable, if the part of itself is new and useful so 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 envelopec for bottles. We are of opinior that they could not. The use of a model or mandril for producing given forms of pliable materials was admitted at the trial. Such use was part of common knowledge, and a model or mandril similar to that of this patent was an ordinary and well-known tool. The application of a well-known tool to work previously untried materials, or to produce new forms, is not in our opinion the subject-matter of a patent.

PATENT MARINE INVENTIONS COMPANY *against* CHADBURN, A.D. 1873. } L.R. 16 Eq. 447. }

Practice in Patent Suits as to Trial of Issues.

Suit to restrain from infringing a patent. The parties had agreed upon certain issues; but plaintiffs desired that the issues should be tried either before the Court itself with a jury, or before a Court of Law, and defendants opposed a motion to that effect.

LORD SELBORNE, L.C. ordered a trial before the Court without a jury, and said:—'My opinion is, like that of Lord Cairns (see *Bovill* v. *Hitchcock*, L.R. 3 Ch. 417), that in these patent cases, where all the ordinary issues are raised, and nothing special appears to show that the assistance of a jury is wanted on some mere question of fact properly so called, trial by jury is not ordinarily the most convenient mode of trial. 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 makes 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 a judge; thirdly, that much of the evidence, or that which is permitted to be given as 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 any 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, where the 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.

PATENT TYPEFOUNDING COMPANY *against* RICHARD, A.D. 1859. Johns. 381.

Pleading. Demurrer. Sufficiency of Specification.

Suit to restrain from infringing a patent of 7th *April*, 1854, No. 817, to *J. R. Johnson*, for 'improvements in the manufacture of type.'

The specification stated:—'The object of my invention is to make type harder, tougher, and more enduring, by employing tin in large proportions with antimony, and to greatly reduce or wholly omit the use of lead. The best proportions I am acquainted with are 75 of tin and 25 of antimony; but this may be to some extent varied; and, when lead is also used, I find that it must not exceed 50 parts in 100 of the combined metals employed.' There was no separate claim. Demurrer, on the ground that the specification was bad for uncertainty, over-ruled. Costs to be costs in the cause.

Per WOOD, V.C.—What I have to determine is, whether this specification is so clearly and manifestly bad, that no explanations by workmen or other experts, to whom the specification must be considered as addressed, could induce the Court to hold that this is a new invention, set forth with sufficient clearness and precision. What the patentee considers the best proportions (and he is bound, according to the authorities, to state this) is 75 of tin to 25 of antimony; but this, he says, may be to some extent varied. 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.

PATENT TYPEFOUNDING COMPANY *against* WALTER, A.D. 1860. Johns. 727.

Inspection and Delivery of Samples. Laches. Practice in Patent Suits.

Suit to restrain from infringing a patent for improvements in the manufacture of type. Application to inspect certain type, and take samples. It appeared that the Court of Exchequer had refused to grant such permission; also that plaintiffs had lain by for nearly a year in the prosecution of the suit. Order made for inspection and delivery of samples. Costs to be costs in the cause.

Per WOOD, V.C.—The jurisdiction of this Court to order inspection, and, if necessary, the taking samples for the purpose of a suit here, has scarcely been contested. If a precedent is wanted, the case of *Russell* v. *Cowley* (1 Webs. Pat. Ca. 457) is in point. There specimens were allowed to be taken away, though the necessity for doing so was scarcely so great as in the present case.

It was said that, if plaintiffs had come for an interlocutory injunction *simpliciter*, without asking for any discovery, it would have been refused on the ground of delay, whatever case they might have made out as to the infringement; and therefore, it is said, there can be no inspection for the purpose of supporting such an application; and there is much weight in this argument. But these cases of patents are peculiar. Relief is given in two shapes. It may be by interlocutory injunction in the first instance. But much more frequently, unless the case is of the strongest possible kind, it is by merely putting the matter in train for determination of the right at law; and then, at the hearing, a perpetual injunction is granted, upon the plaintiff succeeding in the action at law. Power has been conferred upon the Common Law Courts to grant an injunction pending an action at law. The words of stat. 15 & 16 Vict. cap. 83, sect. 42, are, 'in any action;' and this seems to have been construed by the judges as limited to the pendency of an action; but whether they have been right or not in their view of the limits of their jurisdiction, the jurisdiction of this Court is unaffected.

With respect to obtaining a perpetual injunction, the rule is

established in *Bacon* v. *Jones* (4 Myl. & Cr. 433), that in patent cases, unless the plaintiff takes steps to bring the matter before the Court by motion before the hearing, he will not in general be entitled to a perpetual injunction at the hearing. He is therefore not at liberty to wait for the hearing, but the Court requires him to place the matter in course of investigation at the earliest possible period.

PENN *against* BIDBY, A.D. 1866. L.R. 1 Eq. 548; L.R. 2 Ch. 127.

Particulars of Objections. Novelty of Invention. Variance between Complete and Provisional Specifications. Subject-matter of a Patent.

Suit to restrain from infringing a patent of 2nd *Oct.* 1854, No. 2,114, to *J. Penn*, for 'an improvement in the bearings and bushes for the shafts of screw and submerged propellers.'

Defendant filed amended particulars of objections, alleging prior user of the invention 'in the following, among other, instances, viz., &c.' The words 'among other instances' were objected to, but were allowed to remain.

Per WOOD, V.C.—I think these words 'among other instances' may be permitted to remain, in order to give the defendant the benefit of a general saving, and liberty to apply for leave to give particulars of other instances of prior user, if and when he may find them.

Defendant subsequently applied for leave to specify seven instances of prior user, which was granted on terms that he paid the costs of the application; any additional costs consequent thereon being reserved.

The patent related to the construction of hard wood bearings for the shafts of screw propellers. The provisional specification merely stated:—'This invention consists in employing wood in the construction of the bearings and bushes for the shafts of screw and submerged 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 surface of the metal bearings, and allow the water to circulate freely in the channels so formed. The wood is, by preference, *lignum vitæ*, the grain being either longitudinal with the fillets, or at right angles to the bearing surfaces thereof. In other words, the bearings are not continuous metal surfaces, as previously constructed, but a series of wooden fillets or ridges, having water spaces between them, which support the rubbing action of the shaft. It was further stated that the several pieces of wood

employed in a bearing might be inclined to the axis instead of parallel to it, as shown. *Also*, that it was not essential that the fillets of wood should be fitted in the interior of fixed metal bearings, as a like effect would be obtained if they were attached to the shaft and revolved therewith in metal bearings in the manner shown in figures 4 and 5 of the drawings. *Claim*: 'The employing of wood in the construction of the bearings and bushes for the shafts of screw and submerged propellers, as herein described.'

Hearing of the suit. The following questions of fact were tried before the Court, without a jury (that is to say):—1. Was the invention new at the date of the patent? 2. Was the specification sufficient? 3. Was the invention the subject-matter of a patent? 4. Had the defendant infringed? Defendant gave evidence in accordance with an allegation in the particulars of objections, that wooden bearings had been applied in *May*, 1851, to the propeller shaft of the screw-steamer *Livorno* and used in a voyage. Plaintiff then proposed to call witnesses in reply. Wood, V.C. held that the evidence was admissible. After evidence of plaintiff in reply had been given, and counsel had summed up defendant's evidence, the Court was asked to allow defendant to adduce further evidence to contradict that of plaintiff in reply. Wood, V.C. refused to admit such evidence, and found in the affirmative on each of the above issues.

Appeal to the Lord Chancellor for a new trial on the grounds, (1) that the verdict was against the weight of evidence; (2) that there was a variance between the provisional and complete specifications; (3) that the invention was not the subject-matter of a patent. Motion refused with costs.

Lord Chelmsford, L.C. said that, in dealing with the finding of the Vice-Chancellor upon the first question, he regarded himself as placed precisely in the situation of the judges of the Courts of Common Law when a rule is obtained to set aside the verdict of a jury. They do not consider what would be the proper view of the case if originally presented to them, but merely whether there is sufficient evidence to warrant the verdict. Nor had he ever known an instance in which there was evidence on both sides, and the judge who tried the cause was satisfied with the verdict, where a new trial was granted.

His Lordship came to the conclusion that, on the evidence, the Vice-Chancellor was justified in finding in favour of the novelty of the invention, and continued:—'The defendant contends that the patent is void because there is a variance between the title and the specification, or between the provisional and the complete specifica-

tions. It is said, on the part of the plaintiff, that there is no issue to raise this question; and that the correct mode of tendering such an issue at law would have been either by plea of *non concessit*, or by expressly pleading the variance between the title and the specification. I think, however, that with perhaps a little license of construction, the second issue may meet the case. The objection may be thus stated:—The provisional specification describes the nature of the invention, in the most general terms, to consist in employing wood in the construction of the bearings and bushes for the shafts of screw and submerged propellers. The complete specification describes a particular mode of employing wood to prevent the parts of a propeller shaft, which are within the bearings, from coming in contact with the metal of the bearings, and to cause them to revolve against pieces of wood fixed in such a manner as to admit of water flowing freely between the pieces of wood, and between the inner surfaces of the metal bearings and the outer surfaces of the propelling shaft. The claim at the end of the specification is, "the employing of wood in the construction of the bearings and bushes for propeller shafts, as herein described." If the words "herein described" are to be disregarded, the patent is void, as the claim will then be for the employment of wood in every possible way in the bearings and bushes of propellers; and, if these words limit the claim to the precise description in the specification, this is not what is described in the provisional specification, and the plaintiff has therefore obtained a patent for one thing and specified another. This is the defendant's argument.

'There can be no doubt that the claim in the specification must be read with the limitation produced by the words "herein described," and that the question thereupon arises, whether this occasions a departure from the provisional specification so as to render the patent void. It seems 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 officer 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 in which the invention is to be worked or carried out. That is left to the complete specification. Nor is it at all necessary that the complete specification should extend to everything comprehended within the provisional specification. It is clear, therefore, that unless the complete specification in this case claims something different from the provisional specification, the objection to the patent under consideration cannot prevail. But there is not the slightest foundation for the objection in point of

fact, and each specification appears to me faithfully to fulfil its own office.

'But it was said that one part of the complete specification went beyond the provisional, and extended to something which could not be included in it, viz., the application of wood to the shaft so as to revolve therewith, the provisional specification confining the employment of wood to the bearings and bushes. If wood applied in this manner to the shaft may be properly called a bearing, then there is no excess in this part of the specification. But if, strictly speaking, this application of wood would not come within the description of a bearing, then the answer to the objection is, that it is not claimed, the claim being limited to the employment of wood in the construction of bearings and bushes. There is, therefore, no departure from the provisional specification in the complete specification, and the finding of the Vice-Chancellor upon this issue was right.

'The last question raised was upon the finding that the invention was the proper subject-matter of a patent. To this it was objected that the finding is erroneous, because the alleged invention was merely a new application of an old and well-known thing. 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. 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 the bearings of screw propellers in the way described in the patent. It is, to my mind, not merely a different application, but something in itself essentially different. It had been found that, in the mode of constructing screw propellers by making metal work upon metal, they soon wore out, and occasioned a violent irregular motion on the vessel. Mr. *Penn* devised the plan of placing fillets of wood upon the inner surface of the bearings, so as to prevent the shaft coming in contact with the metal of the bearings, and so as to admit of the water flowing freely between the shaft and the inner surfaces of the metal bearings, thereby keeping the wood constantly lubricated. The success of this invention has been proved in a remarkable

manner. It would be an extraordinary fact if an invention of this kind, so long wanted, and of such great utility, should have been lying in everybody's way who knew anything of the construction of a water-wheel or grindstone, and yet should never have been discovered.'

PENN *against* BIBBY; PENN *against* JACK; PENN *against* FERNIE,
A.D. 1866. L.R. 3 Eq. 308.

Practice as to Damages and Costs in Patent Suits.

The hearing of these causes now came on together. Plaintiff asked for an injunction, for an account against Mr. *Jack*, and for an inquiry as to damages against the other two defendants. Injunction granted in each case with costs. The account being waived, an order for an inquiry as to damages was made against all the defendants.

Per WOOD, V.C.—With regard to the damages, it has never, I think, been held in this Court that an account, directed against a manufacturer of a patented article, licenses the use of that article in the hands of all the purchasers. The patent is a continuing patent, and I do not see why the article should not be followed in every man's hand, until the infringement is got rid of. So long as the article is used there is continuing damage.

Application for full costs, as between solicitor and client, under stat. 15 & 16 Vict. cap. 83, sect. 43, refused. Application, on behalf of defendant, *Bibby*, to postpone the decree until after the decision of the House of Lords on the appeal, also refused. The Court declined to enforce an offer made by *Bibby* to pay plaintiff the same royalties as were paid by others, not infringers.

Per WOOD, V.C.—My reason for not giving the costs, as between solicitor and client, is this: I consider that stat. 15 & 16 Vict. cap. 83, sect. 43, means that when a second trial for infringement takes place, the certificate by the judge of the first action is produced in evidence on the second trial, and the extra costs are given to afford a complete indemnity. In *Davenport* v. *Rylands* (L.R. 1 Eq. 302) I gave the certificate for costs *after* the first trial, but I have not done so *upon* the first trial.

With respect to the postponement of the decree, I consider it a matter of right that the plaintiff should have a decree at once and not be delayed.

As to the royalties, I cannot compel the plaintiff to accept the same royalty from these defendants as he receives from others. I cannot in the decree do less than give the plaintiff his full right, and I cannot bargain for him what he may choose, or may not choose, to do. There will be liberty to apply generally.

PENN *against* JACK, A.D. 1867. L.R. 5 Eq. 81.

Assessment of Damages in a Patent Suit.

After decree for injunction as above mentioned, and order that an inquiry be made as to what damages plaintiff had sustained 'by reason of the user and vending of the said invention,' plaintiff claimed to be compensated for the loss of profit of which he had been deprived as a manufacturer in consequence of defendant having wrongfully fitted the invention to certain vessels. Claim disallowed, with costs of the hearing.

Per WOOD, V.C.—There are three portions into which the relief which has been obtained by the plaintiff in this suit may be divided. The first is in respect of the vexation and annoyance of a lawsuit, for which he is entitled to his costs. Secondly, he is enabled, for ever, to restrain the defendant from again infringing his patent; and hence he is in a condition, for the future, to make any bargain he pleases, to any amount. Then the third branch of relief is that which is granted in the shape of damages for the loss which the plaintiff has actually sustained by the conduct of the defendant, irrespective of the vexation and expense of a lawsuit. With reference to this I have to ask myself, what would have been the condition of the plaintiff if the defendant had acted properly, instead of acting improperly? That condition, if it can be ascertained, will, I apprehend, be the proper measure of the plaintiff's loss.

Now if the plaintiff's case had been one of a patentee who had never granted a licence, and had always remained his own manufacturer, the question would have been one of great difficulty; and I do not hesitate to say I should not have attempted to grapple with it, but I should have sent it to a jury to settle the amount of damages. But here is a case where the patentee is not in the habit of manufacturing the articles to which the patent applies, or, at all events, very seldom does so; but he has been in the habit of granting, not general shipbuilders' licences, but a particular licence of 2*s.* 6*d.* per horse-power for each ship which is about to be built with his invention. The defendant accordingly, if he had applied, as he ought to have applied, to the plaintiff, would have had to pay 2*s.* 6*d.* per horse-power for every ship which he built with the plaintiff's invention. That is the amount which the plaintiff got from everybody else; and it does not appear to me that he is entitled to anything more from the defendant. It has been contended that the plaintiff has lost more than this; he is said to have lost a profit besides. But he has himself estimated the profit at 2*s.* 6*d.* per horse-power. His damage must be confined to 2*s.* 6*d.* per horse-power for those ships for which he has not been paid.

PIDDING *against* FRANKS, A.D. 1849. 1 Mac. & G. 56.

Equitable Assignment. Estoppel.

Suit to restrain from infringing a patent for manufacturing coffee. It appeared that plaintiff had granted, by deed, to one S., a defendant in the suit, an exclusive licence to use the patent. S. thereupon made an equitable assignment of all his interest under the licence to the other defendants. KNIGHT BRUCE, V.C. having directed an action at law, plaintiff now sought to put the defendants, other than S., on terms not to dispute the validity of the patent. Application refused.

Per LORD COTTENHAM, L.C.—Are the defendants not to be at liberty to say, we have bought the patent, and paid for it, but we do not intend to use it? They are mere equitable assignees, and why should they be deprived of the right which every stranger has of disputing the validity of the patent?

PIGGOTT *against* THE ANGLO-AMERICAN TELEGRAPH COMPANY, A.D. 1868. 19 L.T. N.S. 46.

Practice in Patent Suits. Inspection.

Suit to restrain from infringing a patent for 'improvements in the manufacture of submarine telegraph cables, and in the method of giving signals.' Plaintiff applied for an inspection of the mode of working a certain cable in possession of defendants. Application opposed on the ground that the inspection would disclose important secrets and might expose the company to loss and injury. GIFFARD, V.C. refused the application, and said:—'The Court ought to be satisfied of two things: that there was really a case to be tried at the hearing of the cause, and that the inspection asked for was of material importance to the plaintiff's case as made out by his evidence. The plaintiff could have no difficulty in proving the nature of the cable used by the defendants; in fact, a portion of it had been produced in the arguments, and the difference between it and that of the plaintiff was apparent.'

PLATT *against* ELSE, A.D. 1853. 8 EX. R. 364.

Pleading non concessit.

CASE for the infringement of a patent.

Rule nisi for leave to plead *non concessit* (Martin, B. having refused leave at Chambers) made absolute by the Court of Exchequer. (Pollock, C.B., Parke, Alderson, Martin, BB.)

During the argument PARKE, B. said:—'The law is thus stated in *Hynde's* case. (4 Rep. 71 *b*.) So against the King's letters patent under the great seal showed in Court, none can deny them, but *non concessit per præd. literas patentes* is a good plea; for although there

be such letters patent, yet perhaps nothing pass by them; and so *per consequens non concessit.*'

POTTER *against* PARR, A.D. 1860. 2 B. & S. 216 *n.*

Novelty of Invention. A part previously published must be distinguished.

CASE for the infringement of two patents—viz., of 21st *Dec.* 1836, No. 7,263, and of 25th *May*, 1842, No. 9,366, each to *J. Potter*, for 'improvements in spinning machinery.' Pleas: 1. Not guilty. And (as to patent of 1842): 11. That the invention was not new. 12. That the specification was insufficient. Issue.

The patents related to one part of the operation of mule spinning, viz., the winding the yarn into a '*cop*' upon the spindle. This operation is begun by winding a conical layer of thread at a continually increasing vertical angle, so as to form the '*cop bottom*' upon the bare spindle, and is completed by winding a succession of similar conical layers upon the foundation thus formed. The speed of revolution of the spindles for taking up the yarn should therefore vary according to the diameter of that portion of the cop at which the winding is taking place. The specification of the patent of 1836 described a method of obtaining the required variable motion of the spindles during the *winding on* by means of a chain attached to a spiral conical drum, and caused to traverse towards the smaller end of the drum during the formation of the cop bottom. The shifting of the chain on the drum was effected by a screw of varying pitch, called a *hyperbolic* screw. The winding of the uniform conical layers which completed the cop was effected by the spiral drum after the screw had ceased to act upon the chain. *Claim*: 'The spiral drum and hyperbolic screw, with which, in connection with the chain-wheel and chain, I effect the winding-on motion as described. I do not confine myself exclusively to the hyperbolic screw, as the curve may be varied by using a different form of spiral drum, &c.'

The specification of the patent of 1842 referred to the patent of 1836, and described the invention as consisting in various improvements on the mule therein specified. The spiral drum and hyperbolic screw were abandoned, and in their place a plate with curved slots on its face was rotated at the back of another plate with radial slots, whereby a set of studs working at the same time in both sets of grooves was caused to assume a spiral form, and gave a flattened fusee for the chain connected with the chain-wheel to run upon. This fusee was caused to enlarge or contract in dimensions by rotating the plate with curved scrolls relatively to the other plate by means of a worm or screw, and could be adapted to the varying requirements of speed during the respective stages of the formation

of the cop. The relative motion of the scroll and radially grooved plates was effected by a combination of two segmental wheels called '*sectors*,' with a snail called a '*spiral*.' *Claim* 5: 'The improved winding-on motion, as set forth, which, although in part used in an imperfect form before the date of this patent, did not produce a correct winding-on till I constructed the improved curves as represented, and which, together with the sectors and spiral, regulate the position and form of such curves, by which, in conjunction with the parabolic incline, seen at fig. 8 (this incline was concerned in the movement of the faller wire), I produce a perfect result.'

At the trial, it appeared that the form of winding-on motion referred to in the fifth claim (which embodied the radiating apparatus but was defective in the curves) had been brought out in a machine constructed in 1839. Verdict for plaintiff. Leave reserved.

Rule nisi to enter a verdict for defendant on the first and eleventh issues made absolute by the Court of Queen's Bench. (Cockburn, C.J., Crompton, Blackburn, JJ.)

Per COCKBURN, C.J.—I think the true construction of the fifth claim is, that the radiating apparatus as shown is a substitution for the conical drum in the patent of 1836; and that in 1842 the plaintiff intended to patent that as a substantial part of his claim, and not only in combination with the improved curves. He said that he had made that radiating apparatus in 1839, and that it did not work satisfactorily; and that he had improved it by substituting for one portion of it an improved system of curves; and he contended that he might then take out a patent for the radiating apparatus, which he had made perfect by the improved curves. In that he was wrong, for he had already made known to the world the principal part of the machine; and he could not take out a fresh patent for a combination including that and the improvements without expressly stating that the patent was for a new combination only. Therefore the patent of 1842 falls to the ground for want of novelty.

As to the patent of 1836, the specification claims a spiral movement by means of the apparatus therein described,—the spiral drum and chain, and hyperbolic screw,—which last, it says, may be varied. For that apparatus the plaintiff, in the patent of 1842, substitutes an entirely new apparatus in express terms. I think the two are perfectly distinct; and indeed it hardly lies in the mouth of the plaintiff to say the contrary, because, if they are not distinct, the patent of 1842 would be bad as patenting an old invention. The defendant's machine is an infringement of the patent of 1842, and not of the patent of 1836, and the patent of 1842 is bad for the reasons already given.

POW *against* TAUNTON, A.D. 1845. 9 Jur. 1,056.

Misdirection by Judge. Subject-matter of a Patent.

CASE for the infringement of a patent of 28th *Feb.* 1837, No. 7,312, to *J. Robinson*, for 'a nipping lever for causing the rotation of wheels, shafts,' &c. Pleas: 1. Not guilty. 2. That the invention was not new. Issue.

The patent related to a method of rotating a wheel by the reciprocation of a nipping lever which dragged the wheel round in one direction by a friction grip on its rim, but was inoperative when moving in the opposite direction. It was an equivalent for an ordinary ratchet-wheel and driving paul, and has been commonly fitted to the windlasses of ships. The specification stated:—'That the invention consisted in a nipping lever applied to the rim of a wheel in such a manner that, when the outer arm of the lever was acted upon, the inner arm or *tusk* pressed against the rim, and caused a nip which enabled the power applied to the outer arm of the lever to force the wheel round, together with any machinery to which it might be attached.' It then described the invention by reference to drawings, and showed the wheel having a rimmed flange upon which a block or *box* was capable of sliding. The nipping lever was pivoted on a pin passing through the box. *Claim*: 'The nipping lever, with its tusk and sliding box, hereinbefore described, applied to a rimmed wheel for the purpose of causing the same to rotate together with any shaft or machinery which may be attached thereto.'

At the trial, it appeared that a nipping lever was not new, and ROLFE, B. directed the jury:—That the invention was new if the application of a nipping lever to the surface of a wheel, by means of the sliding boxes, as a method of making the wheel revolve, was new.

Verdict for plaintiff.

Rule nisi for a new trial on the ground of misdirection made absolute by the Court of Queen's Bench.

Per LORD DENMAN, C.J.—The application of a nipping lever to the surface of a wheel for the purpose of making it revolve may be new, but the mere novelty of the application is not enough; it must also appear that the means essential for carrying the application into effect are also new. In the present case the means for applying the old invention to the new purpose are the sliding boxes; and if they are essential to the application, and novel as means for the purpose, the patent may be supported.

The learned judge left no question to the jury as to whether the sliding boxes were or were not an essential or necessary part of the

invention claimed. We think the jury may have been misled by the mode in which the question was left to them, and that they may have considered that it was unimportant whether the use of sliding boxes was necessary or essential to the plaintiff's invention, provided their use was new. Either they are essential and not claimed; or they are not essential, and in that case there is no novelty: we therefore think that the rule should be made absolute for a new trial.

POUPARD *against* FARDELL, A.D. 1869. 18 W.R. 59, 127.

Novelty of Invention. Sufficiency of Specification.

Suit to restrain from infringing a patent of 19th *Jan.* 1859, No. 166, to *W. Poupard*, for 'an improved wheel-skid or shoe.'

The patent related to the construction of a skid with a tail-piece of some length, which formed a gradual incline for the wheel to run upon when entering the skid. The specification described the contrivance by reference to drawings, and showed a skid with a tail projecting backwards in a curve adapted to the form of the carriage wheel. It went on to state:—'I find the best results to be obtained when the projecting tail-piece is curved upwards, but I do not limit myself to so shaping it.' *Claim*: 'The construction of a wheel-skid with a tail-piece projecting from the back part and top of the skid chamber, as hereinbefore described and illustrated.'

At the hearing by the Court, without a jury, it appeared that the service skid in use by the *Royal Artillery* had a short projection, with an eye for hanging the skid to the carriage, but that it was insufficient for guiding the wheel into the skid. MALINS, V.C. granted a perpetual injunction with costs, and also an inquiry as to damages, and said:—'What the plaintiff claims in this case is perfectly clear from the drawings and specification, and by their aid any good workman could produce the article intended to be patented. It is a skid with a tail projecting from the upper plate, but differing from the *Royal Artillery* skid. I hold that the specification is sufficient. The addition of the words, "but I do not limit myself to so shaping the tail-piece," does not vitiate the specification.'

PRICE'S PATENT CANDLE COMPANY *against* BAUWEN'S PATENT CANDLE COMPANY, A.D. 1858. 4 K. & J. 727.

Practice in Patent Suits. Account. Expiry of Patent.

Suit to restrain from infringing four several patents for the manufacture of candles. Bill for injunction and account filed on 28th *Nov.* 1856. Notice of motion for an *interim* injunction given for 10th *Dec.* 1856, two days before the expiry of the first patent on 8th *Dec.* 1856. Order made for actions at law, which were tried, and

resulted in a verdict for plaintiffs upon the first patent, but in a verdict for defendants upon the remaining three patents.

At the hearing of the cause, defendants admitted the infringement of the first patent down to 8th *Dec.* 1856, but denied the possession of any candles or fatty matters, of which an account was sought. As regarded the first patent, account refused; but inquiry ordered as to the possession, by defendants, of any candles or fatty matters manufactured according to that patent; and as regarded the remaining patents, bill dismissed with costs.

Per WOOD, V.C.—I must adhere to the observations I made in *Smith* v. *London and South-Western Railway Company* (Kay 408) as to the right to an account being dependent mainly upon the right to an injunction, so that, if for any reason an injunction cannot be obtained, there can be no right to an account.

On the 10th of *December*, a stock of these articles (of which the bill seeks an account) must have been still in the defendants' possession; and that being so, it follows that had I been then clear as to the question of right which has since been established at law—or, rather, had that question been then established at law as it has since been—the plaintiffs would have been entitled to an injunction. But it does not by any means follow that they are *now* entitled to the same relief, at a time when it may well be that an injunction would be utterly useless, in consequence of there being nothing left upon which it could operate. If, at the hearing, there is nothing upon which an injunction can operate, the arm of the Court is stayed; and I am bound by the authorities to say that, there being nothing at the hearing to which the jurisdiction of equity can attach, the case is reduced to damages, and the bill must be out of Court.

RALSTON *against* SMITH, A.D., 1860–5. 9 C.B. N.S. 117; 11 C.B. N.S. 471; 11 H. L. Ca. 223.

Function and validity of Disclaimer. Evidence of Infringement. Subject-matter of a Patent. Sufficiency of Specification.

CASE for the infringement of a patent (in part disclaimed) of 23rd *Nov.* 1858, No. 2,654, to *W. Ralston*, for 'improvements in embossing and finishing woven fabrics, *and in the machinery or apparatus employed therein.*' By disclaimer, the words in italics were erased from the title of the patent. Pleas: 1. Not guilty. 4. That the specification was insufficient. 5. That the disclaimer extended the patent right. 6. That the patent was not for the working or making of any manner of manufacture. Issue.

The invention related to a method of obtaining a *watered* or *moiré antique* finish on woven fabrics. A series of small circular

grooves, about equal in number to the warp threads in a fabric, were engraved round a metal cylinder, which was made to run against a smooth paper roller or *bowl*, but at a higher surface speed. The fabric was pulled a little on one side during its passage between the roller and bowl, whereby the threads became crushed upon the ridges of the grooves in irregular patches, and a watered or *moiré* pattern, as as well a glaze or polish, was produced. This was the invention, but the specification stated:—'I employ a roller of metal, wood, or other suitable material, and groove, flute, mill, or otherwise indent *upon* it any required design, and cause it to revolve with a bowl or bowls of paper; and I give the circumference of the pattern roller a quicker motion than that of the bowl, so as to obtain a frictional action upon the surface of the fabric as well as pressure. If the fabric is moved transversely when fed up to the machine, an indefinite number of watering patterns may be given at one operation; and, with two operations, *moiré antique* or other varieties may be obtained, which may be varied according to the number of times that the fabric passes. A finish or lustre is also given to the fabric by means of the friction of the surfaces of the rollers.' *Claim*: 'The employment of grooved, fluted, engraved, milled, or otherwise indented rollers of metal, wood, &c., driven at greater speed than the bowls connected with them, so as to exert a rubbing friction upon the fabric submitted to their action, and thereby to produce an indefinite variety of pattern, as well as a bright finish or lustre.'

The disclaimer stated:—'I disclaim the use of any pattern roller except those which are made of metal, or other suitable material, and have circular grooves, flutes, or indentations, made *around* their surface; and I also disclaim the use of any other description of design upon the surface of such rollers except such circular grooves, flutings, or indentations, as aforesaid. If the grooves are as numerous as the warp threads operated on, or nearly so, and the fabric has a slight transverse motion given to it when fed into the machine, an indefinite number of watering patterns may be produced.' The amended *claim* was for 'the employment of groved, fluted, or indented rollers of *hard* metal or other suitable material driven at a greater speed &c. (as in the original claim).'

At the trial, plaintiff deposed that, up to the time of filing his specification, he had used no other than circular grooves for the purpose of his invention. It appeared that the plaintiff's roller had from sixty-two to seventy-four rings per inch of length, the surface speeds of the roller and bowl being eighteen and ten respectively. The defendant's roller had spiral or screwed grooves with sixty-eight turns of the spiral per inch, the surface speeds of the roller and bowl

being eleven and a half and ten respectively. It also appeared that a differential motion of the roller and bowl was not new, and that the use of a patterned roller for embossing was well known at the date of the patent. ERLE, C.J. left the case to the jury. Verdict for plaintiff. Leave reserved.

Rule nisi to enter a verdict for the defendant on the 1st, 4th, 5th, and 6th issues, made absolute by the Court of Common Pleas.

Per ERLE, C.J.—The plaintiff has entered a disclaimer; and his amended specification confines his invention to one kind of substance for rollers, viz., a hard metal; and to one kind of pattern for engraving thereon, viz., circular grooves around the roller. It seems to us that this is practically a claim of a new invention, and not a part of any invention comprised in the former specification. The patentee, under colour of disclaiming, introduces a new invention. Such a disclaimer is in effect an attempt to turn a specification for an impracticable generality into a grant for a specific process which is comprised within the generality in one sense, but could not be discovered to be there without going through the same course of experiment which led to the discovery of the specific process in the disclaimer.

The plaintiff has disclaimed all patterns except circular grooves round the roller. Spiral grooves are not within the strict meaning of circular grooves; and we think we should hold the plaintiff to that strict meaning, and, under that construction, we find that the defendant did not infringe.

We also observe that a patent for the exclusive right to one particular use of a known machine might be objected to. Although the patentee may have discovered how to use the machine more beneficially than the owner knew, he has no right to take a grant which virtually prohibits the owner from an existing right over his own property.

(11 C.B. N.S. 471.) Error brought in the Court of Exchequer Chamber. (Wightman, Crompton, Blackburn, JJ., Channell, Wilde, BB.) Judgment affirmed except as to the issue upon not guilty; verdict upon that to be entered for plaintiff; the Court being of opinion that the use of spiral grooves was an infringement of plaintiff's patent.

Per WIGHTMAN, J.—If the 'other' rollers disclaimed will not succeed, and the special rollers are alone *effectual*, then the true invention resides entirely in the process described in the disclaimer; and the original specification does not describe or even suggest the form of roller in which that invention consists. And this is by the disclaimer to extend the right granted by the patent.

With respect t. . entry of the verdict on the plea of not guilty, we are not prepared to concur with the Court of Common Pleas.

(11 H.L. Ca. 223.) On appeal to the House of Lords, judgment affirmed as to the 5th and 6th issues, but reversed as to the 4th issue, verdict upon that to be entered for plaintiff.

Per LORD WESTBURY, L.C.—It is quite clear that the original specification was utterly bad and void in law. It was expressed in such a way that the indentations, grooves, or flutings might be made longitudinally, and not merely in a circular form around the roller. And it is quite clear upon the evidence that any longitudinal grooves or patterns would not have the effect desired, but would be destructive of the fabric. Therefore, upon the face of the original specification, there was, in reality, no invention that could be maintained.

In the amended specification the plaintiff has struck out the material word '*upon*,' and instead of that he has put in the distinctive word '*around*' the roller, and he has altered the language so as to convert the general direction contained in the original specification into a specific direction to make grooves, flutes, or indentations around the roller. And instead of the words being made to comprehend 'any required design,' these words are struck out, and the only direction now consists of a direction to make circular grooves around the roller. It is quite obvious that the limits of the authority or license given to the patentee by the statute with respect to disclaimers, are here very much transgressed. 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, without the necessity of addition, then you might, by the operation of a disclaimer, lop off the vicious matter, and leave the original invention as described in the specification untainted and uninjured by that vicious excess.

The next question is, whether the description contained in the specification, as corrected by the disclaimer, amounts to a new manufacture. I should have thought that the patentee might have maintained a patent for a new combination if he had put his invention upon this ground, that he was the first person who discovered that the circular grooved roller would answer by one process the double operation of calendering and imprinting the fabric. Your Lordships are well aware that by the large interpretation given to the word '*manufacture*' it not only comprehends productions, but it also comprehends the means of producing them. Therefore, in addition

to the thing produced, it will comprehend a new machine, or a new combination of machinery; it will comprehend a new process, or an improvement of an old process. But, if we look at this patent, I think there is no such improvement as amounts to a new manufacture.

There were some objections raised to the specification, and particularly with regard to the uncertainty of the material, the language of the amended specification being that the plaintiff took 'a roller of hard metal or other suitable material.' I do not think those words, 'or other suitable material,' contain anything like such a generality of direction as would be fatal to the patent; 'other suitable material' no doubt would mean any material equally sufficient for the purpose with hard metal.

Per LORD CRANWORTH.—The most material question is as to the issue which is raised in the sixth plea. I agree with what was said by Mr. *Grove*, that it is not every useful discovery that can be made the subject of a patent, but you must show that the discovery can be brought within a fair extension of the words '*a new manufacture*.' I, as a manufacturer, have my engraved roller, which I am in the habit of rolling upon a bowl, the fabric passing between the two at equal velocities. Then I can impress my pattern upon it. I have my roller without any pattern engraved upon it; I can impress that at an unequal velocity, and it will calender. But I do not do them both at the same time, because I suppose that in doing so I shall tear the fabric; and I rightly so suppose, until the plaintiff makes the discovery that there is one particular sort of pattern which may be produced without tearing the fabric. That is a very useful discovery, but it would be strange to say that it is a new manufacture, and that therefore I am to be deprived of the most useful way of employing my roller. There is nothing new in the invention, except that I now know that by a particular use of it I shall obtain a result which I did not before know that I could obtain.

RENARD *against* LEVINSTEIN, A.D. 1864–5. 10 L.T. N.S. 94, 177; 11 L.T. N.S. 79, 505; 13 W.R. 229; 2 H. & M. 628.

Practice in Patent Suits. Interrogatories. Obligation on Patentee when Invention is in part communicated from abroad. Evidence admissible under Particulars of Objections. Rights of Licensee. Injunction. Account.

Suit to restrain from infringing a patent of 12th *Jan.* 1861, No. 97, to *C. A. Girard*, for 'improvements in preparing colouring matters for dyeing and printing.' (The result partly of a communication from abroad by *G. de Laire*, and partly of invention made by himself.)

Injunction granted. Answer excepted to upon the ground that defendant had not stated fully whether he had used the materials and substances according to *Girard's* process. WOOD, V.C. said :—
The defendant is bound to answer whether he uses the ingredients mentioned in the specification, whether he adds anything else, and whether the additions make any difference in the process, though he is not compelled to disclose the nature and quantities of the additions.

On appeal to the Lords Justices, injunction dissolved, defendant to keep an account. Costs to be costs in the cause. One objection taken was that, although the specification stated that the invention was partly original and partly communicated from abroad, it did not distinguish between the respective portions thereof.

Per KNIGHT BRUCE, L.J.—In the present case, various objections have been suggested at the bar, one being that the invention, being stated to be partly original and partly communicated from a foreign country, it is not distinguished either in the letters patent or in the specification, or otherwise, what is the nature or what are the particulars of the communication from abroad, made by the gentleman mentioned. Considering the different consequences that may arise as to the part of an invention communicated from a foreign country, and as to the part of the same invention which may be deemed to be in every respect new, I consider it to be a serious and very arguable question, whether it is or is not incumbent on the patentee to distinguish, to define, and to particularise what is new and what is old, which here is not done. This is not the time at which to decide upon such a point.

I think that the sufficiency and validity of the specification is matter of serious doubt. The consequence is, that with a patent no older than the present patent is, though its age is no objection to an interlocutory injunction of itself, in the present stage of the cause there ought to be no injunction.

(11 L.T. N.S. 79.) The Court was next occupied in considering the sufficiency of plaintiffs' answers to certain interrogatories. One related to the proportions of acid and water used by plaintiffs in forming the dye, as to which WOOD, V.C. said :—'Those who practise an invention are bound to say what they do themselves. The plaintiffs must state the proportions they use.'

(11 L.T. N.S. 505; 13 W.R. 229.) The cause now came on for hearing before the Court without a jury. At the close of plaintiffs' case, counsel for defendant referred to prior publication by the specification of a patent taken out by *Girard* in 1860. Leave was then given to defendant to serve a notice of motion to amend his particulars. On the argument, WOOD, V.C. said:—

'Nothing can be more inconvenient and objectionable than the omission to bring forward this objection at an earlier period. The Court is bound to look at the substance of the case. It sees that to refuse this application may be an injury to the plaintiffs, for the only result would be a motion for a new trial before the Court itself, or an appeal to a higher jurisdiction; while to grant a perpetual injunction would be most burdensome on the defendant, if it should turn out afterwards that there is now a document in existence which makes the patent invalid upon the face of it. Therefore, holding that the lesser of two evils is to admit the evidence now tendered, I shall allow the amendment of the particulars of objection. In doing so, however, I shall exercise the power given by stat. 15 & 16 Vict. cap. 83, sect. 41, and impose such terms as seem to me fit. They are, payment of the costs of this motion; and, whatever may be the result of the trial, payment by the defendant of any extra costs which may be occasioned by the introduction of this fresh evidence.

His Honour was then asked to order defendant to give security for such extra costs, but he declined to vary the terms.

(2 H. & M. 628.) The next step was a motion for injunction, when it appeared that MM. *Renard* were the assignees of the patent, and that they had granted an exclusive licence for *England* to Messrs. *Simpson & Co.*, who filed the present bill. MM. *Renard* were made co-plaintiffs, and after the suit had advanced some stages, they assigned their interest in the patent to one *Fayolle*, as trustee for a company. The new owners were joined as defendants. It was objected that a mere licensee, not being assignee of the patent, had no right to sue for an infringement. Wood, V.C. granted an injunction, and said:—'The Court is constantly in the habit of interfering to protect plaintiffs, in cases where there is some actual or apprehended wrongdoing by a third party, with reference to some contract which has been entered into by the plaintiff or for his benefit. In this case the defendant is knowingly committing a wrong at once against the owners and licensees of this patent. If, then, the case were now exactly in the position in which it was at the time when this bill was filed, there could be no doubt, on this part of the case, that the owners and licensees, acting together as co-plaintiffs, would have such a common interest as would enable them to maintain the suit, and would be entitled to the injunction now asked for. The difficulty in this case arises from the fact that, at the time when the assignment of the patent to *Fayolle* took place, the cause had advanced to such a stage that I did not think I could allow the introduction of a new set of plaintiffs, and therefore *Fayolle* and the company which he represents have been added as

defendants to the bill. But how does that affect the wrong done to *Simpson & Co.*, the licensees?

'Then it is said, "We offer to keep an account, and therefore there can be no injunction." But although the Court is in the habit of refusing an injunction when it sees that that course will satisfy the requirements of justice, on the defendant's undertaking to keep a proper account, I apprehend that it is perfectly discretionary with the Court, and that the strict right of the plaintiff is to have an injunction as soon as he has established the fact that there is an infringement. That there is an infringement in this case I have no doubt.

'I must grant this injunction. As, however, the defendant has offered, even at this late hour, to keep an account, I must require from the plaintiffs an undertaking as to damages.'

RUSHTON *against* CRAWLEY, A.D. 1870. L.R. 10 Eq. 522.

Subject-matter of a Patent.

Suit to restrain from infringing a patent of 24th *June*, 1867, No. 1,841, to *H. Rushton*, for 'improvements in the manufacture of artificial hair.'

The specification stated:—'This invention relates to the manufacture of hair to be used in imitation of human hair for headdresses. For these purposes I take animal fibre, by preference *Russian* wool, or wool of coarse texture.' Then followed a description of the treatment of this material. *Claim*: 'The use and application of wool, particularly that kind known as *Russian tops*, or other similar wools or fibre, in the manufacture of artificial hair, and also in the manufacture of crisped or curled hair for furniture, upholstery, &c.'

It appeared that in 1865 plaintiff had taken out a patent for the manufacture of chignons from mohair, or wool of the *Angola* goat. Also that *Russian tops* was a name given to wool of a coarse description. And further that, before the date of the patent, horsehair, mohair, and wool had all been used in the manufacture of artificial hair. Bill dismissed with costs.

Per MALINS, V.C.—Here the patentee makes an exclusive claim to the use and application of wool. The witnesses have proved beyond doubt that it has been the common course of the trade to make these things from wool of all kinds, for certainly the last fourteen or fifteen years. It is a gross violation of the privilege conferred upon inventors, for a person to take out a patent for a known article which has been used for years, because he finds he can produce a thing cheaper or better by a new material. The use of a new material to produce a known article is not the subject of a

patent. The case of *Brook* v. *Aston* (8 E. & B. 478) is conclusive against the plaintiff.

RUSSELL *against* COWLEY, A.D. 1832–4. 1 Webs. Pat. Ca. 457; 1 Cr. M. & R. 864.

Inspection and delivery of Specimens. Novelty of Invention. Sufficiency of Specification.

Suit to restrain from infringing a patent of 26th *Feb.* 1825, No. 5,109, to *C. Whitehouse*, for 'improvements in manufacturing tubes for gas and other purposes.' Account. Inspection *by consent.* Each party, with their respective scientific witnesses, to be at liberty to inspect the works of the other, and to remove specimens of the pipes or tubes operated upon in their presence.

Action at law in pursuance of an order of the Court. Plea: Not guilty. Issue.

The specification stated:—'I prepare a piece of iron plate, of suitable substance and width, according to the intended calibre of the tube; this is prepared for welding by being bent up or turned over into the form of a long cylindrical tube. The tube is heated by a blast; and when the iron is on the point of fusion it is drawn out by a chain attached to a draw-bench, and passed through a pair of dies, by which means the edges of the iron will become welded together.'

The specification further described the apparatus by reference to drawings, and stated:—'I do not confine myself to this precise construction of apparatus, as several variations may be made without deviating from the principles of my invention, which is to heat the previously prepared tubes of iron to a welding heat and to pass them between dies, by which the edges may be pressed together and the joint firmly welded. The length of the pieces of tube may be from two to eight feet in one piece, whereas by the old modes the length of tubes cannot exceed four feet without considerable difficulty.'

At the trial, it appeared that no mandril was required in order to preserve the circular form of the tube. The alleged infringement consisted in the welding of a tube, prepared like plaintiff's, by passing it between grooved rollers, and then drawing it through an apparatus called a *scorpion*, which was formed by placing together three conical draw-holes. The scorpion restored the cylindrical forms to tubes distorted by the preliminary drawing. The defendant gave in evidence the specification of a patent of 26th *July*, 1811, No. 3,469, to *H. James* and *J. Jones*, for 'a method of making gun-barrels by rolling.' The specification described a method of welding rollers grooved so as to fit the form of the barrel, and stated that care should

be taken to put in or take out the mandril as quickly as possible. Verdict for plaintiff. Leave reserved.

Rule nisi to enter a nonsuit discharged by the Court of Exchequer. (Lord Lyndhurst, C.B., Parke, Alderson, Gurney, BB.)

Per LORD LYNDHURST, C.B.—Without any question this invention is ingenious and useful; and the point upon which the validity of the patent depends is, whether it claims to manufacture the pipes without the use of the mandril, in which case it would be a new invention. It is said, on behalf of the defendant, that the specification includes too much, and that the principle of the invention claimed is in fact not new; but it appears to me that the specification claims the invention of welding tubes without the use of the mandril. As I read the specification, the mandril is excluded both in the particular and in the general description. I think that the plaintiff's patent is good as being limited to the welding of tubes without the use of internal support. He has not extended his claim to anything which is not in fact his own invention.

Per PARKE, B.—I am of the same opinion. If the patent claims the invention of welding by circular pressure, then it is clearly void; but if the plaintiff only claims a limited and particular mode of effecting that object, then it is certainly new. In the construction of a patent the Court is bound to read the specification so as to support the patent, if it can be fairly done. Taking the whole specification together, it is clear that it was intended to exclude the mandril.

Per ALDERSON, B.—We ought not to be astute to deprive persons of the benefits to be derived from ingenious and new inventions.

RUSSELL *against* LEDSAM, A.D. 1843–8. 11 M. & W. 647; 14 M. & W. 574; 16 M. & W. 633; 1 H.L. Ca. 687.

Novelty of Invention. Evidence of Infringement. Computation of time. 'Prosecution with effect' within the terms of stat. 5 & 6 Will. IV. cap. 83, sect. 4.

CASE for the infringement of the same patent, extended for six years. Pleas: 1. Not guilty. 2. That the patentee was not the true and first inventor. 3. That the invention was not new. 7. That the extended letters patent were granted after the expiration of the term of the original patent, and not before the expiration of the said term, as in the declaration stated. Issue.

At the trial, defendant put in evidence the specification of a patent of 19th *Jan.* 1824, No. 4,892, to *J. Russell*, for a mode of welding iron pipes by hammering, wherein a strip of plate iron was bent into the form of a tube, and placed on an anvil having a block or bolster with a semi-cylindrical recess. The edges were then

welded by a succession of blows from a tilt hammer, either with or without the use of a mandril. After this operation, the pipe was passed between rollers, and the inside was made true by the use of a conical mandril.' It further appeared that the original patent bore date 26th *Feb.* 1825, and the extended patent bore date 26th *Feb.* 1839, and it was contended that the original patent expired on 25th *Feb.* 1839, and before the grant of the extended patent; but ALDERSON, B. over-ruled the objection.

The alleged infringement consisted in welding the edges of the pipe by passing it between rollers arranged so as to form a contracting or bell-shaped cavity, whereby the union of the edges was effected without the use of a mandril. Verdict for plaintiff. Leave reserved.

(14 M. & W. 574.) Rule nisi for a new trial and to enter a verdict for defendant on the issue raised by the 7th plea. Plaintiff also moved for judgment *non obstante veredicto* on the 7th plea, on the ground that under stat. 5 & 6 Will. IV. cap. 83, sect. 4, it is provided that 'no such extension shall be granted (that is, by the Crown) if the application by petition shall not be made and prosecuted with effect before the expiration of the term.' The Court of Exchequer were of opinion that the judgment ought not to be arrested, and that on the whole the plaintiff was entitled to succeed.

Per PARKE, B.—On the trial of this cause, a patent granted in 1824 to Mr. *J. Russell* was given in evidence for the defendant. This patent, it was contended, was for circumferential pressure and without a mandril, and therefore was the same in principle as the plaintiff's, and consequently the latter could not be supported. It appears to us, however, that the principle of the two inventions is not the same, for *J. Russell's* does not operate by continuous equal circumferential pressure as the plaintiff's does, but by the repetition of violent contact of short duration. But then it is said, that, in order to carry the plaintiff's invention into effect, the drawing the pipe through a fixed hole, and that of a conical or bell-mouthed form, is necessary; that it is an essential part of the plaintiff's patent; and that the defendant has not infringed it, for his apparatus does not move the pipe through a fixed hole; there is no relative motion between the pipe and the roller; and it does not draw out or stretch the pipe. It is on this part of the case that some of us have entertained more doubt than on the other; but, after much consideration, we do not see reason to differ in opinion from the jury, and think that the defendant's mode, though it is an improvement in some respects on the plaintiff's patent, is in others the same, and is an infringement of it. There may not be the same injury to the

fibre of the iron as by the drawing process, which weakens and attenuates the tube, and the method of operating is more convenient than that by which the plaintiff carries his principle into effect. But if the process is, as we think it is, in a material part the same, the defendant has been guilty of an infringement.

Another question is, whether the day of the date of the first letters patent was inclusive or exclusive. The usual course in recent times has been to construe the day exclusively, whenever anything was to be done in a certain time after a given event or date; and consequently the time for enrolling a specification within the six months given by the proviso is reckoned exclusively of the day of the date. We are of opinion that the verdict on the issue on the seventh plea must be entered for defendant.

The 'prosecuting with effect,' which is to warrant the Crown to grant, means, according to the ordinary construction of the sentence, a prosecuting with effect prior to and independent of the grant, and not the grant itself; and that must be the obtaining the report of the Judicial Committee, or the approbation of it by the Crown; and, if so, there is no necessity for the new letters patent to be actually issued before the expiration of the old. It seems to us there is no limit except the discretion of the Crown, and it is presumed that the grant will not be made after a long interval. With respect to those persons who use the invention in the interval, there is no doubt they are not responsible. The conclusion to which we have come is, that the Legislature did not intend to restrict the Crown as to the actual date of the grant, if all the preliminaries were completed before the expiration of the term; and therefore it appears to us that the seventh plea is bad.

(16 M. & W. 633.) Error brought in the Court of Exchequer Chamber. (Tindal, C.J., Patteson, Williams, Coltman, Maule, Wightman, Cresswell, JJ.) Judgment affirmed.

(1 H.L. Ca. 687.) Appeal to the House of Lords. Judgment affirmed, with costs.

SAUNDERS *against* ASTON, A.D. 1832. 3 B. & Ad. 881; 1 Webs. Pat. Ca. 75.

The Specification must distinguish what is new.

CASE for the infringement of a patent of 13th *Oct.* 1825, No. 5,264, to *B. Saunders*, for 'improvements in making buttons.' Plea: Not guilty. Issue.

The patent related to a method of forming a covered button with a flexible shank. A toothed steel ring or *collet* secured the back of the button, the surplus material being pinched up at the centre, so

as to form a flexible shank. *Claim*: 'The substitution of a proper soft and flexible material in place of metal shanks to all such buttons as may be formed in the various methods herein described.'

At the trial, there was evidence that, before the date of the patent, flexible shanks had been put upon buttons in several of the ways described by plaintiff; also that the *collet* itself was not new. LORD TENTERDEN, C.J. directed a nonsuit. Leave reserved.

Rule nisi to enter a verdict for plaintiff discharged by the Court of King's Bench. (Lord Tenterden, C.J., Littledale, Parke, Taunton, JJ.)

Per LITTLEDALE, J.—Neither the button nor the flexible shank was new, and they did not, by merely being put together, constitute such an invention as could support this patent. It is contended that the operation of the collet, under the present patent, is new; but that is not stated in the specification as the object of the invention, and it is, in fact, only one mode of carrying it into effect. It appears on the plaintiff's case that there were other modes of producing the same result. I think, therefore, the nonsuit was right.

SAVORY *against* PRICE, A.D. 1823. Ry. & M. 1; 1 Webs. Pat. Ca. 83.

Specification void for misleading.

CASE for the infringement of a patent of 23rd *Aug.* 1815, No. 3,954, to *T. F. Savory*, for the 'invention of a neutral salt under the name of *Seidlitz* powder.' Plea: Not guilty. Issue.

The specification set out three distinct recipes for making the ingredients of the powder—viz. (1) *Rochelle* salts (*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. It further stated the proportions in which these ingredients were to be mixed for compounding the *Seidlitz* powder. Plaintiff nonsuited.

Per ABBOTT, C.J.—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.

SAXBY and ANOTHER *against* EASTERBROOK and OTHERS, A.D. 1872. } L.R. 7 Ex. 207. }

Practice as to Account and Inspection of Books pending an Appeal.

CASE for the infringement of a patent. At the trial, after verdict for plaintiff, KELLY, C.B. granted an account.

Rule nisi to enter a verdict for defendants discharged by the Court of Exchequer. On 3rd *Feb.* 1872, notice of appeal was given. On 13th *Feb.*, order made at Chambers by Lush, J. for an account of profits to be taken by the master. On 2nd *March*, an injunction, which had been previously granted, was suspended to abide the appeal. On 9th *March*, the parties appeared before the master, but defendants declined to produce any books, and it became impossible to proceed.

Rule nisi for production and inspection of defendants' books, and to administer interrogatories, made absolute by the Court. (Kelly, C.B., Martin, Bramwell, Cleasby, BB.)

Per KELLY, C.B.—In this case the trial was before me; and, upon the verdict being pronounced, I at once, under the power given by the statute, granted an order for an account, meaning an account of profits from the time of the infringement to the time of the verdict. Judgment was afterwards given in this Court confirming the verdict. It appears that afterwards application was made to Mr. Justice Lush, who made a formal order to the same effect, extending its operation to the date of the order, and that order is still in force and has not been appealed against. In pursuance of that order the parties appeared before the master, whose duty it was to take the account, but he found himself stopped almost *in limine* by the refusal of the defendants to produce their books. Application is now made to this Court to enforce the production of these books, and to administer interrogatories. No objection has been made to any particular interrogatory. I am clearly of opinion that the rule should be made absolute.

Per BRAMWELL, B.—The case of *Bridson* v. *McAlpine* (8 Beav. 229) would go to show that if there was inconvenience in ordering the account the Court would not order it. But no application has been made here by the defendants.

Per CLEASBY, B.—We ought to enforce the order that has been made unless reason is shown for making a different order, and none has been shown.

SAXBY and ANOTHER *against* HENNETT and ANOTHER, A.D. 1873. L.R. 8 EX. 210.

Pleading. Demurrer. Priority of Patent Right.

CASE for the infringement of a patent of 20th *July*, 1867, No. 2,119, to *J. Saxby*, for 'improvements in machinery for locking railway points and signals.' Plea: That the alleged infringements were in respect of certain apparatus made by defendants under a patent bearing date the 23rd *July*, 1867, and granted to *W. Easterbrook*,

before the grant of plaintiffs' patent. Demurrer and joinder. The contention was, that as *Easterbrook's* patent was sealed before that of the plaintiff, it took priority, although of later date. Judgment for plaintiffs by the Court of Exchequer. (Kelly, C.B., Martin, Pollock, BB.)

Per KELLY, C.B.—Notice is given by a patentee at each step, and any one interested may lodge a *caveat* against the grant of the patent. In this case *Saxby's* application bore date on the 20th of *July*; the defendants' was a few days later. Nothing was done by *Saxby* or *Easterbrook* to prevent the patent of the other from being sealed; and eventually both were sealed, the sealing of *Easterbrook's* being prior in point of time. Now of the competency of the Crown to seal both there can be no doubt; and then the 24th section of stat. 15 & 16 Vict. cap. 83 comes into operation, and enacts that letters patent, where antedated, are to be of the same validity as if sealed on the day they bore date. In this case, therefore, *Saxby's* patent must be taken as dated before the patent of *Easterbrook*, and the plaintiffs are therefore entitled to judgment.

SEED *against* HIGGINS and OTHERS, A.D. 1858. 8 E. & B. 755, 771; 8 H.L. Ca. 550.

Evidence of Infringement. Construction of Specification after Disclaimer.

CASE for the infringement of a patent (in part disclaimed) of 14th *July*, 1846, No. 11,293, to *W. Seed*, for 'improvements in machinery for preparing, slubbing, and roving fibrous substances.' Pleas: 1. Not guilty. 5. That the specification was insufficient. 7. That the invention, as altered by disclaimer, was another and a different invention from that for which the patent was granted. Issue.

The patent related to the application of the so-called principle of centrifugal force in causing the small spur or finger which conducted the sliver of cotton to a bobbin, to press upon the same during the operation of winding. The specification stated that the spur in question might be brought to press or bear upon the bobbin by the action of centrifugal force, instead of by springs or other mechanical pressure. It then described one mode of applying the invention to a flyer in an ordinary roving machine. The drawings annexed showed two fixed bearings, at the top and bottom of the leg of a flyer. A vertical wire was swivelled loosely in these bearings, being bent at its lower end into a horizontal spur for conducting the sliver to the bobbin and for pressing thereon, and being also bent at its upper end, first in a horizontal and then in an upward vertical direction, so as to support a small weight at a little distance on one side of the leg of the flyer. As the flyer revolved, the weight tended

to move outwards from the axis of rotation, and the spur was forced inwards so as to press upon the surface of the bobbin. The specification went on to state:—'The above apparatus represents one particular and practicable mode of applying my invention; but I would remark that I do not intend to confine myself to this particular method; but I *claim*, as my invention, the application of the law or principle of centrifugal force to the particular or special purpose above set forth; that is, for the purpose of producing a hard and evenly compressed bobbin.' On 3rd *Aug.* 1854, the patentee filed a disclaimer, in which he stated that he had been advised that the claim of invention might be construed in such a manner as to be more extensive than he intended, and amended it in the terms following:—'I do hereby *disclaim* all application of the law or principle of centrifugal force as being part of my invention, except only the application of centrifugal force by means of a weight acting on a presser so as to cause it to press against a bobbin as described.'

At the trial, it appeared that the presser in common use before the patent was a lever-finger connected with a spring. There were various forms of springs. The defects of this arrangement were that the spring pressure was weak at starting and became gradually stronger, whereby the outer portion of the bobbin was more compressed than that within; also that the elastic pressure of different springs varied. Defendants put in evidence the specification of a patent of 27th *Feb.* 1830, No. 5,909, to *J. C. Dyer*, for (*inter alia*) a presser for winding the roving of cotton upon bobbins in a hard and compressed state. The drawing showed a cross-arm pivoted near its centre so as to swing freely in a horizontal plane about a point at the end of the guide-arm of a flyer. The tail end of this arm was carried outwards by the centrifugal force during rotation, and the guiding or front part of the arm was thereby pressed against the bobbin and hardened it in the manner required.

The alleged infringement consisted in distributing the weight necessary for pressing the spur upon the bobbin along a line parallel to the leg of a flyer and close beside it. The weight thus distributed along the leg to the flyer, was attached in such a manner as to move a little outwards during the rotation, and produced a pressure on the bobbin in precisely the same way as the separate weight of plaintiff's. Mr. *May*, the engineer, deposed that defendants' flyer was something between *Seed's* and *Dyer's*, being rather more than half way between the two, and rather more *Seed's* than *Dyer's*, and that every approach of the weight to the lower part of the leg was bad, as setting up vibration. It was objected that the specification, after disclaimer, claimed an invention different from that

for which the patent was granted, and also that there was no evidence of infringement. LORD CAMPBELL, C.J. over-ruled both objections. Verdict for plaintiff. Leave reserved.

Rule nisi to enter a verdict for defendants on the ground that the disclaimer described a different invention from that for which the patent was granted, and for a new trial on the ground of misdirection by the judge in not telling the jury that the specification claimed too much, discharged by the Court of Queen's Bench. (Lord Campbell, C.J., Wightman, Crompton, JJ.)

Per LORD CAMPBELL, C.J.—It is quite clear that, if, the specification and the disclaimer being taken together, anything is claimed which was not comprised in the original specification, the whole is bad. But we are of opinion that nothing new is claimed by the disclaimer, and that, due effect being given to the disclaimer, the plaintiff only claims a particular application of centrifugal force as described by the diagram and explained in the specification. To suppose that the exception mentioned in the disclaimer refers to the general description of the invention, and not to the apparatus portrayed in the diagram, seems to us a violation of the language the plaintiff employs and a perversion of his meaning. If this be so, the alleged misdirection of the judge, in reference to the specification, cannot be supported.

Appeal to the Court of Exchequer Chamber (Williams, Willes, Byles, JJ., Martin, Bramwell, Watson, BB.), leave to appeal having been granted on the additional ground that there was no evidence of infringement to go to the jury. The majority of the Court were of opinion that the decision of the Court of Queen's Bench on the point of law was correct, but the learned judges gave their unanimous judgment for a new trial on the ground that there was no evidence of infringement to go to the jury.

Per WILLIAMS, J.—I am of opinion that the judgment of the Court of Queen's Bench must be reversed; not on any ground considered in that Court, but on the additional ground that there was no evidence, to go to the jury, of any infringement of the patent. The plaintiff sets out one mode of application, yet wishes to state that his patent consists in applying the principle in any way. Then, seeing that his claim is not good, either as comprehending something not new, or as not explaining sufficiently so general a claim, he enters a disclaimer. Now, he is entitled to withdraw so much of his original claim as would leave only an application of the particular method. It comes therefore to this, that he claims simply what is in his drawing. The witnesses show only the user by the appellants of something different from the machine represented by the drawing.

(8 H.L. Ca. 550.) On appeal to the House of Lords, judgment of the Court of Exchequer Chamber affirmed.

Per LORD WENSLEYDALE.—The question of infringement is one of mixed law and fact. The construction of the specification is for the Court, with the aid of such facts as are admissible to explain written documents. In deciding whether there has been an infringement, there is a question of fact wholly for the jury, viz., what the defendants have done; and if scientific evidence is necessary fully to elucidate the case on either side, it is no doubt admissible; and, in determining the question of infringement, the judge must apply what the jurymen find to be true. The opinion of scientific witnesses is only admissible as proof of facts. Their opinion as to whether there has been an infringement or not, though sometimes received in order to save time and trouble, is, strictly speaking, inadmissible, and, if objected to, ought to be rejected. The Court alone is to decide questions of law.

In this case the models of both machines are brought before us, and would be before the jury; and, judging from them, we see for ourselves that, though they both answer the object of applying centrifugal force to the flyers, they do it in a different way. The plaintiff uses what is in common parlance *a weight*, and that weight is at the end of the perpendicular wire, at the top of it, and could not be put lower without interfering with the bobbin; the defendants do not use such a weight; they distribute weight by a sort of case round the bottom part of the flyer, the centre of gravity being lower than the middle of the flyer. The evidence of the scientific witnesses cannot alter these facts, and their opinion that one machine is a piracy of the other is of no consequence whatever, for that is a question not in their province to decide. If the claim in the patent had continued to be for *any* mode of applying centrifugal force to the finger or presser, undoubtedly the defendants' machine would have been an infringement. But the disclaimer puts an end to that argument; and the patent being for a particular machine only, which clearly operates differently from that of the defendants, it seems, I own, to be very clear that one is not a piracy of the other. It is only by confounding the patent as it was, with the patent as it is, that infringement of the patent can be made out.

Per LORD CHELMSFORD.—It appears to me that the plaintiff first claims the particular method described, and afterwards every other application of centrifugal force to the purpose set forth. Then, when he disclaims all application of the law or principle of centrifugal force, except only the application of centrifugal force as described in the specification, he does not abandon the whole of his invention,

and leave himself nothing but an illustration of it; but he gives up all that is general, and limits himself to the particular method, which was a substantial and independent claim, to which the general claim had previously been added. In this view the disclaimer certainly does not extend the right, nor can it be said to describe a different invention.

SELLERS *against* DICKINSON, A.D. 1850. 5 Ex. R. 312.

Evidence of Infringement. User of Part of a Combination.

CASE for the infringement of a patent of 17th *March*, 1845, No. 10,563, to *J. Sellers*, for 'improvements in looms for weaving.' Pleas: 1. Not guilty. 4. That the specification was insufficient. Issue.

The patent related to a method of stopping a power-loom automatically when the shuttle remained in the shed. The specification stated that in ordinary power-looms this object was effected by means of a spring *swell* or ridge on the outside of the shuttle-box. When the shuttle entered the box it forced out the swell, and a lever-finger was thereby kept raised; but, when the shuttle failed to travel, the finger fell out of place and came in contact with a piece called a frog, the result of which was that the driving strap was thrown from the fast to the loose pulley, and the lathe or slay was stopped. The concussion, however, caused by this mode of stopping the loom was found to be injurious. The specification then described an improved arrangement of mechanism for the same purpose, which adopted the swell and stop-rod finger, but stopped the loom by separating the two halves of a clutch-box, one attached to the main driving pulley, and the other to the driving shaft, and further arrested the motion without any concussive action by bringing a friction break to bear on the periphery of the fly-wheel. *Claim*: 'The above-described novel arrangement of mechanism for stopping the loom when the shuttle does not complete its course, by disconnecting the main driving pulley from the driving shaft, and also the method of bringing a break into connection with the fly-wheel for the purpose of preventing the lathe from beating up any further.'

At the trial, it appeared that the alleged infringement consisted in working under a patent of 11th *Sept.* 1848, No. 12,267, to defendant for a like invention. In defendant's looms, a finger or detector connected with the swell caused the shifting of the driving strap from the fast to the loose pulley in the ordinary manner, but, at the same time, brought a friction break to press against the periphery of the fly-wheel. WIGHTMAN, J. left it to the jury to say whether plaintiff's arrangement for bringing the break into action

with the fly-wheel was new and useful, and whether defendant's arrangement for effecting a like object was substantially the same as that of plaintiff. The jury answered both questions in the affirmative. Verdict for plaintiff. Leave reserved.

Rule nisi to enter a verdict for defendant or for a new trial, on the grounds that the specification was insufficient and that there was no evidence of infringement, discharged by the Court of Exchequer. (Pollock, C.B., Rolfe, Platt, BB.)

Per POLLOCK, C.B.—With the facts as found, I am of opinion that the specification is perfectly good.

The next point is, whether there has been any infringement of the patent. The argument addressed to us was that this is a patent for a combination of old and new mechanism, and, the defendant not having used the combination, there can be no infringement. But that is not so. There may be an infringement by using so much of a combination as is material, and it would be a question for the jury whether that used was not substantially the same thing. The machine is so constructed that one and the same operation throws it out of gear, and at the same time applies a break to the fly-wheel, so as to stop the momentum. The defendant has substituted for the clutch-box the old plan of the '*frog*,' and, instead of separating the power and the machine by a clutch-box and so throwing the machine out of gear, he has followed the old mode of throwing off the strap; but he has adopted the more important and substantial improvement of the break, which the jury have found in itself an arrangement of machinery new and useful. I think it may be laid down as a general proposition (if a general proposition can be laid down on a subject applicable to such a variety of matters as patent law), that if a portion of a patent for a new arrangement of machinery is in itself new and useful, and another person, for the purpose of producing the same effect, uses that portion of the arrangement, and substitutes, for the other matters combined with it, another mechanical equivalent, that would be an infringement of the patent. Such is the case in the present instance.

SIMPSON *against* HOLLIDAY, A.D. 1865–6. 5 N.R. 340; L.R. 1 H.L. Ca. 315.

Sufficiency and construction of Specification.

Suit, by assignees, to restrain from infringing a patent of 18th *Jan.* 1860, No. 126, to *H. Medlock*, for 'improvements in the preparation of red and purple dyes.'

The patent related to the preparation of red and purple dyes by treating aniline with arsenic acid. The specification stated:—'I

mix aniline with *dry* arsenic acid, and allow the mixture to stand for some time; *or* I accelerate the operation by heating it to, or near to, its boiling point, until it assumes a rich purple colour, and then I mix it with boiling water, and allow the mixture to cool; when cold it is filtered or decanted.' The filtered solution gave a red dye, and the residuum when dissolved in alcohol furnished a purple dye. The specification went on to say:—'The mixture of aniline and arsenic acid, *after being heated*, may be allowed to cool, and then forms a paste which may be preserved; when required for use, it is mixed with boiling water, and treated as above described.' The proportion of two parts by weight of aniline to one of arsenic acid gave a good result, but these proportions might be varied. *Claim*: 'The preparation of red and purple dyes, by treating aniline with arsenic acid as hereinbefore described.'

The suit came on before Wood, V.C. for trial without a jury on issues of novelty, utility, sufficiency of specification, and infringement, all of which were found in favour of plaintiff. From this decision plaintiff appealed, when two objections were raised. (1) That the specification described two processes for obtaining the red dye, one a hot process and the other a cold process, and that the latter would not succeed (this was proved in evidence, and admitted by plaintiff). (2) That *dry arsenic acid* meant *anhydrous* acid, as to which there was evidence that the arsenic of commerce was hydrated, and that no good result was obtained unless the arsenic contained a considerable percentage of water. After argument, the Lord Chancellor reversed the order of the Vice-Chancellor, declared the patent to be void at law, and dismissed the bill without costs.

Per Lord Westbury, L.C.—The first objection raised by the defendant is that two processes for effecting the end proposed, one of which may be called the cold, and the other the hot process, are described in the specification, but that one of them, viz., the cold process, is ineffective. If the true construction of the specification be, that two distinct processes are described as being both efficient, and are both claimed as part of the invention, but one is found upon trial to be inefficient and useless, it is plain that the patent has been granted on a false suggestion, and is therefore invalid and bad at law. If a specification alleges that a particular process, which may be slow, troublesome, and expensive, is efficient, and the statement is untrue, the vice is not removed by the fact that the same specification also describes another process which is efficient, and which is stated to be speedy, certain, and economical. When it is said that an error in a specification which any workman of ordinary skill and experience would perceive and correct, will not vitiate a patent, it

must be understood of errors which appear upon the face of the specification, or the drawings it refers to, or which would be at once discovered and corrected in following out the instructions given for any process or manufacture; and the reason is because such errors cannot possibly mislead. But that proposition is not a correct exposition of the law, if applied to errors which are discoverable only by experiment and further inquiry. Neither is the proposition true of any erroneous statement amounting to a false suggestion, even though the error would be at once observed by a workman possessed of ordinary knowledge of the subject.

Coming now to the construction of the specification, the inquiry is, whether, according to the ordinary rules of interpretation, there is a distinct statement of two separate processes, which are both claimed as inventions. The question depends on the construction of the first sentence in the specification. His Lordship analysed the sentence and continued:—It seems to me impossible, without rejecting several words, and altering the form of the whole sentence, to make it descriptive of *one* process only. Two modes of treating aniline with arsenic acid are plainly indicated. It was argued before me that the word '*or*,' in the words 'or I accelerate the operation,' should be read '*and*,' a construction which is forbidden by the whole structure of the sentence. And it was further contended, that the subsequent sentence which begins with the words, 'the mixture of aniline and arsenic acid, *after being heated*,' proved that one process only, viz., the hot process, was intended to be described and used, and that it corrected the alternative form of expression in the first sentence. But this is not the case, for the sentence in question applies only to the paste which is formed by the hot process, if the mixture, after being heated as directed, is allowed to cool before it is treated with hot water, in the manner described. It was argued that every person well informed on the subject would see that the cold process was ineffective. But this is to correct the specification by the superior intelligence of the reader, and is a mode of proving the invalidity of the patent by showing the false suggestion on which it was granted.

Although my decision rests on the ground I have stated, it would be wrong to omit all notice of the other objection of the defendant. This objection is founded on the direction contained in the specification to take '*dry* arsenic acid.' 'Dry,' says the defendant, is synonymous with 'anhydrous.' From the evidence it would seem that arsenic acid, as an article of commerce, at the time when this patent was granted, was usually so prepared as that when sold it was found to contain twelve to fifteen or sixteen per cent. of water of

hydration. It further appears from the evidence that no good result could be obtained from using, in the manner directed by the patent, arsenic acid that contained less than twelve to fourteen per cent. of water of hydration; but there is some evidence to show that, with that extent of water of hydration, a beneficial result would be obtained. Upon a review of the arguments and the evidence, I cannot on this point accept the contention of either side. 'Dry' is not synonymous with 'anhydrous.' When used in its ordinary sense as opposed to 'wet,' it means physically dry, or dry to the touch, and many things are dry superficially to the touch which contain a great deal of water of combination. The plaintiff *Nicholson* states in his evidence that the word '*dry*' was used in order that the proper proportion of acid might be more readily ascertained, and he therefore construes the words as meaning physically dry. Inasmuch as I have found it proved that the ordinary arsenic acid of commerce when used in a state of dry powder, in which it was and is commonly sold, would produce a beneficial result, this addition of the word 'dry' would not affect the working of the patent. I should not therefore have been of opinion that this objection was fatal to the patent; but the other objection I hold to be fatal.

On appeal to the House of Lords it was contended that the decree of the Lord Chancellor was erroneous in form as well as substance, and that his Lordship, under stat. 21 & 22 Vict. cap. 27, sects. 3 & 5, had no power to declare the patent to be void, but could only direct a new trial. No counsel appeared for the respondent. Decree appealed from affirmed so far as it declared the patent to be bad and void in law, but reversed so far as it ordered the findings of the Vice-Chancellor to be reversed. No order as to costs.

Per LORD CHELMSFORD, L.C.—In this case the issue upon the specification was in part a question of law, and the fact which showed its invalidity was not only proved but admitted by the appellants. It would be the height of absurdity to send the case to a new trial merely to try an undisputed fact, upon which the construction of the specification does not depend, but which shows that the patent is void.

Per LORD CRANWORTH.—There is no doubt in this case as to the construction of the specification. It specifies two modes of obtaining the mixture which produces the dyes, one with, and the other without, the agency of heat. It was admitted that no practical result can be obtained without the heat. This clearly makes the specification bad. It specifies two processes, whereas only one is practicable.

It is no answer to say, as was said at the bar, that any practical

workman would know that the cool process was bad, and so would adopt the other. It may be that, in construing a specification, the Court may sometimes feel justified in understanding the language, not according to its ordinary meaning, but in the mode in which it would be understood by skilled workmen called upon to act according to its direction. But this does not warrant us in giving effect to a specification claiming two things, one practicable, and the other impracticable, because a skilful workman would know that one of them could not be acted upon, and so would confine himself to the other.

THE SINGER MANUFACTURING COMPANY *against* WILSON, A.D. 1865. 5 N.R. 505.

Inspection.

Suit to restrain from infringing a patent for sewing machines. Motion for an order to inspect all sewing machines on defendant's premises, and to take drawings or photographs thereof. WOOD, V.C. refused to make an order in so general a form, but granted an inspection of one machine of each class sold or exposed for sale by defendant, such machines to be verified by affidavit.

SMITH *against* THE LONDON and NORTH-WESTERN RAILWAY COMPANY, A.D. 1853. 2 E. & B. 69; Macrory's Pat. Ca. 188.

Damages recoverable by surviving Assignee of a Patent. Evidence of Infringement. User of Part of a Combination.

CASE for the infringement of a patent of 14th *Aug.* 1835, No. 6,880, to *J. Day*, for 'an improved wheel for carriages.' Pleas: 1. Not guilty. 4. That the invention was not a new manufacture. 5. That the invention was not new. Issue.

The patent related to a method of constructing the nave, spokes, and rim of railway-carriage wheels, wholly of wrought iron, by welding. Two pieces of bar iron were placed side by side to form a spoke. A wedge-shaped piece of wrought iron was inserted between the ends of the bars, and the whole was heated and welded into one piece, forming thereby a spoke and part of the nave. The portions of the bar at the other end of the spoke were not welded, but were bent back in opposite directions, so as to form a part of the circular rim. The separate pieces were afterwards welded into a complete wheel having the arms, rim, and box all constructed of wrought iron. *Claim*: 'I declare the new invention to consist *in the circumstance* of the centre box or nave, arms, and rim of the said wheel being wholly composed of wrought iron welded into one solid mass in manner hereinbefore described.'

At the trial, it appeared that the alleged infringement consisted in forming the box of a wrought-iron wheel by welding together separate sectors. The rim was made in one piece, and was fitted to the spokes and sectors of the nave while cold. The whole was then heated, and welded into a solid mass. It further appeared that, in *Aug.* 1845, *Day* assigned the patent to plaintiff and another person, since deceased, as tenants in common, and that the infringements complained of were committed after assignment, but before the death of the co-assignee. It was thereupon contended that plaintiff was not entitled to recover more than half the damages sustained by the infringement; but MARTIN, B. directed the jury to find for the whole damages, if the issues were found for plaintiff. Verdict for plaintiff; damages 1,250*l.* Leave reserved.

Rule nisi to enter a verdict for defendants on the 2nd, 4th, and 5th issues, or to reduce the damages by one half, and for a new trial on the ground that the damages were excessive, refused by the Court of Queen's Bench. (Lord Campbell, C.J., Wightman, Erle, Crompton, JJ.)

Per LORD CAMPBELL, C.J.—We are all clearly of opinion that there is no ground for the application with respect to the alleged division of the right to damages between the representatives of the deceased assignee and the plaintiff, because the right of action was a joint right; and, if one of the assignees had not died, the action must really have been brought by both of the two assignees, and, upon the death of one of them, the right survived to the survivor.

The evidence showed a clear imitation and infringement of the manner of forming the box or nave into one piece of malleable iron with the rest of the wheel. Mr. *Atherton* contended that the words of the claim restricted the patent to the invention of a wheel made in every respect 'in manner hereinbefore described;' and that, as the defendants had not used the same mode with regard to the spokes and rim, as the patentee had specified, there could be no infringement of the patent. My brother Martin, who tried the cause, intimated his opinion that the claim was for the invention of a wheel as described in the claim; but that if the defendants had imitated or pirated the mode of welding the nave, and that were a material part of the invention, there was an infringement of a part of the patent for which this action was maintainable. We are of opinion that this ruling was quite correct, and that there was ample evidence to support the action. Where a patent is for a combination of two or three or more old inventions, a user of any of them would not be an infringement of the patent; but, where there is an invention consisting of several parts, the imitation or pirating of any part of

the invention is an infringement of the patent. Suppose that a man invents a machine consisting of three parts, of which one is a very useful invention and the two others are found to be of less practical use, surely it could not be said that it was free to any person to use the useful part so long as he took care to substitute some other mode of carrying out the less useful parts of the invention.

SMITH *against* THE LONDON and SOUTH-WESTERN RAILWAY COMPANY, A.D. 1854. Kay, 408; Macrory's Pat. Ca. 209.

Practice as to an Account in Patent Suits. Delay.

Suit to restrain from infringing the same patent. The bill was filed on 30th *June*, 1853, more than three years after the patent had expired, and complained of infringements committed nine years previously. It appeared that plaintiffs had delayed to institute these proceedings until after the termination of the action *Smith* v. *London and North-Western Railway Company* (2 E. & B. 69), where they obtained a verdict with large damages. Bill dismissed with costs. Account refused.

Per WOOD, V.C.—The true ground of relief in these cases is laid down in *Bailey* v. *Taylor* (1 Russ. & M. 75), where Sir J. Leach, M.R. says:—'The Court has no jurisdiction to give to a plaintiff a remedy for an alleged piracy, unless he can make out that he is entitled to the equitable interposition of this Court by injunction; and, in such case, the Court will also give him an account that his remedy here may be complete. If this Court do not interfere by injunction, then his remedy, as in the case of any other injury to his property, must be at law.' Unless that primary right to an injunction exists, this Court has no jurisdiction with reference to a mere question of damages. Unless a case were made out, of a numerous series of past infringements, from which the parties are still deriving advantage, I am at a loss to see how the jurisdiction of the Court could attach, or the relief by injunction be arrived at, after the expiration of the patent. Such a case of a fraudulent attempt to evade the patent might occur, as would enable the Court to restrain the use of articles made in infringement of the patent, and kept back until it expired, even after its expiration; and, the plaintiff having thus obtained the right to an injunction, the right to an account would follow.

I have therefore to consider in this case whether it is right to grant an injunction. The plaintiffs did not file their bill until three years after the patent had expired. During the whole time numerous violations of the patent were going on of which they were aware. They proceeded to bring an action against the *London and North-*

Western Railway Company, in respect of alleged violations committed by them; but they did not give the least intimation to the defendants that they should hold them responsible for any violation of the patent; and not until nine years after some of the infringements now complained of were committed, and when the patent had expired, was any attempt made to restrain the defendants by injunction or otherwise. Now, I think a delay of nine months would be sufficient to induce the Court to say that it was not a case in which the Court would interfere by injunction, especially after the expiration of the patent. Therefore, as to any right to ask now for an account, the right to which appears to be entirely ancillary to the injunction, it must in this case completely fail. I think that the circumstance that some wheels are in use, which were manufactured before the patent expired, does not alter the case: the objection of delay applies to them also.

SMITH *against* THE GREAT WESTERN RAILWAY COMPANY, A.D. 1854. } Macrory's Pat. Ca. 221. }

Inspection.

CASE for the infringement of the same patent.

Rule nisi for liberty to inspect certain books of the company, refused by the Court of Queen's Bench. (Lord Campbell, C.J., Wightman, Erle, JJ.)

Per LORD CAMPBELL, C.J.—There is nothing on the face of these affidavits to show that the books it is sought to inspect will show an infringement of the plaintiff's patent. Great injury by the discovery of trade secrets and other such inconveniences might result if we were to sanction the principle that, on the mere possibility of discovering matter advantageous to one party, an inspection should be allowed by him of the other party's books, ranging, it might be, over a lengthened period of time.

SMITH *against* NEALE, A.D. 1857. 2 C.B. N.S. 67.

Pleading. Non concessit.

Action for breach by defendant of stipulations in a contract for the assignment of a patent to him by plaintiff. Plea: *Non concessit.* Issue.

At the trial, it was contended that defendant was entitled to a verdict on the plea of *non concessit*, upon the ground that the invention was not the subject of a patent. WILLES, J. left the case to the jury. Verdict for plaintiff, with 75*l.* damages.

Rule nisi for a new trial discharged by the Court of Common Pleas. (Cresswell, Williams, Crowder, Willes, JJ.)

Per WILLES, J.—The declaration alleges a contract for the assignment by the plaintiff of the letters patent to be used as therein mentioned, and we apprehend that this is a correct expression of the contract, and that such a contract involves no warranty that the invention was new, or was a manufacture within the statute of James. The defendant in this case, as in *Hall* v. *Conder* (2 C.B. N.S. 22), contracted for the use of the plaintiff's right, such as it was, without regard to whether it could be sustained on litigation or not; and there is nothing unreasonable or uncommon in such a bargain. Upon this construction of the declaration, the plea of *non concessit* would be bad if it put in issue more than the granting of the letters patent. The learned judge was right in ruling that proof of the letters patent entitled the plaintiff to a verdict upon this issue.

SMITH *against* SCOTT, A.D. 1859. 28 L.J. C.P. 325; 6 C.B. U.S. 771.

Pleading. Demurrer. Estoppel of Licensee.

Declaration for breach of covenant by defendant to pay royalties to plaintiff due under an exclusive licence by deed to work, within certain limits, an invention of improvements in manufacturing wire rope; the declaration setting out the recital in the deed of a grant to plaintiff of a patent for the invention. Plea 11. That the invention was of no use, and was not new, and that plaintiff was not the true and first inventor thereof, and at the time of making the deed plaintiff knew the matters aforesaid, and defendant did not and had no notice thereof. Demurrer and joinder. Judgment for plaintiff by the Court of Common Pleas. (Williams, Willes, Byles, JJ.)

Per WILLIAMS, J.—The first part of the 11th plea, down to the words 'true and first inventor thereof,' is clearly bad on the authority of *Hall* v. *Conder* (2 C.B. N.S. 22) and the other cases cited. As to the latter part, the agreement being by deed, the parties are estopped from going into the question of consideration, and the allegation in the plea of such knowledge of the plaintiff and ignorance of the defendant does not amount to fraud. There being, then, no fraud, the plea is no answer to the action.

Per BYLES, J.—The 11th plea does show a total failure of consideration; but, the contract being by deed, that is immaterial. No doubt it would be good if it alleged fraud; but the plea does not allege fraud, but only evidence of fraud.

SMITH *against* BUCKINGHAM, A.D. 1870. 21 L.T. N.S. 819.

Pleading. Demurrer. Agreement to purchase a Patent-right.

Declaration for breach of an agreement by defendant to purchase the patent-right of plaintiff in an invention for which provisional

protection had been taken out. The declaration set out a recital in the agreement that plaintiff 'had lately invented an improved composition or material to be used in waterproofing, or rendering woven fabrics impervious to moisture.' Plea: That plaintiff had not invented an improved or any composition or material which could be employed in rendering woven fabrics impervious to moisture. Demurrer and joinder. Judgment for plaintiff by the Court of Queen's Bench. (Cockburn, C.J., Mellor, Lush, Hannen, JJ.)

Per MELLOR, J.—I think that the plea does not show a total failure of consideration. There is no express or implied warranty. The defendant has got what he bargained for, and therefore I think the plea is no answer to the declaration.

SPENCER *against* JACK, A.D. 1862–4. 3 De G. J. & S. 346; 11 L.T. N.S. 242.

Subject-matter of a Patent. Construction of Specification.

Suit to restrain from infringing a patent of 17th *Jan.* 1860, No. 120, to *J. F. Spencer*, for 'improvements in steam-engines for propelling vessels.'

The patent related to improvements in surface condensers for marine engines, and the specification stated:—'This invention refers to further improvements on inventions previously patented by me, viz., on 16th *Nov.* 1857 (No. 2,874), and on 29th *March*, 1858 (No. 661),and consists of several parts, each and all of which have reference to improvements in steam-engines working in connection with surface condensers of the kind and description patented by me in the year 1857.' It then described the invention by reference to drawings, showing (1) a direct acting screw-engine, having a pair of inverted cylinders raised overhead, with a surface condenser below the level of the cylinders, and occupying the space between the guides of the two connecting rods; (2) a paddle-wheel engine with a pair of oscillating cylinders, and a surface condenser lying between the cylinders. *Claims*: 1. 'In the arrangement of direct acting screw-engines the disposition of surface condensers of the kind patented by me in my previous patents (of 1857 and 1858), by which the external casing thereof forms part of the main framing, and is placed between and under the cylinders of such engines; and the tubes whereof, being horizontal or slightly inclined, are placed across the line of the propeller shaft.' 2. A like claim for paddle-wheel engines. 3. 'The arrangement, construction, and disposition of parts, and mode of working condensing steam-engines as herein described.'

The patent of 1857 related to improvements in the construction of surface condensers, and that of 1858 related (*inter alia*) to the

combination of a jet with a surface condenser of the kind patented by plaintiff in 1857, and also to an improved construction of marine engines with surface condensers.

On motion for injunction, ROMILLY, M.R. directed issues to be tried in the Court of Common Pleas, viz.:—1. Is it a new invention or manufacture? 2. Is it sufficiently described? 3. Have defendants infringed? On appeal, the Lords Justices severed the first issue into two questions; (1) Is it a new invention? (2) Is it a new manufacture?

At the trial, ERLE, C.J. directed the jury, that plaintiff's claim rested upon a combination of old things known before, but that if it were a new combination, resting on a substantial improvement, the patent could be supported, and put the questions:—Is the invention new? Is it a substantial improvement? The jury answered both questions in the affirmative, and found for plaintiff on all issues. His Lordship then certified to the Master of the Rolls that he was satisfied with the verdict, and that there was no conflict of evidence. The case then came back to ROMILLY, M.R., who was of opinion that the invention was not the subject of a patent, and granted a new trial. Appeal to the Lords Justices from this order, when, by consent, the hearing was taken as that of the original motion for injunction. Their Lordships were divided in opinion, and the case went before the Lord Chancellor, who dismissed the bill without costs.

Per LORD WESTBURY, L.C.—In the present case it seemed right to the Court to direct issues to be tried, instead of leaving the plaintiff to bring an action in the ordinary way. I advert now particularly to the second issue, whether the invention was a new manufacture. When the matter came back before his Honour the Master of the Rolls, his Honour appears to have taken up the point of law, without considering, in his judgment, that it was at all affected or concluded by the opinion of the jury, in the answer given by the jury to the second question. But, with very great respect to his Honour, I am of opinion, that he was bound to consider the point of law, taking into his hand the fact, and being guided, for the purpose of so considering it, with the aid and assistance of the fact found by the jury, that fact being that the alleged invention was a substantial improvement. If I am to approach the question of law, with the aid and with the guidance of the finding of the jury, there remains but very little question upon the matter of law, because, having regard to the reason and principle of the thing, and having regard to the numerous decisions upon the point, it is impossible to deny that if there be a combination of several things previously well known, which combination is attended with results of such utility and advantage to the

public that the combination itself is rightly denominated a *substantial improvement*, it is, I say, impossible to deny that that is the subject of a patent. Now the learned judge at the trial used that particular phrase, 'substantial improvement,' for the purpose of putting the question to the jury whether the thing patented was or was not attended with new and useful results. I have no hesitation, therefore, in expressing my opinion that the verdict for the plaintiff on the second issue—involving, as it does, the principal point of controversy before me—is a verdict which ought to stand, and that it includes within it of necessity the legal consequence that this invention is a new and useful thing, and therefore properly the subject of a patent. I cannot, therefore, at all concur with the Master of the Rolls in the direction for a new trial.

Another question is this, whether, in the construction of the specification filed under the patent of 1860, I am to take the plaintiff as limiting his description to the particular form of improved surface condenser, which had been made by him the subject of two antecedent patents. His Lordship then proceeded to examine the patentee's specification in detail, and continued:—The whole arrangement for which the patent is alleged to have been taken, is an arrangement founded upon this, that his own improved condenser is of necessity to be an integral part, a portion, an element, and a unit in that arrangement. That being the plain and obvious meaning of the specification, which I am compelled to give effect to, I find it a confessed fact, as established in the trial of the issues, that the defendants have not used at any time, in that combination or arrangement which the plaintiff says was a violation of his patent, they have never used any patent condenser with the improvements, either described in the patent of 1857, or described in the patent of 1858. I am obliged, therefore, to come to the conclusion that there was no ground for this suit at all. It is a very melancholy spectacle to observe how great has been the miscarriage, how great has been the misapprehension of the true subject which was to be tried, and into what an amount of useless matter and useless speculation these legal proceedings have been carried. It is indeed a strong lesson to distinguish in these cases between matters of law and matters of fact.

STEAD *against* WILLIAMS and OTHERS, A.D. 1843–4.
2 Webs. Pat. Ca. 126; 8 Scott N.R. 449.

Novelty of Invention. Prior Publication. Misdirection by Judge. Subject-matter of a Patent. Title of Patent.

CASE for the infringement of a patent of 19th *May*, 1838, No. 7,645, to *D. Stead*, for 'paving public streets and highways, and

public and private roads, courts, and bridges, with timber or wooden blocks.' Pleas: 2. That plaintiff was not the true and first inventor. 3. That the invention was not a new manufacture. 6. That before the patent the invention was publicly known, practised, used, and published within *England*. 7. That the title was too large and vague, and at variance with the nature of the invention described in the specification. Issue.

The patent related to a method of paving roads with equal hexagonal blocks of wood, having their sides parallel to each other, and perpendicular to the roadway, the grain of the timber being also vertical. The specification stated:—'I do not confine my claim to hexagonal blocks, as triangular or square blocks placed diagonally may be used with advantage.'

At the trial, it appeared that hexagonal wood pavement had, before the date of the patent, been laid down in the carriage way at the porch of a house of Sir *W. Worsley*, in *Yorkshire*, the blocks being somewhat pointed at the base so as to admit of being driven into the ground. Also that in 1832, two letters, written by one *Heard*, had been published in the *Transactions* of the *Society of Arts*, containing an account of hexagonal wood pavement similar to that patented, which had been laid down at *St. Petersburg*.

CRESSWELL, J. directed the jury:—The defendants say, that scientific books published throughout *England*, before the patent, contained statements which substantially communicated to the public all the information which the plaintiff himself has given; and if he from such communications derived that knowledge which enabled him to take out this patent, he cannot convert to his own private use that knowledge which has before been given to the public. But then the defendants do not bring home to the plaintiff the fact of his having seen these publications; and it is for you to judge, upon the whole of the matter, whether you think that he had seen these publications, or whether he had derived his information from some persons residing abroad. . . . The next question is, whether paving with wood can be the subject-matter of a patent. I propose to state, as my opinion, here, that it is so. . . . Then comes the question, that long before the patent was granted, the invention was publicly known in this country. If you think that the blocks at Sir *W. Worsley's* were essentially the same as the hexagonal blocks introduced by the plaintiff, I should say that, in point of law, that makes an end of the patent; because that pavement appears to have been introduced by Sir *W. Worsley*, or to have been used by him in public—not concealed—no secrecy about it—made known to all persons who came to his house, so far as their ocular inspection went. If you think

that is the same thing in substance as that which the plaintiff claims, I think it was publicly used before, and that he cannot have his patent. Whether it had been used by one or used by five, I do not think it makes any difference. . . . Whether the title is too vague or not is rather matter of law than anything else, and upon that I am in favour of the plaintiff. Verdict for plaintiff.

Rule nisi for a new trial, on the ground of misdirection, made absolute by the Court of Common Pleas. (Tindal, C.J., Coltman, Cresswell, JJ.)

Per TINDAL, C.J.—We think, if the invention has already been made public in *England*, by a description contained in a work, whether written or printed, which has been publicly circulated, in such case the patentee is not the true and first inventor within the meaning of the statute, whether he has himself borrowed his invention from such publication or not; because we think the public cannot be precluded from the right of using such information as they were already possessed of at the time of the patent granted. It is obvious that the application of this principle must depend upon the particular circumstances which are brought to bear on each particular case. The existence of a single copy of a work, though printed, brought from a depository where it has long been kept in obscurity, would afford a very different inference from the production of an Encyclopædia, or other work in general circulation. The question will be, whether upon the whole evidence there has been such a publication as to make the description a part of the public stock of information. We think, therefore, that, as this question has not been submitted to the jury, there ought to be a new trial in this case.

STEAD *against* ANDERSON, A.D. 1846–7. 2 Webs. Pat. Ca. 147; 4 C.B. 806.

Novelty of Invention. Evidence of Infringement. Prior Publication.

CASE for the infringement of the same patent. Pleas: 1. Not guilty. 2. That plaintiff was not the true and first inventor. 5. That before the patent, the invention was publicly known, practised, used, and published within *England*. Issue.

At the trial, it appeared that the alleged infringement consisted in the paving of roads with wooden blocks, presenting on the surface squares of equal size, but *rhomboidal* in shape, with two of the sides inclined at angles of 63 to 45 degrees with the horizon, the grain of the wood being parallel to the inclined sides. The evidence of prior user and publication was the same as in the previous case.

PARKE, B. directed the jury:—The first issue should be found for the defendant, unless you are of opinion that this was a fraudulent

imitation and a mere colourable evasion of the plaintiff's patent right. The 5th issue embraces in it three different allegations. The first is, that the invention has previously been actually used; the second, that it has been publicly known; the third, that it has been published, at least in part. As to the alleged user, the only evidence is, that a similar pavement had previously been laid down at Sir *W. Worsley's*. If the mode of forming and laying the blocks had been precisely similar to the plaintiff's that would have been a sufficient user to destroy the patent, though put in practice in a spot to which the public had not free access. The pavement laid down at *St. Petersburg* unquestionably was of such a description, and the user was of an extent that, if it had existed in *England* prior to the grant of the letters patent, would have rendered them void. Then has it been generally known and published? I think those words mean different things. 'Generally known' means known to the public generally, or at least to that portion of the public whose attention is turned to such matters. But 'published' means offered or dedicated to the public. Was the invention published or offered to the public to such an extent as that it was generally known amongst engineers and persons likely to take an interest in such a matter? His Lordship then referred to the judgment of the Court of Common Pleas in *Stead* v. *Williams* (8 Scott N.R. 472), stating that he should adopt the law as there laid down, and continuing:—It will be for you to say whether Mr. *Heard*, who clearly first brought the knowledge to *England*, by the communication made to him by the scientific body, made a present of it to the public so as to prevent an individual from appropriating it to himself by taking out a patent for it. If you are of that opinion, your verdict must on the fifth issue be for the defendant. Verdict for defendant on 1st and 5th issues, and for plaintiff on remaining issues.

Rule nisi for a new trial, on the ground of misdirection and that the verdict was against the evidence, discharged by the Court of Common Pleas. (Wilde, C.J., Coltman, Maule, Cresswell, JJ.)

Per WILDE, C.J.—We are of opinion that there was no evidence to justify a jury in finding that there had been an infringement. It may be observed that in *Heath* v. *Unwin* (13 M. & W. 583) the Court of Exchequer seems to have deemed it material to consider the intention of the defendant in determining whether he had infringed a patent. But in that case the evidence negatived any such intention, and the other circumstances of the case were not such as to show an infringement, so that there was no decision as to what the effect of such intention would be. And we think it clear that the action is maintainable in respect of what the defendant does, not of what

he intends. It appears, that the proper direction was that the verdict should be for the plaintiff on the 5th plea, inasmuch as there was no evidence of user; but as the publication given in evidence was clearly before the plaintiff's invention, it sustained the 2nd plea, that the plaintiff was not the true and first inventor. We discharge the rule, on the defendant consenting that the verdict shall (if the plaintiff think fit) be entered for the defendant on the 2nd plea, and for the plaintiff on the 5th.

STEINER *against* HEALD, A.D. 1851. 2 Car. & K. 1022; 6 Ex. R. 607.

Subject-matter of a Patent.

CASE for the infringement of a patent of 8th *Aug.* 1843, No. 9,860, to *F. Steiner*, for 'a new manufacture of a certain colouring matter, called *garancine*.' Pleas: 5. That the alleged invention was not any manner of manufacture. 6. That it was not a new manufacture of garancine. Issue.

The patent related to a method of extracting the colouring matter from a refuse substance, known as 'spent madder,' which remained in dye-baths after the cloths had taken up as much colouring matter as they could absorb. The spent madder was treated with sulphuric acid and steam, whereby a substance termed *garancine*, containing the whole colouring power of the *residuum*, was extracted. *Claim*: 'The manufacture, hereinbefore described, of the colouring matter, called "garancine," from madder, which has been previously used in dyeing, and which is usually called spent madder.'

At the trial, it appeared that, in the ordinary process of dyeing calico, the bath containing madder was raised to a boiling temperature, whereby a large proportion of the colouring matter was extracted. Also, that before the date of the patent, garancine had been made from fresh madder by the action of sulphuric acid at a boiling temperature; the process of extracting garancine from fresh madder being substantially the same as that patented. The effect of the acid was to dissolve some of the earthy matter in the substance and to set free the whole of the colouring agent.

In reply to counsel, POLLOCK, C.B. said:—'In my opinion it is not a new manufacture. Garancine produced from spent madder is the same thing as garancine produced from fresh madder. The process is perfectly old; the product is perfectly old; the thing upon which the process is to be applied is old; indeed I do not see any novelty in the invention at all. There is no magic in calling this "spent madder." It is madder which has undergone a process by which the whole of its virtues are not extracted.' His Lordship then ruled that in point of law, upon the 5th plea, he ought to direct the jury 'that

the invention was not a new manufacture within the statute. Verdict for defendant on 5th and 6th issues.

Error on bill of exceptions to this ruling. Judgment of *venire de novo* by the Court of Exchequer Chamber.

Per PATTESON, J.—We are all of opinion that there must be a *venire de novo* in this case. Here is no new contrivance, for the process used under the plaintiff's patent with 'spent madder' is the same as that previously used with 'fresh madder;' neither is the product new, for the garancine produced from the one and the other appears to have precisely the same qualities. If, therefore, the patent be good, it must be on account of the old contrivance being applied to a new object under such circumstances as to support the patent. Now, 'spent madder' might be a very different thing from 'fresh madder' in its properties, chemical or otherwise. Or it might be, in effect, the same thing, with the difference only that part of its colouring matter had been already extracted. Again, the properties, chemical or otherwise, of both, might or might not have been known to chemists and other scientific persons, so that they could tell whether 'fresh madder' and 'spent madder' were different things, or substantially the same thing. We think that the learned judge was wrong in treating the conclusion to be drawn from the evidence as matter of law, and that the exception is well pointed in treating it as a matter of fact which should have been left to the jury, with such observations, of course, as the learned judge might think proper to make for their assistance.

STEVENS *against* KEATING, A.D. 1847–8. 2 Phill. 333; 2 Ex. R. 772; 2 Webs. Pat. Ca. 175; 1 Mac. & G. 659.

Practice in Patent Suits. Sufficiency of Specification. Costs.

Suit to restrain from infringing a patent of 8th *Oct.* 1834, No. 6,688, to *R. F. Martin*, for 'a certain process of combining materials so as to form cements, and for the manufacture of artificial stones, marble, and other like substances;' and likewise a patent of 2nd *June*, 1840, No. 8,528, to *R. F. Martin*, for 'improvements in the manufacture of cement.' Injunction granted, but subsequently dissolved on the ground of delay. Account ordered, with action at law. On action brought, defendant pleaded:—1. Not guilty. (And as to first patent) 2. That plaintiff was not the true and first inventor. 3. That the invention was not new. 4. That the specification was insufficient. Issue.

The patent related to a method of making cement by mixing gypsum, limestone, or chalk, each in a state of powder, with a strong solution of pearlash in water, and then adding sulphuric acid in

sufficient quantity to neutralise the alkali. A stated quantity of water and of the powdered material was next added, and the product was dried and heated to a red heat. The specification stated:—'Other alkalis and acids, besides those hereinbefore mentioned, will answer the purposes of my invention, though none that I have tried answer so well as the alkali and acid hereinbefore set forth.' *Claim*: 'The processes of mixing the powdered materials, alkalis, and acids, as hereinbefore described, and subsequently burning, heating, or calcining the same, for the purposes hereinbefore set forth.'

At the trial, it appeared that the alleged infringement consisted in the use of borax, a compound of boracic acid and soda, in substitution for sulphuric acid and potash. Also it was proved that *nitric acid* would not answer for making the cement. It was objected that the patent was for a process, and not for a product, and that the specification was bad; but POLLOCK, C.B. observed:—'In one sense, an old substance produced by a new process is a new manufacture; of that there can be no doubt. . . . . Although I think this is a patent for the process rather than the product, I think it may be a patent for the product. But, whether it be the one or the other, the objection, I think, takes the same shape—namely, is the process sufficiently described? . . . . If the patentee had simply said, I perform my operation in such a way, and had then left it to the ordinary protection which the verdict of a jury generally throws round an honest invention, honestly stated, I think in all probability the specification might have been free from objection; for if any other person had used *borax* as a salt, which is composed of boracic acid and soda, and that had been found to answer, it would have been a fair question for the jury, whether there had not been a colourable imitation of the process invented by the patentee, and whether the person complained of had not in reality been travelling the same road, ploughing with his heifer, and, in substance, using his invention.'

His Lordship then directed the jury:—Some observations have been made at the bar on the subject of patents and specifications, and the different rules of construction that have been maintained at different periods. I take the rule to be that you are not to intend anything in favour of a specification or a patent, and certainly not to intend anything against it; you are to deal with it just as you find it; you are to put the true and right and fair construction upon every allegation and every fact connected with it, and you are to find what is the true and fair and just result.

His Lordship directed a verdict for defendant on the 4th issue. Verdict for plaintiff on remaining issues. Leave reserved.

(2 Ex. R. 772.) Rule to enter a verdict for plaintiff on the 4th

issue, refused by the Court of Exchequer. (Pollock, C.B., Parke, Alderson, Platt, BB.)

Per POLLOCK, C.B.—The question is, whether the specification be good or not. Only one alkali (potash) and one acid (sulphuric) are mentioned in the specification, but manifestly the inventor does not confine himself to these; if he did, the defendant would be entitled to a verdict on the plea of not guilty, for he has used neither. 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 as 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 *Rex* v. *Wheeler* (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 any view, therefore, this specification is defective.

(1 Mac. & G. 659.) Appeal petition, by two of the defendants, that, after dismissal of the bill, the costs of the motion for injunction should be paid by plaintiff.

LORD COTTENHAM, L.C. made the order, and said:—'The injunction is the only object of the cause, and getting the costs of the cause without the costs of the motion for the injunction would be practically getting nothing.'

STOCKER *against* ROGERS, A.D. 1843. 1 Car. & K. 99.

Practice as to Certificate for Costs.

CASE for the infringement of a patent. Pleas: 1. Not guilty. 2. That the invention was not new. 3. That the specification was insufficient. Issue.

At the trial, no evidence was adduced, and a verdict was taken by consent for plaintiff, with 40s. damages. ERSKINE, J. refused to certify that the validity of the patent came in question, and said:—'I think that as this is a verdict by consent, and as no evidence has been adduced before me, I ought not to grant a certificate. My certificate would affect third parties, and it would be possible in a case like the present for two parties, by collusion, to consent to a verdict in favour of a patent, and, if they could obtain a certificate under stat. 5 & 6 Will. IV. cap. 83, sect. 3, to use it afterwards to the injury of another person who was really contesting the validity of the patent.'

STURTZ *against* DE LA RUE, A.D. 1828. 5 Russ. 322.

Sufficiency of Specification. Title of Patent.

Suit to restrain from infringing a patent of 14th *Feb.* 1827, No. 5,463, to *J. G. Christ*, for 'improvements in copper and other plate printing.'

The patent related to a method of preparing a glazed surface on paper by coating it with a mixture of white lead and size, before the application of pressure. The specification stated that the white lead used should be the finest and purest chemical white lead. *Claim*: 'The glazing and enamel hereinbefore described, applied to paper or cardboard in the manner hereinbefore described for the purpose of copper and other plate printing.'

It appeared that ordinary white lead would not answer the purpose; but that a purer material, imported from *Germany*, and sold at one particular shop in *London*, would produce the required effect.

Per LORD LYNDHURST, L.C.—The title for this patent is for 'improvements in copper and other plate printing.' Copper-plate printing consists of processes involving a great variety of circumstances: an improvement in any one of these circumstances—in the preparation of the paper, for instance—may truly be called an improvement in copper-plate printing. In this case the principal part of the improvement relates to the preparation of the paper. It is material to the perfection of copper-plate printing that the lines should be as distinct as possible; and if by adding anything to the surface of the paper more clearness is given to the lines, that is an improvement in copper-plate printing.

It is a principle of patent law, that there must be the utmost good faith in the specification. It must describe the invention in such a way, that a person of ordinary skill in the trade should be able to carry on the process. Here the specification says that there is to be added to the size certain proportions 'of the finest and purest chemical white lead.' A workman would naturally go to a chemist's shop and ask for 'the finest and purest chemical white lead;' the answer which he would receive would be, that there was no substance known in the trade by that name. It appears to me that this specification does not give that degree of full and precise information which the public has a right to require.

SWINBORNE *against* NELSON, A.D. 1852-3. 16 Beav. 416.

Practice in Patent Suits. Discovery.

Suit to restrain from infringing a patent of 24th *Nov.* 1847, No. 11,975, to *G. P. Swinborne*, for 'improvements in the manufac-

ture of gelatine.' For an action at law in this cause, see *Wallington* v. *Dale* (7 Ex. R. 888).

The bill interrogated defendant respecting his dealings and transactions, and sought an account of profits made by the infringement. Defendant, who had obtained prior patents for the manufacture of gelatine, answered that he had worked under a patent of his own, and not under that of plaintiff, and submitted that he was not bound to furnish an account of articles so manufactured. He also denied plaintiff's title. ROMILLY, M.R. said that defendant must answer the interrogatories, notwithstanding that he rested his defence on a denial of plaintiff's title. No costs given to either side.

TALBOT *against* LAROCHE, A.D. 1854. 15 C.B. 310.

Particulars of Breaches.

CASE for the infringement of a patent of 8th *Feb.* 1841, No. 8,842, to *W. H. F. Talbot*, for 'improvements in obtaining pictures or representations of objects.' The particulars of breaches delivered pursuant to stat. 15 & 16 Vict. cap. 83, sect. 43, charged infringement generally by selling pictures; and further stated:—'That one of such pictures was made and sold by defendant to one *A. H. C.*, on 27th *April*, 1854; but plaintiff states this by way of example only, and not so as to preclude him at the trial from insisting on other infringements.'

Rule for the delivery of further and better particulars, refused by the Court of Common Pleas.

Per JERVIS, C.J.—I am of opinion that the defendant is not entitled to any further or better particulars in this case. Under a plea of want of novelty, the Court requires the particulars of objections to condescend upon particular instances. But that is very different from this case; the matter there is not in the knowledge of the patentee. But the defendant must know whether, and in what respects, he has been guilty of an infringement.

TAYLOR *against* HARE, A.D. 1805. 1 B. & P. N.R. 260; 1 Webs. Pat. Ca. 292.

The Licensee of a void Patent cannot recover back Payments.

Action for money had and received. Verdict for 425*l.* subject to a case stated for the opinion of the Court. It appeared that defendant obtained a patent on 12th *Sept.* 1791 (No. 1,826) for an invention of an apparatus for preserving the essential oil of hops in brewing. By agreement, reciting the grant of the patent, defendant licensed plaintiff to use the invention. Plaintiff worked under the licence for several years, and paid sums of money amounting to 425*l.* The

invention turned out not to be new, but the patent was not repealed. Judgment of nonsuit by the Court of Common Pleas. (Mansfield, C.J., Heath, Rooke, Chambre, JJ.)

Per MANSFIELD, C.J.—In this case, two persons, equally innocent, make a bargain for the use of a patent, the defendant supposing himself to be in possession of a valuable patent right, and plaintiff supposing the same thing. Under these circumstances, the latter agrees to pay the former for the use of the invention, and he has the use of it; *non constat* what advantage he made of it; for anything that appears he may have made considerable profit. These persons may be considered, in some measure, as partners in the benefit of this invention. In consideration of a sum of money, the defendant permits the plaintiff to make use of this invention, which he would never have thought of using had not the privilege been transferred to him. How then can we say that the plaintiff ought to recover back all that he has paid? I think that there must be judgment for the defendant.

Per HEATH, J.—We cannot take an account here of the profits. It might as well be said, that if a man lease land, and the lessee pay rent, and afterwards be evicted, that he shall recover back the rent, though he has taken the fruits of the land.

Per CHAMBRE, J.—The plaintiff has had the enjoyment of what he stipulated for.

TEMPLETON *against* MACFARLANE, A.D. 1848. 1 H.L. Ca. 595.

Failure of Novelty in Part of an Invention.

Suit, in *Scotland*, for the infringement of a *Scotch* patent of 17th *July*, 1839, to *T. Templeton* and *W. Quigley*, for 'an improved mode of manufacturing silk, cotton, woollen, and linen fabrics.' *Claim*: 'The method of preparing stripes of silk, cotton, &c., so that both cut edges of each stripe shall be brought up on one side and in close contact; *and*, the re-weaving such stripes, with the whole fur or pile uppermost, into the surfaces of carpets, rugs, &c.'

At the trial, it appeared that the method of preparing the stripes was not new; whereupon LORD ROBERTSON directed the jury that proof of a separate prior public user of one part of the invention—viz., the method of preparing the stripes—would not suffice to invalidate the patent. Verdict for the pursuer. Error, on bill of exceptions to this ruling. Exceptions allowed by the Court of Session. On appeal to the House of Lords, judgment affirmed, with costs.

Per LORD COTTENHAM, L.C.—If I am right, the judge at the trial mistook the law in supposing it to be immaterial whether all the

invention, or only part of it, was new; and whether, part only being new, the patentee appeared by his specification to claim the whole.

TETLEY *against* EASTON and AMOS, A.D. 1852–7. Macrory Pat. Ca. 48; 2 E. & B. 956; 18 C.B. 643; 2 C.B. N.S. 706.

Novelty of Invention. Subject-matter of a Patent. Evidence of Infringement. Sufficiency of Specification.

CASE for the infringement of a patent of 11th *Feb.* 1846, No. 11,081, to *C. Tetley*, for 'improvements in machinery for raising and impelling water, and other liquids, *and also thereby to obtain mechanical power*.' Pleas: 1. Not guilty. 2. That plaintiff was not the true and first inventor. 3. That the invention was not a new manufacture. 4. That is was not new. 5. That the specification was insufficient. Issue.

The patent related to a form of centrifugal pump for raising water. The specification described the apparatus by reference to drawings, and showed a hollow wheel mounted on a horizontal axis, and having a central chamber or nave with radial arms projecting therefrom, like the spokes in an ordinary carriage-wheel. The arms were straight tubes fitted with collapsible valves at the ends. The nave was divided into two parts by a plate carrying the wheel and keyed to the driving shaft, the spokes being enlarged at their junction with the nave so as to allow the water to enter freely from either side of the plate. Two hollow shafts, one on each side of the wheel, formed channels for supplying water to the interior of the nave. When the wheel was in action the water entered simultaneously at both sides, and the central partition or disc caused the fluid pressure to become equalised. The wheel itself was mounted in an empty case connected with an exit pipe. The apparatus might be wholly immersed below the water to be lifted, but otherwise an air-pump was employed to suck water into the wheel and fill it before the rotation commenced. When the pump was to be used for forcing water to a higher level, the case was made air-tight and was filled with compressed air, so as to act like the air-vessel in an ordinary force-pump. The specification stated:—'And, generally, I propose to construct the wheel of every variety of configuration, so long as it is constructed to have a channel or channels in the interior thereof for the passage of liquids, and shall be adapted to neutralise the effects of suction, by having a corresponding degree of suction at each side; nor do I confine myself to a form or configuration, or manner of connecting together any other parts of the machine, but I propose to vary the same. Nor do I claim, in any way, the sole application of machinery for raising water by centrifugal force, except

only when the same is used as a means of introducing liquids into compressed air, as specified in my fifth claim.' *Claims*: 1. 'The means of neutralising the effects of suction at one side of the wheel by causing the same degree of suction at both sides thereof. 2. The means of increasing the action of the machine by causing the liquid to enter the wheel at both sides. 5. The construction of machinery for raising or impelling water, by introducing such water into compressed air *or other suitable elastic fluid*, and causing such compressed air, *or other elastic fluid*, to operate as the lifting power to impel such water upwards. 9. The application of the before-mentioned inventions, both when all used in combination or when used severally.'

At the trial, it appeared that the alleged infringement consisted in the use and manufacture of a pump known as *Appold's* centrifugal pump, which consisted of a hollow cylindrical box or wheel made up of two outside annular plates, placed parallel to an inside circular disc, which divided the wheel into two distinct parts. The outside plates were connected with the disc by curved blades, the result being that the centre of the wheel on both sides was perfectly open, as was also the circumference, and that there were free passages or channels from the centre to the circumference, the whole forming a divided wheel with an open nave and curved hollow arms. To set up the action, the wheel was immersed in water and rotated on a horizontal driving spindle, to which the central disc was keyed, whereby water entered freely at the central open spaces on each side, and was discharged into a separate chamber at the bottom of an exit pipe. By increasing the velocity of rotation a higher lift was obtained.

In directing the jury, POLLOCK, C.B. read the passage, 'Nor do I claim in any way the sole application of machinery,' &c.; and observed:—I think that these words, taken literally, would limit his claim to compressed air. It appears to me that there is some mistake in the passage, and that it is not consistent with the rest of the specification. I think we ought always to give effect to what a specification means; and if there is a mistake which can be corrected by another part of the specification, I think we are bound to make that correction.

We are also bound to oppose in every possible degree, where the case calls for it, the endeavours to make a patent grasp at and embrace a number of matters that never were in the head of the inventor. It is very likely that Mr. *Tetley* had not in his mind, at the time when he took out his patent, any idea of using bent arms. If he had, there is no doubt that his patent was worth nothing,

because he did not, in his specification, give the public the full benefit of it. A man has no right to patent a principle, and then to give the public the humblest instrument that can be made from his principle, and reserve to himself all the better parts of it, and to box up his improvements, and say to the world, 'You are at liberty to use the straight arm if you like, it will be of very little use;' and if you believe the testimony of one of the witnesses to-day, it would not do more than one-third of the work. Then what is the patent worth without the curved arms? He says: 'I claim every possible shape in which it may be used hereafter.' I do not think that can be done. What you have to decide is, where you think the principle is to be found which *Appold* used. I think all the rest is matter of law. Verdict for defendants.

The patentee then disclaimed a part of his invention, excising, *inter alia*, the part of the title printed in italics, and particularly the sentence commented on in the direction of the learned judge—viz., '*and generally I propose to construct the wheel of every variety of configuration*;' rejecting also claims 3, 4, 6, 7, 8, and omitting the words in the former 5th (*now* the 3rd) claim, which are printed in italics; but retaining claim 9 as being now claim 4.

(2 E. & B. 956.) Second action between the same parties for infringement of same patent after disclaimer. Pleas: 2. That plaintiff was not the true and first inventor. 3. That the invention was not a new manufacture. Issue.

At the trial, defendants put in evidence the specification of a patent of 22nd *March*, 1841, No. 8,896, to *M. W. Ruthven*, and raised an objection that the specification was bad as describing and claiming the wheel, which was admitted to be old. WIGHTMAN, J. directed the jury that this was a fatal objection to the patent. Verdict for defendants on second and third issues.

Rule nisi for a new trial on the ground of misdirection, discharged by the Court of Queen's Bench. (Lord Campbell, C.J., Coleridge, Wightman, JJ.)

Per LORD CAMPBELL, C.J.—It was proved, and is now admitted, that the wheel is not new. I am of opinion that there is nothing to show that the wheel is not comprehended in the claim. I do not think that the words of the disclaimer, which precede the four claims, amount to anything like a clear disclaimer of the wheel. But when we come to the third and fourth claims, we find that the wheel is directly claimed. As to the third, the wheel clearly is part of the 'machinery for raising and impelling water' into the compressed air; it does so 'in virtue of centrifugal force imparted thereto by such machinery.' His Lordship then referred to claim 4 (formerly claim

9), and said:—Had the wheel been new and the plaintiff been suing for the infringement of this patent by the mere use of such a wheel, this fourth claim would have furnished him with a most powerful argument to show that the patent was infringed.

Per COLERIDGE, J.—If a specification includes what is old, as well as what is new, the patentee must be taken to claim all, unless he clearly makes it appear that he does not claim that which is old. Here, among the things used as part of the machinery, is the wheel. Does he treat that as an old invention, such an invention as was too notoriously old to require disclaimer? On the contrary, we find an elaborate description of the wheel, and it is introduced into the patent as one of the things necessary to make up the machine.

(18 C.B. 643.) The patentee again disclaimed, giving up wheels of every form, and striking out all claims except the second.

Third action between the same parties for infringement of the same patent after second disclaimer. Pleas: 2. That plaintiff was not the true and first inventor. 3. That the invention was not a new manufacture. Issue.

Plaintiff having obtained an order under stat. 17 & 18 Vict. cap. 125, sect. 51, interrogated defendants as follows:—7. State the names and addresses of the several persons to whom the centrifugal pumps (made by you between 21st *April*, 1855, and 5th *May*, 1856) have been sold, &c. 8. Where are or were the said pumps respectively in use or sent to be used. Rule to strike out these interrogatories, refused by the Court of Common Pleas, JERVIS, C.J. observing:—'That the customers (of defendants) may be exposed to actions is no objection. If you admit the infringement, the plaintiff is entitled to the information he asks.'

(2 C.B. N.S. 706.) At the trial, plaintiff relied on the single claim now left in the specification, and defendants put in the specification of *Ruthven's* patent before mentioned (No. 8,896). WILLES, J. was of opinion that plaintiff's invention had been anticipated by *Ruthven*, and directed a verdict to be entered for defendants on 2nd and 3rd issues. Verdict accordingly. Leave reserved.

Rule nisi to enter a verdict for plaintiff on the second and third issues, discharged by the Court of Common Pleas. (Cockburn, C.J., Cresswell, Crowder, Willes, JJ.)

Per CRESSWELL, J.—The form of the wheel used by the plaintiff was not new, nor does he claim it as new; nor was the plan of admitting water at both sides, for the purpose of being projected forwards by centrifugal force, new,—it having been made known by the specification enrolled by *Ruthven*, and the drawings annexed to it. It may be true that the plaintiff first explained the full benefit obtained

by so introducing it; but the discovery that a particular advantage was obtained by the use of a wheel known before, in a manner known before, cannot be called an invention or application to sustain a patent (*Losh* v. *Hague*, 1 Webs. Pat. Ca. 200).

THOMAS *against* FOXWELL, A.D. 1858–9. 5 Jur. N.S. 37; 6 Jur. N.S. 271.

Novelty of Invention. Prior Patent for Part of a Combination.

CASE for the infringement of a patent (in part disclaimed) of 1st *Dec.* 1846, No. 11,464, to *W. Thomas*, for 'improvements in machinery for sewing and stitching various fabrics' (a communication from abroad). Pleas: 2. That plaintiff was not the first inventor. 3. That the invention was not a new manufacture. Issue.

The patent was for a *Howe's* sewing machine, and the specification stated:—'The principal novelty of this invention is the combination of a vibrating needle with a shuttle, which shuttle, when the point of the needle has entered the cloth or other fabric under operation, and formed a loop of thread, passes through that loop, and leaves a thread on the face of the cloth, by which means the needle, when withdrawn, leaves a tightened loop on the opposite side of the cloth to that at which it entered.' *Claim* 2: 'The application of a shuttle in combination with a needle, as shown in sheet 1, for forming and securing loops of thread or other substance for the purpose of producing stitches, either to unite or ornament various fabrics, whatever may be the means of working such shuttle and needle when employed together.'

In 1855, plaintiff entered a disclaimer, wherein he referred to a patent of 7th *Dec.* 1844, No. 10,424, to *J. Fisher* and *J. Gibbons*, for 'improvements in the manufacture of lace,' which contained, *inter alia*, a description of an invention wherein a series of needles were arranged to act simultaneously, together with a like number of shuttles, for the purpose of ornamenting fabrics. The specification of the patent of *Fisher* and *Gibbons* stated:—'Secondly, our invention consists of improvements in the manufacture of lace, or other fabrics, by causing threads or gymp or yarn to be sewn in pattern on the surface of such fabrics by machinery.' It went on to describe a mode of doing this by means of a needle and shuttle, the shuttle passing between the needle and its thread each time that the needle passed up through the fabric; and the needle, on descending, sewing down the thread as laid by the shuttle. The *claim* was for 'the mode of manufacturing figured lace and other fabrics, herein described, wherein threads or gymp are sewn in pattern by machinery on the surfaces of fabrics.' Plaintiff's disclaimer stated:—'I do not

claim the use in a machine of several needles and shuttles, nor do I claim any of the mechanical parts separately of which the machinery in the drawings is composed.'

At the trial, defendant relied on the specification of the patent of *Fisher* and *Gibbons* (No. 10,424), above mentioned.

Verdict for plaintiff. Leave reserved.

Rule nisi to enter a nonsuit on the ground, *inter alia*, of failure of novelty in the second claim of invention, made absolute by the Court of Queen's Bench. (Lord Campbell, C.J., Coleridge, Erle, Crompton, JJ.)

Per LORD CAMPBELL, C.J.—Unfortunately the plaintiff seems to have thought that *Howe's American* machine (the invention he had purchased) was not only new in its general combination, but that all the subordinate parts of the general combination were likewise new. Accordingly, after the claim to the general combination, the plaintiff goes on to say, 'Secondly, I claim the application of a shuttle in combination with a needle,' &c. His Lordship read the whole claim, and continued:—In his disclaimer in 1855 he adds to this, 'But I do not claim the use in a machine of several needles and shuttles, nor do I claim any of the mechanical parts separately of which the machinery shown in the drawings is composed.' This, however, as far as claim No. 2 is concerned, is only a disclaimer of the use in a machine of a plurality of needles and shuttles.

We think that upon the plaintiff's second claim a question of law arises for the Court, and that we are bound to decide whether the subordinate combination described in the plaintiff's second claim is disclosed by *Fisher* and *Gibbons's* specification. We by no means lay down, as a general rule, that upon a question of novelty of invention such as this, raised by the comparison of two specifications, it must necessarily be a question of law for the Court. The specifications may contain expressions of art and commerce, upon which experts must be examined, and there may be conflicting evidence, raising a question of evidence to be determined by the jury. But it is quite clear that there may be cases in which the Court would be bound to decide the question of novelty exclusively, for the two specifications might be, *in ipsissimis verbis*, the same; and if they be in such plain and common language that the judge is sure he understands their meaning, he is bound to construe them as he does other written documents.

In the present case the important point for us to consider is, what is the extent of the plaintiff's claim, No. 2? Is it confined exclusively to the single application of a shuttle in combination with a needle as shown in sheet 1, or does it extend generally to the

application of a shuttle with a needle 'for forming and securing loops of thread or other substance for the purpose of producing stitches either to unite or ornament various fabrics?' We put the latter construction upon the words, considering that the application is shown in sheet 1 by way of example.

The specific claims with which *Fisher* and *Gibbons* sum up their specification, appear to us to include the plaintiff's claim No. 2, although the particular application of a shuttle in combination with a needle shown by him in sheet 1 is not by them expressly described or delineated. Therefore, if the plaintiff's claim, No. 2, be general, as we construe it to be, *Fisher* and *Gibbons's* machine, if posterior to it, would be an infringement, and, being anterior, disproves the novelty of the invention.

Error brought in the Court of Exchequer Chamber. (Pollock, C.B., Williams, Crowder, Willes, JJ., Bramwell, B.) Judgment affirmed.

Per POLLOCK, C.B.—I am of opinion that the judgment of the Court of Queen's Bench is right, and that claim No. 2 is to be read as claiming something more than that which is in fig. 1. 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 formed. It is clear that the patentee did not mean to confine himself in the manner Mr. *Bovill* invites us to construe the claim. *A needle and a shuttle* do not mean *the needle and shuttle in the specification*, but extend to other needles and other shuttles. That which is at the end of the second claim makes this still more evident, and puts it beyond a doubt, 'whatever may be the means of working such shuttle and needle when employed together.' Unless we can see that there are no possible means of working a needle and shuttle other than that comprised in sheet 1, and the description of sheet 1, the patent cannot be sustained. The needle and shuttle are avowedly not new; then how can a claim of every possible mode of working a needle and shuttle together be sustained?

Per WILLIAMS, J.—The construction put upon the claim by the Court of Queen's Bench is strengthened by the disclaimer, which is in exact accordance with its being a general claim.

THOMAS *against* HUNT, A.D. 1864. 17 C.B. N.S. 183.

Rights of Vendee of Licensee.

CASE for the infringement of a patent for improvements in the manufacture of soap. Plea (in substance). That the alleged in-

fringement was the resale by defendant of soap purchased by himself from licensees of plaintiff. Demurrer and joinder.

Judgment for defendant by the Court of Common Pleas.

Per WILLIAMS, J.—The vendee of the licensee has all the privileges of a vendee, including that of selling again. The very object of the licence would be frustrated if this were not so.

THOMAS *against* WELCH, A.D. 1866. L.R. 1 C.P. 192.

Variance between the Provisional and Complete Specifications. Sufficiency of Specification after Disclaimer.

CASE for the infringement of a patent (in part disclaimed) of 27th *April*, 1853, No. 1,026, to *W. F. Thomas*, for 'improvements in apparatus for stitching and sewing.' Pleas: 1. Not guilty. 4. That the invention was not a new manufacture. 7. That no specification was filed. 9. That the disclaimer extended the patent right. Issue.

The patent related to the invention of the so-called *four-motion* feed for sewing machines, consisting of an instrument which made four movements in producing a step by step feed of the fabric operated upon. This instrument held the work during the insertion of the needle, rose vertically, moved horizontally, and again descended so as to hold the work during the withdrawal of the needle. It then returned to its first position, and carried the fabric through the length of a stitch. The provisional specification stated:—'The improvements consist, *first*, in moving the work after each stitch by an instrument acting on that surface of the fabric which the needle enters. This instrument, *or another acting therewith*, acts to hold the work during the insertion of the needle, and again during its withdrawal. *Secondly*, in withdrawing the holding means from the fabric, whilst the needle is therein, to admit of any shifting thereof, and to facilitate the varying the direction of the next stitch.'

The complete specification contained drawings of sewing machines, with details of parts thereof, and concluded with five separate claims. On 3rd *August*, 1861, plaintiff excised all the claiming clauses by disclaimer, and the amended specification stated:—'*g* is the instrument by which the work is held during the insertion of the needle.' The construction and operation of *g* was then described, and three forms of it were shown—viz., (1) the instrument already mentioned; (2) an instrument made in two parts as shown; (3) an instrument in the form of a roughened roller which did not rise from the fabric. The specification continued:—'It is the arranging an instrument *g*, *as herein described*, which, while it is the means of holding the fabric during the insertion and withdrawal of the needle, is also the means

by which the step by step movement is given to the fabric or material for the succession of stitches, which constitutes *the* peculiarity of the invention.' The words in italics were inserted in the amended specification, the word '*the*' replacing the word '*another*' in the original specification. Verdict for plaintiff. Leave reserved.

Rule nisi to set aside the verdict (granted on sixteen different grounds of objection), discharged by the Court of Common Pleas. (Erle, C.J., Willes, Keating, Montague Smith, JJ.)

Per ERLE, J.—It is said that the complete specification is void because it omits some of the inventions put forward in the provisional specification. The provisional specification describes an instrument, and then says that 'this, *or another acting therewith*, acts to hold the work during the insertion of the needle.' It is said that the complete specification contains nothing corresponding to this second alternative. Assuming that this is so, I do not think 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 of *g* mentioned in the complete specification, which is in two parts, is what was referred to in the expression, '*and another acting therewith.*'

The real questions, however, are whether the patent is void for want of novelty, and whether there was any infringement, both of which depend on the construction of the specification. In dealing with such inventions I consider what was the mechanical contrivance in the patentee's mind, and what was the object he sought to gain thereby; and if the same object has previously been carried out by the same or similar means, the patent is void. It is necessary that the specification should state the object, and the means by which the patentee proposes to effect it; this is often done in the form of a claim, but here all the claiming clauses have been struck out by disclaimer. In the specification, however, he has declared what is the peculiarity of his invention; and it is the arranging an instrument, *g*, as herein described, which, whilst it is the means of holding the fabric, also moves it. The object of the invention is to show how the fabric can be at the same time held and moved, and it is always by means of *g*. The letter *g* stands for three instruments; but it is the mode in which *g* is used, both to hold and to move the fabric, which constitutes the peculiarity of the invention. Does the patentee then claim all instruments which at once move and hold the fabric? I

think not. Comparing the instrument with those in use before, I find it differs in several points, and there is considerable evidence that it was a really valuable improvement. If we take the invention to be the holding and moving the fabric at the same time, as therein described, by an instrument similar to *g*, I think it is clear that the defendant has infringed it, since his machines contain an instrument similar to *g*, producing substantially the same effects.

THOMPSON *against* JAMES, A.D. 1863. 32 Beav. 570.

Subject-matter of a Patent.

Suit, by assignees, to restrain from infringing a patent of 22nd *July*, 1856, No. 1,729, to *C. Amet*, for 'improved means of distending articles of dress.'

The patent was for a flexible petticoat, known as a 'crinoline,' and the specification stated that the petticoat was composed of a sufficient number of hoops, made of watch-spring steel, and suspended at intervals by tapes or bands. *Claim*: 'The exclusive use of steel springs in combination with suspending tapes or bands, made as hereinbefore described and forming a skeleton petticoat.'

Upon motion for injunction, ROMILLY, M.R. made no order, and said:—'The patent seems to be a mere substituting of steel springs in the place where other elastic materials were used before. There is no invention, and nothing that can be called an invention, in that, and nothing which can properly form the subject of a patent.'

Plaintiffs then asked for an issue to try the validity of the patent, but his Honour said that he would find everything in favour of the plaintiffs which could be found for them by a jury if an issue were directed; still, he must determine, as a judge, that the substitution of steel wire for whalebone was not the subject of a patent. The application must be refused.

TROTMAN *against* WOOD and OTHERS, A.D. 1864. 16 C.B. N.S. 479.

Evidence of Infringement. Estoppel of Licensee.

Action for breaches by defendants of stipulations contained in a licence to them by plaintiff to use a patent of 20th *April*, 1852, No. 14,076, to *J. Trotman*, for 'improvements in anchors.' The declaration assigned as breaches (1) non-payment of royalties; (2) not accounting; (3) not marking certain anchors. Defendants traversed the breaches. Issue.

The patent related to improvements in an anchor patented in 1839, No. 7,774 (as to which see *Honiball* v. *Bloomer*, *ante*, page 179). The specification stated:—'The improvements consist

(1) in forming or fixing the palm intermediate to the breadth of the arm; (2) in forming the horn wider than the arm; (3) in forming or affixing the palm of that class of anchor known as "*Porter's* anchor" at the back of the arm.' It then described the invention by reference to drawings, and showed two anchors, with arms movable on an axis, the palm being placed at an angle with the direction of the arm, and prolonged at one end so as to form a 'horn,' which was broader than the arm. In the first anchor the palm was so formed that part of the substance of the arm was on either side of it; whereas the second anchor had the palm altogether at the back of the arm. The specification concluded by stating:—'I am aware that it is not new to place the palm at the back of the arm of ordinary anchors; this part of the invention therefore consists in combining the fixing of the palms to the back of those arms of anchors which move on axes.' There was no separate claim.

At the trial, it appeared that the object of the invention was to obtain greater power of penetration and a better hold on the ground. Also, that it was not new to forge the palms at the back of the arms of anchors, when the same were fixed immovably to the shank.

It further appeared that defendants made anchors with arms movable on an axis, like *Porter's* anchor, with a palm at the back, and a horn of greater width than the arm, nearly identical in form with the patented anchor; but they forged the arm, palm, and horn all in one piece, whereas plaintiff's palm and horn were affixed to the back of the arm by a separate operation. ERLE, C.J. directed the jury:—That if the defendants adopted the plaintiff's plan in the form and position of the palms and horns, then the circumstance of the whole—arm, palm, and horn—being formed or welded in one piece, would not prevent its being a manufacture in accordance with the plaintiff's patent.

The jury found that the defendants' mode of placing the palm was the same as that described in the plaintiff's specification; but as to the horn, they could not agree.

Verdict for plaintiff for 130*l*. Leave reserved.

Rule nisi for a new trial, discharged by the Court of Common Pleas. (Erle, C.J., Willes, Byles, JJ.)

Per WILLES, J.—It is unnecessary to do more than consider whether the anchor constructed by the defendants be or be not within the specification, having regard to the position of the palm. I apprehend that the licensee of a patent invention, upon the ordinary terms of the licence which appear to have been adopted here, stipulates, not that the patent shall be a valid one in respect of the novelty, utility, and sufficiency of the specification; but that he

stipulates simply for leave to use that which is alleged to be the invention, admitting conclusively that such invention is new, useful, and properly specified. His Lordship then referred to *Hall* v. *Conder* (2 C.B. N.S. 22), and continued:—This specification must be read according to the ordinary rules of construction; and it does appear to me to claim the application to anchors having arms movable upon an axis, of palms at the back or outside of the arms; and that it is not necessary to constitute an infringement of this patent that another portion of the invention specified should also have been used, viz., the horn forming the palm. I think it is plain that there has been an infringement, and that the plaintiff is entitled to recover. This view of the case renders it unnecessary to enter into any other question.

Per ERLE, C.J.—I am of opinion that the patent was not for the mode of making the palm, but that it was for the form. I am of opinion that this patent was for forming the palm at the back of the arm. The whole value of the patent lay in this form. Mr. *Trotman* formed the palm separately, and then joined it on to the arm. The defendants have taken the identical form of anchor which Mr. *Trotman* specified, and have got the benefit of his invention; but they have made it by welding in one piece, instead of making the palm separately and joining it on afterwards. I think that was an infringement.

TURNER *against* WINTER, A.D. 1787. 1 T.R. 602; 1 Webs. Pat. Ca. 77.

Obligation in Specifying. A Patent which misleads is void.

CASE for the infringement of a patent of 26th *Feb.* 1781, No. 1,281, to *J. Turner*, for 'a new invented method of producing a yellow colour for painting in oil and water, making white lead, and separating the mineral alkali from common salt, all by one process.' Plea: Not guilty. Issue.

The specification stated (in substance):—'Take any quantity of lead, and calcine it, *or minium*, or red lead, litharge, &c., add half the weight of sea salt, with water sufficient to dissolve it, *or sal gem*, or rock salt, or fossil salt, or any marine salt, and mix together by trituration. When the materials have been ground together and allowed to stand for twenty-four hours, the lead will be changed to a good white. The decomposition of the salt may also be produced by digestion or calcination. The alkali (caustic soda) is separated by the addition of water. The yellow colour is produced by calcining the lead, after the alkali has been separated from it, till it acquires the colour wanted, which will be of different tints

according to the continuance of the calcination or the degree of heat employed.'

At the trial, it was objected, on behalf of defendant:—(1) That *minium* would not answer if calcined only, but that it required to be fused. (2) That fossil salt was improperly mentioned, as there were several kinds of fossil salt, whereof one only, viz., *sal gem*, would answer. (3) That the substance obtained was not white lead (mainly a carbonate of lead), but a different product, viz., oxychloride of lead. BULLER, J. directed the jury that if any one of these objections were well founded, it would avoid the patent.

Verdict for plaintiff.

Rule nisi for a new trial made absolute by the Court of King's Bench.

Per ASHURST, J.—It is incumbent on the patentee to give a specification of the invention in the clearest and most unequivocal terms of which the subject is capable. And if it appear that there is any unnecessary ambiguity affectedly introduced into the specification, or anything which tends to mislead the public, in that case the patent is void. If the process, as directed by the specification, does not produce that which the patent professes to do, the patent itself is void.

Per BULLER, J.—In this case no evidence was offered by the plaintiff to show that he had ever made use of the several different ingredients mentioned in the specification, as for instance *minium*, which he had nevertheless inserted in the patent, nor did he give any evidence to show how the yellow colour was produced. If he could only make it with two or three of the ingredients specified, and he has inserted others which will not answer the purpose, that will avoid the patent. So if he makes the article, for which the patent is granted, with cheaper materials than those which he has enumerated, though the latter will answer the purpose equally well, the patent is void, because he does not put the public in possession of his invention, or enable them to derive the same benefit which he himself does.

As to the first objection, the specification should have shown by what degree of heat the effect was to be produced. The next objection was as to the salts. It was proved 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. There was no contradiction on the third objection; for the most that the plaintiff's witnesses said was that following the specification the experiment only produced a white substance like white lead. On either of these grounds the patent is void. Because if the patentee says that by one process he can pro-

duce three things, and he fails in any one, the consideration of his merit, and for which the patent was granted, fails, and the Crown has been deceived in the grant.

VIDI *against* SMITH and ANOTHER, A.D. 1854. 3 E. & B. 969.

Inspection and Account pending an Action.

CASE for the infringement of a patent for metallic barometers—viz., of 27th *April*, 1844, No. 10,157, to *P. Armand Le Comte de Fontainemoreau*, for 'a new mode of constructing barometers' (a communication from abroad).

Before trial of the action, plaintiff obtained a rule nisi for an account of profits made by the sale of metallic barometers since 1st *Oct.* 1851, and for an inspection of defendants' books. The Court of Queen's Bench (Lord Campbell, C.J., Coleridge, Erle, Crompton, JJ.) discharged the rule for an inspection of books, and also for an account of profits before action, but made it absolute for 'an account to be kept by defendants of all such barometers as they should sell upon the principle alleged by plaintiff to be an infringement of his patent and of all profits made therefrom' until further order; on condition that plaintiff waived a claim to any but nominal damages, and undertook, if he failed in the action, to pay the costs of the account.

Per LORD CAMPBELL, C.J.—Before final judgment we ought not to grant any retrospective account. The inspection mentioned in stat. 15 & 16 Vict. cap. 83, sect. 42, is, we conceive, an inspection of the instrument or machinery manufactured or used by the parties, with a view to evidence of infringement, and does not refer to an inspection of books, which is provided for by another Act of Parliament. With regard to an account to be kept during the litigation, we are to see whether there is laid before us reasonable evidence of a valid patent, of this patent having been infringed by the defendants, and of the defendants making profits by the infringement. But we are of opinion that it should only be granted on the condition of the plaintiff waiving his claim to damages, for he ought not to be allowed to seek substantial damages and an account of profits, conjointly.

WALLINGTON *against* DALE, A.D. 1851–2. 7 Ex. R. 888.

Novelty of Invention. Sufficiency of Specification. Subject-matter of a Patent.

CASE for the infringement of a patent (in part disclaimed) of 24th *Nov.* 1847, No. 11,975, to *G. P. Swinborne*, for 'improvements in the manufacture of gelatinous substances.' Pleas: 4. That no sufficient specification was enrolled. 10. That the invention was not new. 11. That it was not a new manufacture. Issue.

The patent related to a method of manufacturing gelatine by

reducing the skin into shavings or thin slices by means of an instrument resembling a carpenter's plane. The specification stated:—'That when gelatine was to be extracted, the shavings after soaking were to be subjected to heat, taking care that the heat applied should not exceed that of boiling water.' It also pointed out that heretofore it had been the practice to operate on large pieces of hides or skins, except in the case where the hides were reduced to pulp in a paper machine.

At the trial, defendant gave in evidence the specification of a patent of 23rd *March*, 1839, No. 8,010, to *G. Nelson*, for a process of extracting gelatine by scoring hides to a depth of one-eighth of an inch, in lines about one inch apart, and then macerating them in caustic alkali. It was objected that the mere cutting of a material into thin slices was not the subject-matter of a patent, and that the specification was defective in not stating whether the hides were to be cut in a wet or dry state, and further, in not stating the minimum amount of heat to which the shavings were to be subjected.

ALDERSON, B. left it to the jury to say whether the specification was reasonably sufficient, telling them that it must be such as to define the invention so that an ordinary and skilful workman might do it, and so as to limit the claim of monopoly, and not to embarrass the invention or operation of others.

Verdict for plaintiff. Leave reserved.

Rule nisi for a new trial—on the grounds of misdirection by the learned judge in not telling the jury that the cutting a material into thin slices or shavings was not the subject of a patent, and also that the learned judge was incorrect in leaving to the jury the question as to sufficiency of the specification, which was a point of law, and that the verdict was against the evidence—discharged by the Court of Exchequer.

Per POLLOCK, C.B.—It appears to us that the plaintiff's process was new and different from any other described in the specifications given in evidence, and that it was indisputably useful. We think also that the ground of misdirection fails, and that the case was properly left to the jury.

WALTON *against* POTTER and HORSFALL, A.D. 1841. 3 M. & G. 411; 1 Webs. Pat. Ca. 585.

Novelty of Invention.

CASE for the infringement of a patent of 27th *March*, 1834, No. 6,584, to *J. Walton*, for 'improvements in cards for carding wool, cotton, silk, and other fibrous substances.' Plea 3. That the invention was not new. Issue.

The patent related to a method of constructing cards for carding wool, cotton, &c. The specification described a mode of slicing sheets of indiarubber from a block by means of a sharp knife. The sheets were then cemented to linen cloth, and wire dents were inserted. In some cases the linen cloth was cemented between two sheets of indiarubber. *Claim*: 'The application and adaptation of indiarubber as the fillet sheet or medium in which the dents or teeth are to be set together in the manufacture of cards, and thereby obtaining a superior elasticity and durability to cards as above described.'

At the trial, defendant gave in evidence the specification of a patent of 15th *March*, 1825, No. 5,120, to *T. Hancock*, for a patent leather which was made as follows:—A piece of cotton cloth was stretched on a board and coated with a compound of indiarubber and glue. It was then covered with a layer of carded cotton, upon which a fresh coating of the compound was spread. A second piece of cloth was placed over all, and the material was compressed between plates of metal passed through rollers, thereby forming the patent leather.

At the trial, TINDAL, C.J. directed the jury:—Where a party has obtained a patent for a new invention, or a discovery he has made by his own ingenuity, it is not in the power of any other person, simply by varying in form or in immaterial circumstances the nature or subject-matter of that discovery, either to obtain a patent for it himself, or to use it without the leave of the patentee, because that would be in effect and in substance an invasion of the right. There can be no doubt whatever that, although one man has obtained a patent for a given object, there are many modes still open for other men of ingenuity to obtain a patent for the same object; there may be many roads leading to one place, and if a man has by dint of his own genius and discovery, after a patent has been obtained, been able to give to the public without reference to the former one, or borrowing from the former one, a new and superior mode of arriving at the same end, there can be no objection to his taking out a patent for that purpose. But he has no right whatever to take, if I may so say, a leaf out of his neighbour's book, for he must be contented to rest upon his own skill and labour for the discovery, and he must not avail himself of that which had before been granted exclusively to another. Verdict for plaintiff.

Rule nisi for a new trial, or to arrest the judgment on the ground that the invention was not the subject-matter of a patent, discharged by the Court of Common Pleas. (Tindal, C.J., Coltman, Erskine, Maule, JJ.)

WALTON *against* BATEMAN, A.D. 1842. 1 Webs. Pat. Ca. 613.

Prior experimental User. Sufficiency of Specification.

CASE for the infringement of the same patent. Pleas: 1. Not guilty. 2. That the invention was not new. 3. That it was not a new manufacture within the statute. 4. That the specification was insufficient. Issue.

At the trial, it appeared that the alleged infringement consisted in forming the backs of cards by cementing together several pieces of cloth, with a layer of indiarubber cement between each. Also that a small quantity of *Hancock's* patent leather had been supplied to certain manufacturers, for the purpose of making card backs, between *July*, 1826, and *Dec.* 1827, but not subsequently.

CRESSWELL, J. directed the jury:—Even supposing that the article (*Hancock's* patent leather) did embody the principle of the plaintiff's, 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 user is not to be considered rather in the nature of an experiment than of any public use of the article, so as to deprive the plaintiff of the fruit of this discovery in respect of this manufacture. His Lordship then referred to the question as to the sufficiency of the specification, and continued:—It is a question for the jury whether the plaintiff has given such a description of his invention, and of the manner of carrying it out, as will enable a workman of competent skill in that line of business to act upon it. And he further said:—I will point out to you what has been the general rule on the subject of these specifications, to show what information a person must give to the public, because if a man knows a better mode than that which he states to the public, that would be very unfair and wrong, and his patent would be vitiated by it.

Verdict for plaintiff.

WALTON *against* LAVATER, A.D. 1860. 8 C.B. N.S. 162.

Assignment of Patent in separate moieties. Evidence of Infringement. Estoppel. Account.

CASE for the infringement of a patent (in part disclaimed) of 7th *Jan.* 1858, No. 23, to *M. L. J. Lavater* (defendant), assigned to plaintiff, for 'the application of the principle of exhausting air for fixing pegs to solid surfaces.' Plea: Not guilty. Issue.

The amended specification stated:—'My invention consists in the application of the principle of pneumatics to cause pegs to adhere mechanically on solid surfaces, such as glass, walls, panels, and furniture.' The principle was that of the common sucker. The base of a peg was cup-shaped and was covered with a flat disc of indiarubber.

On pressing the peg against a smooth surface, and then pulling out the centre of the disc by means of a screw, a vacuum was formed underneath the cup, and the atmospheric pressure held the peg *in situ*. The specification described the construction of the pegs, and the *modus operandi*, without referring to any drawings. There was no separate claim.

At the trial, it appeared that articles called 'plate-holders,' wherein the same principle of exhaustion was applied in the same manner, had been in common use before the date of the patent. Such plate-holders were used by photographers in manipulating glass plates. Also that defendant had assigned one moiety of his patent to plaintiff, and the remaining moiety to other parties, D. and G., who had subsequently assigned their share to plaintiff.

The alleged infringement consisted in the importation from *France* of the patented articles, and in the sale of the same in *London* and elsewhere in *England*. BYLES, J. directed the jury:—That the defendant, having sold the patent, and received the purchase-money, could not be allowed to say that the invention was not new, and he directed a verdict for plaintiff with nominal damages, reserving the point whether certain pegs called 'plate-holders' were within the description of the specification. Verdict for plaintiff.

Rule for a new trial, on the ground that the assignee of two separate moieties of a patent was not entitled to sue for an infringement, refused by the Court of Common Pleas.

Per ERLE, C.J.—As to the point—that the plaintiff, being the assignee of the two moieties of the patent, is not entitled to sue for an infringement in the same manner as he would have been if he had taken the whole interest in the patent under one assignment—we are of opinion that the assignment to the plaintiff of that partial interest, under the deed of 1858, made the plaintiff in effect tenant in common with the defendant of the entirety of the patent; and that, the defendant having afterwards assigned the remaining moiety to D. and G., when D. and G. assigned to the plaintiff in 1859, the plaintiff became assignee of the whole patent, as if the original assignment to him from the defendant had comprised the whole.

Rule nisi to enter a verdict for defendant—on the grounds that the patent was not wholly vested in plaintiff; and that the sale of articles imported from abroad was not an infringement; and for a new trial on the ground of misdirection—discharged by the Court of Common Pleas. (Erle, C.J., Keating, Byles, JJ.)

Per ERLE, C.J.—I think the law will be much better laid down as we lately, whether rightly or wrongly, held in *Dunncliff* v. *Mallet* (7 C.B. N.S. 209), that an as ignee, whether of the entirety of a

patent, or of a part or share in it, takes the legal interest, and is not to be considered merely as a licensee.

The next point contended for is, that the mere sale of articles imported from abroad is not an infringement of the patent, though the making of them would be. The words in the statute of James are *working or making*. In the granting part of the letters patent the words are 'make, use, exercise, and vend;' in the prohibitory part, 'make, use, or put in practice.' All these words are susceptible of some of the constructions which have been contended for; but it appears to me to be clearly the intention of the Crown, in granting letters patent for a new invention, to prohibit and prevent third persons from using the patent article for the purpose of profit by selling. The object is to give to the inventor the profit of his invention; and the most effectual way of defeating that object would be the permitting others to derive from the sale of the patented article the profit which it was intended to secure to the patentee. It seems to me, therefore, that proof that a party has sold the patented article, without proof of his having made it or procured it to be made, would be good evidence to warrant a jury in finding that he has been guilty of an infringement. As to the circumstance of the goods having been imported from abroad, I should say, that if this were simply the case of an importation, without any proof of knowledge on the part of the importer that the article imported was a patented article, the mere sale would be sufficient to charge him. But it is unnecessary to lay that down here, for the defendant acted with full knowledge: he has imported articles with his own name stamped on them as the maker, which he well knew to be a violation of the patent.

As between these parties, the defendant, who has received a large sum for the sale of this patent, ought not to be allowed to raise any question as to its validity.

Per BYLES, J.—As to the selling patented articles not being an infringement—I will not say a word as to the principle, but upon authority the matter stands thus—there is no authority to show that it is not, and there are two distinct authorities to show that it is. In the case of *Minter* v. *Williams* (4 A. & E. 251) every one of the learned judges gave his judgment on the ground that exposing for sale was not selling, which leads to the inference, as clearly as if it had been expressed in words, that in their opinion a vending or selling of the patented article is an infringement of the patent.

Order made (under stat. 15 & 16 Vict. cap. 83, sect. 42.) for an account of all profits of which plaintiff had been deprived by means of the infringement by the defendant of the letters patent, and that defendant do pay to plaintiff the amount of such profits.

WATSON *against* PEARS, A.D. 1809. 2 Campb. R. 294; 1 Webs. Pat. Ca. 154 *n.*

Enrolment of Specification. Computation of Time.

CASE for the infringement of a patent.

At the trial, it appeared that the patent bore date the 10th of *May*, 1808, and contained the proviso that the specification should be enrolled 'within one calendar month next and immediately after the date thereof.' The specification was enrolled on the 10th of *June* following. LORD ELLENBOROUGH, C.J. held that this was a good enrolment, and said:—'The case cited upon the statute of enrolments (*Thomas* v. *Popham*, Dyer, 218 *b*; F. Moo. 40, *s.c.*) I think is expressly in point. That shows that the day on which the patent bears date is not to be reckoned.'

REX *versus* WHEELER, A.D. 1819. 2 B. & Ald. 345.

Variance between Title and Specification. Sufficiency of Specification.

Sci. fa. to repeal a patent of 28th *March*, 1817, No. 4,112, to *D. Wheeler*, for 'a new or improved method of drying and preparing malt.' The specification stated:—'My invention consists in the heating of malt to 400° Fahr. and upwards, so that the greater part of the saccharine and amylaceous principles of the grain become changed into an extractive matter of deep brown colour readily soluble in hot or cold water. A small quantity of the malt so prepared may be used as a substitute for the colouring agent made of sugar.' It went on to say:—'The proper degree of heat and the time of exposure will be easily learnt by experience, the colour of the internal part of the grain affording the best criterion.' The drawing showed, *inter alia*, an apparatus consisting of a hollow iron cylinder open at both ends, and having a screw-like channel withinside, whereby the grain was progressively carried forwards as the cylinder rotated, and was delivered when sufficiently heated. There was no separate claim.

At the trial, ABBOTT, C.J. was of opinion that the title of the patent showed that it was obtained for a different thing from that stated in the specification. Also that the title was defective in not stating the purposes to which the article, when prepared, was to be applied; and that the specification did not state the process with sufficient precision. Verdict for the Crown.

Rule for a new trial refused by the Court of King's Bench.

Per ABBOTT, C.J.—The word 'manufacture' has been generally understood to denote either a thing made which is useful for its own sake, and vendible as such, as a medicine, a stove, a telescope, and many

others; or to mean an engine or instrument, or some part of an engine or instrument, to be employed either in the making of some previously known article, or in some other useful purpose, as a stocking-frame, or a steam-engine for raising water from mines. Or it may perhaps extend also to a new process, to be carried on by known implements, or elements, acting upon known substances, and ultimately producing some other known substance, but producing it in a cheaper or more expeditious manner, or of a better and more useful kind. But no merely philosophical or abstract principle can answer to the word 'manufacture.' Something of a corporeal and substantial nature, something that can be made by man from the matters subjected to his art and skill, is requisite to satisfy this word.

The defendant has represented himself to the Crown to be the inventor of 'a new or improved method of drying and preparing malt.' Then has the patentee by his specification shown himself to be the inventor of any method of drying or preparing this well-known article? For this we look at the specification; and we there find that he claims to be the inventor, not of a method of drying or preparing this well-known article, but of a method of giving to it, when previously prepared, some qualities which it did not possess before, or which it possessed only in a very slight degree, viz., the qualities of being soluble in water, and colouring the liquor in which it shall be dissolved, which latter is the object in view. And this is to be effected by a second and additional process, the application of a very high degree of heat. We think the invention mentioned in the specification so entirely different from that mentioned in the patent, as that the latter (if any such there be) remains wholly undescribed and unspecified, and consequently that the issue could not be found for the defendant. His Lordship then commented on the specification, pointing out that it omitted to refer to the condition of the malt, the temperature of the heating process or the length of time it was to last, and said:—A specification which casts upon the public the expense and labour of experiment and trial is undoubtedly bad. There is either no certain and clear process described, or the process described is such as might be practised without the assistance of the patentee.

WHITE *against* FENN, A.D. 1867. 15 W.R. 348; 15 L.T. N.S. 505.

Evidence of Infringement. User of part of a Combination.

CASE for the infringement of a patent of 11th *Jan.* 1862, No. 83, to *J. White*, for 'improvements in oil-cans.' Plea: Not guilty. And other pleas denying the novelty and utility of the invention. Issue.

The patent related to an oil-can, in which an orifice leading to the spout was closed by a valve placed at one end of a lever of the first order, having a fulcrum near the centre. A spiral spring was attached to the top of the can, and fastened to the lever on the side removed from the valve, the valve being opened against the pull of the spring by means of a plunger pressing down one end of the lever. Each time that the plunger descended some air was let into the can. The specification described the invention minutely by reference to drawings, and showed the lever supported against the under side of a wire fastened to brackets, one on each side of the can. *Claim*: 'The exclusive right and title to the invention, the exclusive right to which is set forth in the outset (here referring to certain parts of the specification) of this my specification thereof.'

At the trial, it appeared that it was not new to have a valve in the spout of an oil-can closed by the action of a spiral spring upon a bell-crank lever connected with the valve and opened by a plunger, the same having been patented on 17th *July*, 1855, No. 1,604, by *A. Burdess*. The alleged infringement consisted in the use of a lever similarly supported by the aid of brackets and a cross wire, but having a lock spring underneath the lever instead of a spiral spring above it. The jury found that the invention was new, and that defendant had infringed by the use of the spring and brackets. KEATING, J. directed a verdict for plaintiff. Leave reserved.

Rule nisi to enter a nonsuit, on the ground that there was no evidence of infringement, made absolute by the Court of Common Pleas. (Bovill, C.J., Willes, Keating, Montague Smith, JJ.)

Per MONTAGUE SMITH, J.—The patent was for a combination, and the alleged infringement was for parts of that combination only; and the plaintiff's verdict cannot be supported unless the particular parts of the invention alleged to be infringed were new. I think they were not. The plaintiff's case cannot be supported by proving an infringement of a limited character.

WHITE *against* TOMS, A.D. 1867. 37 L.J. Ch. 204.

Subject-matter of a Patent.

Suit to restrain from infringing a patent of 27th *April*, 1864, No. 1,055, to *J. White*, for 'improvements in ladies' mourning bonnet and hat falls.'

The patent related to a mode of making falls for mourning bonnets so that both sides were alike. The specification stated that a fold of crape was to be applied on both sides of a fall above the bottom fold, instead of on one side only as heretofore, and that the edges of the folds were to be pressed down so as to hide the stitches.

Claim: 'The forming both sides of ladies' mourning bonnet and hat falls alike by applying thereto the folds above the bottom fold on each side thereof as explained.'

MALINS, V.C. refused to grant an injunction, and said:—'Whereas formerly the fold was sewn on one side only, now it is sewn on both sides; so that whichever way it is turned it has a good side outwards. There is no invention in it. However meritorious as an improvement, which might probably have been registered for one or two years, it is not the subject of a patent.'

WILLIAMS *against* NASH, A.D. 1859. 28 Beav. 93.

Payment of Stamp Duty. Computation of Time.

Suit to restrain from infringing a patent bearing date 26th *Feb.* 1855. It appeared that a stamp duty of 50*l.* was paid on 26th *Feb.* 1858, and defendant insisted that the patent had lapsed. (See stat. 16 & 17 Vict. cap. 5, sect. 2.) ROMILLY, M.R. held that the payment of the stamp duty on the 26th of *February* was within time.

WILLIS *against* DAVISON, A.D. 1863. 1 N.R. 234.

Novelty of Invention. Subject-matter of a Patent.

CASE for the infringement of a patent of 28th *Feb.* 1851, No. 13,538, to *H. Willis*, for 'improvements in the construction of organs.' Pleas: 2. That the invention was not a new manufacture. 3. That plaintiff was not the true and first inventor. 4. That the invention was not the subject of a patent. Issue.

The material part of the patent related to an invention for bringing certain stops under the command of the performer, so that he could effect the changes of putting them in or drawing them out without raising his hand from the keys of the instrument. For this purpose the stop was actuated by a separate bellows, called a *pneumatic lever*, an apparatus commonly used in organs, and supplied with compressed air from the main bellows. The specification contained a drawing of the apparatus, and described the pneumatic lever as connected with the stop. When the performer pressed a finger-key the lever was set in action by the opening of an ordinary flap valve; and when the finger was withdrawn the valve closed by a spring, and opened a *double-beat compensating* valve for the rapid escape of air. The object was to make a large opening with a small expenditure of force; and this was effected by constructing the escape valve of two discs, threaded on separate spindles, and attached to the opposite ends of a rocking-bar, whose fulcrum was outside the pneumatic lever. One disc moved inwards and the other outwards, and the pressure of the air was thereby balanced. *Claim*: 'The applica-

tion to pneumatic levers of the *improved escape valve*, whereby the reiterating power of the pneumatic lever is greatly increased. Also, the mode of arranging the pneumatic levers as above described.'

At the trial, it appeared that compound disc or balanced valves, threaded on one spindle, were commonly used in steam-engines, and were old. Also that, before the patent, a compound valve similar to plaintiff's had been fitted to pedal organs as a *supply* valve, in order to obtain greater ease in working; but it was admitted that the use of such a valve in combination with a pneumatic lever, as an *escape* valve, was new. Verdict for plaintiff. Leave reserved.

Rule nisi to enter a verdict for defendant on 2nd, 3rd, and 4th issues, made absolute by the Court of Queen's Bench.

Per CURIAM.—It appears that there was an old use of this invention for the purpose of easing the working of organ bellows. Our judgment, therefore, proceeds upon the ground that the novelty of the patent has been successfully impugned, and that the patent is bad.

WOOD *against* ZIMMER, A.D. 1815. Holt, N.P. 58.

Patent void for Concealment. Prior Public Sale.

Issue out of Chancery to try the validity of a patent of 20th *Jan.* 1812, No. 3,519, to *J. Zink*, 'for a new method of manufacturing verdigris.' Plea: Not guilty. Issue.

The specification stated that granulated copper and oil of vitriol, in certain proportions, were to be boiled together in a vessel of particular construction as described, and that the liquid was afterwards to be strained off and mixed with a solution of potash or soda.

At the trial, it appeared that *Zink* was accustomed to put *aquafortis* into the boiler, whereby the copper was dissolved more rapidly. Also, that four months prior to the date of the patent he sold, under the name of *Dutch Imperial Green*, a quantity of verdigris manufactured according to the process subsequently patented. GIBBS, C.J. directed the jury:—A man who applies for a patent, and possesses a mode of carrying on that invention in the most beneficial manner, must disclose the means of producing it in equal perfection, and with as little expense and labour as it costs the inventor himself. If anything which gives an advantageous operation to the thing invented be concealed the patent is void. Now though the specification would enable a person to make verdigris substantially as good without *aquafortis* as with it, still, inasmuch as it would be made with more labour by the omission of *aquafortis*, it is a prejudicial concealment and a breach of the terms which the patentee makes with the public. To entitle a man to a patent, the invention must be new to the

world; the public sale of that which is afterwards made the subject of a patent, though sold by the inventor only, makes the patent void.

His Lordship left two questions to the jury:—1. Whether *aqua-fortis* was used by the inventor as an ingredient in the verdigris? 2. Whether the invention was in public sale before the patent? In either case he thought the patent void. The jury found both questions in the affirmative. Verdict for defendant.

WREN and ANOTHER *against* WEILD, A.D. 1869. L.R. 4 Q.B. 213, 730.

Slander of Title relating to a Patent.

Action for slander of title. The declaration alleged that defendant falsely and maliciously wrote to and told persons who had bought certain machines of plaintiffs that the said machines were infringements of his (defendant's) patent, and claimed royalties for the use of the said machines, and threatened legal proceedings if they used the same without payment of royalties. Plea: Not guilty. Issue.

Rule nisi for defendant to deliver particulars of the alleged infringements of his patent, made absolute by the Court of Queen's Bench. (Cockburn, C.J., Mellor, Hayes, JJ.)

Per CURIAM.—The defendant has driven the plaintiffs to take the initiative, and they ought to be in the same position as if the defendant had brought an action against them for the infringement of his patent.

At the trial, plaintiffs' counsel offered to prove that the specification of defendant's patent claimed matters that were not new; but LUSH, J. ruled that this evidence was immaterial, and directed a nonsuit.

Rule nisi for a new trial, on the grounds of rejection of evidence and misdirection, discharged by the Court of Queen's Bench. (Blackburn, Lush, Hayes, JJ.)

Per BLACKBURN, J.—We think that as soon as it was shown in evidence that the defendant really had a patent right of his own and was asserting it, the occasion privileged the communication, and the plaintiffs were bound to prove such malice as would support the action. But we think that, supposing everything had been proved which the evidence tendered could have proved, there would have been no case on which the jury could properly have found for the plaintiffs. We think the action could not lie unless the plaintiffs affirmatively proved that the defendant's claim was not a *bonâ fide* claim in support of a right which, with or without cause, he fancied he had; but a *malâ fide* and malicious attempt to injure the plaintiffs by asserting a claim of right against his own knowledge that it was without any foundation.

WRIGHT *against* HITCHCOCK and ANOTHER, A.D. 1870.
L.R. 5 Ex. 37.

Evidence of Infringement. Variance between complete and provisional Specifications. Subject-matter of Patent. Infringement by sale of Patented Articles.

CASE for the infringement of a patent of 19th *Feb.* 1862, No. 448, to *J. Willcox*, for 'improvements in the manufacture of frills or ruffles, and in the machinery or apparatus employed therein' (a communication from abroad). Defendants pleaded not guilty; that the invention was not new; and that it was not the subject-matter of a patent; and it should seem, although not stated in the report, that there was a further plea raising an objection on the ground of a variance between the complete and provisional specifications. Issue.

The provisional specification stated:—'The invention relates to a peculiar manufacture of frills and ruffles, and to a peculiar combination of mechanism,' &c. 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. The peculiarity is, that the frills are crimped in one direction transversely to the cloth in a perfectly even and regular manner, and are secured by stitches in lieu of the fabric being puckered or gathered in the ordinary manner.' It went on to describe the machine, which had a reciprocating knife for raising the folds, and a spring presser for turning them down and holding them until secured by the stitch of a sewing machine, which was incorporated into the apparatus. It further stated:—'Fig. 8 represents the kind of work produced by the machine.'

The drawing, Fig. 8, showed a double frill, the separate portions of which were secured on opposite sides of a narrow flat band, which itself was formed in flat plaited folds, and was made by the machine. *Claims*: 1. 'The general construction, arrangement, and combination of machinery, apparatus, or means for producing crimped or plaited frills or trimmings in a sewing machine, as hereinbefore described. 2. The application and use of a reciprocating knife for crimping fabrics in a sewing machine, as hereinbefore described. 3. The peculiar manufacture of crimped or plaited frills or trimmings, as hereinbefore described, and illustrated by Fig. 8 of the drawings.'

At the trial, it appeared that the alleged infringement consisted in manufacturing plaits by a machine with a reciprocating knife (as patented on 4th *Nov.* 1867, No. 3,093, by *J. Orr*), which was described in the specification referred to as capable of 'folding plaits upon the surface of a roller, straight plate, or table,' but that the

plaits so made were not secured by a sewing machine. KELLY, C.B. ruled that the buying and selling by defendants of plaits made as stated was an infringement, if the manufacture by *Orr's* process was so. Verdict for plaintiff. Leave reserved.

Rule nisi to enter a verdict for defendants—on the grounds that the third claim was not the subject-matter of a patent; that there was a variance between the complete and provisional specifications; that there was no evidence of infringement; and for a new trial on the ground of misdirection—discharged by the Court of Exchequer. (Kelly, C.B., Martin, Pigott, BB.)

Per KELLY, C.B.—The first point made in this case is, that the patent in question is for a particular product, the result of manufacture, and not for a manufacturing process. The title of the patent describes it as being for the invention of 'improvements in the manufacture of frills or ruffles, and in the machinery or apparatus employed therein.' The specification relates entirely to the machinery, and contains, from beginning to end nothing which could lead us to construe it as a specification of the articles manufactured. The third claim is in these words—'the peculiar manufacture of crimped or plaited frills or trimmings, as hereinbefore described and illustrated by Fig. 8;' and, looking at the drawing, we find a double frill, or a middle plaited strip with a frill above and a frill below. But is it the kind of frill that is made the subject of the claim? On the contrary, it is the peculiar mode of manufacturing it, or the frill as manufactured by a reciprocating knife. Therefore, whether we look at the title of the patent, the specification, or the claim, the patent is not for the article manufactured, but for the mode by which the article described is brought into existence.

A second point was, that the manufacture includes the use of a sewing machine, or that it is a manufacture by means not only of a reciprocating knife, but of a sewing machine, without which unquestionably the complete article cannot be produced in the manner described. But, looking at the whole specification and claim, this is only pointed out as the best mode of completing the manufacture. The sewing machine is treated as an invention already in use, and it is separate and distinct from the mode of crimping or plaiting to which the plaintiff lays claim. This point, therefore, also fails.

A third point made is, that there is an inconsistency between the provisional and final specification, the word '*trimming*' being added in the latter. But by whatever name it is described, the thing is in substance identical.

The last point is, whether the selling by the defendants of articles manufactured by the plaintiff's process is an infringement. To de-

termine this, we must look at the words of stat. 21 Jac. I. cap. 3, sect. 5, which excepts from its nullifying operation patents for the 'sole making or working of any manner of new manufacture.' The statute does not contain the word '*vend*' which is found in the grants of patents, but we may have some regard to the constant usage according to which for 200 years patents have contained an express license to use and vend; and although the use of this word by the Crown is not conclusive upon the construction of the statute, it would be strange if for so long a time every patent should have purported to convey the exclusive right and interest if the grant were unauthorised. But, besides this, the authorities are clear and uniform, and are confirmed by the very recent case of *Elmslie* v. *Boursier* (L.R. 9 Eq. 217) before Vice-Chancellor James. I am clearly of opinion that if a man takes out a patent by means of which an article is made at a considerably less cost than the same article was before produced at, one who buys and sells such articles—I do not say on a single occasion, for each case must be determined on its own circumstances, but when he becomes, in the way of trade, a buyer and seller of quantities of such articles—knowing them to be manufactured by a machine which is *de facto*, though unknown to him, itself an infringement, such buying and selling is an infringement by him of the patent. It is impossible to suppose that an exclusive right to vend is not given, and the defendants have therefore infringed the plaintiff's right, and it is immaterial whether it was or was not known to them that *Orr's* machine was identical with the plaintiff's.

YOUNG *against* FERNIE, A.D. 1863-6. 1 De G. J. & S. 353; 4 Giff. 577; L.R. 1 H.L. 63.

Novelty of Invention. Evidence of Infringement. Procedure in Prosecuting an Appeal to the House of Lords.

Suit to restrain from infringing a patent of 17th *Oct.* 1850, No. 13,292, to *J. Young*, for 'improvements in the treatment of certain bituminous mineral substances or matters, and in obtaining products therefrom.'

The patent related to a method of distilling paraffin oil. The specification stated:—'My invention consists in treating bituminous coals in such manner as to obtain therefrom an oil containing paraffin (which I call paraffin oil), and from which oil I obtain paraffin. The coals which I deem to be best fitted for this purpose are parrot coal, cannel coal, and gas coal.' It then described the process of distillation of the coal broken into small pieces and placed in a common gas retort, to which was attached a worm-pipe, passing through a refrigerator, kept at a temperature of about 55° Fahr. It

went on to say:—'The retort, being closed in the usual manner, is then to be gradually heated up to a low red-heat, at which it is to be kept until the volatile products cease to come off; care must be taken to keep the temperature of the retort from rising above a low red-heat, so as to prevent the products being converted into permanent gas.' The crude paraffin oil thus distilled or driven off as a vapour was condensed into a liquid in passing through the worm-pipe. The solid substance, paraffin, was separated from the oil by cooling to a temperature between 40° Fahr. and 30° Fahr. *Claim*: 'Obtaining paraffin oil, or an oil containing paraffin, and paraffin, from bituminous coals by treating them in the manner hereinbefore described.'

The first step reported in this suit was an appeal from an order made by STUART, V.C. directing the trial of certain issues before the Court of Common Pleas. LORD WESTBURY, L.C. directed the cause to be restored to the paper of the Vice-Chancellor, to be heard in the ordinary way.

(4 Giff. 577.) The cause then came on for hearing before STUART, V.C. without a jury, on the following issues:—(1) Was plaintiff the true and first inventor? (2) Was the invention new? (3) Was the specification sufficient? (4) Had defendants infringed? A number of scientific and other witnesses were called on both sides, and it appeared that paraffin was discovered by Dr. *Reichenbach* in 1830, and was first obtained from beech-wood tar. Also, that plaintiff had found out 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.

STUART, V.C. found in favour of plaintiff on all the issues, and granted an injunction and account, saying:—The main objection to the validity of the plaintiff's patent is that both as to the process and material there is nothing new, and that the specification indicates nothing which was not publicly known and publicly used before the date of the patent.

It appears from the evidence that for very many years before the discovery of the substances now called 'paraffin' and 'paraffin oils' the distillation of coals and bituminous substances, at every variety of temperature, had been well known and practised for the production of tars and oils which had been used for lubrication of the ruder kinds of machinery and for burning. It is certain that *Reichenbach*, although he ascertained the existence of paraffin in coal, did not indicate coal of any kind as a material capable of producing paraffin or paraffin oils in most abundance. There is no evidence of any

specification, of any patents, or any publication in which cannel coal, or coal which produces olefiant and other illuminating gases in considerable quantity, was indicated as the class of materials among the wide range of animal, vegetable, and mineral substances which, subjected to a proper process, would produce paraffin and paraffin oils in large quantities so as to create a manufacture for commercial purposes, till *Young's* specification was published. Cannel coals had been tried by many, but without success. Among the many practical and manufacturing chemists who had been vainly attempting to find out how to manufacture paraffin oils and paraffin, so as to supply the market, none had been fortunate. The fair result of the immense load of evidence in this case shows the prevailing opinion to have been that not coals of any kind, but shales or schists properly so called, were the best material.

Referring to the scientific evidence on the part of defendants, his Honour observed:—Experiments conducted for the express purpose of manufacturing evidence for this cause are to be looked at with distrust; and in respect of the evidence adduced to prove that 'boghead coal' was a shale, and that all cannel coals were shales, his Honour regarded it as unimportant. He then continued:—On the question of infringement, as well as with reference to the validity of the patent, the defendants have laboured to show by evidence that a temperature lower than a low red-heat, and therefore not according to *Young's* specification, is that at which they have worked, and is the best temperature for producing paraffin oils and paraffin in the greatest quantity and of the best quality. Their evidence has entirely failed to establish the fact that they have not used for their manufacture the same class of coals and the same gradation and limit of temperature which *Young* describes, or that a gradation and limit of temperature lower than *Young's* is the best.

Mr. *Fernie* has adduced in evidence a passage from the work of an eminent *American* chemist, Dr. *Antisell.* This book gives the following extract from a publication by *Reichenbach* in 1854:—'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.' This illustrates the important distinction between the discoveries of the merely scientific chemist and of the practical manufacturer, who invents the means of producing in abundance, suitable for economic and commercial purposes, that which had previously existed as a beautiful item in the cabinets of men of science.

What the law looks to is the inventor and discoverer who finds out and introduces a manufacture which supplies the market for

useful and economical purposes with an article which was previously little more than the ornament of a museum. It has been established to my satisfaction that the plaintiff *Young* is an inventor of this class, and that his patent is entitled to the protection of the law. I find that he has ascertained, by a course of laborious experiments, a particular class of materials among many, and a particular process among many, which has enabled him to create and introduce to the public a useful manufacture, which amply supplies the market with that which, until the use of the materials and process, and temperature indicated by him, had never been supplied for commercial purposes. At the date of his patent something remained to be ascertained which was necessary for the useful application of the chemical discovery of paraffin and paraffin oils. This brings it within the principle stated by the Lord Chancellor in *Hills* v. *Evans* (31 L.J. Ch. 457). The manufacture, with the materials and process indicated by him, according to the sense in which I understand the word 'manufacture' to be used in the statute, was a new manufacture not in use at the date of the patent.

(L.R. 1 H.L. 63.) Appeal to the House of Lords. A preliminary objection was taken that the appeal was not maintainable by reason that defendants had omitted to move for a new trial on the findings either before the Vice-Chancellor or before the Court of Appeal. (See stats. 21 & 22 Vict. cap. 27, and 25 & 26 Vict. cap. 42.) Their Lordships held that an appeal was only competent to the extent to which error could be shown in the decree consistently with leaving the findings of the Vice-Chancellor entirely unchallenged.

Per Lord Westbury.—Inasmuch as we find a distinct enactment that the verdict of the Court shall have the same effect as the verdict of a jury, and as we know perfectly well that the verdict of a jury, if it remained unchallenged, would be conclusive, we must hold the verdict of the Court as equal to the verdict of the jury; and in so doing the cause is not decided on any technical objection, but it is decided by the application of the clear language of the Act of Parliament.

The case was now heard in the restricted form imposed by the above judgment, and the appeal was dismissed with costs.

ADDENDA.

In the case of *Lister* v. *Leather* (8 E. & B. 1004) three objections were raised on behalf of the defendant, which were omitted in the abstract of the case, *ante*, page 196, as being manifestly untenable, but are now inserted.

Lord Campbell, C.J. (in delivering the judgment of the Court of Queen's Bench) further observed:—'The defendant now asserts that each of these patents (viz., those of plaintiffs of 1851 and 1852) is void, contending, first, that a patent for a combination is, in effect, a claim that each part of that combination is new; and, if any part claimed by a patent to be new is old, the whole patent is void. The answer is, that 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 known parts may be valid, as has often been decided. Even if the specification contained no disclaimer, it would be a question of construction whether the patent was void. But where there is either a disclaimer or an acknowledgment that a part is old, all ground for this objection is gone.

'The second argument was that, if a subsequent patent for a combination includes a part of an invention already protected by patent, 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. The answer is, that 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 license, would be an infringement; but with license, that also would be lawful, as is in constant experience. Indeed the objection was carried to the extent that a patent for an infringement 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 was 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.'

In a suit, *Tangye* v. *Stott*, A.D. 1866 (14 W.R. 386), brought to restrain the infringement of a patent for differential pulley-blocks (*Weston's*), an injunction was granted by WOOD, V.C., who further said that there must be a decree for the delivery up to plaintiff of the pulleys made in infringement of the patent.

And in *Betts* v. *De Vitre*, *ante*, page 33, as reported in 34 L.J. Ch. 291, the order contained the following clause:—'That an inquiry should be made whether the defendants, or any of them, had in their possession or power any or what articles made in violation of the plaintiff's patent; and that all articles which should be certified to have been so manufactured and to be in the possession of the defendants, or any of them, should be destroyed in the presence of the persons named, being the managers and solicitors of the plaintiff.'

DIXON *against* THE LONDON SMALL ARMS COMPANY, A.D. 1876.
L.R. 1 Q.B.D. (C.A.) 384.

Appeal from the judgment of the Court of Queen's Bench (*ante*, page 119). Judgment reversed, and entered for defendants by the Court of Appeal. (Kelly, C.B., James, Mellish, L.JJ., Grove, J.)

Per JAMES, L.J.—It appears to me that *Feather* v. *The Queen* was decided upon principles impossible to be questioned, and that that case is now a binding authority. It has been settled in all kinds of cases that what a person may lawfully do himself he may lawfully do by his attorney, his bailiff, his contractor, his agent, his servant, his workman; and it is a sufficient plea in certain cases that the thing was done by the authority, at the request, or on behalf of the person who had a legal right to do it. Almost every great work in this country is done by contractors, who act under the authority of the bodies who have received authority from Parliament to do what is required to be done.

If it be the case, as it appears to me to be the case here, that what was done was done by the authority, and the express authority, for the use and for the benefit, of the Crown, it is, in my mind, merely saying that it was done by the Crown. The Crown has done it by such person or persons, in such a way and under such circumstances, as the officers of the Crown thought fit to do it.

Per MELLISH, L.J.—I think our difference with the Court below arises partly upon the construction of the contract itself. Some of

the learned judges seem only to have looked at the printed part of the contract, without considering that it refers to a schedule, and that the most material parts of the contract are really contained, not in the printed part, but in the written schedule annexed to it. In the written schedule, when we look at the contents of it, it is plain the Crown was to provide the steel tube and the stock for each rifle, and that then the contractor was to manufacture the steel tube and the stock into a perfect *Martini-Henry* rifle, which was to be inspected during the process of manufacture by the Crown's officers at the particular place where it was to be manufactured. Therefore it plainly was a contract to manufacture certain articles for the purposes of the Crown.

Now if the Crown has the right to have the patented articles manufactured by its servants, has it not the right to have them manufactured by entering into a contract with a contractor? If a railway company employs a contractor to do any one of the numerous works which the railway company are authorised to do by Act of Parliament, there is no doubt at all that the contractor may justify doing the act under the authority of the railway company. The act of the contractor, expressly authorised by the contract, is the act of the employer, just as much as the act of a servant is the act of his master. Therefore, when the Queen employs these defendants to manufacture her stocks and barrels into these *Martini-Henry* rifles, that is really, in point of law, the act of the Queen herself, and the contractor may justify, just as the servant may justify.

On appeal, the House of Lords reversed this decision, and restored that of the Court of Queen's Bench. (Not yet reported.)

SELECTED CASES OF APPLICATIONS RELATING TO PATENTS.

ADAMSON'S *Patent, in re*, A.D. 1856. 6 De G. Mac. & G. 420.

Caveat at Great Seal. Prior public User.

Petition for Great Seal to be affixed to a patent for an invention of a travelling stage or crane to be used in the construction of piers or harbour-works; opposed by one *Robinson*, who claimed to be the inventor. It appeared that the petitioner *Adamson* had used the apparatus, in the construction of a pier at *Hartlepool*, for a period of four months before applying for a patent; and he submitted that it was impossible to test the efficacy of the invention except in rough weather, and in a position exposed to the view of the public.

Petition dismissed with costs.

Per LORD CRANWORTH, L.C.—I cannot put the Great Seal to this patent, because I think there has been a clear dedication to the public. In the present instance an invention has been made in the progress of a work, and it has been used publicly by the inventor, not as an invention, but in the carrying on and execution of that work. It was alleged by *Robinson* that he, and not the petitioner, was the true inventor; but in the circumstances of this case it is not necessary for me to give an opinion upon that point. No doubt an experiment might have been made, and, if made *bonâ fide* only for the purpose of testing the merits of an invention, I do not think it would have amounted to a dedication to the public; but when, as in the present case, thousands of persons had an opportunity of seeing the apparatus at work for a period of four months, during the carrying on of the petitioner's contract, and in the regular course of the undertaking, it is quite clear that no intention of applying for a patent originally existed, and under such circumstances, and after such a lapse of time, I must hold that there was a dedication to the public.

SHARP'S *Patent, in re*, A.D. 1840. 3 Beav. 245; 1 Webs. Pat. Ca. 641.

Alteration of Enrolment. Jurisdiction of the Master of the Rolls.

Application, to the Master of the Rolls, to expunge a material part of a disclaimer which had been duly enrolled. Petition dismissed with costs.

Per LORD LANGDALE, M.R.—Patents for inventions are granted on condition of a specification of each invention being enrolled in a limited time; and except for the purpose of correcting mere verbal or clerical errors, proved to have arisen from mistake or inadvertence, I am of opinion that I have no authority to make any alteration in the enrolment of the patent or specification. It does not appear that the Master of the Rolls, as keeper of the Records in Chancery, has ever exercised any greater authority than I have stated in matters of this kind; and being of opinion that I have no jurisdiction to make any such order as is asked by this petition, I must dismiss the petition with costs.

GREEN'S *Patent, in re*, A.D. 1857. 24 Beav. 145.

Register of Proprietors of Patents. Expunging of entry.

Motion, under stat. 15 & 16 Vict. cap. 83, sect. 38, to expunge an entry from the register of proprietors in the Great Seal Patent Office.

It appeared that in 1853 one *Green*, the grantee of a patent, assigned the same to the applicants *W.* and *H.* On 18th *Aug.* 1855 *Green* executed a second assignment of his patent to another party, and the assignment was registered on the same day. On 25th *Aug.* 1855 the first assignment was also registered. Application being now made, on behalf of *W.* and *H.*, to expunge from the register the entry of 18th *Aug.* 1855, ROMILLY, M.R. made the order, with costs, and said:—'I have no doubt that there is a sufficient case to entitle the applicants to the order to expunge the entry.'

MOREY'S *Patent, in re*, A.D. 1858. 25 Beav. 581.

Jurisdiction of the Master of the Rolls over entries in the Register of Proprietors of Patents.

Motion to expunge or vary an entry made in the register of proprietors in the Great Seal Patent Office.

It appeared that on 13th *Jan.* 1851 one *Morey*, the patentee of a sewing machine, assigned by deed one moiety of his patent to one *M.*, and on 14th *Jan.* agreed with *M.* to grant him an exclusive licence to work the patent. The assignment and agreement were registered on 5th *Aug.* 1857.

On 4th *Feb.* 1853 *Morey* assigned by deed the whole patent to another party *J.* The deed recited that *J.* had agreed to purchase the patent and all rights under it, save and except a licence to use a portion of the invention previously granted to *M.* This assignment was registered on 21st *June*, 1853.

Application being now made, on behalf of *M.*, that the entry on the register might be expunged, vacated, or varied, ROMILLY, M.R. directed an entry to be made—stating the recitals and operative parts of the deed of 1853, and declaring that the licence mentioned in the above passages was referable to the deed of assignment of 13th *Jan.* 1851, and the agreement of 14th *Jan.* 1851, which had been entered in full on the register on 5th *Aug.* 1857,—and said he was satisfied that the duty of the Court was to insert on the register any facts relating to the proprietorship, but not the legal inferences to be drawn from them. No costs given.

HORSLEY and KNIGHTON'S *Patent, in re*, A.D. 1869. L.R. 8 Eq. 475; L.R. 4 Ch. 784.

Register of Proprietors of Patents. Jurisdiction of the Master of the Rolls.

Motion, under stat. 15 & 16 Vict. cap. 83, sect. 38, that an entry in the register of proprietors kept in the Great Seal Patent Office might be expunged, vacated, or varied.

It appeared that *Horsley* and *Knighton* were joint patentees of an invention, and that *Knighton* executed a deed of assignment purporting to convey to *O.* all his interest in the patent, and further to release *O.* from all claims by either or both of the co-patentees in respect of the patent. The deed was entered *verbatim* on the register. Application being made on behalf of *Horsley* to excise the entry, LORD ROMILLY made the order, with costs, and said:—'Here is a patent granted to two persons, and therefore either of them may use it, but neither can dispose of the right of the other. I cannot alter the deed, because the deed has been executed by two persons, who, whatever may be the effect of it, were competent to enter into it, and I cannot make them execute a deed other than what they have actually executed. I have no option but to strike out the whole entry; and the persons who put it on the register must pay the costs of this application.'

On appeal to the Lords Justices, GIFFARD, L.J. refused to hear the application, and said:—'Probably a right of appeal would have been given if the attention of the Legislature had been called to the subject. An entirely new register of proprietors of patents was created by the Act, and then the 38th section creates a new jurisdiction, and gives the power of expunging entries to the Master of the Rolls or to one of the Common Law Judges; but nothing is said about an appeal from their decisions, and without such enactment I think there can be no appeal.'

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