PATENT PRACTICE.

BY THE SAME AUTHOR.

ABSTRACT OF REPORTED CASES

RELATING TO

LETTERS PATENT FOR INVENTIONS

BRINGING THE CASES DOWN TO THE END OF THE YEAR 1883.

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PATENT PRACTICE

BEFORE THE COMPTROLLER AND THE LAW OFFICERS,

WITH AN

ABSTRACT OF REPORTED CASES.

BY

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PREFACE.

THE object in this book is to arrange in a systematic and orderly manner the various reported cases of applications relating to patents which have at present been heard before the Comptroller and the Law Officers.

The existing reports may be considered to be somewhat voluminous and obscure, and they will certainly gain by being subjected to a process of sifting, which can be done very easily in an abstract.

Also, by grouping the cases together according to subject-matter, there may be a saving of time and trouble to the reader.

T. M. GOODEVE.

5, CROWN OFFICE ROW, TEMPLE,
July, 1889.

697463

LIST OF ABBREVIATIONS.

Goodeve P. C. *for* Goodeve's Patent Cases.

P. O. R. *for* Patent Office Reports.

Gr. P. C. *for* Griffin's Patent Cases.

Gr. A. P. C. *for* Griffin's Additional Patent Cases.

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PATENT PRACTICE.

CHAPTER I.

APPLICATIONS FOR PATENTS.

In discussing the procedure before the Comptroller and Law Officers in relation to the applications treated of in this book, it will be necessary to refer to the sections of the Patents, &c., Act of 1883, as amended by the Patents, &c., Act of 1888.

Sections 4, 5, and 6 of the Act of 1883 relate to the procedure in applying for a patent, to the lodging of a provisional or complete specification, and to the reports of examiners, together with the consequences incidental thereto, and these sections are unaltered.

In sect. 7, a material change has been introduced into the practice by the Act of 1888, and it will be incumbent on inventors to examine carefully the new provisions in the section, upon which at the present time there are no reported cases.

It is necessary here to point out that the right of appeal to the Law Officer, as given in sect. 7 and subsequent sections, remains undisturbed.

In sect. 9, sub-sect. (5), of the Act of 1883, the words "other than an appeal to the Law Officer under this Act" are now omitted, but there is no alteration in sect. 10, which provides for the publication of the complete specification after acceptance.

There have been also a few alterations in the Act of 1883, by the Patents Acts of 1885 and 1886, which are chiefly explanatory.

It is not the object of the writer to comment upon or explain the actual practice in obtaining a patent, for that is the province of the patent agent. The intention has rather been to bring forward in systematic order the various decisions bearing upon the several clauses of the Act, whereby it becomes more easy to arrive at a knowledge of the general practice than by reading directions or comments however carefully they may have been prepared.

Very few cases have been reported under sections 4 to 10, and it may be laid down as a rule that in applications for patents any such thing as refined criticism on the language used by an inventor will not be favourably received by the Law Officers.

Of the published cases bearing upon sections 4 to 10, one is of importance, inasmuch as Lord Herschell, when Solicitor General, laid down a principle which is invariably acted upon, namely, that it is not the duty of the Patent Office to criticise the language of the claiming clauses inserted under sect. 5, sub-sect. (5), of the Act of 1883, which is to the effect that a complete specification shall end with a distinct statement of the invention claimed.

In following out this direction it will not be enough for an applicant to describe his invention and to finish by saying: "I claim the invention previously described in the specification." This would be equivalent to a specification without a claim, as was common under the old law, whereby, if no claim was inserted, the invention described in the specification was in effect claimed. It is laid down, therefore, that a real statement of the invention claimed must be inserted at the end of the specification, and if that be done, the precise language in which the inventor frames his claim is a matter for him alone.

Re SMITH. Gr. P. C. 268.

Application for a patent, where the Comptroller required (1) the omission of certain claims, (2) the addition of certain words to other claims in the complete specification.

Appeal to the Law Officer, who directed the acceptance of the specification as lodged.

Per HERSCHELL, Sol. Gen.—This point has been considered by the Attorney General in conjunction with myself, and we have come to the conclusion that provided the specification ends with a statement of the invention claimed distinct from the description of the invention contained in the specification, sub-sect. (5) of sect. 5 of the Act is complied with, and there is no power in the Patent Office to examine into the conformity of the claims put forward by the patentee with the description of the invention which he has given. I think there must be a real statement of the invention claimed, but if there is such a statement I do not think it is competent for the Patent Office to enquire whether it goes beyond or is in conformity with the description of the invention. Merely to say "I claim the invention described in the specification" is a case in which, although it has the form of a claim, I should think there was not a distinct statement of the invention claimed.

Re BROWN (Gr. A. P. C. 1) was an application for a patent for "improvements in casks and tubs."

It appeared that the claims were for a peculiar method of fastening in the heads and bottoms of vessels formed of staves.

The specification stated that the invention was applicable to barrels, casks, tubs, and analogous vessels, and the Comptroller required the applicant to amend the title by inserting the words "*and analogous vessels.*"

On appeal, WEBSTER, Att. Gen., passed the patent with the original title, and said that he expressed no opinion as to whether the applicant could claim anything more than that

which was covered by his title and claims, but inasmuch as he had elected to stand by his title, and the claims were specific, that was sufficient.

Again, *Re* EVERITT (Gr. A. P. C. 27) was an application for a patent for "An apparatus for the delivery of a given quantity of liquid in exchange for an equivalent in coin or the like."

Here the provisional specification described the nature of the invention as applicable to any suitable measuring tap, and the complete specification described and claimed a suitably constructed measuring tap *as described*.

The Comptroller held that the special means described in the complete specification were not to be found in the provisional specification, and required alterations, but on appeal, WEBSTER, Att. Gen., was of opinion that the provisional specification described the nature of the invention, and that the only criticism which could be made on the complete specification was, that it narrowed the ambit of the thing claimed, and he therefore allowed the patent to proceed with the original specification as lodged in the office.

GRANT FOR ONE INVENTION ONLY.

At the stage of procedure now under discussion, another clause operates which has required interpretation.

Sect. 33 enacts that "*a patent shall be granted* for *one invention* only," and the question arises, what is one invention?

Upon this point we have a judgment of Lord Herschell, when Solicitor General, which is valuable, as laying down a rule to be followed in future decisions.

Re JONES. Gr. P. C. 265.

Application for a patent refused by the Comptroller on the

ground that the provisional specification comprised more than one invention.

On appeal, HERSCHELL, Sol. Gen., said:—It seems to me that the general object of an invention is the test by which the question of one invention must be decided.

I should always allow alternative devices for producing a particular object as one invention. But if you say "I have invented six different kinds of sleepers, each of which has its own merits and purposes and objects distinct," then those are six inventions.

You may get into one patent the combination, and all subordinate parts of that combination, so far as you claim to use them for one main purpose. But if you are going to claim a subordinate part, or one of the elements of the combination, for a purpose independent of the purpose of the combination, then you have an extra invention, and it is not all one invention.

In the above case the Solicitor General allowed the patent to proceed on the insertion into the specification of words showing that the respective parts had one common object.

Re ROBINSON. Gr. P. C. 267.

Application for a patent for "Improvements in the art of producing and utilizing induced electrical currents for telegraphy and other purposes."

The invention consisted in a certain appliance to be used with transmitting and receiving instruments. The Comptroller required amendment of the title and provisional specification as *comprising more than one invention.*

On appeal, HERSCHELL, Sol. Gen., said the thing claimed might be the whole apparatus as one telegraphic apparatus, or the appliance itself for all purposes. Upon this intimation the applicant elected to take a patent for the general use of the appliance, and accordingly the title was altered to "Improve-

ments in the art of producing and utilising induced electrical currents," the provisional specification being amended accordingly.

Re HEARSON. No. 11,437 of 1885. Gr. P. C. 266.

Application for a patent for "Improvements in apparatus for rapidly heating flowing water, a part of which improvements are applicable to other purposes."

The provisional specification intimated the *other purposes* to which the invention was applicable.

The Comptroller held that was more than one invention, and required the excision from the title and provisional specification of the part relating to "*other purposes.*"

On appeal, DAVEY, Sol. Gen., affirmed this decision.

GROUNDS OF OPPOSITION.

We now pass on to sect. 11, upon which it will be necessary to dwell for a considerable time, for the whole subject of opposition to the grant of a patent comes in under this section.

The grounds of opposition are the following:—

1. That the applicant has obtained the invention from the opponent, or from a person of whom he is the legal representative.

2. That the invention has been patented in this country on an application of prior date.

3. That the complete specification describes or claims an invention other than that described in the provisional specification, and that such other invention forms the subject of an application made by the opponent in the interval between the leaving of the provisional specification and the leaving of the complete specification.

By the Act of 1883, the 3rd ground of opposition was that the examiner had reported to the Comptroller that the specification of the applicant appeared to him to comprise the same invention as is comprised in a specification bearing the same or a similar title and accompanying a previous application.

The alteration of the 3rd ground of opposition has probably been made in view of cases which have frequently occurred, and of which the following is an example:

Re GREEN. No. 6176 of 1885. Gr. P. C. 286.

Application by *Green*, dated *5th July*, 1885, for a patent for "Improvements in and connected with Fuel Economizers," opposed by *Lowcock and Sykes*, as grantees of a prior patent dated *4th March*, 1885, No. 2875, for parts of the invention claimed by the applicant.

The dates of lodging the complete specifications were respectively, *Green* on *3rd Dec.*, 1885, *Lowcock* on *2nd April*, 1886.

The contention of the opponents was that their provisional specification, which was of earlier date than *Green's* complete specification, described fully the parts objected to, and that such parts were not specially described in *Green's* provisional specification although set forth in his complete specification.

The Comptroller decided that certain claims and the corresponding description should be excised from the applicant's specification.

Appeal dismissed with costs.

Per WEBSTER, Att. Gen.—In this case the matter before me is whether I can allow the applicant to have a patent for the parts objected to.

The opponents' provisional was first in order of time, and therefore they were entitled to have their patent sealed as of earlier date.

It is said that the opponents have included in their com-

plete subject-matter which was not in their provisional. If that is so, that is an objection to the validity of the opponents' patent which will be available to the applicant or to anybody else in the event of proceedings being taken; but it is wholly impossible for me, on the present application, to alter, deal with, or interfere with the specification of the opponents' patent, as allowed.

It may be a misfortune, but the opponent is unfortunately in the position in which other applicants have been.

NOTICE OF OPPOSITION.

When an opponent has settled the ground or grounds of opposition on which he intends to rely under sect. 11, he must carefully fill up Form D, which can be obtained at the Patent Office, and which should be signed by himself.

Rules 34 and 40 of the Patents Rules give instructions for preparing the notice when the opponent relies on anticipation by a prior patent, and it might be supposed that there would be little difficulty in complying with the official directions.

It turns out, however, that informality in the notice of opposition is a continual source of trouble, and were it not for the wide power of amendment which is given to the Comptroller by Rule 18, and which that officer exercises with no unsparing hand where the defect is merely technical, it is obvious that great inconvenience might arise in particular instances.

Rules 18 and 34 are the following:—

Rule 18.—Any document for the amending of which no special provision is made by the said Act, may be amended, and any irregularity in procedure, which in the opinion of the Comptroller may be obviated without detriment to the interests of any person, may be corrected, if, and on such terms as the Comptroller may think fit.

Rule 34.—Where the ground or one of the grounds of opposition is that the invention has been patented in this country on an application of a prior date, the title, number, and date of the patent granted in such prior application shall be specified in the notice.

Rule 35 is to the effect that the opposition shall not be allowed unless the title, number, and date of the patent are duly specified in the notice.

Some cases bearing on the sufficiency of notice are the following:—

Re AIREY. 5 P. O. R. 348.

Application for a patent opposed by *Stanley* on the ground "that claims Nos. 1 and 2 (the only important part) are the same as my claims in patent 4726—86 for a machine for measuring the height of human beings automatically."

At the hearing it was objected that the notice of opposition was insufficient as not giving the date and title of the patent as required by Rule 34.

The Comptroller thereupon gave leave to amend, and remarked that the Law Officer had decided that he had power to allow amendments to be made at the hearing. The applicant had before him the means of referring to the specification.

Re DANIEL. 5 P. O. R. 413.

Application for a patent opposed by *Stanley* on the ground "that it is a direct infringement of my patent No. 7244 of 1887."

It appeared that the examiner had reported interference. The sufficiency of the notice being objected to, the Comptroller gave leave to amend, and said that under sect. 7, sub-sect. (6), and Rules 11, 12, 13, and 15 of the Act of 1883, he had power to hear and determine the point as to whether the inventions were the same or different on the report of the examiner, irrespective of any opposition.

Re LAKE. Gr. A. P. C. 35.

Application for a patent opposed by *Wrigley*, who was agent for *Black*, the real opponent.

The grounds of opposition were, (1) Prior patents; (2) Report by examiner of interference.

It appeared that the Comptroller had addressed the notice to interference to *Black*, care of *Wrigley*. The notice of opposition commenced, "I, *Thomas Wrigley*," and was signed "*Thomas Wrigley*, agent for the opponent." At the hearing it transpired that *Wrigley* had died, and *Black* applied to be heard.

It was objected that the notice was informal, but the Comptroller, under Rule 18, allowed *Black* to strike out *Wrigley's* name from the notice and to write his own in place thereof, and the case went on.

On appeal, the objection was mentioned but not pressed.

There are numerous other instances of a like kind; thus, in the course of one week, the writer was engaged as counsel in the two following cases:—

1. *Re* WELCH. *Apr.* 15*th*, 1889. (Not reported.)

Application for a patent opposed by *A. C.* and *T. Sterry*, on the ground "that the results described and claimed by the applicant are the same as those described and claimed under our patent, dated 27*th Oct.*, 1886, No. 13782, and are obtained by substantially the same means."

An objection was taken to the terms of the notice, but the Comptroller allowed an amendment in accordance with Rule 34, and the case was heard on its merits.

2. *Re* FAWCETT. *Apr.* 16*th*, 1889. (Not reported.)

Application for a patent opposed on the ground "that the invention or *material parts thereof* had been patented in this country on applications of prior date, videlicet, &c."

The notice being objected to on account of the insertion of the words in italics, the Comptroller gave leave to strike them out, which was done, and the case proceeded.

Where an opponent, as in *Re* JONES (Gr. A. P. C. 38), objected to the grant on the ground that the invention sought to be patented was "the same or *substantially the same*" as his own, DAVEY, Sol. Gen., said that the words in italics raised the question of infringement into which he did not enter, and further that the opponent was not entitled to show the *Joncs'* invention was bad subject-matter, that being a question upon which the law officer had no jurisdiction.

It does not appear that any objection was raised to the terms of the notice.

Again, there is a case where the notice failed to reach the opponent.

Re WARMAN. Gr. A. P. C. 43.

Application for a patent opposed on the ground of a prior patent for the same invention.

At the hearing the opponent did not appear, and the Comptroller decided to seal the patent.

Subsequently it transpired that a notice of hearing, sent by post to the opponent's agent, had miscarried.

On appeal, WEBSTER, Att. Gen., directed that the case should be remitted to the Comptroller.

LOCUS STANDI OF OPPONENT.

According to sect. 11, sub-sect. (3), any person giving notice of opposition to the grant of a patent may be called upon by the law officer to show "*that he is a person entitled to be heard.*"

The reported cases on this sub-section refer to oppositions

to the grant of a patent on the ground that the invention has been patented in this country on an application of prior date.

A difficulty has arisen in this way:—An opponent finds that an invention sought to be patented by an applicant comes very near some invention disclosed in a prior patent. It may be that the opponent has not and never has had any interest in the prior patent, but he may nevertheless feel himself hampered by the grant of a monopoly affecting a particular subject-matter, and he therefore enters an opposition on the ground that the invention has been patented in this country on an application of prior date.

Here, however, he will find the law officers inexorable in their interpretation of the words "*entitled to be heard.*"

The two leading cases are:—

1. *Re* GLOSSOP. No. 6801 of 1884. Gr. P. C. 285.

Application by *Glossop* for a patent for "Improvements in the valve-motion of steam-hammers" opposed by *Taylor*, as assignee and manufacturer for 13 years under a patent, No. 3113 of 1872, which had lapsed.

The Comptroller allowed the patent to proceed, and, on appeal, his decision was affirmed by Herschell, Sol. Gen.

At the hearing of the Appeal an objection was taken that the opponent was not entitled to be heard, but the objection was over-ruled.

Per HERSCHELL, Sol. Gen.—I shall hesitate very much before I say that any member of the public can come in and oppose a patent and raise an enquiry, and cause an appeal of this sort who has no interest in it, and who simply says:—"Do not ask me what my interest is, because I have none, except that I am going to show you that this patent is the same as that." Because that system might be used so as to cause a vast amount of annoyance and expense, of a most

objectionable character, to patentees. I know it was intended to prevent that.

In the present case, the opponent purchased a prior patent which, he says, has anticipated the present invention, and he has been working under it, and he is a manufacturer who has been making machines in accordance with that patent. Although that patent has now become public property, I do not think that I ought to hold that he is a person not entitled to be heard.

2. *Re* HEATH & FROST. No. 5222 of 1886. Gr. P. C. 288.

Application for a patent opposed by *Hardingham*, as agent for *McNab*, the grantee of a prior patent.

On appeal it was objected, as was the fact, that *Hardingham* was merely agent for the opponent, and had no interest in the patent.

CLARKE, Sol. Gen., ruled that this was a valid objection, and said:—

It seems to me perfectly clear from the Act that members of the public, as such, are not entitled to be heard in opposition before me. . . . The only class of persons who are entitled to be heard in opposition before the law officer are persons who are interested with a legitimate and real interest in the prior patent upon which an application is opposed, or persons who while they have not patented the invention have yet been the originators of it, from whom the person seeking the patent has obtained it.

Hardingham then asked to amend, by substituting *McNab's* name for his own in the notice, but leave was refused.

The same rule applies also in applications for amendments; for example, there is the case of—

Re BELL. Gr. A. P. C. 10. Which was an opposed application to amend the specification of a patent; one ground of

objection being that the amendment would make the invention the same as that comprised in certain prior patents in which the opponents had no interest.

Here both the Comptroller and CLARKE, Sol. Gen., following *Glossop's* case, ruled that the opponents were not entitled to be heard with regard to these patents.

The remaining reported cases bearing on this point are the following :—

Re LANCASTER. Gr. P. C. 293, where an application for a patent was opposed by the grantee of a prior expired patent. On appeal, the applicant objected that no opposition could be founded on an *expired* patent, but GORST, Sol. Gen., over-ruled the objection, and said :—It makes no difference whether the patent has expired or not. The Act allows an application for a patent to be opposed on the ground that the invention has been previously patented.

In *Re* HOOKHAM (Gr. A. P. C. 32), which was an application for a patent opposed on the ground of prior patents, the question arose on appeal as to whether the opponent could be heard in reference to an objection founded on a prior patent in which he had no interest, but it became unnecessary for the law officer to decide the point.

WEBSTER, Att. Gen., said :—I concur in the principle laid down in *Glossop's* case, (*ante*, p. 12), and I should not allow any person who merely comes forward as one of the public to claim to strike out certain paragraphs of a specification on the ground that it was included in a prior patent in which he had no interest. It may be that the Comptroller would have some power to do such a thing if the patent was obviously bad.

Re MACEVOY, 5 P. O. R. 285.

Here an application was opposed on the ground of prior patents.

On appeal, it was objected that the opponent had no *locus standi*, inasmuch as he was merely a manufacturer under one of the patents relied on.

CLARKE, Sol. Gen., held that this was a good objection, and said:—I do not think manufacturing is sufficient, and I do not want to make any further statement in another case which may appear to alter the decisions which have been previously arrived at. I wish to leave *Glossop's* case, and *Heath and Frost's* case, as far as I am concerned, exactly where they stand.

Re BAIRSTOW. 5 P. O. R. 286.

Application for a patent opposed on the ground that the invention had been previously patented.

It appeared that the opponent was about to work the invention for which the prior patent had been granted, but CLARKE, Sol. Gen., said that was not enough, and refused to hear the opposition.

But in *Re* HILL (5 P. O. R. 599), which was an opposed application for a patent, it was held that a licensee under a prior patent is entitled to oppose the grant.

Where an applicant has only obtained provisional protection for an invention, it is not competent for him to bring forward such provisional specification in opposition to a later applicant, either under section 11 or in any other manner.

The ground of opposition permitted by the Act is that the invention has been *patented* in this country on an application of prior date, and of course the word "patented" implies that there has been an actual grant, or some statutory equivalent for the same.

Sect. 15 supplies the statutory equivalent, for it will be seen that after the acceptance of the complete specification the applicant has the "like privileges and rights as if a patent for the invention had been sealed on the date of the acceptance.

Provided that an applicant shall not be entitled to institute any proceeding for infringement unless and until a patent for the invention has been granted to him."

Accordingly it was obvious that whenever the case arose, it would be decided that the right of opposition on the ground of a prior patented invention would be accorded immediately after the acceptance of the complete specification. This was decided in *Re L'Oiseau and Pierrard*, No. 12833, of 1886 (Gr. A. P. C. 36), which was opposed by *Everitt* as grantee of a prior patent, No. 10860, of 1886, which however, had not been sealed, although the *complete* specification had been *accepted*.

It was objected that the opponent had no *locus standi*, but the Comptroller over-ruled the objection.

On appeal, WEBSTER, Att. Gen., affirmed this decision, and said:—I am satisfied, that in order to give effect to sect. 15, where a person has had a complete specification accepted, he is entitled to be in the same position, for the purpose of opposition, as a person who has already got a patent upon which he can oppose. In fact, the proviso preventing him from taking proceedings for infringement, accentuates and makes clear that position; because a limit has been put upon his rights of bringing actions for infringement which limit would only be necessary if he were in the *quasi* position of a patentee.

It follows also that no one can oppose on the ground of the existence of a prior provisional specification published by the Patent Office before the Act of 1883.

A reported case is the following:—

Re BAILEY. No. 12067 of 1884. Gr. P. C. 269.

Application by *Bailey* for a patent for "Improvements in attaching knobs to the spindles of locks and latches."

Opposed by *Talman*, who relied upon certain specifications of prior date, three of which were provisional specifications.

At the hearing it was objected that under sect. 11, sub-sect. (1), the inventions to which the provisional specifications referred had not been "*patented in this country*," and could not be produced in evidence.

The Comptroller refused to consider such provisional specifications, and on appeal, DAVEY, Sol. Gen., affirmed this decision.

It remains to consider another question, namely, what is to be done when the invention for which an applicant seeks to obtain a patent has been already described, but not claimed, in a prior specification relied upon by the opponent. An answer to the inquiry can now be given by a reported case, which shows the potential value of technical language in matters of this kind.

Re VON BUCH. Gr. A. P. C. 41.

This was an application for a patent for "Improvements in incandescent gas lights," opposed by a Company as assignees of a patent granted to *Von Welsbach*, No. 15,286 of 1885. It appeared that there were 10 claims in the specification.

The Comptroller was of opinion that the whole invention claimed (except so far as related to claims 8 and 9) had been described in *Von Weisbach's* specification, and he directed the insertion of a special disclaiming clause which was settled as follows :—

My invention, "which is for the purpose of supporting caps or hoods such as those for which letters patent were granted to *Von Welsbach*, No. 15,286 of 1885," and so forth.

Appeal dismissed with costs.

Per CLARKE, Sol. Gen.—In this case, upon hearing argument on the question of fact, I come to the conclusion that the

Comptroller was right when he said, "It appears clear that the invention for which the patent is sought is described in the opponent's specification."

The case is the same as it would have been if *Von Buch* had actually copied the whole of *Von Weisbach's* specification, and had then claimed as his invention those matters which were not included in the claiming clause of the specification he had appropriated.

I have now to decide whether, in this state of facts, I am entitled to refuse to allow the patent of *Von Buch* to be sealed. I find myself strictly bound and limited by the Act which gives me jurisdiction in this matter.

Sect. 11 sets out the grounds, and the only grounds, upon which an opposition to the grant can be made. One of these grounds, and that upon which alone the present opposition is founded, is "that the invention has been patented in this country on an application of prior date."

It is a rule long established, and of obvious justice and importance, that only that is patented which the inventor claims. Sect. 5 of the Act requires that a complete specification shall end with a distinct statement of the invention claimed.

The Solicitor-General then read the claim in *Von Weisbach's* complete specification, and being of opinion that he had no power to amend or alter the language of the claim, or to give the words used anything but their plain and direct meaning, felt himself constrained to hold that the invention claimed by *Von Buch* had not been patented by *Von Weisbach*, and directed the patent to be sealed.

EVIDENCE AT THE HEARING.

In order to prepare for the hearing, the opponent should leave at the Patent Office any statutory declarations in support of his opposition which he may be advised to put in.

Rule 35 gives a period of fourteen days after the expiration of two months from the date of the advertisement of the acceptance of the complete specification for filing such declarations.

It will, of course, be understood that any of the periods of time mentioned in the Act for regulating procedure are imperative and cannot be varied, but the Comptroller has power, under the provisions of Rule 47, to enlarge any of the times mentioned in the rules, and he may do so upon cause shown, with due notice, and upon terms.

Not only should the opponent lodge declarations at the Patent Office, but, upon doing so, he must also deliver to the applicant a list of the same.

The opponent having lodged his declarations and delivered his list to the applicant, the admission of further evidence is now to be regulated.

Rule 36 gives the applicant 14 days from the time of delivery of the list above mentioned for filing declarations in answer.

The applicant must also deliver to the opponent a list of such declarations.

Within 7 days from the delivery of the last-named list the opponent must lodge declarations in reply, and such declarations must be confined strictly to matters in reply.

Copies of declarations may be obtained either from the Patent Office or from the opposite party.

Rule 40 makes it imperative on the opponent to confine his opposition to the particular ground or grounds stated in his notice.

Rules 37 and 38 deal with the possibility of lodging further evidence, in special cases, by leave of the Comptroller, but as a general rule the evidence is strictly confined to the three sets of declarations above enumerated.

Rule 39 deals with the time for hearing, which is fixed by the Comptroller, who is required to give at least 7 days' notice to the parties concerned.

If the opponent fails to deliver declarations the case will be heard on a comparison of the documents then before the Comptroller, and unless they are sufficient to support the opposition on the grounds taken, the opposition will fall through. For example, declarations are indispensable where an opposition is based on the ground that the applicant has taken the invention from the opponent.

Thus, in *Re* DUNDON, Gr. P. C. 278, which was an application for a patent opposed by *Paterson* on the ground (1) that *Dundon* had obtained the invention from him, it appeared that no evidence had been filed in support of the first ground of objection, whereupon the Comptroller decided in favour of the applicant on that ground.

Where the opposition is based on the existence of a prior patent for the same invention, and the opponent is the prior patentee, it sometimes happens that no declarations are filed.

One great use of the declarations in an opposition case is to enable either party to put in such explanatory drawings, models, or specimens as may be useful.

Of course the Comptroller has a wide discretion as to the use by Counsel of drawings or models, but in order to avoid waste of time in arguments as to the admissibility of the same at the hearing, it is better to make an exhibit of anything which is relied upon as showing the state of public knowledge prior to the date of the application.

In particular, if the opponent relies upon any prior specifi-

cations, he must make them exhibits, or they cannot be referred to.

A reported case is the following :—

Re LANCASTER. Gr. P. C. 293.

Application for a patent for "Improvements in pistons and plungers." Opposed by *Buckley* as grantee of a prior expired patent for the same invention.

The Comptroller refused to seal the patent.

On appeal, the applicant produced specimens of his packing which had not been made exhibits.

It was objected that these specimens could not be received in evidence, but GORST, Sol. Gen., said that he should look at them as aiding him in the inquiry. When he came to determine whether the two inventions were the same or different, he should go by the drawings and specifications.

Also in *Re* JONES (Gr. A. P. C. 3), which was an application for a patent for "more efficiently fastening the frames of writing slates," DAVEY, Sol. Gen., allowed certain specifications referred to in the declarations to be read, and observed that it was extremely material to know the state of knowledge upon the question of securing the frames of slates prior to and at the date of the opponent's patent.

LAW OFFICERS' RULES.

Sect. 38 of the Act of 1883 gives the Law Officers power to examine witnesses on oath, to administer oaths for that purpose, and also to make rules for regulating the practice and procedure before them, and further to order costs to be paid by either party, and direct that any such order may be made a rule of the Court.

Accordingly, certain rules have been drawn up, known as the "Law Officers' Rules," which should now be considered.

Rules 1, 2, 3 are important as dealing with the notice of appeal, upon which mistakes have arisen. They are as follows:—

Rule 1.—When any person intends to appeal to the Law Officer from a decision of the Comptroller in any case in which such appeal is given by the Act, he shall, within 14 days from the date of the decision appealed against, file in the Patent Office a notice of such his intention.

Rule 2.—Such notice shall state the nature of the decision appealed against, and whether the appeal is from the whole or part only, and if so, what part of such decision.

Rule 3.—A copy of such notice of intention to appeal shall be sent by the party so intending to appeal, to the Law Officer's clerk at Room 549, Royal Courts of Justice, London; and when there has been an opposition before the Comptroller, to the opponent or opponents; and when the Comptroller has refused to seal a patent on the ground that a previous application for a patent for the same invention is pending, to the prior applicant.

Rule 8 limits the evidence on appeal to that already lodged before the Comptroller, "and no further evidence shall be given, save as to matters which have occurred or come to the knowledge of either party, after the date of the decision appealed against, except with the leave of the Law Officer upon application for that purpose."

Rules 9 and 10 refer to the cross-examination of witnesses, and Rules 11 and 12 deal with the subject of costs, and there are two additional rules.

We have seen that the notice of opposition has given rise to difficulties in procedure before the Comptroller, and there are a few cases relating to notice of appeal which may be referred to:—

Re ANDERSON and MCKINNELL. No. 3801 of 1886. Gr. A. P. C. 23.

Application for a patent opposed on the ground that the invention had been previously patented.

The Comptroller decided to seal the patent.

The opponent appealed, but gave no notice thereof to the applicant. Also it appeared that the notice of appeal was signed by the agent of the opponent.

On objection taken, CLARKE, Sol. Gen., held that Rule 3 did not require any notice of appeal to be sent to an applicant, and that a notice of appeal signed by an authorised agent was sufficient.

In *Re* HILL. 5 P. O. R. 601, a difficulty occurred as to the notice required under Rule 3.

The opponent before the Comptroller was now the appellant, and he gave notice to the clerk of the Law Officer, but not to the respondent.

When the case was called on, the respondent did not appear, as he was not aware of the appeal, and the hearing was adjourned in order that the respondent might be represented.

Subsequently, WEBSTER, Att. Gen., said that he agreed with the construction put upon Rule 3 by the Solicitor General in *Re* ANDERSON and MCKINNELL (Gr. A. P. C. 23), but that the respondent ought to receive due notice of appeal, and he would give the necessary directions either to the Patent Office or the Official Clerk, and would consider the necessity of issuing a supplemental rule.

Re BAIRSTOW. No. 619 of 1886. 5 P. O. R. 286.

Application by *Bairstow* for a patent for "Improvements in and looms or apparatus for weaving velvet or cut-pile fabrics."

Opposed by *C. Vorwerk* of *Barmen*, in *Germany*, on the grounds,

(1.) That the applicant had obtained the invention from him at *Barmen*.

(2.) Prior patents for the same invention.

The invention consisted in making pile fabrics with a double backing, so that when the ornamental body threads were divided two complete pile fabrics were produced.

The Comptroller, following *Edmund's* case, held that the first ground of opposition failed, but required the excision of claims 1, 2, and 4.

The applicant appealed, but there was no cross appeal by the opponent.

At the hearing of the appeal, CLARKE, Sol. Gen., refused to review the Comptroller's decision on the first ground of opposition, and said:—

The effect of Rules 1 and 2 of the Law Officers' Rules is to limit the hearing before the Law Officers to points specifically raised by the notice of appeal, and where a notice of appeal is as to part only of the Comptroller's decision, the person receiving such notice and desiring to question other parts of the Comptroller's decision must give a counter notice. If the original notice of appeal is only given just before the expiration of the 14 days, the time for giving a counter notice may be extended under Rule 5.

A question as to the *locus standi* of the opponent was then raised, and decided against the opponent (*ante*, p. 15).

The Sol. Gen. finally varied the Comptroller's decision, and allowed claims 1 and 2 to be amended, the applicant consenting to abandon claim 4.

Re CHANDLER. No. 3100 of 1886. Gr. P. C. 270.

Application for a patent opposed by a Company on the ground of prior patents. The Comptroller required amendment both in the title and specification. The Company forthwith gave notice of appeal, and after two days withdrew the appeal.

Subsequently, when the form of the amendment was settled,

the Company lodged a fresh notice of appeal, and it appeared that the notice was lodged within 14 days from the time of the receipt by the Company of a copy of the amendment.

At the hearing, it was objected that the notice of appeal was too late, but CLARKE, Sol. Gen., ruled that the time for appeal should in such a case date from the day of forwarding to the opponent a copy of the amendment as approved by the Comptroller.

The appeal being dismissed, the Solicitor General gave costs against the appellants on the ground that after having virtually submitted to the decision by withdrawing the first appeal, they should not have contested the matter a second time.

In *Re* ANDERTON (Gr. A. P. C. 25), which was an application for a patent opposed on the ground that the invention had been obtained from the opponent, the Comptroller decided to seal the patent, and WEBSTER, Att. Gen., in affirming this decision, said:—

I make costs follow the event in appeals if I possibly can. It is only a right thing.

In *Re* FLETCHER (Gr. A. P. C. 30), which was an application for a patent opposed on the ground that the invention had been previously patented, the Comptroller decided to seal the patent.

On appeal, the decision was affirmed by CLARKE, Sol. Gen., who approved of a small verbal alteration in the specification not going to substance, and said that he should give costs to the appellant.

In *Re* BAILEY, Gr. P. C. 269, already referred to (*ante*, p. 16), the appellant asked leave, under Rule 8, to put in evidence a specification which had come to his knowledge since the hearing before the Comptroller, but DAVEY, Sol.

Gen., refused to allow this to be done, inasmuch as the specification was not evidence, but an additional ground of opposition.

Re AINSWORTH. No. 5176 of 1885. Gr. P. C. 269.

Application for a patent which was opposed.

On appeal, the respondent did not appear, and WEBSTER, Att. Gen., reserved his decision in order to afford an opportunity for explanation. The non-attendance having been explained satisfactorily, the respondent was ordered to pay the appellant's costs of the day, and another day was appointed for hearing the appeal.

Re KNIGHT. No. 15,580 of 1886. Gr. A. P. C. 35.

Here an appeal was lodged, but withdrawn two days before the day fixed for hearing, and no sufficient reason was assigned, whereupon the appellant was ordered to pay costs.

RE DIETZ. 6 P. O. R. 297.

Application for a patent opposed by *Gallico*, as grantee of a prior patent, No. 10231 of 1886. The Comptroller decided to seal the patent. On appeal, the opponent did not appear, and it transpired that the agent of the opponent had written to the applicant asking his consent to an adjournment, but this was refused.

CLARKE, Sol. Gen., dismissed the appeal with costs (5 guineas).

FIRST GROUND OF OPPOSITION.

We shall now collect some cases on the 1st ground of opposition, namely, that the applicant has obtained the invention from the opponent, and a primary conclusion is that the taking

complained of must have occurred in this country, inasmuch as the *first importer* of an invention has the full rights with which a legal concession invested him in the earliest days of patent law.

The leading case is the following:—

Re EDMUNDS. No. 1292 of 1886. Gr. P. C. 281.

Application by *Edmunds* for a patent on 28*th Jan.*, 1886, for "Improvements in telephones" (in part a communication from abroad by *Thornberry* of Boston, U.S.A.), opposed by *Thompson*, who applied for a patent on 29*th Jan.*, 1886, for the same invention (a communication from abroad by *Gilliland* of Suffolk, U.S.A.).

The grounds of opposition were:—

(1.) That the invention was obtained by *Thornberry* from *Gilliland*, by whom it was communicated to *Thompson*.

(2.) That an examiner had reported interference between the specifications of *Edmunds* and *Thompson*.

Prior to the hearing *Thompson* applied, with consent of the applicant, for leave to strike out the 2nd ground of opposition, and to substitute the following:—"And also on the ground that the applicant obtained the invention from *Gilliland* of Suffolk, U.S.A., of whom I (*Thompson*) am the legal representative."

It appeared that *Thompson* held a power of attorney from *Gilliland*.

The Comptroller decided to seal the patent, and ruled that the first importer of an invention was the true and first inventor within the meaning of the Statute of Monopolies. He refused to go into the question of fraud.

The Comptroller was also of opinion that the opponent had no *locus standi* on the 2nd ground of objection, inasmuch as the words "legal representative" in sect. 11 of the Act should be construed in their ordinary signification as meaning an

executor or administrator of a deceased person and not as including a person holding a power of attorney.

On appeal, the question of the *locus standi* on the 2nd ground of objection was reserved, but fell through. The decision of the Comptroller was then affirmed, with no order as to costs.

Per WEBSTER, Att. Gen.—I am of opinion that sect. 11 was intended to apply to communications between persons in the United Kingdom and the Isle of Man and not to communications made abroad.

Prior to the passing of the Act of 1883, the law was well settled that a person importing into the realm an invention was the true and first inventor within the meaning of the Statute of James, and it mattered not under what circumstances he had obtained the invention abroad. In my judgment the Act of 1883 has made no alteration of the law in this respect.

In the case of an imported invention, the merit of the invention is the importation, and I think therefore the Comptroller has no jurisdiction to inquire as to the circumstances under which the invention was obtained by the importer.

There is another case which may be quoted :—

Re LAKE. 5 P. O. R. 415.

Application for a patent (a communication from abroad by *Ladd* of *Boston*, U.S.A.).

Opposed by *Swinerton* of *New York*, U.S.A., on the ground of the applicant having obtained the invention from him, the opponent alleging that *Ladd* had obtained the invention when in New York.

The Comptroller decided to seal the patent, and held that a person availing himself of information from abroad is an inventor within the meaning of 21 James I. cap. 3, sect. 6.

Appeal dismissed, with 5 guineas costs.

Per CLARKE, Sol. Gen.—There is the case of *Edmunds* (*ante*, p. 27), which I have myself followed in a later case. I think I am bound by that decision.

There are but few cases of interest under this head, except perhaps those which indicate the nature of the terms imposed where inventions overlap, and no fraud is alleged or proved.

Re LUKE.—No. 5156 of 1885. Gr. P. C. 294.

Application by *Luke* for a patent for "Improvements in or applicable to machines for slubbing, roving, spinning, doubling, or winding fibrous materials."

Opposed by *Tatham* on the ground that *Luke* had obtained the invention from him whilst in his employ and confidence.

Declarations were filed on both sides.

The Comptroller decided to seal the patent in order that the case might be heard on appeal, when the witnesses could be cross-examined.

On appeal, GORST, Sol. Gen., directed that the evidence for the opponent should be taken first as the *onus probandi* lay on him. The declarants were then sworn, and the declarations were read to them; they were then asked if they adhered to their statements, and after they had made such corrections as they desired they were cross-examined.

Per GORST, Sol. Gen.—It has not been proved to my satisfaction that *Luke* obtained the whole of the invention which he seeks to patent from *Tatham*, but I am at the same time convinced that the applicant is not the sole inventor, but that part, at least, of the merit of the invention is due to *Tatham*.

Under these circumstances it appears to me that the justice of the case will be best met by following the precedent set in *Russell's* Patent by LORD CRANWORTH (*Goodeve*, p. 589), with such modifications as the present law requires.

I think that *Luke* and *Tatham* should enter into an agreement by which the former should undertake to do all such acts as may be necessary for securing to the latter the full rights of a joint patentee in the invention in question and the latter should undertake to take no proceedings for revocation of the patent when granted.

On the filing of such agreement at the Patent Office I determine that the grant shall be made, and that each party shall pay his own costs of the appeal.

In the event of *Luke* refusing to enter into such agreement, I determine that the grant shall not be made, and that *Luke* shall pay the costs of both parties in the appeal. In the event of *Tatham* refusing to enter into such agreement I determine that the grant shall be made, and that *Tatham* shall pay the costs of both parties in the appeal.

Re HATFIELD. No. 14,621 of 1884. Gr. P. C. 288.

Application by *Hatfield* for a patent, opposed on the ground that the applicant had obtained the invention from the opponent.

The Comptroller decided to seal the patent without going into the merits, in order that the case might go to the Law Officer when the witnesses could be cross-examined.

On appeal, an arrangement was suggested by WEBSTER, Att. Gen., and it appearing that the opponent had also applied for a patent, it was agreed that if the present opposition were withdrawn, there should be no opposition to the opponent's application.

Re EADIE. No. 739 of 1885. Gr. P. C. 279.

Application by Messrs. *Eadie* for a patent for "Improvements in the construction of the travellers used in machinery for spinning and doubling cotton, wool, silk, and other fibrous materials."

Opposed by *Bourcart*, and *Clark* his patent agent, on the ground the invention or a material part thereof had been obtained from *Bourcart*, and also on the ground of prior patents Nos. 1602 of 1882, and 4241 of 1884, granted to *Clark* as communications from *Bourcart*.

The Comptroller was of opinion that the invention in question was not wholly invented by the applicants, and decided to seal a patent to the *Eadies* and *Bourcart* as joint inventors.

Re EVANS & OTWAY. No. 12,415 of 1884. Gr. P. C. 279.

Application for a patent for "Improvements in steam engines," opposed by *Cutting* on the ground that the applicants had obtained the invention from him.

In order that the witnesses might be cross-examined on the declarations, the Deputy Comptroller decided to seal the patent without going into the facts.

On appeal, it appeared that *Cutting* had already obtained a patent, No. 2,514 of 1885, for an invention which was substantially the same as that of *Evans & Otway*. Also, that *Evans & Cutting* had been jointly experimenting on the subject matter of the invention.

WEBSTER, Att. Gen., directed the sealing of the patent, on terms that *Evans & Otway* should assign one half-share of their patent to *Cutting*, and that *Cutting* should assign one half-share of his patent to *Evans & Otway*.

It transpired that *Otway* could not be found, and could not be made a party to the assignment, whereupon the Attorney General stopped the patent on the terms that *Cutting* should assign one half-share of his patent to *Evans* alone.

Re GARTHWAITE. No. 3,124 of 1886. Gr. P. C. 284.

Application for a patent for "Fish biscuits for dogs and food

for poultry and game," opposed by *King* on the ground that the invention had been obtained from him.

It appeared that *King* had applied for a patent, No. 4,932 of 1886, for an invention substantially the same as that of *Garthwaite*, and that an examiner had reported interference.

The Comptroller was of opinion that part of the invention originated with *King* and that the parties were joint inventors. He therefore consented to grant both patents upon condition that each party agreed to assign to the other one half-share of and in the respective patents, and to pay one-half of the necessary fees for maintaining the same in force.

Re DAVID & WOODLEY. Gr. A. P. C. 26.

Application for a patent by *David & Woodley*, opposed by *Jones* on the ground that the applicants had obtained the invention from him.

The Comptroller refused to seal the patent.

On appeal, DAVEY, Sol. Gen., affirmed this decision, on the ground that, on the evidence, *Woodley* stood to *Jones* in the relation of paid servant to employer, and he stated a well-known doctrine of patent law as follows:—

I am of opinion that if a workman is employed by an inventor to make a model for the purpose of carrying out his invention, and the workman suggests improvements in details, which are adopted in the machine or model as completed; those suggestions are the property of his employer, and the workman cannot afterwards take out a patent for them.

In *Re* MARSHALL, 5 P. O. R. 661, which was an application for a patent opposed by *Simmons* on the ground that the applicant had obtained the invention from him, the Comptroller refused to seal a patent, and on appeal, CLARKE, Sol. Gen., affirmed this decision with costs (5 guineas).

Re HOMAN. No. 11,937 of 1887. 6 P. O. R. 104.

Application on *2nd Sept.* 1887, for a patent for "Improvements in the construction of fire-proof floors," opposed by *Ashwell* on the ground that the invention had been obtained from him.

It appeared that on *6th July*, 1887, *Ashwell* had registered as a design a brick of the same form as that of *Homan*.

The Comptroller gave an alternative decision, viz.,

(1) That a patent should be granted to the applicant and opponent jointly.
(2) That a patent be sealed on condition that the applicant disclaimed the form of brick registered by Homan.

On appeal, CLARKE, Sol. Gen., allowed the patent free from conditions, being of opinion that *Homan* was entitled to claim originality in the matter.

SECOND GROUND OF OPPOSITION.

It is here that we meet with the great majority of opposition cases, and for convenience of reference and in order to elicit, as far as possible, the principles which have governed the decisions, it may be convenient to classify the cases in order, taking :—

(1.) Those where the opposition has failed.
(2.) Those where a *general* disclaiming clause has been inserted in the specification.
(3.) Those where a *special* disclaiming clause has been put in.
(4.) Those where the grant of a patent has been refused.

PATENT GRANTED WITHOUT CONDITIONS.

Re HUTH. No. 1571 of 1884. Gr. P. C. 292.

Application by *Huth* for a patent for "Improvements in the manufacture of compounds of indiarubber, gutta-percha, and the like materials."

Opposed by *Gerner* on the ground that the invention was the same as that patented by him No. 6232 of 1882, which consisted in combining indiarubber, gutta-percha, or any analogous gum with certain substances enumerated in the notice.

No declarations were lodged at the Patent Office.

The Comptroller allowed the patent.

On appeal, it was objected that the language of the notice raised the question of fraud on the part of the applicant.

HERSCHELL, Sol. Gen., said that he would not allow any imputation of fraud to be gone into as there was no evidence filed in support of it, nor would he allow time for evidence as to fraud to be put in.

The opposition must be confined to the question whether the applicant's invention had been previously patented as alleged.

Appeal dismissed with costs.

Re CUMMING. No. 8988 of 1884. Gr. P. C. 277.

Application by *Cumming* for a patent for "An improved fastener for bracelets."

Opposed by *Jones*, the grantee of a prior patent No. 5194 of 1882.

The Comptroller decided to seal the patent.

On appeal, decision affirmed with costs.

JAMES, Att. Gen., was of opinion that the two inventions were very nearly the same, but that there was just sufficient difference (although a very slight difference) to justify him in

affirming the Comptroller's decision. He felt, too, that if he refused a patent, his decision would be final.

It appearing that *Cumming's* claim was for "The improved fastener for bracelets constructed *substantially* as above described," the word "*substantially*" was by consent struck out.

Re STUBBS. No. 2100 of 1884. Gr. P. C. 298.

Application for a patent for "Improvements in apparatus for removing the dust from carpets or other similar articles."

Opposed on the ground of a prior patent No. 5010 of 1880.

The Comptroller decided to seal the patent.

Appeal dismissed with costs (10 guineas).

Per WEBSTER, Att. Gen. Stopping a patent is a very serious step, because there are no means whatever of an applicant getting that which he applies for if I stop it, and it must be distinctly understood that I shall not stop the patent unless I am satisfied that the inventions are identical.

In cases before me where there is no fresh evidence I shall, as a rule, allow the costs to follow the event. That will not apply to cases where there may be further evidence brought forward, or special matters which ought to influence the judgment of the law officer.

Re LORRAIN. Nos. 8751 and 8896 of 1886. 5 P. O. R. 142.

Application for patents for "Improvements in clocks and apparatus for winding the same by electricity."

Opposed by *Lund* on the ground of a prior patent No. 15,500 of 1884 granted to *Thompson* for the same invention.

The Comptroller directed that both patents be sealed.

Appeal dismissed with costs (8 guineas).

It appeared that *Lorrain* had stated in his specification that the object of his invention was to overcome drawbacks in connection with clocks in which a *rotary* electro-motor is employed,

and further, that "a continuously *rotating* electro-motor cannot be relied upon to wind up a spring or weight to the exact amount required."

Also, that the 1st claim in each specification of the applicant was "The improvement in clocks consisting in the combination of a mechanical clock mechanism and an electrical winding mechanism, substantially as and for the purpose specified."

Counsel for the appellant limited his opposition to the 1st claim in each specification, and contended that this claim did not indicate the type of motor employed, and therefore covered the prior invention. He asked that the 1st claim be struck out or otherwise be prefaced by a disclaimer of *Thompson's* invention.

Per WEBSTER, Att. Gen. By allowing a specification in any particular form no harm is done to persons who have a prior patent; but on the other hand the Law Officer is bound to protect the public so that they may not be misled by any specification which, upon the face of it, might be held to have a wider scope or include a wider kind of invention than that to which the patentee is, on the evidence, entitled. The patentee of the later patent frames his specification at his peril.

I see that in the earlier specification of the patentee, page 5, line 8, he refers to the existence of self-winding clocks in which a rotary electro-motor is employed. "That is, an electro-motor which, when a current of electricity is passed through it, rotates continuously in one direction."

Counsel for the appellant admitted that this description gave a substantial statement of the class of electro-motor which is described in *Thompson's* patent.

Therefore I do not think that anybody reading the 1st claim fairly, as he must refer to the specification, could assume that it was intended to claim mechanism in which a rotary electro-motor was used. The same observation applies to 8896.

For these reasons—again repeating that the patentee frames

his specification at his peril—I cannot see that there is any ground for supposing that the owners of *Thompson's* patent would be in any way prejudiced, or the public misled, by the publication of the specifications framed as they are.

Re PITT. No. 12,908 of 1886. 5 P. O. R. 343.

Application by *Pitt* for a patent for the "Manufacture of new naphthol and napthylamine-monosulphonic acids and of dye stuffs therefrom."

Opposed on the ground of a prior patent No. 5846 of 1886.

The Comptroller decided to seal the patent.

On appeal, decision affirmed with 10 guineas costs.

Per CLARKE, Sol. Gen. If I thought that by allowing other witnesses to be called, or by asking for the cross-examination of witnesses, or by any other means, I could arrive at a conclusion which would be more just to the parties than that which I am now going to signify, I certainly would not spare any time in the matter, and I would have the fullest investigation.

It is an exceedingly difficult subject, but there seems to have been ample opportunity for producing declarations in this case; and I am bound to say my own scientific knowledge is not so extensive and so minute as to enable me to feel any great assurance that I could deal better with evidence given before me on cross-examination than I can with these declarations. I should, in my turn, probably require to be assisted by some expert upon the matter.

I must adhere to the Comptroller's decision.

Re BROWNHILL. No. 7012 of 1887. 6 P. O. R. 135.

Application by *Brownhill* for a patent for "An improved gas-meter for supplying gas in exchange for coin or an equivalent."

Opposed by a Company on the ground of prior patents

of *Wallace*, No. 1963 of 1886, No. 15,631 of 1886, and No. 1620 of 1887.

The Comptroller decided to seal the patent without requiring a reference to the specifications of the opponents.

Appeal to the Law Officer. Decision affirmed, with costs (5 guineas).

Per CLARKE, Sol. Gen. It appears to me that the claims in *Brownhill's* patent, guarded and limited as they are, cannot be looked upon as infringing the patent of *Wallace*, without giving to *Wallace's* patent a larger interpretation and scope than it properly bears. I, therefore, decide to uphold the decision of the Comptroller.

GENERAL DISCLAIMING CLAUSE.

The next class of cases are those where the applicant's invention runs to an appreciable extent upon the same lines as some prior patented invention, and where a general disclaiming clause, referring to the state of public knowledge in the particular subject matter at the date of the application, is required to be inserted in the specification.

Such a general statement as to existing public knowledge does not of course injure a prior patentee, and accordingly the Law Officers have directed it to be put in rather with a view of protecting the public than for any other reason, and have expressed an opinion that when a patent is applied for the public may be entitled to know what a subsequent patentee can claim with reference to the then existing state of public knowledge.

It is probable that the following recent decisions may make this matter more clear:—

Re GUEST & BARROW. No. 1559 of 1887. 5 P. O. R. 313.

Application by *Guest & Barrow* for a patent, No. 1,559 of 1887, for "An improvement in velocipedes or cycles."

Opposed by *Laming* on the grounds:—(1) Report of interference of examiner with *Laming's* patent No. 12,901 of 1886. (2) That the spring joints claimed by applicant were identical with the spring joint claimed in the above-named patent.

The Comptroller decided to seal the patent subject to amend*ment of the 1st claim and the insertion of a disclaiming clause.*

The disclaiming clause required by the Comptroller was (omitting the words printed in italics) as follows:—

We are aware that various arrangements of cycles have been heretofore proposed, having either a jointed back-bone, or the frame divided into portions joined together *with one or more joints*. Such arrangements have been defective owing to the nature of the joint *or joints* used, and its *or their* position in relation to the various portions of the cycle, but we wish it to be understood that we make no general claim to the principle of preventing vibration in cycles by the introduction of joints or springs *into* the backbone.

The 1st claim was altered by the insertion of the words in italics.

Claim 1. Constructing the framework connecting the back and front wheels of velocipedes or cycles in two or more parts connected together by movable spring joints, *the front part carrying the front wheel or wheels, and the back part carrying the hind wheel or wheels and the crank axis being situated near to the axis of the joint,* substantially as and for the purpose hereinbefore described.

On appeal, upon the ground that the disclaimer and other alterations were not sufficient, the disclaiming clause was amended by the insertion of the words in italics, and the first claim was again altered by substituting the word *close* for *near,* and subject to these alterations the decision of the Comptroller was affirmed. No order as to costs.

Per WEBSTER, Att. Gen. I am clearly of opinion that all the opponent is entitled to is a disclaimer as to the existing state of knowledge.

I have on many occasions pointed out that the insertion of these disclaimers does not affect the rights of the prior patentee at all. They are inserted for the purpose of preventing the subsequent patentee from alleging that his invention is wider than he is entitled to claim, both in his own interests, in order that his specificatior may not be considered as being too wide, and in the interests of the public, on the ground that the public are entitled to know what a subsequent patentee may claim, and to have a fair description of the existing state of knowledge.

It is not because a particular patentee or a prior inventor has made a broad claim that he is entitled to have limiting words inserted, unless he can show, upon the fair view of the evidence, that such words are really necessary to protect him.

I have to consider what is the kind of disclaimer that ought to be inserted in the face of what is before me as regards prior knowledge; and it being proved that a joint and springs were not disclosed for the first time in Mr. *Laming's* specification, it would, in my judgment, be a wrong thing to call upon the present applicants to insert a specific reference to *Laming*. It might do them very great harm, because it might be said, you have referred to *Laming* and not referred to the others, and therefore it must be assumed that you intended to exclude the others, or did not know of the others.

I have never considered that a prior patentee has any right to be specially named, unless the applicants are willing to name him, and unless it is clear there is no other publication except the one that is mentioned.

The remaining objection is as to whether there ought to be an allegation allowed of defect.

As the specification only contains a statement of general knowledge, there cannot be said to be anything in the patent law to prevent a patentee, on the face of his specification, referring to the general defects, which, rightly or wrongly, he alleges to exist. The earlier patentees are not bound by this description.

Re SIELAFF. No. 2365 of 1887. 5 P. O. R. 484.

Application by *Sielaff* for a patent for "Improvements in automatic selling and lending apparatuses."

Opposed by *Everitt* as the grantee of a prior patent, No. 8408 of 1886, and by *Russell* on the ground of patents No. 7836 of 1884 (*Keeson*), and 3176 and 15,398 of 1886 (*Russell*).

The Comptroller required the insertion of the following disclaiming clause :—

"I do not claim broadly the use of a coin as the connecting and transmitting medium between the actuating and delivery mechanisms of an apparatus designed to deliver a measured quantity of liquid, or an article, in exchange for a coin deposited in such apparatus."

Appeal by *Everitt*, when the Comptroller's decision was affirmed with costs.

Per WEBSTER, Att. Gen. I think the Comptroller's decision was right and should be affirmed. Counsel has made a strong argument to show that the combination described by *Sielaff* in Figures 1 and 3, having regard to the inclusion of both modifications in one claim 5, is to be regarded as an infringement of *Everitt's* patent. I express no opinion upon that. I do not say whether I should adopt it or not, and it is not in the least for me, but I am clearly of opinion that there is far too much difference in the modifications described by *Sielaff* to enable the Law Officer to strike out or decline to allow a claim for that particular matter the subject of that subordinate combination.

I was a good deal impressed by the suggestion that this was after all only a different method of using an obvious modification of Figure 1 in *Everitt's* specification, but I am satisfied that *Sielaff's* arrangement may go much further. I do not say it does, because that is not for me. It may go further, and if it may go further it is quite evident that the Law Officer cannot stop the patent, because if he does any harm to *Everitt* in that position, *Everitt* has his full opportunity of bringing an action for infringement; and *Sielaff*, if it is an improved modification requiring invention, would be entitled to prevent others, including *Everitt*, from using it. I am by no means satisfied that *Everitt's* is the master patent. Looking at the claim "as described" I should doubt exceedingly whether it was a proper description to suggest that *Everitt's* was the first patent for connecting together two moving pieces of mechanism by a coin.

I think it is very doubtful whether the reference to *Everitt's* specification by name would be a sufficient protection either to the public or to the subsequent patentee, and I do not consider that *Everitt's* rights are in the least injured or affected by the allowance of *Sielaff's* application.

I therefore dismiss the appeal with costs (6 guineas).

The Attorney General further stated that it was desirable that each party should hand in to the official desk a statement of the fees which have been paid before the Law Officer.

Re HILL. No. 12,133 of 1886. 5 P. O. R. 599.

Application by *Hill* for a patent for "Improvements in wire ropes."

Opposed by *G. Elliot & Co.*, on the ground that the invention was covered by *Batchelor's* patent, No. 5724 of 1884, of which the opponents were licensees.

The Comptroller decided to seal the patent on the claims,

as submitted, being amended by the insertion of the words in italics, so as to read :—

" The particular combination of patterns or sections of wire *of suitable tensile and ductile qualities*, forming a strand or rope as described and clearly illustrated in each of the figures 1 to 12 of the accompanying drawings."

The opponents appealed, and counsel stated that they did not oppose the grant, but asked for a special disclaimer. Decision of the Comptroller affirmed with costs (3 guineas, which were reduced in amount for special reasons).

Per WEBSTER, Att. Gen. I am clearly of opinion that the representatives of *Batchelor's* patent, who are quite entitled to appear here, have no special rights entitling them to a disclaiming clause.

I frequently have to point out that a subsequent patent does no harm to a prior patentee, or those interested in a prior patent, but that for the interests of the public it is desirable that if the patents overlap, the distinction between the inventions described in the later and the earlier patents should be made clear upon the face of the decisions.

In order, therefore, to be entitled to a disclaiming clause, counsel must satisfy me that the description in *Hill's* specification in terms includes and purports to claim a part of the invention described in *Batchelor's* specification.

I do not express any opinion as to how far *Hill's* patent is good, or as to whether it is an infringement of *Batchelor's* patent. Very likely it is an infringement, and, if so, I am thankful to know that I am not depriving the opponent of any one of his rights, because the later specification will not make any difference.

I cannot see any reason, either on the ground of similarity of description, or manifest overlapping of the inventions, for the insertion of any special disclaimer, and therefore I shall confirm the Comptroller's decision.

Re COOPER & FORD. No. 1450 of 1885. Gr. P. C. 275.

Application by *Cooper & Ford* for a patent for "Improvements in knitting machines."

Opposed by *Rothwell*, the grantee of a prior patent, No. 8570 of 1884.

The Comptroller decided to seal the patent on condition that the applicants inserted in their specification an acknowledgment of the prior patent, and a statement that they did not claim anything therein contained.

And he further added an alternative proposition, *viz.*:—If the applicants will furnish me, within 14 days from date, with an amended specification which sets forth more explicitly what they intend to claim, I shall be happy to reconsider the case.

The applicants thereupon submitted to the Comptroller the following clause:—

"To the driving of the shaft D. by the loose driving-wheel N. and cone O., we lay no separate claim, as a friction-driving apparatus of this kind has been used before for driving the shafts of knitting machines."

The Comptroller accepted the amendment.

Appeal by the opponent on the ground that the amendment was not in accordance with the Comptroller's decision.

The objection was that the second alternative given by the Comptroller was inconsistent with the first part of the judgment, which was in itself definite and sufficient, and would have satisfied the opponent.

CLARKE, Sol. Gen., overruled the objection, but said that he would vary the order if the opponent could show that the amended specification did not sufficiently protect him.

The opponent then submitted that he was the first to adapt frictional driving-gear to knitting machines, and that he had patented the invention, which the applicants had taken *en bloc*. He asked that his patent should be named especially.

CLARKE, Sol. Gen., was of opinion that the words put in sufficiently protected *Rothwell*, and dismissed the appeal with costs.

SPECIAL DISCLAIMING CLAUSE.

We come now to cases where the applicant's invention trenches upon or overlaps to some extent the invention of a prior patentee who has been first in the field. It may be that the applicant's invention is a mere improvement on something which has gone before, but nevertheless he may be entitled to his patent, and the question of infringement is not before the present tribunal, and ought not to be entertained.

It follows that the relief which an opponent can obtain, short of stopping the patent altogether, is the insertion of a special disclaiming clause referring by number, date, and name of patentee, to the prior patented invention in which the opponent is interested.

Re HOSKINS. No. 8922 of 1884. Gr. P. C. 291.

Application by *Hoskins* for a patent for "Improvements in folding cots and hammock frames."

Opposed by *Needham* on the grounds (1) that the invention had been obtained from him, and (2) that the invention was already the subject of a patent, No. 3332 of 1883, granted to *Needham*.

The Comptroller was of opinion that both grounds of objection failed, and decided to seal the patent. Appeal to the Law Officer, who required the insertion of a disclaiming clause, and gave costs to the appellant.

Per HERSCHELL, Sol. Gen. All the elements which are to be found, and which are described, as far as I can see, as the essential elements of *Needham's* invention, are to be found in

what *Hoskins* has produced. Of course the parts differ, and the mode of carrying out the idea differs, but there is not a single idea to be found in the one that is not to be found in the other arrangement modified.

Can I allow, not as being an improvement or modification of the prior patent, but as an independent patent which the person taking it out is entitled to work independently, this apparatus or cot? I am satisfied that I cannot.

The disclaiming clause was settled as follows:—"This invention refers to improvements in the description of cots invented by *E. H. Needham*, for which invention a patent, No. 3332 of 1883, has been granted to him, and it consists, &c."

Re WELCH. No. 15,275 of 1884. Gr. P. C. 300.

Application by *Welch* for a patent for "Improvements in the utilization of a waste product (refuse slate), and in the manufacture of bricks, tiles, and other articles therefrom."

Opposed by a company, on the ground of a prior patent by *Evans*, No. 431 of 1878.

The Comptroller decided to seal the patent.

On appeal, the opponents offered to withdraw the opposition if the applicant would insert a disclaiming clause, but the applicant refused to accept the clause as submitted by the opponents.

Per WEBSTER, Att. Gen. I have had considerable doubt whether I should allow this patent to go, and I wish it to be distinctly understood that I give no opinion as to the validity of the patent.

I think there is ground for saying that *Evans*' specification may be read in such a way as to include the process which *Welch* has described, but if there is any doubt in the matter I think it is now the well-recognized practice that the doubt should be given in favour of the sealing of the patent.

I shall allow the patent to be sealed, but I shall require *Welch* to insert these words in his specification :—

"I am aware that the utilization of slate *debris* for the manufacture of bricks, tiles, and other articles is not new, and that a process for this purpose is described in the specification of *T. Evans*, dated 1st *Feb.*, 1878, No. 431, and I make no claim to the process therein described."

Patent sealed, no order as to costs.

Re TEAGUE. No. 15,973 of 1884. Gr. P. C. 298.

Application for a patent for "Improvements in rock drills," opposed by *Parnell* as grantee of a prior patent, No. 629 of 1878.

It appeared that for the purpose of explanation the applicant had described and illustrated in his drawings a complete rock drill, although the invention related only to a portion thereof.

The Deputy Comptroller required the insertion of a disclaiming clause referring specially to the opponent's patent.

On appeal, WEBSTER, Att. Gen., directed the excision of a portion of the disclaiming clause required by the Comptroller, or, in the alternative, directed that the specification should be altered by the omission of that portion thereof which described the shape of the valve port and the portion of the drawing which showed the valve and the sides of the piston with its ports, these being the parts in dispute.

The parties then agreed upon an amendment by the excision of a portion of the specification and drawings, and a patent was sealed on the amended specification.

Re NEWMAN. No. 3480 of 1886. 5 P. O. R. 271.

Application by *Newman* for a patent for "Improvements in pneumatic door-springs and checks."

Opposed by *Adams* as assignee of a prior patent, No. 4153 of 1880, granted to *Gossage*.

It was objected (*inter alia*) that the complete specification went beyond the provisional, and beyond the title.

The Comptroller decided to seal the patent, claim 4 being struck out by consent.

Appeal to the Law Officer, who required the insertion of a special disclaiming clause, which was settled as follows:—

"I am aware of the prior patent granted to *R. W. Gossage*, dated *Oct.* 13*th*, 1880, No. 4153, and I do not claim any thing described and claimed in the specification of that patent, and in particular, I do not claim the apparatus as shown and described with reference to Figures 15 and 25, nor do I claim the double-armed levers, *per se*."

Per WEBSTER, Att. Gen. I am not here to decide the validity or invalidity of letters patent. Nor do I consider that I am here to stop patents, and certainly not at the instigation of an opponent because there is some general principle of patent law which is infringed. I do not decide that in no case would such a point be taken notice of.

The Law Officers have always recognised that where there is an existing patent, and they can see fair ground for supposing that the construction of the later specification would interfere with the rights of the existing patent, the existing patentee is entitled to be protected.

I agree that a later applicant is entitled to say, "I have got an improvement, and I wish to claim my improvement, and leave you to your action for infringement."

I leave entirely to the applicant the question of whether he will consider the difference between the provisional specification and the final specification.

Respondent to pay costs (10 guineas).

Re NEWMAN, No. 9608 of 1886. 5 P. O. R. 279.

Application by *Newman* for a patent for "Improvements in pneumatic door checks and combined door checks and springs."

Opposed by *Adams* as grantee of a patent, No. 4447 of 1886, for "Improvements in springs for self-closing doors, and in checks for preventing slamming, and in the methods of adjusting the same."

The Comptroller decided to seal the patent.

Appeal to the Law Officer, who required the insertion of a special disclaiming clause as follows:—

"I am aware of the prior patent granted to *Robert Adams*, dated *March 30th*, 1886, No. 4447, and I do not claim any thing described and claimed in the specification of that patent, and in particular I do not claim the apparatus as shown and described with reference to Figure 35."

Per WEBSTER, Att. Gen.—I agree with the view taken by Lord Herschell (*Re* Hoskins, Gr. P. C. 291), that it is not the interest of subsequent patentees that their patents should be apparently for an original invention, when, as a matter of fact, they themselves admit before a Law Officer that they can only claim the particular combination which they have described, and also admit that there is a description of a more general combination which may or may not include the particular combination that they have invented.

Further, I have to consider the public interest; because it is certainly not for the interests of the public that they should be led into supposing that a description in a specification is entirely general, whereas it can only be supported as a specification of valid letters patent if the description is understood to be a description of improvement.

No order as to costs.

Re AIREY. No. 13,764 of 1886. 5 P. O. R. 348.

Application by *Airey* for a patent for "An improved auto-

matic height-measuring machine," opposed by *Stanley*, as grantee of a prior patent, No. 4726 of 1886.

Here a defective notice of opposition was amended by leave (see p. 9).

The Comptroller decided to seal the patent on the insertion of the following disclaiming clause :—

"I am aware of *Stanley's* patent, No. 4726 of 1886, for 'Machine for measuring the height of human beings automatically,' and I declare that I do not claim, broadly, a machine for measuring height automatically, nor actuating such a machine by means of a coin or the like, but what I claim is, &c."

On appeal, CLARKE, Sol. Gen., varied the disclaiming clause as follows :—

"I am aware of *Stanley's* patent, No. 4726 of 1886, for 'Machine for measuring the height of human beings automatically,' and I declare that I do not claim the mechanism therein described and claimed."

No order as to costs.

Re GOZNEY. No. 13,514 of 1886. 5 P. O. R. 597.

Application by *Gozney* for a patent for "A combined weighing and height-measuring machine."

Opposed by a Company on the ground that the invention had been previously patented in *Everitt's* patent, No. 16,433 of 1884, and *Salter's* patent, No. 6983 of 1886.

The Comptroller decided to seal the patent subject to the insertion of the following clause in *Gozney's* specification :—

"I do not claim as my invention the weighing machine described in the specifications of *Everitt's* patent, No. 16,433 of 1884, and *Salter's* patent, No. 6983 of 1886."

The opponent appealed, and asked that the disclaiming clause might follow that inserted in *Airey's* case, 5 P. O. R. 348.

The Law Officer amended the disclaiming clause, but gave no costs.

Per CLARKE, Sol. Gen.—It seems to me that the words as allowed by the Comptroller are not sufficient, because they say, simply, "I do not claim a specific weighing machine described in some other specification."

What a disclaiming clause is intended to guard against is the claiming in a new patent of something included in the claim of the old patent—not of something mentioned in the old patent, but of something which has not only been described in the old patent, but has been claimed as a part of the previous invention.

I shall vary the decision of the Comptroller by inserting the following clause :—

"I say that I am aware of the specifications of *Everitt's* patent, No. 16,433 of 1884, and *Salter's* patent, No. 6983 of 1886, and I do not claim the mechanism therein described and claimed."

Re LYNDE. No. 3251 of 1887. 5 P. O. R. 661.

Application by *Lynde* for a patent for "Improvements in weighing machines."

Opposed by a Company, on the ground that the invention had been previously patented by *Everitt*, on the applications No. 16,433 of 1884, and No. 10,680 of 1886.

The Comptrolier directed that the patent should be sealed.

Appeal to the Law Officer, who required the insertion of a disclaiming clause.

Per CLARKE, Sol. Gen.—I think it a matter of duty in these cases, where there appears to be a doubtful case, to take such a course as will protect the interest of both parties.

I am quite satisfied that a reference, in the words I will suggest, will not deprive Mr. *Lynde* of any rights which he has in consequence of the ingenious arrangement of the

electrical battery, but I believe it will have the effect of protecting him, and those who may deal with him in the matter of this patent from future litigation and difficulty.

I can only let these letters patent go on condition that Mr. *Lynde* inserts in the specification a statement:—

"I am aware of *Everitt's* patent, No. 16,433 of 1884, and do not claim anything claimed and described therein."

No order as to costs.

Re WALLACE. No. 1621 of 1887. 6 P. O. R. 134.

Application by *Wallace* for a patent for "Improvements in apparatus for the reception of coins, counters, cubes, or equivalents, and the delivery of articles, or imparting of information in exchange therefor."

Opposed by a Company on the ground that the invention had been previously patented by *Everitt*, No. 16,433 of 1884, of which the opponents were proprietors.

The Comptroller decided to seal the patent.

Appeal to the Law Officer, who required the insertion of the following disclaiming clause:—

"I am aware of *Everitt's* patent, No. 16,433 of 1884, and I do not claim anything claimed and described therein."

No order as to costs.

Per CLARKE, Sol. Gen.—In the year 1886 a patent was obtained by Mr. *Wallace* (No. 1963) and in his specification a reference was made to the patent No. 16,433 of 1884, which belongs to the opponent.

Now I look to the specification in the present case and I find—"The operation of the weighing mechanism is substantially the same as described in the specification of my said former patent, No. 1963 of 1886." Well, but if in this new specification we import anything which is contained in the former specification of 1886, I think it must be imported with the protecting reference which was assented to in that case.

APPLICATION REFUSED.

The next class of cases has reference to the refusal to grant a patent on the ground that the invention is not capable of being distinguished from some analogous invention which has been previously patented, and no doubt the identity between the two inventions must be complete or the patent will not be stopped.

It might be of advantage if cases of this kind were more frequently and more carefully reported. The instances now brought forward refer mainly to the absolute refusal to grant a patent without reservation of any kind. This severe treatment only occasionally occurs, though it is common enough for the Comptroller to excise certain claims or portions of the descriptive part of a specification, as in a recent case, which may be quoted first, inasmuch as it puts the principle of decision in an intelligible form.

Re WEBSTER. 6 P. O. R. 163.

Application for a patent for "Improvements in the construction of wire-ropes," opposed on the ground of prior patents for the same invention, viz., 4287 of 1876, 138 of 1879, and 14,183 of 1884.

It appeared that the invention consisted in making the strands of wire ropes *compound*, that is, laying some of the wires in a strand in one direction and some in the opposite direction. The claims were:

1. In the manufacture of wire ropes, the improvement consisting in making all the strands compound, &c.

2. The laying up into a rope *compound* strands, constructed and arranged as specified: one method being with the direction of the external wires of such strands to the right and left hand alternately.

It appeared that in No. 4287 of 1876, there was a claim for making wire ropes with ordinary strands laid to the right and left hand alternately.

The Comptroller required the excision of claim 2.

On appeal, decision affirmed, with costs (5 guineas).

Per WEBSTER, Att. Gen.—I am aware that, as a rule, the framing of the specification is a matter with which neither the Comptroller nor Law Officer ought to interfere except under very clear circumstances. If the compound strand be new it is amply protected by the first claim. In the event of the compound strand not being new, I am of opinion that it does not disclose any invention in the mode of laying up an old strand.

I think that where a patentee upon the face of both the provisional and final specification has disclosed a new element, as he clearly has here if this compound strand is new, and proceeds to use that in an old way without any invention in the mode of use, any person who is interested in a patent for the old way has a right to come forward and say: "This is a claim which ought not to be inserted in a specification unless there is a distinct claim to invention for the way in which this is proposed to be applied."

Re HEATH & FROST. Gr. P. C. 310.

Application for a patent, No. 6039 of 1885, for "An improved method of blasting and shot-firing in mines," opposed by *Settle* as grantee of a prior patent, No. 4945 of 1882.

Before the hearing of the opposition the applicants applied for leave to amend their specification.

The hearing of the opposition and application for amendment came on together, the amendment being taken first.

It appeared that the invention consisted in placing an explosive in a double casing, the space between the inner and outer cases being filled with water.

It also appeared that *Settle's* specification, No. 4945 of 1882, described and claimed the same thing.

The applicants now desired to limit their claim to a simple form of water-cartridge where the explosive was in direct contact with water, the inner casing being dispensed with.

The Comptroller refused the amendment.

On appeal, decision affirmed with costs, by CLARKE, Sol. Gen., who said that he could hardly imagine that the very simple expedient of putting an explosive into a shell without an inner case, when the inner case was not required, could be supposed by anyone to be the subject-matter of a patent.

The case went back to the Comptroller, who refused to grant a patent, on the ground that no invention, differing from that of *Settle*, was disclosed by the applicants.

Re HALL & HALL. No. 5619 of 1886. 5 P. O. R. 283.

Application for a patent opposed on the ground that the invention had been previously patented.

There were 4 claims and the Comptroller required the excision of claim 3.

The opponent appealed, but the applicant did not present a cross appeal.

At the hearing of the appeal the applicant asked to be allowed to amend claim 3, but CLARKE, Sol. Gen., said he could not entertain that question without consent, which was refused by the opponent.

Eventually, claim 2 was also struck out, and the decision was affirmed with costs (5 guineas).

Re AIRE & CALDER and GLASS BOTTLE WORKS & WALKER. No. 7074 of 1887. 5 P. O. R. 345.

Application for a patent for "An improved screw-stopper," opposed by *Barrett*, the grantee of a prior patent, No. 4184 of 1879.

Barrett's specification described a glass stopper with a conical shoulder just underneath the flat head, and having an indiarubber washer under the conical shoulder. The stopper was cylindrical below the conical part, and had a screw thread formed on it. The top of the neck of the bottle was coned to fit the stopper. A tight joint was obtained by means of the compression of the washer between the conical portions of the bottle and the stopper.

The applicant had a screwed stopper and an indiarubber ring, but the position of the ring was just under the head.

It appeared that *Walker's* provisional specification stated that the ring was "*formed round the upper part of the stem of the stopper,*" and in the complete specification the ring was described as being "*immediately under the head of the stopper.*"

The Comptroller decided to seal the patent on condition that the applicants limited their invention to placing the groove and ring "*immediately under the head.*"

On appeal, patent refused with costs (7 guineas), the costs being somewhat increased in order to cover the expense of the stamp on the notice of appeal.

Per WEBSTER, Att. Gen.—I am unable to see any subject-matter or patentable novelty in the point. I do not decide against *Walker* in any way on the ground of the apparent disconformity between his provisional specification and his complete specification.

I have grave doubt, having regard to the fact that, when *Walker* framed his claim originally, he framed it in these words, "formed round the upper part of the stem of the stopper," whether he ever intended to rely on what I may call the minute position of the groove with reference to the cap and the screw.

Re WALLIS & RATCLIFF. No. 9650 of 1885. 5 P. O. R. 347.

Application by *Wallis & Ratcliff* for a patent, opposed by *Livesey* as grantee of a prior patent, No. 1331 of 1881.

The Comptroller allowed a patent subject to the insertion of a disclaiming clause.

On appeal, patent refused, with costs (7 guineas).

Per WEBSTER, Att. Gen.—I am of opinion that I must decline to allow the application of *Wallis & Ratcliff* on the ground that there is no substantial difference between the two apparatus.

Re BAILEY. No. 13,397 of 1887. (Not reported.)

Application by *Bailey* for a patent for "Improvements in apparatus for working and making up butter," opposed by *Maude* as grantee of the prior patents No. 2992 of 1884 and No. 9687 of 1885.

The invention was for expressing milk from a mass of butter and forming it into measured pats without any handling.

The butter was put into a square box and compressed by a screw actuating a square plunger, whereby the butter-milk was squeezed out through small holes in a slide at the end of the box. Afterwards another slide with an opening was employed and the butter was squeezed out in the form of a cylinder into a trough and measured lengths were cut off.

It appeared that *Maude* had done precisely the same thing in a machine capable of compressing a larger quantity of butter, and except that the vessel containing the butter was cylindrical and not rectangular, and that the screw was worked, not directly by hand, as in *Bailey's* press, but by the intervention of a pinion and wheel giving increased power, there was no difference in the construction and operation of the two contrivances.

The Comptroller refused to seal the patent.

Re DANIEL. 5 P. O. R. 413.

Application by *Daniel* for a patent for "Improvements in

kettles, pans, or similar vessels for heating water," opposed by *Stanley* as grantee of a prior patent, No. 7244 of 1887, for "Heat conductors for baking and boiling."

Here a defective notice of opposition was amended by leave (see page 9).

The invention was for inserting in the bottom of the vessel a tube or dome (marked B.), open at the bottom and extending into the interior of the vessel.

The specification of *Stanley* stated:—For baking I form in the centre of the tin or dish a hollow cone (marked A.) preferably made of copper, which rises with its base upon and from the lower surface.

For boiling water I form a similar metal hollow cone in the bottom of a pot, saucepan or kettle. The cones here described may be varied in form, and the apices may be enclosed or open so that the form inscribes a conical area.

Some of the drawings showed a cone and others a conic space like the top of a sugar loaf.

Claim.—The manufacture and use of an open cone, or a form which encloses a conic space, placed in the bottom of a vessel to be used for baking or boiling, substantially as described and illustrated in the accompanying drawings.

The Comptroller refused to grant a patent.

On appeal, decision affirmed with costs (2 guineas).

Per WEBSTER, Att. Gen.—In my opinion the decision of the Comptroller was right. Counsel has argued the case very fairly, and contends on behalf of Mr. *Daniels* that, as he is willing on behalf of his client to put words into the claim excluding any form which would represent the cone, to which he contends the specification of Mr. *Stanley* is confined, he is entitled to letters patent. In my opinion, having regard to the interests of the public, it would be an improper thing to allow this patent to go.

I have looked carefully at the specification and I have asked

counsel to give me assistance in the matter—which he would have done if he could—to see whether there is any part of the specification which indicates any difference in operation or function due to the fact that the top of the space A. or B. in the two pictures is rounded instead of being angular.

I notice that this is a complete specification, filed in the first instance; and without intending to express any definite opinion, it would certainly seem that Mr. *Daniels*, who no doubt might have invented this independently, was unaware when he filed his complete specification of anything that had gone before, and thought he was patenting that which would have been a novelty, and a complete novelty, had there been no previous specification.

When I look at the description of the invention in Mr. *Stanley's* specification, it seems clear that the whole ground is covered. It is quite true the word "cone" is used, but if the figures are looked at it will be observed that, except that there are angles at the top of the space, the whole function of that which is proposed to be accomplished by Mr. *Daniel's* invention is practically described in Mr. *Stanley's* specification.

We conclude this chapter by quoting an observation made by WEBSTER, Att. Gen., in *Re* Anderton (*ante*, p. 25), which should be carefully borne in mind both by applicants and opponents, namely:—

"It is exceedingly important, especially before the Comptroller, who cannot cross-examine witnesses, that there should be the fullest good faith in the statements made."

CHAPTER II.

AMENDMENTS.

It only remains, in this concise notice of cases, to treat of the subject of amendment of the specification of a patent under sect. 18.

By sub-sect. (1) the amendment may be by way of disclaimer, correction, or explanation, and the applicant must state the nature of such amendment, and his reasons for the same.

By sub-sect. (2) the request and the nature of the proposed amendment must be advertised in the prescribed manner, and at any time within one month from its first advertisement any person may give notice at the Patent Office of opposition to the amendment.

By Rule 49, a notice of opposition to an amendment must state the grounds of opposition, and must be *signed* by the opponent, and state his address for service.

Rule 51 gives a period of 14 days after the expiration of one month from the first advertisement of the application for leave to amend, for filing declarations in opposition.

By sub-sect. (8) the amended specification must not "claim an invention substantially larger than or substantially different from the invention claimed by the specification as it stood before amendment."

There are but few cases on this subject which are useful for reference. The amendment of a specification is frequently an intricate matter, which can only be understood when the facts of the case as to the state of prior public knowledge, and as to

the method of carrying out the invention, are fully before the reader. Under official protection, the reports of cases of this kind are now much improved, and ere long it may become possible to enter fully into the niceties of argument and discussion which appertain to this part of the subject, but at present the writer feels constrained to deal with this portion of the inquiry in a brief and certainly not an exhaustive manner.

Where any principle, for the guidance of others in future applications, is laid down in the judgments, that will be as far as possible preserved.

It will be seen that in the case of the amendment of patents granted prior to the time when the Act of 1883 came into operation, the rule is to impose a condition that no action shall be brought for infringements taking place prior to 1*st Jan.*, 1884; and that where the application for amendment relates to patents granted subsequently to this date no condition is imposed, but the applicant is left to any relief which may be accorded to him, under sect. 20, at the trial of an action.

Sect. 20 is the following:—

Where an amendment by way of disclaimer, correction, or explanation, has been allowed under this Act, no damages shall be given in any action in respect of the use of the invention before the disclaimer, correction, or explanation, unless the patentee establishes to the satisfaction of the Court that his original claim was founded in good faith, and with reasonable skill and knowledge.

Re HEARSON. 1 P. O. R. 213.

Application by assignees to amend the specification of a patent, No. 1419 of 1881, under leave of the Court in an action for infringement (sect. 19).

The Comptroller granted leave unconditionally.

On appeal, the following order was made:—

Application allowed on condition that the applicants shall

not bring any action or take any proceeding in respect of an infringement of the patent prior to the 1*st Jan.*, 1884; this condition to be without prejudice to the pending action or any question arising therein. No costs of the appeal.

Per HERSCHELL, Sol. Gen.—The Attorney General and I considered this point some little time ago, and we considered it a matter not without doubt, owing to the wording of the sections of the Act, but we came to the conclusion that the Comptroller had power to impose conditions on giving liberty to amend a specification by way of disclaimer.

I have, after consultation with the Attorney General, arrived at the conclusion, that, as a general rule and apart from exceptional circumstances, it is proper that when desired a condition should be imposed that no action shall be brought or other proceeding taken for any infringement prior to 1*st Jan.*, 1884.

Re HADDAN. Gr. A. P. C. 12.

Application for a second disclaimer to part of a specification, No. 2003 of 1878, which was opposed.

The disclaimer was allowed by the Comptroller, and, on appeal, the order was affirmed, without costs.

WEBSTER, Att. Gen., said it was very important that there should be uniformity of practice, and in the absence of special circumstances, he should adhere to the rule laid down by the former Law Officers, and direct that no action be brought in respect of infringements prior to 1*st Jan.*, 1884.

Re CHEESBROUGH. Gr. P. C. 303.

Application to amend the specification of a patent, No. 4847 of 1878.

Amendment allowed by the Comptroller. No action to be brought for infringements prior to 1*st Jan.*, 1884.

It appeared that certain words, "*and purifying the same*,"

were objected to by the opponents when before the Comptroller, and were struck out.

On appeal, the opponents objected that the original notice as advertised did not state that these words should be struck out, and that they could not be excised; but HERSCHELL, Sol. Gen., said that the opponents, having taken objection to the retention of these words when before the Comptroller, could not now object to their omission.

Decision affirmed, when two questions were raised upon the terms of the order :—

(1) Whether the continued use of lamps made by the opponents prior to 1*st Jan.*, 1884, was protected, and the Sol. Gen. *held* that such user was protected.

(2) Whether protection should be given to lamps in stock and unsold prior to 1*st Jan.*, 1884, and the Sol. Gen. *held* that such lamps should be protected, and observed :—If the opponents had been making lamps after notice that the patentee was going to disclaim, there would be a good deal to be said for not protecting them, but if the lamps were made before the opponents had any idea of a disclaimer on the part of the patentee, the equity of the thing would seem to be rather in favour of their being protected.

Re WESTINGHOUSE. Gr. P. C. 315.

Application for leave to amend the specification of a patent, No. 1540 of 1874, for "Improvements in apparatus for working breaks and communicating signals on railway trains," opposed by several railway companies, against one of which an action had been brought, but discontinued.

On 2*nd March*, 1885, the Comptroller allowed the amendment, subject to terms.

On appeal, JAMES, Att. Gen., allowed the amendment as

from the *2nd March*, 1885, subject to conditions which were to the following effect:—

1. No action for infringement in respect of apparatus made and fitted prior to *1st Jan.*, 1884.
2. Opponents to give particulars of all brake apparatus fitted and applied prior to *1st Jan.*, 1884, and of any changes in such apparatus except mere renewals.
3. Nothing herein contained to limit the scope of the order in the action.
4. The applicant, within 8 weeks, to deposit in the Patent Office an undertaking to accept the amendment upon the above conditions.

Re ALLEN. Gr. A. P. C. 3.

Application for leave to amend the specification of a patent, No. 12,505 of 1885, under leave of the Court in an action for infringement.

The Comptroller refused to allow the amendment. On appeal, this decision was over-ruled, and a question arose as to the terms on which the amendment should be granted.

CLARKE, Sol. Gen., refused to impose any condition as to the bringing of actions for infringements prior to the date of the amendment and said:—

This appears to be the first case in which the question has come up for decision in respect of patents issued since the passing of the Act of 1883. . . . This patent was dated *20th Oct.*, 1885, and if after amendment any action is brought for a prior infringement it is clear that the Court will have to decide whether the matters referred to in sect. 20 have been established to its satisfaction. I do not think that I am entitled to substitute my opinion for that of the Court.

Re COCHRANE. No. 5003 of 1885. Gr. P. C. 304.

Application for a patent opposed on the ground of a prior patent, No. 3812 of 1880.

The applicant also applied for leave to amend, under sect. 18, before the day fixed for hearing the opposition.

The invention related to the construction of moulds for receiving molten slag from blast furnaces, and consisted in constructing cores for such moulds of an angular or wedge shape.

The specification stated:—"Although I prefer to make the part A. (of the core) of a rounded shape, yet it will be evident that it may be of other configuration, so long as the angular or wedge shape of the part A. is retained."

By the amendment it was proposed to excise a paragraph in the specification, and to vary the claim by inserting the words in italics.

Claim: Constructing cores for slag moulds of an angular or wedge shape *on the one side and of rounded shape on the opposite side*, whereby they are made to operate with a wedging action upon the slag, and to effect the complete discharge thereof substantially as herein described.

The hearing of the opposition and amendment coming on together, the Comptroller took the amendment first.

It was objected that the opposition was a "legal proceeding" within the meaning of sect. 18, sub-sect. (10), and that the amendment could not be heard, but the Comptroller held that the sub-section did not relate to "*proceedings*" before him, but only to "proceedings" in Courts of Law, after the sealing of a patent.

The Comptroller allowed the excision of the paragraph, but refused the amendment of the claim.

On appeal, the amendment of the claim was allowed with costs (5 guineas).

Per DAVEY, Sol. Gen.—It seems to me that if the original specification claims all angular or wedge-shaped slag boxes,

and then words are put in which confine it to the angular or wedge-shaped boxes which have a rounded back—the invention is thereby confined to a particular class of slag box which was included with a number of other slag boxes in the previous claim.

Re CODD. No. 3070 of 1870. Gr. P. C. 305.

Here the patentee, *Codd*, had brought separate actions for infringement against A. and B., and in the action against A. he had obtained leave to apply to amend his specification under sect. 19. He now applied accordingly.

The Comptroller, being informed that the action against B. was still pending, refused to hear the application.

Subsequently, the leave of the Court to apply for amendment was obtained in the other action, and the application was renewed.

Opposition being entered, it was objected that the opponents had no *locus standi;* inasmuch as the notices of opposition were not *signed* by the opponents as required by Rule 49.

It appeared, however, that the Comptroller had allowed these notices to be signed subsequently under the powers granted to him by Rule 18, and the objection was overruled.

The amendment was then allowed upon terms.

Re ASHWORTH. Gr. A. P. C. 6.

Application to amend the specification of a patent granted to *G. & E. Ashworth*, No. 3513 of 1878, for "Improvements in wire cards and in the preparation and treatment of wire therefor, &c.," which was opposed by several parties.

The specification stated:—Our invention relates in the first place to wire cards employed in carding cotton and other fibrous substances. To this end we employ steel wire which has been rendered as hard as is consistent with its being bent in the usual manner in the card-setting machine.

A second part of our invention consists of special means for hardening and tempering the wire. We draw the wire in a straight line through a gas flame or line of gas flames, and then through a bath or stream of oil, and then through a carefully regulated gas flame or line of gas flames, in order to burn off the oil to some extent and thereby to impart the required temper. The wire is then conducted to a drum upon which it is wound.

The amendments were confined to claims 1 and 2, which were the following :—

Claim 1.—The manufacture of the dents or teeth of cards from a continuous length of hardened and tempered steel wire as set forth and indicated hereinbefore in and by the accompanying drawings.

It was proposed to alter claim 1 so that it should read, ". . . a continuous length of steel wire hardened and tempered in the manner substantially as set forth, &c."

Claim 2.—Hardening the wire for cards by drawing it through a gas flame and passing it instantaneously into a bath of oil or other matter.

It was proposed to alter claim 2 by inserting the words "substantially as set forth and indicated," after the words "other matter."

The Comptroller allowed both amendments.

On appeal, DAVEY, Sol. Gen., affirmed this decision and said :—I think there is enough, when read with the context, without expressing any concluded opinion, which I have no right to do, to justify me in allowing the amendment to be made in the 1st claim.

With regard to the 2nd claim : The object of these words—whether they were necessary or not, I express no opinion—seems to me to be to restrict, and not enlarge or make the invention different.

The only other point is this : what condition should be

annexed to the amendment? I invited a statement of any circumstances which were supposed to arise in the present case.

If the patentees had been threatening persons, and endeavouring to prevent persons from making or selling wire hardened and tempered in a mode different from that which was claimed, I should consider that a special circumstance. But there is nothing of that kind here.

The Solicitor General then directed that no actions should be brought for infringements committed prior to 1*st Jan.*, 1884, and gave no costs of the appeal.

Re PIETSCHMANN. Gr. P. C. 314.

Application to amend the specification of a patent, No. 7756 of 1884, for "Improvements in barrel organs," opposed by *Ehrlich*.

It appeared that several amendments were applied for, some of which were abandoned, and the Comptroller allowed the amendments on condition that the applicant paid 10 guineas as compensation to the opponent.

The applicant appealed, on the ground that the Comptroller had no power to make such an order.

Per WEBSTER, Att. Gen.—If the opponent is wholly successful, he cannot get costs, and it seems to me to follow that, if partly successful, the Comptroller has also no power to give him costs.

Decision varied by striking out the order for the payment of 10 guineas. No costs.

Re JONES. Gr. P. C. 313.

Here a complete specification was lodged 9 months after the application for provisional protection.

Ten weeks later, but prior to the acceptance of the complete specification, the applicant applied for leave to amend. The

case went before WEBSTER, Att. Gen., who held that any proceedings for amendment should be taken under sect. 18.

Re DART. Gr. P. C. 307.

Here provisional protection was granted for an invention with the title "Improved means for regulating the action of dynamo-electric machines *and motors*."

At the expiration of 8 months a complete specification was lodged, in which the words "and motors" were struck out. The Comptroller refused acceptance without amendment.

WEBSTER, Att. Gen., held that the proper course was either to give the applicants the option of filing the specification with the original title, and inserting a disclaiming clause, or to allow them to amend the original title in the application and provisional specification, and said:—

The question of the amendment of title is not directly dealt with by any section of the Act. If the applicant merely desires to omit part of the invention described in the original title and provisional specification, I do not see that any amendment of the title and provisional specification is of necessity required, as I think that a proper disclaiming clause might be inserted in the complete specification.

And he further observed that it was open to the Patent Office, under the powers of sects. 7 and 9, to permit the original application and provisional specification to be amended by striking out the part which it was no longer desired to retain, but that such amendment should be confined to excision, and should not extend to explanation.

The amendment not being made under sect. 18, no fee was chargeable.

Re ARNOLD. Gr. A. P. C. 5.

This was a second application for leave to amend the title and specification of a patent, the first application having been refused by the Comptroller, and not appealed against.

The Comptroller again refused leave, and on appeal the facts became known to WEBSTER, Att. Gen., who considered that the amendment now sought was substantially the same as that originally applied for; and no sufficient reason being shown for allowing the first decision to remain unquestioned, he dismissed the appeal.

Re MORGAN. Gr. A. P. C. 17.

This was an application for leave to amend the specification of a patent, No. 2892 of 1876, by inserting a sufficient description of Fig. 3, which had not been properly described, and by inserting at the end of a claim already concluding with the words "substantially in the manner described," the additional words "*and as illustrated in the accompanying drawings.*"

The Comptroller refused both amendments.

On appeal, WEBSTER, Att. Gen., allowed the first amendment, but refused the second, holding that the claim, as it stood originally, was sufficient.

No order was made to return the fee on the notice of appeal, this being a case which the Comptroller had rightly left to the Law Officer.

Re NORDENFELT. Gr. A. P. C. 18.

Application for leave to amend the specification of a patent, No. 8269 of 1885, for "Improvements in the manufacture of castings from wrought iron and steel." The invention related to the admixture of a small quantity of aluminium or its alloys with molten iron or steel shortly before the metal was poured, whereby it was said that the metal gained in fluidity, and was better adapted for casting.

The specification stated that the addition of the aluminium or alloy should be made to the molten metal shortly before it was poured, and that, "*The addition might, however, be made earlier.*"

By amendment it was proposed :—

(1) To strike out the words in italics.

(2) To introduce a long explanatory clause ending with a statement of proportions of the metal, aluminium, which would suffice to produce the result.

The Comptroller refused both amendments.

On appeal, WEBSTER, Att. Gen., allowed the excision of the words in question, it being clear that this alteration did not extend the claim, but refused the other amendment, and said : —Before the patentee can insert anything into a description, which, if the invention were new, was sufficient, and if not new, open to serious objection, I think he must show that there is a real reason for requiring it. The principle of his invention was, in my opinion, amply described in his original complete specification.

Re HAMPTON & FACER. Gr. A. P. C. 13.

Application to amend the specification of a patent, No. 8981 of 1885, for "Improvements in the method of casting steel ingots," opposed by *Melling*, the grantee of a prior patent, No. 13,022 of 1884.

The applicants desired to make certain amendments on which no contest arose, and at the same time to insert a statement, by way of disclaimer, which ended by imputing disadvantages to all formerly used or patented methods of the kind described and claimed by *Melling*.

The Comptroller refused to allow the insertion of this statement by way of amendment.

On appeal, the applicants applied for leave to file evidence to show that *Melling's* invention had been in use before the date of his patent, which was refused, and the opponent asked that his patent should be specially referred to.

CLARKE, Sol. Gen., was of opinion that a general disclaimer in the following terms was sufficient :—

"We do not claim the casting of steel ingots simultaneously through centrally situated nozzles or outlets."

As to insertion of the statement above referred to, the Solicitor General refused to allow it to stand, on the ground that he was not at all satisfied that the faults, imputed to methods formerly used or patented, did in reality exist.

Decision affirmed without costs.

Re LAKE. Gr. A. P. C. 16.

Application to amend the specification of a patent, No. 4387 of 1886, for "Improvements in and relating to the manufacture of colouring matters," by altering part of the description of the process without amending the claim.

The Comptroller refused leave on the ground that the amended specification claimed an invention larger than or different from that claimed before amendment.

On appeal, WEBSTER, Att. Gen., allowed the amendment, on the ground that, on the information before him, he was unable to see that the amendment extended the grant. In any question of doubt it was not, in his opinion, the duty of the Law Officer to disallow an amendment, because he might thereby deprive a patentee of valuable rights, but the patentee took the amendment at his peril. The fact that the claim was not altered was not conclusive, inasmuch as the words of the claim might be large enough to include any mode of production referred to in the specification.

The Attorney General gave no costs, the amendment being unopposed, and said that in the absence of very special circumstances the Comptroller should neither give nor receive costs.

Re BECK & JUSTICE. Gr. A. P. C. 10.

Application to amend the specification of a patent, No. 4114 of 1887, for "Improvements in nozzles for the escape of steam or gases under pressure," by inserting (*inter alia*) a statement

relating to the exhaust of *gas engines*, there being no mention of gas engines in the specification.

The Comptroller refused to allow this amendment, and, on appeal, his decision was affirmed.

WEBSTER, Att. Gen., said that he was dealing with a comparatively old specification, and the amendment was admittedly necessitated by the development of the gas engine. He thought the function of an explanation under sect. 18 was to explain the meaning of the patentee at the time he patented the invention, and not to put in subsequently acquired knowledge.

Re SERRELL. 6 P. O. R. 101.

Application to amend the specification of a patent, No. 14,983 of 1886, for the "Application of a solenoid for reinforcing electrical contacts."

The specification stated:—"My invention consists in reinforcing the actual contact between two contact pieces of an electric circuit by means of a solenoid," and it went on to describe the apparatus, showing the contact pieces and their operation by reference to drawings.

The contact-pieces were peculiar, one being swung upon a pivoted lever, the other being movable by the action of a core of soft iron within the solenoid, whereby a scraping and cleaning action occurred between the curved surfaces of the contact-pieces.

Claim.—The employment of a solenoid, X., and core, A., for the purpose of reinforcing the contact between the contact-pieces, C. C., of a electric circuit.

The applicant sought to amend (1) by altering the title to "Improvements in electrical contact devices"; (2) by stating:—My invention consists of an improved electrical contact device, the main purpose of which is to keep the contact-pieces clean; (3) by claiming:—"The production of a

scraping, and consequently cleaning motion between the contact-pieces, C. C., &c."

The Comptroller refused to allow the amendments, but indicated others which he would accept.

On appeal, WEBSTER, Att. Gen., affirmed this decision, and said:—I think it would be beyond what is intended by the power of amendment under the Act of 1883, that there being a distinct and specific claim to the operation of what is believed to be new, and there being no claim to the minor arrangement of the contact-pieces, the patentee should be allowed to strike out the whole of his claim and insert an independent claim to a subordinate part.

Re RYLANDS. 5 P. O. R. 665.

Application for leave to amend the specification of a patent, No. 4897 of 1883.

The invention related to the formation of grooves or channels round wooden packing cases wherein to fit the binding iron hoops or wires used for strengthening the boxes or cases.

The specification stated:—that the hoop iron or wire may be nailed down or that small wire loops with pointed ends *may be* used instead of nails.

One amendment restricted the claim to the securing of the hoops or wire *by means of loops*.

No declarations were lodged, but nevertheless the Comptroller allowed the amendment.

On appeal, decision affirmed, with costs (5 guineas).

Per WEBSTER, Att. Gen.—The essence of the invention is putting the wire in the grooves; and under these circumstances I see no reason why the patentee should not limit his claim, provided he does it in clear language, to the fastening by means of loops.

It is said that I ought not to allow this amendment because there is no declaration: but I am of opinion that if, on the

face of the specification, it is quite clear that the specification is capable of two constructions, it is open to a person applying to satisfy the Law Officer or Comptroller on the face of the specification that he desires to limit the claim to one construction to which the specification is open.

It remains to notice a section of considerable importance to applicants for patent rights in foreign countries, viz., sect. 103 of the Act of 1883, which is quoted as amended by the Act of 1885.

Sect. 103, sub-sect. (1.)—If Her Majesty is pleased to make any arrangement with the government or governments of any foreign state or states for mutual protection of inventions, then any person who has applied for protection for any invention in any such state, shall be entitled to a patent for his invention under this Act, in priority to other applicants; and such patent shall have the same date as the *date of application* in such foreign state.

(By the Act of 1885, the words "date of application" are substituted for the words "date of the protection obtained" in the Act of 1883.)

Provided that his application is made, in the case of a patent, within seven months from his applying for protection in the foreign state with which the arrangement is in force.

Provided that nothing in this section contained shall entitle the patentee to recover damages for infringements happening prior to the date of the actual acceptance of his complete specification.

And sub-sect. (3) directs that an application for the grant of a patent under this section shall be made in the same manner as an ordinary application under the Act.

A reported decision is the following:—

Re Everitt. Gr. A. P. C. 28.

Re L'Oiseau & Pierrard. Gr. A. P. C. 36.

These were applications for patents by concurrent inventors for substantially the same invention.

Everitt's application was dated 20*th Aug.* 1886.

L'Oiseau & Pierrard's application was dated 8*th Oct.* 1886, but, it appearing that a patent had been granted on *Aug.* 18*th*, 1886, to the applicants in France for the same invention, they now asked that, under the provisions of sect. 103, their English patent, when granted, should bear date 18*th Aug.*, 1886.

The Comptroller refused to take notice of the French patent as the same was not in evidence, and required amendment of the specification.

On appeal, WEBSTER, Att. Gen., gave leave to the applicants to file evidence as to the existence of the French patent, on payment of costs.

Such evidence being adduced, the patent was ante-dated to 18*th Aug.*, 1886, without amendment.

In this case, both the Comptroller and the Attorney General held that *Ercritt* was entitled to oppose on an accepted specification (*ante*, p. 16).

In the opposition to *Ercritt's* application the Comptroller held that *L'Oiseau & Pierrard* had no *locus standi* to oppose; and on appeal, this decision was affirmed.

In giving judgment, WEBSTER, Att. Gen., said—We have this state of things, that you can have a completely valid and effective English patent, and seven months may elapse before the application may be made, founded on the foreign application of earlier date, and the later applicant may be entitled to have a good patent sealed which will over-ride the English patent, though granted and sealed prior to the application under sect. 103.

And the Attorney General further said, that in his opinion although the foreign applicant gets most valuable rights, he does not get the right of opposing a later patent.

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