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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SWEET & MAXWELL, LIMITED, 3, CHANCERY LANE.

PATENT PRACTICE

BEFORE THE COMPTROLLER AND THE LAW OFFICERS,

WITH AN

ABSTRACT OF REPORTED CASES,

AND

APPENDIX I.

BRINGING THE CASES DOWN TO THE END OF THE YEAR 1892.

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.

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. 8178 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, *Lowcock* on *3rd Dec.*, 1885, *Green* on *2nd April*, 1886.

The contention of the applicant was that his provisional specification, which was of earlier date than *Lowcock's* complete specification, described fully the parts objected to, and that such parts were not specially described in *Lowcock'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 applicant 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 of 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. 33), 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 *Jones'* 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.

16 RPC. 233.

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. 16 RPC. 233

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 Welsbach'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 Welsbach*, 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 amendment 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 specification may not be considered as being too wide, and in the interests of the public, on the ground that the public are entitled to know what a subsequent patentee may claim, and to have a fair description of the existing state of knowledge.

It is not because a particular patentee or a prior inventor has made a broad claim that he is entitled to have limiting words inserted, unless he can show, upon 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. 8403 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 specially.

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 Comptroller 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. *Danicls*, 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. *Danicl'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 2*nd 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 1*st Jan.*, 1884.
2. Opponents to give particulars of all brake apparatus fitted and applied prior to 1*st 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 20*th 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 *Everitt* was entitled to oppose on an accepted specification (*ante*, p. 16).

In the opposition to *Everitt'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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THE END.

BRADBURY, AGNEW, & CO., PRINTERS, WHITEFRIARS.

PATENT PRACTICE.

FIRST APPENDIX.

Re GRIFFIN. Nos. 10,457 and 10,458 of 1887. 6 P. O. R. 296.

Application for patents for "Improvements in india-rubber compositions" and for "The manufacture of soft or spongy material from rubber compounds," as communications from abroad by *Henderson*.

Opposed by *Wood* on the ground that the applicant had obtained the inventions from the opponent.

It appeared that *Griffin* was chairman of a company and the allegation was that the opponent (Mrs. *Wood*) furnished certain information relating to the inventions at divers meetings of the directors, and of a committee at which *Griffin* was present, such information being subsequently made use of by *Griffin* for the purpose of applying for the above-named patents.

The Comptroller decided to seal both patents.

On appeal, decision reversed, with 5 guineas costs.

Per CLARKE, Sol. Gen. If I had any doubt I should, of course, decide in favour of Col. *Griffin*, partly because I should desire to follow the decision of the Comptroller, and partly because of the consideration which has been mentioned in the course of the argument that my decision against Col. *Griffin* would absolutely stop these patents. But I have not the slightest doubt in the world.

There are matters here which are of extreme importance, and seem to me to leave no doubt whatever as to what my decision should be. Col. *Griffin* says, "these communications were made to me from America," and no communication is produced. There is no statement at all as to the date on which he received these communications, nor does he refer to any note or letter or memorandum of any sort or kind in his possession, which establishes the fact that he got these communications in substance from abroad.

The Solicitor General having further commented on the evidence, decided that the patents should not be sealed, and gave 5 guineas costs to cover both cases.

Re ATHERTON. No. 12,441 of 1887. 6 P. O. R. 547.

Application for a patent for "Improvements in coating, plating, or napping felt hat bodies."

Opposed by *Cheetham* as grantee of a prior patent, No. 2,014 of 1887.

The invention consisted in obtaining a coating of fur upon the bodies of hats by treating them in hot water charged with fur cut in short lengths.

The Comptroller ordered certain amendments to be made in the specification.

On appeal, WEBSTER, Att. Gen. directed that claim 6 should be struck out as being practically the same as claim 3.

There being a statement in the specification as to prior knowledge with reference to the coating of hat bodies with fur, the Attorney General said :—

There is no objection to the patentee inserting (provided he does it fairly) what he believes to be a statement of prior knowledge. It is, in my opinion, a very convenient course.

But I object to any one putting in his construction of written documents, because, in my opinion, written documents have to speak for themselves or be interpreted by the Court.

The statement finally inserted by the patentee with the approval of the Attorney General was the following:—

"In processes of coating felt or cloth with fur or wool heretofore in use, and to which I make no claim, the short fur or wool has been felted into the hat or body by treatment in a fulling, bumping, milling, or other similar felting machine, or by rollers which rub and press the fabric, or by hand planking. Illustrations of such processes are to be found in the Specifications of *Cresswell and Lister* (No. 1,350 of 1860); *Weiss* (No. 2,031 of 1860); *Newton* (No. 1,580 of 1868); *Hinchliffe* (No. 2,056 of 1873); *Rhodes* (No. 16 of 1875); and *Cheetham* (No. 2,014 of 1887). According to my improved process, I secure the incorporation of the coating material into the surface of the body or fabric without any treatment in the nature of beating, rolling, or planking, and such methods of treatment are not within the scope of my invention."

Re LAKE. No. 11,318 of 1887. 6 P. O. R. 548.

Application for a patent for "Improvements in the manufacture of alpha-naphthol disulpho acid, and in the production of colouring matters therefrom."

Opposed by the *Badische Anilin und Soda Fabrik*, on the ground that the invention had been patented in the prior patents, Nos. 6872 and 9808 of 1884, and 5305 of 1879.

Opposed also by *Levinstein* on the ground of prior patents, Nos. 5692 of 1882, 6872 and 9808 of 1884, and 15,775 of 1885, for the same invention.

The specifications finally relied on by the opponents were No. 5692 of 1882 (*Levinstein*), and No. 5305 of 1879 (*Johnson*).

The Comptroller decided to seal a patent subject to the insertion of a disclaimer embodying a description of the process of preparing sulpho-acids of alpha-naphthol given in *Levinstein's* specification No. 5692 of 1882.

On appeal, decision affirmed with costs (20 guineas).

Per CLARKE, Sol. Gen. The first question for me to decide is, whether I am to exercise my power of having an expert to advise me with regard to the matters which are here in discussion and dispute. Whatever advice that expert gave me upon the matter, it would have to be my judgment, and the responsibility of that judgment is a considerable one in a case of this character, and I do not think that even if advised by an expert I should consider it right, in view of a strongly controverted question of scientific anticipation, to decide that in a way which would put a stop to the patent now asked for. I think such a question, if it is to be discussed at all, should be discussed elsewhere, where the evidence can be more thoroughly dealt with.

Well then, if I am not to have an expert, and I do not think it worth while to have one, the question is what to do with this proposed patent of *Lake?*

The Solicitor General then discussed the effect of the prior patents of *Levinstein* and *Johnson*, and further said:—

Looking at the whole circumstances of the case, I think I ought not to interfere with the Comptroller's decision.

I think, seeing that the result of deciding the other way would practically be to stop this patent altogether, I cannot take upon myself to discharge so serious a duty as that, but must leave it to be determined in other ways. I shall certainly give costs, as I am supporting the Comptroller's decision; and looking at the seriousness of the case, I will say 20 guineas costs.

Re SHALLENBERGER. 6 P. O. R. 550.

Application for a patent, for an invention previously patented in America by *Shallenberger*, to be antedated under the terms of sect. 103 of the Patents, &c. Acts of 1883 and 1885.

It appeared that after *Shallenberger* had obtained an American patent, he assigned his rights therein to *Westinghouse*. The latter appointed *Thompson* as his agent to take out a patent for the invention, under the International Convention, in England.

Two applications were filed on *7th Aug.* 1888.

(1.) Form A 1, in which *Thompson* applied for a patent to be granted to him for an invention communicated to him by *Westinghouse*.

(2.) Form A 2, in which *Shallenberger* applied "that a patent may be granted to me, or to *William Phillips Thompson*, patent agent, as a communication from *George Westinghouse*, my assignee."

The Comptroller refused to accept the first application as being under the International Convention, and required the second application to be amended in accordance with the Patents Rules (International and Colonial Arrangements), 1888.

On appeal, decision affirmed.

Per WEBSTER, Att. Gen. I have pointed out in previous judgments, which are reported, that the rights under Sect. 103 are personal rights. They are intended to encourage people who have invented to come to this country and to make known their inventions.

In my opinion the Patent Office are perfectly right in saying the only person who is entitled to claim that dating back, is the applicant in the foreign country in his own name.

Otherwise we might have the very great danger of persons who are only recipients of the communication, and are entitled to apply as recipients of the communication, claiming the right to date back; whereas, as a matter of fact, they have had no direct authority from the person who authorizes them.

Therefore it seems to me that *Thompson* must elect whether or not he will proceed under the Convention, and under Sect. 103, or whether he will proceed on the ground that he is the

first and true inventor. If he proceeds on the footing that he is the true and first inventor, as being the importer of the invention, he is not entitled to have his patent dated back.

If he still asks that his patent shall be dated back, it must be a patent in the name of *Shallenberger*, and not in the name of *Thompson*.

Re CAVEZ. 6 P. O. R. 552.

Application, on 1*st April*, 1889, for a patent under the International Convention by *E. Cavez*, director of the *Société Générale de Maltose*, of Brussels, in respect of an invention for which that Société had applied for a patent in Belgium.

Part of Form A 2 was worded as follows :—

"I and they humbly pray that a patent may be granted to *William Phillips Thompson*, of 6 Lord Street, Liverpool, as a communication from the said *Société* of which he is for the time being agent, representative, and '*ayant droit*' for the said invention."

The Comptroller refused to accept the application, and required it to be amended in accordance with the Patents Rules (International and Colonial Arrangements), 1888.

On appeal, decision affirmed.

Per WEBSTER, Att. Gen. I wish to give as far as I can a clear and distinct judgment with reference to the position on Form A 2, which is the only matter before me at the present time.

Form A 2 was signed by the *Société Générale de Maltose*, Director *Euyène Cavez*, and requested that letters patent should be granted to *Thompson* of Liverpool, as a communication from the Société of which he is for the time being agent, representative and "*ayant droit.*"

I do not enter into the question here of whether there is any difficulty in corporations applying under clause 103 of the statute; my present impression is that they can so apply.

For the reasons which I pointed out in *Shallenberger's* case, I consider it would be a most dangerous thing to allow patents to be taken out as communications from abroad, or to be taken out in any other name than the name of the person who is in fact the inventor in the foreign country.

The words are "*who had applied for protection,*" not the true and first inventor abroad, but the person who has applied for protection in any such State, meaning, as in *Wirth's* case (Goodeve Pat. Ca. 603), *Monsieur Cavez,* or any patentee abroad who may obtain it by communication. If he has been allowed to get registration or protection according to the law of the State in which application has been made, he comes within the section.

I am satisfied that there is no ground whatever for departing from the usual practice in this case. That is to say, that if *Eugène Cavez* or the *Société Générale de Maltose* were the original applicants for protection in a foreign country, and desire to avail themselves of the Convention, the patent must be in their name and Form A 2 properly followed, or if that course is not adopted the patent can be granted as a communication from abroad on Form A 1 in the usual way.

Re MAIN. No. 15,858 of 1887. 7 P. O. R. 13.

Application made on 18*th Nov.* 1887, by *Main*, an American, for the grant of a patent for "Improvements in dynamo-electric machines and electro-motors," being an invention for which *Main* had applied for a patent in the United States on 18*th April*, 1887.

The applicant claimed that the English patent should be dated as of 18*th April*, 1887.

Opposed on the ground that the invention had been patented in this country on an application of prior date, viz.—No. 8262, dated 8*th June*, 1887.

The applicant admitted that parts of his invention were

similar to parts of the opponent's invention, but claimed to have his patent ante-dated under the International Convention of 1883, which would remove this objection.

The opponent contended that America came within Sect. 103 of the Patents, &c. Act of 1883 by an order in Council dated 12*th July*, 1887, and not until after the date of the application for the American patent.

The Comptroller decided to seal and to antedate the patent.

On appeal, decision affirmed. No order as to costs.

Per WEBSTER, Att. Gen. It seems to me that Sect. 103 created certain statutory rights, and one of the statutory rights so created is that if an application is made in a contracting State, then the applicant in the contracting State can, within seven months from the date of his application in the contracting State, become an applicant in another contracting State, and if so, he has a statutory right in priority to other applicants to have a patent for his invention in the latter State, registered or dated as of the date of the application in such foreign State.

Being a prior applicant, *Main*, in my opinion, was entitled to come, not, of course, within the whole of the seven months, but within so much of the time as was left of the seven months after the order in Council was passed, he was entitled to come and apply. My difficulty is this. If he is entitled to come and apply, as I pointed out in the *L'Oiseau and Pierrard* case, he is entitled to have his patent antedated, and I have no jurisdiction, and the Comptroller has no jurisdiction either to impose terms or make any conditions in connection with the grant of this patent. I must confirm the decision of the Comptroller.

Re VAN DE POELE. No. 6005 of 1889. 7 P. O. R. 69.

Application made on 8*th April*, 1889, by a foreign patentee, under Sect. 103 of the Patents, &c. Act, 1883, for a patent to be antedated as of 7*th Sept.* 1888.

It appeared that the application of *7th Sept.* 1888, which was made in America, was a "renewed application," the original application having been filed on *8th Feb.* 1887.

Under these circumstances, the Comptroller decided that the prior date applied for could not be granted.

On appeal, the Attorney General was informed that the application of *8th Feb.* 1887 had become abortive, and that it was merely for the convenience of the applicant that he was allowed, in connection with his second application, to make use of certain documents which had been filed in the American Patent Office in connection with the earlier application.

The applicant was thereupon directed to file a further declaration in confirmation of the facts relied upon.

It then appeared that the application of *8th Feb.* 1887 was no longer of any force or effect, and that the applicant in America had no rights thereunder, and further that the proceedings under the application of *7th Sept.* 1888 were in all respects the same as if no prior application had been made, the documents filed on the first application being allowed solely as an accommodation to the applicant, and in order to save him the expense of preparing fresh documents.

WEBSTER, Att. Gen., said that under these circumstances he should assume that the application in America was made on *7th Sept.* 1888. He should therefore allow the appeal, and direct that the patent be sealed as of *7th Sept.* 1888.

The appeal being from the decision of the Comptroller no costs would be given.

Re HAYTHORNTHWAITE. No. 946 of 1888. 7 P. O. R. 70.

Application for a patent for "Improvements in valves for operating alarm apparatus," opposed by *Jackson & Macbeth* as grantees of a prior patent, No. 658 of 1888.

The specification stated :—"that the invention was particularly applicable to valves used in connection with installations of

automatic fire extinguishing sprinklers, but could be used for other purposes, the chief object of the improvements being to give an alarm in the event of any attempt being made to close the valve which controlled the supply of water to the installation."

The Comptroller refused to grant a patent.

On appeal, decision affirmed, with 5 guinæas costs.

It was argued that although the objects aimed at and the general principles of the means for carrying out the two inventions were the same, yet the details were different, and the decision of Sir *R. Webster* in the case of *Stubbs'* patent (Gr. P. C. 298) was relied on as an authority for the proposition that it was not competent for the law officer to enter into the question of mechanical equivalents.

It was further objected that the construction sought to be put by the opponents on their complete specification would extend it beyond their provisional, and thus invalidate their patent.

Per CLARKE, Sol. Gen. I cannot agree that the question of mechanical equivalents does not come before the Law Officer, and I do not think that the Attorney General intended to use any language in *Stubbs'* case which would have the effect of excluding the consideration of that.

I have here to take the complete specification of *Jackson & Macbeth's* patent as being a good specification. I cannot enter into questions, as to whether it does or does not describe the same invention as was described in the provisional specification. That is excluded from my view by the terms of the statute; because upon the filing of a complete specification the Comptroller refers the specification to an examiner, and one of the questions is:—"Whether the invention particularly described in the complete specification is substantially the same as that which is described in the provisional specification."

Then I must take it that the Examiner has reported satis-

factorily upon that; and therefore that as far as my office is concerned the complete specification is a good one.

It seems to me clearly to cover the things which are in *Haythornthwaite's* specification. I think the Comptroller was clearly right upon what was under his consideration. I must, therefore, uphold his decision, and I give 5 guineas costs.

Re HOFFMAN. No. 10,108 of 1888. 7 P. C. R. 92.

Application for a patent for "Improvements in automatic ticket-printing weighing machines."

Opposed by the Automatic Weighing Machine Co. as assignees of *Everitt's* patent, No. 16,433 of 1884, for "Improvements in weighing machines."

It appeared that the applicant's invention referred to the "so-called automatic coin-freed weighing machines," the object being to provide internal ticket printing and ejecting mechanism which should deliver automatically to the user a record of his weight on the insertion of a coin into the machine.

The machine was not perfectly automatic inasmuch as the ticket was only partially pushed out, and it was necessary for the user to draw out the ticket, and during the complete withdrawal of the ticket the mechanism was restored to its normal position.

The Comptroller decided that, having regard to the general similarity of the respective machines, and to the fact that he must hold *Everitt's* patent to be the master-patent for the kind of mechanism which he described and claimed, a disclaiming reference to *Everitt's* patent should be inserted.

On appeal, decision affirmed, with 5 guineas costs.

Per CLARKE, Sol. Gen. The question I have to deal with is this:—taking the claim in *Hoffman's* specification as it stands, and seeing what is claimed there, I am to decide whether it is so open to the contention that it covers some-

thing which *Everitt* has already patented, that it will be fair to *Everitt*, and fair to the new patentee, and a protection to the public, to put in the disclaiming clause. Counsel has rightly said that the disclaiming clause serves, and is intended to serve, two useful purposes: one, to protect the former inventor, and the other to protect the new inventor, by limiting his claim, thus showing that his patent is not assailable on the ground that it is an infringement on the former patent. Now, looking at the descri[illegible]on and claim in *Everitt's* specification, and looking at the description and claim in *Hoffman's* specification, I should myself have come to the conclusion that there was so much room for contention that the *Hoffman* machine was an infringement of the other that there ought to be a reference.

I have more than once said that I am not myself anxious to put in references of this kind unless I think there is very strong ground for inserting them, but in this case I think it will be reasonable that the reference should stand, and I therefore affirm the decision of the Comptroller with 5 guineas costs.

Re GRENFELL & MCEVOY. No. 11,911 of 1888. 7 P. O. R. 151.

Application for a patent for "Improvements in appliances for directing the discharge of ordnance and other weapons of war at night."

The complete specification was filed on 17*th May*, 1889, and was signed by *McEvoy* alone. The Comptroller refused to accept the specification unless it was signed by both applicants, or by an agent duly authorized to act for both.

On appeal, decision reversed.

Per WEBSTER, Att. Gen. I am of opinion that this appeal ought to succeed. I will not deal with the very difficult question which may some day arise as to the filing of two complete specifications.

It is of course intended that the applications and the various steps shall be in accordance with the prescribed forms; but if from time to time a case arises which was not contemplated at the time the Act was passed, or the rules framed, I do not think that the statute would fail in its operation because a form had to be slightly modified.

Here was a *bonâ fide* application by two persons. It is quite clear that both must sign the application, because it is a request that the patent should be issued in their names and to them. Then follows the condition—the lodging of the complete specification. I do not consider that it is absolutely essential that the final specification should be signed by both parties. There must be a final specification in accordance with the provisions of the statute, and one which is to be examined by the Comptroller, and I have no doubt that it should be signed by one or other of the applicants, as indicating that it relates to the same invention. But I think it would work or might work considerable hardships if I were to rule, as a matter of strict law, that a patent must be stopped because all the applicants had not signed.

I think that this complete specification should be accepted, and the decision of the Comptroller reversed.

Re C. 7 P. O. R. 250.

Appeal from the refusal of the Comptroller to allow an amendment of a complete specification before acceptance and publication.

There is no report as to the result of the appeal, but some general observations of the Attorney General are set out, to the effect following:—

Per WEBSTER, Att. Gen. Sub-sect. 4 of Sect. 5 of the Patents, &c. Act of 1883 provides that:—

"A complete specification, whether left on application or subsequently, must particularly describe and ascertain the

nature of the invention and in what manner it is to be performed, and must be accompanied by drawings if required."

That condition applies to the complete specification, whether left originally or subsequently. There is then power in the Comptroller to refer these applications to Examiners.

Under Sect. 6, every application is reported upon by an examiner in order to ascertain whether the condition of Subsect. 4 of Sect. 5 has been fulfilled. In my judgment the report of the Examiner is not to fetter the judgment of the Comptroller but to assist him, and if upon the face of the specification the Comptroller saw, apart from the report of the Examiner, that the specification was insufficient, it would be in his power to require an amendment.

The amendment is to be determined by the judicial act of the Comptroller, with an appeal to the Law Officer.

Re ANDERSON & ANDERSON. No. 13,308 of 1888. 7 P. O. R. 323.

Application for a patent for "Improvements in the manufacture of explosives," opposed by *Abel & Dewar* on the grounds:—

(1.) That the complete specification describes and claims an invention other than that described in the provisional specification, and that such other invention forms the subject of an application (No. 5614 of 1889) made by the opponents in the interval between the leaving of the provisional specification by the applicants and the leaving of the complete specification.

(2.) That the invention was obtained from the opponent.

The Comptroller held that inasmuch as the first ground of opposition was introduced by the Act of 1888, which did not take effect until 1*st Jan.* 1889, a date subsequent to that of the present application, the opponent could not be allowed to raise such ground of opposition.

On the second ground the Comptroller held that the objection failed.

On appeal, WEBSTER, Att. Gen., was of opinion that the opponents had a *locus standi* to oppose under the first ground of objection, and on the second ground he was of opinion that *Messrs. Anderson* had found out all that was in their provisional and complete specifications from their own experiments, and that there was no evidence of their having obtained the invention from *Messrs. Abel & Dewar*. The Attorney General was further of opinion that there was no disconformity on the face of the provisional and complete specifications, and no such invention by the opponents of that which was alleged to be in excess as to justify him in giving effect to the appeal.

He thereupon confirmed the Comptroller's decision, and dismissed the appeal with costs (8 guineas).

Re KITSON. No. 10,043 of 1888. 7 P. O. R. 388.

Application for a patent for "Improvements in carburetting gas lamps," a complete specification being filed with the application.

Opposed by *Livesey* on the ground of several prior patents.

It appeared that *Livesey's* notice of opposition was dated 14*th Sept.* 1888, and that his declaration in support was filed on 15*th Oct.* 1888.

The applicant's time for filing his declaration was by consent extended to 19*th Nov.* 1888, but no such declaration was in fact filed before 30*th Aug.* 1889, when the opponent objected to it as informal.

The Comptroller having decided to accept the declaration, the opponent answered it, under protest, on 6*th Sept.* 1889.

The Chief Examiner decided to seal the patent, subject however to a reference and disclaimer, and to the excision of claim 8.

On appeal, decision affirmed, with costs (4 guineas).

WEBSTER, Att. Gen., after discussing the case on its merits said:—If this case had stood, as I think it must now be treated as standing, upon its merits, I have no doubt that the Comptroller was right in declining to stop this patent. I have very serious doubts on the question of delay, which has been raised before me, and I confess, although I do not know that any words of mine will have much effect, I am most reluctant to allow patents to be sealed after such long delay.

I wish there was some machinery provided by rule in a case where such an extraordinary delay takes place—practically speaking very nearly a year—whereby unless an applicant moves to obtain an extension of time, the opponent should be in a position to treat the application as lapsed or abandoned.

It is impossible for me to say, having regard to the applications which were made, and the considerations that were presented to the Comptroller, that this case is one in which the delay was not caused by the opposition; and inasmuch as the applicant's case does not rest upon any matters contained in the declaration which was subsequently filed, I think it would be too severe a penalty to visit upon *Kitson* to stop the sealing of this patent.

Re HETHERINGTON. No. 16,157 of 1887. 7 P. O. R. 419.

Application for a patent for "Improvements in apparatus for controlling the grinding of carding engine flats."

Opposed by *Richardson & Greaves* on the ground that the applicant had obtained his invention from the opponents.

It appeared that the opponents had themselves applied for a patent, No. 16,829 of 1887, for "Improvements in carding engines," and their complaint was that *Hetherington* had inserted in his specification the following sentence:—

"I will mention that in Fig. 2 the flexible band appears as when brought close up to the edge of the main cylinder in accordance with an invention for which letters patent, No.

9,579 of the year 1886, have been granted to me." The allegation of the opponents being that the particular construction herein refered to, was not deducible from *Hetherington's* prior specification, but had been obtained from an inspection of machines constructed in accordance with the invention, No. 16,829 of 1887.

The Comptroller refused to seal the patent until the applicant amended his specification by excising Fig. 2 and the description as quoted, or by substituting therefor a correct description and representation of the parts of the applicant's prior specification to which it might be necessary to refer.

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

Per CLARKE, Sol. Gen. It was contended that the opposition by the opponents must be disregarded because the invention which was incidentally described in *Hetherington's* specification, and untruly stated to be his own, was not part of the invention in respect of which he claimed to have a patent.

It was contended that the words in Sect. 11 of the Act of 1883, "having obtained the invention from him," must be read as applying solely to the invention claimed in the specification of the patent to which the objection is made. Even if this construction were sound, I should not hold myself bound to permit the sealing of a patent which bore upon its face a statement, untrue in fact, and injurious to the interests of a person to whom a prior patent had been granted. The function of the specification is to describe and ascertain the nature of the alleged invention, and the words objected to in this case purport to be part of that description.

I am of opinion that the opponents were entitled to be heard in opposition to the grant, and I affirm the decision of the Comptroller and order the appellant to pay 5 guineas costs.

Re LANG. 7 P. O. R. 469.

Application for leave to amend the specification of a patent,

No. 138 of 1879, for "Improvements in the construction of wire ropes." The invention consisted in the construction of wire ropes, having the strands laid into rope in the same direction as the wires in each strand.

The specification stated:—that the machinery as at present employed for the construction of wire ropes requires no alteration for the construction of wire ropes as by my present invention. There were no drawings.

The *claim* was "The improvement in the construction of wire ropes, that the strands be laid up into rope, same lay as the wires in strand, substantially as and for the purposes set forth."

On 17*th* of *Sept.* 1888, *Lang and others* commenced an action for infringement of the patent against the *Whitecross Wire and Iron Co. Ld.*

After delivery of the defence, the plaintiffs obtained permission (upon terms) to apply for leave to amend the specification by way of disclaimer. (*See* 6 P. O. R. 570.)

On 28*th Nov.* 1889, application was made at the Patent Office for leave to amend, and the amendments proposed were the addition of a sheet of drawings showing in elevation and section a piece of wire rope made according to the invention, and such a rope when worn. Several alterations were to be made in the specification, references to the drawings were to be inserted, the amendments concluding with the following statement and claim.

"I wish it to be understood that the method of laying hereinbefore described is of no practical utility except as applied to wire ropes such as are made by machinery as at present employed, and I do not desire my claim to extend beyond such application. I am aware that there is in existence a piece of old hand-made rope in the Museum of the Royal School of Mines, which has strands laid in the rope in the same direction as the lay of wires in the strands, but forming in effect a

wholly different combination of wires from that which my invention is designed to produce, as herein described and illustrated. As applied in the art of wire rope making, as practised at the date of my patent, and with the use of machinery such as then employed, the result of the variation in the mode of manufacture which is the subject of my invention is shown in Figs. 1 and 2, and the result of wear upon such a rope is shown in Figs. 3 and 4. I do not therefore desire to claim generally any rope having wires in strands and strands in rope laid in the same direction. But having now described my invention and in what manner the same is to be performed, I wish it to be understood that what I *claim* is :—

"The improvement in the construction of wire ropes such as are made by machinery as at present employed, that the strands be laid into the rope same lay as the wires in strand as and for the purposes herein set forth, and so as to produce a wire rope substantially such as is hereinbefore described and shown in Figs. 1 and 2."

The amendment was opposed by the *Whitecross Company* and other parties, the main objection being that the amendment would vary or enlarge the right granted by the patent.

The Comptroller refused leave to amend.

On appeal, decision affirmed with 10 guineas costs to be paid to each of two separate opponents.

Per CLARKE, Sol. Gen. My jurisdiction in the main depends upon the 18th Section of the Patents Act, and I do not doubt that I have power to allow any amendment. whether of the letterpress of the specification, or of the drawings, or by way of adding drawings, if drawings have not in the first instance been appended to the specification, necessary to define the disclaimer which it is desired to make.

I need not at the moment discuss the terms of the amendment which is desired, because, of course, the important point is whether this amendment is to be allowed at all.

The specification, as it originally stood, was a specification for "Improvements in the construction of wire ropes," and the important description of the thing which it was proposed to do was this:—"In constructing wire ropes by this invention, I lay the strands up into rope same lay as the wires in strand: thus when strands are spun to the left hand ropes are laid up to the left hand also, and when strands are spun to the right hand the ropes are laid to the right hand too." The *claim* made in that specification was this:—What I *claim* is:—"The improvement in the construction of wire ropes that the strands be laid up into the rope same lay as the wires in strand, substantially and for the purposes herein set forth."

Now it appears to have been discovered at some time after the filing of that specification, that there was at the Museum of the Royal School of Mines a specimen of old rope (whether hand-made or machine-made is quite immaterial) which did precisely meet the description of the method and the terms of the claim of that specification, that is to say, the strands were laid up into that rope the same lay as the wires in the strand. Therefore it appears to have been feared by those interested in the patent that the patent was not a good one, and they desire now to amend it.

As things stand now it is not proposed to claim what was claimed in the original specification, that is the method of making wire ropes that the strands be laid up into rope same lay as the wires of the strand, but I am told that what is now sought to be claimed is a new construction, which is the application of that method of laying the wires to the construction of ropes by means of machinery in use at the time of the specification. The specification states that the machinery, which was then known and in use, could be used for the purpose of producing this new form of rope. So that what really would be patented, if the specification were allowed to be

amended as desired, would be the use of existing machinery in order to produce that which was a known product—a rope formed by wires laid in the method described in the specification.

It appears to me that I could not allow that amendment without contravening the terms of the 18th Section of this Act, by which I am bound, that no amendment shall be allowed which will make the specification, as amended, claim an invention, substantially larger than, or substantially different from, the invention claimed by the specification as it stood before amendment.

I think that the acceptance of the proposed amendment would make the specification claim an invention substantially different from the invention which was at first claimed: and therefore I uphold the decision of the Comptroller, and decline to allow the specification to be amended in the manner proposed.

Re J. W. KILNER. No. 5922 of 1889. 8 P. O. R. 35.

Application for a patent for "Improvements in tools for forming or moulding the necks of bottles."

Opposed by *T. Kilner* as grantee of a prior patent, No. 6126 of 1888.

The specification stated:—The object of my invention is to enable the outside of glass bottle necks to be formed accurately to a given size, so that a cap which fits on the outside of one bottle neck shall also accurately fit the outside of all or any other bottle necks formed with the same tool. The tool generally used for the purpose consists of a spring tongs, carrying at each of its upper ends a die for forming the collar or swell and the parts above and immediately below the same. The outside diameter of the collar or swell is determined partly by the distance apart to which the two sides of the tongs are compressed or squeezed by the hand and partly also by the

amount of "metal" the maker puts on for the purpose, and such distance is therefore not perfectly uniform for all bottle necks made, even with the same tool.

I am well aware that prior to this my invention glass bottle necks have been formed to a uniform diameter by the use of fixed dies, but the object of my invention is to serve the same purpose with movable dies, this I effect by liniting the position to which such dies (for forming the upper part of the bottle necks) can be moved.

It appeared that according to *T. Kilner's* specification the edge of the neck of the bottle was formed by the use of *fixed* dies, but the collar or enlarged portion of the neck was formed by dies carried at the ends of the spring tongs.

The *claim* was :—In a tool for forming the necks of glass bottles, the use of fixed dies or distance pieces, for securing accuracy and uniformity in the outside diameters of the lip or edge of the necks of glass bottles formed therewith, substantially as herein set forth.

According to *J. W. Kilner's* specification the dies for the purpose of forming the upper part of the bottle necks were movable, but were, by the act of compressing the tongs, brought into a definite fixed position.

The *claim* was :—In a tool for forming or moulding glass bottle necks, the use of movable dies which can be brought to a fixed, limited, or final position for the purpose specified.

The Chief Examiner, acting for the Comptroller, decided to seal a patent without requiring any amendment.

On appeal, decision affirmed, but without costs.

Per WEBSTER, Att. Gen. I had some doubt on the statement made respecting the distance pieces as to whether or not the disclaimer was sufficient; but the rule which I have laid down on these matters is well known, and I regard the question, not for the purpose of defining the rights of *T. Kilner* in par-

ticular, but for the purpose of considering whether there is such a similarity as would necessitate a specific reference to *T. Kilner's* specification.

Now there is a general disclaimer which, it cannot be denied, in terms includes the way in which *T. Kilner's* apparatus acts, because the disclaimer states that he [the applicant] is aware that glass bottle necks had been formed to a uniform diameter by the use of fixed dies; but the point which was made was that prior to *T. Kilner's* patent the dies could be pressed up further; the consequence was that there was only a rough uniformity, or in fact it might be said no uniformity at all. Therefore it cannot be reasonably contended that lines 19 & 20 of *J. W. Kilner's* specification do not include the operation described in the opponent's specification.

Is it necessary that I should go further and should refer to *T. Kilner's* specification? I am always unwilling to insert a special reference unless there are such strong grounds for it that I think it is right that the public should be protected by their attention being called specifically to the named patents.

Of course I do not discredit the statement made that this was the first time these fixed pieces were used; but at the same time I think that the more general statement should be used, having regard to what may afterwards be discovered. I do not think it would be right at any rate to do more with reference to that than to insert these two lines.

Re STELL. No. 16,729 of 1889. 8 P. O. R. 235.

Application for a patent for "Improvements appertaining to mechanism employed in the doubling and twisting of wool or other fibrous substances."

Opposed by *Farrar* as grantee of the prior patents, No. 113 of 1881, and No. 16,752 of 1887.

The invention related to mechanism for stopping the draw-

drum or roller in machines, for doubling or twisting wool or other fibrous substances when a thread broke.

The *claim* was :— "The bevel wheel *e* having the projections c^2 attached thereto or formed thereon, the annular piece *c* having the cam surfaces e^1 and e^2 and radial arms e^3 and e^4, the coupling-piece *a* having its cam surfaces and projecting arms as described, the drum *d* formed as set forth and the lever *g in combination*, each and all of these several parts being mounted and arranged to operate substantially as herein specified."

At the hearing before the Comptroller the opponent did not ask that the patent should be stopped, but that either the applicant should amend the claim and say that he was not entitled to claim the bevel wheel with projections, or that there should be a disclaiming reference to *Farrar's* prior patents.

The applicant thereupon proposed to amend the claim by striking out the words "*in combination*" printed in italics in the claiming clause and to commence with the words "The combination of a bevel wheel, &c."

The Comptroller decided that such an amendment would remove all ambiguity and would fairly meet the opposition.

On appeal, decision affirmed, with 6 guineas costs.

Per WEBSTER, Att. Gen. The principles upon which the Law Officers have acted now for some years in allowing disclaiming clauses are, *first*, if it appears clear that upon the invention claimed by the prior patentee there will be a repetition of the claim to the earlier invention in the later patent; and, *secondly*, if it is clear that the public would be misled by the later specification without disclaimer.

Upon what ground could the opponent ask for a special disclaimer and reference? It seems to me it must be upon the ground that the matter is so clear that the Law Officer must decide that the reading of the claim of *Stell's* specification will be a repetition of *Farrar's* claim. I am not prepared to go as

far as that. I do not express any opinion whether it is an infringement or not.

The disclaimer asked for is a disclaimer with special reference to *Farrar's* specification, No. 16,752 of 1887. It is quite clear that the Law Officer is not in a position to be satisfied that he has the whole knowledge before him. I do not know whether, if this matter comes to be investigated, there may not be other specifications covering some part of the ground as near *Stell* as *Farrar's*, or at any rate indicating that a disclaimer should be in wider terms, or should have reference to other existing arrangements besides those which are covered by *Farrar's* specification. It is obvious that a disclaimer which has reference solely to *Farrar's* specification might be construed as not being sufficiently wide to include a correct description of the antecedent state of knowledge.

Therefore, I cannot see that any injury will be done to *Farrar* by the granting of a patent to *Snell*, and I cannot, in the face of the very particular claim, properly so framed, of *Farrar* in his specification No. 16,752 of 1887, construe the claim proposed to be put in *Snell's* specification as being a repetition of that claim, and that claim only, especially having regard to the alteration of the claim which is required by the Comptroller to limit the claim to the combination as distinguished from the subordinate parts of the combination. I think that the *onus* lies upon a prior patentee who asks for a disclaimer to show that it is necessary.

I affirm the decision of the Comptroller, and I think this is a case in which I ought to allow costs, which I shall fix at 6 guineas.

Re HEALD. No. 10,773 and No. 12,203 of 1889. 8 P. O. R. 429.

Application for a patent (No. 10,773) for "Improvements in gas lamps," and for a patent (No. 12,203) for "Improvements

in appliances for use with gas lamps for producing light by incandescence (Welsbach system)."

Opposed by *The Incandescent Gas Light Co. Ld.*, and by *Ruler* on the ground that the applicant had obtained the inventions from *Ruler* while in the company's employment.

The Comptroller decided to seal a patent on each application.

On appeal, after cross-examination of some of the declarants, this decision was affirmed.

Per CLARKE, Sol. Gen. There is no doubt in my mind that it was as a servant of the *Incandescent Gas Light Co.*, and in the desire to serve the interests of that company, that Mr. *Heald* made the improvements, so far as he made them, in question.

But then I have to deal with the proposition on which counsel has challenged his opponents to quote an authority—the proposition that an improvement made by a servant is the property of his employer, so as to entitle his employer to take out a patent for it, or to prevent the servant from taking out a patent for it. I am not aware of any authority which lays down that the invention of a servant, even made in the employer's time, and with the use of the employer's materials, and at the expense of the employer, thereby becomes the property of the employer, so as to prevent the person employed from taking out a patent for it.

That being so, the question is, as between the different persons who were in the employment of the company, whose invention this was? Upon that I come to the same conclusion as a matter of fact as that to which the Comptroller has come—a conclusion stated in the second paragraph of his decision.

"The invention the applicant desires to patent was the subject of experiments and discussion by certain servants, of whom the applicant was one, of the opposing company, and it

is alleged by Mr. *McTear*, the technical director, and Mr. *Mc Keen*, the chemist, and Mr. *Ruler*, the foreman, that the discussion took place and the experiments were carried out by the Company's servants, in the Company's time, and at the Company's expense." That is the conclusion at which the Comptroller arrives as a matter of fact, and I see nothing to disturb the correctness of that conclusion. But then he goes on :—" The applicant however emphatically declares that he is the true and first inventor of that which he desires to patent."

Mr. *Heald* says so in his declarations, he says so now, and I do not think that there is sufficient in the declarations of *Ruler* or his evidence before me, or in the declarations or evidence of Mr. *McTear*, to enable me to say that the claim of Mr. *Heald* is an unfounded claim.

I therefore come to the conclusion that I must support the decision of the Comptroller, and allow Mr. *Heald* to have these patents.

Re McHardy. No. 18,620 of 1889. 8 P. O. R. 431.

Application for a patent for "Improvements in velocipedes."

Opposed by *Cocks* as grantee of a prior patent, No. 17,201 of 1889, for "Improvements in or relating to velocipedes."

It appeared that the specification of the *opponent's* patent described and claimed a method of constructing velocipede frames of the diamond pattern by bending two continuous rods (which were in the shape of tubes, half tubes, rim steel, and the like) into the required shape, and uniting their ends at the rearmost angle of the frame, the term "diamond pattern" referring to the contour or outline of the frame.

In the *applicant's* specification the frame described was also of the diamond pattern, and the ends of the bent material, which was continuous, were united at the rearmost angle of the frame.

The opposition was directed solely against the fourth claim of the applicant, which was the following :—

Claim 4. The construction of velocipede frames of continuous solid material.

The Comptroller decided to seal the patent, subject to the insertion of a general disclaiming clause, as follows :—

"I am aware that it has been proposed to manufacture velocipede frames in the manner hereinbefore described, except that the frames had been made of tubes, half tubes, rim steel, or like material. I therefore make no claim to the construction of velocipede frames, except when they are made of solid material."

On appeal, WEBSTER, Att. Gen., struck out claim 4, together with the disclaiming clause, and gave costs (4 guineas).

Per WEBSTER, Att. Gen. The simple question before me is, has Mr. *McHardy*, in his specification, patented an invention similar to that which has been patented in this country on an application of prior date ?

Now I have often expressed the opinion in my decisions that it is only in clear cases that the Law Officer is justified in interfering, so as to prevent letters patent from including a claim to an invention which is covered by an earlier specification ; but in a clear case the Law Officer cannot avoid the responsibility of acting.

The Law Officer is bound to look at the provisional specification in order to see what was the nature of the invention described, and I have no doubt, in my mind, that when Mr. *McHardy* filed his application, before he knew anything about *Cocks*, he had conceived the idea of the girder construction, to which tube would be applicable as well as solid material, and that he did not intend to exclude tube. He says, when he framed his final specification, he limited it to solid in order to avoid *Cocks*.

In my opinion, on a proper construction of *Cocks*' specifica-

tion, he has not avoided him, as by the 4th claim he has in effect claimed the girder construction with solid material which would cover the steel rim mentioned in *Cocks'* specification.

I put the construction on Mr. *Cocks'* specification that it describes a girder mode of construction in which tubular or solid materials may be used.

Looking at Mr. *McHardy's* provisional specification, by which he is bound, I think he did mean in the first instance to apply for a patent in which he would have been entitled, if Mr. *Cocks* had not been there before him, to protection for an invention of the girder construction of frames with tubular materials if necessary. I do not think he was justified, or that the Comptroller was right in allowing the 4th claim, and I therefore direct that the 4th claim be struck out. Of course this disclaimer will go with it. I allow this appeal and award 4 guineas costs.

Re WELCH. No. 10,239 of 1887. 8 P. O. R. 442.

Application for a patent for "Improvements in velocipedes."

Opposed by *Sterry & Sterry* as grantees of a prior patent, No. 13,782 of 1886.

It appeared that the applicant's invention comprised :—

(1.) Means for obtaining a transverse tilting of one part of the frame of a tricycle or similar velocipede about a horizontal or suitably inclined axis supporting the other part of the frame.

(2.) Means for reducing horizontal vibrations, and assisting the passage of the wheels over obstructions.

The applicant relied upon the specifications No. 224 of 1879 (*Langshaw*) and No. 12,373 of 1884 (*Couchman*) as showing that the opponents did not hold a master-patent for the improvements described in their specifications.

The Comptroller decided to seal the patent but required the insertion of a disclaiming clause as follows :—

"I would have it distinctly understood that I am aware that horizontal joints have been used with and without springs on various machines for allowing one wheel to pass over an obstacle without affecting the other; I am also aware that horizontal joints have been used for coupling one machine to another, but not as I believe in the manner and for the purpose herein stated."

On appeal, decision affirmed.

Per WEBSTER, Att. Gen. I have only to consider whether it is so clear that the apparatus described in *Welch's* specification is within the previous claim or previous description—I care not which—of *Sterry*, that the public are entitled to have a statement made on the face of the specification to show that all that can be claimed under the later patent is something which is an improvement upon the apparatus described in *Sterry's* specification.

I do not think that a later patentee ought to be compelled to insert a special reference to the earlier specification of the opponent unless it is practically admitted by the later applicant that the governing principle was, for the first time, discovered or disclosed in the opponent's specification.

There may be some ground for contending that *Couchman* and *Langshaw* did not go so far, but, in the face of those publications of prior knowledge, I think it would be dangerous to assume that all that is required is a disclaimer of that which was in the earlier specification of Mr. *Sterry*.

I think the decision of the Comptroller should be affirmed.

Re NAIRN. 8 P. O. R. 444.

Application to amend the specification of a patent, No. 6213 of 1887, for "Improvements in printing patterns on Floor-cloths, Linoleum and similar materials, and in apparatus therefor."

There was no opposition.

The invention related to an improved method of printing patterns on floor-cloths and the like, the *claims* being as follows:—

(1.) The improved method of printing patterns on floor-cloths, linoleum, and similar materials, whereby a given length is printed in two or more mechanical operations by means of a block or series of blocks caused to travel gradually across the material from margin to margin thereof.

(2.) Constructing machines for printing patterns on floor-cloths, linoleum, or similar materials, by repeated applications of the same block or series of blocks in a direction transverse to the length of the material substantially as herein described.

The specification contained only a general description of machinery for carrying out the improved method, the drawing filed with the specification being of a diagrammatic nature.

The amendments proposed consisted of the description and drawings of a machine for carrying out the invention, such machine having the same general features as that referred to in the original specification, together with a statement by the patentee that he did not claim in whole or in part any of the details described.

The Comptroller refused to allow the amendments.

On appeal, the order was affirmed.

Per WEBSTER, Att. Gen. It seems to me that Mr. *Nairn* is in this difficulty: either the invention consisted in the detailed appliances, or else those appliances were so well known that an enunciation of the principle of lateral movement was sufficient to enable him to claim any ordinary modification or application of that principle. It has been argued that what has been inserted is merely for the elucidation or more elaborate statement of the parts originally described, not for the purpose of claiming them but for the purpose of adding information.

While I agree that in all probability some cases of disclaimer or alteration do turn or do remove objections to the validity of a patent, I think it is going too far to say that you can press that principle to the extent that where a patentee has chosen to claim an improved method apart from particular means you can allow him, practically speaking, to re-write his specification by inserting all the particular means with considerable doubt as to whether they would not be made the subject of a claim.

I think the specification must stand, at any rate so far as this amendment is concerned, as it was originally filed.

Re Ross. No. 1955 of 1890. 8 P. O. R. 477.

Application for a patent for "Improvements in breech-loading small arms," opposed by *Perkes* as grantee of the prior patents, No. 10,084 of 1888, and No. 2784 of 1889.

The opposition was confined to claims 1 and 8 of the applicant's specification.

The Comptroller decided that, having regard to the limited field of invention, there was sufficient distinction between the specifications to entitle the applicant to a patent.

On appeal, decision affirmed, with costs (6 guineas).

Per WEBSTER, Att. Gen. Counsel for the opponent does not produce any specification which identically claims that which is the subject of *Ross'* first claim: but he suggests that by putting together two claims in the specifications, No. 10,084 of 1888, and No. 2784 of 1889, he anticipates claim 1 of *Ross'* specification. I confess I should require a very clear case to stop a patent on such a ground. It by no means follows that the combination of two previous arrangements will not require invention; and although I do not lay down any rule where you have to combine and piece together the claims in two specifications, the combination cannot amount to such a prior claim as would prevent a subsequent patent being sealed,

yet having regard to the direction given in sub-section (1) of section 11, I think it would require a very clear case, and I am not myself satisfied that if that had been the only objection to this application, I could have entertained the contention of the opponents.

But after the assistance I have received from the arguments addressed to me, I have come to the conclusion that there is sufficient difference in *Ross'* arrangement to make it quite impossible to refuse the patent. I need not point out that if the subsequent patent be an infringement, *Perkes* will have his remedy. The question is whether or not it is so clearly covered by the earlier specification that the Law Officer ought to refuse the application.

Then came the later specification No. 2784 of 1889, and in that counsel called attention to some words which did require explanation.

The Attorney General hereupon compared and discussed the several details and concluded by saying :—

I am clearly of opinion that the specification of Mr. *Ross* does not in any way adopt either of the two matters which form that part of Mr. *Perkes'* claims, and that the decision of the Comptroller was right. I think that any proper consideration and understanding of the two specifications would have led anybody to the same conclusion.

I make the usual order that this appeal is dismissed with costs, which I fix at six guineas.

Re HIGGINS. No. 14,418 of 1889. 9 P. O. R. 75.

Application for a patent for "Improvements in machines for type-distributing, type-setting, and type-justifying."

Opposed by *Wynne*, *Topliss*, and *Kay*, on the grounds :—

(1.) That the applicant obtained the invention from the opponents.

(2.) That the complete specification described and claimed

an invention other than that described in the provisional specification, and that such other invention formed the subject of an application made by the opponents in the interval between the leaving of the provisional specification and the leaving of the complete specification, viz., application No. 15,291, dated 28th of *September*, 1889.

All the parties to the case resided in Australia, and the first ground of opposition related to circumstances alleged to have taken place in Australia.

The Comptroller overruled the objections on both grounds, and decided to seal the patent.

On appeal, the first ground of opposition being alone relied on, the decision was affirmed, with 5 guineas costs.

Per WEBSTER, Att. Gen. The position of matters is this: Prior to the Act of 1883, an importer was regarded by the law of the United Kingdom as the true and first inventor. I have always understood that was upon the ground that he was the person who had introduced to this country the new invention. It mattered not whether he had stolen it, or learnt it from some third person, or whether he was receiving it as some foreign communication, he was regarded as meritorious in the sense of being the first and true inventor, in the same sense that the true and first inventor, if in the United Kingdom, was regarded as meritorious.

The question then arises, was the law altered by the Act of 1883? I very carefully considered this matter at the time of my decision in *Edmunds'* case. I took means of acquainting myself with all the authorities I possibly could, and I came to the conclusion that whatever might have been the intention of the framers of the Act—and nobody suggests that they intended to alter the law—there was not sufficient in the Act of 1883 to make any change in the law. I must point out that that practice has prevailed since *Edmunds'* case, and importers have been regarded as being the true and first inventors; and

having regard to the large number of persons who have applied for patents in their own names, as being the recipients of communications, I think it would be impossible for me to act upon any other view of the law. That being so it almost follows that the Comptroller or the Law Officer cannot inquire into what has happened outside the United Kingdom.

I think this is a case in which there is not sufficient distinction to prevent me from adopting the usual rule.

I must dismiss this appeal with costs, which I fix at 5 guineas.

Re TATTERSALL. No. 5,429 of 1890. 9 P. O. R. 150.

Application for a patent for "A new or improved air-compressor or blower."

Opposed by the *Acme Ventilating and Heating Company* as assignees of a prior patent, No. 10,759 of 1884.

It appeared that the applicant's blower consisted of a V-shaped chamber from the upper or pointed end of which a vibrating blade or flap was suspended. The blade was operated by a crank and connecting rod or in any other convenient manner. On each oscillation of the blade air was drawn through one set of valves and expelled through another set. To discharge the air at an approximately uniform pressure, the air before leaving the blower was passed into a surrounding casing or receiver.

The *claim* was:—An air-compressor or blower constructed with a vibrating blade within a V-shaped chamber communicating with a receiver substantially as herein shown and described, and illustrated in the accompanying drawings.

The patent No. 10,579 of 1884, granted to *Baker*, was for "Improvements in apparatus for ventilating purposes."

The material claims of the specification of this patent were the following:—

Claim 1. "The manufacture and use of apparatus for

ventilating purposes having an exhaust chamber (B), with inlet and outlet valves, in which a vane depending from or supported by an oscillating shaft moves to and fro, by means of which air is drawn into the exhaust chamber through the inlet valves at one side while other air is being expelled through the outlet valves at the other side thereof at each stroke or movement, substantially as described and shown."

Claim 2. "The construction of apparatus for ventilating purposes with an exhaust chamber formed of vertical and inclined sides, which support an oscillating vane, each of the inclined sides being provided with inlet and outlet valves through which the air is forced by the vane, substantially as described and shown."

There was no claim in *Baker's* specification covering a receiver, and the case made for the applicant was that the receiver was an integral part of the invention claimed.

The Chief Examiner decided to seal a patent on the insertion of a disclaiming clause in the following terms :—"I am aware of the specification of letters patent No. 10,579 of 1884 granted to *James Campbell Baker*, and I lay no claim to anything described and claimed therein."

On appeal, decision affirmed. No order as to costs, the Attorney General taking the view that although the decision was right, the grounds upon which it rested could not be supported.

Per WEBSTER, Att. Gen. I shall never hesitate to stop a patent in a case in which I think there is no substantial difference ; but I must remember the governing principle which has operated upon the minds of Law Officers for a very long time, namely, that if they can preserve and safeguard the interests of prior patentees in a case in which it is doubtful as to whether or not the second patent does cover exactly the same ground as the first, they ought to do so for the reason that the granting of a second patent, though it may, and undoubtedly

does at times do harm to an earlier patent, yet still it is not anything like so serious an injury as to stop a patent.

I am very much pressed by the argument that there is no invention in connection with *Tattersall's* apparatus. I am by no means clear that the apparatus described in *Tattersall's* specification amounts to anything more than a particular mode of using the apparatus described by *Baker*. But on the other hand, I do find that it is of the essence of the combination described in *Tattersall's* specification that there should always be a receiver in which the air that is compressed or blown should be contained.

On the whole, I have come to the conclusion, with very considerable doubt, that I cannot stop this application; and I have come to that conclusion on the ground that I think sufficient protection is given to *Baker* by the disclaimer on the face of the specification calling the attention of the public to his specification; and if any attempt was made to allege that an apparatus constructed according to *Baker's* apparatus, however used, was an infringement of *Tattersall's* patent, I think the answer would be that on the face of *Tattersall's* specification there was a direct recognition that the combination shown in *Baker's* specification was a combination which people were entitled to use who had the licence and authority of *Baker* to use it.

Re VAN GELDER. No. 20,030 of 1889. 9 P. O. R. 325.

Application for a patent for "Improvements in or appertaining to machines for separating dust or like particles from air or other gases."

Opposed on the ground of a prior patent, No. 9,423 of 1886.

It appeared that the inventions of both the applicant and opponent were for separating dust, &c. from air by means of centrifugal action. It was contended by the applicant that his invention was an improvement upon that described in an

expired patent No. 6,873 of 1884, whereas the opponent alleged that it was a colourable imitation of the invention described and claimed in the specification No. 9,423 of 1886.

Before sealing the patent, the Comptroller required the insertion of the following disclaiming clause:—

"I am aware of the specification of letters patent No. 9,423 of 1886, granted to *Henry Harris Lake*, and I wish it to be understood that I make no claim to anything described and claimed therein."

On appeal, the Attorney General struck out the above-cited clause, and required the insertion of a reference to the prior patent No. 6,873 of 1884 and No. 9,423 of 1886 in the terms set out in the judgment. No order as to costs.

Per WEBSTER, Att. Gen. The argument on behalf of the appellant has satisfied me that the Comptroller has gone too far in this case.

The Comptroller directed a disclaimer to be inserted which, practically speaking, would have indicated on the face of it that *Van Gelder's* claims might be construed so as to include something which was in *Lake's* claims under the patent No. 9,423 of 1886; and under the circumstances of this case, I think the insertion of a disclaimer might unfairly prejudice the patent.

It is said the apparatus described in *Lake's* specification is not useful.—I have nothing to do with that; if it be so, the patent will be held bad in any proceedings in which the question of its validity arises. The point of view in which I regard this question of reference is to guide the public to the proper construction of the specification.

The Attorney General then discussed the several inventions as patented, and continued:—

Upon the evidence before me, a type of machine in which all auxiliary adjustments were dispensed with was that shown in the specification No. 6,873 of 1884, and I therefore shall

direct that in the statement of prior knowledge, there shall be included a reference to this simply as a fact which should fairly be mentioned, inasmuch as the patentee has thought fit, under, no doubt, good advice, to refer to a type, as he calls it, of this machine; and these words will I think read best:—

"One machine of this type is well set forth in expired patent No. 6,873 of 1884, only in place of having the spiral chambers inside the main one, I do not extend the spout A, set forth in said specification, into the chamber except to the rudimentary extent hereinafter set forth; and I do away with all other internal apparatus set forth in the drawings of said specification except the simple walls and cover of the chamber."

Now it cannot be denied that if you do away with the spiral chambers inside the main chamber, and have nothing but "simple walls and cover," then, barring a relation between circular and conical which has been relied on, that would be a description which would in terms include *Lake's* patent; and that being so, it is only common fairness to say:—"Another form of such machine is shown in the specification of letters patent No. 9,423 of 1886 granted to *Henry Harris Lake*." Therefore I shall disallow the disclaimer which the Comptroller directed to be inserted, and shall order a reference to be inserted substantially as I have stated it.

In this case I think the appellant was justified in bringing the appeal; but inasmuch as the disclaimer was, practically speaking, ordered by the Comptroller, and was not insisted on by the opponent, and the opponent has not appealed against the decision, it is a case in which I shall leave each party to pay their own costs.

Re STUART. No. 15,835 of 1890. 9 P. O. R. 452.

Application for a patent for improvements in machinery for making nets for fishing, opposed by *Young* on the ground that the applicant had obtained the invention from him.

Several declarations were filed, but the nature of the evidence is not stated in the report.

The Comptroller was of opinion that the weight of evidence was in favour of the opponent, and refused to seal the patent.

On appeal, decision affirmed with 30 guineas costs, and 10 guineas in respect of the costs of an application for leave to file additional evidence before the Law Officer.

During the hearing, CLARKE, Sol. Gen., said :—I think that the Law Officer is only entitled to stop the issue of a patent, having examined all the evidence given on one side or the other, if he is so clearly of opinion that the opponent has made out his case that he would, if a jury were to find in favour of the applicant, refuse to accept it and overrule the decision on the ground that it was perverse and contrary to the obvious weight and effect of the evidence. That is the proposition which I keep before my mind.

In delivering judgment CLARKE, Sol. Gen., said :—The decision of the Comptroller, who said that, in his opinion, the weight of evidence was in favour of the opponent, does not exactly express the result at which, in my opinion, it is necessary that a Law Officer should arrive before he refuses the sealing of a patent. Having regard to the fact that by allowing the issue of a patent I do not close the matter, but leave it open to the opponent to challenge, in a Court of Law, the validity of that patent, I do not think I ought to refuse to permit a patent to be sealed unless I am satisfied that no jury could reasonably come to a decision in favour of the applicant. In this case I am of that opinion.

Upon the fullest consideration I can give to all these declarations, I not only think that the weight of evidence is in favour of the opponent, but I think that the opponent's case is so overwhelmingly strong that it would be unreasonable to come to another conclusion in the matter. In these circumstances I uphold the decision of the Comptroller.

The matter has been a lengthy one and an expensive one, but it is not the custom of the Law Officers upon these appeals to attempt to give costs to such an amount as will indemnify the parties. To do so would be seriously to discourage the appeals, and to limit very much the usefulness of the office which the Law Officers fill in these matters. The Solicitor-General thereupon awarded costs as stated above.

Re TODD. No. 8,802 of 1891. 9 P. O. R. 487.

Application for a patent for "Improvements in stoppers for bottles, jars, and the like," opposed by *Phillips* as grantee of a prior patent, No. 533 of 1888.

The invention of *Phillips* related to improvements on a stopper for bottles known as the "Union" stopper, which was commonly in the form of a wooden plug having a head piece coated with thin metal. The cylindrical plug was inserted into a cylindrical cork sheath to which it was glued, the sheath supported by the wooden plug forming the actual cork for the bottle.

According to *Phillips*, the internal plug of wood was dispensed with and a solid cork or bung was employed without the use of glue or cement.

A head-piece was first stamped out of sheet metal, being in the form of a cap or short hollow cylinder with one end closed. The specification stated that within this cap or head-piece there was to be inserted "a suitable strip of sheet metal or metal plate placed on edge and bent into a waved shape with, at convenient distances, sharp pointed pieces projecting inwards which enter the upper portion of the sides of the cork."

The result was that the cork was held by the strip of corrugated metal, and both the strip and cork were attached to the head-piece.

There were several drawings, but claim 40 related to one mode of construction as to which no drawing was appended.

Claim 40 was as follows:—The method of preventing the cork or other material forming the body portion of the stoppers from rotating, consisting of a strip of metal placed on edge in the space surrounding the upper end of the cork and bent into a waved shape to prevent its rotating in the cap or head-piece, and having sharp-pointed pieces projecting into the upper portion of the sides of the cork or other material, substantially as described.

According to *Todd*, an open cylindrical cap or head is first stamped out of sheet metal, after which "a strip of metal having a breadth somewhat less than the depth of the projecting rim of the head is crimped or bent into a zig-zag fashion, and is then bent round into a circular shape and inserted within the rim of the head as a lining." The cork is then inserted, the edge of the cap is turned over, whereby the projecting parts of the lining are forced into the cork, and the stopper is ready for use.

The Comptroller required the insertion of a general disclaiming clause:—"I am aware that a lining bent into a wave shape has previously been proposed for the heads of stoppers of this kind, and I make no claim to such lining apart from the particular construction I have described and illustrated on the drawings."

He also altered the *claim* whereby it stood as follows:—"Securing a cork to a metallic head by a *crimped or bent in zig-zag fashion* lining inserted between the turned up edge of the head and the cork, and forced into the cork and secured in the head by turning over the said edge of the head substantially as described *with reference to the drawings*." The words in italics were put in by the Comptroller, the lining being described as "corrugated" in the original claim.

With these amendments the patent was to proceed.

On appeal, the application for a patent was refused, with 10 guineas costs.

Per WEBSTER, Att. Gen. In cases where the Law Officer is forced to the conclusion that there is no substantial difference between the invention or combination described in the applicant's specification and an earlier specification, it has not only been the practice, but it is the duty, of the Law Officer to refuse the patent.

I have listened with the greatest care to counsel's argument, and with every wish to permit this application to go forward if I could; because I have always acted on the principle that it is only in the clearest possible case that a patent ought to be stopped.

I am of opinion that the invention purported to be claimed in this case is so identical with that which is disclosed in the opponent's specification, that this application cannot be allowed to proceed.

The Attorney General then commented on some passages in *Phillips'* specification, quoting *inter alia* a passage on page 12 thereof, which described as of the invention :—"a suitable strip of sheet metal or metal plate placed on edge and bent into a waved shape, with, at convenient distances, sharp-pointed pieces projecting inward, which enter the upper portion of the sides of the said cork," and continued :—

I have not to deal with subject matter properly so called, that is to say, supposing *Todd's* invention to have been the first invention brought before me, it would not matter whether it showed no subject matter if it was a claim to that which had not been done before—I quite agree I have not to consider whether it is subject matter or not. But when there is a previous anticipatory patent, it is necessary to consider then indirectly the differences, and without saying whether those differences form subject matter or not, to decide whether the differences are sufficient to differentiate that which has gone before from that which is now claimed.

Now I observe that in the description of the actual drawing

at line 44 the applicant says: "The strip B may be punched with small holes so as to form a roughened surface at the part which enters the cork, or may have its bottom edge turned inward," and above that he says, "The cork C is then inserted in the centre of the lining B, and the edge *a* of the head A is turned over as shown in Figs. 7, 8, and 9, so as to force the lining inwards."

It may be a very useful form of cork, but what it amounts to, in my judgment, is that the entrance of the strip into the cork is achieved by bringing pressure to bear upon the outside of the cap when it is turned over. I cannot see that that affords any difference from the point of view of invention as compared with that which was described in the earlier specification.

Re BIRT. No. 21,250 of 1890. 9 P. O. R. 489.

Application for a patent for "Improvements in bicycles, tricycles, and other velocipedes."

Opposed by *Swindley* on the ground that the complete specification described and claimed an invention other than that described in the provisional specification, and that such other invention formed the subject of an application made by the opponent in the interval between the leaving of the provisional and complete specifications.

Swindley's application was dated 13*th Feb.* 1891, No. 2,657, and his complete specification was lodged on 10*th Dec.* 1891.

Birt's application was dated 31*st Dec.* 1890, and his complete specification was lodged on 30*th Sept.* 1891.

It appeared from *Birt's* provisional specification that one part of this invention consisted "in providing a removable air-tube within the usual tubular-cushioned or pneumatic tyre, this air-tube being made in one or more parts or sections, each furnished with a valve or other means for retaining the compressed air therein."

The provisional specification went on to say:—"The air-tube fits in the tubular tyre and can readily be removed therefrom or replaced therein through a lateral slot or opening without removing the tyre proper from the wheel."

In the complete specification, at Figs. 21–25, the air-tubes were shown as made in four sections, with valves, and placed within the tyre which was fitted upon the rim of the wheel, but the openings for inserting or removing the air-tubes were holes cut in the rim and in the portion of the tyre in contact with the rim. It was objected that such opening did not come within the descriptive words, "lateral slot or opening without removing the tyre proper from the wheel."

It further appeared that *Swindley's* application related to an invention of improvements in pneumatic or inflated tyres for the wheels of velocipedes, which consisted in a method of inserting and securing air-tubes in such tyres by "forming in the rim of the wheel one or more holes or slots through which the air-tube could be inserted or withdrawn from the tyre without disturbing the connection of the said tyre with the rim of the wheel," and there was a further provision for closing the inside of the rim by a plug or plate.

The Chief Examiner decided to seal the patent, being of opinion that there was no disconformity between the provisional and complete specifications of the applicant.

On appeal, decision affirmed, with 8 guineas costs.

Per WEBSTER, Att. Gen. I am of opinion that I cannot interfere with the decision in this case. There are practically two questions involved. The *first* and most important is whether in fact, on the construction of the complete specification, this slot in the wheel rim is fairly within, or is a fair development of, that which was described in the provisional; and *secondly*, whether or not there is any ground for contending that if the complete specification is allowed to remain in the present form it will either include something which was outside

the provisional, or something which may be said to have been the same as in the specification of *Swindley*.

The Attorney General then described the applicant's invention in general terms, and quoted the passage: "Another part of my invention consists in providing a removable air-tube within the usual cushioned or pneumatic tyre," and continued:—

Now I think it is fair to come to the conclusion that the applicant was referring to a complete tyre; that that complete tyre would be fastened on to some arrangement, such as a rim, in order to be retained in its place. The removable air-tube is to be made "*in one or more parts or sections, each furnished* with a valve." Then, "the air-tube fits in the tubular tyre, and can readily be removed therefrom or replaced therein through a lateral slot or opening without removing the tyre proper from the wheel."

The specification deals with the tubular tyre as a whole; not a sector of a circle or other section of a circle cemented on, but a tubular tyre which is intended to be fastened on by well-known means to the rim. It is through that tubular tyre that the slot is to be made, and I think that the fair and proper construction of those words as they stood would be that, in the absence of any evidence to the contrary, they ought to entitle the applicant to make a lateral slot or opening within any part of that tubular tyre, even though it should go through the rim, and especially when it is remembered that the words are used "without removing the tyre proper from the wheel."

The Attorney General further discussed the question as to whether there was any ground for a suggestion that the applicant had intended that the cut made in the tyre for the insertion of the tube should be subsequently closed up by lacing or cementing, and after inspecting an original drawing made by Mr. *Birt*, arrived at the conclusion that there was a clear indication that a cut might be made in the rim, but no indication of any means of fastening up the aperture in the tyre by

lacing or cementing or otherwise, after the tube had been inserted. He further said:—I think that, on the materials before me, Mr. *Swindley* had not sufficient ground for lodging this appeal, and therefore think that this is a case in which the ordinary consequences ought to follow, and that I ought to dismiss the appeal with eight guineas costs.

Re CURTIS & ANDRÉ. No. 11,383 of 1891. 9 P. O. R. 495.

Application for a patent for "Improvements in the manufacture of gunpowder."

Opposed by *Heidemann*, and by *Abel* and *Dewar*, on the ground of a prior patent No. 11,664 of 1889, and by *Lundholm* and *Sayers* as grantees of the patent No. 12,338 of 1889.

The application related to the manufacture of smokeless powder, and the specification stated:—

"Heretofore nitro-cellulose, either in the soluble form (as dinitro-cellulose) or in the insoluble form (as trinitro-cellulose), has been used in combination with nitro-glycerine as an ingredient in 'explosives for blasting purposes, and more recently in smokeless powder.'

"Now we have discovered, by a series of experiments extending over a long period of time, that a mixture during manufacture of the insoluble with the soluble varieties of nitrated cotton in certain proportions, say about two of the former to one of the latter, forms a base which in combination with nitro-glycerine gives a product differing materially in its physical qualities from those obtained from the use of one variety of nitrated cotton alone, and one which is more suitable as a gunpowder. This our product is translucent, tough and leathery, and is practically smokeless."

Further directions for making the compound were given, the material being granulated in the usual way. Other ingredients might be incorporated in small proportions.

Claim 1. The manufacture of smokeless gunpowder con-

sisting of a nitro-cellulose base composed of soluble and insoluble nitrated cotton in combination with nitro-glycerine, in or about the proportions named, and with or without modifying agents, substantially as set forth.

2. In the manufacture of nitro-glycerine explosives suitable for fire-arms, the application and use of soluble and insoluble nitro-cellulose in or about the proportions named substantially as set forth.

It appeared that the specification No. 12,338 of 1889 claimed :—"The improvements in the manufacture of explosives consisting in combining nitro-glycerine with so-called insoluble nitro-cellulose, and with or without soluble nitro-cellulose, nitro-oxycellulose, or nitro-hydrocellulose with the aid of heat and pressure combined, substantially as hereinbefore described." And it was admitted that what was called "insoluble nitro-cellulose" might contain a considerable amount of "soluble nitro-cellulose."

The Comptroller decided to seal the patent.

On appeal by *Lundholm* and *Sayers*, the Attorney General held that either the claims must be modified or a disclaimer be inserted, and that on this being done, the patent should be sealed. No order as to costs.

Per WEBSTER, Att. Gen. For some time I did entertain very considerable doubt whether this claim in *Curtis* and *André's* specification is for anything more, in other words, than the combination which had been foreshadowed and claimed by *Lundholm* and *Sayers*.

The Attorney General then discussed the language of the several specifications, and after referring to the admitted fact that so-called "insoluble nitro-cellulose" would include some "soluble nitro-cellulose" he gave his decision :—either that both claims should be distinctly confined to a mixture of insoluble and soluble, the one with the addition of nitro-glycerine and the other without; or that there should be a

disclaimer by a statement that the patentee is aware, that nitro-glycerine explosives have been made from one variety of insoluble nitrated cotton, though such variety contained some proportion of soluble nitrated cotton, and that no claim is made thereto, but what is claimed is the use of the explosive produced from a mixture of insoluble nitrated cotton with soluble nitrated cotton in the proportions in the specification.

Re WILSON. No. 12,974 of 1890. 9 P. O. R. 512 (*note*).

Application for a patent for "Velocipede and other wheel tyres."

Opposed by four separate opponents, *Trigwell*, *Golding*, *Bartlett*, and *Smallman*, each on the ground that the complete specification described and claimed inventions other than that described in the provisional specification, and that such invention formed the subject of applications made by the opponents in the interval between the leaving of the provisional and complete specifications.

The invention related to improvements in velocipede tyres, by constructing the outer part of hard rubber with an inside core of spongy rubber. In one modification the inner portion was a pneumatic tube.

The complete specification showed special means for fastening the tyres to the wheels, and such means were claimed.

The Comptroller decided that the complete went beyond the provisional specification, and ordered an excision of certain figures in the applicant's specification, with a corresponding amendment of the description and claims.

On appeal, WEBSTER, Att. Gen., varied the decision of the Comptroller, and required the insertion of a disclaiming clause to the effect that *Wilson's* methods of fastening the tyres to the wheels formed no part of his invention.

Re BARTLETT. No. 16,783 of 1890. 9 P. O. R. 511.

Application for a patent for "Improvements in tyres or rims for cycles and other vehicles."

Opposed by *Wilson* as grantee of a prior patent No. 12,974 of 1890.

The invention comprised a metal rim having its edges bent into a dovetail shape for receiving the edges of an arched rubber band which enclosed a pneumatic tube.

Claim 1 was for a grooved rim and an arched tyre of india-rubber held in the groove by the pressure of an inflated tube within the arch against the sides of the groove as described.

Claim 2. Tyres or rims for cycles and other vehicles, substantially as described and shown on the drawings.

The Comptroller decided to seal the patent, subject to amendment of claim 2, so as to make it clear that the words "tyres and rims" referred only to the parts combined and arranged as shown on the drawings.

On appeal, decision affirmed, with 8 guineas costs.

WEBSTER, Att. Gen., compared the dates of the specifications which were as follows:—

Wilson.	Provisional specification .	19 *Aug.*, 1890.
	Complete . . .	19 *May*, 1891.
Bartlett.	Provisional specification .	21 *Oct.*, 1890.
	Complete . . .	20 *July*, 1891.

and said:—If I were to permit *Wilson's* complete specification to stop this application, I might be doing a very serious injustice to *Bartlett* in the event of his satisfying a Court that the statement contained in *Wilson's* complete specification is not an anticipation, and that that mode of fastening was, in fact, new at the date of his application.

I have looked most carefully at *Bartlett's* provisional specification, and I am satisfied that he did intend to describe as his invention the method of fastening the tyre within the dovetailed rim, by having a horse-shoe piece of thicker rubber

with or without lugs, which horse-shoe piece was pressed outwards by the extension of the internal tube filled with air. I agree, when the complete specification comes to be looked at, there is language in *Wilson's* specification which obviously does point to the same operation, either as part of the description or, it may be, as the method of fastening altogether. But I am satisfied that it would not be just, having regard to my previous decision to allow *Wilson's* description, which I permitted to remain at the request of *Wilson's* counsel, to be used as an argument against *Bartlett's* earlier claim to the mode of fastening.

It seems to me that having given a distinct decision that *Wilson's* invention was to be confined to the construction of the tyre, I could not in justice hold that *Wilson* was entitled to rely, as anticipating *Bartlett*, on the references contained [in his specification] to the mode of fastening.

I should of course adhere to the view laid down by Lord Herschell as Solicitor General, and my colleague the present Solicitor General, that in order to justify an opponent in succeeding upon the ground that an invention has been patented upon an application of prior date, he must show that the invention comes within that which is fairly described as invention in the earlier specification. In this case if I had come to the conclusion that in the provisional specification of *Wilson* there had been a description of this invention, followed up by a claim in the complete, I certainly should have given greater weight to *Wilson's* opposition; but having treated the words in his specification as pure matter of description, I think it would not be within the rule that has been laid down by my predecessors and by myself.

Re THWAITE. No. 15,591 of 1890. 9 P. O. R. 515.

Application for a patent for "Improvements in methods for inducing circulation of water in steam generators and in

apparatus therefor." Opposed by *Gamgee* on the ground that the applicant had obtained the invention, or a material part thereof, from him.

A number of declarations were filed.

The Comptroller decided to seal the patent.

On appeal, several of the declarants were cross-examined, and leave was given (under Sect. 38 of the Patents Act of 1883 and Rule 8 of the Law Officer's Rules) to call as witnesses persons who had not made declarations.

WEBSTER, Att. Gen., in delivering judgment, stated that, in his opinion, the words "obtained the invention" in sub-sect. (1) of sect. 11 of the Patents Act of 1883 referred solely to the identity of the invention, and not to any right in the person from whom the invention was obtained to be regarded as the true and first inventor, and he decided that all that portion of the provisional and complete specifications which related to the first five claims and one drawing should be struck out, and he allowed the appeal with 20 guineas costs.

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THE END.

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