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THE PRESENT

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BY

H. FLETCHER MOULTON

BARRISTER-AT-LAW

Joint Author of Roberts' and Moulton's "The Patent Act, 1907."

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THIS WORK IS

DEDICATED

PREFACE

THE English Law of Letters Patent is of the greatest interest both from the legal and the commercial point of view. It was the forerunner and the model of the Patent Laws of all countries; in the past it has greatly helped to build up the commercial supremacy of this Country, and on the certainty and justness of this law and its administration depends to-day the willingness of capital to assist in developing new inventions.

But the subject is one whose treatment presents great difficulties to the author, since the majority of the reported decisions really turn on questions of fact. The Courts have quite properly realised this and the practice of quoting numerous authorities on such questions as subject-matter and infringement has greatly decreased. Nevertheless the citation of a really apposite decision is often of the greatest value, and the just appreciation of prior decisions is also of great assistance to those who have to advise on questions relating to Letters Patent. I have therefore attempted to give in a digested and classified form the decisive points in all such cases as may be likely to be of assistance for either of these purposes.

This work presents the law and practice in regard to Letters Patent as it stood at the end of 1912. Although the basic principles of this law have remained unchanged, recent legislation has greatly affected the practice. The Patents Act of 1907 has also introduced many fresh problems for the practitioner, and some of the most important of these —as for example those referring to restrictive conditions in licences, a point to which public attention has been recently called—have not yet had the benefit of judicial elucidation. In such cases the legal and practical applications of the new provisions have been fully discussed with a view to assisting those who may have to advise thereon.

The practice in the High Court has been fully treated, as there are many points of frequent occurrence in patent cases with which those who only occasionally have to deal with the subject are necessarily unfamiliar.

Special attention has been paid to the practice of the Patent Office. Unfortunately until recent years the decisions of the Comptroller were not reported, and many important and well-defined points of practice were little known. Happily the present Comptroller General has introduced a change in this respect, and I have endeavoured to make the fullest use of the fresh materials supplied by the reports of his decisions. I take this opportunity of expressing my thanks for the great assistance which has been rendered to me in regard to the chapter on Patent Office Practice by Mr. W. J. Tennant, who has placed his great experience in the matter at my disposal.

Some suggestions have also been added as to the method of drafting specifications. The importance of this subject cannot be overrated, as the existence of a clear and uniform system of drafting both lightens the labours of the Courts and greatly increases the security of Letters Patent.

In conclusion I wish to express my thanks to Mr. E. W. Sheppee and to Mr. J. H. Evans-Jackson for their assistance in preparing this book for the press.

H. FLETCHER MOULTON.

11, KINGS BENCH WALK, TEMPLE.

February, 1913.

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ABBREVIATIONS AND REFERENCES

The following abbreviations should be noted—

C.G. - -	Comptroller General.
I.H. - -	Inner House.
L.O. - -	Law Officer.
O.H. - -	Outer House.
Carp. - -	Carpmael's Patent Cases.
Davies. - -	Davies Patent Cases.
Goodeve -	Goodeve's Patent Cases.
Griff. - -	Griffin's Patent Cases (1887).
Griffin L.O.C.	Griffin's Patent Cases decided by the Comptroller General and Law Officers (1888).
Macrory. -	Macrory's Patent Cases.
W.P.C. - -	Webster's Patent Cases.

References to the *Law Journal* and the *Law Times* are to the new series unless otherwise stated. References to "Webster's Patent Cases" to the first volume unless otherwise stated.

The References to the reports of the Court of Sessions cases are given with the series in Arabic and the volume in Roman numerals, thus 4 S. XII 100.

References to sections refer to the Patents and Designs Act, 1907 (7 Ed. VII. c. 29), unless otherwise stated.

The dates of cases in the Reports of Patent Cases are not inserted in the notes, as each volume contains the cases for one year, the first volume having those reported in 1884.

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Page 199. Chadburn *v.* Robinson, 18 R. P. C. 468, *should be* 22 R. P. C. 468.

LAW OF PATENTS

CHAPTER I

PROPERTY IN LETTERS PATENT

Nature of Patent Rights

Meaning of patent.

THE Letters Patent dealt with in this book are grants of the sole privilege of exercising an invention.

Early patents.

The granting to private persons or corporations of the monopoly of a trade or manufacture was an exercise of the Royal Prerogative which at one time was largely used. Such grants were, however, unfavourably regarded by the Courts, and it was held that the grant by the King of the monopoly of an existing trade was void at common law, unless it was also legalised by the consent of Parliament or by prescription, since the effect of such a monopoly was "to take away free trade, which is the birthright of every subject" (*a*).

Statute of monopolies.

The question of monopolies was dealt with by Parliament in 1624 by the passing of the Statute of Monopolies (*b*). This Statute declared monopolies (*c*) in general to be bad. But the case of new manufactures was excepted by the sixth section, which was as follows :—

"Provided also, and be it declared and enacted, that any declaration, before mentioned, shall not extend to any Letters Patent and grants of privilege for the term of fourteen years or under, hereafter to be made, of the sole working or making of any manner of new manufactures within this Realm, to the true and first inventor and inventors of such manufactures, which others

(*a*) The Clothworkers of Ipswich (1615), Godbolt 252.

(*b*) 21 Jac. 1, c. 3. See also *Darcy* v. *Allin* (1602), Noy 178.

(*c*) Coke defines a monopoly as "an institution or allowance by the King by his grant commission or otherwise to any person or persons, bodies politique or corporate of or for the sole buying selling making working or using of any thing whereby any person or persons bodies politique or corporate are sought to be restrained of any freedome or liberty that they had before or hindered in their lawful trade," Inst. part III., c. 85.

at the time of making such Letters Patent and grants shall not use, so as also they be not contrary to the law, nor mischievous to the State, by raising prices of commodities at home, or hurt of trade or generally inconvenient. The said fourteen years to be accounted from the date of the first Letters Patent or grants of such privilege hereafter to be made, but that the same shall be of such force as they should be, if this Act had never been made, and of none other."

This section is quoted in full since it still forms the basis of the whole of the English Patent Law, and it may be said of the patent laws of the world. Although in form it merely declares that certain grants of the sole privilege of working shall have the force they formerly had, it was in fact, and has always been treated by the judges as being, declaratory as to what grants of this kind were legal (*d*). There is no reported case since the passing of the statute in which a patent satisfying the conditions here laid down has been declared void at common law.

Statutes relating to patents.

A number of statutes have since been passed dealing with the subject of patents for inventions (*e*), but these have dealt mainly with the machinery for the grant and enforcement of patents, and the question as to whether the grant is one which might legally be made is still ordinarily determined by the above section.

(*d*) *Australian Gold Recovery Coy.* v. *Lake View Consols Coy.*, 18 R. P. C. 114; *Feather* v. *The Queen* (1865), 6 B. & S. 257; *cf.* Coke's Institutes, part III., c. 85.

The reason given by Coke why such privileges, even if fulfilling the Statutory conditions, might yet be declared illegal, was to provide for cases where the long period of the grant might be found to be prejudicial to apprentices.

(*e*) Statutory Declarations Act, 1835, s. 11 (5 & 6 Will. 4, c. 62).

Statute 5 & 6 Will. 4, c. 83.

Statute 2 & 3 Vict. c. 67.

Statute 7 & 8 Vict. c. 69.

The Patent Law Amendment Act, 1852 (15 & 16 Vict. c. 83).

Statute 16 & 17 Vict. c. 115.

Statute 22 Vict. c. 13.

The Industrial Exhibitions Act, 1865 (28 & 29 Vict. c. 3).

The Protection of Inventions Act, 1870 (33 & 34 Vict. c. 27).

The Great Seal Act, 1880 (43 & 44 Vict. c. 10).

The Revenue, Friendly Societies, and National Debt Act, 1882 (45 & 46 Vict. c. 72).

Patents, Designs and Trade Marks Act, 1883 (46 & 47 Vict. c. 57).

Patents, Designs, and Trade Marks (Amendment) Act, 1885 (48 & 49 Vict. c. 63).

Patents Act, 1886 (49 & 50 Vict. c. 37).

Patents, Designs, and Trade Marks Act, 1888 (51 & 52 Vict. c. 50).

Patents Act, 1901 (1 Ed. VII. c. 19).

Patents Act, 1902 (2 Ed. VII. c. 34).

Patents and Designs (Amendment) Act, 1907 (7 Ed. VII. c. 28).

Patents and Designs Act, 1907 (7 Ed. VII. c. 29).

Patents and Designs Act, 1908 (8 Ed. VII. c. 4).

The provisions as to patents contained in all these Statutes, except the last two, have been repealed. All the provisions of the 1907 Act except those contained in s. 33, s. 37, and s. 41 (1) apply to patents of any date.

Such grants were formerly mere voluntary exercises of the Royal Prerogative, and undoubtedly then no one had the right to the grant of a patent. The present Patent Act, like the Act of 1883, saves the prerogative of the Crown (*g*), but since a complete machinery is provided for the granting of patents; and the officers appointed by the Act are directed either expressly or by implication to carry out each step (*h*) necessary for such grant, provided that the applicant has an invention and has fulfilled the proper formalities, it may be said that Parliament has now given an inventor the right to a patent under certain conditions (*i*).

Right to a patent.

Patents were formerly issued by the Lord Chancellor under the Great Seal, but by the Act of 1883 and the present Act a Patent Office has been created having its own seal (*k*).

Seal of Patent Office.

A patent can be granted to a British subject or *alien ami*, but it is doubtful whether it could be granted to an *alien enemi* or to any person in trust for him (*m*). It can be granted to one or more persons or to a corporation, but the grantees must include the inventor, or in the case of his death his personal representatives (*n*).

Persons to whom patents may be granted.

The Letters Patent granted by the Patent Office are of two classes, (1) Ordinary Letters Patent ; (2) Patents of Addition (*o*).

Classes of patents.

Ordinary Letters Patent are granted for a term of fourteen years from the date of application, but are subject to defeasance if the patentee fails to pay renewal fees or to supply articles for the public service (*p*). There is also a provision for defeasance if it should be made to appear to six members of the Privy Council that the grant is contrary to law or prejudicial or inconvenient to the King's subjects in general, or that the invention was not new, or the grantee was not the first and true inventor, but there is no reported case of defeasance under this provision.

Ordinary patents.

(*g*) Sect. 27. As to Letters Patent still being an exercise of the prerogative, see *Von Heyden* v. *Neudstadt* (1880), 14 Ch. D. 230.

(*h*) *Cf.* s. 3, s. 6, s. 7 (3), s. 12.

(*i*) As to whether this right can be enforced by mandamus, see p. 290.

(*k*) Sect. 14 and Patents, Designs and Trade Marks Act, 1883 (46 & 47 Vict. c. 57), s. 12.

(*m*) *Bloxam* v. *Elsee* (1825), 1 Car. & Payne 558 ; *Beard* v. *Egerton* (1846), 15 L. J. (C. P.) 270.

(*n*) See p. 253.

(*o*) Special grants may be made in cases of revocation on the ground of fraud, see p. 216, and in cases of prolongation, see p. 318.

(*p*) See form of letters patent, Appendix, *post*. The fourteen years includes day of date, *Russel* v. *Ledsam* (1845), 9 Jur. (O. S.) 557. *Semble*, even after a defeasance an action may be brought for infringement before lapse. See *Hill* v. *Mount* (1856), 25 L. J. (C. P.) 190.

Apart from the effect of the defeasance clauses Letters Patent are liable to be terminated by revocation on various grounds (*q*). They may also come to an end by surrender (*r*), and possibly by merger in the Crown in the absence of any person holding the legal interest (*s*). They may be restricted in scope by amendment (*t*), or in operation by the grant of compulsory licences (*u*).

Patents of addition.

These differ from other grants in that no renewal fees are payable, and that they come to an end with the original patent. Otherwise it would seem that they have the same effect, and are subject to the same restrictions as other grants (*x*).

Nature of patent right.

Although the question of the grant, etc., of patents has now been dealt with by Act of Parliament, and the grant is always made in one of the forms authorised by the Act, or the rules under it (*y*), the rights of the patentee are wholly derived from, and to be found in, the grant itself (*z*).

The patent so issued is in the form of a grant from the Crown which is twofold in its nature, in that it firstly gives to the patentee (*a*) the sole right to make, use, exercise, and vend within the United Kingdom and the Isle of Man (*b*) the invention patented, and secondly forbids others to do any of these acts. The first portion of this right was of importance in the early days of Letters Patent as freeing the patentee from the interference of the various trade guilds, but is now chiefly of historic interest (*c*). The second portion is in the nature of a *chose in action* (*d*), or a right which the patentee may assert whereby the patentee derives his profit either by maintaining

(*q*) See Chapter XI.

(*r*) Sect. 26 (3).

(*s*) See *In re Taylor's Agreement Trusts*, 21 R. P. C. 713; *Heath's Patent*, 29 R. P. C. 390.

(*t*) See Chapter XIII.

(*u*) See pp. 251, *et seq.*

(*x*) See p. 262.

(*y*) Sect. 14 (2).

(*z*) See p. 156, *n.* (*a*).

(*a*) This term includes executors, administrators, and assigns; see also p. 291.

(*b*) Besides the privileges in the United Kingdom, the grant gives the patentee the right to acquire similar privileges in certain British possessions by registering the grant there. The rights under the International Convention (see *post*, p. 259) arise from the application not from the grant.

(*c*) See Gordon on Monopolies, p. 121. A patent, however, gives no right to work the invention if it infringes an earlier patent. See *Saxby* v. *Kennett* (1873), 42 L. J. (EX.) 137; *Steers* v. *Rogers*, 10 R. P. C. 251, H. L. See also *Stead* v. *Carey* (1845), 14 L. J. (C. P.) 177.

(*d*) *British Mutoscope Coy.* v. *Homer*, 18 R. P. C. 177; *Heath's Patent*, 29 R. P. C. 390, and *Steers* v. *Rogers*, *supra*.

Stephen (Commentaries, Vol. II. p. 969) defines the patent right as an "incorporeal chattel," but *cf.* *Heath's Patent*, *supra*. It also comes within the definition of a "Franchise." *R.* v. *County Court Judge of Halifax*, 8 R. P. C. 338.

for himself a monopoly of the manufacture, with the extra profits that flow from such monopoly, or by obtaining sums from others who wish to use the invention for abstaining from asserting his full rights, that is to say, by granting licences.

Courts having patent jurisdiction.

This right must in England be asserted in the High Court or in the County Palatine Court, which have by the Act sole jurisdiction (*e*).

Effect of patent against Crown.

The patent is of the same effect against the Crown as against a subject, but any Government Department may use the invention by themselves and others on terms to be agreed either before or after use, or in default of agreement to be settled by the Treasury (*f*). Also, although the prohibition clause is in terms only addressed to the King's subjects, it has been held that its effect extends to foreigners interfering with the sole privilege granted (*g*).

Whether grant is voluntary or for consideration.

There has in the past been much discussion as to whether the grant is a purely voluntary one by the Crown without any consideration, or whether the inventor is to be considered as having given good consideration by the communication of his invention. The chief importance of the point is on the question as to whether the grant and specification are to be construed strictly against the grantee or not. It may be said that, at any rate as far as the construction of the specification is concerned, the view, powerfully upheld by Lord Eldon, that the invention communicated is consideration for the grant has in fact prevailed (*h*).

(*e*) *R.* v. *County Court Judge of Halifax, supra.* The Court were also of opinion that the jurisdiction of the County Court was also ousted, where the validity was in question, by sect. 56 of the County Court Act, 1888, since the trial would involve the investigation of the title to a Franchise.

(*f*) Sect. 29. This section was pleaded as a defence in *Nobel's Explosive Coy., Ltd.* v. *Anderson*, 11 R. P. C. 115, but the plea was not relied on at the trial. In this respect the inventor's rights are increased by the Statute, since at common law the patent was ineffectual against the Crown: *Feather* v. *The Queen* (1866), 35 L. J. (Q. B.) 200; *Ex parte Pering* (1836), 4 A. & E. 949. The only way of enforcing the right is by action against the agent using the invention since infringement being a tort there cannot be a Petition of Right in respect of it: *Feather* v. *The Queen, supra.* The right of a Government department to use an invention may now be exercised through contractors, sect. 29; formerly it was otherwise: *Dixon* v. *London Small Arms Coy.* (1876), 1 A. C. 632.

(*g*) *Caldwell* v. *Vanvlissingen* (1851), 9 Hare, 415.

(*h*) See *per* Lord ELDON in *Williams* v. *Williams* (1817), 3 Mer. 157, and *Australian Gold Recovery Coy.* v. *Lake View Consols Coy.*, 18 R. P. C. 114, P. C. See *contra*—*Feather* v. *The Queen, ubi supra*, at p. 205; see also p. 306, *n.* (*e*).

Devolution of Patent Rights

State of the law as to property in patents.

The whole subject of property in Letters Patent is but meagrely covered by judicial decisions, and many of these decisions are based on suggested analogies between real property and Letters Patent which afford a somewhat unsatisfactory method of deciding such questions (*i*), and may lead to results which are obviously unjust (*k*). This difficulty is aggravated by the inconsistent and indefinite usage of the term "patentee" both in the Act and in judicial language (*l*).

Devolution of property.

The property in Letters Patent can pass—

(*a*) By devolution of law.

(*b*) By assignment.

Devolution of law.

Property in Letters Patent passes by devolution of law by the death or bankruptcy of the patentee. Letters Patent are personal property both by English and Scotch law (*m*), and pass to the personal representatives of the deceased patentee (*n*). In the case of bankruptcy the property has always vested in the assignee or trustee in bankruptcy (*o*). Letters Patent cannot be taken in execution or be reached by a judgment creditor otherwise than by bankruptcy (*p*).

In the case of the absence of personal representatives, or in the case of a company which has been wound up being the owner, the patent probably merges in the Crown. But if there is an equitable owner such equitable owner may be registered as proprietor (*q*).

In the case of an inventor dying before application for Letters Patent his personal representatives may apply for letters patent in respect of his invention (*r*).

Assignment.

Letters Patent being a grant can only be assigned by deed (*s*), consequently an agent to be able to assign must have

(*i*) There is, for example, no analogy in the case of Letters Patent to the rights arising from possession as distinguished from those arising from property.

(*k*) *E.g.* the decision that in the case of joint patentees the survivor took the whole benefit, see p. 131, *n.* (*s*).

(*l*) See p. 291.

(*m*) *Attorney-General* v. *Lord Oswald* (1848), 2 S. X. 969.

(*n*) See p. 12.

(*o*) *Hess* v. *Stevenson* (1803), 3 B. & P. 505.

(*p*) 7 Ed. VII. c. 20, s. 45. See *British Mutoscope Coy., Ltd.* v. *Homer*, 18 R. P. C. 177; and *cf.* also *Attorney-General* v. *Lord Oswald*, *supra*, where the statement in Bells' Commentaries, Vol. I. p. 122, that a patent is "unattachable by any diligence but adjudication" was referred to with approval. See also *Edwards & Coy.* v. *Pickard*, [1909] 2 K. B. 963, C. A.

(*q*) *Taylor's Agreement Trusts*, 21 R. P. C. 713; *Heath's Patent*, 29 R. P. C. 390.

(*r*) Sect. 45.

(*s*) Coke upon Lytt. 172 (*a*). See also *Stewart* v. *Casey*, 9 R. P. C. at page 11, but *cf.* *King* v. *Oliver & Coy.*,

authority under seal (*t*). It would seem that there can be no assignment until after the grant has in fact been made (*u*). In the case of a bankrupt an assignment needs the consent of his trustee (*x*).

An assignment may either be immediate or take effect on the happening of a future event (*y*), and likewise the assignment may provide for the revesting of a patent on the happening of a future event, or the default of the assignee, and the patent then revests automatically (*z*).

Partial assignment.

The assignment may be of the whole patent or of part of the patent. Such partial assignment may be—

(1) Of an undivided share (*a*).

(2) Of a separate part of the invention (*b*).

(3) Of the patent right for a particular area (*c*).

An assignment of a part of a patent passes a legal interest (*d*). The position of assignees of a portion of a patent is dealt with later (*e*).

Survival and transmission of causes of action.

There seems little doubt that an action for infringement committed during the life of a patentee survives to his personal representatives (*f*). The rules against champerty and maintenance would probably prevent an assignment of the right to sue for past infringement unless such assignment were to a person already equitably interested in the patent (*g*).

Covenants and recitals.

Covenants and recitals in assignments of patents will be interpreted as in other assignments, *e.g.* as to their being limited or unlimited covenants for title (*h*). There is no warranty

Ltd., 1 R. P. C. 23, 42, where an agreement, which seems not to have been under seal, was treated by the Court as an assignment. There are no reported decisions as to the rights of assignees with regard to royalty, covenants, etc., in licences granted prior to assignment.

(*t*) *Haslehurst* v. *Rylands*, 9 R. P. C. 1.

(*u*) *E. M. Bowden's Patents Syndicate, Ltd.* v. *Herbert Smith & Coy.*, 21 R. P. C. 438, and 1910 E.

(*x*) *Manning's Patent*, 20 R. P. C. 74.

(*y*) *Cartwright* v. *Armatt* (1799), Davies 240.

(*z*) *King* v. *Oliver*, 1 R. P. C. 23, 42.

(*a*) *Walton* v. *Lavater* (1860), 29 L. J. (C. P.) 279; *Anderson* v. *Patent Oxonite Coy.*, 3 R. P. C. 279.

(*b*) *Dunnicliffe* v. *Mallet* (1859), 7 C. B. N. S. 209.

(*c*) Such an assignment came in question in *Actiengesellschaft für Cartonnägen Industrie* v. *Temler*, 18 R. P. C. 6.

(*d*) *Walton* v. *Lavater*, *supra*.

(*e*) Pp. 12, *et seq.*

(*f*) See *Baley and Sons* v. *Dalton* (1887), 35 Ch. D. 700 (a trade mark case). The survival of the cause of action for infringement of a patent seems to have been assumed by WARRINGTON, J., in *E. M. Bowden's Patents Syndicate, Ltd.* v. *Herbert Smith & Coy.*, 21 R. P. C. 438.

(*g*) See the *United Horseshoe Coy.* v. *Stewart & Coy.*, 3 R. P. C. 141, and p. 196, *n.* (*l*), where damages were given from the date when the plaintiffs became equitable owners. The point was not considered in the H. L.

(*h*) *Hess* v. *Stevenson* (1808), Davies 244. Although such assignments do not come within the Conveyancing Act, it is common to use the phrase

of, or covenant for, validity implied by an assignment of a patent, nor is such a covenant included in the covenant for title (*i*).

Although there is no implied covenant for validity an assignor is not allowed to dispute validity against his assignee, since to do so would be against his deed (*k*), but this does not apply to an assignee from the patentee's trustee in bankruptcy (*l*). A recital as to questions affecting validity would bind both assignor and assignee unless it appeared from the deed that it was intended to be the statement of the assignor alone (*m*).

Covenants constituting a charge.

A covenant by the assignee for himself and his assigns to pay a certain proportion of the profits arising out of the patent, so as to amount to a charge on the patent, binds legal assignees taking with notice, but not equitable assignees, but an independent covenant to pay a certain sum not necessarily arising out of the patent, and not constituting a charge or encumbrance, would not be directly enforceable against assignees (*n*).

Agreements with regard to patents.

Agreements for the sale of patents need not be under seal or even in writing (*o*). The ordinary rules of law apply to such agreements and specific performance of contracts for the sale of British Letters Patent will be granted if the Letters Patent

"as beneficial owner" to imply the ordinary covenants for title. See *Guyot* v. *Thomson*, 11 R. P. C. 594, C. A.

(*i*) *Hall* v. *Conder* (1857), 26 L. J. (C. P.) 138; *Smith* v. *Neale* (1857), 26 L. J. (C. P.) 143. It has never been decided whether the covenants for title include a covenant that the assignor has done all things necessary to keep the patents in force, *e.g.* paid renewal fees. Where goods are sold as patented, the invalidity of the patent is no defence to an action for the price. *Todd* v. *O'Regan* (1859), 2 S. XXI. 1320.

(*k*) *Walton* v. *Lavater* (1860), 29 L. J. (C. P.) 275; *Oldham* v. *Longmead* (1789), Davies 157. In *Hocking* v. *Hocking*, 4 R. P. C. 255, KEKEWICH, J., held that the assignor could not dispute validity. In the higher Courts, this point was not seriously argued, but it seemed to be assumed by the Court. See also *Chambers* v. *Crichley* (1864), 33 Beav. 374; *Gonville* v. *Hay*, 21 R. P. C. 49. But such estoppel does not affect a partner of the assignor, at any rate if not a partner at the time of the assignment: *Heugh* v. *Smith* (1877), 25 W. R. 742; *Cropper* v. *Smith*, 1 R. P. C. 81; see also *Axmann* v. *Lund* (1874), 43 L. J. (CH.) 655.

(*l*) *Cropper* v. *Smith*, *supra*.

(*m*) *Bowman* v. *Taylor* (1835), 4 L. J. (K. B.) 58; *Stroughill* v. *Buck* (1850), 19 L. J. (Q. B.) 209.

(*n*) See *Werdeman* v. *Societe Generale d'Electricite* (1881), 19 Ch. D. 246, followed in *Dansk Rekylriffel, etc.* v. *Small*, 25 R. P. C. 421, and the explanation of this case by VAUGHAN WILLIAMS and ROMER, L.JJ., in *Bagot Pneumatic Tyre Coy., Ltd.* v. *Clipper Pneumatic Tyre Coy., Ltd.*, 19 R. P. C. 69. See also *Cox* v. *Bishop* (1857), 8 De G. M. & G. 815.

(*o*) *Smith* v. *Neale* (1857), 26 L. J. (C. P.) 142. The argument in this case turned on whether the contract was to be performed within a year, and the question as to whether patents were "goods" so that a contract for their sale, if of over ten pounds in value, must be in writing, was not raised.

are in existence at the time of the action (*p*). The same would probably hold good for foreign letters patent (*q*). It is doubtful if specific performance can be granted where the patents have not been sealed by compelling the inventor to take the necessary steps for completion (*r*), but failure to take such steps will give ground to an action for damages (*s*).

Agreements as to future patents.

A covenant in an assignment of a patent to assign all future patents relating to the same subject-matter of which the assignor might become possessed is not contrary to public policy, and specific performance of such a covenant will be granted (*t*).

Covenants as to validity.

In agreements for the sale of patents, as in the case of assignments, there is no implied covenant for, or warranty of, validity (*u*), and consequently invalidity cannot be set up as a defence to an action on the agreement, except perhaps if

(*p*) *Printing and Numerical Coy.* v. *Sampson* (1875), L. R. 19 Eq. 462; *Bewley* v. *Hancock* (1855), 6 De G. M. & G. 391; *Liardet* v. *Hammond Electric Light Coy., Ltd.* (1885), 31 W. R. 710.

(*q*) For examples of the exercise of equitable jurisdiction by the English Courts in respect of foreign patents see *Richmond* v. *Wrighton*, 22 R. P. C. 25, and *Worthington Pumping Engine Coy.* v. *Moore*, 20 R. P. C. 41.

(*r*) CHITTY, J., in *Punchard* v. *Dade*, 11 R. P. C. 257, doubted whether an inventor could be compelled to complete. In *Wool, Hide and Skin Syndicate, Ltd.* v. *Riches* (1902), 19 R. P. C. 127, KEKEWICH, J., granted *ex parte* an injunction restraining the inventor from abandoning his application. The case was settled without further proceedings. See also *London and Leicester Hosiery Coy.* v. *Griswold*, 3 R. P. C. 251; *Bewley* v. *Hancock*, *supra*, and *Marx* v. *Galt*, 28 R. P. C. 419.

(*s*) *Lewin* v. *Brown* (1866), 14 W. R. 640.

(*t*) *Printing and Numerical Coy., Ltd.* v. *Sampson* (1875), L. R. 19 Eq. 462; *Bewley* v. *Hancock* (1855), 6 De G. M. & G. 391. But see *Firth* v. *Ridley* (1864), 33 Beav. 516, where specific performance of an agreement to pool all future patents was refused on the ground (*inter alia*) that it was unlimited in time. As to what comes within the term, frequently found in such agreements, "improvement on an invention," see *Linotype and Machinery, Ltd.* v. *Hopkins*, 27 R. P. C. 113, H. L.; *Wilson* v. *Barber*, 5 R. P. C. 675, Ir.; *Valveless Gas Engine Syndicate, Ltd.* v. *Day*, 16 R. P. C. 97, C. A.; *Davies* v. *Davies Patent Boiler Coy., Ltd.*, 25 R. P. C. 823. See also *Davies* v. *Curtis and Harvey*, 20 R. P. C. 561, C. A. In the last case, at p. 572, ROMER, L.J., suggested that to be an "improvement," the new invention must come within the claim of the earlier patent. It would seem doubtful if this is correct, as it would often make the word meaningless, *e.g.* in the provisions for a Patent of Addition, see p. 262. In *King* v. *Oliver*, 1 R. P. C. 23, DENMAN, J., left to the jury the question of whether a later patent was "an extension or modification" of an earlier one. Patents of which the assignor may become "possessed" includes patents he may acquire by purchase (*Printing and Numerical Coy.* v. *Sampson*, *supra*), but not patents in which he merely acquires an equitable interest together with other persons (*Pneumatic Tyre Coy.* v. *Dunlop*, 13 R. P. C. 553).

(*u*) *Smith* v. *Buckingham* (1870), 18 W. R. 314; *Hall* v. *Conder* (1857), 26 L. J. (C. P.) 138; *Smith* v. *Neale* (1851), 26 L. J. (C. P.) 143; *Liardet* v. *Hammond Electric Coy.* (1883), 31 W. R. 710. In *Cutler* v. *Bower* (1848), 17 L. J. (Q. B.) 217, the Court seemed to be of opinion that such a covenant was implied in a covenant for title, but this is inconsistent with the later cases.

the patentee knew that the patent was bad (*x*). It has, however, never been decided whether there is an implied covenant that the vendor will not do any act which would invalidate the letters patent (*y*). Where, however, there is a covenant for validity, or an agreement to assign and give such a covenant, the purchaser may claim damages or set up invalidity as a defence to an action on the contract (*z*).

Rules as to performance.

In many cases part of the purchase consideration is the advance of money to pay fees, etc., in connection with the invention. In such cases it has been held that time is of the essence of the contract (*a*), but that money for the payment of renewal fees need not be advanced till such fees are due (*b*). Where the vendor had agreed to take out a patent and assign a share of such patent, but failed to assign it, it was held that there was a total failure of consideration, the taking out of the patent alone being no consideration (*c*).

Patent Register.

A register of patents is kept at the patent office for the purpose of notifying facts in connection with the ownership of letters patent, and the person registered as the proprietor has absolute power to assign, grant licences, or otherwise deal with the patent, subject to the enforcement in the usual way of any equities and to anything appearing on the register. Such register is *primâ facie* evidence of anything directed to be entered therein (*d*).

(*x*) *Smith* v. *Buckingham, supra.* In this case also, COCKBURN, C.J., suggested that the defendant might plead that the invention patented had only existed in the patentee's imagination.

(*y*) See *Dey* v. *Howard*, 20 R. P. C. 21; see also *Bewley* v. *Hancock, supra.*

(*z*) *Hazlehurst* v. *Rylands*, 9 R. P. C. 1; *Nadel* v. *Martin*, 20 R. P. C. 129, 723; 23 R. P. C. 41, H. L.; *Berchem* v. *Wren*, 21 R. P. C. 683. In the first case part of the purchase money was paid down, the remainder was to be paid immediately the purchaser had satisfied himself as to the validity of the patents; it was held that in order to succeed in his defence he must prove that the patents were in fact invalid, and not merely that he was not satisfied, but that it was sufficient to prove the invalidity of any one of them. See also pp. 244, *et seq.*

(*a*) *Payne* v. *Banner* (1846), 15 L. J. (CH.) 227. In this case a sum was to be paid for the purpose of enabling the patentee to take out foreign patents.

(*b*) *Sequelin* v. *Terrell* (1867), 16 L. T. 537; *Hill* v. *Mount* (1856), 25 L. J. (C. P.) 190.

(*c*) *Hill* v. *Mount, supra.*

(*d*) See p. 286. For examples of the enforcement of equities, see *New Ixion Tyre Coy.* v. *Spilsbury*, 14 R. P. C. 567; *Morey's Patent* (1858), 25 Beav. 581; *cf.* also *Actiengesellschaft für Cartonnägen Industrie* v. *Temler*, 18 R. P. C. 6. There is considerable difficulty in reconciling the rights arising from the legal assignment of the patent with the rights given by Statute to the registered proprietor. If, for example, such registered proprietor executes assignments of the patent to two different persons, or grants exclusive licences to different persons, then it is clear, in spite of the provision that as registered proprietor he can assign or license, one of these assignments or licences must be ineffective. This point has never arisen for decision, but it would seem that the second licence or assignment must, in each case, be invalid unless

It has never been decided by the English Courts how far registration is necessary to complete the title, under the present Act or the Act of 1883, or whether the title when so completed dates back to the assignment (*e*). Effect of registration.

The provisions, however, of the statute seem to be directed rather to simplifying transactions in regard to patents by letting the title start from the registered proprietor, than to making assignment a condition precedent to the enjoyment of the rights given by the patent, and it would therefore seem that registration is not a condition precedent to the right to sue for infringement.

Rights of Co-patentees

The Patent Act provides that where after January 1, 1908, a patent in the ordinary form is granted to two or more persons each shall be entitled (in the absence of any agreement) to use the invention for his own benefit, but not to grant licences without the consent of the other co-patentees (*g*). The rights Rights of co-grantees.

it should be held that where the first assignee or licensee has neglected to register his title for an undue time he is estopped from setting up his title against a later assignee or licensee: *cf. Ex parte Green* (1857), 24 Beav. 145.

(*e*) See *Bowden's Patents Syndicate* v. *Smith*, 21 R. P. C. 438. The only decision under the 1883 Act (which substantially corresponds to the present Act on this point) is the *United Horseshoe Coy.* v. *Stewart & Coy.*, 3 R. P. C. 141, O. H.

In this case the plaintiffs had entered into an agreement for the purchase of a business and certain patents, the assignment and registration of the patents being at a later date. The Lord Ordinary gave damages for the infringement back to the date of the agreement. The Inner House reversed his judgment, finding for other reasons that the damages were only nominal. The House of Lords restored the judgment of the Lord Ordinary but only seem to have considered the grounds of the decision of the Inner House, and the question of the date from which the damages ran does not seem to have been mentioned in argument; see also *Duncan* v. *Lockerbie*, 29 R. P. C. 464. The following decisions on these points were under the Patent Law Amendment Act, 1852 (15 & 16 Vict. c. 83), which differed from the present Act by providing that until registration of the assignee's title, the patentee should be deemed and taken to be the sole proprietor. In *Chollett* v. *Hoffman* (1857), 26 L. J. (Q. B.) 249, the Court decided that registration was necessary before the plaintiff could succeed; but expressly left open the point as to whether or not after registration the title would date back to the assignment. In *Elwood* v. *Christy* (1864–65), 34 L. J. (C. P.) 130, it was decided that registration completed an inchoate title, and that where there had been a series of devolutions it was sufficient if the changes of title were registered after the last assignment. In this case, damages were only given from the date of the completion of the title by registration.

In *Walton* v. *Lavater* (1860), 29 L. J. (C. P.) 275, damages seem to have been given from the date of assignment; see also *Hassall* v. *Wright* (1870), L. R. 10 Eq. 509. In *Ex parte Green* (1857), 24 Beav. 145, the patentee had assigned to A. and subsequently assigned to B., who apparently took without notice, B. registered his assignment first and then A. registered his. On A. moving to rectify the register, B.'s assignment was expunged with costs.

(*g*) Sect. 37. What is meant by a

of co-patentees in patents of earlier date are the same, since these provisions only give the effect of former decisions (*h*). Co-patentees must probably all be joined in an action for infringement either as plaintiffs or defendants (*i*).

Rights of co-owners by devolution.

In the case of a patent vested in several persons holding either jointly or in common, by assignment or operation of law, the position of the co-owners in the above respects is probably the same as those of persons to whom a patent has been jointly granted. Where, however, a patent is divided so that one person has the whole right in a certain separate part of the invention, he can sue alone for infringement of that part and can presumably grant licences (*k*). An assignee for a district is in the position of a sole patentee so far as regards that district (*l*). Where after an infringement has been committed one of two owners of a patent dies, the survivor (whether they hold jointly or in common) can sue alone and recover the whole of the damages (*m*).

Devolution of joint patent rights.

On the death of one of the joint patentees of a patent (granted subsequently to January 1, 1908 (*n*)), the legal interest in the patent passes to the other patentees but the beneficial interest devolves on his personal representatives as part of his personal estate (*p*). Presumably such beneficial interest includes the right to work (*q*), as otherwise it would be of no value unless the patents were worked by licence, since the surviving patentees, although trustees, would not have to account for profits made by their working under the patent (*r*).

patent granted after the commencement of the Act (*i.e.* 1st January, 1908) is not clear. From a comparison with sect. 98 (2), to which this section forms an exception, it would certainly appear that a patent granted after the commencement of the Act means one which was, in fact, issued and sealed after that date. On the other hand, sect. 13 says that "a patent shall be dated and sealed as of the date of application," and for all other purposes the date of application is taken as the date of the grant. This point will need judicial determination.

(*h*) See *Mathers* v. *Green* (1865), 1 Ch. App. 29, and *Steers* v. *Rogers*, 9 R. P. C. 177.

(*i*) This, at any rate, is the invariable practice, and is in conformity with the rule that joint tenants or tenants in common must all be joined in an action for trespass. See, however, *contra* the remarks of BACON, V.C., in *Sheehan* v. *G.E.R.* (1880), 16 C. D. 59, which seem contrary to the rule followed by the Court in *Smith* v. *L. & N. W. Ry. Coy.* (1853), 2 E. & B. 69.

(*k*) *Dunnicliff* v. *Mallett* (1859), 7 C. B. N. S. 209. In *Anderson* v. *Patent Oxonite Coy.*, 3 R. P. C. 279, the assignee of an undivided share obtained an interim injunction, but this point was not argued.

(*l*) Sect. 14 (1).

(*m*) See *Smith* v. *L. & N. W. Ry. Coy.*, *supra*.

(*n*) See note (*g*), *ante*.

(*p*) Sect. 37.

(*q*) See, however, *Bewley* v. *Hancock* (1860), Johnson 601, when this was treated as an open point.

(*r*) *Steers* v. *Rogers*, 9 R. P. C. 177.

In the case of a patent granted before January 1, 1908, the patentees are joint owners, and on the death of one his interest passes to the survivors (*s*).

The Partition Acts do not apply to Letters Patent, and there is no way for one of several co-patentees to force the sale of the patent or the granting of licences under it. It has, however, always been assumed, on the analogy of the powers of joint tenants of real property, that one of the grantees can assign his share without the consent of the others, and terminate the joint ownership, though the point has never been decided (*t*).

No right of partition but shares may be assigned.

A further point of great difficulty is whether one of several grantees can divide his share, or assign part of it, so as to give several persons independent rights of working under the patent. It is here that the ordinarily accepted analogy to the case of joint tenants of real property is so unsatisfactory. If a tenant has a half share of the profits to be derived from land no injury is done to the other tenant by his dividing such share, since his assignees cannot get in all more than the half of the whole profits (*u*). But in the case of a patent that which the two grantees enjoy is the sole privilege of working a certain invention, and if one of them can divide his share and put two persons in possession of it, it is clear that the share of the other is reduced from one-half to one-third of the monopoly, presuming that all the persons exercise the trade to the same extent. For this reason there seems good ground for thinking that the interests of one of several co-grantees of a patent may belong to that class of interests which by law cannot be divided, such as a *common sauns nombre*, or the right to dig on certain land, since such division would increase the burden on others (*x*).

Can one of several patentees further divide his share?

Persons acquiring an interest in patents by assignment or operation of law can hold either jointly or in common (*y*).

Co-patentees may hold jointly or in common.

(*s*) *National Society for the Distribution of Electricity* v. *Gibbs*, 16 R. P. C. 339. The decision was reversed by the C. A. on another point without any decision on this point.

(*t*) See *per* BYLES, J., in *Dunnicliffe* v. *Mallett* (1859), 7 C. B. N. S. 209.

In this case, however, the only assignment by a part owner, without the consent of the other part owner, was by the defendant himself, who would have been estopped from denying the validity of his own assignment.

In *Manning's Patent*, 20 R. P. C. 74, the title of the person aggrieved arose in this way, but the point was not raised.

(*u*) See 3 & 4 Anne, c. 3, s. 27. Coke on Lytt. 172*a* and 186*a*.

(*x*) *Lord Mountjoy's case*, Coke on Lytt. 164*b*.

(*y*) *Walton* v. *Lavater* (1860), 29 L. J. C. P., at p. 280.

For joint grantees to change their interests so as to hold in common a release under seal would probably be necessary (*z*). The above remarks as to the power of assigning shares in the patent apply equally to persons whose interest has been acquired by assignment or operation of law.

No right to compel amendment surrender or payment of fees.

There is no provision for one co-owner of a patent compelling the others to amend or surrender the patent, or for his obtaining a patent of addition, nor is there any provision for his compelling the others to pay the renewal fees, or for his recovering from them any share of such fees if he pays the whole.

(*z*) Coke on Lytt. 169*a*.

CHAPTER II

NOVELTY AND SUBJECT MATTER

Patents only for new manufactures.

THE Statute of Monopolies declares all Letters Patent invalid except those which are for a new manufacture, and therefore the first question to be considered in investigating the validity of any Letters Patent is whether that which has been patented comes within these words (*a*).

Questions of fact and law.

In this investigation the only question of law is whether or not the subject of the Letters Patent is a manufacture (*b*). The question of novelty, in the sense of whether that which is claimed has been in fact done or described before, is of course a question of fact, and so is the further question of whether it has those qualities which the Courts consider as essential to constitute "a new manufacture" (*c*).

What is a new manufacture?

The further test above referred to is—does the novelty appertain to the manufacture? From the earliest times the Courts have held that a manufacture of a thing new in itself does not necessarily constitute a new manufacture (*d*). It is in many, if not in all cases, the business of a manufacturer to constantly vary his products, and hence it follows that the novelty of the product cannot alone determine whether its production is a new manufacture. Probably the best criterion is whether that which is claimed as a new manufacture lies within the limits of development of some existing trade, in the sense that it is such a development as an ordinary person skilled in

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

(*b*) *Walton* v. *Potter* (1841), W. P. C. 597, 601; *Cornish* v. *Keen* (1836), W. P. C. 501, 517.

(*c*) *Losh* v. *Hague* (1838), W. P. C. 200, 205; *Hill* v. *Evans* (1862), 31 L. J. (CH.) 457; *Lyon* v. *Goddard*, 11 R. P. C. 354, H. L.; *Stohwasser* v. *Humphreys*, 18 R. P. C. 116. See *contra Thomson* v. *James* (1863), 32 Beav. 570.

(*d*) *Gadd* v. *Mayor of Manchester*, 9 R. P. C. at p. 524, C. A., and cases there quoted: *Harwood* v. *Great Northern Railway* (1865), 11 H. L. C. 654; *Riekmann* v. *Thierry*, 14 R. P. C. 105, H. L.

that trade could have naturally made, had he wished to (*e*). If so, then, even if the actual thing is new in fact and is a manufacture, it is not a new manufacture but simply a particular instance of an old one.

Examples of this will readily occur to the mind. Take for example a manufacturer of wall papers. It is an essential part of this manufacture to continually produce new patterns. The means by which such new patterns are produced are, generally speaking, old and well known, and therefore it cannot be considered that the mere change in a pattern produced by these old means, although the article produced has never been produced before, is a new manufacture. Such power of change is a necessary part of the knowledge of a competent workman in the particular art. Again, to take a case actually decided in the Courts, a patent was taken out for making tubular boilers, commonly used for heating greenhouses, by casting them in one piece. These boilers were in themselves old but had been made by making the tubes separately and then inserting them in sockets in the connecting rings and fixing with iron cement. It was, however, held that, as the process of casting was well known to the whole world and was applied to the casting of objects of all shapes, and as it was not suggested that there were any special modifications of the ordinary methods necessary for casting this particular object, this was a mere ordinary development of the manufacture of the worker in cast iron, and was not a new manufacture (*f*).

Invention.

This further quality which is necessary to constitute subject matter for Letters Patent is often expressed by saying that that which is patented must involve invention, and, in fact, the Statute of Monopolies itself speaks of the patent being granted to the first inventor. It is thought that the best criterion of invention is that given above, but perhaps it may also be expressed by saying that an invention necessarily involves an addition to the stock of public knowledge, that is to say, that the public must be told something which they did not know before.

(*e*) *Place* v. *Blackburn Loom Coy.*, 29 R. P. C. 663, C. A.; *Morgan* v. *Windover*, 7 R. P. C. 131, 446, H. L.; *Tucker* v. *Kaye*, 8 R. P. C. 58, 61; *Muirhead* v. *Commercial Cable Coy.*, 12 R. P. C. 39, 62, C. A.; *Cooper* v. *Bædeker*, 17 R. P. C. 209, C. A.; *British United Shoe Machinery Coy., Ltd.* v. *Claughton*, 23 R. P. C. 321, 335.

(*f*) *Ormson* v. *Clark* (1863), 32 L. J. (C. P.) 8 and 291. *Cf.* also *Dredge* v. *Parnell*, 16 R. P. C. 625, H. L.

Subject-matter a question of fact.

From the criterion suggested above—viz. is the development one which a competent workman in the particular trade could naturally have made had he needed to make it—it is clear that no general rules can be laid down as to what does and what does not constitute invention. What a skilled person could probably have done is a question of fact to be decided on all the evidence which the Court has before it. It has on many occasions been laid down that the questions arising in patent cases are mainly those of fact, and that although in interpreting the Statute of Monopolies regard must be had to the decisions of the last two hundred and ninety years (*g*), yet decisions as to the existence or non-existence of subject matter in particular cases, or dicta on the subject of invention, are not to be regarded as decisions binding on the Court in other cases, but are useful only as showing how the Court has treated various classes of evidence (*h*).

Subject-matter involves three questions.

There are therefore these three questions to be considered in deciding whether the alleged invention forms subject-matter for letters patent. Firstly, is it a manufacture? Secondly, is it new? Thirdly, is it a new manufacture or in other words, does it involve invention? This third question by itself is often referred to as the question of subject-matter.

Manufacture.

A patent can only be granted for a manufacture, and although "manufacture" has been very widely interpreted this restriction is of great importance.

It is extremely difficult to give any satisfactory definition of the word "manufacture," which includes both the process of manufacture and the thing manufactured (*i*). The fact

(*g*) *Plimpton* v. *Malcolmson* (1876), 45 L. J. (CH.), *per* JESSEL, M.R., at p. 506.

(*h*) See *Lister* v. *Norton*, 3 R. P. C., *per* CHITTY, J., at p. 205; *Lyon* v. *Goddard*, 10 R. P. C., *per* BOWEN, L.J., at p. 346; *Savage* v. *Harris*, 13 R. P. C., *per* LOPES, L.J., at p. 370, C. A.; *Riekmann* v. *Thierry*, 14 R. P. C., *per* HALSBURY, L.C., at p. 115, H. L.; *Sandow* v. *Szalay*, 21 R. P. C., *per* BYRNE, J., at p. 30.

(*i*) *R.* v. *Wheeler* (1819), 2 B. & Ald. 345, 349. *Cf.* also *Vorwerk* v. *Evans*, 7 R. P. C. 265, C. A. See also *Boulton & Watt* v. *Bull* (1795), Davies, 208; *Hornblower* v. *Boulton* (1799), Davies, 229. It does not matter that the article is built up *in situ*—*Newall* v. *Elliott* (1863), 10 L. T. (N. S.) 792. In *Higgs* v. *Goodwin* (1858), 27 L. J. (Q. B.) 421, the Court seemed to have doubted whether a process for the purification of water was subject matter for a patent, though they held that its application for treating sewage so as to get a substance useful as manure was. There seems no reason to doubt that a process for water purification would now be held to be a manufacture, *cf.* *Innes* v. *Short*, 15 R. P. C. 449, where the use of zinc powder for preventing corrosion in boilers was held patentable.

that the real value of a patent lies in the prohibition clause shows that that which is sought to be patented must be something which others may be prohibited from doing, and it must therefore be a physical process or thing as apart from a mere discovery. Thus Sir Isaac Newton could not have patented the fact that the earth's attraction varies inversely as the square of the distance from the earth's centre, though he could have patented a spring balance made so as to show the latitude by measuring the earth's attraction (*k*). Perhaps the best attempt at a definition is that of Abbot, C.J.: "But no merely philosophical or abstract principle can answer to the word 'manufacture.' Something of a corporeal and substantial nature, something that can be made by man from the matters subjected to his skill and art or at the least some new mode of employing his art and skill is requisite to satisfy this word" (*l*). Again, it may be said that a patent can only prohibit a manual process and not a process which is merely an exercise of brain power carried out by ordinary manual means—*e.g.* you cannot have a patent for a process of literary or artistic composition, of a method of advertising, or of a scheme for business correspondence. Nor can a patent be granted for an article such as a printed paper for carrying out these processes (*m*). But where a manual process produces any commercial result, or an article is produced which is different from what has been produced before, the difference being not merely a literary or artistic one, the patent would be held to be for a manufacture (*n*). The question of whether a patent was for a manufacture or for an abstract principle was much more frequently discussed in the earlier days than at present, and the result arrived at by the Courts may be said to be that if together with a new principle the patent shows a method of putting it into practice, so that there is something definite to prohibit, this may be good subject-matter (*o*).

(*k*) *Cf. Lyon* v. *Goddard*, 11 R. P. C., *per* HERSCHELL, L.C., at p. 358, H. L.

(*l*) *R.* v. *Wheeler*, *ubi supra*.

(*m*) See p. 255, *n.* (*q*). In *Philpot* v. *Hanbury*, 2 R. P. C. 153, GROVE, J., doubted whether a method of measuring for dressmaking-purposes was a manufacture.

(*n*) *Cf. Cooper's Application*, 19 R. P. C. 53.

(*o*) *E.g.* Watt'sPatent for a use of a separate condenser, to avoid cooling of cylinder, *Boulton & Watt* v. *Bull* (1795), Davies, 162; *Hornblower* v. *Boulton & Watt* (1799), Davies, 221.

Neilson's Patent for heating the air before introduction into furnace, and out of contact with fire, so that its oxygen was not affected. *Neilson's Patent* (1841), W. P. C. 245.

Patent for arranging intermediate

Although what is patented must be a manufacture it must be remembered that the merit of the patent, that which removes it so far from the track of previous practice as to constitute it a new invention, need not fulfil this requisite (*p*), thus sheathing ships with a known alloy was held subject matter, though the process of sheathing was carried out in the ordinary way, and the whole merit of the patent was that the inventor had discovered a new property of this alloy (*q*).

The invention may be in the principle not the means.

A patent can only be granted for the invention made and disclosed, and "cannot extend beyond the consideration" (*r*), though, of course, it may cover modifications of such invention. A patent therefore which claims something other or wider than the invention disclosed would be bad, quite apart from any question of novelty, as a contravention of the Statute of Monopolies. This objection would have been formerly raised under the plea that the title was too large (*s*), and now would be raised by the corresponding plea that the claim is too large (*t*). Such a plea has been recognised as good, but since the specification and claims are to be read together the claims will be construed as only being for the invention disclosed unless the wording absolutely contradicts this (*u*).

Grant cannot extend beyond consideration.

stations on a telegraph so that duplicate signals were given at each. *Electric Telegraph* v. *Brett* (1851), 20 L. J. (C. P.) 123.

Patent for "stratifying" the gases in an explosion engine so that there was a cushion of combustible gas next to piston, and igniting at end furthest from piston, thus getting a more gradual explosion. *Otto* v. *Linford* (1881), 46 L. T. (N. S.) 35. See also *Jupe* v. *Pratt* (1837), W. P. C. 144; *Hadden* v. *Pirie* (1823), 1 S. 1, 423, and cases in next note.

In all of these cases means for carrying out the invention were shown, but these possessed no special novelty. In *Otto* v. *Linford*, *ubi supra*, BRETT, L.J., expressed the opinion that it would have been sufficient had the patentee given the principle only without showing special means. Of course this only applies where a competent workman could supply the means. In *Neilson's Patent*, *ubi supra*, ANDERSON, B., considered that it was necessary to describe some practical means for carrying out the invention.

(*p*) *Hickton's Patent Syndicate* v. *Patents and Machines Improvements Coy., Ltd.*, 26 R. P. C. 339, 345, C. A.; *Place* v. *Blackburn Loom Coy.*, 29 R. P. C. 591.

(*q*) *Muntz* v. *Foster* (1843), 2 W. P. C. 93. *Cf.* also *Lyon* v. *Goddard*, 11 R. P. C. 354, H. L. (use of superheated steam for disinfecting).

(*r*) *Per* ABBOT, C.J., in *Brunton* v. *Hawkes* (1820), 4 B. & Ald. 541.

(*s*) *Derosne* v. *Farie* (1835), W. P. C. 154; *Cochrane* (*Lord* v. *Smethurst* (1811), 1 St. 205.

(*t*) *Moser* v. *Mardsen*, 13 R. P. C. 24, H. L.; *Arnold* v. *Bradbury* (1871), 6 Ch. App. 766; *Edison & Swan Coy.* v. *Holland*, 6 R. P. C. at p. 284. In *Arnold* v. *Bradbury*, *ubi supra*, HATHERLEY, L.C., referred to the American case of *Wyeth* v. *Stone* (1 Story, 273), where the point appears clearly. See also *Unwin* v. *Heath* (1854), 5 H. L. C. *per* POLLOCK, B., at p. 540; *Cassel Gold Extracting Coy.* v. *Cyanide Gold Recovery Syndicate*, 12 R. P. C., p. 256, C. A., and pp. 85 *et seq*.

(*u*) *Edison-Bell Phonograph Corporation* v. *Smith*, 11 R. P. C., at p. 103, and see pp. 115, 116. But *cf.* *British United Shoe Machinery Coy.*,

Danger of wide claims.

In some cases, too, the mere breadth of claim may destroy subject-matter, apart from any question of anticipation, by changing the alleged invention from something which is the result of ingenuity and experiment to a mere attempt to appropriate unexplored ground, or by changing the boundary between the monopoly sought and the former practice so that it is not co-incident with any special advantage (*x*). So, too, if a wide right of variation is claimed for the patented invention, the same rule must be applied to the anticipations (*y*). Again, the absence of proper description may put the patentee in the dilemma that either there is no invention or that he has not described it (*z*).

Claim must not include any old matter.

Nor must the monopoly include anything that is old, and however meritorious the invention the patent will be bad if it transgresses this rule, at any rate until it is limited by disclaimer (*a*).

Validity of grant as a whole must be considered.

The question to be decided is whether the grant as a whole is valid and not whether any particular claim would be valid if it stood alone, and therefore a patent may be bad by reason of want of novelty or subject-matter in a claim which is not alleged to be infringed (*b*).

Ltd. v. *Simon Collier, Ltd.*, 26 R. P. C. 21, where the patent was held bad on this ground.

(*x*) *E.g.* a claim for the use of *any* clamp for holding clothing on cards would be bad though claim for particular clamp good. *Tweedale* v. *Ashworth*, 9 R. P. C. 121—127, H. L.

A claim for setting incandescent mantles by use of any liquid would have been bad (n.b. the judge may have meant bad because not new). *Sunlight Incandescent Coy.* v. *Incandescent Gas Coy.*, 14 R. P. C. 757, 773.

Claim for use for purifying flour of "any oxidising agent except ozone," would be bad but claim for particular oxidising agents good, though these in fact covered all other known gaseous oxidising agents. *Andrews' Patent*, 24 R. P. C. 349, 367, C. A.

Claim for use of mica in tympanum of any sound transmitting instrument would have been bad. *United Telephone Coy.* v. *Harrison* (1882), 21 Ch. D. 720. See also *Rickerby* v. *Duncan*, 25 R. P. C. 248.

(*y*) *Patent Exploitation, Ltd.* v. *American Novelty Coy.*, 22 R. P. C. 316, C. A., and p. 52, *n.* (*f*).

(*z*) *E.g.* Patent for mixing vegetable and mineral oils with no description of process. *Hutchinson* v. *Patullo*, 5 R. P. C., 351, C. A. See Chapter on SUFFICIENCY, p. 100.

Claim for all automatic means of effecting a result previously effected by hand labour held bad. *British United Shoe Machinery Coy.* v. *Simon Collier, Ltd.*, 26 R. P. C. 21, 50.

This point was not considered in the higher Courts.

(*a*) *Kay* v. *Marshall* (1841), 8 C. & F. 245, H. L.; *Minter* v. *Mower* (1835), W. P. C. 140; *Crossthwaite* v. *Moorwood*, 11 R. P. C. 555; *Murchland* v. *Nicholson*, 10 R. P. C. 417; *Kane* v. *Guest*, 16 R. P. C. 433; *Bowden's Patent*, 22 R. P. C. 49; *Nadel* v. *Martin*, 22 R. P. C. 41, H. L.

It may be, however, that in some cases what would be held to be clumsy infringement may not amount to an anticipation. *Cf. Daw* v. *Eley* and other cases, at p 62, *n.* (*o*).

(*b*) *Wilson Brothers, Ltd.* v. *Wilson & Coy.*, 20 R. P. C. 11 H. L.; *Murchland* v. *Nicholson*, 10 R. P. C. 417.

On the other hand, it does not matter how the monopoly is divided between the various claims, if each claim satisfies the necessary criteria, nor can that which is claimed in one claim be used to diminish the subject-matter of other claims (*c*). A claim is not made bad by the fact that it is unnecessarily narrowed, *e.g.* a claim which specifies some new and patentable integer is not invalidated by the fact that it purports to be for such integer in combination with others which are old, even though the alleged combination is not a true combination (*d*). This is because such a claim does not extend the monopoly (*e*).

Novelty and subject-matter.

Although it might seem that the question of novelty and the question of invention are separate, they are usually very closely connected in every patent case, and, in fact, it will not be found that any consistent distinction in terminology has been observed by the Courts between novelty and subject-matter in its restricted sense. It will readily be seen that the distinction is often one without any real difference. In nearly every case the exact thing patented has never been proposed before, and the dispute is usually as to the extent of the advance made on previous knowledge. In such case the question, is the alleged invention new, might be said to be solved by the Court determining what advance on previous knowledge would be necessary in that case to constitute an invention and then deciding if such advance had in fact been made, while the question of subject-matter would be decided by first determining what advance

(*c*) *E.g.* where a new explosive dynamite was claimed by one claim, and the explosion of such dynamite by an old fuse formed the subject of another claim, the patent was held good since the second claim did not extend the monopoly. *British Dynamite Coy.* v. *Krebs* (1879), 13 R. P. C. 190, H. L. See also the judgment of FLETCHER MOULTON, L.J., in *British United Shoe Machinery Coy., Ltd.* v. *Fussell*, 25 R. P. C. 631, 649; *Edison Bell Phonograph Corporation* v. *Smith*, 11 R. P. C. 148, 163, and cases at p. 125, *n.* (*g*).

A different view was expressed by EADY, J., in *Sirdar Rubber Coy.* v. *Wallington*, 22 R. P. C. 257, 266, but the attention of the learned judge was not called to the authorities on this point, and the point was left open by the C. A., 23 R. P. C. 132.

The fact that certain matters are mentioned in the provisional but abandoned in the complete does not prevent the patentee from saying that he invented them, nor can these matters be treated as old and used to diminish the subject-matter of his claims. *Pneumatic Tyre Coy.* v. *East London Rubber Coy.*, 14 R. P. C. 77, 98.

(*d*) See p. 41.

(*e*) *Per* MOULTON, L.J., in *British United Shoe Machinery Coy., Ltd.* v. *Fussell, ubi supra.*; *Edison Bell Phonograph Corporation* v. *Smith*, *supra.* In *R.* v. *Arkwright* (1785), W. P. C. 64, it was treated as an open question whether if one part of the machine is new the patent should be for the addition or for the whole machine. See also *Boulton & Watt* v. *Bull* (1795), Davies, 162; *Harrison* v. *Anderston Foundry Coy.* (1874), 1 A. C. 574.

had been made and then considering whether such advance were sufficient to constitute invention, and it is usually very doubtful which process has been adopted by the Court (*f*).

Consequently in dealing with subject-matter many decisions which are in form decisions as to novelty will have to be considered (*g*).

Evidence as to invention.

The question of whether a development which has in fact been made was a probable natural development of the art or one which required inventive skill is obviously one of great difficulty, and the relevant evidence is of a very wide nature. Of course the first thing to be ascertained is the state of prior knowledge, in order to ascertain what advance has been made (*h*), and when the exact bounds of the alleged invention have been fixed the question of subject-matter proper is ready for determination.

Sometimes, but rarely, the intrinsic nature of the discovery may be sufficient. Even after the result is known the sense of surprise may still persist in the mind (*e.g.* Edison's discovery that the sensitiveness of the diaphragm of a telephone was immensely increased by firmly clamping it in position instead of mounting it loosely as formerly; or Nobel's discovery that the violently explosive guncotton could be rendered safe by admixture with the still more violent nitroglycerine). But there is no doubt that the general tendency of the mind is to minimise the difficulty of a discovery after it has been made (*k*), and it is often necessary to have recourse to extrinsic evidence to show that what has been done by the patentee was not obvious. One class of such evidence is of supreme importance.

(*f*) See *Gadd* v. *Mayor of Manchester*, 10 R. P. C., *per* LINDLEY, L.J., at p. 525; *Max Muller's Patent*, 24 R. P. C. at p. 479; *Wilson* v. *Wilson Brothers Bobbin Coy., Ltd.*, 28 R. P. C., *per* FLETCHER MOULTON, L.J., at p. 737. See *contra Edison Bell Phonograph Corporation* v. *Smith*, 11 R. P. C., *per* ESHER, M.R., at p. 398.

(*g*) The question of publication is considered separately, see Chapter III.

(*h*) *Beavis* v. *Rylands*, 17 R. P. C., *per* Lord ALVERSTONE, M.R., at p. 710.

In considering subject-matter the Court have to take into consideration all the advantages arising from the invention, and not merely those pointed out in the specification.

Aliter if the advantage only arises from some modification or special method of working the invention not indicated in the specification. *Von der Linde* v. *Brummerstaedt*, 26 R. P. C. 289.

(*k*) "When you consider it you come to the conclusion that it is so easy, so palpable . . . that any fool could do it." *Edison Bell Phonograph Corporation* v. *Smith*, 11 R. P. C. *per* LINDLEY, M.R., at p. 399; *Murray* v. *Clayton* (1872), 7 Ch. App., *per* JAMES, L.J., at p. 583; *Vickers* v. *Siddell*, 7 R. P. C., *per* Lord HERSCHELL, at p. 304, H. L.; *Incandescent Gas Lighting Coy.* v. *De Mare Incandescent System*, 13 R. P. C. 300, 323; *Waterhouse's Patent*, 23 R. P. C., *per* ROMER, L.J., at p. 476, C. A.

If the development be one of great utility, and one which has satisfied a long-felt want in the trade, the inference is almost overwhelming that it required inventive ingenuity or it would have been made before (*l*), that is presuming that there has been no material change in the conditions of the trade, such, for example, as a new demand caused by a change of fashion (*m*).

Another class of evidence which often carries great weight is the fact that the alleged invention was only arrived at by a series of experiments (*n*). It is, of course, not necessary that an inventor should have laboured—the invention may well be the result of a happy thought (*o*), but if the inventor, being equipped with the proper knowledge of his art, has been unable to arrive at the result he has claimed without a series of experiments, the inference is undoubtedly strong that such result was not obvious and constitutes a real addition to public knowledge. This inference may, however, be rebutted, and it must be carefully noted that for the mere fact of experiments to be of much value the inventor must have started with competent knowledge, or he may have been merely rediscovering what was old (*p*).

In some cases evidence may be given to show that the generally received opinion was that success could not be attained by the methods adopted by the inventor (*q*).

Evidence may also be given to explain the nature of the advance made, and the difference of the problem, conditions,

(*l*) *Murray* v. *Clayton* (1872), 7 Ch. App. 570; *Von Heyden* v. *Neudstadt* (1880), 14 Ch. D. 230; *Haslam* v. *Hall*, 5 R. P. C. 1; *Boyd* v. *Horrocks*, 5 R. P. C. 557, 575; *American Braided Wire Coy.* v. *Thompson*, 6 R. P. C. 518, H. L.; *Pirrie* v. *York Street Flax Spinning Coy.*, 11 R. P. C. 429, C. A., Ir.; *British Vacuum Cleaner Coy., Ltd.* v. *Suction Cleaner Coy., Ltd.*, 21 R. P. C. 303, 312; *Taylor* v. *Annand*, 18 R. P. C. 53, 63, H. L.; *Van Berkel* v. *Simpson*, 24 R. P. C. 117, I. H.

But of course there are a number of cases where commercial success has not been held sufficient to establish invention: see *Thierry* v. *Riekmann*, 14 R. P. C. 105, H. L.; *Cooper & Coy.* v. *Baedeker*, 17 R. P. C. 209, C. A.; *Thermos Ltd.* v. *Isola Ltd.*, 27 R. P. C. 288; *Wilson* v. *Wilson Brothers Bobbin Coy., Ltd.*, 28 R. P. C. 733, C. A.

User by the defendant is often appealed to for this purpose, *e.g.* *Deeley* v. *Perkes*, 13 R. P. C. 581, 589, H. L.; *Vickers* v. *Siddell*, 7 R. P. C. 292, 305, H. L.

But as to this see *Clarke* v. *Adie* (1877), 2 A. C. 315, 337.

(*m*) *Gaulard & Gibbs Patent*, 7 R. P. C. 367, 380, H. L.; *King, Brown & Coy.* v. *Anglo-American Brush Corporation*, 9 R. P. C. 313, H. L.; *Gosnell* v. *Bishop*, 5 R. P. C. 151, 158, C. A.; *Savage* v. *Harris*, 13 R. P. C. 364, 374, C. A.

(*n*) *Ehrlich* v. *Ihlee*, 5 R. P. C. 437, 450; *Day* v. *Davis*, 22 R. P. C. 34, 42, and for the converse proposition *Longbottom* v. *Shaw*, 8 R. P. C. at p. 336, H. L.

(*o*) *Cf.* p. 24, *n.* (*t*).

(*p*) *Riekmann* v. *Thierry*, 14 R. P. C., *per* Lord DAVEY at p. 122, H. L.

(*q*) *Cf. British Liquid Air Coy.* v. *British Oxygen Coy., Ltd.*, 25 R. P. C. 601, C. A.

means, etc., in the patentee's invention to those in alleged anticipations.

Processes of invention.

An invention may, and usually does, involve three processes. Firstly, the definition of the problem to be solved or the difficulties to be overcome (*r*); secondly, the choice of the general principle to be applied in solving this problem or overcoming these difficulties (*s*); and thirdly, the choice of the particular means used (*t*). Merit in any one of these stages, or in the whole combined, may support the invention, and it is therefore all important in considering subject-matter to consider, at any rate in the first instance, the whole advance in knowledge due to the inventor, rather than to examine in detail the variations from former practice (*u*).

New articles and new processes.

Although in the following pages the question of patents for new articles and patents for new processes are to some extent treated separately the division is not an exact one, many patents for apparatus being really for their use in new processes, and the subjects necessarily overlap.

Variations in nature and function.

The manufactures forming the subject-matter of Letters Patent have to be considered from two aspects, that of their nature, and that of their function. Their nature is defined by the directions given in the patent as to the manufacture of the article, or the carrying out of the process or system. Their function depends on the use of the article when made, or the results of the process or system. Novelty has to be established in the first respect, but for the purpose of subject-matter both have to be considered, and the second is often the more important.

In the general case it will be found that the directions to the workman are new in the sense that the exact thing proposed has never been done before. Equally generally will it be found that an analysis establishes that the alleged invention can be divided into parts, each of which is old, or resembles what is old, *e.g.* an article is composed of old parts or the various

(*r*) *Fawcett* v. *Homan*, 13 R. P. C., *per* LINDLEY, L.J., at p. 405: "The merit of an inventor very often consists in clearly realising some useful end to be obtained, or, to use Dr. Hopkinson's language in 'apprehending a desideratum.'" See also *Hickton's Patent Syndicate, Ltd.* v. *Patents & Machine Improvement Coy., Ltd.*, 26 R. P. C. 339, C. A.

(*s*) *E.g* *Hayward* v. *Hamilton* (1881), Griff. 115, C. A.

(*t*) All these stages need not exist separately. Sometimes the discovery of the result and the means are simultaneous, *e.g.* discovery of water tabbies referred to in *Liardet* v. *Johnson* (1778), W. P. C. 53.

(*u*) *Annand* v. *Taylor*, 18 R. P. C. 53, 63, H. L.; *Bray* v. *Gardiner*, 4 R. P. C. 400, 404.

steps of a process have been applied to the same or other substances. While, therefore, the question for the Court is whether there is invention in the alleged new manufacture as a whole, it is often necessary to consider how far the individual parts are novel, but it must be remembered that variations in the function of a part, considered apart from the rest of the invention, may be variations in the nature of the article or process as a whole. This variation of function leads to the question of analogous user.

There are various classes of new user. Thus a claim may be made for the use of an article as a whole for a new purpose, or for the application of a process to a new substance, or an old article may be embodied as a part of some other article. The considerations affecting such new users are probably best expressed in the words of Lord Chelmsford in *Penn* v. *Bibby*— New users.

"In every case of this description the main consideration seems to be whether the new application lies so far out of the track of the former use as not naturally to suggest itself to a person turning his mind to the subject, but to require some application of thought and study" (*x*).

The ingenuity of the application may lie in grasping the fact that the old means will deal with the problem to be overcome, or in adapting the old means so as to overcome the special difficulties (*y*) which occur in the particular case. In the first case it is usually necessary that it should not have been known that the new and old problems were identical (*z*), which is generally expressed by saying that the user must not be "merely analogous." The merit of the invention may lie in the determination of the real nature of the difficulties to be overcome (*a*), but if these were known then ingenuity must be shown either in the choice of a method for overcoming these difficulties or in the means for carrying such method out, but it is not necessary that the means should be new in themselves (*b*).

(*x*) 1866, 2 Ch. App. at p. 136. *Cf. Acetylene Illuminating Coy., Ltd.* v. *United Alkali Coy., Ltd.*, 22 R. P. C. 145, 155, H. L.

(*y*) *Hayward* v. *Hamilton* (1881), Griff. 115, 116; *British Liquid Air Coy., Ltd.* v. *British Oxygen Coy., Ltd.*, 25 R. P. C. at p. 601, C. A., where the fact that scientific opinion thought the method impossible was held evidence against analogy. *Hickton's Patent Syndicate* v. *Patents & Machine Improvements Coy.*, 26 R. P. C. 339, 247, C. A. And see cases in note (*b*), *infra*.

(*z*) *Steiner* v. *Heald* (1851), 20 L. J. (EX.) 410.

(*a*) See p. 24, *n.* (*r*).

(*b*) *Cannington* v. *Nuttall* (1871), L. R. 5 H. L. 205; *Hickton's Patent Syndicate* v. *Patents & Machine Improvement Coy., Ltd.*, 26 R. P. C.

Non-analogous users.

Where the new user is such as to involve fresh difficulties for which the remedy is not too obvious, the old user is not

339, C. A.; *Dangerfield* v. *Jones* (1865), 13 L. T. 142; *Lawrence* v. *Perry*, 2 R. P. C. 179; *Gadd* v. *Mayor of Manchester*, 9 R. P. C. 566, C. A.; *Kinmond* v. *Keay*, 20 R. P. C. 497, I. H.; *Reason Manufacturing Coy.* v. *Moy*, 19 R. P. C. 409.

See also as to the application of old means to get over special defects in complicated machines, *Edison Bell Phonograph Corporation, Ltd.* v. *Smith*, 11 R. P. C., *per* ESHER, M.R., at p. 398. But *cf. British United Shoe Machinery Coy.* v. *Claughton*, 23 R. P. C. 333.

Among cases of this class are the following:—

Use of perforated disc in place of band for musical boxes in which levers were actuated by air pressure held good subject-matter, though both these means had been used for Jacquard machines in which, however, the movement had been step by step and not continuous. Also the suggestion for the use of a disc in a musical box without levers held not to anticipate. *Ehrlich* v. *Ihlee*, 5 R. P. C. 437, C. A.

Use of three wires on the principle of the trussed frame for forming a support for cycle saddles held good. *Brookes* v. *Lamplugh*, 15 R. P. C. 33, C. A.

Use of soft metal confined within hard metal rims for bearing of rotating shafts and as guides for piston rods. It had been previously used for packing pistons, but while in previous user object was to produce pressure in order to avoid leakage, the object of present user was to avoid pressure. *Newton* v. *Vaucher* (185[illegible] 21 L. J. (EX.) 305.

Doubling over edge of ring before forcing on to bobbin so that it would enter wood held to be subject-matter, although edges of biscuit tins had been doubled over. (So held by a majority of the judges. Patent held bad for non-utility.) *Wilson* v. *Wilson*, 18 R. P. C. 139, C. A.

Adapting the method of propulsion formerly used in bicycles to tricycles would be subject-matter if new. *Brereton* v. *Richardson*, 1 R. P. C. 165. (This would seem a most doubtful decision; *cf. Nadel* v. *Martin*, *infra*.)

Use of spring jaws for sliding pencil case. Similar jaws had been used for watch keys. (Patent held bad on other grounds.) *Lawrence* v. *Perry*, 2 R. P. C. 179, 187.

Use of two hinged lids for electrical fuse boxes so arranged that both could not be opened at once. Similar interfering doors had been used in compression apparatus for the same purpose. (The C. A. seemed to doubt subject-matter, but reversed the decision on other grounds.) *Reason Manufacturing Coy., Ltd.* v. *Moy*, 19 R. P. C. 409; 20 R. P. C. 205, C. A.

Fixing brackets in ploughs in H girder beams, thereby preventing shearing, although brackets had been fixed in such beams in house construction. *International Harvester Coy. of America* v. *Peacock*, 25 R. P. C. 765, P. C.

Adaptation of a number of old devices to use on phonograph held to form subject-matter. *Edison Bell Phonograph Corporation* v. *Smith*, 11 R. P. C. 389, C. A.

Use of iron plates, old in themselves, in building houses so as to render them fireproof is good subject-matter. *Boulton & Watt* v. *Bull* (1795), Davies, *per* EYRE, J., at p. 209 (obiter).

The use in a dobby loom of a certain arrangement of cams and levers for actuating shuttle change mechanism good subject-matter, though the arrangement would not be subject-matter claimed apart from the loom as a separate tool. *Hattersley* v. *Hodgson*, 23 R. P. C. 192, H. L.

Making putties of material cut with a curve to get a better fit. Cutting a material with a curve for this purpose was old in dressmaking, etc., and had been proposed for leather leggings. *Fox* v. *Astrachans, Ltd.*, 27 R. P. C. 377.

Use of mandril heated internally for bending sawn wood not analogous to use of solid mandril for bending roots, etc., to make walking sticks, heat being applied externally. *Dangerfield* v. *Jones* (1865), 13 L. T. 142.

Use in a machine for separating chaff from dust of a cone in which air formed a vortex, the air and dust escaping at a hole at the top, and the chaff from a hole at the bottom. A fan was used to produce suction and air entered at the bottom. A former machine for separating air from dust

usually considered analogous (*c*). So, too, where the new user makes use of properties or advantages which were not apparent or useful in the old user (*d*) it may form subject-matter.

had a similar cone, but there was only one small hole at the bottom for escape of dust and no suction fan, as the entry of additional air would have defeated object of machine. *Sutcliffe* v. *Abbott*, 20 R. P. C. 50.

Patent for "Stepney" auxiliary wheel with pneumatic tyre and devices for fastening it to the rim of a wheel with deflated tyre. Held not analogous to the use of additional wheels affixed to hub, or to extension pieces used for broadening rim. *Stepney Spare Motor Wheel Coy., Ltd.* v *Hall*, 28 R. P. C. 381.

Use of inextensible wires for holding on a tyre held not to be anticipated by the use of spring wires in the edges of a tyre. The patentees' wires acted by their inextensibility and the tyre would have come off had one been cut; in the alleged anticipation the wires acted by pressure on the rubber and the tyre would have remained on had one been cut. *Pneumatic Tyre Coy., Ltd.* v. *Casswell*, 13 R. P. C. 375, C. A.; *Same* v. *Ixion Patent Pneumatic Tyre Coy., Ltd.*, 14 R. P. C. 853; *Same* v. *East London Rubber Coy.*, 14 R. P. C. 573, C. A.; *Same* v. *Leicester Pneumatic Tyre Coy.*, 15 R. P. C. 159.

Patent for detachable tyre held on to rim by projections fitting into dovetail grooves, an inner air tube forcing them in, not anticipated by solid rubber tyres sprung into grooves, or by tyres in which outer cover was cemented either to rim or to air-tube, since the projections were not held into the grooves by air pressure. *North British Rubber Coy.* v. *Gormully & Jeffery Manufacturing Coy.*, 15 R. P. C. 245, H. L.; *Same* v. *Macintosh*, 11 R. P. C. 477.

Making a compass bowl double, and placing in the outer bowl viscous liquid which by its friction checked the motion of the bowl containing it. It had been formerly proposed to use viscous liquid to float the compass bowl. *Thomson* v. *Batty*, 6 R. P. C. 84.

(*c*) Among cases of this class are the following:—

Use of wood in bearings for screw propellers so arranged that water could flow freely within bearings to cool them. Wood had formerly been used in bearings of grindstones and waterwheels, but the rate of revolution was very much less, and cooling arrangements were unnecessary. *Penn* v. *Bibby* (1866), 2 Ch. App. 127.

Use of principle of rectifier, as used in Coffey's Patent still for separation of two liquids, for separation of oxygen and nitrogen. *British Liquid Air Coy., Ltd.* v. *British Oxygen Coy., Ltd.*, 26 R. P. C. 509, H. L.

Use of a special arrangement for heating glass in a tank the walls of which were air cooled. Air cooling was very old, but the new user involved fresh difficulties. *Cannington* v. *Nuttall* (1871), L. R. 2 H L. 205.

Use of wheels gearing into racks for raising and lowering gasometer, in place of ordinary arrangement of pulleys over supports. Practically the same means had been used for floating docks, but these never rose above the level of the supports. *Gadd* v. *Mayor of Manchester*, 9 R. P. C. 516, C. A.

Use of two cylinders in register (as in web printing) for printing on detached pieces of uneven thickness such as sacks, which were fed in at the proper periods, the cylinders being so mounted as to deal with the uneven thickness. (Patent was held bad for insufficiency.) *Kinmond* v. *Keay*, 20 R. P. C. 497, I. H.

The use, for cold pressing of nuts, of a female tool having a shallow recess into which the metal might expand so as to avoid the risk of the blank splitting or bulging, held not anticipated by the user of recesses to hold thin articles such as washers where there was no risk of splitting or bulging and the recess was only used centrally. *Fellows* v. *Brookes*, 27 R. P. C. 101.

Use of centring devices for a ship's telegraph where the problem was "substantially different" to those met with in their former use. *Chadburn* v. *Mechan*, 12 R. P. C. 120.

Adapting principles of above ground conveyers to underground conveyers. *Blackett* v. *Dickson & Mann, Ltd.*, 26 R. P. C. 73, O. H.

(*d*) Among cases of this class are the following:—

Use of thin flexible paper tubes for

Object to be considered.

In considering whether the user is analogous, attention must be paid not only to the effect of the means employed, but

the wet spinning of flax held good in spite of fact that they had been used for dry spinning. The special advantage for wet spinning was that in drying the paper tube adhered to, and expanded with, the flax, and so parted from the bobbin, while tangling, etc., of flax was prevented. In the previous use in dry spinning the tube never parted from bobbin. *Pirrie* v. *York Street Flax Spinning Coy.*, 11 R. P. C. 429, C. A. Ir.

Use of a particular alloy of copper and zinc for sheathing ships held good though such alloy had been used for other purposes. The particular advantage for sheathing purposes was that while preventing excessive rust it allowed enough to keep barnacles from adhering. This property had not been recognised or utilised in the previous user. *Muntz* v. *Foster* (1844), 2 W. P. C. 93.

Use of dilute cyanide solution for extracting gold from ores not anticipated by use of strong solutions, since the dilute solution exercised a selective action which the strong did not. (Patent held bad on other grounds.) *Cassel Gold Extracting Coy., Ltd.* v. *Cyanide Gold Recovery Syndicate*, 12 R. P. C. 303, C. A.

Heating air out of contact with fire, so that oxygen was unaffected, not anticipated by heating air in contact with fire for purpose of creating a draught. *Neilson's Patent* (1841), 1 W. P. C. 295.

Use of mohair and silk together for pile fabrics (which gave effect of animal skins) not anticipated by their use separately for pile fabrics, or their use together for glacé goods. (Patent held bad on other grounds.) *Lister* v. *Norton*, 3 R. P. C. 199.

Use of farina on waterproof fabrics, which were afterwards printed in colours, not anticipated by its use without printing, since it was found to have a special power of absorbing colouring matter which could not have been foretold. *Moseley* v. *Victoria Rubber Coy.*, 4 R. P. C. 241.

Use of springs to support an incandescent burner with a flexible connecting pipe for the purpose of avoiding vibration. Ordinary gas burners had been mounted on springs, and both classes had had flexible connecting pipes attached for portability. *Anti-Vibration Incandescent Lighting Coy., Ltd.* v. *Croesley*, 22 R. P. C. 157.

Use of retort inclined at such an angle that while the coal could be automatically charged, and the coke similarly discharged, the coal arranged itself on top in an even layer, and thus prevented gas from having to pass through glowing coal. The use of inclined retorts had been suggested for purifying animal charcoal, but in this case there was no need for top layer to be even. Inclined retorts had also been suggested for cases where coal was charged in by a continuous process, but with such a process it would have been impossible to attain result achieved by new invention. *Automatic Coal Gas Retort Coy.* v. *Mayor of Salford*, 14 R. P. C. 450.

Where the patentee had shown how to make transmitters and receivers for wireless telegraphy which had certain advantages for whose production "loose" coupling was necessary, all prior specifications involving "tight" coupling, which would not give these advantages, were put aside as irrelevant. *Marconi* v. *British Radio Telegraph Coy., Ltd.*, 28 R. P. C. 181.

Use of a closely wound carbon filament for the purpose of diminishing the radiant surface in incandescent lamps not analogous to use of widely wound spirals in arc lamps, the winding not being for the same object or producing the same effect. *Edison & Swan Coy.* v. *Woodhouse*, 4 R. P. C. 79, C. A.

Patent for forming non-porous carbons by placing carbon in an atmosphere of hydrocarbon gas, heating by passing current and gradually increasing such current. The amount of deposition increased with the temperature and thus the inequalities in size were automatically corrected, since at the places of smaller section there was increased resistance and consequently higher temperature. The increase of current kept up the temperature and was necessary for success. *Held*, not anticipated by a process of deposition by means of external heating which would not have given the automatic correction, or by experiments in the fusion of carbon in which

also of the object for which they were used. If the results or some of them sought to be attained by the new user; although in

a current was passed through it, and it was noted that the carbon became denser, but the process employed did not include increasing the current, and would not have given the patentee's result. *Edison* v. *Woodhouse*, 4 R. P. C. 99, 106, C. A.

Use of prisms in pavement lights which both refracted and reflected not anticipated by use of prisms refracting only in cabin lights. *Hayward* v. *Hamilton* (1881), Griff. 115, C. A.

Wire mattresses having in the centre a wire network and at each end springs pointing from centre to side, so that the middle portion of the mattress received the greatest amount of support. *Held*, not to be anticipated by mattresses in which some springs were shown arranged straight, and some slightly diagonal, no stress being laid on this latter form, or by a specification showing inclined springs pointing alternately in different directions, since neither of these arrangements achieved the patentee's object. *Evans* v. *Hoskins*, 24 R. P. C. 517, C. A.

Use of thorium and 1 per cent. cerium in mantles, which combination gave a maximum illuminating effect. *Held*, patentable although thorium had been used before, and as appeared at trial such thorium had contained 0·05 per cent. cerium, but the presence of the cerium was not known, nor did it give the patentee's effect. *Welsbach Incandescent Gas Light Coy., Ltd.* v. *McGrady*, 18 R. P. C. 513.

Use of indiarubber for card fillets in place of leather, the advantage being that it was much more elastic. *Held*, not anticipated by its use to form part of an artificial leather, the object being in this case to get a comparatively non-elastic substance. The jury were directed that the question was, had this article the qualities and properties sought by the patentee. In a later case the patent was held bad on proof that a statement had been published that this artificial leather had in fact been used for card fillets, but proceedings were then compromised after a rule *nisi* had been granted for a new trial. *Walton* v. *Potter* (1841), W. P. C. 585.

A process for welding iron rails by the use of aluminium which reduced iron oxides, and in which the melted iron was run on to the rails so as to strengthen the joint, not anticipated by a former patent for welding by means of the heat caused by aluminium reducing other oxides, but in which the metal was kept away from rails. *Thermit Ltd.* v. *Weldite Ltd.*, 24 R. P. C. 441.

Use of blocks for closing round boilers, made so as to pivot, not anticipated by use of blocks which might possibly have pivoted, but which were used with a backing of earth so that they could not move. *Poulton* v. *Adjustable Cover and Boiler Block Coy.*, 22 R. P. C. 690.

Patent for the "three wire system" in which lamps were arranged in parallel between each of the main conductors and a third wire connected between two dynamos running in series. *Held* good though a similar arrangement had been used with lamps in parallel with a third wire not connected to the dynamos, and a third wire connected to the dynamos had been used with lamps arranged in series. In neither of these cases had the patentee's object of saving copper been attained. *Hopkinson* v. *St. James's Electric Lighting Coy., Ltd.*, 10 R. P. C. 46.

Patent for equalising amount of thread used from different bobbins of a lace machine by traversing bar so that each in turn did net and pattern parts. Formerly bobbins had been changed by hand. Traversing was used in other branches of lace making, but did not achieve purpose of equalising user of thread. *Hickton's Patent Syndicate* v. *Patents & Machines Improvement Coy.*, 26 R. P. C. 339, C. A.

Patent for dumb-bells which were divided down the middle, the two halves having a spring between them so that the effect of the exercises was increased by the muscles being kept in a state of tension in order to maintain the grip. *Held*, not anticipated by handgrip machines, not properly adapted for use as dumb-bells, and therefore not similarly affecting the muscles. *Sandow* v. *Szalay*, 23 R. P. C. 6, H. L.

Patent for device for varying the extent of opening of exhaust valve

fact produced by the old user, were merely accidental and unimportant consequences, this considerably diminishes the effect of such prior user in destroying subject-matter (*e*).

Analogous users.

On the other hand the Courts have fully realised the importance of manufacturers not being prevented from continually developing their methods, and availing themselves of the great store of knowledge which has been accumulated as to useful appliances in their own and in other trades (*f*), and therefore it has been held that the substitution of parts or substances which have been recognised as equivalents does not constitute subject-matter unless such new use results in

in motor without affecting point of stroke where such opening commenced, not anticipated by device where such point varied. *De Dion Bouton, Ltd.* v. *Muskett*, 26 R. P. C. 404.

Patent for lamp with floating feed and horizontal carbons held good, though horizontal carbons not new, and there had been lamps with floating feeds and vertical carbons, in which there was the disadvantage that the feed was affected by the loss of weight in the carbons. *British Westinghouse Coy.* v. *Braulik*, 27 R. P. C. 224, C. A.

Use of a filter press for producing a wet "slip," which was not ready for use and which had to be treated again, no anticipation of use of a filter press so as to produce a slip, dry enough to be ready for use, and which had special quick setting properties. *Adamant Stone Coy.* v. *Liverpool Corporation*, 14 R. P. C. 11.

Patent for making belts by impregnating canvas with dissolved gutta percha and evaporating off solvent, not anticipated by specification which spoke of use of heated gutta percha, but did not mention solvent or evaporation. *Dick* v. *Tullis*, 13 R. P. C. 149.

In a telescopic ladder in which upper part was raised by rope passing over a pulley on the lower part, levers were provided on the lower part which by *their own weight* fell under each step of the upper part when it passed them. These levers were all raised by a rod for the ladder to be lowered. *Held*, not anticipated by a ladder in which levers were worked by spring pawls which had to be compressed by hand or otherwise to lower ladder, or by a ladder in which the weight of the upper part was wholly supported by a chain attached to a hook. *Kelly* v. *Heathman*, 7 R. P. C. 343.

(*e*) See *Automatic Coal Gas Retort Coy.* v. *Mayor of Salford*, p. 28, *n.* (*d.*); *Anti-Vibration Incandescent Lighting Coy.* v. *Crossley*, *ibid.*; *Welsbach Incandescent Gas Light Coy., Ltd.* v. *McGrady*, *ibid.*; *Evans* v. *Hoskins*, *ibid.* See also *Harwood* v. *G. N. Ry. Coy.* (1850), 29 L. J. (Q. B.), *per* BLACKBURN, J., at p. 202.

Where a patentee claimed the use of nitrogen peroxide for conditioning flour, and an earlier specification had claimed the use of ozone, and it was shown that ozone had in fact no effect, and that any results got by the earlier inventor were due to small quantities of nitrogen peroxide produced as an impurity by his process, it was held that this was no publication of the use of nitrogen peroxide. *Flour Oxidising Coy.* v. *Carr*, 25 R. P. C. 428; *Same* v. *Hutchinson*, 26 R. P. C. 597. See also p. 68.

(*f*) *Gadd* v. *Mayor of Manchester*, 9 R. P. C. 516, C. A.; *Sideley* v. *London Hygienic Coy.*, 14 R. P. C. 514; *Wood* v. *Raphael*, 13 R. P. C. 730, 735; *Dredge* v. *Parnell*, 16 R. P. C. 625, H. L.; *Donnersmarck hutte, &c.* v. *Electric Construction Coy.*, 27 R. P. C. 774, 779, 783, C. A.

The fact that workers in a particular trade are ignorant of devices used in other trades is not necessarily sufficient to make the use of such devices in that trade patentable. Cf. *Shaw* v. *Barton*, 12 R. P. C. 282, 291; *Nadel* v. *Martin*, 20 R. P. C. 723, 743, C. A.; *Patent Bottle Envelope Coy.* v. *Seymour* (1858), 28 L. J. (Q. B.) 22.

some unexpected advantage. Again, the use of an old device in an analogous manner and for an analogous purpose is not subject-matter (*g*). Of course it is a question of fact whether any user comes within this definition, but a number of decisions fall within a few principal classes.

Alternative methods.

A class of user in which the presumption for analogy is very strong is where methods A and B, having been employed in dealing with some articles or in some trades, and method A only for other articles or in other trades, it is proposed to patent the use of method B in relation to such last-mentioned articles or trades. The fact of method B having been used under circumstances where A could also be used is looked on as very strong evidence of the user being analogous (*h*).

(*g*) *Gadd* v. *Mayor of Manchester*, *supra*; *British Ore Concentration Coy.* v. *Minerals Separation Syndicate*, 27 R. P. C. 33, H. L.; *Waterhouse's Patent*, 23 R. P. C. 470, C. A.; *Kay* v. *Marshall* (1839), 2 W. P. C. 74; *Patent Bottle Envelope Coy.* v. *Seymour*, *supra*; but *cf. Dangerfield* v. *Jones* (1865), 13 L. T. 142.

(*h*) There were two types of piano damper in general use, Broadwood's and Collard's. Broadwood's had been centred either in the body or in a separate arm, Collard's only in the body. *Held*, that centring Collard's on a separate arm was not patentable. *Herburger Schwander et Cie.* v. *Squire*, 6 R. P. C. 194, C. A.

The substitution of a scar, as commonly used in hammer actions, for another form of detent in a special, but previously patented, ejector mechanism. *Westley Richards & Coy.* v. *Perkes*, 10 R. P. C. 181. See also *Deeley's Patent*, 12 R. P. C. 192, C. A.

Substitution of an old longitudinal folder for old chopper folder between two printing machines. *Northern Press & Engineering Coy., Ltd.* v. *Hoe*, 23 R. P. C. 613, C. A.

Substitution of top for bottom driving in a double screen stone breaking machine, both top and bottom driving having been used in a single screen machine. *Baxter* v. *Mardsen*, 22 R. P. C. 18.

Putting transformers in parallel, many electrical machines having been arranged either in parallel or series, and transformers having been used in series. *Rucker* v. *London Electric Supply Corporation, Ltd.*, 17 R. P. C. 279.

Use of one of several well-known forms of candle holding device attached directly to base of candlestick, as other forms had been. *Carter* v. *Leyson*, 19 R. P. C. 473, C. A.

Use of iron tubes covered with copper in tubular boilers, such tubes having been used for other purposes as alternatives to iron tubes. *R.* v. *Cutler* (1847), 3 Car. & Kir. 215.

Use of a form of spring previously used for front spring of a carriage as a back spring. *Morgan* v. *Windover*, 7 R. P. C. 131, H. L.

Substitution of free top spinning in bowl for fixed top for working mechanical figures, both kinds of tops having been used in other forms of this class of toy. *Cole* v. *Saqui*, 6 R. P. C. 41, C. A.

Use of a particular device formerly used for adjusting toe piece of cycle pedal for adjusting side piece, other devices for the adjustment of the toe piece having been used previously for adjusting the side piece also. *Waterson* v. *Lloyd's Cycle Fittings, Ltd.*, 16 R. P. C. 277.

Use for protecting tyres of leather prepared in a particular known way, leather prepared in other ways having been used for this purpose. *Brassington* v. *Cox*, 15 R. P. C. 502.

Both sheet metal and leather had been embossed between male and female dies. Leather had also been embossed by hammering it on a soft substance. The use of this last process for sheet metal not patentable. *Embossed Metal Plate Company* v. *Saupe*, 8 R. P. C. 355.

Substitution of pivoted for fixed placquets in eye-glasses with a fixed

Self-contained units.

Similar cases are those in which what may be called self-contained units of machinery, or processes fulfilling a function complete in itself, are transferred from one trade to another or to a different purpose in the same trade. If these units act in the old way, and achieve in their new environment a result not new in itself, the transfer has generally been held not to constitute subject-matter (*i*).

bridge, both kinds having been used in glasses with spring bridges. *Wood* v. *Raphael*, 14 R. P. C. 496, C. A.

Oil spray lamps were of two classes, in one of which steam was used to spray the oil, in the other oil alone was used. In some of the lamps of the latter class the vapour of the oil had been taken to the reservoir to neutralise the back pressure. The use of steam in the first class of lamps for this purpose held not patentable. *Rose's Patents Coy., Ltd.* v. *Braby*, 11 R. P. C. 198, I. H.

Use for holding pile fabrics of strips of metal with hooks cast on them (the hooks being in plane of strip), which strips were attached to rollers, instead of separate hooks being attached as formerly, held not patentable in view of separate hooks, and strips with hooks on them having both been used for holding articles (though in this case the hooks were a right angles to plane of strip). *Longbottom* v. *Shaw*, 8 R. P. C. 333, H. L.

Both revolving and fixed rubber heels were known and constructed ordinarily in the same way. A patent for making revolving heels with metal plate pierced so that rubber on both sides was in contact, held bad in view of this having been proposed for fixed heels. *Hickson* v. *Redfern*, 22 R. P. C. 307.

Clinker and granite had been both used for making certain kinds of artificial stone. A patent for the substitution of clinker for granite in a special process for making such stone held bad. *Adamant Stone Coy.* v. *Liverpool Corporation*, 14 R. P. C. 11. See also *Horton* v. *Mabon* (1862), L. J. (C. B.) 255.

(*i*) Use in a mowing machine of a device for making the blades revolve at a variable speed, which device had previously been used in a hay-making machine. *Bamlett* v. *Picksley* (1875), Griff. 40.

Use in a machine for tearing shoddy of rollers revolving at different speeds, in order to accumulate material between them, as had been done in cotton machinery. *Tatham* v. *Dania* (1869), Griff. 213.

Use of ordinary clockwork mechanism for actuating top. *Britain* v. *Hirsch*, 5 R. P. C. 226, C. A.

Use of double groove to get over dead point in embroidering machinery, this device having been proposed for the same purpose for cycles. *Nadel* v. *Martin*, 22 R. P. C. 41, H. L.

Use in waste water preventer of special method of relieving air pressure already used in another type of such preventers. *Humpherson* v. *Syer*, 4 R. P. C. 407, C. A.

Use of bicycle pump in place of bellows in vacuum cleaning machine. *Bimm* v. *Shoppee*, 28 R. P. C. 274, C. A.

Use in lace machine of method of construction, common in other machines, for securing rigidity. *Cropper* v. *Smith*, 1 R. P. C. 81, 88, 90, C. A.

Use for bottle stopper of a sphere pierced with a hole, rotatable so that liquid could escape, the same device having been used for tea urns. *Hazlehurst* v. *Rylands*, 9 R. P. C. 1.

Use of joint in upper bar of collapsible bicycle luggage carriers, a joint having been similarly used for collapsible seats. *Main* v. *Ashby & Coy.*, 28 R. P. C. 492. See also *Baker* v. *Kinnell*, 9 R. P. C. 441.

Use for belts of a guard formerly applied to cogwheels. *Leadbeater* v. *Kitchen*, 7 R. P. C. 235, C. A.

Use of cramps, as used to hold belts, to stretch leather on rollers. *Oddy* v. *Smith*, 5 R. P. C. 503.

Use of particular method of joining ends of wires for securing bicycle tyres, which method had been used for securing ends of wires in cotton and other machinery. *Shaw* v. *Barton*, 12 R. P. C. 282.

Use of old method of applying and forming metal for forming compound

Another class of cases in which the presumption that the previous user was analogous is very strong is where there has merely been a duplication of an existing part without any alteration in the function or mode of action (*k*). A similar principle applies where the use of a mode of construction or action is extended without a new purpose being achieved (*l*). Duplication.

Again, patents for making in one articles previously made in two or more pieces have generally been held invalid (*m*), Consolidation or division.

conductors with square ends. *Glover* v. *American Wire Coy.*, 19 R. P. C. 102.

Use of canvas for making joint between "Sykes" pipes, this method being old for other pipes and there being no difficulty in applying it to "Sykes" pipes. *Doulton & Coy., Ltd.* v. *Albion & Clay Coy., Ltd.*, 28 R. P. C. 638, C. A.

Use of a process for making hair nets which had been used for making tulle. *Marsh* v. *Wolff*, 23 R. P. C. 265.

Use for shaping filaments during sintering of method formerly used for shaping them after sintering. *Osram Lamp Works* v. *Z Electric Lamp Coy.*, 29 R. P. C. 429.

Use of distillation *in vacuo* at a particular stage of process for making acetic acid, distillation *in vacuo* having been formerly used at other stages in this process, and the only gain in either case being a saving of fuel. *Von der Linde* v. *Brummerstaedt*, 26 R. P. C. 289.

Use of chloroform for crystallising acetyl-salicylic acid, it being a well-known reagent for crystallising other organic bodies. *Farbenfabriken, &c.* v. *Chemische Fabrik von Heyden*, 22 R. P. C. 501.

Claim for mixing thickened vegetable oils (old in themselves) with mineral oils. *Hutchinson* v. *Pattulo*, 5 R. P. C. 351, I. H.

Use of coloured varnishes for decorating tinplate made in a special, but old manner, although a new artistic effect was obtained. *Hudson & Scott & Sons, Ltd.* v. *Barringer*, 23 R. P. C. 502, C. A. See also *Harrison* v. *Nicholson*, 25 R. P. C. 398.

(*k*) The following are cases of this class where the patents have been held void :—

Use of two fans instead of one for actuating imitation flames on stage. *Fuller* v. *Handy*, 21 R. P. C. 6.

Use of springs at each end of shuttle carrier in place of one spring and a leather buffer. *Deutsche Nahmaschinen Fabrik* v. *Pfaff*, 7 R. P. C. 251, C. A.

Doubling rollers so that two tinplates might be dipped at a time instead of one. *Elias* v. *Grovesend Tinplate Coy.*, 7 R. P. C. 455.

Making a thin razor blade with two edges. *Gillett Safety Razor Coy.* v. *Gamage*, 26 R. P. C. 745.

Duplicating cylinders in refrigerating machine. *Haslam* v. *Hall*, 5 R. P. C. 1.

Making crape falls with fold on both sides instead of one only. *White* v. *Toms* (1867), 37 L. J. (CH.) 204. But see *British United Shoe Machinery Coy.* v. *Fussell*, 25 R. P. C. 648.

(*l*) *E.g.* making a safety skirt that ripped up to the waist instead of only to the pommel. *Nicoll* v. *Swears & Wells*, 10 R. P. C. 240.

Constructing a washing basin so as to make complete revolutions instead of tilting to a certain angle where it was stopped. *Allen* v. *Horton*, 10 R. P. C. 412.

(N.B. In this case there were also complete anticipations.)

Making a matrix of three pieces of wire material overlapping at edge so as to give extra strength, it being old to make matrices of two pieces. *Siddall & Hilton, Ltd.* v. *Wood*, 21 R. P. C. 230.

(*m*) The following are cases of this kind where the patent has been held void.

Patent for casting tubular steam heaters in one piece. (N.B. In this case the Q. B. and Ex. Ch. held that as a matter of law this was not patentable.) *Ormson* v. *Clarke* (1862), 32 L. J. (C. P.) 291.

Patent for heel plates and nails cast in one. *Blakey* v. *Latham*, 6 R. P. C. 184, C. A.

Casting certain parts of a printing machine in one piece. *Newsum* v. *Mann*, 7 R. P. C. 307.

and similarly mere division would not in general constitute subject-matter (*n*).

Other cases of analogous user.

Beyond the classes above referred to there are many cases of analogous user of a contrivance "applied in a manner or to a purpose which is not quite the same, but is analogous to the manner or the purpose in or to which it has hitherto been notoriously used" (*o*), but whether this is so is essentially a question of fact in each case, and the decisions below only help as examples (*p*).

Casting two flukes of an anchor in one. *Brunton* v. *Hawkes* (1820), 4 B. & Ald. 541.

Making the piston of a lubricating device and the screw actuating it in one piece. *Jensen* v. *Smith*, 2 R. P. C. 249, 253. See also *Longbottom* v. *Shaw*, 8 R. P. C. 333, H. L. But see *contra Legge* v. *Wakelem*, 10 R. P. C. 379, and p. 34 *n.* (*h*).

(*n*) Patent for a paving block which was merely an earlier block cut in two would be bad. *Macnamara* v. *Hulse* (1842), W. P. C. 129, *n.*

(*o*) *Per* WESTBURY, L.C., in *Harwood* v. *Great Northern Railway* (1865), 11 H. L. C. at p. 682. It can hardly be said that "notorious" use is always necessary.

(*p*) Among cases of this class where the patent has been held bad are the following:—

Use of channelled plates for fishing rails analogous to their use for joining beams of bridges. *Harwood* v. *Great Northern Rail.* (1865), 11 H. L. C. 657.

Joining tramway rails by fixing below them an inverted piece of rail embedded in concrete not patentable, a like method (but without embedding in concrete) having been proposed for joining railway rails. *Cooper Patent Anchor Rail Joint Coy.* v. *London County Council*, 23 R. P. C. 289.

Use of double angle irons old in themselves for forming water joint in gasometers. *Horton* v. *Mabon* (1862), 31 L. J. (C. P.) 255.

Use of special joint well known for hot-water coils in boiler tubes. *Baker* v. *Kinnell*, 9 R. P. C. 441, 445.

Use of ferro concrete for piles analogous to its use for other structures (*per* BUCKLEY, L.J.). *Mouchel* v. *Coignet*, 23 R. P. C. 49. Affirmed in the H. L. under the title *Hennibique* v. *William Cowlin & Sons*, 26 R. P. C. 280.

Use of wooden planking in iron ships analogous to its use in wooden ships. *Jordan* v. *Moore* (1866), L. R. 1 C. P. 624.

Use of system of construction employed for shore fences for making sea groynes. *Case* v. *Cressy*, 18 R. P. C. 417.

Use of method of supplying air for working under water which had been previously used for working in wet ground. *Bush* v. *Fox* (1856), 5 H. L. C. 707.

Use of machine previously used for straining wire for purpose of testing wire would not be subject-matter. *Johnson* v. *Rylands* (1873), Griff. 138.

Use of bisulphite of lime to preserve fresh meat analogous to its use for packing meat which had been treated in a particular way. (*Per* Lords BLACKBURN and HATHERLEY.) *Bailey* v. *Roberton* (1878), L. R. 3 A. C. 1055.

Use of paraffin to purify wood pulp in order to prevent deposit on machinery, paraffin having been previously used to dissolve such deposit. *Partington* v. *Hartlepool Pulp & Paper Coy., Ltd.*, 12 R. P. C. 295.

Use of flexible envelope through which a wire passed (such as had been previously used as a surgical instrument) for actuating bicycle brakes. *Bowden's Patent*, 22 R. P. C. 49.

Use of lock for fixing steering wheel of bicycle at rest in manner in which it had been suggested for bicycle in motion, though latter use was impracticable. *Singer* v. *Rudge Cycle Coy.*, 11 R. P. C. 463.

Use on railways of wheels made like those formerly used on road. *Losh* v. *Hague* (1839), W. P. C. 200. In the same case ABINGER, C.B., told the jury that it would not be patentable to claim the use of scissors for cutting silk instead of cloth or of a spoon for eating peas instead of soup.

The particular use of an old article can only be patented when such use amounts to a new manufacture. Of course many such users satisfy this definition (*q*), but a very wide view has been taken with regard to analogous user of tools or machinery, and, generally speaking, it is not a patentable invention to apply tools used for one purpose to carry out another known process formerly accomplished by other means (*r*). But

New use of old article or process.

See also *Westley* v. *Tolley*, 11 R. P. C. at p. 608.

Use of evaporating pipes in propagating pans analogous to their use in greenhouses. *Pascall* v. *Toope*, 8 R. P. C. 1.

Use of rubber band round coil of tape in place of other bands, though the rubber band was more effective in preventing entanglement. *West* v. *Keeves*, 28 R. P. C. 474.

Use of thick plates in place of thin ones at end of cells of icemaking machine in order to conduct heat away more quickly. The superior conductivity of thick plates was well known. *Siddeley* v. *London Hygienic Ice Coy.*, 14 R. P. C. 514.

Use of insulator to prevent arc to magnet in electric blowout. *British Thomson-Houston Coy.* v. *Manchester Corporation*, 20 R. P. C. 461, 470.

Use of special old fabric for making tyre covers. *Palmer Tyre Coy.* v. *Pneumatic Tyre Coy.*, 16 R. P. C. 451, 495.

Use of steel springs in place of whalebone for stiffening petticoat. *Thompson* v. *James* (1863), 32 Beav. 570.

Use of clamp and cleat for supporting battens in vessels. *Rockcliffe* v. *Priestman*, 15 R. P. C. 155.

Use of ordinary folding screen on window. *Sharp* v. *Brauer*, 3 R. P. C. 193.

Use of a spring blind for displaying advertisements. *Gawthorpe* v. *Mason*, 23 R. P. C. 401.

Use of strap attached to legging to wind round and secure it. *Stohwasser* v. *Humphreys*, 18 R. P. C. 116.

Use of hooks on one side of boots combined with holes on the other. *Hill* v. *Thomas*, 24 R. P. C. 415, C. A.

Use for holding water of hollow column supporting floors. *Ticklepenny* v. *Army & Navy Stores*, 5 R. P. C. 405.

Use of space under coachman's seat as glass-sided hearse for child's coffin. *Tadman* v. *Owens*, 11 R. P. C. 349.

See also remarks of judges in *Bamlett* v. *Picksley* (1875), Griff. P. C. 40.

(*q*) The following cases in which the patents were upheld illustrate this:—

Use of an iron ring covered with fibre for placing in kettle, etc., to prevent corrosion. *Peckover* v. *Rowlands*, 10 R. P. C. 234, C. A.

Use of zinc powder in boiler to prevent corrosion. *Innes* v. *Short*, 15 R. P. C. 449.

Use of secondary batteries in conjunction with dynamos as pressure regulator, though batteries had previously been used for storing electricity. (Patent held bad on other grounds.) *Lane Fox* v. *Kensington Electric Lighting Coy.*, 9 R. P. C. 417, C. A.

Use of iron plates, old in themselves, in building houses so as to render them fireproof is good subject-matter. *Boulton & Watt* v. *Bull* (1795), Dav. P. C., *per* EYRE, J., at p. 209 (*obiter*).

Where an alteration has to be made to fit the device for its new use subject-matter is more easily established, *e.g.* Use of mandrel heated internally for bending sawn wood not analogous to use of solid mandrel for bending roots, etc., to make walking sticks, the heat being applied externally. *Dangerfield* v. *Jones* (1865), 13 L. T. 142.

(*r*) See generally as to analogous user, *Dredge* v. *Parnell*, 16 R. P. C. 625, H. L.; *R.* v. *Cutler* (1847), 3 Car. & Kir. 213; *Bamlett* v. *Picksley* (1875), Griff. 40; *Tatham* v. *Dania* (1869), Griff. 213; *Losh* v. *Hague* (1838), W. P. C. 203; but *cf.* *Fellows* v. *Brookes*, 27 R. P. C. 102.

The following are examples of this class of case where the patents were held bad:—

Use of templet and band saw as used by tailors, etc., for cutting neckties. *Dredge* v. *Parnell*, 16 R. P. C. 625, H. L.

Use of blocks for building up letters, patterns, etc., for printing large posters, such blocks having been previously suggested and used for small

it would be patentable if the new materials were so different from the old that it was a real step forward to see that the application of the old machinery was practicable, *e.g.* applying machinery formerly used for making macaroni to the manufacture of steel tubes (*s*). The analogous user may of course be in the same trade and in general a patent cannot be obtained for a special method of using a machine, such method not being new in itself, unless a new product is obtained (*t*).

So, too, attempts to restrain the general use of processes are

work. (The patent had been previously upheld on a statement that alleged anticipation was unworkable—see *Shaw* v. *Jones*, 6 R. P. C. 328.) *Shaw* v. *Day*, 11 R. P. C. 188.

Use of mandrel shaped like a bottle for manufacture of straw bottle covers. *Patent Bottle Envelope Coy.* v. *Seymour* (1858), 28 L. J. (C. P.) 22.

Use for flattening "Paragon" ribs in umbrellas of tools formerly used for flattening solid ribs. *Edmond's Patent*, 6 R. P. C. 355.

Use for finishing wool and hair threads of revolving beaters which had been proposed for finishing cotton threads. *Brook* v. *Aston* (1859), 28 L. J. (Q. B.) 175.

Use of old corrugated packing for sending articles through parcels post. *Jackson* v. *Needle*, 2 R. P. C. 191.

Use of strip of canvas and rubber for fixing to tyres to repair them. *Reynolds* v. *Smith*, 20 R. P. C. 410, C. A.

Use of ordinary lock hold for locking steering wheel of bicycle when at rest. *Singer* v. *Rudge Cycle Coy.*, 11 R. P. C. 463.

Use of electric furnace for forming calcium carbide held to be analogous (in view of the state of knowledge), to its use for producing aluminium. *Acetylene Illuminating Coy., Ltd.* v. *United Alkali Coy.*, 22 R. P. C. 145, H. L.

See also cases at p. 31, *n.* (*h*), and especially *Rucker* v. *London Electric Supply Corporation*, 17 R. P. C. 279; *Northern Press & Engineering Co.* v. *Hoe*, 23 R. P. C. 613, C. A.

(*s*) *Bamlett* v. *Picksley*, *ubi supra*, at p. 242.

Some remarks of the Judges and Law Lords in *Ralston* v. *Smith* (1865), 11 H. L. C. 223, would seem to point to no user of known machinery being patentable, but on reading the judgments it will be seen that they were considering analogous users. But see *Adamant Stone Coy., Ltd.* v. *Liverpool Corporation*, 14 R. P. C. 11.

(*t*) *Kay* v. *Marshall* (1841), 2 W. P. C. 71. "*Kay* v. *Marshall* said that if the world has got the whole thing before it you putting in your boundary line in the midst of that which is common property cannot mark off a part of the common which the whole world has the right to feed on. You cannot put a hedge across it and say, 'This is something of my own which I appropriate to myself.'" *Bovill* v. *Crate* (1865), Griff. N. C. at p. 46.

The following are cases of this kind:—

Patent for using a spinning machine with a reach of 2½ *held* bad. *Kay* v. *Marshall* (1841), 2 W. P. C. 71.

Curved pieces having been used for the purpose of dress measurement there was no subject-matter in suggesting use of curves of a special shape. *Philpott* v. *Hanbury*, 2 R. P. C. 153.

Driving the grooved rollers of an embossing machine differentially, and so producing a special gloss *held* not subject-matter. Grooved rollers were old and so was differential driving, but there had been an idea that if grooved rollers were driven differentially they tore the goods. (There was a difference of opinion as to whether a claim for the new combination of machinery would have been good.) *Ralston* v. *Smith* (1865), 11 H. L. 233.

Use of a spinning machine with a certain number of heads and bobbins in a particular (old) way. *Kopp* v. *Rosenwald*, 19 R. P. C. 205, and 20 R. P. C. 154, C. A. See also *Nadel* v. *Martin*, 23 R. P. C. 41, H. L.; *Tetley* v. *Easton* (1857), 26 L. J. (C. P.) 269; *Subdury* v. *Lee*, 11 R. P. C. 58.

discouraged (*u*), but there are many more examples of variations in a process (especially if it is of a chemical nature) being held to form subject-matter than is the case with variations in the use of tools or machinery (*x*), nor are the Courts so ready to find that former uses were merely analogous (*y*).

Rules are subject to modification.

These "rules" are little more than classifications of relevant evidence. In estimating the effect of such evidence it is necessary to consider whether the former application to other purposes was wide and well known, or merely special or experimental, or only a suggestion. Further, this effect may be supplemented or modified by extrinsic evidence to prove that the application needed ingenuity, *e.g.* evidence that the want satisfied by it was of long standing.

New Article.

The novelty of an article may either lie in the size, shape, etc., of the article itself or it may lie in the method of manufacture (*z*) or material (*a*) of which it is made. When novelty in one or more of these respects has been established the further question of invention arises.

In considering whether the new article is an invention attention must be paid both to the qualities of the article itself, *e.g.* its appearance, durability, cheapness of manufacture (*b*), and also to the function it performs. Thus it is important to consider whether the new article produces a result never obtained before, or produces an old result in a better or cheaper way (*c*), or merely furnishes a useful-variant for obtaining an old result (*d*). In any of these cases the article may possess subject-matter, but naturally the Courts are more apt to find invention in an article which produces a result never

(*u*) *Patterson* v. *Gas Light & Coke Coy.* (1875), 3 A. C. 239, and 2 Ch. D. 812, 835, C. A.; *Acetylene Illuminating Coy.* v. *United Alkali Coy.*, 22 R. P. C. 145, H. L.

(*x*) See cases at p. 32, n. (*cc*).

(*y*) *E.g.* patent for extracting "garancine" from spent madder by the same process by which it had been got from fresh madder. The Judge at trial having directed verdict for defendants on subject-matter the Exchequer Chamber held it should have been left to the jury, since it was a question of fact whether fresh and spent madder were known to be substantially the same thing. *Steiner* v. *Heald* (1851), 20 L. J. (Ex.) 410.

Dipping incandescent mantles for impregnation purposes patentable although shirts, etc., had been dipped for starching. *Sunlight Incandescent Coy.* v. *Incandescent Gas Coy.*, 14 R. P. C. 557; but *cf.* cases at p. 51.

(*z*) *Cf. Elliott* v. *Aston* (1840), W. P. C. 222 (buttons covered with silk and made by pressure).

(*a*) See p. 39.

(*b*) See *Cornish* v. *Keen* (1835), W. P. C. 506; *Elmslie* v. *Boursier* (1869), L. R. 9 Eq. at p. 217; *Heath* v. *Unwin* (1855), 5 H. L. C. 505, 545.

(*c*) See *Crane* v. *Price* (1842), W. P. C. 409.

(*d*) *Scott* v. *Hamling & Coy., Ltd.*, 14 R. P. C. 123, 140; *Welsbach Incandescent Coy.* v. *New Incandescent Coy.*, 17 R. P. C. 252.

obtained before, or which produces a better or cheaper result than in one which merely furnishes a variant.

New substance.

Where a patentee has shown how to produce a new and useful substance this in general constitutes subject-matter (*e*). But here again it must be remembered that certain manufactures involve a continual production of new varieties of a substance, and such new varieties would not constitute new manufactures unless their method of production lay outside the ordinary methods of the art, or unless they had qualities which could not have been predicated. It has been said that new and useful chemical compounds are always patentable, and that it is not a valid objection to show that persons were on the point of discovering such substance, or that the course of development of chemical research would have naturally led to it (*f*). This, of course, is not a rule of law, but a finding of fact as to the chemical knowledge of the day, and there are now branches of chemical industry, where the method of production of new compounds is so well known, and their properties can be predicted with such certainty, that it is doubtful whether they are necessarily patentable.

Where such claim is made to a material *per se* it is anticipated if there has been any description of such article for any purpose (*g*).

New article may be produced by old means.

If an article new in itself is produced, and such that it can be said that its production is a real addition to public knowledge, it is of course no objection that it is entirely manufactured by old processes and that previous existing machines could have produced the result (*h*). In fact, this is the case with the greater number of new articles.

(*e*) *Badische, etc.* v. *Levinstein*, 4 R. P. C., *per* HALSBURY, L.C., at p. 462, H. L.; see also *Same* v. *Dawson*, 6 R. P. C. 387; *Acetylene Illuminating Coy.* v. *United Alkali Coy.*, 22 R. P. C. at p. 153, H. L.

But a claim for a particular kind of paper covered with wax was held bad in *Dick* v. *Ellam*, 17 R. P. C. 196, C. A. For other cases where substances new in themselves were held not to be patentable, see *Adamant Stone Coy.* v. *Liverpool Corporation*, 14 R. P. C. 11; *Maclay* v. *Lawes*, 22 R. P. C. 199. See also *Palmer Tyre Coy.* v. *Pneumatic Tyre Coy.*, 16 R. P. C. 451, 495; *Hudson Scott* v. *Barringer*, 23 R. P. C. 502, C. A.

(*f*) *Badische, &c.* v. *Levinstein*, *ubi supra*.

(*g*) *Adhesive Dry Mounting Coy., Ltd.* v. *Trapp & Coy.*, 27 R. P. C. 341, 353.

(*h*) *Acetylene Illuminating Coy.* v. *United Alkali Coy.*, 22 R. P. C. 152, H. L.

The following are cases of this class where the patents were upheld:—

Boot hook made from a single piece of wire with a tubular shank and having a groove cut in the head. All the processes were old but the product was new. *Bray* v. *Gardner*, 4 R. P. C. 400.

Wire mattress with patches of "close" weaving. "Close" weaving could have been done on the old

A variation in scale or degree in an article or process may form subject-matter if the change is sufficient to lead to new and useful results (*i*).

Variation in degree may constitute subject-matter.

A patent may in some cases be supported for an old class of article made from a substance not previously used for it. The question here again is, was such manufacture a probable development of any existing trade, and it may be said that the Courts, which scrutinise such patents somewhat narrowly, require firstly, that, the new material should not be an obvious substitute for the old, *e.g.* the mere substitution of one wood for another (*k*), and, secondly, that the new manufacture should exhibit a considerable advantage over the old (*l*). The fact that such new material has been used for other analogous purposes may destroy the subject-matter (*m*). There may also be invention in some cases in applying a process to an article to which it has not been previously applied, if such application or its results were not obvious (*n*).

Old article made of new material.

machines but was in fact new. *Dowling* v. *Billington*, 7 R. P. C. 191, C. A. (Ir.).

Wrought-iron lock and staple made in one. *Legge* v. *Wakelem*, 10 R. P. C. 379. See also remarks of EYRE, C.J., in *Boulton & Watt* v. *Bull* (1795), Davies, at p. 209. But *cf.* *Riekmann* v. *Thierry*, 14 R. P. C. 105, H. L.

(*i*) *E.g.* where it had previously been proposed to extract dust from carpets, etc., by means of air passing through a filter, but the vacuum used was only a few inches of water, it was held that a patent for a machine arranged to operate with a vacuum of five pounds was good. The earlier apparatus was quite unable to accomplish the results effected by this machine. *British Vacuum Cleaner Coy., Ltd.* v. *Suctions Cleaner, Ltd.*, 21 R. P. C. 300; *Same* v. *London & South Western Railway Coy.*, 29 R. P. C. 309, H. L. See also *Nobel's Explosive Coy., Ltd.* v. *Anderson*, 12 R. P. C. 614, H. L.; *Thompson* v. *Moore*, 6 R. P. C. at p. 455; *Bovill* v. *Cowan* (1867), W. N. 116; *Same* v. *Crate* (1868), Griff. N. C. 45, 47; *Brown's Patent*, 25 R. P. C. 86, 116, C. A.

(*k*) Thus the use of sheet felt in place of block felt for handles of bicycles was held not to be patentable. *Cooper* v. *Baedeker*, 17 R. P. C. 209, C. A. See also *MacClay* v. *Laws*, 22 R. P. C. 199, 203; *Rushton* v. *Crawley* (1870), L. R. 10 Eq. 522.

(*l*) For examples of such patents see *Muntz* v. *Foster* (1844), 2 W. P. C. 93 (use of special copper alloy for sheathing); *Walton* v. *Potter* (1841), W. P. C. 585 (use of india rubber for holding teeth of cards). In *Martin & Hyam's Patent* (1855), 25 L. T. (o. s.) 171, it was suggested that the use of gutta-percha for clogs would be patentable. In *United Telephone Coy.* v. *Harrison* (1883), 21 Ch. D. 720, it was suggested that the use of mica in telephone tympana would not be in itself patentable.

(*m*) Patent for metal eyelet having its flange embedded in celluloid held bad because hooks had been so made. *Riekmann* v. *Thierry*, 14 R. P. C. 105, H. L.

Use of solid naphthalene for enriching gas, other forms of naphthalene having been so used held not to be patentable. *Albo-Carbon Light Coy.* v. *Kidd*, 4 R. P. C. 535. See also *Palmer Tyre Coy.* v. *Pneumatic Tyre Coy.*, 16 R. P. C. 451, 494.

(*n*) Applying Neilson's hot-air blast to anthracite coal, which had not previously been considered available for use in furnaces; held good subject-matter. *Crane* v. *Price* (1842), W. P. C. 393.

Invention by selection.

There may be subject-matter in selecting one out of a class of substances for a particular purpose, although others of the class have been used before for the same purpose, and even although a patent has been taken out for the use of the whole class, provided that there is a special advantage attached to the use of the particular substance claimed and that the suggestion of using it was a real addition to former knowledge (*o*). These conditions are necessary to prevent the original patentee from being restricted in the exercise of his invention by subsequent claims for substances included in his general description the selection of which required no invention. It has also been said there may be subject-matter in selecting a special known machine best adapted for a special purpose (*p*).

New articles composed of old parts.

An article which is new may not contain any part new in itself and may yet be patentable. The cases of this kind fall into three classes. Firstly, although all the parts are old, yet the former use of one or more of them may have been for a purpose or in a manner so different to its purpose or manner in the new article that the change of user amounts to invention (*q*); secondly, the new article while not containing any new part which may be said to possess sufficient novelty, even in that particular class of machinery, to constitute subject-matter in itself, yet may constitute or contain a combination which is new and which possesses subject-matter, in that it

Applying process for extracting garancine from fresh madder to spent madder might be patentable if it was not known that the problems were identical. *Steiner* v. *Heald* (1851), 20 L. J. (Ex.) 410.

Applying principle of rectification as used in distillation of whisky to separation of oxygen from nitrogen. *British Liquid Air Coy., Ltd.* v. *British Oxygen Coy., Ltd.*, 25 R. P. C. 601, C. A., affirmed 26 R. P. C. 509, H. L.

Applying process for making carbon filaments to tungsten filaments. *Osram Lamp Works* v. *Z Electric Lamp Coy.*, 29 R. P. C. 421, 423.

(*o*) Patents of this class which have been upheld are the following :—

Use of a particular oxide of iron for gas purification though an earlier patent had covered the use of any oxide of iron. *Hills* v. *Evans* (1862), 31 L. J. (CH.) 457; *Hills* v. *London Gas Coy.* (1860), 29 L. J. (EX.) 409.

Use of a particular oxidiser for purifying flour. *Andrew's Patent*, 25 R. P. C. 477, H. L.

Use of particular substances to produce an explosive having certain special qualities though there had been a former specification suggesting the use for explosives of classes of substances of which these formed part. *Lancashire Explosives Coy., Ltd.* v. *Roburite Explosives Coy., Ltd.*, 12 R. P. C. 470, C. A.

Use of certain substances for making incandescent mantles, though these might have been included in the suggestions contained in a former specification. *Incandescent Gas Light Coy., Ltd.* v. *De Mare Incandescent Gas Light System*, 13 R. P. C. 322. See also *Wylie & Morton's Application*, 13 R. P. C. 98, L. O.

(*p*) *Adamant Stone Coy.* v. *Liverpool Corporation*, 14 R. P. C. 11, 21; but see p. 35. See also on the question of invention by selection, p. 43.

(*q*) *E.g. Brookes* v. *Lamplugh*, 15 R. P. C. 33, C. A., and see p. 26 *et seq.*

has an advantage greater or other than the sum of the advantages of the different parts ; and, thirdly, there may be subject-matter in selecting a number of parts, although all may be old and in fact may have been used before for similar purposes; if there has been such careful selection of the very best forms of each as to make a great improvement on previous practice. Similar considerations apply to new processes.

Each of these classes might be said to form a combination, but it is better for the purpose of discussion to restrict the term to the second case—that in which the novelty of the whole is said to be something different from the novelty of the parts.

Combinations.

The large majority of claims appear at first sight to be combination claims, since they specify the use of an article in certain machines, or together with certain other integers. But often these additions are merely for the purpose of description or limitation, and may be taken rather as avoiding anticipation by excluding forms of user not within their terms than as affording subject-matter (*r*).

Generally, it may be said that a monopoly of old devices can no more be obtained by claiming several together than by claiming them singly (*s*). But it may happen that by the union of certain integers special advantages are obtained, or special results follow, which were not obvious from the former use of the separate integers and in such cases the combination may form subject-matter (*t*).

The invention necessary to make a combination patentable may be in any or all of the stages before referred to (*u*), and a patentable combination may be one producing a new result,

(*r*) *Cf. Dredge* v. *Parnell*, 15 R. P. C., *per* RIGBY, L.J., at p. 90, C. A.

(*s*) "A patentee cannot make a combination within the meaning of the Patent Law by calling it a combination." *Bamlett* v. *Picksley* (1875), Griff. at p. 44.

(*t*) *E.g.*, the use of a special clamp enabling braided wire to be used for bustles. *American Braided Wire Coy.* v. *Thompson*, 6 R. P. C. 518, H. L.

Combination of parts giving a valve suitable for use in pneumatic tyres, which none of the valves in which the parts had been formerly used would have suited. *Pneumatic Tyre Coy., Ltd.* v. *Casswell*, 13 R. P. C. 375, C. A.

Placing platinum black in a special case (not new in itself) so that it could be used as a gas lighter but was normally protected from the air. *Heine* v. *Coninco Incandescent Coy.*, 21 R. P. C. 202.

Patent for a compass card consisting of a rim only with short needles attached. The substitution of the rim for the ordinary card enabled the patentee to obtain at the same time lightness and slowness of oscillation (qualities which under the old system were antagonistic) and to control the card by short needles, which allowed of easy correction. *Thomson* v. *Moore*, 7 R. P. C. 325, H. L. ; *Same* v. *Batty*, 6 R. P. C. 84.

(*u*) See p. 24.

or arriving at an old result in a better or cheaper way (*x*), or giving a useful choice of means (*y*), but the criteria of subject-matter necessarily differ in these different cases. If the result is new, this in itself is strong evidence of invention (*z*), but if the result is old the question is more difficult.

If in, say, a machine of an old class, but in which the elements are varied, all the parts perform the same functions as they have performed in earlier users, there would be a strong suspicion that all that the patentee had done was to make a more or less intelligent choice of equivalents, and that the improved result was only that to be expected from the separate advantages of such equivalents (*a*). This is especially the case where the improvements are in parts of a machine only more or less remotely connected with each other (*b*), and it may be said that in a true combination in which the patentability arises from the combination of parts in themselves old but which have not previously been used together, the advantage of the combination should not be merely the combination of the advantages of the separate parts. The combination of one part with another should either develop fresh advantages or overcome disadvantages in one or both parts or at any rate should allow the inherent capabilities of the parts to have fuller play than they had before. Often the construction of one or more of the parts must be modified to enable these results to be achieved, the invention lying not only in the conjoint use of the parts, but in the appropriate adaptations for such use (*c*).

In the case, however, of a combination producing a new result, or an old result by means substantially different from those formerly employed, this rule is relaxed in view of the intrinsic evidence of invention (*d*).

(*x*) *Crane* v. *Price* (1842), W. P. C. 393, 409; *Cornish* v. *Keene* (1835), W. P. C. 509, 517; *Cannington* v. *Nuttall* (1871), L. R. 5 H. L. 205; *International Harvester Coy. of America* v. *Peacock*, 25 R. P. C. 765, P. C.; *Harrison* v. *Anderston Foundry Coy.* (1876), 1 A. C. 574; *Murray* v. *Clayton* (1872), 7 Ch. App. 570; *Spencer* v. *Jack* (1864), 3 De J. & S. 346.

(*y*) *Scott* v. *Hamling & Coy., Ltd.*, 14 R. P. C. 123, 140.

(*z*) *Crosthwaite Fire Bar Syndicate* v. *Senior*, 26 R. P. C. 713, 732.

(*a*) *Cf. Donnersmarckhutte, etc.* v. *Electric Construction Coy.*, 27 R. P. C., *per* FLETCHER MOULTON, L.J., at p. 783, C. A.

(*b*) "But the point in a combination patent must always be that the elements of which the combination is composed are combined together so as to produce one result." *Klaber's Patent*, 23 R. P. C., *per* Lord DAVEY, at 469, H. L.; *Allen* v. *Oates*, 15 R. P. C. 298, 303; *British United Shoe Machinery Coy.* v. *Fussell*, 25 R. P. C. 631, 657, C. A.

(*c*) *International Harvester Coy. of America* v. *Peacock*, 25 R. P. C. 777.

(*d*) See note (*z*), *supra*.

In all cases the state of knowledge as to the separate parts is important, since the Courts have to consider whether the choice and combination of the parts involved research and invention (*e*), and this question is largely affected by whether the separate integers had been commonly used, so that their effects and limitations were all known, or whether their use had been merely suggested in different specifications (*f*).

These considerations emphasise the necessity of considering the advance made by the combination as a whole rather than analysing the changes in particular parts (*g*).

There may also be in some cases subject-matter in selecting for a machine a number of parts, although there may have been Selection of parts.

(*e*) *Saxby* v. *Gloucester Wagon Coy.* (1881), 7 Q. B. D. at p. 312. *Chadburn* v. *Mechan*, 12 R. P. C. 120, 154.

(*f*) *Von Heyden* v. *Neudstadt* (1880), 50 L. J. (CH.) 126, 128, C. A., and see p. 55.

(*g*) The following are examples of combinations held patentable :—

Mixing nitroglycerine and collodion guncotton so as to form a powder less violent than either and fit for use for propulsive purposes, *Nobel's Explosive Coy., Ltd.* v. *Anderson*, 11 R. P. C. 519, C. A.

Combination of molasses and peat to form a cattle food the peat not being a mere diluent but neutralising the potassium salts in molasses. *Molassine Coy., Ltd.* v. *Townsend Ltd.*, 23 R. P. C. 27.

An instrument for giving a light consisting of sulphuric acid in a glass tube the end of which was wrapped in paper containing potassium chlorate and fat, so that on breaking the tube a light was produced, *held* to form a patentable combination, although the chemical reactions involved were well known, and glass tubes known articles. *Lukie* v. *Robinson* (1838), 2 Jur. 201.

A pneumatic valve consisting of a combination of old parts which as previously used would have been unsuitable for producing the results sought by the patented combination was held good subject-matter. *Pneumatic Tyre Coy.* v. *Casswell*, 13 R. P. C. 375, C. A.

Substitution of sliding glass panel in shape of segment of sphere on glass lamp in place of hinged panel, thus avoiding metal work and so enabling lamp to cast no shadow and also diminishing risk of breaking from unequal expansion. *Parkes* v. *Stevens* (1869), 5 Ch. App. 36.

Improved gigmill in which raising rollers were so arranged that their motion was at the same time independent and variable. Former machines had given either of these results but not both together. *Moser* v. *Marsden*, 13 R. P. C. 24, H. L.

Patent for a gramophone horn in which lower part was tapered and which also had a double joint so that it could move both horizontally and vertically. Tapering and double jointing both old in themselves, but by the combination special difficulties were surmounted. *Gramophone and Typewriter Coy., Ltd.* v. *Ullman*, 23 R. P. C. 752, C. A.

Use of bisulphite of lime in combination with gelatine so that a new process of preserving meat, etc., by glazing was produced. (Patent held bad on other grounds.) *Bailey* v. *Roberton* (1878), 3 A. C. 1055.

Use in ejecting mechanism of three parts in combination (whose use separately for this purpose was held not to be patentable), the combination permitting a spring to remain normally uncompressed, and also causing ejection to be performed by movement of gun barrel and not by spring action. *Deeley's Patent*, 13 R. P. C. 51, H. L.

Lintel for concrete floor of such shape that concrete got its main support from girder and there was also an air passage formed under girder. Neither of these results new *per se*. *Fawcett* v. *Homan*, 13 R. P. C. 398, C. A.

Compass suspended by horizontal springs under tension attached to a piece of metal hinged to compass.

analogous user of these and there is no true combination, if a

Horizontal springs under tension attached directly to compass were old, and the hinged metal had been used with vertical springs. *Kelvin* v. *Whyte Thomson*, 25 R. P. C. 177.

Roaster for use on ships, formed in one with grate and having vertical spits with bearings so that meat was always held at same angle to fire. Such bearings had been mounted in moveable roaster, and roasters formed integral with grate had also been used. *Lynch* v. *Phillips*, 26 R. P. C. 389, I. H.

The combination in the same cloth of elastic and non-elastic threads. *Cornish* v. *Keene* (1835), W. P. C. 509.

In apparatus for concentrating sulphuric acid the use of a special form of beaker, together with a special method of circulation (both of which were old separately). (See, however, judgment of Lord SHAND who seemed to hold subject-matter not to be in dispute. The patent was held bad for insufficiency.) *Kynoch & Coy., Ltd.* v. *Webb*, 17 R. P. C. 100, H. L.

The combination with a milking machine of a regulating valve to prevent the vacuum becoming excessive. *Murchland* v. *Nicholson*, 10 R. P. C. 417, O. H.

Combination of an internally toothed wheel, worked by a rachet on a lever fulcrumed on axis of wheel, and supporting a chair that raised and turned a forging, all the separate parts being old and having been used for similar purposes. *Siddell* v. *Vickers*, 7 R. P. C. 292, H. L.

In the case of a refrigerating machine it was held that it was not sufficient for the defendants to prove that if part of one prior machine and part of another were combined you would get the plaintiff's machine. *Haslam* v. *Hall*, 5 R. P. C. 1.

Combination of a screw and clamps in a trouser stretcher, though clamps and weights had previously been used, and also a screw acting on two boards to which the trousers were attached. (A doubtful case, the Court of Appeal expressly refused to decide validity.) *Gosnell* v. *Bishop*, 5 R. P. C. 41.

The following are cases of combinations held not patentable.

The use of an (old) secondary coil with a circuit worked by an (old) alternating machine producing high tension current. *Gaulard & Gibb's Patent*, 7 R. P. C. 367.

Formerly sausage-making machines had been of two classes. In one revolving knives shredded the meat by pressing it against and through a perforated plate, in another revolving knives shredded the meat against other revolving knives and also fed it forward into the skins. *Held*, that a machine in which revolving knives forced meat through a perforated plate and then other revolving knives fed it into the skin was not patentable. *Williams* v. *Nye*, 7 R. P. C. 62. (See also *Northern Press* v. *Hoe*, 23 R. P. C. 613, C. A.)

In certain classes of electrical machinery sudden excessive demands for current had been met by the use of a fly-wheel and also by special excitation of the fields. It was held that a combination of the two methods was not patentable. *Donnersmarckhutte, etc.* v. *Electrical Construction Coy.*, 27 R. P. C. 774, C. A.

Signalling and interlocking device which had the signalling device the same (except for one variation held to be a mere mechanical equivalent) as was shown in one specification, and the interlocking device the same as was shown in another, each part performing its original function. *Saxby* v. *Gloucester Wagon Coy.*, 7 Q. B. D. 305, 312.

The attachment of an old abdominal belt to a corset. *Wardroper* v. *Gibbs*, 20 R. P. C. 355.

Fastening together protecting sheets to be used for stencil purposes. *Klaber's Patent*, 23 R. P. C. 461, H. L.

Combining a "Dewar" flask with a protective covering. *Thermos Ltd.* v. *Isola Ltd.*, 27 R. P. C. 388.

Combining grooves (held to be equivalent to roughing which was old) and an enlarged end in a racquet handle. *Slazenger* v. *Feltham*, 6 R. P. C. 232, C. A. (overruling *Moss* v. *Malins*, 3 R. P. C. 373).

The combination of a watering pot of canister shape and a particular form of handle. *Haws* v. *Harding*, 14 R. P. C. 930, C. A.

Combination of a vertical pipe of special shape and a horizontal pipe to form a water closet. *Held* not patentable since each pipe performed its old function. *Allen* v. *Oates & Green*, 15 R. P. C. 744, C. A.

Woolwashing tanks had been made with the bottoms of various shapes,

greatly improved result is obtained (*h*). Patents of this class are, however, closely scrutinised, especially if the parts have been in common use (*i*). There is a certain amount of analogy between patents of this class and patents for the selection of that one of a class of substances which gives a specially good result (*j*).

There may be invention in omitting a stage of a process (*k*) or an unnecessary part of a machine (*l*) or an unnecessary ingredient (*m*). Invention by omission.

In some cases which have been before the Courts the Court found that the article or combination was in fact new, or achieved a new result, and held that this in itself was sufficient Novelty constituting invention.

including sloping bottoms. A slit had also been made in the false bottom to get in a brush. Held that a tank with a bottom sloping to one side and a slit in false bottom on that side not patentable. *McNaught* v. *Dawson*, 23 R. P. C. 219, C. A.

A combination of rubber thread wound under tension on a gutta-percha core for golf balls *held* bad in view of the fact that rubber thread had been so wound on other cores in golf balls, and golf balls had been made of gutta-percha. (The H. L. seemed to have doubted the advantages claimed for the ball.) *Haskell Golf Ball Coy.* v. *Hutchinson*, 25 R. P. C. 194, H. L.

The union in the same shop of two trades which had formerly been carried on separately would not be subject-matter (*obiter per* Lord MACKENZIE). *Templeton* v. *Macfarlane* (1848), 1 H. L. C. 595.

(*h*) *Van Berkel* v. *Simpson*, 24 R. P. C. 117, 135.

(*i*) See *Northern Press* v. *Hoe*, 23 R. P. C. 613, C. A.

(*j*) See cases at p. 40, *n.* (*o*).

"The essence of the invention appears to be that the inventor has taken a great many things which were common knowledge and tried which of these items of common knowledge would produce a useful result and a new result, and he has ascertained that following the process described by him you will arrive at the new and useful result which he does arrive at, and I consider that that is undoubtedly invention." *Lancashire Explosive Coy.* v. *Roburite Explosive Coy.*, 12 R. P. C., *per* RIGBY, L.J., at p. 482.

"In selecting with a view to alteration one may be inventing." *British Westinghouse Coy.* v. *Braulik*, 27 R. P. C., *per* FLETCHER MOULTON, L.J., at p. 224. See also *Webb* v. *Kynoch Ltd.*, 15 R. P. C. 290, Ir.

(*k*) "It is just as much invention to reject the bad as to select the good." *British Westinghouse Coy.* v. *Braulik*, 27 R. P. C., *per* FLETCHER MOULTON, L.J., at p. 224.

The following are examples of such patents which have been held good:—

Making gas direct from seeds instead of first expressing the oil, and then making gas from the expressed oil. *Booth* v. *Kennard* (1856), 26 L. J. (EX.) 305.

Varying a chemical process for the production of dyes by omitting the first stage, which the patentee had proved to be useless. *Badische, &c.* v. *Société des Usines du Rhone*, 15 R. P. C. 359, C. A. See also *Leonhardt* v. *Kalle*, p. 46, *n.* (*r*), and *Russell* v. *Cowley*, p. 50.

(*l*) *Minter* v. *Mower* (1835), W. P. C. 140. *Cf.* also *British Motor Syndicate* v. *Universal Motor Carriage Coy.*, 16 R. P. C. 113, and *Beeton* v. *Watts*, 25 R. P. C. 19, C. A.

(*m*) Using cyanide of potassium alone for the extraction of gold from its ores not anticipated by a specification suggesting the use of a mixture of cyanide of potassium and carbonate of ammonia. *Cassel Gold Extracting Coy., Ltd.* v. *Cyanide Gold Recovery Syndicate*, 12 R. P. C. 303, C. A.

evidence of invention (*n*), though in some cases the variation required little, if any, ingenuity (*o*).

Invention where result could not be foreseen.

In some cases, and more particularly in the case of chemical patents, a variation of old methods has been held to form subject-matter because it was not possible to predicate the new result from the results of the old method with any certainty or without experiments and research (*r*).

(*n*) *E.g.* frame containing prism for use as pavement light. *Hayward* v. *Hamilton* (1881), Griff. 115, C. A.

Glass semi-cylinders mounted on trunnions for use in producing photographic prints. *Halden* v. *Hall*, 21 R. P. C. 609.

Steam trap in which for first time motion was at junction of two rods and not at joint. *Geipel's Patent*, 21 R. P. C. 379, C. A.

Use of auxiliary drum for printing in stop news, auxiliary drums being old for other purposes in printing. *Taylor* v. *Annand*, 18 R. P. C. 53, H. L.

An electric battery having certain constituents (all previously used in various ways), and in particular having outer layer "semi-solid." The battery was in fact very successful, though it was not clear that reason for this was due to any particular variation. *Patent Exploitation Ltd.* v. *Siemens*, 21 R. P. C. 541, H. L.; but *cf. Same* v. *American Novelty Coy.*, p. 52, *n.* (*f*).

Feeding coal by an oscillating radial arm good subject-matter though coal had been fed by the backward and forward movement of a pusher, and also by a rotating arm acting by the combined effect of the blow and of centrifugal force. *Proctor* v. *Bennis*, 4 R. P. C. 333, C. A.

Machine for testing wire in which it was uncoiled from one drum and coiled on another driven differentially, though previously wire had been strained by winding it on a drum, while it was unwound from an independent drum retarded by a brake. *Johnson* v. *Rylands* (1873), Griff. 138.

Lamp adapted to fit into ordinary socket, but made to rotate so that either of two filaments of different resistance could be brought into use. *True and Variable Lamp Syndicate* v. *Bryant*, 25 R. P. C. 461. See also *Stepney Spare Wheel Ltd.* v. *Hall*, p. 27 (*b*), *n.*

(*o*) *E.g. Taylor* v. *Annand*, *supra*.

(*r*) *Nobel's Explosive Coy., Ltd.* v. *Anderson*, 11 R. P. C. at p. 127; *British Liquid Air Coy.* v. *British Oxygen Coy., Ltd.*, 25 R. P. C. at p. 601, see p. 18; *Orram Lamp Works* v. *Z Electric Lamp Coy.*, 29 R. P. C. 421, 423; *Moseley* v. *Victoria Rubber Coy.*, 4 R. P. C. at p. 252; *British United Shoe Machinery Coy.* v. *Fussel*, 25 R. P. C. 648 C. A.; *Croysdale* v. *Fisher*, 1 R. P. C. at p. 17; *Electric Telegraph Coy.* v. *Brett* (1851), 20 L. J. (C. P.) 131; *Brown's Patent*, 25 R. P. C. 114, C. A.

But where in view of the knowledge of the time the result would appear *à priori* to be probable mere experiment to verify this may not be sufficient. *Alsop's Patent*, *infra*.

The following are examples of such patents which have been held good:—

Formerly a blasting powder had been made by adding 7 per cent. of collodion guncotton to nitroglycerine. A process in which the proportion of collodion guncotton was raised to 60 per cent. of the whole, and which gave a powder suitable for propulsive purposes held good subject-matter. *Nobel's Explosive Coy.* v. *Anderson*, 11 R. P. C. 115.

An explosive was formed by taking certain substances which belonged to a large class whose use had been suggested for explosive purposes. It was admitted that a chemist would have known this mixture would have produced an explosive, but not that the explosive would have the desirable qualities it in fact possessed. *Lancashire Explosives Coy.* v. *Roburite Explosives Coy.*, 12 R. P. C. 471, C. A.

In a chemical process a direction to stop the oxidation at an earlier point than usual gave a new dye stuff. Held good subject-matter. *Leonhardt & Coy.* v. *Kalle*, 12 R. P. C. 306.

Example of process variations not constituting subject-matter:—

The use of electricity to produce certain gases for conditioning flour not subject-matter, such gases having been formerly produced by means of nitric acid, and the chemical know-

Invention by rendering process practicable.

It must never be forgotten that patent rights are primarily intended as the reward for the introduction of a "new manufacture." There may, therefore, be subject-matter in introducing a new manufacture by describing a commercial process, though it is based on principles already applied in laboratory work or known in other forms (*t*). So, too, in considering whether the patentee has introduced a new manufacture the Courts do not pay much attention to previous suggestions which were not available commercially, *e.g.* suggestions for machines which would have been more expensive than hand labour (*u*). But this application to commercial purposes must involve some ingenuity, or be of such a nature that its success could not have been predicted with certainty (*x*).

Mere discovery not sufficient.

Mere discovery of the nature or action of a process, or that certain results do or do not follow its normal use, however commercially valuable such discovery may be, does not constitute "invention" (*y*). Were it possible to get a patent for such discoveries it would have the effect of restricting the use of the process.

ledge of the day making it appear probable that electricity would produce the same result. *Alsop's Patent*, 24 R. P. C. 733.

(*t*) *Fernie* v. *Young* (1866), L. R. 1 H. L. 63; *Von Heyden* v. *Neudstadt* (1880), 14 Ch. D. 230; *Washburn & Moen Coy.* v. *Paterson*, 2 R. P. C. 27; *Betts* v. *Menzies* (1862), 10 H. L. C. 117; *Hills* v. *London Gas Coy.* (1860), 29 L. J. (EX.) 409, 413, 424; *Incandescent Gas Light Coy.* v. *De Mare Incandescent Gas Light System*, 13 R. P. C. 559, C. A.; *Edison & Swan Coy.* v. *Woodhouse*, 4 R. P. C. 79, 106, C. A.

(*u*) *Murray* v. *Clayton* (1872), 7 Ch. App. 570.

(*x*) *Acetylene Illuminating Coy., Ltd.* v. *United Alkali Coy., Ltd.*, 22 R. P. C. 145, H. L.; *British Thomson Houston Coy., Ltd.* v. *Mayor of Manchester*, 20 R. P. C. 461.

(*y*) As to the difference between discovery and invention, see *Reynolds* v. *Smith*, 20 R. P. C., *per* BUCKLEY, L.J., at p. 126.

The following cases illustrate this point:—

Discovery that a known process for making calcium carbide could be used on a commercial scale without injurious electrolisation did not give right to a patent for such use. *Acetylene Illuminating Coy., Ltd.* v. *United Alkali Coy., Ltd.*, 22 R. P. C. 145, H. L.

Discovery that it was practicable to drive a concrete pile did not give right to a patent for such a pile, which had previously been suggested. *Mouchel* v. *Coignet*, 24 R. P. C. 229, C. A. affirmed; in H. L. *sub. nom. Hennebique* v. *Cowlin*, 26 R. P. C. 280, H. L.

Discovery that it was practicable to drive grooved rollers in an embossing machine differentially without tearing goods held not to be subject-matter. *Ralston* v. *Smith* (1865), 11 H. L. C. 223.

Appreciating how to obtain the full advantage of the use of a wheel for raising water by centrifugal force, the wheel being old for this purpose, is not sufficient to support a patent. *Tetley* v. *Easton* (1857), 26 L. J. (C. P.) 203.

The fact that the patentee of an early electrical machine did not see all its advantages held not to prevent it from anticipating a later invention. *King Brown* v. *Anglo-American Brush Corporation*, 9 R. P. C. 313, H. L.

Discovery that in purifying gas with lime, lime should be frequently changed. *Paterson* v. *Gas Light & Coke Coy.* (1875), 3 A. C. 239.

Result more important than means.

In judging of invention it may be broadly said that the result is more important than the means (*z*), and if a new machine is made which enables an important new result (*a*) to be obtained it may be patentable no matter how small the difference between it and what went before, if that difference is such that without it the new result could not be obtained (*b*), or is in other words, "the difference between failure and success" (*c*). Similarly a slight alteration or new direction in a process may lead to such an important change as to be subject-matter (*d*).

(*z*) *Day* v. *Davies*, 22 R. P. C. 34, 42. "Sometimes the greatest inventive skill is shown by the smallest alteration." *Electrolytic Plating Apparatus Coy.* v. *Evans*, 17 R. P. C., *per* WILLS, J., at p. 741.

(*a*) As to the necessary amount of improvement, see *Gramophone Coy., Ltd.* v. *Ruhl*, 27 R. P. C. 629, and 28 R. P. C. 20, C. A.

(*b*) *Hinks* v. *Safety Lighting Coy.* (1876), 4 Ch. D. 607; *Gammons* v. *Battersby*, *ubi infra*, *n.* (*d*); *Brown's Patent*, 25 R. P. C. 86, C. A. Of course the improvement must be due to the change, see *Arkwright's Patent* (1785), W. P. C. at p. 72; *Pow* v. *Taunton* (1845), 9 Jur. 1056.

(*c*) *Edison & Swan Coy.* v. *Holland*, 6 R. P. C. 243, 283.

(*d*) Among cases illustrating this point in which the patents have been upheld are the following:—

Patent for a machine for disinfecting fabrics, etc., by dry steam. The fabrics were put into an inner chamber into which steam was admitted, and steam was also let into the outer chamber at such a pressure that the steam in the inner chamber was kept dry. This was held good subject-matter though there had previously been a machine with similar chambers, but which could not have been used for the new process, *i.e.* working with dry steam, as the fastenings were too weak to hold steam at the necessary pressure. *Lyon* v. *Goddard*, 11 R. P. C. 113, H. L. *Cf. Lake & Elliot* v. *Rotax Motor Accessories, Ltd.*, 28 R. P. C. 532, C. A.

Improvements in carpet cleaning machines in which by substitution of pump and filter for fans, etc., and use of narrow slit, a machine was for the first time produced capable *inter alia* of extracting dust from interior of carpets or from underneath them. *British Vacuum Cleaner Coy., Ltd.* v. *Suctions Cleaners Ltd.*, 21 R. P. C. 303; *British Vacuum Cleaner Coy., Ltd.*, v. *London & South Western Railway Coy.*, 29 R. P. C., H. L. 309.

Patent for a brickmaking machine, which was only distinguished from a former machine by small changes in the cutting mechanism and by the provision of means for removing the bricks automatically, but these changes made the machine cheaper instead of dearer than hand labour. *Murray* v. *Clayton* (1872), 7 Ch. App. 570.

Use of gas for flaming lace. Other flames had been used but there was a difficulty in getting them to pass through lace and the change revolutionised the industry. *Hall's Patent* (1817), W. P. C. 97.

Improvements in sewing machine for boots in which the looper was made to bring thread up to notch of needle instead of as formerly presenting it to point of needle, thus avoiding danger of breakage. *English & American Machine Coy., Ltd.* v. *Union Boot & Shoe Machines Coy.*, 11 R. P. C. 367, C. A.

Improvement in pulp strainers in which the oscillating plate was arranged to move about the same axis as the crank working it, so avoiding vibration. *White* v. *Bertrams, Ltd.*, 14 R. P. C. 735, I. H.

Patent for an improved latch by which a door was opened by pushing or pulling a handle. A prior specification for a similar latch had shown apparatus which would not permit the door to be opened and shut on the same side. *Kaye* v. *Chubb*, 5 R. P. C. 641, 652, H. L.

Improvements in oil engines in which small variations in the air and oil inlets enabled heavy oils to be used

Where a small change has been made in a known article or process to "effect a small result of trifling or dubious utility, where only light oils could be used before. *Day* v. *Davies*, 22 R. P. C. 34.

Variations which are not patentable.

Process for making rims for rubber tyres, by first rolling them with a "W" section and then flattening the "W" and so causing sides to come together so as to give undercut groove. *Held*, not anticipated by process for rolling plates in which a section with inclined sides and concave base was produced, since this would have been useless for object desired. *Shrewsbury & Talbot* v. *Sterckx*, 13 R. P. C. 44, C. A.

Use of a spring in place of a fixed seating for the arms of a lever of a steam trap. This prevented straining should the temperature rise too high, and also allowed the trap to be opened by hand to give a free blow through. *Geipel* v. *Mayor of Manchester*, 21 R. P. C. 41.

Use of chains instead of weights for applying pressure in manufacture of ensilage, thus getting a greatly improved result. *Reynolds* v. *Amos*, 3 R. P. C. 215.

Improved process for making tin-coated lead for use in capsules by first separately laminating the tin and lead and then laying the tin on the lead and incorporating by rolling. There had been a previous patent for making tin-coated lead, but it had not prescribed the preliminary lamination or smooth application of the surfaces, and the new product was a great improvement. *Betts* v. *Menzies* (1862), 10 H. L. C. 117; *Betts* v. *Neilson* (1866), 3 Ch. App. 429.

Improvements in machine for sewing bindings on hats by which a slight rearrangement of the gauges enabled the binding for the first time to be sewn along one edge and then "snapped" on. *Gammons* v. *Battersby*, 21 R. P. C. 322, C. A.

Clamp for insertion at the corners of cardboard boxes made of a strip of metal with small claws, which differed from former clamps in that claws remained in cardboard and did not project inside. *Actien Gesellschaft für Cartonnägen Industrie* v. *Schroeder*, 13 R. P. C. 466.

Variation in method of putting adjustable weights on plough wheels, the effect of which was to save use of a horse a day. *International Harvester Coy. of America* v. *Peacock*, 25 R. P. C. 765, P. C.

Increasing depth of water lute in machine for testing drains so that the machine could also be used for a pressure test. *Macdonald* v. *Fraser*, 11 R. P. C. 169, I. H.

Applying pressure to circumference instead of centre of buttons, thereby enabling silk-covered buttons to be made by pressure without spoiling the silk. *Elliot* v. *Aston* (1840), W. P. C. 222.

Arranging gauge at mouth of beer tap so that air could not get behind it, and thus preventing dripping. *Mathews* v. *Pamenter*, 13 R. P. C. 514.

Clothing fancy rollers with wire strips placed far apart instead of close together as formerly, and thus getting better air current. *Sykes* v. *Howarth* (1879), 12 Ch. D. 826.

Use of a carbonised filament instead of a carbon rod in incandescent lamps, thus getting a greatly improved result. *Edison* v. *Woodhouse* (first action), 4 R. P. C. 79, C. A.

Use of zinc powder in boiler to prevent corrosion. Zinc bars had previously been used, but the increased surface greatly improved action. *Innes* v. *Short*, 15 R. P. C. 449.

Apparatus for electro-plating small articles consisting of a perforated rotating drum whose shaft formed the cathodes. The rotation of drum insured constant rubbing. A former specification had suggested a rotary drum with a spiral contact wire, but patented apparatus gave greatly improved results. *Electrolytic Plating Apparatus Coy.* v. *Evans*, 17 R. P. C. 733; *Electrolytic Plating Apparatus Coy.* v. *Holland*, 18 R. P. C. 521.

Process for assisting evaporation of sugar by bringing in the air by a horizontal pipe near surface and forcing it down through a series of vertical pipes. A prior specification had suggested bringing air in by a perforated pipe near the bottom, but such process had no practical utility. *Hullet* v. *Hague* (1831), 9 L. J. (o. s.) K. B. 242.

Improvements in otter boards by attaching ropes to a bracket arranged centrally and rising above plane of board and so enabling boards to be used with the ordinary trawl net. *Scott* v. *Hamling & Coy., Ltd.*, 14

or where the alteration is not essential to the result obtained,

R. P. C. 123; *Scott* v. *Hull Steam Coy.*, 14 R. P. C. 143.

Patent for making nuts by cold pressing, by the use of a die having a recess with a flaring opening so that the tool entered and yet the blank was properly formed. In former practice there was danger, if the size of the recess was exactly that of the punching tool, that the latter might be injured if it got out of truth, and if the recess was larger the blank was not properly formed. *Fellows* v. *Brooks*, 27 R. P. C. 89.

Making gas pipe by passing bent iron through hole in plate without use of mandril. There had been a similar process with mandril, and tubes had been made by hammering similarly bent iron on anvil or by propelling similarly bent iron through grooved rollers; *Russell* v. *Cowley* (1835), W. P. C. 457; *Russell* v. *Ledsam* (1847), 1 H. L. C. 687; *Russell* v. *Crichton*, 2 S. 1. 893.

Patent for improvements in protecting covers for carbons for arc lamps. It was known that such covers should have a tight fit at entrance, but patentee also made the space enclosed between them and the carbon small, so as to diminish the amount of gas and the risk of explosion. *Jandus Arc Lamp Coy., Ltd.* v. *Arc Lamp Coy.*, 22 R. P. C. 277.

Patent for a lamp in which the column of oil for feeding the reservoir was balanced against the pressure of air in a trap. A former specification has shown a lamp, on the same principle, but which was liable to flooding on changes of temperature owing to the burner chamber being too low. *Defries* v. *Sherwood*, 14 R. P. C. 313.

Fixing plain or crushed glass or sand on to the back of glass, which was to be used for facing bricks, by means of a flux melting below the melting point of the glass. Sand, etc., had been previously attached to glass in plastic state, but the heating necessary for the earlier process had been liable to injure the appearance of the glass. *National Opalite Coy., Ltd.* v. *Ceralite Syndicate, Ltd.*, 13 R. P. C. 649.

Improved refrigerating machine intended to keep the air at a moderate temperature, which had inclined pipe with a stop cock for letting off moisture to prevent formation of snow. Earlier machine had no cock, and snow was formed causing intense cold. Cocks were known in refrigerating machines, but not for the same purpose. *Haslam* v. *Hall*, 5 R. P. C. 1.

Patent for a razor stropping machine. The razor was supported on a rocker round which strop passed. The friction of the strop moving in either direction so turned rocker and razor that the latter was held in the proper position for stropping. In an earlier device razor holder was rotated not by friction of strop, but by springs communicating with a lever supporting two pulleys round which strop passed. *Beston* v. *Watts*, 25 R. P. C. 10, C. A.

In centrifugal machines two types of bearing were known, one a single bearing with a cylindrical rubber washer, one with upper and lower bearing each with flat conical washers. *Held*, that patent for a single bearing with a steep conical washer was good in view of improved result. *Watson, Laidlaw & Coy.* v. *Potts, Cassels & Williamson*, 27 R. P. C. 541, I. H. See also same case 28 R. P. C. 565, H. L.

Patent for a cradle for draw bars in railway carriages in which excessive strains on rivets occurring in earlier suggestions for apparatus were avoided. *Steel Railway Journal Box Coy., Ltd.* v. *Hurst, Nelson & Coy., Ltd.*, 26 R. P. C. 493, C. A.

Improvements in covers for preserves having sloping sides which lay tangentially on a rubber ring surrounding the neck, in order that the slight pressure due to the vacuum inside the jars might be sufficient, owing to the broad contact surface between ring and tangential sides of cover, to give an airtight closure, while at the same time it was easy to hold cover by a spring during boiling process. There had been many other covers approaching this, but none so advantageous. *Automatic Air Tight Cover, Ltd.* v. *Stockford*, 19 R. P. C. 453.

Improvements in special type of water closets by varying the position of the dipper pan and so getting a much more effective flush. The previous form was not practically successful. *Duckett & Son, Ltd.* v. *Whitehead*, 12 R. P. C. 376, C. A.

Improvements in cigar cutters by

the new variation is in general not patentable (*e*). In many of these cases the alteration involves the sacrifice of advantages in some respects in order to gain additional advantages in other respects, so as to suit the article for some particular use. The Courts have looked on such adaptations as not being a "new manufacture," but as variations properly forming part of a workman's business, and have refused to restrict the general right to use them. Another view of such cases is that the advantage gained is either only to meet some special need which may have recently arisen or is for other reasons so small, that

addition of an outer tube which rendered it easier to hold and work. *Hardmuth* v. *Baker*, 22 R. P. C. 66, C. A.

Fixing the recording and reproducing points of a phonograph on the same diaphragm, thereby avoiding need of change. *Edison Bell Phonograph Corporation* v. *Smith*, 11 R. P. C. 389, C. A.

In centrifugal machines two types of bearing were known, one a single bearing with a cylindrical rubber washer, one with upper and lower bearing each with flat conical washers. *Held*, that patent for a single bearing with a steep conical washer was good in view of improved result. *Watson Laidlaw & Co.* v. *Potts, Cassels & Williamson*, 27 R. P. C. 541, I. H. See also same case 28 R. P. C. 565, H. L.

See also *Marine Torch Coy.* v. *Holmes*, 29 R. P. C. 686.

The following are cases of chemical processes :—

Process for getting cholesterine from wool fat by treating with an alkali, separating in centrifugal machine, and then purifying with water. A similar process had been described omitting the use of the alkali, but a pure article could not be obtained without using this to saponify the fatty acids. *Benno Jaffe* v. *Richardson*, 11 R. P. C. 261, C. A.

Patent for making threads from viscose by forcing it into a bath of sulphuric acid and sodium sulphate having an acid concentration of 20 per cent., and a sodium sulphate concentration of 23 per cent. A prior specification had suggested for same purpose the use of a bath having an acid concentration of 9 per cent. The new result was much better and the patentee was able to use "new" viscose while former "aged" viscose had to be used. *Max Muller's Patent*, 24 R. P. C. 469.

In a certain known chemical process the patentee gave two new directions: (1) to use an excess of acid; (2) to keep the temperature below 5° Cent. This increased the useful yield from 25 per cent. to 60 per cent. *Saccharin Corporation Ltd.* v. *Chemicals and Drugs Coy.*, 17 R. P. C. 28.

Variation in chemical process enabling pure substance to be got in place of substance with at least 18 per cent. of impurity. *Badische* v. *Société des Usines du Rhone*, 14 R. P. C. 873.

Patent for mixing maltine with dough and keeping it at 150° Cent. for three hours, not anticipated by mixing malt with dough and baking straight away, which stopped action of malt. *Montgomery* v. *Paterson*, 11 R. P. C. 633, I. H.

The following cases may also be consulted on this point, the patents being upheld in view of the improved result :—

Making screw with nick deeper in middle than at sides. *Frearson* v. *Loe* (1878), 9 Ch. D. 48.

Improvements in method of mounting engine in road vehicles. *Foden* v. *Wallis*, 25 R. P. C. 501.

Substituting a pin and hole internal feed for a ratchet feed. *Birch* v. *Harrap*, 13 R. P. C. 615, C. A.

Small alteration in lamps. *Hinks* v. *Safety Lighting Coy.* (1876), 4 Ch. D. 607. See also *Perry* v. *Société des Lunetiers*, 13 R. P. C. 664.

(*e*) *Waterhouse's Patent*, 23 R. P. C., *per* ROMER, L.J., at p. 477. See also *Dangerfield* v. *Jones* (1865), 13 L. T. 142; *R.* v. *Arkwright* (1785), W. P. C. 64; *Pow* v. *Taunton* (1845), 9 Jur. 1056.

manufacturers may well have been content to employ other forms, and that therefore the novelty of the result is no proof in itself of invention (*f*).

Patents for printed matter, etc.

Although it can hardly be said to be a rule of law that there can be no patentable subject-matter in printing or drawing

(*f*) The following are cases of this kind in which small variations have been held not to be subject-matter:—

Braiding machine made so as to be capable of rotary motion where the same results could be got from a former machine, though in fact this was only capable of oscillatory motion. *Nadel* v. *Martin*, 22 R. P. C. 41, H. L.

Safety device for carding machines in which the action of throwing belt on to loose pulley opened the machine, instead of as formerly releasing detent and permitting it to be opened. *Witham* v. *Catlow*, 25 R. P. C. 788.

Variation in battery in which one of the layers was "semi-solid." In anticipation chiefly relied upon this layer was "phlegmy." On evidence being given that this difference produced no result the patent was held bad although it had previously been upheld. *Patent Exploitation, Ltd.* v. *American Novelty Coy.*, 22 R. P. C. 317, H. L. *Cf. Patent Exploitation, Ltd.* v. *Siemens*, p. 46, *n.* (*n*).

Making old fitting for connecting pump to tyre with a collar so that parts could not come apart. Also arranging so that all screws turned same way. *Atkinson* v. *Britton*, 27 R. P. C. 469, C. A.

Variation in gear changing device by inverting teeth and notches and sliding a shaft instead of moving an arc on an axle. *Stroud* v. *Humber, Ltd.*, 24 R. P. C. 141.

Variation in lock by which detent, instead of projecting and being actuated by door jamb, was made flush and worked by special projecting part. *Tucker* v. *Kaye*, 8 R. P. C. 230, C. A.

Variation in stretcher for wire mattress so that it was arranged above instead of within the bed frame. *Rowcliffe* v. *Longford Wire Coy.*, 4 R. P. C. 281.

Pressing together lead-holding jaws in a pencil case by movement of outer sheath instead of movement of ring. *Lawrence* v. *Perry*, 2 R. P. C. 179.

Substitution of lever worked by thumb for simple thumb piece. *Consolidated Pneumatic Tool Coy., Ltd.* v. *Clark*, 24 R. P. C. 593, C. A.

Variation in shape of railway rug so that there was platform under feet and it could be used by motor driver. *Arnot* v. *Dunlop Pneumatic Tyre Coy., Ltd.*, 25 R. P. C. 309, H. L.

Small variation in the shape of unions for pipes. *Waterhouse's Patent*, 23 R. P. C. 471, C. A.

Variation in section of solid rubber tyre. *Sirdar Rubber Coy.* v. *Wallington*, 24 R. P. C. 539, H. L.

Variation in shape of channel in neck of lemonade bottle. *Beavis* v. *Rylands Glass Coy., Ltd.*, 17 R. P. C. 704, C. A.

Variation in number of teeth for fasteners for hats. *Savage* v. *Harris*, 13 R. P. C. 364, C. A.

Omission of nut in device for fixing tension pulley for blind cords. *Dobbs* v. *Penn* (1849), 3 Ex. 427.

Variation in position of wire in lamp used to conduct heat to and liquify the solid paraffin. *Cera Light Coy.* v. *Dobbie*, 11 R. P. C. 10.

Addition to bootmaking machine of a side guard to the shoot for nails. *British United Shoe Machinery Coy., Ltd.* v. *Claughton*, 24 R. P. C. 33, C. A.

Substitution of hinged for sliding plates on top of stove. *Fletcher* v. *Arden*, 5 R. P. C. 46.

Variation of spacing of holes in boots, and use of hooks on one side and holes on the other. *Hill* v. *Thomas*, 24 R. P. C. 415, C. A.

Variation in shape of hoe. *Sudbury* v. *Lee*, 11 R. P. C. 58.

Putting a glass window into a milk receptacle. *Murchland* v. *Nicholson*, 10 R. P. C. 417, O. H.

Substitution of chlorine gas for chlorine water in purifying cotton seed oil foots. *Wilson* v. *Union Oil Mills*, 9 R. P. C. 57.

Changes in temperature and ingredients in process for baking producing no change of importance in result. *Haddan's Patent*, 2 R. P. C. 218.

See also *Montgomery* v. *Paterson*, 11 R. P. C. 633, I. H., where a similar

on articles signs that facilitate their use such patents have in fact not been upheld by the Courts (*g*).

Patents for improvements.

It has been held from very early times that an improvement in an article or process may form subject-matter for letters patent (*h*), and in fact nearly all patents are for improvements. It is no objection that the former process is the subject of an existing (or expired) patent, or that the improved process could only be worked by license under a former patent (*i*). Formerly there were many decisions turning on the point of whether the improvement alone or the whole machine or process had been claimed, but these have been rendered unimportant since the true rule for the construction or combination claims was laid down in *Harrison* v. *Anderston Foundry Company* (*k*).

patent was held bad, but another for changes producing important results was held good, see p. 51.

(*g*) Patent for improved stencil paper having a scale along edge and a line to show where it was to be inserted into the duplicating machine, held bad. *Klaber's Patent*, 19 R. P. C. 174.

Patent for drain trap with supports for spirit level and a horizontal line drawn close to them to facilitate levelling, held bad. *Duckett & Son, Ltd.* v. *Sankey*, 16 R. P. C. 357. See also *Philpott* v. *Hanbury*, 2 R. P. C. 33; and *Johnson's Application*, p. 255, *n.* (*q*).

(*h*) *R.* v. *Arkwright* (1785), W. P. C. 64.

(*i*) *Crane* v. *Price* (1842), W. P. C. 377.

(*k*) (1876), 1 A. C. 574. See also chapter on CONSTRUCTION, p. 119.

CHAPTER III

PUBLIC KNOWLEDGE

Effect of prior publications.

ALTHOUGH all knowledge once it has been published within the realm becomes, whatever may have been the form of publication (*a*), part of the public knowledge, so that a monopoly for the precise matter published cannot afterwards be granted (*b*), yet the circumstances and extent of the publication are of great importance when the subject-matter of a later patent has to be considered. The question here is, Has the patentee made a real addition to public knowledge, or is what he has done a mere development of pre-existing knowledge such as a competent craftsman might be expected to make? It would be absurd to assume for this test that such a competent craftsman should have present all matters in his mind which were within the realm of public knowledge (*c*), and it has therefore always been recognised that a patentee may make a real addition to public knowledge, amounting to invention, by the useful assemblage of isolated matters already known (*d*).

In judging of the effect of any prior public knowledge in limiting the field of invention it is necessary to consider whether

(*a*) There are now two statutory exceptions: see pp. 65, 66.

(*b*) A good example of such anticipation will be found in *Mouchel* v. *Coignet*, 23 R. P. C. 649, C. A., affirmed in H. L. under title of *Hennebique* v. *Cowlin*, 26 R. P. C. 280.

(*c*) *British Westinghouse Coy.* v. *Braulik*, 27 R. P. C., *per* FLETCHER MOULTON, L.J., at p. 224. But see *King Brown & Coy.* v. *Anglo-American Brush Corporation*, 9 R. P. C., *per* Lord WATSON, at p. 320.

(*d*) "We are of opinion that if it requires this mosaic of extracts from annals and treatises spread over a series of years to prove the defendant's contention, that contention stands thereby self-condemned." *Von Heyden* v. *Neudstadt* (1880), 50 L. J. (CH.) 128, C. A.; *cf. Huddart* v. *Grimshaw* (1803), Davies 265, 278; *Lancashire Explosives Coy.* v. *Roburite Explosives Coy.*, 12 R. P. C. 470, 483, C. A.; *Fawcett* v. *Homan*, 13 R. P. C. 398, 405, 410, C. A.

"It is not a mosaic if (in the later specification) there is a reference to an earlier specification." *Wilson* v. *Wilson Brothers Bobbin Coy., Ltd.*, 28 R. P. C., *per* FLETCHER MOULTON, L.J., at p. 739, C. A.

Of course it is quite immaterial how the patentee has in fact arrived at his invention.

the publication relied on gave such knowledge clearly, so that an intelligent man would realise its full effect (*e*). Again, if the medium of publication was a mere suggestion, such as a statement in a specification or in some little read learned publication, the effect is far less than if the same matter had been generally and practically used and applied (*f*).

Knowledge of equivalents.

The fact that the apparatus or process relied on against the patented invention has been practically employed, and that the scientific laws governing its operation are well known, is most important from this point of view, since it may render new applications or variations obvious which could not otherwise be so. The best examples of this occur in the case of what are called "mechanical equivalents." Knowledge has been accumulated from the earliest times as to the action of certain mechanical devices and the modifications of them which are to be used for certain purposes, and this knowledge is so general that it has become burnt in to the human mind, and is judicially recognised to be so. Thus, for example, in some operation the use of a lever is described in order to increase the power. This description of the use of a lever would at once convey, at any rate to the mind of a skilled man, that a wheel and axle can be used if the power is required to be transmitted to a distance, and that a bell crank lever or a screw may be used if the direction of the power is required to be changed, and the specification of the wheel and axle, bell crank lever or screw for such purpose would in itself be no addition to public knowledge, and consequently no invention, though of course there might be invention in seeing that in the particular problem the power should be applied at a distance or in another direction and in telling the world to do this.

The association of ideas conveyed by the mention of such a piece of knowledge has been termed its "penumbra," and the ascertainment of the extent of this penumbra is all-important in determining the effect of any given publication on the subject-matter of the patent under investigation.

The "mechanical equivalents" are most often spoken of

(*e*) The evidence of the writer as to what he meant would seem clearly irrelevant: *cf. King Brown & Coy.* v. *Anglo-American Brush Corporation*, 9 R. P. C., at p. 315, H. L.

(*f*) See p. 58, *n.* (*q*). *Cf.* also *Bowden's Patent*, 22 R. P. C. at p. 56; *Thomson* v. *Batty*, 6 R. P. C. at p. 98. As to the effect of publication in a provisional specification, see p. 65, *n.* (*x*).

and are the best known; but the same rule applies in other sciences (*g*).

Distinction between common and public knowledge.

There is, therefore, this important distinction between matters of mere public knowledge and matters of common general knowledge such as this knowledge as to mechanical equivalents. While it is in general not legitimate to assume that the craftsman would carry all the various matters of public knowledge in his mind simultaneously, and it is therefore not proper to combine items from different publications so as to destroy the subject-matter of a later patent, matters of common general knowledge are assumed to be always present to his mind, and therefore such matters may be combined with other matters of public knowledge. Thus a reader of any publication may be assumed to interpret or even extend it in view of the common general knowledge of the trade (*h*). While matters of public knowledge can be proved by any of the media hereafter referred to (*i*), matters of common general knowledge must be proved by the evidence of witnesses cognisant of the state of knowledge, or by reference to generally accepted and widely read text-books, etc. Such documents as specifications are not in themselves evidence on this point (*k*).

Effect of publication on skilled reader.

This principle of interpreting a written document as it would appeal to the mind of the skilled reader is carried further so that a statement will not be interpreted in such a way as would make the writer say something which is obviously untrue (*l*), or as to which he could clearly have no knowledge (*m*),

(*g*) *E.g.* Chemistry. Vaughan Williams, L.J.: "The doctrine (of equivalents) does apply in cases where, having regard to the subject-matter, it can be truly asserted that one or two or more chemical substances are well known as producing the same effect on the same subject-matter": see also p. 145. *Andrew's Patent*, 24 R. P. C., at p. 366; and as to electricity, *Gaulard and Gibbs' Patent*, 7 R. P. C. 367, 382, H. L.

(*h*) See in regard to this point p. 123 and p. 132. See also *Gaulard and Gibbs' Patent*, 7 R. P. C. 367, 382, H. L.; *Donnersmarckhutte, etc.* v. *Electrical Construction Coy., Ltd.*, 27 R. P. C. 774, 779, C. A.; *Marconi* v. *British Radio-Telegraph and Telephone Coy.*, 28 R. P. C. 181, 205.

(*i*) See p. 63.

(*k*) *Saccharin Corporation, Ltd.* v. *Chemicals and Drugs Coy., Ltd.*, 17 R. P. C. 28.

The full list of cases on this point will be found in the chapter on LICENSES, p. 246, *n.* (*q*).

But see SUFFICIENCY, p. 94, *n.* (*x*), for a possible exception.

(*l*) *Cf.* SUFFICIENCY, p. 93, *n.* (*s*).

(*m*) Thus where a specification spoke of "organic substances" and gave a number of examples all of which were products of animal or vegetable life, a statement that all "organic products" gave dyes when treated with sulphur, was interpreted as referring only to organic products of the class mentioned and as not extending to the whole series of coal-tar products, both because such interpretation was more consistent with the rest of the specification, and

nor must such statement be interpreted apart from the object and meaning of the specification as a whole. The important point is for the Court to ascertain the effect the alleged publication would have upon a competent man (*o*).

Effect of form of publication.

In estimating the effect of any publication in advancing general knowledge and so anticipating later inventions the Courts consider carefully whether or not the circumstances of such publication were such as would make it likely to affect the process of the particular manufacture, or in other words to attract the attention of practical men (*p*). It is not only that a mere "paper anticipation" consisting of a suggestion to make, say, a particular machine, carries much less weight, and is more critically examined than an actual machine (*q*), but the utility or lack of utility of what has been proposed or done is most important, since a machine or process that does not work practically or is less efficient than previously existing methods, or a publication which contains statements mixed with matters that are false, not only may fail to lead in the direction of a practical development, but may actually lead

also because a skilled reader would reject the other interpretation as involving a statement obviously beyond the writer's knowledge. *Vidal Dyes Syndicate, Ltd.* v. *Levinstein*, 29 R. P. C. 262, C. A.

Where from the specification as a whole it seems that the writer was ignorant of certain apparatus, statements in it will not be interpreted as involving the use of such apparatus. *Marconi* v. *British Radio-Telegraph Coy., Ltd.*, 28 R. P. C. 181, 209.

(*o*) *British Westinghouse Coy.* v. *Braulik*, 27 R. P. C. 209, 224. See chapter on CONSTRUCTION.

(*p*) "As for annals, in particular, the annual register of science, one knows that in every country every year thousands of facts or supposed facts find their way into them coming like shadows so departing without leaving any permanent traces behind them." *Von Heyden* v. *Neudstadt* (1880), 50 L. J. (CH.) at p. 126, C. A.

(*q*) "I think it is very material in considering whether there is any ingenuity or invention in applying an article to a new subject to consider whether the article is only described in print or whether it is actually to be seen or handled, because when a thing is to be seen—when it exists and is to be handled—it may require a very much less degree of invention to make it into a new article than if it is only seen in description or in drawings." *American Braided Wire Coy.* v. *Thomson*, 5 R. P. C., *per* COTTON, L.J., at p. 123.

"When anticipation is simply by a publication, not by a machine put in use, that publication should be examined somewhat critically." *Ellington* v. *Clark*, 5 R. P. C. 141, *per* KAY, L.J. : *cf.* also *Stoner* v. *Todd* (1876), 4 Ch. D. 58.

In *Otto* v. *Linford* (1881), 46 L. T. 35, the Court of Appeal held that the later invention must be described in the earlier publication that is held to anticipate it. It is not sufficient that if a machine had been made according to such description, it would have produced a result, not to be gathered from the description, which would have disclosed such invention. See also *Jandus Arc Lamp Coy.* v. *Arc Lamp Coy.*, 22 R. P. C. 296; *Patent Exploitation, Ltd.* v. *Siemens Brothers, Ltd.*, 20 R. P. C. 242, C. A.; *Evans* v. *Hoskins*, 24 R. P. C. 517, 526, C. A.; *Vorwerk* v. *Evans*, 7 R. P. C. 172.

away from it by reason of the failure of the machine or of the methods advocated by the publication. In general it may be said that a useless machine or process, in the sense of one that did no useful work, would not be able to destroy a later useful invention, and that any distinction would be sufficient to prevent anticipation provided that the different part was an essential part of the later machine, so that the claim did not cover the original form (*r*).

(*r*) "The publication was not likely to lead a manufacturer or practical chemist to think of doing what is described in the specification. It would, on the contrary, effectually discourage any attempt in that direction." *Von Heyden* v. *Neudstadt* (1880), 50 L. J. (CH.) at p. 126.

"The first patentee so far from showing the way to success left his wrecked barque as a warning to others who might be thinking of pursuing the same channel." *Andrews' Patent*, 24 R. P. C., *per* FARWELL, L.J., at p. 371. See also *Hill* v. *Evans* (1862), 31 L. J. (CH.) 457, 465; *Murray* v. *Clayton* (1872), 7 Ch. App. 570; see *contra Beavis* v. *Rylands*, 17 R. P. C. 704, 711, C. A.; *Thomson* v. *Macdonald*, 8 R. P. C. 5, where it seems to be suggested that carelessness does not prevent a publication affecting subject-matter; *cf.* also *Singer* v. *Rudge*, 11 R. P. C. 463.

"Now I am not aware of any principle or authority upon which the exhibition of a useless machine, which turns out a failure, can be held to affect the right of a patentee who has made a successful machine, although there may be a degree of similarity between some of the details of the two machines." *Murray* v. *Clayton* (1872), 7 Ch. App., *per* JAMES, L.J., at p. 581.

In this case, in which the patent was for a brickmaking machine, the Court held that where the alleged anticipation, although it would make bricks, involved more labour than the process of making them by hand, it must be treated as useless and held it was therefore not an anticipation. They also held that the fact that the defendant had tried the alleged anticipating machine and abandoned it for the plaintiff's was strong evidence that it was not an anticipation. On the last point, *cf. Deeley's Patent*, 13 R. P. C. 581, H. L., and *Siddell* v. *Vickers*, 7 R. P. C. 292, H. L.

BRETT, J., directed the jury as to alleged anticipation by a machine that the question was whether such machine would do the work more or less badly: "Because in my opinion if it would not, I do not say perfectly, but if it would not do the work ordered of it, it was not an invention at all or a machine in a business sense. . . . I put the words 'more or less badly' because I do not think that if the only defect in the machine was some defect in the levers which any workman could find out at once, if it would make a nut, though badly, that would not prevent its being a machine." The jury having found for the plaintiff, a new trial was refused: *Barlow* v. *Baylis* (1875), Griff. at p. 46.

"Where defendant states a prior anticipation ten years ago and cannot prove that it has been of the slightest utility at all, it certainly makes a judge look carefully into the anticipation to see whether it is in reality an anticipation of the patent which is of utility." *Duckett* v. *Whitehead*, 12 R. P. C., *per* SMITH, L.J., at p. 382.

In *Minter* v. *Mower* (1835), W. P. C. 123, the Court were of opinion that had the claim been properly defined the patent would not have been anticipated by a chair which, though it embodied this principle of the plaintiff's invention, had so many useless and additional parts that the principle would not be appreciated from seeing the chair.

So, too, a prior specification, which was held in one case not to anticipate because unworkable, was held to anticipate in a later case on proof that it would work. *British Motor Traction Coy.* v. *Sherrin*, 18 R. P. C. 265; *Same* v. *Friswell*, 18 R. P. C. 497.

A similar result occurred in *Shaw* v. *Jones*, 6 R. P. C. 328; *Same* v. *Day*, 11 R. P. C. 185.

Again the form of a paper publication is important, and where it merely forms part of a mass of ill-digested suggestions so that it would be likely to be rejected by any practical man little attention is paid to it unless it contains the actual matter of the later patent (*u*). It is in fact treated as adding nothing to public knowledge. These remarks apply with special force to publications of many years back which are liable to have passed into "the limbo of forgotten things" (*x*).

Anticipation by written document.

For a single publication to constitute an anticipation the "information as to the alleged invention given by the prior publication, must be for the purposes of practical utility equal to that given by the subsequent patent" (*y*). Whatever, therefore, is essential to the invention must be contained in the prior publication, and if specific details are necessary for the practical working and real utility of the alleged invention they must be found in substance in such publication (*z*). But this does not mean that the same rules of criticism are to be applied to a publication put forward as an anticipation, as would be applied to determine the question of the sufficiency of a

In *Hallett* v. *Hague* (1831), 9 L. J. (O. S.) (K. B.) 283, TENTERDEN, C.J., put the question to the jury whether the alleged anticipation was of any practical utility. See also *Andrews' Patent*, 24 R. P. C., *per* FARWELL, L.J., at p. 271, C. A.; *Edison and Swan Coy.* v. *Woodhouse* (1st action), 4 R. P. C. 98; *Heidemann* v. *Smokeless Powder Coy.*, 15 R. P. C. 320; *Steel Railway Journal Box Coy., Ltd.* v. *Hurst Nelson & Coy., Ltd.*, 26 R. P. C. 493, O. H.

Prior publications may also lead away by denouncing the idea as impracticable; *cf. British Liquid Air Coy.* v. *British Oxygen Coy.*, 25 R. P. C. 601, C. A., or by selecting methods or substances less convenient or more expensive than those chosen by the patentee and so suggesting that the simpler or cheaper ones will not do; *cf. Osram Lamp Works* v. *Electric Lamp Coy.*, 29 R. P. C. 423; *Unwin* v. *Heath* (1855), 5 H. L. C. 505, 543.

Flour Oxidising Coy. v. *Carr*, 25 R. P. C. 428, 454.

(*u*) *Incandescent Gas Light Coy.* v. *De Mare Incandescent Gas Light System*, 13 R. P. C. 300, 323; *Betts* v. *Menzies* (1862), 10 H. L. C. 117, 134; *Murray* v. *Clayton*, *supra*; *Molassine* v. *Townsend*, 23 R. P. C. 27; *cf.* also *Bowden's Patent*, 22 R. P. C. at p. 56.

But a mere mistake in theory does not necessarily prevent a prior publication being an anticipation. *Andrews' Patent*, 24 R. P. C., *per* VAUGHAN WILLIAMS, L.J., at p. 356. See also *Thomson* v. *Macdonald*, 8 R. P. C. 5.

(*x*) *Pirrie* v. *York Street Flax Spinning Coy.*, 11 R. P. C., *per* FITZGERALD, L.J., at p. 445, C. A. Ir.; *Incandescent Gas Lighting Coy.* v. *De Mare Incandescent Gas Light System*, *supra*.

(*y*) *Hill* v. *Evans* (1862), 31 L. J. (CH.) at p. 463.

(*z*) *Hill* v. *Evans*, *ubi supra*. See also *Betts* v. *Neilson* (1871), 3 Ch. App. 429, 457; *Muntz* v. *Foster* (1844), 2 W. P. C. 93; *Von Heyden* v. *Neustadt* (1881), 50 L. J. (CH.) 126, 128, C. A.; *Edison and Swan Coy.* v. *Woodhouse* (2nd action), 4 R. P. C. 99, 106; *Bray* v. *Gardner*, 4 R. P. C. 400; *Haslam* v. *Hall*, 5 R. P. C. 1; *Cassel Gold Extracting Coy.* v. *Cyanide Gold Recovery Syndicate*, 12 R. P. C. 232, 254, C. A.; *Hookham* v. *Johnson*, 14 R. P. C. 562; *Evans* v. *Hoskins*, 24 R. P. C. 517, 526, C. A.

specification. In the latter case the criterion is whether the description is sufficient to enable the ordinary workman of average competence to carry out the invention, while on the question of publication it would be sufficient if the earlier document gave sufficient information to enable a skilful master to give instructions to a workman to carry out the invention (*a*), but it would probably not be sufficient to say that the earlier publication would have suggested the later idea to the mind of a Lord Kelvin or an Edison who "could invent for himself." In certain cases a drawing alone may constitute an anticipation (*b*), or possibly even a mere title (*c*), but only if this makes the whole invention clear (*d*). If, however, the publication relied on is such that the competent reader would see what had to be done, it may not matter that certain parts are omitted which he would know he must add (*e*).

The earlier publication must give the knowledge required, it is not sufficient that it merely gives the means of attaining the knowledge (*f*), or that when the later invention is known it can be seen that it could have been arrived at by the means shown in the earlier specifications (*g*). Nor where a patentee has first shown how to do a thing do the Courts look favourably on suggestions that by modification of former machines,

(*a*) *King Brown* v. *Anglo-American Brush Corporation*, 9 R. P. C. 313, 320, H. L.; *Van Berkel* v. *Simpson*, 23 R. P. C. 257, 258, O. H.; *Young* v. *Rosenthal*, 1 R. P. C. 29; *Philpott* v. *Hanbury*, 2 R. P. C. 33, 43; *Thomson* v. *Batty*, 6 R. P. C. 84, 98; *Moser* v. *Marsden*, 13 R. P. C. 24, 30, H. L.

In *Plimpton* v. *Spiller* (1877), 6 Ch. D. 412, JESSEL, M.R., adopted the test of whether the directions were sufficient for an intelligent workman. A similar view was taken in *Rucker* v. *London Electric Supply Corporation*, 17 R. P. C. 279, 293.

(*b*) *Electric Construction Coy.* v. *Imperial Tramway Coy.*, 17 R. P. C. 537, 550, C. A.; *Herrburger Schwander et Cie* v. *Squire*, 6 R. P. C. 194, C. A.

(*c*) See *Thermos, Ltd.* v. *Isola, Ltd.*, 27 R. P. C. 388, 399; but see *contra*, *British Liquid Air Coy., Ltd.* v. *British Oxygen Coy., Ltd.*, 25 R. P. C. 610, C. A.; 26 R. P. C. 509, H. L.; and *Lewis's Patent*, 14 R. P. C. 24.

(*d*) In many cases, drawings with or without short descriptions have been held insufficient. See *Plimpton* v. *Spiller* (1877), 6 Ch. D. 412, C. A.; *Bray* v. *Gardner*, 4 R. P. C. 400.

In *Defries* v. *Sherwood*, 14 R. P. C. 313, where the alleged anticipation was a drawing of a lamp to scale and a lamp so made to scale would have been useless, the patent was upheld. In *Watson, Laidlaw & Coy., Ltd.* v. *Potts Cassel and Williamson*, 26 R. P. C. 349, I. H., it was held that a drawing of what seemed intended for a cylindrical bearing, but which, probably by a draftsman's error, had a slight inclination, was not an anticipation of a conical bearing.

(*e*) See *Muirhead* v. *Commercial Cable Coy.*, 12 R. P. C. 39, C. A.

(*f*) *Betts* v. *Wilmot* (1870), 6 Ch. App. 239; *Otto* v. *Linford* (1881), 46 L. T. 35, C. A.; *American Braided Wire Coy.* v. *Thomson*, 5 R. P. C. 113, 123, C. A.

(*g*) *Incandescent Gas Lighting Coy.* v. *De Mare Incandescent Gas Light System*, 13 R. P. C. 300, 323; *Bovill* v. *Goodier* (1865), L. R. 2 Eq. 198; *Bovill* v. *Crate* (1868), Griff. N. C. 45, 47.

never suggested at the time, the later invention could be achieved (*h*).

Reading publication in light of later knowledge.

The question of how far knowledge subsequent to the date of the alleged publication can be used to extend its effect is a very difficult one. Probably it may be said the common general knowledge up to the time of the application for the later patent may be applied to extend the scope of an anticipation to the same extent as the common general knowledge of an earlier date (*i*), but, as has been observed above, it is always a question whether the publication has that degree of clearness and certainty which would enable a competent man to see with certainty what details might be varied, on the general principles with which he was acquainted, without departing from the object sought, and it is always a pertinent criticism that this former publication, even with the advance of general knowledge, had not in fact led to the later result (*k*). Of course, the technical terms contained in the publication must be given the meaning which they had at the date of such publication (*l*). Also all knowledge, either general, or as to the meaning of the prior publication, acquired since the date of application for the later patent must be carefully excluded (*m*).

(*h*) Cases of this class are :—

Starting device for motors, which depended on the checking of the rate of flow of the gas, not anticipated by an igniting device depending on a similar principle, but which had no automatic closing valve and could not have been used as a starting device without the provision of a separate gas supply, which had never been suggested. *British Motor Syndicate* v. *Andrews*, 16 R. P. C. 577, 593.

An improved gig-mill in which rollers had a motion which was both independent and variable, was held not to be anticipated by an earlier mill in which the same effect could have been produced, had a part which was normally fixed, but was rotatable for cleaning purposes, been loosened and independently driven. *Moser* v. *Marsden*, 13 R. P. C. 24, H. L. See also *Watling* v. *Stevens*, 3 R. P. C. 42 ; *Incandescent Gas Lighting Coy.* v. *De Mare Incandescent System*, *supra* ; *Taylor* v. *Annand*, 17 R. P. C. 126, 136, C. A. ; *Gammons* v. *Battersby*, 21 R. P. C. 322, 332, C. A. ; *Gramophone Coy.* v. *Ulman*, 23 R. P. C. 752, C. A. ; *British Westinghouse Coy.* v. *Braulik*, 27 R. P. C. 209, 230, C. A. ; *Marconi* v. *British Radio-Telegraph Coy.*, 28 R. P. C. 181, and p. 97, *n.* (*g*).

In *Gramophone Coy. Ltd.*, v. *Ruhl*, 28 R. P. C. 20, the C. A. criticised comparisons of patented instruments with machines purporting to represent an earlier form, but obviously suggested by the later patent.

(*i*) *King, Brown & Coy.* v. *Anglo-American Brush Corporation*, 9 R. P. C. 313, 320, H. L. ; *Betts* v. *Wilmot* (1870), 6 Ch. App. 239 ; *Betts* v. *Neilson* (1871), 3 Ch. App. 429 ; *Marconi* v. *British Radio-Telegraph Coy.*, 28 R. P. C. 181, 205.

(*k*) *Cf. Dowling* v. *Billington*, 7 R. P. C. 191, 204, C. A. Ir. ; *Shrewsbury and Talbot* v. *Stercxs*, 13 R. P. C., *per* SMITH, L.J., at p. 53.

(*l*) *Betts* v. *Menzies* (1862), 31 L. J. (Q. B.) 233 H. L.

(*m*) *Lewis's Patent*, 14 R. P. C. 24 ; *Ehrlich* v. *Ihlee*, 5 R. P. C. 452, C. A. ; *Bray* v. *Gardner*, 4 R. P. C. 400, 406 ;

It is probably the sounder view that it is a question of fact whether even a printed publication describes the later invention, and would if the case were tried by a jury be a question for them (*n*).

Question of anticipation one of fact.

In pursuance of the doctrine that a useless machine or suggestion for a machine forms no addition to public knowledge, the Courts have held that what might have been considered as a clumsy infringement of a patent had it been produced after the date of the grant is not necessarily an anticipation, since it may not disclose the real invention (*o*).

A clumsy infringement might not anticipate.

Media of Publication

The publication, whether in a document or by user, which is relied on as anticipating a patent must be a publication within the Realm (*p*).

Publication must have been within realm.

One of the commonest methods of publication is by means of a printed document publicly exposed or circulated in this country (*q*). It would seem, on comparison with the authorities, that the publication must be such that the reasonable inference is that the matter has actually been read by and

Publication by printed document.

Vidal Dyes Syndicate v. *Levinstein*, 29 R. P. C. 277, C. A. See also *Unwin* v. *Heath* (1855), 5 H. L. C. 505, 523; and p. 123, *n.* (*u*).

(*n*) Lord WESTBURY held that it was for the Court to explain to the jury the meaning of the various specifications according to the meaning the jury may find attached to the technical terms, but it is then for the jury to say whether the inventions disclosed in such specifications are identical. The remarks of the Lord Chancellor in *Bush* v. *Fox* (1856), 5 H. L. C. 708, as to its being in the power of the Court to themselves decide on such identity were, in his opinion, merely obiter. *Hills* v. *Evans* (1862), 31 L. J. (CH.) 457. See also *Hills* v. *London Gas Coy.* (1860), 29 L. J. (EX.) 409, and *Betts* v. *Menzies*, *supra*.

GROVE, J., left it to the jury to decide whether a statement in a specification that the patent was for "seams run transversely across stays instead of vertically or obliquely" would indicate to a competent man that oblique seams could be used. *Young* v. *Rosenthal*, 1 R. P. C. 29.

In *Booth* v. *Kennard* (1856), 26 L. J. (EX.) 23, the Court entered judgment for defendant after a verdict for the plaintiff, holding that invention was identical with that described in a prior specification.

(*o*) This view was first suggested by WOOD, V.C., in *Daw* v. *Eley* (1865), 14 W. R. 126. It was approved in *Murray* v. *Clayton* (1872), 7 Ch. App. 570, C. A., and also in *Pneumatic Tyre Coy.* v. *East London Rubber Coy.*, 14 R. P. C. 77. See also *Hopkinson* v. *St. James's Electric Lighting Coy.*, 10 R. P. C. 46, 60, and *Watling* v. *Stevens*, 3 R. P. C. 51.

(*p*) *Rolls* v. *Isaacs* (1878), 19 Ch. D. 268; *Beard* v. *Egerton* (1846), 15 L. J. (C. P.) 270.

(*q*) It was recognised, certainly as early as Arkwright's case, that a description in a book, in that case a technical dictionary, anticipated a subsequent patent, and such is now generally recognised. The decision to the contrary in *Stead* v. *Anderson* (1841), W. P. C. 134, 157, cannot be regarded as of any authority. See also *Hill* v. *Thomson and Foreman* (1818), W. P. C. 235, 247.

become known to some member of the public, and it is not sufficient merely to show that persons might have had access to it (*r*). There are, however, a class of documents, such as British complete specifications, which are held to be published so soon as the public have acquired the right to see them, whether or not any member of the public has actually seen them (*s*).

(*r*) *Cf. Plimpton* v. *Malcolmson* (1876), 3 Ch. D. 531; *Plimpton* v. *Spiller* (1877), 6 Ch. D. 412, C. A. The dicta of the Court of Appeal as to the necessity of the publication becoming known to "a sufficient number of people" (6 Ch. D. 434) or becoming part of the "common knowledge," would seem too wide in view of the later cases, especially *Pickard* v. *Prescott, infra.*

The following are examples of cases where publication was held to be proved :—

Where a German specification had been in the Patent Office Library for forty days before the date of application, and was duly indexed. *Harris* v. *Rothwell*, 4 R. P. C. 232, C. A.

Where a foreign book was sent to a bookseller in this country and four copies sold. ROMILLY, M.R., expressed opinion that the exposure in the shop would have been enough alone without proof of sale. *Lang* v. *Gisborne* (1862), 31 L. J. (CH.) 769.

Where a book was in the British Museum Library, was indexed, though only under author's name, and was referred to in a later (apparently foreign) work. *Heidemann* v. *Smokeless Powder Coy., Ltd.*, 15 R. P. C. 305.

Where the publication of an electrical discovery was in an electrical technical paper received at the Patent Office and Institute of Civil Engineers. *United Telephone Coy.* v. *Harrison* (1883), 21 Ch. D. 720.

Where a publication in a technical paper had been in the Patent Office Library two days before the application for the patent. *Rucker* v. *London Electric Supply Corporation, Ltd.*, 17 R. P. C. 279, 295.

Publication of an improvement in eyeglasses in an optical paper sent to a regular subscriber in this country held sufficient for presumption that he had read it within a day or two of the time of receipt though, *semble*, this might have been rebutted by proof that he had not so read it. *Pickard* v. *Prescott*, 9 R. P. C. 105, H. L.

Where a large number of circulars were sent to an agent in England for distribution, although it was not proved that they were sent out. *Jensen* v. *Smith*, 2 R. P. C. 249; see also *Bovill* v. *Goodier* (1871), Griff. N. C. 47.

The following are cases in which publication not held to be proved :—

Where the only copy of a book was one in the British Museum Library in a room to which the public had no access, and it was only indexed under the author's name in the British Museum catalogue, although it had also been indexed under its subject in a bookseller's catalogue. *Otto* v. *Linford* (1881), 46 L. T. 35; see also *Otto* v. *Steel*, 3 R. P. C. 109.

Where a book had been sent to the Patent Office, but was kept in a room to which the public did not go and owing to an error was omitted from the index. *Plimpton* v. *Malcolmson* (1876), 3 Ch. D. 531; *Plimpton* v. *Spiller* (1877), 6 Ch. D. 412, C. A.

The question of when publication may be presumed to have taken place is also a question of fact: *cf. Harris* v. *Rothwell, supra.*

(*s*) *Fox* v. *Astrachans, Ltd.*, 27 R. P. C. 377. Here it was held that publication dated from acceptance. See also *Hill* v. *Evans* (1862), 31 L. J. (CH.) 463.

In *Ellington* v. *Clark*, 5 R. P. C. 319, C. A., a specification accepted the same day as the application for the patent in question was held to be an anticipation, but the point does not seem to have been fully argued.

In other respects, the publication of a British specification has the same effect as that of any other document. *Hills* v. *London Gas Co.* (1860), 29 L. J. (EX.) at p. 420.

It would seem that a similar rule would apply to a "Convention" specification open to inspection under

Where the publication is in a language understood by persons in England the effect is the same as if it were in English (*t*), though doubtless the fact of the document being in a language little known here would properly be taken into account as affecting the probability of its having been read. Documents in foreign languages.

These considerations only apply to documents intended for the public and coming to this country in the ordinary course. When a document is sent privately to this country and is kept secret, or only used for experimental purposes, the position is the same as where an invention is made by a person here and never published, *i.e.* it does not affect a later patent (*u*). Private documents.

It is now provided by statute that in the case of any patent applied for on or after the first day of January, 1905, the invention shall not be deemed to have been anticipated by reason only of its publication in a specification left pursuant to an application made in the United Kingdom not less than fifty years before the date of the patent, or of its publication in a provisional specification of any date not followed by a complete specification (*x*). There have been no decisions throwing light on the application of these provisions. Statutory exceptions as to publication.

So too a verbal communication made in this country not confidentially is a publication (*y*). Verbal communications.

With regard to a confidential communication this in itself Confidential communications.

sect. 91. *Parsons and Stoney's Application*, 27 R. P. C. 491, L. O., and see *International Harvester Coy. of America* v. *Peacock*, 25 R. P. C. at p. 773, P.C. As to other documents, see *Patterson* v. *Gas Light and Coke Coy.* (1878), 3 A. C. 239 (Report of Commissioners). See also *Harris* v. *Rothwell*, 4 R. P. C., *per* LOPES, L.J., at p. 232, C. A.

(*t*) *Harris* v. *Rothwell*, 4 R. P. C. 225, C. A.; *Lang* v. *Gisborne* (1862), 31 L. J. (CH.) 769. See also *Harteloop's Patent* (1836), W. P. C. 553, and see comments thereon by LINDLEY, L.J., in *Harris* v. *Rothwell*, 4 R. P. C. at p. 231, C. A.; *Rucker* v. *London Electric Supply Corporation, Ltd.*, 17 R. P. C. 279, 295.

(*u*) *Per* BAILEY, J., in *Lewis* v. *Marling* (1829), W. P. C. 496, but a form of invitation for tenders sent to two contractors in this country was held to be published: *Ludlow* v. *Jenkins*, 29 R. P. C. 179.

(*x*) Sect. 4 (1). The Act does not deal with the case where something has been published in a provisional specification but abandoned in the complete, and matter so published might still anticipate. The Courts have generally been reluctant to attach much weight to such a publication since the abandonment by the inventor himself is likely to prevent others paying much attention to it: *cf. Stoner* v. *Todd* (1876), 4 Ch. D. 58.

Prior to the Act there were several cases where the Courts held a provisional specification to be an anticipation. See *Davis* v. *Feldman*, 1 R. P. C. 193, C. A.; *Lawrence* v. *Perry*, 2 R. P. C. 179, 187; *Gaulard and Gibbs' Patent*, 7 R. P. C. 307, 387, H. L.

(*y*) *E.g. Humpherson* v. *Syer*, 4 R. P. C. 407, 414, C. A. No communication made abroad can affect a British patent. See TRUE AND FIRST INVENTOR, p. 74.

was never held to be publication and a broad view has been taken as to what establishes a relation of confidence (*z*).

Where, however, a communication is made to some person who is a trustee for the public and whose duty it is to use the knowledge for the public benefit, the communication cannot be confidential (*a*).

Publication without knowledge or consent of inventor.

The Act also provides that a patent shall not be held to be invalid by reason only of the publication of the invention if the patentee shows that the matter published was derived from him, that the publication was without his knowledge and consent, and that he applied for a patent with all reasonable diligence on learning of such publication (*b*).

Publication by exhibition of article.

In many cases the publication is effected by the exhibition or use of the article in question. If the article clearly shows the means of manufacture, and if it is not shown as a pure experiment (*c*), such publication is generally complete and effective, but cases arise where the article has been manufactured abroad, so that the manufacture was not a prior user within the realm, and the means of manufacture are not apparent from the manufactured article. The law in such cases would seem to be that if the article has passed into the hands of a member of the public, and if analysis would have shown the means of manufacture, then the publication is effective, but not otherwise (*d*). In

(*z*) *Cf. Pilkington* v. *Yeakley*, 18 R. P. C. 459. In the opinion of FRY, L.J., some evidence as to communication being confidential is necessary. *Humpherson* v. *Syer*, 4 R. P. C. 407, 414, C. A.

(*a*) *Patterson* v. *Gas Light and Coke Coy.* (1878), 3 A. C. 239.

(*b*) Sect. 41 (2). Before the Act it was held that if a communication had been made so that some person in this country not under an obligation of secrecy knew of the invention, this was a publication. *Humpherson* v. *Syer*, 4 R. P. C. 407, C. A. In Scotland, however, a different view prevailed: *Templeton* v. *Macfarlane* (1847), 2 S. X. 4. The publication of a foreign specification of the inventor containing *inter alia* an account of the invention is within the section. *International Harvester Coy. of America* v. *Peacock*, 25 R. P. C. 765, P. C.

If, as the result of such communication, some other person had applied for a patent, this section would not afford a ground of opposition, *e.g.* if the communication were made abroad, nor any answer to a plea of prior grant. Nor, *semble*, would it help if a commercial user of the invention had been started here so that others were using the invention at the time of the grant.

(*c*) See pp. 69 *et seq.*

(*d*) See *per* ROMER, J., in *Miller's Patent*, 15 R. P. C. 205, and also *Hancock* v. *Somervell* (1851), 39 Newton Law Journal 158. In *Sunlight Incandescent Coy.* v. *Incandescent Gas Light Coy.*, 14 R. P. C. 757, WILLS, J., seemed to take the question to be whether others in fact knew the constituents; but here there had only been exhibition and not sale.

In *Gill* v. *Coutts*, 13 R. P. C. 128, the Inner House held that if there had been public sale it did not matter that the constituents were unknown. Here, however, the manufacture had been by the defendant and in England. The same view seems to have been held by GIBB, J., in *Wood* v. *Zimmer* (1815), W. P. C. 44. Here, again, the prior manufacture was in

the case of a mechanical invention, where the details of manufacture can be completely seen by opening the article, the fact that such an article has been accessible to members of the public would seem to be sufficient to constitute publication (*dd*). There are special provisions as to publication of inventions during the holding of certain industrial exhibitions (*e*).

Prior User

Prior user of the invention is another medium of publication, and this may also in certain cases defeat a patent quite apart from the question of publication (*ee*). It is important to remember this double *rôle* of a prior user, especially in considering the cases dealing with experimental user. Prior user.

If the manufacture is being practised at the date of the grant, whether secretly or openly, the grant is not for a new manufacture, and the patent is bad. This applies equally whether such manufacture is being practised by the patentee or others (*f*). Existing manufacture.

England. See also *Spilsbury* v. *Clough* (1842), W. P. C. 259, and note thereto; *McLay* v. *Lawes*, 22 R.P.C. 199. It must be remembered that patents were primarily rewards for the introduction of new *industries* into the realm, and the fact that the products have been imported does not prevent the industry from being a new one here.

There is one difficulty in regard to this class of case which has not been discussed by the Courts. If the patent is valid the continued use of articles within the claim would *primâ facie* be an infringement, even if these had been imported before the date of the patent, and if this is so, the continued use of such articles would be interfered with were the patent upheld. Probably the view taken would be that the Courts have held user of imported article to be an infringement for the purpose of ensuring the patentee the full value of his monopoly of the right to manufacture, and as this is not affected by the use of articles obtained before the date of the monopoly, this would not be held to be an infringement.

(*dd*) *Cf. Carpenter* v. *Smith* (1841), W. P. C. 530; *Taylor's Patent*, 13 R. P. C. 482; *Lifeboat Coy.* v. *Chambers*, 8 R. P. C. 418; *Stohwasser* v. *Humphreys*, 18 R. P. C. 116; *Poulton's Patent*, 23 R. P. C. *per* VAUGHAN-WILLIAMS, L.J., at p. 560; *Brereton* v. *Richardson*, 1 R. P. C. 165.

(*e*) See s. 45.

(*ee*) See *Robertson* v. *Purdey*, 24 R. P. C. 291.

(*f*) See 21 Jac. c. 3, s. 6. As to prior user by patentee, see *Betts* v. *Menzies* (1862), 1 E. & E., *per* CAMPBELL, C.J., at p. 1008; *Germ Milling Coy.* v. *Robinson*, 3 R. P. C. 399, 408, C. A.; *Hoe* v. *Foster*, 16 R. P. C. 33, C. A.; *Poulton's Patent*, 23 R. P. C. 183 and 560, C. A.; *Bentley* v. *Fleming* (1844), 1 Car. & Kir. 587. A contrary view was taken by the Scotch Courts in *Roebuck* v. *Stirling*, 8 English Reports, p. 174, *n.* As to user by others, see *Tennant's Case* (1795), W. P. C. 125, *n.*; *Hill* v. *Thompson* (1818), W. P. C. 229, 240; *Hutchinson* v. *Patullo*, 5 R. P. C. 351.

The Courts have, in many cases, said that prior secret user by the inventor invalidates a patent, the reason generally given being that otherwise the patentee would get a longer monopoly than fourteen years. This reason hardly seems satisfactory, since the only limitation in the Statute is that the monopoly given by the *patent* shall not be more than fourteen years from the date of the grant; and, further, the words "which others shall not use" would seem to except the case of user by the patentee. This ground of invalidity would seem to be founded not on the Statute, but on some doctrine of the Common Law the origin of which is lost.

Abandoned manufacture.

The question of when a user in secret which has never been published, and which has been abandoned before the date of the grant, invalidates such grant is one as to which there has been no clear decision. Probably the true test is, has the manufacture been so completely abandoned that but for the patentee's discovery it would in all probability have never been heard of again ? (*g*).

Prior user must not have been merely fortuitous.

It has been suggested and would seem to be good law that a prior user in order to defeat a patent must have been a user as a manufacture and not a mere fortuitous user of the subsequent invention, in which the person using it gained no knowledge of the advantages of the invention, and which would not have led to its further use (*h*). Some of the older rulings were to the effect that there must have actually been a user "in trade" (*i*), and even in the same trade (*k*), but it seems doubtful if these would be followed.

User amounting to publication.

A user in the presence of the public, or a user in the presence of workmen without any special or implied injunction to secrecy, and for ordinary manufacturing or trade purposes is such a public prior user as will defeat a patent even if such use is abandoned (*l*).

The lapse of time since the user occurred does not alter its effect, except possibly if the user was so long ago that it may be said to be forgotten (*m*), but of course strong evidence is required

(*g*) See *Lewis* v. *Marling* (1829), W. P. C. 490, 492, *n*. See also 4 Newton London Journal 146, 2nd Ser.; Godson on Patents, 2nd Edition, p. 43. In *Tennant's Case* (1795), W. P. C. 125 *n*., the user seems to have continued up to the date of the grant.

In the case of *Wright's Patent* (1843), W. P. C. 736, an extension of term was granted for a patent which admittedly was for the rediscovery of a process known in the Middle Ages but since lost.

(*h*) *Per* BLACKBURN, J., in *Harwood* v. *G. N. Ry. Coy.* (1850), 29 L. J. (Q. B.) at p. 202. (See also judgment of Exchequer Chamber in same case (1852), 31 L. J. (Q. B.) at p. 200.) *Cf. Rockcliffe* v. *Priestman*, 15 R. P. C. 155. See also WEBSTER'S note to *Spilsbury* v. *Clough* (1842), W. P. C. 259, and cases there referred to.

(*i*) *Smith* v. *Davidson* (1857), 2 S. XIX 691, O. H.

(*k*) *Wilson* v. *Black* (1847), 2 S. X. I.

(*l*) *Household Coy.* v. *Neilson* (1843), 9 C. & F. 788, 801; *Humpherson* v. *Syer*, 4 R. P. C. 407, C. A.; *Lifeboat Coy.* v. *Chambers*, 8 R. P. C. 418, I. H.; *Wesley Richards* v. *Perks*, 10 R. P. C. 181; *Haggenmacher's Patent*, 15 R. P. C. 437; *Haggenmacher* v. *Watson*, 14 R. P. C. 631, C. A.; *McLeay* v. *Lawes*, 22 R. P. C. 199; *Gramophone Coy., Ltd.* v. *Ruhl*, 27 R. P. C. 629. In the last case, a trial in the presence of workmen not pledged to secrecy was held to be publication; see also *Humpherson* v. *Syer*, *supra*.

The ruling in *Jones* v. *Pearce* (1832), W. P. C. 121, would seem contrary to this, but must be taken to have been overruled by *Household Coy.* v. *Neilson*, *supra*. See as to this *Tangye* v. *Scott* (1866), 14 W. R. 386. See also on this point *Lewis* v. *Marling* (1829), W. P. C. 490.

(*m*) *Cf. Dick* v. *Tullis*, 13 R. P. C. 149; *Household Coy.* v. *Neilson*, *supra*.

to establish an ancient user (*n*). It may be, however, that if a short user long ago abandoned is set up the onus is on the defendant to show that it was not an abandoned experiment (*o*).

Manufacture and sale constitute prior user.

It has been said that if even a single article has been manufactured and sold in the ordinary way of trade, this would probably establish a fatal prior user or publication (*p*), and in fact comparatively small sales have been held sufficient to invalidate a patent. Apart from sale a use for the purposes of trade by the patentee or others may constitute a prior user even if there is no publication (*q*). Mere manufacture for the purposes of subsequent sale does not, however, constitute a prior user if the articles are not offered for sale before the date of the patent, and the user is kept secret for the purposes of obtaining a patent, whether such manufacture be by the patentee (*r*) or others (*s*). The exhibition of an article for the purpose of obtaining orders or seeing how the trade like it is generally held such use in trade as amounts to publication (*t*).

Secret experiment no anticipation.

It has from a very early date been held that mere experiment never published to the world is not publication (*u*), and generally it may be said that if the user is experimental (*x*) and the inventor has done nothing in the course of the experiment

(*n*) *Dick* v. *Tullis*, *supra*; *Haggenmacher* v. *Watson*, *supra*; *Morgan* v. *Windover*, 4 R. P. C. 417; 5 R. P. C. 195; 7 R. P. C. 131, H. L.

(*o*) *Morgan* v. *Windover*, *supra*, *per* KEKEWICH, J., BOWEN and COTTON, L.JJ. The point seems to have been doubted in the H. L.

This applies particularly where the patent has been very successful. *Robertson* v. *Purdey*, 24 R. P. C. 299; *Dick* v. *Tullis*, *supra*.

(*p*) *Morgan* v. *Seward* (1837), W. P. C. 170; *Losh* v. *Hague* (1839), W. P. C. 200; *Lister* v. *Norton*, 3 R. P. C. 199; *Young* v. *Rosenthal*, 1 R. P. C. 29; *Haskell Golf Ball Coy.* v. *Hutchinson*, 25 R. P. C. 194, but *cf. contra Elliot* v. *Ashton* (1840), W. P. C. 222, where COLTMAN, J., left it to the jury to say whether the sale of 70 gross of a certain button proved its public use and they found it did not, and *Fellowes* v. *Brookes*, 27 R. P. C. 103, where the manufacture and sale of 2 cwt. of nuts by a person not the patentee, was held to be a mere experiment. See also *Crampton* v. *Patents Investment Coy.*, 5 R. P. C. 382, 403; but the C. A. here seem to have considered that the judge did not believe the evidence as to publication: see 6 R. P. C. 287.

(*q*) *Cf. Hudson Scott* v. *Barringer*, 23 R. P. C. 79, where the use of samples, of which the method of manufacture was not apparent, to obtain orders was held a prior user. *Betts* v. *Neilson* (1871), 3 Ch. App. 429.

(*r*) *Betts* v. *Menzies* (1859), 28 L. J. (Q. B.) 361.

(*s*) *Moss* v. *Malings*, 3 R. P. C. 373. But it is otherwise if they have been offered for sale though not exposed. *Mullins* v. *Hart* (1852), 3 Car. & K. 297.

(*t*) *Winby* v. *Manchester Steam Tramways Coy.*, 8 R. P. C. 61; *Wesley Richards* v. *Perkes*, 10 R. P. C. 181; *Stohwasser* v. *Humphreys*, 18 R. P. C. 116; *Hudson Scott* v. *Barringer*, *supra*; *Robertson* v. *Purdey*, 24 R. P. C. 273.

(*u*) See *Dollond's Patent* (1776), W. P. C. 43.

(*x*) *Cf.* p. 71, *n.* (*f*).

which would be such a publication as to prevent him from getting a patent, it will not prevent others doing so (*y*).

Use for the purpose of an experiment of a process or article would seem not to be a prior user so as to defeat a later patent, though such process or article was in itself perfectly successful and its use was only abandoned because the main purpose of the experiment failed (*z*).

Experimental user.

With regard to prior user of an experimental nature by the patentee or others a distinction must be made between those cases where the user has been private, and those in which the user has become known to members of the outside public, so that it might have formed an addition to the stock of public knowledge (*a*). With regard to the latter class of case it may be said that if the exact thing subsequently patented has been done under such circumstances that the public may be presumed to have become acquainted with the invention the fact that it was an experiment would not prevent the publication being fatal (*b*), but that if what was done was not the complete invention so that something was wanting for success, the fact that it was an experiment and was unsuccessful is presumed to have discounted the value of any advance made, so that the stock of public knowledge is considered to be unaffected (*c*).

(*y*) *Cf. Gadd* v. *Mayor of Manchester*, 9 R. P. C. 516, C. A., where communications by previous inventor to his partners and advisers with a view of getting a patent were held no publication. See also *Mosely* v. *Victoria Rubber Coy.*, 4 R. P. C. 241; *Humpherson* v. *Syer*, 4 R. P. C. 407, C. A.

The question as to whether the user was merely experimental may, however, be answered differently in the cases of user by the patentee and user by others, see p. 72, *n.* (*h*).

(*z*) *Electrolytic Plating Coy.* v. *Holland*, 18 R. P. C. 521. In *King Brown* v. *Anglo-American Brush Corporation*, 6 R. P. C. 414, O. H.; 7 R. P. C. 436, I. H., and 9 R. P. C. 313, H. L., a machine had been used for the purpose of producing electric light to show experiments with a diving machine. Though in Scotland, the O. H. and the I. H. held this was public user of the machine, the H. L. were doubtful and left the point undecided.

(*a*) Public user does not necessarily mean user by the public, but user in public. *Carpenter* v. *Smith* (1841), W. P. C., *per* ABINGER, C.B., at p. 534; *Stead* v. *Williams* (1844), 2 W. P. C. 126; *Croysdale* v. *Fisher*, 1 R. P. C. 17; *Young* v. *Rosenthal*, 1 R. P. C. 29; *Lifeboat Coy.* v. *Chambers*, 8 R. P. C. 415, I. H.; *Humpherson* v. *Syer*, 4 R. P. C. 407, C. A.; *Taylor's Patent*, 13 R. P. C. 482; *Gramophone Coy., Ltd.* v. *Ruhl*, 27 R. P. C. 629. It would appear to be sufficient if the public have access to the place where the article is, if it is openly shown. *Humpherson* v. *Syer*, *supra*; *Gramophone Coy., Ltd.* v. *Ruhl*, *supra*; but *cf. contra Electrolytic Plating Coy.* v. *Holland*, 18 R. P. C. 521, 527; *Crampton* v. *Patents Investment Coy.*, 5 R. P. C. 382, 403.

(*b*) *Brereton* v. *Richardson*, 1 R. P. C. 165; *Taylor's Patent*, *supra*; *Sinnett's Patent*, 15 R. P. C. 761.

(*c*) *Jones* v. *Pearce* (1832), W. P. C. 122; *Galloway* v. *Bleaden* (1839), W. P. C. 521; *Bovill* v. *Goodier* (1871), Griff. N. C. 47; *Edison and Swan Coy.* v. *Holland*, 6 R. P. C. 243, 277.

With regard to users of the former class, these, unless they have been followed by practical user, are treated as abandoned experiments, and do not affect later patents (*d*). Generally speaking the Courts treat experiments that have only become known to the experimenter's own workmen, or to friends to whom they have been shown as experiments, as within the first class, and are not eager to presume that they became known to the public merely because the public might have had access to, or got to know the nature of, the apparatus or process, unless it is shown that they have actually done so (*e*).

Limits of experimental user.

The Courts have generally taken a broad view on the question of the amount of user which yet leaves such user experimental. So long as such user has not been more than what was genuinely necessary for the inventor to satisfy himself as to the practicability of the invention, or as to the best form of such invention, it is classed as experimental, but if it has exceeded this limit and been carried on for profit or for the ordinary use of the invention, then such user defeats a subsequent patent (*f*). Of course the limit of the permissible user varies

(*d*) *Lewis* v. *Marling* (1829), W. P. C. 490; *Bentley* v. *Fleming* (1844), 1 Car. & Kir. 587; *Moss* v. *Malins*, 3 R. P. C. 373; *Moseley* v. *Victoria Rubber Coy.*, 4 R. P. C. 241; *Kane* v. *Guest*, 16 R. P. C. 433; *Robertson* v. *Purdey*, 24 R. P. C. 273.

(*e*) *Lewis* v. *Marling*, *supra*; *Newall* v. *Elliott* (1858), 27 L. J. (C. P.) 337; *Bentley* v. *Fleming*, *supra*; *Moss* v. *Malins*, *supra*; *Kane* v. *Guest*, *supra*; *Moseley* v. *Victoria Rubber Coy.*, *supra*; *Electrolytic Plating Coy.* v. *Holland*, *supra*; but *cf.* *Humpherson* v. *Syer*, 4 R. P. C., *per* FRY, L.J., at p. 415.

(*f*) The following are examples of cases where the user was held to be experimental:—

Where inventor tested a cable-laying machine by using it for laying an Atlantic cable. *Newall* v. *Elliott* (1858), 27 L. J. (C. P.) 337.

Where inventor had 600 bottles made in order to test if depth of a certain groove was uniform. *Useful Patents Coy.* v. *Rylands*, 2 R. P. C. 255.

Where a process had been used for purifying several thousand cubic feet of gas and then abandoned. *Hills* v. *London Gas Coy.* (1860), 29 L. J. (EX.) 409.

Where two pairs of paddle-wheels were made for a person interested in the invention to be used abroad. *Morgan* v. *Seward* (1837), W. P. C. 170. See also *Kane* v. *Guest*, 16 R. P. C. 433; *Electrolytic Plating Coy.* v. *Holland*, 18 R. P. C. 521; *Fellows* v. *Brooks*, p. 69, *n.* (*p*).

The following are cases where the user was held not to have been experimental:—

Where contractor publicly used a machine on a contract for four months, and originally had no idea of patenting it. *Adamson's Patent* (1856), 25 L. J. (CH.) 456.

Where workman communicated idea to his master, who converted two machines in July and August and had a new one made which was started the following February, and the patent was not applied for till April. *Elias* v. *Grovesend Tinplate Coy.*, 7 R. P. C. 455.

Where contractor entered into contract for printing machines which were erected and run for a trial period in accordance with contract. The trial was only to test particular machines and not the invention. *Hoe* v. *Foster*, 16 R. P. C. 33, C. A.

Where certain boiler blocks were put in by contractor in boiler erected by him. The Court drew attention to

with the nature of the invention (*g*), and it would also seem that wider limits are accorded to the term experimental user when such user has been by the patentee than when it has been by others (*h*). The fact that it was the intention of the user to apply for a patent or design would furnish a presumption that such user was experimental and secret (*i*).

the fact that the contractor made no attempt to see how invention worked. *Poulton's Patent*, 23 R. P. C. 506, C. A.

Where gauge glasses were sold and used by purchasers till they were worn out, although this was a trial order and glasses were not renewed. *Guilbert Martin* v. *Carr*, 4 R. P. C. 18; see also *Rickerby* v. *Duncan*, 25 R. P. C. 248.

Use of axle on bicycle by person (not patentee) in the way of trade, although object was to see how it worked, *semble*, this result would not have been affected had parts been covered in. *Brereton* v. *Richardson*, 1 R. P. C. 165.

Single anchor made, sold, and used till broken. *Honiball* v. *Bloomer* (1854), 2 W. P. C. 109; see also *Sinnett's Patent*, 15 R. P. C. 761.

(*g*) *Hills* v. *London Gas Coy.* (1850), 29 L. J. (EX.) *per* BRAMWELL, B., at p. 423.

(*h*) *Westley* v. *Tolley*, 11 R. P. C. 602, 607; *cf.* also such cases as *Croysdale* v. *Fisher*, 1 R. P. C. 17.

(*i*) *Moss* v. *Malins*, 3 R. P. C. 373; *semble*, where the prior user under such circumstances was by the defendant, he may be estopped from relying on it, *ibid.*; *cf.*, however, *Humpherson* v. *Syer*, 4 R. P. C. 407, C. A.; *Brereton* v. *Richardson*, 1 R. P. C. 165.

CHAPTER IV

PART I

TRUE AND FIRST INVENTOR

Grant must be to true and first inventor.

THE Statuto of Monopolies provides that tho patent must be granted to the truo and first inventor, and it is therefore an objection to the validity of a patent that the grant was not so made (*a*).

Who is such inventor.

The true and first inventor may be said to be the man who substantially originated tho invention within the realm (*b*) though he may have adopted suggestions for details and improvements from others, especially from persons employed by him in working out the idea, provided that such suggestions do not form substantially separate inventions (*c*). But the Courts are not eager to find that a man is the inventor because he has made a bare suggestion of an idea or a desired result, which has then been put into practical form by others (*d*).

Importers.

An importer of an invention from abroad is an inventor

(*a*) 21 Jac. 1, c. 3, s. 6. If the first and true inventor is one of the grantees other persons may be joined with him. See p. 253, *n.* (*a*). As to grants to the personal representatives of an inventor, see p. 253, *n.* (*b*).

(*b*) As to questions of priority, see p. 75, *n.* (*x*).

(*c*) In the following cases the person originating the idea has been held to be the true and first inventor though workmen or others had subsequently made suggestions to him, which were adopted. *Bloxam* v. *Elsee* (1827–8), 1 C. & P. 567; *Allen* v. *Rawson* (1845), 1 C. B. 551; *Sirdar Rubber Coy.* v. *Wallington*, 22 R. P. C. 267; *Smith's Patent*, 22 R. P. C. 59; *Richmond* v. *Wrightson*, 22 R. P. C. 25. See also *Norwood's Patent*, 12 R. P. C. 226, and *Norwood's Patent* (*No.* 2), 15 R. P. C. 103.

But where a material part of the patented invention is obtained from another person the whole patent is bad. See *Ralston's Patent*, 26 R. P. C. 313.

(*d*) *Pirrie* v. *York Street Flax Spinning Coy.*, 11 R. P. C. 429, 447, C. A. Ir.; *Jackson's Patent*, 22 R. P. C. 387; *Marshall's Patent*, 17 R. P. C. 553. See also *Elias* v. *Grovesend Tinplate Coy.*, 7 R. P. C. 455, C. A.; *Winby* v. *Manchester Steam Tramways Coy.*, 8 R. P. C. 65.

Where, too, the originator of the idea had understood it so little that he cumbered his apparatus with parts which prevented it from working, it was held that the man who subsequently put it into practical form was the true and first inventor. *Minter* v. *Mower* (1835), W. P. C. 141.

within the meaning of the Statute of Monopolies (*e*). By modern practice a person to whom the invention is communicated from abroad is classed as such an importer (*f*), and there is a special form provided for applications by such persons (*g*). It seems, however, doubtful if any objection can be raised, after the patent has been granted, because the applicant claimed as the inventor instead of as a person who had received a communication from abroad (*h*). Neither the Patent Act (*i*) nor the Statute of Monopolies (*k*) authorises a grant to any but the true and first inventor, and therefore the power of the Patent Office to grant a patent to a communicatee is because he is the true and first inventor, and it seems difficult to see how, in describing himself as such, he can be said to have made a mis-statement (*l*). A foreigner who is an *alien ami* can also apply direct (*m*) either in the ordinary way, or under the International Convention (*n*).

But if the communication is made by a person in this country the person to whom it is made is not the true and first inventor (*o*), unless, perhaps, the person communicating is a mere conduit-pipe from a person abroad (*p*).

Master and workman.

Although by contract a master may have equitable rights over the invention of his servant (*q*), yet the latter is in law the inventor, even though he has worked in his employer's time and at his expense, and a patent for such invention granted to the master would be bad (*r*).

(*e*) *Edgeberry* v. *Stephens* (1691), Davies 36; *Moser* v. *Marsden*, 10 R. P. C. 350, 359, C. A.

(*f*) *Beard* v. *Egerton* (1846), 15 L. J. (C. P.), 270. It is no objection that such importer has improved on the invention. *Moser* v. *Marsden*, *ubi supra*.

(*g*) See p. 253, *n.* (*a*).

(*h*) See *Avery's Patent*, 4 R. P. C. 152; *Nickels* v. *Ross* (1849), 8 C. B. 679; *Pilkington* v. *Yeakley Vacuum Hammer Co.*, 18 R. P. C. 459.

(*i*) See s. 1 (1).

(*k*) 21 Jac. 1, c. 3, s. 6.

(*l*) "The patentee is the true and first inventor within the meaning of the Patent Law whether he invents himself or whether he simply imports a foreign invention." *Moser* v. *Marsden*, 10 R. P. C., *per* LINDLEY, L.J., at p. 359, C. A. See, however, *Steadman* v. *Marsh* (1856), 2 Jur. (N. S.) 391, and *Milligan* v. *Marsh* (1856), 2 Jur. (N. S.) 1083.

(*m*) *Cf. Beard* v. *Egerton*, *ubi supra*, and p. 3, *n.* (*m*).

(*n*) See p. 259.

(*o*) *Marsden* v. *Saville Street Foundry and Engineering Coy.* (1878), 3 Ex. D. 203; *Tennant's Case*, W. P. C. 125; *Milligan* v. *Marsh*, *supra*.

(*p*) See *per* JESSEL, M.R., in *Plimpton* v. *Malcolmson* (1876), 3 Ch. D. 531, 532; see also *Pilkington* v. *Yeakley Vacuum Hammer Coy.*, 18 R. P. C. 459.

(*q*) *Edisonia, Ltd.* v. *Forse*, 25 R. P. C. 546. These rights are, however, purely contractual and depend on special circumstances. It may be, however, that where an employee, occupying such a position that it is his duty to direct how work is to be carried out, makes an invention, he is bound, since it is his duty to do his best for his employer, to use such an invention and to let his subordinates use it while he remains in his employer's service.

(*r*) *Worthington Pumping Coy.* v.

The fact that the person alleged to be the true inventor permitted or concurred in the patentee obtaining his patent is no answer to this objection (*s*), although, of course, it has weight in discrediting the evidence in support of the plea (*t*). Acquiescence no answer.

The conceiving or working out of an idea which is kept secret and not used practically does not invalidate a patent applied for subsequent to the discovery but before its publication, or an application by the original inventor (*u*). In the case where two persons make the invention independently and both apply for and obtain patents, the priority to be considered is that of the applications, not of the inventions (*x*). Questions of priority.

PART II

PRIOR GRANT

Another ground of objection sometimes raised against Letters Patent is that they are invalid because the monopoly claimed by them had already been granted to some other person. This is only of importance in the case where the application for the second patent has been made between the application for, and the publication of the complete specification of, the first, since if the second application were made after the publication of the first specification the objection would be that it had been anticipated.

This plea of prior grant may be supported on grounds which

Moore, 20 R. P. C. 41; *Heald's Patent*, 8 R. P. C. 430; *Marshall's Patent*, 17 R. P. C. 553; *cf.*, however, the following case.

Where E, the chemist of a firm, made the first suggestion and worked out the idea, but under the direction of one of the partners, the partners took out the patent with E's permission in their own name, it was held that they were the true and first inventors. *Kurtz* v. *Spence*, 5 R. P. C. 181. A very doubful case. Patent held bad on other grounds.

(*s*) *Ralston's Patent*, 26 R. P. C. 313; but *cf. Kurtz* v. *Spence*, *supra*, *n.* (*r*).

(*t*) *Cf. Lifeboat Coy., Ltd.* v. *Chambers*, 8 R. P. C. 420.

(*u*) *Dollond's Case* (1776), W. P. C. 43; *Cornish* v. *Keene* (1837), W. P. C. 501; *Household Coy.* v. *Neilson* (1843), W. P. C. 719 *n.*; *Stead* v. *Williams* (1843), 2 W. P. C. 126; *Kurtz* v. *Spence*, 5 R. P. C. 161, 179; *Smith* v. *Davidson* (1857), 2 S. XIX. 691; *Robertson* v. *Purdey*, 24 R. P. C. 290.

(*x*) Curiously enough this point has never actually been decided; in *Kurtz* v. *Spence*, *supra*, a different view was suggested. But the whole policy of the Act as to giving priority to the first applicant (see especially sections 8 and 11, and pp. 266 *et seq.*) suggest that such first applicant is to be considered the first and true inventor. It must also be remembered that when he applies he is in exactly the position of the first and true inventor as defined by the cases mentioned above, and it would seem strange if any subsequent act of another person could divest him of his rights.

do not depend on the Statute of Monopolies but on the doctrine that the Crown having granted once cannot grant the same thing to a second person (*y*). In such case the patentee may reply that the first grant was void and may support such contention by any of the grounds on which the validity of Letters Patent may be attacked, since if the first grant was a nullity it would still be in the power of the Crown to make a grant to him (*z*).

But the plea of prior grant might be put in another way, although this has never actually been done. The Statute of Monopolies provides that the monopoly granted by the Crown shall not extend for more than fourteen years from the date of the grant (*a*). The total monopoly granted by the two patents would be more than fourteen years from the date which the first bears, and it might therefore be held that the second grant exceeded the power of the Crown. It must, however, be remembered that the real monopoly, which only starts with the publication of the first complete specification and ends fourteen years after the second application is *ex hypothesi* less than fourteen years, and that although the grant is now antedated by statute to the date of the first application, it is in fact not made until the patent is sealed, and the monopoly granted by the second patent expires within fourteen years of this date (*b*).

(*y*) See *Ex parte Bailey* (1872), 8 Ch. App. at p. 63; *Crane* v. *Price* (1842), W. P. C. 412 and note to same.

(*z*) *Robertson* v. *Purdey*, 24 R. P. C. 273; *Mica Insulator Coy.* v. *Electrical Coy.*, 15 R. P. C. 489. This plea also appeared in *Hill* v. *Adams*, 10 R. P. C. 102; *Rothwell* v. *Macintosh*, 11 R. P. C. 274; *Harrison* v. *Nicholson*, 25 R. P. C. 393, 400, 403.

It is essential to show that the subject-matter claimed by the second grant is that claimed by the first grant. *Birmingham Tyre Coy.* v. *Reliance Tyre Coy.*, 19 R. P. C. 298.

It must, however, be remembered that the grant of letters patent is in form of a grant of the right to use the invention (see p. 4, *n.* (*c*)), and it would seem doubtful if the second grant would stand if it prevented the first patentee from working his invention at all, *e.g.*, if the first patentee had claimed a certain integer in combination with others and the second patent claimed this integer *per se*.

But if the grants differ so that the second is not in derogation of the first, the fact that they are so similar that if the first had been published it would have destroyed the subject-matter of the second does not matter. *Blackett* v. *Dickson*, 26 R. P. C. 82, O. H. See also *Osram Lamp Works* v. *Z. Electric Lamp Coy.*, 29 R. P. C. 428.

It might possibly be held that this objection might not go to the grant as a whole, but only to the part covered by the prior grant. *Cf.* *Daw* v. *Eley* (1867), L. R. 3 Eq. 512.

In *Hill* v. *Adams*, *supra*, evidence was given by the defendant invalidating both patents although the only plea was prior grant, KAY, J., refused to grant an injunction and said either that defendant must amend, or he would dismiss action without costs.

(*a*) 21 Jac. c. 3, s. 6. See also *Crane* v. *Price*, *supra*. This objection would seem equally valid if the two grants are to the same person.

(*b*) See, however, *Nordenfeldt* v.

The objection of prior grant as above described necessarily implies that the invention forming the subject of the second patent has not only been described but has also been claimed for in the first. It might also be pleaded that the second patentee was not the first and true inventor in that the first patentee had made the invention and had communicated it to the public before he did so (*c*). It would not seem to be any objection to this plea either that the first patent was bad, or that the invention forming the subject-matter of the second patent was only described and not claimed in the first specification.

Gardner, 1 R. P. C. 10, *Holste* v. *Robertson* (1877), 4 Ch. D. 9, where it was held that the date of the grant of a British patent must be taken as the date of the application for the purpose of determining whether it was granted before or after a foreign patent.

(*c*) This view seems to have been adopted by the Court in *Rose's Patent Coy.* v. *Braby*, 11 R. P. C. 198, I. H. If, however, the two specifications are filed by the same applicant, the objection that the first was a "dedication to the public" of the matters contained therein so as to prevent their being subsequently patented is unsound in law. *Oxley* v. *Holden* (1860), 30 L. J. (C. P.) 60. See also *Lister* v. *Norton*, 3 R. P. C. 199.

CHAPTER V

Utility

The only limitation put by the Statute of Monopolies on the manufactures for which a valid patent can be granted is that of novelty (*a*), but the Courts have held that patents which are not useful are invalid either as being prejudicial to the public (*b*), or on the ground that the patentee has deceived the Crown by representing that his invention has advantages which it in fact has not (*c*). Hence, a patent to be valid must describe and claim an invention which is not only novel but useful. Meaning of utility in patent law.

The term "utility" is, however, used in a very special sense. In the case of a new machine, article, or process, the test may be put briefly as, "Will the invention work, and will it do what is claimed for it?" (*d*). If so, the question of practical

(*a*) *Per* Parke, J., in *Lewis* v. *Marling* (1829), W. P. C. 497.

(*b*) Formerly it was said that the proper plea was that the patent was prejudicial, not that it was not useful. *Per* Alderson, B., in *Jupe* v. *Pratt* (1837), W. P. C. 145, 151. See also *Elias* v. *Grovesend Tinplate Coy.*, 7 R. P. C. 455, 467; *Ward Brothers* v. *Hill*, 20 R. P. C. 189, 200; *Wilson Brothers Bobbin Coy., Ltd.* v. *Wilson and Coy.* (*Barnsley*), *Ltd.*, 20 R. P. C. 1, 15, H. L.

(*c*) *Pirrie* v. *York Street Flax Spinning Coy.*, 10 R. P. C. 34, 39; *Morgan* v. *Seaward* (1837), W. P. C. 187, 197.

(*d*) *Morgan* v. *Seward* (1837), W. P. C. 187; *Welsbach Incandescent Gas Light Coy.* v. *New Incandescent Gas Lighting Coy. Ltd.*, 17 R. P. C. 237, 282; *Fawcett* v. *Homan*, 13 R. P. C. 398, C.A.; *Wilson* v. *Union Oil Mills*, 9 R. P. C. 57.

The following cases show what is meant by non-utility:—

In the case of a patent for making holes in the breach of a gun large enough for air to enter, but too small for powder to pass through, it was found that in fact a hole made as described would let the powder through and therefore the whole object of the invention failed and the patent was held bad. *Manton* v. *Parker* (1815), Dav. P. C. 327.

In the case of a patent for a method of mounting the folding mirror in a reflex camera, the judge found that the method would not work because it would be impossible to keep the camera light tight, and held the patent bad. The decision was in form on sufficiency. *Nicholls* v. *Kershaw*, 27 R. P. C. 237.

In the case of a patent for the use of batteries for keeping the potential of electric lighting mains constant, it was found that these batteries would not charge unless the potential was greater than 125 volts or discharge unless it was under 50 volts, and that the system was therefore useless for keeping a constant potential. Patent held bad. *Lane Fox*

utility is immaterial, as is the question of comparative utility (*e*). It is the utility, or, rather, the practicability of the invention which has to be considered, not the usefulness of the product (*f*), and it does not matter whether or not this is of commercial utility (*g*), or a benefit to the public (*h*), or even in general whether it is suitable for the purposes suggested (*i*).

In the case of a mere improvement it has been said that some advantage of a substantial nature must be shown over what has gone before (*k*), but it seems doubtful whether there can be said to be any distinction in fact between the two classes of inventions. These dicta probably bear more on subject-matter than utility proper, and illustrate the principle that with a small apparent difference it is generally more necessary

v. *Kensington Electric Lighting Coy.*, 9 R. P. C. 413, C. A.

An admission of utility only means that the patentee's process will work, not that he has made a useful improvement. *Wilson* v. *Wilson Brothers Bobbin Coy., Ltd.*, 28 R. P. C. 733, 739, C. A.; but *cf. Presto Coat Collar Coy.* v. *Levy Brothers*, 28 R. P. C. 363, 364, C. A.

(*e*) *Welsbach Incandescent Gas Light Co., Ltd.* v. *New Incandescent Gas Lighting Co., Ltd.*, *ubi supra*; *Fawcett* v. *Homan*, *ubi supra*; *Philpot* v. *Hanbury*, 2 R. P. C. 33; *Kelvin* v. *Whyte, Thompson and Co.*, 25 R. P. C. 177; *Neilson* v. *Harford* (1841), W. P. C. 293, 324, *n.* See *contra*, *Boulton and Watt* v. *Bull* (1795), Dav. P. C. 162; *Easterbrook* v. *Great Western Railway*, 2 R. P. C. 201; *Young* v. *Rosenthal*, 1 R. P. C. 29, 41; and *per* VAUGHAN WILLIAMS, J., in *Ward Brothers* v. *Hill*, 20 R. P. C. 189. Of course the question of utility may be most important on the issue of subject-matter. See Chapter on SUBJECT-MATTER, p. 23.

(*f*) *Cole* v. *Saqui*, 6 R. P. C. 41, C. A.; *Young* v. *Rosenthal*, 1 R. P. C. 29, 41; *Alsop's Patent*, 24 R. P. C. 733. In this case it was said that if the patented process produced the result claimed, misstatements as to the purposes to which such result might be applied would not necessarily make the patent void.

In one case, however, it was held that where the patentee's directions would only enable a workman to produce a right-hand point piece whereas the point pieces used on railways, etc., are invariably left-hand, the patent was bad for non-utility. *Winby* v. *Manchester Steam Tramways Co.*, 8 R. P. C. 61. This decision seems of very doubtful validity.

(*g*) *Badische Anilin und Soda Fabrik* v. *Levinstein*, 4 R. P. C. 449, H. L. *United Telephone Coy.* v. *Bassano*, 3 R. P. C. 313; *Ehrlich* v. *Ihlee*, 5 R. P. C. 437, 449, C. A.; *Edison and Swan Coy.* v. *Holland*, 6 R. P. C. at p. 257, C. A.; *Sunlight Incandescent Gas Lamp Co.* v. *Incandescent Gas Light Coy.*, 14 R. P. C. at p. 775.

(*h*) *Young* v. *Rosenthal*, 1 R. P. C. 29.

(*i*) *Flour Oxidising Coy., Ltd.* v. *Hutchinson* (*J. & R.*), 26 R. P. C. 597; *Alsop's Patent*, 24 R. P. C. 733. See *contra*, *Cornish* v. *Keene* (1837), W. P. C. 501, 506.

(*k*) *Atkins and Applegarth* v. *Castner-Kelner Alkali Co.*, 18 R. P. C. 281. See also *per* VAUGHAN WILLIAMS, L.J., in *Ward Brothers* v. *Hill*, 20 R. P. C. 189, C. A., and *per* HALSBURY, L.C., in *Badische, etc.* v. *Levinstein*, 4 R. P. C. at p. 462, H.L., followed in *Kurtz* v. *Spence*, 5 R. P. C. 183. Perhaps it may be said that in the class of cases referred to in these dicta no useful choice is afforded by the so-called improvement, and that the objections are greater than the advantages. See *Presto Coat Collar Coy.* v. *Levy Brothers*, 28 R. P. C. at p. 364, C. A. For example, in the first-named case while the old process gave a yield of 60 per cent., the patented variation would only give about 25 per cent.

to show a substantially improved result in order to establish invention (*l*). At any rate, it is sufficient on the issue of utility to show that the improvement gives the public a useful choice (*m*), or is of advantage under special circumstances (*n*).

All parts of the invention must be useful.

If several processes or variations are claimed each must be useful (*o*), and the invention must be useful in the sense of working under all ordinary (*p*) circumstances not excluded by specific direction or the general knowledge of the trade, and without any other modifications than those so supplied (*q*).

(*l*) See Chapter on SUBJECT-MATTER, pp. 48, 49. Of course greater cheapness may be such an improved result. *Cornish* v. *Keene, ubi supra*; *Pirrie* v. *York Street Flax Spinning Coy.*, 11 R. P. C. 429, C. A. Ir. See also p. 82, *n.* (*x*).

(*m*) *Scott* v. *Hamling*, 14 R. P. C. 123; *Welsbach Incandescent Gas Light Coy., Ltd.* v. *New Incandescent Gas Light Coy., Ltd., ubi supra*; *British Liquid Air Coy., Ltd.* v. *British Oxygen Coy., Ltd.*, 26 R. P. C. 509, 577, C. A.; *Kelvin* v. *Whyte-Thomson*, 25 R. P. C. 177; *Ward Brothers* v. *Hill*, 18 R. P. C. 481, 489; and 20 R. P. C. 189, 202, C. A.

(*n*) *Alkins and Applegarth* v. *Castner-Kelner Alkali Coy., ubi supra*; *Welsbach Incandescent Gas Light Coy., Ltd.* v. *New Incandescent Gas Lighting Coy., Ltd., ubi supra*; *Ward* v. *Hill, ubi supra*; *Philpot* v. *Hanbury, ubi supra*; *British Motor Syndicate, Ltd.* v. *Universal Motor Carriage and Cycle Coy., Ltd.*, 16 R. P. C. 113. The direction of TINDAL, C.J., in *Cornish* v. *Keene* (1837), W. P. C. 501, 506, that the invention must be an improvement for all the purposes mentioned is hardly reconcilable with modern cases though apparently followed in *Young* v. *Rosenthal*, 1 R. P. C. 29, 41.

(*o*) *Simpson* v. *Holliday* (1866), L. R. 1 H. L. 315; *Morgan* v. *Seaward* (1837), W. P. C. 170; *R.* v. *Cutler* (1847), 3 Car. & K. 215; *Geipel's Patent*, 21 R. P. C. 379, C.A.; *Wilson Brothers Bobbin Coy.* v. *Wilson and Coy.* (*Barnsley*), *Ltd.*, 20 R. P. C. 1, H. L. See *contra Macdonald* v. *Fraser*, 11 R. P. C., *per* Lord RUTHERFORD CLARK, at p. 174.

(*p*) *Haworth* v. *Hardcastle* (1834), W. P. C. 485; *Tubeless Pneumatic Tyre Coy.* v. *Trench Tubeless Tyre Coy., Ltd.*, 16 R. P. C. 291, 311, 312; *Wilson Brothers Bobbin Coy., Ltd.* v. *Wilson and Coy.* (*Barnsley*), *Ltd., ubi supra*, at p. 16. But see *British Motor Syndicate, Ltd.* v. *Universal Motor Carriage Coy., Ltd.*, 16 R. P. C. 113, 130, where it was held that a patent for an engine which would drive on the level, but would probably fail in hilly country, was not bad for non-utility.

(*q*) Thus where a chemical patent directed that a certain operation should be performed in an autoclave and it was found that there were two types of autoclaves in use, viz. iron and enamelled, and that the operation could only be carried out in an iron autoclave, the patent was held bad. *Badische, etc.* v. *La Société des Usines du Rhone*, 15 R. P. C. 359, C. A.

This was in point of form a decision on sufficiency, but the two issues are often indistinguishable. See *per* Lord DAVEY in *Wilson Brothers Bobbin Coy., Ltd.* v. *Wilson and Coy., Ltd., ubi supra*, at p. 14; *Morgan* v. *Seaward* (1837), W. P. C. 187; *Kurtz* v. *Spence*, 5 R. P. C. 161; *Tubeless Pneumatic Tyre Coy., Ltd.* v. *Trench Tubeless Tyre Coy., supra*; *Wilson* v. *Union Oil Mills*, 9 R. P. C. 57; *Lane-Fox* v. *Kensington Electric Lighting Coy.*, 9 R. P. C. 413, C.A.; *Hattersley and Sons, Ltd.* v. *George Hodgson, Ltd.*, 23 R. P. C. 193, H.L. But if the patented invention works under the general conditions prevailing at the date of the grant that is sufficient. *Incandescent Gas Light Coy.* v. *De Mare Incandescent Gas Light System*, 13 R. P. C. 301; and the fact that perverse effort will produce a useless form within the patent does not disprove utility, *Hopkinson* v. *St. James' Electric Light Coy.*, 10 R. P. C. 46.

Nor in general that by such effort the object of the patent can be defeated. *Reason Manufacturing Coy.* v. *Moy*, 19 R. P. C. 409.

But it is not necessary for all forms to be equally useful, nor, in the absence of any suggestion of *mala fides*, is it essential that the inventor should discriminate between the utility of the different forms (*r*).

So, too, where there are several claims, the matter claimed in each must be useful (*s*), but the fact that the additional part or step in a subsidiary claim is merely unnecessary, or that the form covered by such claim is inferior to the principal form, does not affect the validity unless the addition is said to do something which it will not do, or is introduced *mala fide* (*t*). In general it may be said that the utility of subsidiary claims is not scrutinised so closely by the Courts as the question of their novelty. This is only reasonable since a claim to a monopoly of that which is old would *primâ facie* restrict others from doing something which they may wish to do, whereas a claim for something which is merely of little or no utility would *primâ facie* not injure the general public (*u*).

The invention must be useful in the manner stated.

Where there is an absolute statement in the specification as to the effect of the invention (*x*), or of a step in the invention (*y*), which is untrue, this will generally invalidate the patent, even though it was unnecessary for the inventor to make this

Again the fact that occasionally manual assistance may be necessary to assist the patented device does not matter if this is not unusual with similar devices in the trade. *Miller* v. *Clyde Bridge Steel Coy.*, 8 R. P. C. 198, 201, I. H.; *Ward Brothers* v. *Hill*, 20 R. P. C. 204, C.A. See also *Dudgeon* v. *Thomson* (1873), 3 S. XI. 863, 872, I. H. *Cf.* also *Automatic Coal Gas Retort Coy.* v. *Mayor of Salford*, 14 R. P. C. 450; *Thermit* v. *Weldite*, 24 R. P. C. 441; *British Motor Syndicate Ltd.* v. *Universal Motor Carriage Coy., Ltd., supra.*

(*r*) *Thomson* v. *Batty*, 6 R. P. C. 84, 97; *Macdonald* v. *Fraser*, 11 R. P. C. 169, I. H.; *Benno-Jaffé, etc.* v. *Richardson*, 11 R. P. C. 112; *Automatic Coal Gas Retort Coy.* v. *Mayor of Salford, ubi supra*; *Adamant Stone Paving Coy.* v. *Corporation of Liverpool*, 14 R. P. C. 11.

(*s*) See cases in note (*o*), *supra*, and *Wilson Brothers Bobbin Coy., Ltd.* v. *Wilson and Co., Ltd., supra*; *Geipel's Patent*, 20 R. P. C. 545; *Wallace* v. *Jack*, 22 R. P. C. 581.

(*t*) *Lewis* v. *Marling* (1829), W. P. C. 290; *Ehrlich* v. *Ihlee*, 5 R. P. C. 437, C. A.; *Philpott* v. *Hanbury*, 2 R. P. C. 33; *British Vacuum Cleaner Coy.* v. *L. & S. W. Rail. Coy.*, 29 R. P. C. 309, 338, H. L.

(*u*) *Cf. Ehrlich* v. *Ihlee*, 5 R. P. C. 198 and 437, C. A. See also *Brown's Patent*, 25 R. P. C. 86, 120, C. A.

(*x*) Thus where the specification of a patent for apparatus for interlocking points and signals stated that this apparatus rendered it impossible to set the points and signals antagonistic to each other, and this was proved to be untrue, the patent was held bad for non-utility. *Easterbrook* v. *Great Western Railway Coy.*, 2 R. P. C. 201.

Again where the essence of the improvement is its greater cheapness the patent fails for non-utility if this is disproved. *Atkins and Applegarth* v. *Castner-Kelner Alkali Coy., Ltd.*, 18 R. P. C. 281, following dictum of HALSBURY, L.C., in *Badische Anilin und Soda Fabrik* v. *Levinstein, ubi supra.* See also *Manton* v. *Parker*, p. 79, *n.* (*d*); *Wilson* v. *Union Oil Mills*, 9 R. P. C. 57; *Cornish* v. *Keen* (1837), W. P. C. 513; *Alsop's Patent*, 24 R. P. C. 733.

(*y*) *Monnet* v. *Beck*, 14 R. P. C. 777, 847.

statement. Such statements must be carefully distinguished from inaccuracies as to matters of scientific theory, etc., which, although having reference to the subject of the patent, are not stated to be results of the invention (*z*). These cases would in former days probably have come within the doctrine of false suggestion (*a*). But if the invention is useful in fact the Courts do not usually scrutinise closely how much utility is attributable to the cause set out by the patentee, in the absence of any statement which is definitely untrue (*b*).

There is considerable doubt on whom the onus of the issue of utility lies (*c*), but in practice the patentee offers *primâ facie* evidence on this point (*d*). This evidence generally goes to show that machines made according to the specification will work, and that the patented device is better, at least in some respects, than what has gone before, or that it offers a useful choice to the public (*e*). Frequently this evidence shows that the invention has been largely used or has led to increased public demand for articles embodying it (*f*), and the fact of the defendant's user is often relied on as the best proof of utility (*g*).

Evidence on this issue.

(*z*) See Chapter on SUFFICIENCY, p. 98 *n.* (*q*).

(*a*) See Chapter on SUFFICIENCY, p. 98.

(*b*) *Pirrie* v. *York Street Flax Spinning Coy.*, 11 R. P. C. 429, C. A., Ir.

(*c*) There are judicial dicta that the onus is on the plaintiff. *Patterson* v. *Gas Light and Coke Coy.* (1875), 2 Ch. D. 812, 834, and also that it is on the defendant, *per* COTTON, L.J., in *Ehrlich* v. *Ihlee*, 5 R. P. C. 437, 449. Probably in view of the fact that there is no mention of utility in the Statute of Monopolies, the latter view is the more correct. See *Jupe* v. *Pratt* (1837), W. P. C. 145, 151.

(*d*) See *Vidal Dyes Syndicate* v. *Levinstein*, 29 R. P. C., *per* MOULTON, L.J., at p. 254, C. A.

(*e*) For examples of such evidence, see *Moss* v. *Malins*, 3 R. P. C. 378; *Cole* v. *Saqui*, 5 R. P. C. 495.

In considering such evidence the object of the patent must be remembered, *e.g.* in the case of a patent intended to be worked on a large scale, laboratory experiments may not be sufficient to prove utility. See *Patterson* v. *Gas Light and Coke Coy.* (1875), 2 Ch. D. 812, 834; *Kurtz* v. *Spence*, 5 R. P. C. 161; *Pilkington* v. *Massey*, 21 R. P. C. 697, C. A.; *Badische, &c.* v. *Levinstein*, 4 R. P. C. 449, H. L.; *Wilson* v. *Union Oil Mills*, 9 R. P. C. 57.

It is not necessary that all forms should have been made; evidence may be given that they would work if made. *Neilson* v. *Harford* (1841), W. P. C., at p. 316.

(*f*) Of course it must be shown that the article sold is in substance that specified (see *Lambert* v. *International Phonograph Coy.*, 21 R. P. C. at p. 257), though detail variations do not affect this evidence of utility: *British Westinghouse Coy.* v. *Braulik*, 27 R. P. C. 209, 227, C. A. The vidence should also show that this increased demand was occasioned by the patented improvement: *Cole* v. *Saqui*, 6 R. P. C. 41, C. A.

(*g*) *Fawcett* v. *Homan*, 13 R. P. C. 398, C. A.; *Ward Brothers* v. *Hill*, 20 R. P. C. 189, 200; *Lucas* v. *Miller*, 2 R. P. C. 155, 160; *Miller* v. *Searle, Baker & Coy.*, 106, 111; *Pilkington* v. *Massey*, 21 R. P. C. 421.

But of course it must be shown that the machine used by the defendant is substantially identical with the patented machine in respect of the features whose utility is in question. See *per* Lord BLACKBURN in *Clark* v.

The fact of the public not having used the invention or even of the patentee not having done so is little, if any, evidence of lack of utility (*h*), especially if there are circumstances to explain the non-user such as that other and more useful forms were also shown in the specification, or that further improvements had been made in the class of machine or process soon after the date of the patent (*i*).

Issues of sufficiency and utility.

As is stated in the chapter on Sufficiency the issues of sufficiency and utility are often hardly distinguishable (*k*). It has been said that on the issue of utility sufficiency and novelty ought to be assumed (*l*).

Adie (1873), 2 A. C. 315, 337. See also *Lambert* v. *International Phonograph Indestructible Record Coy., Ltd.*, 21 R. P. C. 247; *Winby* v. *Manchester Steam Carriage Co.*, *ubi supra*.

(*h*) *Fawcett* v. *Homan*, 13 R. P. C. 398, C. A.; *Otto* v. *Linford*, 46 L. T. (N. S.) 35, and *Raynor* v. *Livingstone* there quoted; *Edison and Swan Coy.* v. *Holland*, 6 R. P. C. 243, 283, C. A.

(*i*) *Thomson* v. *Batty*, 6 R. P. C. 84, 100; *Lane-Fox* v. *Kensington Electric Lighting Coy.*, 9 R. P. C. 413, C. A.

(*k*) See *per* Lord LINDLEY in *Wilson Brothers Bobbin Coy., Ltd.* v. *Wilson & Coy., Ltd.*, 20 R. P. C. 1, 14, H. L., and *Vidal Dyes Syndicate* v. *Levinstein*, 29 R. P. C. 245, 254, C. A.

On the other hand, Lord LINDLEY seemed to distinguish these issues in *Hattersley* v. *Hodgson*, 23 R. P. C. 193, H. L.; see also *Badische, etc.* v. *Société des Usines du Rhone*, 14 R. P. C. 875, C. A. In *Presto Coat Collar Coy.* v. *Levy Brothers*, 28 R. P. C. 363, C. A., it was said that the issue of non-utility was a particular case of the issue of insufficiency.

(*l*) *Philpott* v. *Hanbury*, 2 R. P. C. 33.

CHAPTER VI

SUFFICIENCY

Obligations on patentee.

THE Patent Act imposes on a patentee the duty of sufficiently describing in his complete specification the nature of his invention and the manner in which it is to be performed (*a*). These two requirements are quite distinct in their nature. The first relates to the proper limitation of the grant, which is really for the protection of the patentee. The second relates to that disclosure of the new manufacture which is a part of the consideration for the grant, the object being that the public may obtain the full advantages of the patented invention (*b*). Objections under both these heads must be considered under the title of sufficiency.

How far he must distinguish what is new from what is old.

The first objection was formerly frequently pleaded under the form that the specification did not sufficiently distinguish what was new from what was old, and was held to be fatal to the patent in a number of cases. These cases depended to a large extent on the old method of drawing specifications and to a rule as to their construction which no longer holds good (*c*), viz. that anything described in the specification which was not stated to be old was considered to be claimed as new (*d*). With the modern system of definite claiming clauses this rule ceased to be applicable, and the judgment of the House of Lords in *Harrison* v. *Anderston Foundry Company* really marked a new era in patent construction by stating the rule that what is not claimed is held to be disclaimed, and that where a combination is claimed the claim is only for the whole combination and not for

(*a*) Sect. 2 (2).

(*b*) See *Vidal Dyes Syndicate, Ltd.* v. *Levinstein*, 29 R. P. C., at p. 541; *Hookham* v. *Johnson*, 14 R. P. C. 563.

(*c*) For a full discussion of the whole question see the judgments of the C. A. in *British United Shoe Machinery Coy.* v. *Fussell*, 25 R. P. C. 631.

(*d*) See CONSTRUCTION, p. 119.

each of its separate parts; and that it is therefore unnecessary to say which of such parts are new and which are old (*e*).

This objection as now understood would probably be better expressed by saying that the patentee in the specification does not describe with certainty what the monopoly claimed really is. The claim should enable the skilled reader of the specification to know what he might do or might not do without infringing the patent (*f*), and should be definitely limited to something which is novel and useful. It is really in this sense that the objection has been upheld in a recent case (*g*). If a specification either by the description or the claiming clauses clearly shows that the invention is either confined to a combination of elements, such combination being in itself new, or that it is confined to an apparatus or process, which must include an element which is in fact new, it would seem, according to modern cases, to fulfil the requirements to which this objection relates (*h*). "The patentee must distinguish what is new from what is old *by* his claim; he need not distinguish what is new from what is old *in* his claim" (*i*).

If the monopoly is thus clearly and properly defined, so that it is clear of what elements that for which the monopoly is claimed consists, the claim is sufficient, and it is not necessary for the patentee to indicate whether the patentability resides in the combination of the parts or in an element which in itself

(*e*) *Harrison* v. *Anderston Foundry Coy.* (1876), L. R. 1 A. C. 574; overruling *Foxwell* v. *Bostock* (1864), 4 De J. & S. 298. *Foxwell* v. *Bostock* was quoted with approval by HALSBURY, L.C., in *Webb* v. *Kynoch*, 17 R. P. C. 100, but apparently in a limited sense, and has been also followed in *Rowcliffe* v. *Morris*, 3 R. P. C. 17; *Rickerby* v. *Duncan* (*James*) *& Coy.*, 25 R. P. C. 248; and *Leggott* v. *McGeoch*, 10 R. P. C. 429. The latter case can hardly be reconciled with the authorities given above. *Harrison* v. *Anderston Foundry Coy.* was followed on this point in *Moore* v. *Bennett*, 1 R. P. C. 129, 153, H. L.; *Proctor* v. *Bennis*, 4 R. P. C. 363, C. A.; *Perry* v. *La Société de Lunetiers*, 13 R. P. C. 664; *Hookham* v. *Johnson*, 14 R. P. C. 525, 558; *Patent Exploitation Coy.* v. *Siemens Brothers & Coy., Ltd.*, 21 R. P. C. 541, H. L.; *British United Shoe Machinery* v. *Thompson*, 22 R. P. C. 177; *British United Shoe Machinery* v. *Fussell*, 25 R. P. C. 631, C. A.; *Lynch* v. *Philips*, 26 R. P. C. 389, I. H.; *International Harvester Coy.* v. *Peacock*, 25 R. P. C. 763.

(*f*) *British United Shoe Machinery* v. *Thompson*, *supra*; *British United Shoe Machinery* v. *Fussell*, *supra*. See also *Clarke* v. *Adie* (1877), 2 A. C. 315; *Rowcliffe* v. *Morris*, 3 R. P. C. 17; *Morton* v. *Middleton* (1863), 3 S. I. 721.

(*g*) *Kynoch & Coy., Ltd.* v. *Webb*, 17 R. P. C. 100, explained in *British United Shoe Machinery Coy.* v. *Fussell*, 25 R. P. C. 631, 656, C. A.; and in *Beston* v. *Watts*, 24 R. P. C. 219, 228. See also *Cartsburn Sugar Refining Coy.* v. *Sharp*, 1 R. P. C. 181; *Philpott* v. *Hanbury*, 2 R. P. C. 153.

(*h*) *British United Shoe Machinery* v. *Fussell*, *supra*.

(*i*) *Ibid.*, *per* FLETCHER MOULTON, L.J., at p. 651.

is new (*k*). The early decisions as to a patent for an improvement in an old machine being bad, if the whole machine is claimed instead of the specific improvement, are not applicable to patents drawn on the modern system (*l*).

At present, therefore, the objection that the invention is not sufficiently defined would rarely succeed unless the objections of want of novelty or utility would, though there might be cases, *e.g.*, where the claim is unintelligible, where insufficiency would be the proper form of objection (*m*).

Specification must not be ambiguous.

If, however, the specification is ambiguous or misleading, so that it is not made reasonably clear what is covered by the grant, it is insufficient (*n*). For example, if the claim for a combination, where the invention really lies in the presence of something which is new in itself, is so drawn that it would appear that mechanical equivalents could be used for various parts, including the new element, the claim would be bad (*o*).

Greater distinctness necessary where invention small.

Although the above rules are general, there is no doubt that greater distinctness of claim is generally requisite when the invention is a small one and confined to a few parts of a machine or process whose description involves a reference to many other parts (*p*). Of course the question of whether the monopoly is properly defined may depend upon the step in advance in fact made by the patentee (*q*).

It is sufficient if the specification as a whole is clear.

It is not necessary for the validity of a patent that this differentiation should be contained in the claim alone, or indeed that there should be a claim at all. It is sufficient if it appear from the claim read with the body of the specification what the patentee claims as his invention (*r*). Nor is it a valid

(*k*) *British United Shoe Machinery* v. *Fussell, supra.*

(*l*) *E.g. Foxwell* v. *Bostock* (1864), 4 De G. & S. 298, see p. 86, note (*e*).

(*m*) *British Ore Concentration Syndicate, Ltd.* v. *Minerals Separation, Ltd.*, 27 R. P. C. 33, H. L., *per* LORD HALSBURY, at p. 47; *Linotype & Machinery, Ltd.* v. *Hopkins*, 27 R. P. C. 109, H. L., *per* LOREBURN, L.C., at p. 112; *British Vacuum Cleaner Coy., Ltd.* v. *L. & S. W. R. Coy.*, 29 R. P. C., *per* LORD LOREBURN, at p. 320. See also *Tubes Ltd.* v. *Perfecta Seamless Steel Tube Coy., Ltd.*, 20 R. P. C., *per* LORD DAVEY, at pp. 101–103; *Glover & Coy., Ltd.* v. *American Steel & Wire Coy.*, 19 R. P. C. 109.

(*n*) *Campion* v. *Benyon* (1821), 6 B. Moo. (O. S.) 71; *Hastings* v. *Brown* (1853), 22 L. J. (Q. B.) 161. See also *Parkes* v. *Stevens* (1869), L. R. 8 Eq. 358, 365.

(*o*) *Cf. Cartsburn* v. *Sharp*, 1 R. P. C. 185.

(*p*) *Kynoch* v. *Webb*, 15 R. P. C., *per* FITZGIBBON, L.J., at p. 558, approved by HALSBURY, L.C., at 17 R. P. C., p. 107. See also *Beston* v. *Watts*, 24 R. P. C. 219, 228.

(*q*) *Patent Type Foundry Coy.* v. *Richards* (1860), 1 Johns. 381.

(*r*) *Siddell* v. *Vickers*, 7 R. P. C. 292, H. L.; *Tubes, Ltd.* v. *Perfecta Seamless Steel Tube Coy., Ltd.*, 20 R. P. C. 77, H. L. See also *Nordenfeldt* v. *Gardner*, 1 R. P. C. 61, C. A.;

objection that the description of the invention is not distinct from the description of the manner in which it is to be performed (*s*). It would seem, however, that the provisional specification cannot be used to supplement deficiencies in description in the complete (*t*).

The drawings are also part of the specification (*u*), and apparently an improvement may be sufficiently claimed though it only appears from the drawings and is not referred to as an improvement in the letterpress (*x*), though in other cases it has been pointed out that drawings alone cannot define the limits of the monopoly claimed (*y*).

Claim must be confined to what is useful.

Since a valid patent can only be granted for an invention which is both new and useful it is essential that the claim should be confined not only to what is new, but also to what is useful, and if this is not so the patent is bad for insufficiency (*z*). Thus, if a class of material or apparatus be named, and only some members of this class be useful, the patent is bad unless the general knowledge in the trade would enable competent workmen to know which would be useful and which would not (*a*). The insufficiency in this case may be looked on as insufficiency in defining the invention, or in describing the manner in which it is to be performed, and is conveniently treated under the latter head.

Test for sufficiency of directions.

In deciding whether the patentee has sufficiently described the manner in which the invention is to be performed the main rule is that it is essential that such directions be given that a competent workman endowed with the trade knowledge of the date of the grant (*b*) should know the necessary and appropriate

Thomas v. *Welch* (1866), L. R. 1 C. P. 192; *Parkes* v. *Stevens* (1869), L. R. 8 Eq. 358, 5 Ch. App. 36.

(*s*) *Penn* v. *Jack* (1866), 14 L. T. 95.

(*t*) *MacKelcan* v. *Rennie* (1862), 13 C. B. (N. S.) 52.

(*u*) Sect. 2 (3).

(*x*) *Hattersley* v. *Hodgson*, 23 R. P. C. 193, H. L.

(*y*) *Gillies* v. *Dunbar* (1877), 4 S. V. 337, I. H.; *Macfarlane* v. *Price* (1818), 1 Stark. 199; *Kopp* v. *Rosenwald*, 20 R. P. C. 154, C. A.; *Robertson* v. *Purdey*, 24 R. P. C., at p. 297; *Tolson* v. *Speight*, 13 R. P. C., at p. 722.

(*z*) *Hill* v. *Thompson & Forman* (1817), W. P. C. 237; *United Horse-nail Machinery Coy.* v. *Stewart*, 2 R. P. C. 132, O. H.

The fact that a patentee expresses a preference for certain methods does not prevent the specification being insufficient if other methods covered by it are old. *European Eibel Coy.* v. *Lloyd (Edward) & Coy., Ltd.*, 28 R. P. C. 349; or not useful, *Simpson* v. *Holliday* (1866), L. R. 1 H. L. 315; *Kurtz* v. *Spence*, 5 R. P. C. 161, 182; *cf.*, however, *Watson Laidlaw & Coy.* v. *Potts Cassel & Williamson*, p. 92, *n.* (*p*).

(*a*) See p. 91, *n.* (*o*).

(*b*) *Z. Electric Lamp Coy.* v. *Marples*, 27 R. P. C. 737, 745, C. A.; *Incandescent Gas Lighting Coy.* v. *De Mare Incandescent System*, 13

materials, apparatus, and conditions for successfully carrying out the invention (*c*). The patentee need not include directions to matters which such a workman should have known at the date of the grant (*d*), but he cannot call in aid matters not known at that date (*e*).

Workman skilled in the art.

The expression "workman skilled in the art" must be interpreted to some extent differently for different classes of patents, according to the class of person who will really have to apply the knowledge such workman is deemed to possess. For example, in the case of patents for the production of synthetic dyes, or for other highly technical objects, the description would probably be considered sufficient if it would enable the ordinary manager of a factory to give proper directions to the workmen, and it would not be necessary to include directions as to matters of practice with which he would be well acquainted, but which possibly inferior workmen would not know (*f*). On the other hand, the directions for carrying out some small improvement should be such as to enable the ordinary workman to understand them without further explanation (*g*).

R. P. C. 301, 320; *Tiemann's Patent*, 16 R. P. C. 575.

(*c*) *Vidal Dye Syndicate, Ltd.* v. *Levinstein*, 29 R. P. C. 245, C. A.; *British Dynamite Coy.* v. *Krebs* (1879), 13 R. P. C. 192; *Badische Anilin und Soda Fabrik* v. *Levinstein*, 4 R. P. C. 449, H. L.; *Edison & Swan Coy.* v. *Holland*, 6 R. P. C. 243, 280, C. A.; *Lane-Fox* v. *Kensington Electric Lighting Coy.*, 9 R. P. C. 413, 417, C. A.; *Sirdar Rubber Coy., Ltd.* v. *Wallington Weston & Coy.*, 23 R. P. C. 132, C. A.; *Incandescent Gas Light Coy.* v. *De Mare Incandescent Gas Light System*, 13 R. P. C. 301; *Nicholls* v. *Kershaw*, 27 R. P. C. 237, 250; *Arkwright's Patent* (1785), W. P. C. 66. See also *Hornblower* v. *Boulton* (1799), 8 T. R. 95; *Gibson* v. *Campbell* (1841), W. P. C. 627; *Bloxam* v. *Elsee* (1827), 6 B. & C. 169. And cases at p. 161, *n.* (*a*).

(*d*) *Hopkinson* v. *St. James's Electric Light Coy.*, 10 R. P. C. 46, 61; *Edison Bell Phonograph Corporation* v. *Smith*, 11 R. P. C. 389, 403, C. A.

(*e*) *Lane-Fox* v. *Kensington Electric Lighting Coy.*, 9 R. P. C. 248, 417, C. A.; *Robertson* v. *Purdey*, 24 R. P. C. 273, 292. See also p. 92, *n.* (*p*).

(*f*) *Badische, &c.* v. *Levinstein*, *ubi supra*; *Incandescent Gas Light Coy.* v. *De Mare Incandescent Gas Light System*, 13 R. P. C. 301, 327; *Tiemann's Patent*, 16 R. P. C. 561, 574, 575. See also *Neilson* v. *Harford* (1841), W. P. C. 314; *Edison* v. *Holland*, 6 R. P. C. 280.

(*g*) *Plimpton* v. *Malcolmson* (1876), 3 Ch. D. 536, 568, and cases at p. 90, *n.* (*e*).

The class of workman to be considered is that who would carry out the invention, *e.g.* in the case of a patent for electric lamps lampmakers, not chemists. *Z. Electric Lamp Coy.* v. *Marples*, 27 R. P. C. 305, 737, C. A. See also *Osram Lamp Works* v. *Z. Electric Lamp Coy.*, 29 R. P. C. 424.

The fact that persons not skilled in the trade occasionally work at some branches of it does not make them "workmen skilled in the art" for this purpose. Thus, where the directions given in a patent for making golf balls were sufficient for a man skilled in working gutta-percha, but not for golf professionals, who, in fact, often mould or remake balls, the specification was held sufficient. *Haskell Golf Ball Coy., Ltd.* v. *Hutchinson*, 22 R. P. C. 478, 493.

Experiment should be unnecessary.

Generally the description is insufficient if it renders it necessary for the person who attempts to carry it out to make a series of experiments in order to see how the invention can be performed or to get any beneficial effect at all (*h*). But this rule must be reasonably interpreted in view of the particular subject-matter of the patent, and it is recognised that it may often be necessary, even if the description be sufficient, to make a certain number of trials to ascertain the best working conditions, or arrive at a successful result (*i*). This especially applies to patents, such as chemical patents, where a large number of different bodies may have to be dealt with, or where the conditions or the results sought vary largely (*k*). On the other hand, if the invention is for some small detail the description should be such that this is unnecessary (*l*), and the need for such trials should in all cases be reduced to a minimum. Further, the patentee must show that the competent workman should know what trials to make and how to perform them (*m*). Subject to this limitation the directions must be sufficient to enable the invention to be applied in all cases within the ambit of the patent, and if special directions are necessary for its due execution in particular cases these must be given (*n*).

(*h*) *Sirdar Rubber Coy., Ltd.* v. *Wallington Weston & Coy.*, 23 R. P. C. 132, 138, C. A. See also *R.* v. *Arkwright* (1785), W. P. C. 66; *R.* v. *Wheeler* (1819), 2 B. & Ald. 345; *Morgan* v. *Seward* (1837), 2 M. & W. 544; *Bailey* v. *Roberton* (1878), L. R. 3 A. C. 1055, H. L.; *United Horseshoe and Nail Coy.* v. *Stewart*, 2 R. P. C. 132, O. H.; *Pooley* v. *Pointon*, 2 R. P. C. 167; *Lane-Fox* v. *Kensington & Knightsbridge Electric Lighting Coy.*, 9 R. P. C. 221, 248, and 413, C. A.; *Hookham* v. *Johnson*, 14 R. P. C. 525, 563; *Kinmond* v. *Keay*, 20 R. P. C. 497, I. H.

(*i*) *Edison & Swan Coy.* v. *Holland*, 6 R. P. C. 243, 282, C. A.; *Leonhardt* v. *Kalle*, 12 R. P. C. 103, 116. See also *British Dynamite Coy.* v. *Krebs* (1879), 13 R. P. C. 190, H. L.; *Neilson* v. *Harford* (1841), W. P. C. 320; *Beard* v. *Egerton* (1846), 8 C. B. 165.

A very wide interpretation has been given to this by the judgment of the I. H. in *Watson Laidlaw & Coy., Ltd.* v. *Potts Cassel and Williamson*, 27 R. P. C. 541. On appeal the H. L. were equally divided, see 28 R. P. C. 565.

(*k*) In some cases even a specification may be sufficient if it indicates a class of bodies, and experiments are necessary, although the general limits of the class are known, in the case of a few bodies to ascertain whether they come within this class. *Thermit, Ltd.* v. *Weldite, Ltd.*, 24 R. P. C. 441, 461, see p. 92, *n.* (*o*).

(*l*) *Hinks* v. *Safety Lighting Coy.* (1876), 4 Ch. D. 607, 617; *Fletcher* v. *Arden*, 5 R. P. C. 46; *Kinmond* v. *Keay*, *supra*.

(*m*) *E.g.* patent for making puttees of material cut on a curve to fit the leg held good, although only one example was given and the shape would necessarily have to be altered for each individual case. *Fox* v. *Astrachans, Ltd.*, 27 R. P. C. 377, and see also cases at p. 95, *n.* (*z*).

(*n*) In the case of a patent for a machine for giving an edge to knives, scissors, and other cutting instruments, the specification described the use of two circular files of steel, but said that other rollers might be used according to the delicacy of edge required. It was shown that for scissors one circular file and one

If the patentee mentions a class of bodies as coming within the ambit of his patent or as suitable for use in carrying it out and some of such bodies are not suitable, the patent is bad for insufficiency unless either there is some indication given which would lead to the workman rejecting the unsuitable bodies, or a competent workman would have the knowledge necessary to enable him to select those bodies which were suitable (*o*). Again, if a patent is said to be applicable for a

Limits of usefulness should be defined.

smooth roller must be employed unless the rollers were made of Turkey stone. The patent was held bad for insufficiency, there being no direction as to making the rollers for scissors. *Felton* v. *Greaves* (1829), 3 Car. & P. 611.

In the case of a patent for the production of dyes the patentee specified four bodies which were to be treated with sulphur. With regard to one of these bodies it was found that the directions as to heating, etc., given for bodies generally were not sufficient to enable the result to be arrived at. In the case of another it was found that only one of two alternative methods would be effective. The patent was held bad on both grounds. *Vidal Dyes Syndicate* v. *Levinstein*, 29 R. P. C. 245, C. A. See also *Arkwright's Patent* (1785), W. P. C. 69; *Morgan* v. *Seward* (1837), W. P. C. 184; *Maxim-Nordenfeldt Coy.* v. *Anderson*, 14 R. P. C. 371, 385; 671, C. A.; 15 R. P. C. 421, H. L.; *Tiemann's Patent*, 16 R. P. C. 575; *Kopp* v. *Rosenwald*, 20 R. P. C. 154, C. A.; *Carnegie* v. *Bell Brothers, Ltd.*, 26 R. P. C. 265; *United Horsenail Machinery Coy.* v. *Stewart*, 2 R. P. C. 132, O. H.; *Ellington* v. *Clark*, 5 R. P. C. 319, 337, C. A.; but *cf.* *Watson Laidlaw & Coy., Ltd.* v. *Potts Cassel and Williamson*, p. 92, *n.* (*p*).

(*o*) The following are examples of insufficient directions:—

Where a specification gave a direction to take "fossil salt" and it was objected that there was only one "fossil salt" that would do, it was held that if this were so the patent would be bad. (The patent was upheld on a new trial.) *Turner* v. *Winter* (1787), W. P. C. 77.

Where a patent was taken out for making belts from "hard woven" cotton canvas, and it was shown that ten qualities of this were known in the trade, of which only three were suitable for the purposes of the invention, and no evidence was given that a workman would know which to use, the patent was held bad for insufficiency. *Gandy* v. *Reddaway*, 2 R. P. C. 49.

Where the specification of a patent for inserting rings into bobbins did not define the wood of which the bobbins were to be made, the Court was of opinion that the patent must be held to extend to all woods of which bobbins were ordinarily made, and that as the process would not work with hard wood bobbins, the patent was bad for want of utility. *Wilson Brothers Bobbin Coy., Ltd.* v. *Wilson & Coy.* (*Barnsley*), *Ltd.*, 20 R. P. C. 1 H. L.

(This decision was in form on utility, but the issues of utility and insufficiency often run together, see *per* Lord DAVEY, at 20 R. P. C. 14.)

Where the specification of a patent for making rollers for grinding corn said that the patentee "preferred china" for making them, and it was proved that nothing else would do, it was held that the patent was bad. *Wegman* v. *Corkran*, 13 Ch. D. 65, C. A.; but *cf.* *Brown's Patent*, 24 R. P. C. 313, C. A. See also *Crompton* v. *Ibbetson*, p. 96, *n.* (*f*); *Stevens* v. *Keating* (1847), 2 W. P. C. 175, 183; *European Eibel Coy.* v. *Lloyd*, 28 R. P. C. 349.

The following are examples of directions which have been held sufficient:—

Where a patentee spoke of "gunpowder or other proper combustible," this was held sufficient, the evidence being that a workman would know which he could use. *Bickford* v. *Skewes* (1841), W. P. C. 214.

Where a specification for improvements in wet spinning spoke of "flax and like yarns," this was held sufficient, since the process was

number of purposes or if it is said that a class of processes can be used in connection with the patent, a similar rule would apply (*p*).

applicable to any yarns usually spun wet. *Pirrie* v. *York Street Flax Spinning Coy.*, 11 R. P. C. 429, C. A. Ir.

Where a specification contained a direction to use reducing agents, and a number of examples were given, it was held that the patentee was not bound to give an exhaustive list, or to state which gave better and which gave worse results. *Leonhardt* v. *Kallé*, 12 R. P. C. 103.

Where a specification for an improved wire mattress, made so as to be under a diagonal strain, described fully one arrangement with a proper mesh, and then said that other meshes might be used, it was held that the specification was sufficient since it clearly only included meshes capable of taking a diagonal strain, and a competent workman would know which these were. *Evans* v. *Hoskins*, 24 R. P. C. 517, C. A.

Where the specification of a patent for a method of reducing metals and making alloys by the use of aluminium gave certain examples and then continued, "In the same manner all the metals or their alloys mentioned in the first part of the specification can be gained," and there was, in fact, no limitation of the metals given in the specification, and the process did not work with many metals, it was held that the specification clearly only dealt with metals reducible by aluminium, and that it was well known to chemists which these were, though a few experiments might have to be made with metals on the border line, and that the specification was sufficient. *Thermit, Ltd.* v. *Weldite, Ltd.*, *ubi supra*. See also *British Ore Concentration Syndicate* v. *Minerals Separation Coy.*, 26 R. P. C. 124, 140, C. A., but *cf.* same case in H. L., 27 R. P. C. 33; *British Dynamite Coy.* v. *Krebs* (1879), 13 R. P. C. 190, H. L.; *Gaulard and Gibbs' Patent*, 6 R. P. C. 215, 224, C. A.; *cf. contra*, *Stevens* v. *Keating* (1847), 2 W. P. C. 175, 183; *Ralston* v. *Smith* (1865), 11 H. L. C. 223; *Flour Oxidising Coy., Ltd.* v. *Hutchinson*, 26 R. P. C. 597.

If the directions were sufficient in the state of the art at the date of the grant, the sufficiency is not affected by the fact that at a later date other materials came into use in the art. A patentee need not have "the spirit of prophecy." *Clegg's Patent* (1829), W. P. C. 103; *Incandescent Gas Light Coy.* v. *De Mare Incandescent Gas Light System*, 13 R. P. C. 559, C. A.

(*p*) The following are examples of insufficient directions of this nature:—

Where a specification gave a direction to perform a certain chemical operation in an autoclave, it was proved that there were two types of autoclaves in use, viz. iron and enamelled autoclaves, and that the action only took place successfully in an iron autoclave, the iron, in fact, taking part in the reaction. The distinction was not indicated in the specification (or known to the inventor) and the patent was held bad for insufficiency. *Badische* v. *La Société des Usines de Rhone*, 15 R. P. C. 359, C. A.

Where a specification described two processes and said that one was the more speedy and effective, and it was proved that, in fact, the other would not work at all, the patent was bad for insufficiency. *Simpson* v. *Holliday* (1866), L. R. 1 H. L. 315. See also *per* WESTBURY, L.C., 12 L. T., at p. 99; *Vidal Dye Syndicate* v. *Levinstein*, p. 91, *n.* (*n*); *cf.* also *Ellington* v. *Clark*, 5 R. P. C. 327, C. A.

In the following case this principle was held not to apply.

In the case of a patent for a centrifugal drier, in which the old practice had been to put a shaft in a very flat conical bearing with an angle of about 51° to 60°, the inventor in a disclaiming note said that his bearings were to have the shape of a cone approaching much more nearly to a cylinder than in the former practice. The drawings in his specification showed angles of 25° to 40°. In practice the patentee used 10°, and it was admitted by his witnesses that 5° to 25° were the useful limits (28 R. P. C. 575, but see *contra*, 27 R. P. C. 562). Held by the I.H. that the patent was good. The exact angle formed no part of the

The Courts, however, are not anxious, if a specification is fairly drawn, to find it bad for insufficiency because it does not deal with exceptional and out-of-the-way cases (*q*), or because some rare or special material, which a workman would not be likely to choose (*r*), might come within the words of the specification and will not act, or because the words do not exclude some mistake which the competent workman should not make (*s*).

Fuller directions needed where there is large change in practice.

Where a patent introduces a great change from the old practice of the trade, it is not proper for the patentee to leave out working directions and say that they may be supplied from the old practice, since a workman reading the patent would not in general know which parts of such practice were applicable (*t*).

invention, and must be varied according to the special object and could be determined by experiment. On appeal to the House of Lords the House was equally divided (*Watson, Laidlaw & Coy.* v. *Potts, Cassel, and Williamson*, 25 R. P. C. 337; 27 R. P. C. 541, I.H.; 28 R. P. C. 565, H.L.).

(*q*) *Morgan* v. *Seaward* (1837), W. P. C., at p. 180.

(*r*) Thus, where a direction was given to use "carbon gas" and "carbonic gas" in making lamp filaments, and it was objected that the term would include CO and CO_2 which would be useless, the patent was upheld, the Court being satisfied on the evidence that no competent man would think of using these. *Edison and Swan Coy.* v. *Woodhouse* (2nd action), 4 R. P. C. 99, C. A.; *Same* v. *Holland*, 6 R. P. C. 243, C. A. See also *Stevens* v. *Keating* (1847), 2 W. P. C. 175, 183; *Thermit* v. *Weldite, supra*; *Flour Oxidising Coy., Ltd.* v. *Hutchinson*, 26 R. P. C. 597, 626.

(*s*) Thus where a direction was given to use two nuts on a screw so that one might be sure of catching, the Court refused to hold the specification bad because it did not guard against the chance of a workman choosing nuts of different pitches. *Edison Bell Phonograph Corporation* v. *Smith*, 11 R. P. C. 389, C. A. See also *Beard* v. *Egerton* (1848), 8 C. B. 165; *Farbenfabriken &c.* v. *Bowker*, 8 R. P. C. 389; *Hopkinson* v. *St. James' Electric Light Coy.*, 10 R. P. C. 46, 61.

In *Z. Electric Lamp Coy.* v. *Marples*, 27 R. P. C. 305, 316, and 737, C. A., it was held that where a passage *might* lead a workman to adopt a certain unsuitable substitute, the fact that he would necessarily have to make a preliminary analysis which would show him his error, prevented the specification from being misleading.

(*t*) Thus where in a patent for a new form of motor tyre the inventor stated that the former idea that there must be a tight fit between every part of the tyre and rim that came into contact was wrong, and it was proved that it was necessary to have a certain portion (the base) of the tyre made convex so as to give a tight fit, and there was no direction as to this, it was held that the patent was bad for insufficiency, although it had been the former practice to make the base of the tyre in this way. *Sirdar Rubber Coy., Ltd.* v. *Wallington Weston & Coy.*, 23 R. P. C. 132, 140, C. A. See also *Bailey* v. *Roberton* (1878), 4 S. IV. pp. 559–560, approved by Lord BLACKBURN, 3 A. C. 1080; *Maxim-Nordenfeldt Coy., Ltd.* v. *Anderson*, 14 R. P. C. 671, 683, C. A.; *Kinmond* v. *Keay*, 20 R. P. C. 493.

It is also more necessary to give full instructions when the subject-matter of a patent is a dangerous substance, and a workman would therefore be afraid to make variations. *Maxim-Nordenfeldt Coy., Ltd.* v. *Anderson*, 671, 683, C. A.

Necessary directions.

The directions given must also include a description of how to prepare the materials necessary for carrying out the invention unless these are articles known and procurable in this country (*u*), or as to whose preparation directions are given in recognised text-books (*x*), in which case it is sufficient to state their ordinary name. Any direction which makes the obtaining or preparing of such materials unnecessarily complicated may render the patent bad (*y*).

Proportions and similar details also should be given where they are necessary for the proper working of the invention. But many patents are for general processes for mixing or employing two substances, and are in no way

(*u*) The following are examples of this :—

Where in a specification a direction was given to use "the finest and purest chemical white lead," it was proved that no white lead sold by chemists in this country would do, but there was a special quality made in Germany which had to be used. Lord LYNDHURST was of opinion that the patent was bad for insufficiency. *Sturz* v. *De la Rue* (1828), 5 Russ. 322.

Where a patentee directed that certain rollers should be covered with china, and it was proved that no china ordinarily made in this country would do, the patent was held bad. *Wegman* v. *Corkran* (1879), 13 Ch. D. 65, C. A.

Where in a specification a direction was given that certain bituminous schistus should be freed from iron, but the method was not shown, the patent was held bad since it did not appear either that the method of separating the iron was well known, or that bituminous schistus free from iron was procurable in this country except from the patentee. *Derosne* v. *Faric* (1835), 2 Cr. M. & R. 476.

The following are examples of cases where special directions were held to be unnecessary :—

Where a direction was given to use nitrogen gas, it was held that it was unnecessary to describe its preparation since this was well known. *Edison* v. *Woodhouse* (2nd action), *ubi supra* ; *Edison* v. *Holland*, *ubi supra*.

Where a patent involved the use of transformers it was held that it was unnecessary to describe their construction, this being well known. *Gaulard and Gibbs' Patent*, 7 R. P. C. 367, H. L.

Where a patent was taken out for making lithographic stones, BRISTOWE, V.C., was of opinion that the patentee was not bound to give directions as to the method of using them for obtaining transfers, although special means were necessary. (This seems a doubtful decision.) *Coles* v. *Bayliss*, 3 R. P. C. 178. See also *Badische, &c.* v. *Levinstein*, 6 R. P. C. 387, H. L. ; *Gill* v. *Coutts*, 13 R. P. C. 125, 138, 1. H.

(*x*) *Z Electric Lamp Coy.* v. *Marples*, 27 R. P. C. 318. It should be noted that it was also found that the substance here in question was sold commercially at the date of the patent, and in the C. A. the judgment seems to have been based solely on the latter ground. See 27 R. P. C. 744.

There may be certain highly scientific branches of trade where the literature consists of patent specifications. *Vidal Dye Syndicate, Ltd.* v. *Levinstein*, 29 R. P. C. 260, C. A.

(*y*) Thus, where in a patent for making seidlitz powders the specifications gave recipes for making three substances to be mixed to form the final substance, but did not disclose that these three substances were respectively Rochelle salt, carbonate of soda, and tartaric acid, all of which were readily procurable upon the market, the patent was held bad. *Savory* v. *Price* (1823), 1 Ry. & M. 1.

confined to the proportions. In such cases the proportions need not be given, or at any rate may be indicated very broadly (*z*).

It is not necessary for the patentee to deal with matters of scientific theory or give particulars of merely scientific interest (*a*), nor need the patentee of a process producing various substances give their composition or even point out which are commercially useful (*b*). Again, the patentee is not bound to point out the advantages secured by his invention or from which part of it they proceed (*c*), or to go into questions

What need not be stated.

(*z*) *Betts* v. *Menzies* (1862), 10 H. L. C. 117; *Betts* v. *Neilson* (1871), L. R. 5 H. L. 1; *Patent Type Foundry Coy.* v. *Richards* (1860), 1 Johns 381; *Muntz* v. *Foster* (1844), 2 W. P. C. 93; *British Ore Concentration Syndicate, Ltd.* v. *Minerals Separation Coy.*, 26 R. P. C. 124, 139, C. A., but see same case in H. L. 27 R. P. C. 33.

For cases where it has been held that instructions were sufficient see, in addition to cases given above, *British Dynamite Coy.* v. *Krebs* (1879), 13 R. P. C. 190, H. L.; *Leonhardt* v. *Kalle*, 12 R. P. C. 103; *Incandescent Gas Lighting Coy.* v. *De Mare Incandescent System*, 13 R. P. C. 301 & 559, C. A.; *Scotts' Patent*, 19 R. P. C. 273. See also *R.* v. *Wheeler* (1819), 2 B. & Ald. 345.

Further directions as to heating, etc. were considered necessary in *Turner* v. *Winter* (1787), W. P. C. 77. (It appears the patent was upheld on the new trial, see p. 82), as to switching off cells in *Lane-Fox* v. *Kensington Electric Lighting Coy.*, 9 R. P. C. 221, 248, and 413, 417, C. A.; as to timing operations and fixing a bracket in *Kinmond* v. *Keay*, 20 R. P. C. 498, O. H.; as to methods for excluding light from camera in *Nicholls* v. *Kershaw*, 27 R. P. C. 237, 250.

Further directions as to heating and proportions, and as to meaning in a particular reaction of "reduction" were considered necessary in *Vidal Dye Syndicate, Ltd.* v. *Levinstein*, 29 R. P. C. 245, C. A.

For other cases see *Maxim-Nordenfeldt Coy., Ltd.* v. *Anderson*, 14 R. P. C. 371, 384 and 671, 683, C. A.; *Carnegie* v. *Bell Brothers, Ltd.*, 26 R. P. C. 265; *Weir* v. *Dinney*, 11 R. P. C. 657, O. H.

The omission to state that the workman must assist the machine at a certain part of the operation was held to be immaterial. *Miller & Coy.* v. *Clyde Bridge Steel Coy., Ltd.*, 8 R. P. C. 198, 201, O. H. See also *Dudgeon* v. *Thomson* (1873), 3 S. XI. 863, 872, I. H.

In *British Vacuum Cleaner Coy., Ltd.* v. *L. & S. W. R. Coy.*, 29 R. P. C. 309 H. L., it was held that the specification was not insufficient because no directions were given as to the vacuum at the nozzle, the directions as to the vacuum at the filter being sufficient. See also *Edison and Swan Coy.* v. *Holland*, 6 R. P. C. 243, 282, C. A., and p. 91, *n.* (*o*).

(*a*) *Leonhardt* v. *Kalle*, 12 R. P. C. 103, 116; *Atkins and Applegarth* v. *Castner-Kellner Alkali Coy.*, 18 R. P. C. 281, 293; *Gill* v. *Coutts*, 13 R. P. C. 125, 138; *Andrews' Patent*, 24 R. P. C. 349, 372, 373, C. A., and 25 R. P. C. 477, H. L. Anonymous referred to in *Jupe* v. *Pratt* (1837), W. P. C. 147.

But where the patentee stated that a certain step in his process produced a certain intermediate substance, and the statement was untrue, the patent was held bad. *Monnet* v. *Beck*, 14 R. P. C. 846.

(*b*) *Badische, &c.* v. *Levinstein*, 6 R. P. C. 387.

(*c*) *Pickard* v. *Prescott*, 7 R. P. C. 365, O. H.; *Perry* v. *Société des Lunetiers*, 13 R. P. C. 664, see, however, p. 138, *n.* (*u*), and *cf. Von der Linde* v. *Brummerstaedt*, 26 R. P. C. 289.

as to the comparative advantages of the different methods specified (*d*).

Need of *bona fides.*

It is not only necessary that a patentee (*e*) should show a method that will work; he is bound to show the best method that he knows of, and to give all the information that he has so as to enable the user to obtain the full benefit, and all that had been said as to sufficiency of directions must be considered as subject to this further consideration. Any lack of *bona fides* in the preparation of the specification, either by the omission of useful information or by the introduction of unnecessary obscurities or complication as to the nature of the materials, apparatus, or method of working, is fatal to the patent (*f*).

(*d*) *Kurtz* v. *Spence*, 5 R. P. C. 161, 183. See also *Thomson* v. *Batty*, 6 R. P. C. 84, 91, but see *n.* (*f*), *infra*.

(*e*) It should be noted that the patentee for this purpose means the person to whom the grant is made, and it is not an objection to the validity of a patent taken out by a person in this country on a communication from abroad, that the foreign communicator had knowledge which would have enabled him to give more perfect directions. *Plimpton* v. *Malcolmson* (1876), 3 Ch. D. 531, 582.

But, of course, the directions given must be sufficient to attain a useful result. *Wegman* v. *Corkran*, *ubi supra*. See also *Coles* v. *Bayliss*, 3 R. P. C. 178.

(*f*) Examples of this are as follows:—

Where a patent was granted for making steel trusses, and it was proved that the patentee in fact used tallow to facilitate the carrying out of his invention, but had not disclosed this, the patent was held bad. *Anonymous* (temp. Lord MANSFIELD), W. P. C. 175 *n.*

Where the specification of a patent for making verdigris described a process which made good verdigris, but it was proved that the patentee was in the habit of secretly putting into the copper *aqua fortis*, which dissolved the ingredients more quickly, the patent was held bad. *Wood* v. *Zimmer* (1815), 1 W. P. C. 44, 82 *n.*

Where the patentee had made experiments and found that only one particular kind of cloth would do for the web of a printing machine, and then said in his specification, "the cloth may be made of any suitable material, but I prefer it should be made of (naming the particular material)" the patent was held bad. *Crompton* v. *Ibbotson* (1828), 6 L. J. (O. S.) 214.

In the case of Thomson's patent for a new compass card the specification described the use of silk threads for joining the ring to the box. The objection was taken that before the complete specification was lodged the patentee had applied for a second patent for the use of wires for this purpose. KEKEWICH, J., expressed the opinion that this would have been a serious objection had it been proved that the patentee thought that wires were the best, but that as it appeared he considered the use of wires a mere unimportant variant, the patent was good. *Thomson* v. *Batty*, 6 R. P. C. 84.

In *Lewis* v. *Marling* (1829), 10 B. & C. 22, it was held that a direction to use an article which afterwards turned out to be unnecessary did not invalidate a patent, and it is clearly laid down that this objection is based on want of *bona fides*. See also *Turner* v. *Winter* (1787), W. P. C. 80; *Huddart* v. *Grimshaw* (1803), 2 B. & Ald. 377; *Bovill* v. *Moore* (1815), Davies 361, 400; *R.* v. *Arkwright* (1785), W. P. C. 64; *Morgan* v. *Seaward* (1837), W. P. C. 182; *British Dynamite Coy.* v. *Krebs* (1897), 13 R. P. C. 190 H. L.; *Badische, &c.* v. *Levinstein*, 4 R. P. C. 449.

It is sometimes a matter of

But of course it is no objection to the sufficiency of a patent that the patentee has subsequently discovered a better method nor is the fact of his adopting other methods necessarily evidence that the method described in the specification is not the best (*g*).

Specification to be read as a whole.

Of course for this purpose, as for all others, the specification must be read as a whole, and the general directions may correct the effect of some special mistake or omission (*h*). It is now no considerable difficulty to decide what information a patentee must give to fulfil this obligation. Although there is no decision on the subject it is probable that a patentee is only bound to give the information in his possession specially affecting the patented invention apart from other machinery or processes of the same class. For example, if a patent is taken out for a special form of lubricating machinery, and the patentee had a secret recipe for a lubricant which, in fact, was the best lubricant to use, not only with this special form of machinery, but also with other forms, he would not be bound to disclose its composition in his specification. But, on the other hand, if this special form of machinery needed a lubricant of a special character, and he knew this, and the proper lubricant to use, he would probably be held bound to describe it in his specification, though he could, if he chose, make it the subject of a separate patent.

(*g*) *Hardmuth* v. *Baker*, 21 R. P. C. 504, 511. But see *R.* v. *Arkwright* (1785), W. P. C. 64.

Statements made by the patentee are available as evidence against him on this point (*R.* v. *Arkwright*, *ubi supra*). The fact that he is in the habit of supplementing the descriptions given in the specification by private directions to users may throw doubts on his *bona fides*. *Pooley* v. *Pointon*, 2 R. P. C. 167. See also *Bailey* v. *Roberton* (1878), 4 S. IV. 545.

(*h*) Examples of this are :—

Where the specification spoke of the inner edges of the runners of a skate losing their angularity and being reversed so as to get a new edge, this was held to be a sufficient direction that they were to be placed obliquely. *Plimpton* v. *Malcolmson* (1876), 3 Ch. D. 531, 581.

Where the specification of a patent for an improved apparatus for disinfecting by means of steam stated that the steam for the outer chamber was to be taken from a high-pressure boiler, and the door of the chamber in which it was to be used was made especially strong, this was held a sufficient indication that the steam in the inner chamber was to be kept dry by means of high pressure steam in the outer chamber. *Lyon* v. *Goddard*, 11 R. P. C. 354, H. L.; but *cf. Tolson* v. *Speight*, 13 R. P. C., at p. 722.

Where the specification of a patent for making candy said "the compound is boiled or cooked commonly at a temperature of about 212° F. till the mass assumes that particular condition known in the art as 'hard tack,'" and it was proved to be necessary to heat to 230°–250° F. to arrive at this condition, the direction was held to be sufficient, since the practical man did not rely on the thermometer, but heated his substance till it arrived at the required state. *Kane* v. *Boyle*, 18 R. P. C. 325.

Where the specification of a patent for impregnating canvas belts with rubber contained no direction as to limiting the degree of heat employed, and it was proved that a high temperature would be detrimental, it was held that the fact that the drawing showed the belt being carried past a screen in front of an open fire sufficiently indicated that only a moderate degree of heat should be used. *Dick* v. *Tullis*, 13 R. P. C. 149.

Where in a patent for wireless transmitters and receivers the patentee made it clear that he was seeking "tuning," a direction that the coupling of the transformers should be "loose," was read into the patent, since a skilled man would know that this was necessary for tuning. *Marconi* v. *British Radio-Telegraph Coy.*, 28 R. P. C. 181. See also *Leonhardt* v. *Kallé*, 12 R. P. C. 103; *Thermit, Ltd.* v. *Weldite, Ltd.*, 24 R. P. C. 441; *Evans* v. *Hoskins*, 24 R. P. C. 517, C. A. See *contra Turner* v. *Winter*, *ubi supra*; *R.* v. *Metcalfe* (1817),

objection to a specification that the description of how to carry out the invention necessitates a reference to drawings (*i*) or to other specifications mentioned therein (*k*). The question as to whether it is sufficient if important features are only indicated in the drawings and are not referred to in the body of the specification must be regarded as a question of fact in each case (*l*).

False suggestions.

Another objection to a patent may be conveniently considered under the head of insufficiency, although theoretically it has a different origin. This is that the patent is void if it contains false suggestions which may be presumed to have induced the grant (*m*). This doctrine was formerly very widely applied so as to cover nearly every objection which could be raised to a patent, it being said that the grant was obtained on the suggestion that the patent was new and useful, and that the patentee was the first and true inventor, and that if any of these facts were untrue the patent would have been obtained by means of a false suggestion. The modern practice is rather to treat lack of novelty or utility, etc., as preventing a patent from coming within the exception contained in the Statute of Monopolies. But there are certain cases in which the question of false suggestion still arises, as, for example, where a patentee claims some advantage from his invention which is not realised, or points out alleged defects of old methods which in fact did not exist (*n*).

Effect of errors.

In many cases the question has been considered of how far a specification is vitiated by containing statements in the nature of mistakes which should not mislead a competent workman. Generally speaking, the Courts in modern times would not hold a specification to be bad for anything which obviously was a clerical error or a misuse of words which any competent workman would see to be such, and know how to correct, at any rate in a part which was not the essence of the

W. P. C. 141*n* (really a decision on disconformity).

So, too, it is no objection that foreign terms or measurements are used if the general meaning is clear. *Bloxam* v. *Elsee* (1823), 11 C. & P. 558.

(*i*) See p. 89, *nn.* (*c*), (*d*), (*e*), and *Lyon* v. *Goddard*, *ubi supra*. A contrary rule was laid down in some old cases, as in *Ex parte Fox* (1812), W. P. C. 431*n*. See also *Bovill* v. *Moore* (1815), Davies, at p. 369; *Bloxam* v. *Elsee* (1825), 1 C. & P. 558; *Gaulard and Gibbs' Patent*, 6 R. P. C. 215, 224, C. A.

(*k*) *Harmer* v. *Playne* (1800), 11 East. 101; *Lister* v. *Leather* (1858), 8 E. & B. 1004.

(*l*) See cases at p. 89, *nn.* (*d*) and (*e*).

(*m*) The onus of proving the falsity rests with the defendant. *Flour Oxidising Coy., Ltd.* v. *Hutchinson*, 26 R. P. C. 597, 633.

(*n*) *Owen's Patent*, 17 R. P. C. 68, 637. See also *Easterbrook* v. *Great Western Railway Coy.*, 2 R. P. C. 201. (The decision was in form on non-utility.) *Turner* v. *Winter* (1787), W. P. C. 77. This objection was also pleaded in *Hardmuth* v. *Baker*, 21 R. P. C. 507, but was not discussed.

invention (*o*). Thus, if the terms used are proper ones, as addressed to the ordinary workman, the patent is not held bad because these terms are scientifically incorrect (*p*), nor is the patent affected because of mistaken theories if the process works (*q*). In the same way errors in the drawing, if the drawings are merely by way of example, would not be held to vitiate a patent, if the competent workman would see at once what the error was and how to correct it. In fact the Courts hold that such statements would not in fact mislead and therefore do not vitiate the specification, but this only applies to errors discoverable without trouble or experiment (*r*). So also

(*o*) *Simpson* v. *Holliday* (1866), L. R. 1 H. L. 315, where it is pointed out that this must be limited to errors apparent on the face of the specification, and not needing experiment to demonstrate them, and does not extend to material false suggestions as to processes being practicable which are in fact useless. The error must be obvious to the competent workman, not merely to the expert, *Knight* v. *Argylls, Ltd.*, 29 R. P. C. 610. See also *Morgan* v. *Seaward* (1837), W. P. C. 176; *Beard* v. *Egerton* (1846), 9 L. J. (C. P.) 36; *Farbenfabriken* v. *Bowker*, 8 R. P. C. 389, 396; *Miller (H.) & Coy.* v. *Scarle Baker & Coy.*, 10 R. P. C. 106, 111; *Montgomery* v. *Paterson*, 11 R. P. C. 232; *Kane* v. *Boyle*, 18 R. P. C. 325, 366; *British United Shoe Machinery Coy., Ltd.* v. *Fussell*, 25 R. P. C. 368, 385; *Z. Electric Lamp Coy.* v. *Marples*, 27 R. P. C. 737, C. A.; and judgments of Lords ROBSON and SHAW in *British Vacuum Cleaner Coy., Ltd.* v. *L. & S. W. Rly. Coy.*, 29 R. P. C. 303, H. L. See also cases in p. 97, *n.* (*h*). A contrary rule was laid down though not acted upon in *Neilson* v. *Harford* (1841), W. P. C. 371. See also *Hinks* v. *Safety Lighting Coy.* (1876), 4 Ch. D. 607.

(*p*) Thus where a specification spoke of using liquid hydrocarbons, and gave examples including beeswax, and it was objected that a hydrocarbon properly meant a body only containing hydrogen and carbon, and would not include beeswax, it was held that the term was clearly not used in its strict scientific sense and that no one would be misled. *Edison and Swan Coy.* v. *Woodhouse* (2nd action), 4 R. P. C. 99, C. A.; *Jame* v. *Holland*, 6 R. P. C. 243, C. A.

Where a direction was given to mix mohair and silk "when in the raw state," and it was objected that they could not be mixed in the raw state as understood by an importer, i.e. before the silk was boiled, it was held that as the specification was addressed to spinners who would understand what stage was meant it was sufficient. *Lister* v. *Norton*, 3 R. P. C. 199.

Where a specification held to be addressed to lamp makers spoke of "phospham," the objection that chemically pure phospham would not act was overruled, since what was commercially sold as phospham would. *Z. Electric Lamp Coy.* v. *Marples*, 27 R. P. C. 737, C. A. See also *Simpson* v. *Holliday* (1865), 12 L. T. 101; *R.* v. *Metcalfe* (1817), 2 St. 249; *Minter* v. *Mower* (1835), W. P. C. 141; *Beard* v. *Egerton* (1846), 8 C. B. 165; *Haskell Golf Ball Coy., Ltd.* v. *Hutchinson*, 22 R. P. C. 478, 492. Case quoted in argument in *Jupe* v. *Pratt*, W. P. C. 147; *Flour Oxidising Coy.* v. *Hutchinson*, 26 R. P. C. 597, 626, 627, and cases at p. 97, *n.* (*h*).

(*q*) *Andrews' Patent*, 24 R. P. C. 349, 372, and 25 R. P. C. 477, C. A.; *Z. Electric Lamp Coy.* v. *Marples*, 27 R. P. C. 737, C. A.; *Vidal Dyes Syndicate* v. *Levinstein, Ltd.*, 29 R. P. C. at p. 268, C. A.; *Otto* v. *Steel*, 3 R. P. C. 109. But *cf. contra European Eibel Coy.* v. *Lloyd*, 28 R. P. C. 349.

This applies with special force where the theories put forward were generally accepted at the date of the patent. *Andrew's Patent, ubi supra; Z. Electric Lamp Coy.* v. *Marples, ubi supra*, at p. 745.

(*r*) See *n.* (*o*), *supra*.

somewhat loose statements as to the advantages of the invention are passed over if not substantially misleading (*s*). But where a definite statement is made that the invention can be performed in one of several ways and this in fact is not true, the patentee cannot be heard to say that no one would have tried the unsuccessful ways (*t*).

Sufficiency of description is question of fact.

The question of sufficiency—at any rate the sufficiency of the description of how the invention is to be performed—is essentially one for the jury, though directions may be given as to the meaning of the specification (*u*). Evidence is received not only as to the meaning of terms, but also as to whether the description is sufficient for the competent workman to carry out the invention. In particular evidence is frequently offered of the invention having in fact been carried out from the description in the specification (*x*).

Connection of sufficiency with other issues.

Since the question before the Court is whether the invention described in the specification is new and useful, it may happen that a decision does not depend solely on novelty, utility, or sufficiency, but the Court may say that the specification does not describe a new and useful invention, and that therefore the patent is bad for one of these reasons, without saying which. For example, a patentee may endeavour to supplement his description by saying that such and such matters were old and well known, and the Court may say that if this were so there would be no invention. So also in certain instances in which a patent has been held bad on the ground of want of novelty or lack of utility the decision might equally well have been given on the ground of insufficiency or *vice versâ* (*y*).

(*s*) *Dudgeon* v. *Thomson* (1873), 3 S. XI. 863; *Kane* v. *Boyle*, 18 R. P. C. 325, 332; *Flour Oxidising Coy., Ltd.* v. *Hutchinson*, 26 R. P. C. 590, 629.

In this case it was also held that if the patentee correctly stated the results of his invention a mis-statement as to the purposes to which the product could be applied would not affect validity (p. 629), but *cf.* *Turner* v. *Winter* (1787), W. P. C. 77.

(*t*) *Simpson* v. *Holliday* (1866), L. R. 1 H. L. 315; *Vidal Dyes Syndicate* v. *Levinstein*, 29 R. P. C. 245, 269, C. A.

(*u*) *Neilson* v. *Harford* (1841), W. P. C. 295; *R.* v. *Arkwright* (1785), W. P. C. 64; *Bovill* v. *Keyworth* (1857), 7 E. & B. 725. But CAIRNS, L. C., stated that the question of whether the nature of the invention is sufficiently described is for the Court, who may be assisted, but are not bound, by scientific evidence; *Bovill* v. *Smith* (1868), Griffin, N. C., 49, H. L. As to such evidence, see p. 188.

(*x*) *Dudgeon* v. *Thomson* (1873), 3 S. XI. 863; *Astley* v. *Taylor* (1871), 1 Shaw's App. Cas. 54; *Bovill* v. *Keyworth* (1857), 7 E. & B. 725; *Lowe* v. *Penn* (1846), 7 L. T. (o. s.) 203; *Shaw* v. *Jones*, 6 R. P. C. 328; *R.* v. *Arkwright*, *ubi supra*.

(*y*) See *per* LORD DAVEY, in *Wilson* v. *Wilson & Coy.* (*Barnsley*), *Ltd.*, 20 R. P. C. 1, 14. See also *R.* v. *Wheeler* (1819), 2 B. & Ald. 345; *Pooley* v. *Pointon*, 2 R. P. C. 167; *Atkins and Applegarth* v. *Castner Kellner Alkali Coy.*, 18 R. P. C. 295; *Von der Linde* v. *Brummerstaedt*, 26 R. P. C. 289.

CHAPTER VII

Disconformity

Provisions of present Act.

The present Act contains provisions which, while they lessen the likelihood of the objection of disconformity being successful, not only leave it possible for all the difficulties that could formerly have arisen still to arise, but also create new problems (*a*).

Origin of objection.

The exact origin of the modern objection of disconformity is somewhat hard to trace, in fact it probably had several different roots. In the earliest times a patent was granted for what was little more than the title of the invention (*b*), and the nature of the invention would have had to be established by evidence. It would therefore be open to the defendant by the plea of *non concessit* to show that what he had done was not an infringement of the monopoly really granted (*c*). Later it became the practice to make it a condition of the grant that the inventor should within a certain time file a specification fully describing the invention (*cc*). It was then held that besides the

(*a*) Sect. 42 and p. 103. Another factor tending to diminish the probability of disconformity is the very careful comparison now made by the Patent Office between the provisional and the complete specifications.

(*b*) *E.g.* Gilbert's Patent given in Gordon on Monopolies, p. 249.

(*c*) *Cf. Hancock* v. *Noyes* (1854), 23 L. J. (Ex.) 110, though this case was of a much later date.

(*cc*) For cases where disconformity between the title and specification was discussed see *inter alia*, *Cochrane* (*Lord*) v. *Smethurst* (1816), 1 St. 205, as to which see *Cook* v. *Pearce*, *infra*; *R.* v. *Wheeler* (1819), 2 B. & Ald. 345; *Sturz* v. *De la Rue* (1828), 5 Russ. 322; *Clegg's Patent* (1829), W. P. C. 103; *Croll* v. *Edge* (1847), 19 L. J. (C.P.) 261; *Patent Bottle Envelope Coy.* v. *Seymour* (1858), 28 L. J. (C.P.) 22; *Oxley* v. *Holden* (1860), 30 L. J. (C. P.) 68; *Cook* v. *Pearce* (1844), 12 L. J. (Q.B.) 189; *Pirrie* v. *York Street Flax Spinning Coy.*, 10 R. P. C. 45, Ir.

It should be noted that the objection that the specification and patent did not agree was in old days frequently taken where the specification was narrower than the patent on the ground that the Crown had been deceived into granting the patent by the representation that the inventor had a larger invention than he really had. See *Cochrane* (*Lord*) v. *Smethurst* (1816), 1 St. 205; *Jessop's Case* (before 1795), Davies 182.

It was also held by Abbot, C.J., that even if the patent and specification agreed the patent was bad if the inventor had not made the

plea of *non concessit* the defendant could also plead that the invention described in the specification was not the invention for which the patent was granted or that the inventor had not particularly described his invention according to the condition (*d*)—*i.e.* that there was disconformity between the title and the specification.

Later still a fuller description had to be filed before the patent was granted, namely, the provisional specification (*e*). This was taken as really explaining the title, and the complete specification was compared with it as it might have been with a title (*f*).

The Act of 1883 abolished this conditional grant, but imposed on the inventor the duty of filing a full description and definition of the invention before the patent could be sealed (*g*), and the grant now recites that this has been done (*h*). It would, however, obviously be wrong to let an inventor describe in his complete specification a further invention than that on which he applied for the patent, and so antedate such later invention. The Courts have therefore held that the objection still applies, and any other decision would have made a change in the law necessary, but it is somewhat difficult to say on what ground this decision rests (*i*). It has been suggested

invention at the date when he applied. (*Bloxam* v. *Elsee* (1827), 6 B. & C. 169). This doctrine would seem to have received its death blow, in fact if not in form, from the decision of the Ex. Ch. in *Cook* v. *Pearce* (1844), 12 L. J. (Q. B.) 189, and would now seem to be obsolete. See *per* Lord BLACKBURN in *Bailey* v. *Roberton* (1878), 3 A. C. 1055. Under the modern system of granting patents this objection has really no place.

(*d*) *Hancock* v. *Noyes, ubi supra*; *Croll* v. *Edge, ubi supra.*

Another form of plea was that the specification was larger than the patent. *Patent Bottle Envelope Coy.* v. *Seymour, ubi supra.* On this point *cf.* reasoning of Ex. Ch. in *Ralston* v. *Smith* (1862), 35 L. J. (C. P.) 49.

(*e*) This was introduced by the 1852 Act (15 & 16 Vict. c. 83), ss. 6 and 8.

Under this Act provision was made for the grant of patents either before or after the complete specification had been filed. In the former case the above condition was inserted in the patent, in the latter a condition that if the Letters Patent did not particularly describe the invention the patent should be void (see Patent Act, 1852 (15 & 16 Vict. c. 83, s. 9 and schedule). No distinction seems to have been made between these two classes of patents on the question of disconformity.

(*f*) It was held by the Scotch Courts in *Dudgeon* v. *Thomson* (1873), 3 S. XI. 863, that if the claim was within either the title or the provisional specification there was no disconformity, but this decision has not been followed.

(*g*) 1883 Act (46 & 47 Vict. c. 57), s. 5 (4); 1907 Act, s. 2 (2).

(*h*) See form, Appendix, *post.*

(*i*) There have been a number of patents granted since 1883 held bad for disconformity, including one in the H. L. See *Castner-Kellner Alkali Coy.* v. *Commercial Development Coy.*, 17 R. P. C. 593, H. L. There was no argument before the House of Lords as to disconformity being no longer an objection.

that since the Act of 1883 preserved all former grounds of attack on a patent, disconformity was included (*k*), but as the objection of disconformity was based on the non-fulfilment of a condition which is no longer imposed this is hardly a satisfactory reason. It may be that the true ground is that if the inventor claims a different invention to that for which he sought protection, he has not "particularly described the nature of his invention" (*l*), or that by attempting to extend the ambit of the patent which the Crown intended to grant for the invention contained in the original application he has invalidated his patent, or again that such extension being outside the real grant is a mere nullity (*m*).

Exception introduced by new Act.

The present Act provides that any of the old objections can be raised against a patent (*n*), but that no patent, whether granted before or after the date of the Act (*o*), shall be held invalid on the ground of disconformity if the disconforming matter was in fact new when the complete specification was put in, and the applicant was the first and true inventor thereof (*p*).

Fair development permissible.

In considering the subject of disconformity it must be remembered that the Patent Laws contemplate that the applicant will develop his invention during the period of provisional protection, and indeed this is the main object of such protection. The provisional specification may quite properly be filed when the inventor has no clear idea of the limits of his invention, and if it discloses the nature of the invention may and should be in such general terms as will give him full liberty in defining these limits after further experiment. It is

(*k*) See *inter alia*, *Nuttall* v. *Hargreaves*, 8 R. P. C. 450, 454, and case there quoted (C. A.).

(*l*) *Ibidem.*

(*m*) There are certainly dicta that suggest that the disconforming part is mere surplusage and does not affect the remainder of the patent. See *per* Lord BLACKBURN in *Bailey* v. *Roberton* (1878), 3 A. C. 1055; and *Lucas* v. *Miller*, 2 R. P. C. 159. In considering this view it must be remembered that this objection differs from those based on the Statute of Monopolies, since the latter attack the power of the Crown to make the grant at all, and therefore necessarily attack the grant as a whole. The Courts, however, have always treated this plea as going to validity, though in most cases in which patents have been held bad for invalidity the result of the action would have been the same if the other view had been taken, since the claim held bad was that alleged to be infringed.

In *Osmonds, Ltd.* v. *The Balmoral Cycle Coy., Ltd.*, 15 R. P. C. 505, C. A., however, the patent was held invalid for disconformity in a claim not alleged to be infringed, as also was the case in *United Telephone Coy.* v. *Harrison* (1883), 21 Ch. D. 731.

(*n*) Sect. 25 (2).

(*o*) Sect. 98 (2).

(*p*) Sect. 42, as to pleading, see p. 174.

not only his right but his duty to endeavour to develop his invention during this period, and also to prune away what is useless or old, and it is further his duty to include in his complete specification such matters appertaining to his invention as he may have so discovered, and which will be useful to the public in connection therewith (*q*). The mere presence, therefore, of matter in the complete specification which does not occur in the provisional does not even make out a *primâ facie* case of disconformity or put the patentee on the defensive, but the burden still lies on the objector of making out that these additions constitute a different invention to the invention (if any) described in the provisional (*r*).

The difference must be one of substance.

In arriving at a decision as to disconformity the first step is to construe the complete specification, of course taking into account the state of general knowledge, so as to determine what is the invention claimed, and then to see if that invention is fairly fore-shadowed in the provisional specification (*s*). But this is only the first step. Of course, if the specifications pass this test there can be no question of disconformity, but it will often happen that there are elements in the claims not appearing in the Provisional. It is then necessary to consider, quite apart from the wording of the specification, what the real invention was, in order to determine whether these additional elements are merely a limitation of this invention, or whether they in fact constitute the novelty of the patented invention (*t*). Thus, to take a concrete case, if the provisional specification of a chemical patent says that the inventor has discovered that by combining two bodies A and B you get a third body C, and the complete claims the process of combining A and B in a particular solvent D in order to get C, the question of

(*q*) See *per* Lord MACNAGHTEN in *Pneumatic Tyre Coy.* v. *Leicester Pneumatic Tyre Coy.*, 16 R. P. C. at p. 541; *Newall* v. *Elliott* (1858), 27 L. J. (C. P.) 337. See also p. 96, *n.* (*f*).

(*r*) *Per* Lord MACNAGHTEN in *Pneumatic Tyre Coy.* v. *Leicester Pneumatic Tyre Coy.*, *ubi supra*, and *per* Lord DAVEY, *ibid.*, at p. 545; *Moseley* v. *Victoria Rubber Coy.*, 4 R. P. C. 241; *Miller* v. *Scarle Baker and Coy.*, 10 R. P. C. 111; *Kelvin* v. *Whyte Thomson and Coy.*, 25 R. P. C. 177, 190, O. H. *Per* Lord BLACKBURN in *Bailey* v. *Roberton* (1878), 3 A. C. 1055; *Clegg's Patent* (1829), W. P. C. 103; *Birmingham Pneumatic Tyre Syndicate, Ltd.* v. *Reliance Tyre Coy.*, 19 R. P. C. 298, 315.

(*s*) *Siddle* v. *Vickers*, 5 R. P. C. 98.

(*t*) See *per* VAUGHAN WILLIAMS, L.J., in *Andrew's Patent*, 24 R. P. C. at p. 368; *Nuttall* v. *Hargreaves*, 8 R. P. C. 450, C. A.; *Brookes* v. *Lamplugh*, 15 R. P. C. 33, 50, C. A., and *Ralston* v. *Smith* (1862), 35 L. J. (C. P.) 49; but see *contra Cassel Gold Extracting Coy.* v. *Cyanide Gold Recovery Syndicate*, 12 R. P. C. 232, C. A.; *Geipel's Patent*, 21 R. P. C. 379, 389, C. A.

disconformity would turn on whether it was new to combine A and B by any method to get C. If it was, then this is the invention made, and the limitation to what the inventor has found is the best, or perhaps the only method, does not constitute disconformity. But if it was old to combine A and B to produce C by other methods, then the true invention is the use of the solvent D for this purpose, and as this is not foreshadowed in the provisional there is disconformity.

What is disconformity.

If, therefore, the claims contain elements or definitions not foreshadowed in the provisional, it is necessary to see whether these elements constitute the invention claimed. If they do there is disconformity whether the new matter limits the invention, as, for example, by substituting a particluar device for a general element in the provisional, where all that is new is the choice or invention of this particular device (*u*), or extends it as by including other mechanical equivalents for those described in the provisional, where the real invention lies in the choice of the mechanical equivalents used (*x*). But where the invention does not lie in these details and the provisional specification has described a substantially new process or apparatus, the choice of the best form, or the variation of equivalents, or the improvement of a part, would not constitute disconformity (*y*). In the case where disconformity is alleged by reason of the introduction of new details in the claim, a test which may sometimes be of use is to see whether the claim is a mere limitation of a wider claim which could have been made and which would have been good from the point of view of novelty

(*u*) *Gillies* v. *Dunbar* (1877), 4 S. V. 337, I. H.; *Cera Light Coy.* v. *Doby*, 11 R. P. C. 10, I. H.; *King Brown and Coy.* v. *Anglo-American Brush Coy.*, 7 R. P. C. 436, I. H.; *Nuttall* v. *Hargreaves*, 8 R. P. C. 450, C. A.: *cf.* also judgment of Ex. Ch. in *Ralston* v. *Smith* (1865), 11 C. B. (N. S.) at p. 117, and of VAUGHAN-WILLIAMS, L.J., in *Ward Brothers* v. *Hill*, 20 R. P. C. 198, C. A.

(*x*) *Brookes* v. *Lamplugh*, 15 R. P. C. 33, C. A.; *Castner-Kellner Alkali Coy.* v. *Commercial Development Corporation*, 17 R. P. C. 593, H. L.

(*y*) *Sutcliffe* v. *Abbot*, 20 R. P. C. at p. 58; *Watling* v. *Stevens*, 3 R. P. C. 147, C. A.; *Woodward* v. *Sansum*, 4 R. P. C. 166, C. A.; *Ward Brothers* v. *Hill*, 20 R. P. C. 180, C. A.; *Crampton* v. *Patents Investment Coy.*, 6 R. P. C. 287. As to this case see *n.* (*z*), *infra*. *Birmingham Pneumatic Tyre Syndicate, Ltd.* v. *Reliance Tyre Coy.*, 19 R. P. C. 298; *Carter* v. *Leyson*, 19 R. P. C. 473, C. A.; *Chadburn* v. *Mechan*, 12 R. P. C. 120; *Cassel Gold Extracting Coy.* v. *Cyanide Gold Recovery Syndicate*, 12 R. P. C. 232, C. A. As to this case see *n.* (*z*), *infra*. *Castner-Kellner Alkali Coy.* v. *Commercial Development Corporation*, 17 R. P. C. 593, H. L.; *Geipel's Patents*, 21 R. P. C. 370, C. A.; *Gaulard & Gibb's Patent*, 7 R. P. C. 367, H. L.; *Gadd* v. *Mayor of Manchester*, 9 R. P. C. 516, C. A.; *Moseley* v. *Victoria Rubber Coy.*, 4 R. P. C. 241; *Morgan* v. *Windover*, 4 R. P. C. 446; *Newall* v. *Elliott* (1858), 27 L. J. (C. P.) 337; *Pneumatic Tyre Coy., Ltd.* v. *Leicester Pneumatic Tyre Coy.*, 16 R. P. C. 531, H. L.

(though not necessarily from that of utility) and which is foreshadowed in the provisional. If so it is apprehended that the claim is in general good (*z*).

In some cases the provisional clearly shows a particular feature as the essence of the invention, and then devices which do not embody this feature necessarily disconform (*a*).

In modern times the Courts have rightly been liberal to the patentee on the question of disconformity (*b*), and have looked at the substance rather than the form of the description, treating the question of the identity of the inventions as one rather of fact than of construction (*c*). Even a slight suggestion in the provisional is often sufficient (*d*), and elements there mentioned separately may be claimed in combination (*e*), and probably in some cases the converse would apply (*f*). So, too, there is an unwillingness to punish an inventor for having

(*z*) It should be noted that in the following two cases the Courts have held claims bad for disconformity where the claim, if the disconforming part had been omitted, would still have been good: *Osmond* v. *Balmoral Cycle Coy.*, 15 R. P. C. 505; *Kinmond* v. *Keay*, 20 R. P. C. 497, I. H.

It seems difficult, however, to reconcile these decisions with others of equal or greater weight which lay down the general rule that the introduction of an integer, properly or improperly, into a claim, so as to restrict the monopoly covered by the claim, does not invalidate it if the claim would have been good without such restriction: *cf. British Dynamite Coy.* v. *Krebs* (1879), 13 R. P. C. 130, H. L.; *British United Shoe Machinery* v. *Fussell*, 25 R. P. C. 631, C. A., and other cases in n. See also *Newall* v. *Elliot* (1858), 27 L. J. (C. P.) 337; *Lucas* v. *Miller*, 2 R. P. C. 155.

In the last case it was said that this rule would apply even if the invention would have been unworkable without the additional part. On the other hand in some cases the Courts have stated rules for judging as to disconformity which seem too favourable to the patentee, and held there was no disconformity where the statement in the provisional contained no hint of the special feature which was held to constitute the invention. *E.g.* *Cassel Gold Extracting Coy.* v. *Cyanide Gold Recovery Syndicate*, 12 R. P. C. at p. 257, C. A.; *Crampton* v. *Patents Investment Coy.*, 6 R. P. C. 287, C. A.

(*a*) *United Telephone Coy.* v. *Harrison* (1883), 21 Ch. D. 731; *Tubeless Pneumatic Tyre Coy.* v. *Trench Coy.*, 16 R. P. C. 291; *Savage* v. *Brindle*, 17 R. P. C. 228; *Hutchinson* v. *Pattulo*, 5 R. P. C. 351, I. H.; *Brookes* v. *Lamplugh*, 15 R. P. C. 33, 50, C. A.

(*b*) See *Gadd* v. *Mayor of Manchester*, 9 R. P. C., *per* LINDLEY, L.J., at p. 527.

(*c*) *Geipel's Patent*, 21 R. P. C. 379. In *Pneumatic Tyre Coy., Ltd.* v. *Leicester Pneumatic Tyre Coy.*, 16 R. P. C. at p. 55, SMITH, L.J., was of opinion that the question was one of law, so that a decision bound Courts of equal jurisdiction in the absence of fresh evidence.

Probably the question of whether the provisional foreshadows what is in the complete is one of construction, while the question as to whether the differences are of the essence of the invention is one of fact.

(*d*) See *per* Lord BLACKBURN in *Bailey* v. *Roberton* (1878), 3 A. C. 1055. See also *Andrews' Patent*, 24 R. P. C. 349, C. A.

(*e*) *Dudgeon* v. *Thomson* (1873), 3 S. XI. 863, I. H.; *Patent Bottle Envelope Coy.* v. *Seymour* (1858), 28 L. J. (C. P.) 22.

(*f*) See, however, *Bailey* v. *Roberton*, *supra*.

condescended to unnecessary details in his provisional if there is invention apart from such details (*g*).

It is no objection to a patent that matters in the provisional have been omitted or disclaimed in the complete (*h*), or that new matters have been introduced by way of description or explanation only (*i*). If, however, these limitations or new matters are incorporated in the claims by description or otherwise the above rules would apply (*k*).

Case of several provisionals.

New and complicated questions as to disconformity will probably arise from the power given by the present Act of filing one complete specification on two or more provisional specifications for cognate inventions. In such case the novelty of any matter claimed has to be tested as at the date when the provisional relating to the matters claimed therein was filed (*l*). As there is no provision for, or practice of, earmarking the claims as referring to the matters contained in a certain provisional, questions will undoubtedly arise as to the earliest provisional to which a claim can be referred, and even as to whether the filing of the later provisionals was not merely an unnecessary precaution, and the inventions described in such provisionals merely fair developments of the original invention (*m*).

(*g*) *Pneumatic Tyre Coy., Ltd.* v. *Ixion Tyre Coy.*, 14 R. P. C. at p. 869; *Woodward* v. *Sansum*, 4 R. P. C. 166, C. A.; *Geipel's Patent*, 21 R. P. C. 370, C. A.

(*h*) *Aktiebolaget Separator* v. *Dairy Outfit Coy.*, 15 R. P. C. 336; *Andrews' Patent*, 24 R. P. C. 349, C. A.; *Nickels* v. *Haslam* (1844), 13 L. J. (C. P.) 146; *Thomas* v. *Welch* (1866), 35 L. J. (C. P.) 200; *Penn* v. *Bibby* (1866), 2 Ch. App. 127. See also *British Motor Syndicate, Ltd.* v. *Universal Motor Carriage Coy.*, 16 R. P. C. 113, 132.

(*i*) *Oxley* v. *Holden* (1860), 30 L. J. (C. P.) 68; *Penn* v. *Bibby* (1866), 2 Ch. App. 127.

So the omission of a statement as to the advantages of the invention (*British Motor Coy.* v. *Universal Motor Coy.*, 16 R. P. C. 113; *cf.* also *Gaulard & Gibb's Patent*, 7 R. P. C. 367, H. L.) or a different statement as to the theory of a reaction (*Andrews' Patent*, 24 R. P. C. 249, C. A.) do not constitute disconformity. Nor a statement that devices can be used for other purposes (*Oxley* v. *Holden*, *supra*; *Wright* v. *Hitchcock* (1870), 39 L. J. (EX.) 97). *Cf.* also *Lyon* v. *Goddard*, 11 R. P. C. 354, H. L.

Again the addition of a descriptive adjective such as a "thin *flexible* paper tube" for a "thin paper tube" which does not really make any change is not disconformity. *Pirrie* v. *York Street Flax Spinning Coy.*, 10 R. P. C. 45, Ir.

(*k*) See *per* VAUGHAN WILLIAMS, L. J., in *Ward Brothers* v. *Hill*, 20 R. P. C. at p. 198, and in *Andrews' Patent*, 24 R. P. C. at p. 368.

A good example of disconformity caused by excision is *Lane-Fox* v. *Kensington & Knightsbridge Electricity Coy.*, 9 R. P. C. 413, C. A.

(*l*) Sect. 16.

(*m*) The probability of questions arising under this section and also under section 42 through the publication of matters during the period of provisional protection is greater than might be supposed. The inventor is nearly always unconscious of the disconformity, and is quite likely to show his new developments under the impression that they are protected by the provisional.

The following are cases in which

it was held that there was no disconformity :—

Variations held to be fair developments.

The provisional specification of a patent for producing designs on waterproof fabrics, described a process as consisting of covering the fabrics with farina (which was old in itself), printing with colours dissolved in suitable media such as those employed in calico printing, and vulcanising by the "well-known cold vulcanising process." The complete extended the list of media and also said that another process, the "cold vapour" process could be used for vulcanising. *Moseley* v. *Victoria Rubber Coy.*, 4 R. P. C. 241.

The provisional specification of a patent for a cycle fitting described the movement of one part towards another by means of a single clip, and the complete also included a form with two clips with different screws so that the parts approached by double action ; *Miller* v. *Scarle Baker & Coy.*, 10 R. P. C. 106, 111.

The provisional specification of a patent for a method of raising gas holders described racks and wheels, the wheels being all geared together, so that the holders should rise evenly. The complete also showed a device having a number of sets of four pulleys on which were continuous chains crossed in the middle. See illustrations in Roberts, p. 353. *Gadd* v. *Mayor of Manchester*, 9 R. P. C. 516, C. A.

The provisional specification of a patent for separating dust from chaff described the use of a fan above the exit or in the entry. The complete showed and claimed a fan in the interior of the machine. It also showed a collar not in the provisional specification. It was held that the patent was to be broadly interpreted. *Sutcliffe* v. *Abbot*, 20 R. P. C. 50.

The provisional specification of a patent for improvements in connection with dobbies described a rocking lever for bringing one of the two pattern rollers into action, and also proposed certain improvements in the needles actuated by these. In the complete specification the ordinary form of lever was adopted with such needles. *Ward Brothers* v. *Hill*, 20 R. P. C. 189, C. A.

The provisional specification of a patent for the application of composite C springs to the fronts of carriages showed one method of anchoring the spring. In the complete an alternative method was shown. *Held*, by KEKEWICH, J., that this was not disconformity the provisional having pointed out the necessity of such anchoring, and the means being unimportant. The point was not discussed in the House of Lords. *Morgan* v. *Windover*, 4 R. P. C. 423.

The provisional specification of a patent for a pencil case described the lead as being contained in a movement having a pin projecting through a slot. In the complete an alternative was described in which the slot was in the movement and the pin on the casing. *Woodward* v. *Sansum*, 4 R. P. C. 166, C. A. See also *Watling* v. *Stevens*, 3 R. P. C. 147, C. A.

In the case of the Castner-Kelner apparatus (see p. 110), it was held that an alternative in which mercury was stationary, but the bell contained pure water and the space outside brine, did not cause disconformity. *Castner-Kelner Alkali Coy.* v. *Commercial Development Corporation*, 17 R. P. C. 503, H. L.

The provisional specification of a patent for steam traps described the steam as passing through two tubes of different metals arranged so as to form a triangle with a fixed base. The complete specification in addition gave one figure which showed only one tube with a tie rod made of different material. *Geipel's Patent*, 21 R. P. C. 379, C. A.

The provisional specification of a patent for a tyre cover described a cover which was split and joined round a tube, and said that it might be brought round within the rim and secured to the rim by an inner fastening, or by expansion against the overhanging sides of the metallic rim. The complete claimed a method of holding it on by pressure without overhanging sides. *Birmingham Pneumatic Tyre Syndicate* v. *Reliance Tyre Coy.*, 19 R. P. C. 205.

The provisional specification of the Welch patent described a tyre cover having in the edges wires which could be joined so as to become inextensible, in combination with a rim concave in the middle so that the two inextensible wires prevented the tyre slipping over the convexity on either side. It mentioned that the tyre might be fitted over the existing rubbers or that material such as cork might be

used in place of these. In the complete there was also shown and claimed a form in which the wires were made continuous from the first and the use of this cover with pneumatic tyres was also claimed. *Held*, no disconformity. In all cases the wires were continuous when holding the tyre on, and the fact that the inventor discovered that his arrangements for joining the ends were in some cases unnecessary did not change the nature of the invention, nor was its application to pneumatic tyres an undue extension. *Pneumatic Tyre Coy.* v. *Casswell*, 13 R. P. C. 104; *Same* v. *East London Rubber Coy.*, 14 R. P. C. 573, C. A.; *Same* v. *Ixion Patent Pneumatic Tyre Coy.*, 14 R. P. C. 869; *Same* v. *Leicester Pneumatic Tyre Coy.*, 16 R. P. C. 531. See also *Horrocks* v. *Stubbs*, 3 R. P. C. 221.

Where the provisional had described the use of wooden bearings, and the complete described as an alternative putting wood on the shaft to run in metal, but the claim was only for bearings, it was held that there was no disconformity since the wood on the shafts came within the term bearings as mentioned in the provisional, and if not was not claimed. *Penn* v. *Bibby* (1859), 2 Ch. App. 127.

Where the patent was for improvements in the manufacture of cases or envelopes for covering bottles, the specification described apparatus for, and a mode of, making these envelopes, and claimed these in combination, it was held to be no disconformity. *Patent Bottle Envelope Coy.* v. *Seymour* (1858), 28 L. T. (O. P.) 22.

Where the provisional specification was for improvements in the manufacture of frills or ruches, and the machinery or apparatus employed therein, and the claim was for machinery for producing crimp frills or trimmings, etc., it was held that there was no disconformity. *Wright* v. *Hitchcock* (1870), L. R. 5 Ex. 37.

The provisional specification of a patent for a method of purifying flour described a process as working by oxidation. In fact, as stated in the complete, the action was one of nitration. Further nitrogen peroxide was claimed as an agent in the complete specification and not mentioned in the provisional, though there was a statement which might have included it. Ozone had been mentioned in the provisional and expressly excluded in the complete. *Held*, no disconformity. *Andrews' Patent*, 25 R. P. C. 477, H. L.

New matters claimed in combination.

The provisional specification of a patent for apparatus for cable laying described a cone with a vertical axis on which the cable was coiled. The complete also described the use of a series of rings above the cone so that the cable passed inside them, and claimed these in combination. *Newall* v. *Elliott* (1858), 27 L. J. (C. P.) 337.

The provisional specification of a patent for a lamp to be hung on the hub of bicycle described only the lamp, the complete described, in addition, a device for fixing leather washers in barrel on round hub and claimed the whole in combination. *Lucas* v. *Miller*, 2 R. P. C. 155. See also *Sturz* v. *De la Rue* (1828), 5 Russ. 322; *Dudgeon* v. *Thomson* (1873), 3 S. XI. 863; *Crampton* v. *Patents Investment Coy.*, 6 R. P. C. 287, C. A.; *Kelvin* v. *Whyte-Thomson*, 25 R. P. C. 177, 190.

The provisional specification of a patent for an improved candlestick described a candlestick formed of a socket with fangs attached to the base. The complete specification described and claimed the same thing with the addition of bits between the fangs to hold the nozzle on the socket. *Carter* v. *Leyson*, 18 R. P. C. 508.

Specific devices or directions added.

The provisional specification of a patent for improvements in ships telegraphs, after mentioning that gongs were used, said "the gong is sounded, and the pointer moves up to the central or proper position as described practically simultaneously." The complete specification described and claimed special machinery for this purpose. *Held*, though with some doubt, no disconformity. *Chadburn* v. *Mechan*, 12 R. P. C. 120.

The provisional specification of a patent for a method of extracting gold by means of cyanide of potassium did not make any reference to the strength of the solution. The complete specification had a claim for the use of a dilute solution, and it was found that in fact the real invention was the use of such a dilute solution which had a selective preference for gold which a stronger solution had not. It was held that there was no disconformity, and the Court were of opinion that the object of the provisional was only to identify

the invention so that the Law Officer may see what it is. *Cassall Gold Extracting Coy.* v. *Cyanide Gold Recovery Syndicate*, 12 R. P. C. 232, C. A. It is difficult to reconcile this decision with other decisions such as *Nuttall* v. *Hargreaves*, *infra*.

In the following cases disconformity was found:—*Extensions or variations held not to be fair developments.*

The provisional specification of a patent for improvements in cycle saddles described a device for attaching a cycle saddle to the frame, the main novelty of which was that it permitted tilting. The complete showed forms which did not permit of tilting. The novelty of the invention was held to lie in the exact devices used. *Brooks* v. *Lamplugh*, 15 R. P. C. 33, 50, C. A.

The provisional specification of a patent for improvements in electrolytic apparatus for decomposing metallic salts stated that the apparatus had a stationary mercury cathode. The apparatus described had a chamber with mercury laid on the bottom and a bell containing salt water was traversed over it, the space outside the bell containing pure water. In the complete a form was shown in which the brine and water boxes were stationary while the mercury covered bottom revolved. It was held that this was disconformity since "stationary" had been advisedly used in the provisional to distinguish from former apparatus. *Castner-Kelner Alkali Coy.* v. *Commercial Development Corporation*, 17 R. P. C. 593, H. L.

The provisional specification of Edison's telephone patent only dealt with the electrical transmission of sound. The complete also described a phonograph and said that the reproducing diaphragm might either give out sound or work a tension regulator on an electric line to transmit sound elsewhere. The claim covered both forms. *United Telephone Coy.* v. *Harrison* (1883), 21 Ch. D. 731.

The provisional specification of a patent for improvements in roundabouts described a method of giving up and down movement to the horses by means of a crank (old in itself for this purpose) on which were suspended rods carried downwards and attached to a frame free to move radially so that the horses were kept at a proper distance apart. The complete claimed a crank and rods, the rods being moved in a guide so that the horses could move individually. *Savage* v. *Brindle*, 17 R. P. C. 228.

The provisional specification of a patent described a certain process for thickening vegetable oils. The complete claimed in addition mixing vegetable oils, thickened by this or any other process, with mineral oils. *Hutchinson* v. *Pattulo*, 5 R. P. C. 251, I. H.

Where the provisional specification described the use of a solution of bi-sulphite of lime and gelatine for preserving meat it was held that a claim for the use of the bi-sulphite alone would amount to disconformity. *Bailey* v. *Roberton* (1878), 3 A. C. 1055.

The provisional specification of a patent dealing with the distribution of electricity described the use of batteries as reservoirs, but showed an electrometer governing the dynamos for the purpose of regulating them. In the amended complete specification the references to the electrometer were taken out and the regulating was done by means of the batteries. *Lane-Fox* v. *Kensington Electric Lighting Coy.*, 9 R. P. C. 413, C. A.

The provisional specification of a patent for a method of electrical distribution spoke of the use of a "number of induction coils of special construction for the creation of currents whose quality and value depends solely upon the construction of the said induction coils." The complete specification as amended claimed a system of distribution quite apart from any special construction of these coils. *Held*, by C. A. disconformity. The judgment of the various Lords in the House of Lords differed as to this. *Gaulard & Gibb's Patent*, 6 R. P. C. 215, C. A.; 7 R. P. C. 367, H. L.

The provisional specification of a patent for pneumatic tyres described forms in which either the margins of one band or of two separate bands lay over each other so as to form a complete air-tight chamber. The complete also claimed a form in which the margins did not lie over each other, but were simply forced against the rim. *Tubeless Pneumatic Tyre Coy.* v. *Trench Tubeless Tyre Coy.*, 16 R. P. C. 291. See also *Horrocks* v. *Stubbs*, 3 R. P. C. 221.

Addition of elements which formed only novelty.

Where the only novelty in a beer

tap was a wire gauze strainer which did not appear in the provisional held disconformity. *Nuttall* v. *Hargreaves*, 8 R. P. C. 450, C. A.

Where the provisional was merely for forming a spiral screw in a particular part of certain apparatus, and the complete claimed a screw of particular diameter and pitch, and these were the only elements of novelty, held disconformity. *Gillies* v. *Dunbar* (1877), 4 S. V. 337, I. H. See also *King Brown & Coy.* v. *Anglo-American Brush Corporation*, 7 R. P. C. 436, C. A.; *Cera Light Coy.* v. *Dobby*, 11 R. P. C. 10, I. H.; *Brookes* v. *Lamplugh*, 15 R. P. C. 33, 50, C. A.; *Adams* v. *Stevens*, 16 R. P. C. 225, 232.

New elements claimed in combination.

The provisional specification of a patent for improvements in adjusting driving chains of safety bicycles merely described these arrangements. The complete also described a special step which could be used in place of the ordinary step, and was better suited to this special gear, and one of the claims was for a combination including this step. *Osmonds* v. *Balmoral Cycle Coy.*, 15 R. P. C. 505, C. A. See also *Kinmond* v. *Keay*, 20 R. P. C. 497, 508, O. H.

In the case of a patent for "certain improvements in the manufacture of gas for the purpose of illumination, and in the apparatus used when transmitting and measuring gas," the specification added after the word "used" the words "therein and" and the specification described (*inter alia*) an improved retort. *Held* disconformity on the ground that it materially extended the grant. *Croll* v. *Edge* (1847), 19 L. J. (C. P.) 201.

In the case of a patent for a new and improved method of drying and preparing malt, the specification described a process to be applied to malt already dried in the ordinary way to give it colouring properties. *Held*, disconformity. *R.* v. *Wheeler* (1819), 2 B. & Ald. 345.

CHAPTER VIII

Construction

Logically the construction of the Letters Patent, or the ascertainment of the nature and extent of the monopoly claimed, should be the first question in any patent action and should be decided apart from any other question. This, however, is a counsel of perfection not often followed. The main reason is that the specification is addressed to craftsmen of the trade concerned, and the Court cannot properly perform its duties until it is in a position to look at it with their eyes. An analogous case, though perhaps the analogy is not a perfect one, would be the construction of a contract made between foreigners and subject to foreign law. No Court would attempt to construe this until it had been informed by evidence as to what the foreign law was, and also as to customs and other circumstances affecting the matter of the contract, so that it was in a position to determine what the parties really meant by the words used. In fact the construction of the specification has often to be delayed until practically all the evidence has been taken, and it is often difficult to separate the decision on construction from decisions on other issues.

Construction involves knowledge of art.

In particular the question of infringement is always closely joined with that of construction. This is only natural, since once it has been established what the defendant has done, it would appear to be only a question of construction whether or not this is within the monopoly granted. But it must be remembered that while the construction of the specification was always a question for the Court, the further question of the substantial identity of what the defendant had done with the invention for which the monopoly was granted was for the jury (*a*). There is, therefore, a distinction between the rules

Questions of construction and infringement.

(*a*) Thus in *Betts* v. *Menzies* (1859), 10 H. L. C. 970, and *Betts* v. *Neilson* (1866), 3 Ch. App. 429. It was held that it was for the jury to determine

which the Court applies in construing the specification as a document, and the principles which should guide it as a jury in deciding on this question of substantial identity, and an attempt has been made to separate these questions as far as may be, dealing with the first in this chapter, and leaving the other to the chapter on infringement. It is not, however, possible to preserve the distinction in all cases, or to avoid a certain amount of repetition.

Varying doctrines of construction.

In applying former decisions on construction it is necessary to remember that the views of the Courts as to the interpretation of specifications have varied from time to time. In early times there was a view that the specification, being the patentee's own document, should be construed strictly against him, but about 1830 the Courts began to take a milder view (*b*), and later on it was held that the words in the grant "that these our Letters Patent shall be construed in the most beneficial sense for the advantage of the said patentee" applied more to the specification than to the Letters Patent themselves (*c*). This doctrine of benevolent interpretation has in turn been

whether, firstly, the terms of art used in specifications of different dates meant the same and, secondly, whether the inventions described in these specifications were identical.

In *Steiner* v. *Heald* (1851), 20 L. J. (EX.) 410, 17 Jur. 875, a new trial was granted because the Court had not left to the jury the question whether two processes were identical.

In *Bush* v. *Fox* (1852), 23 L. J. (EX.) 251, the Court directed the jury to find that the patent had been anticipated, but as to this case see judgment of BRAMWELL, B., in *Hills* v. *London Gas Coy.* (1860), 29 L. J. (EX.) at p. 321. See also *Westinghouse* v. *Lancashire & Yorkshire Ry.*, 1 R. P. C. 229; *Neilson* v. *Harford* (1841), W. P. C. 273; *Thomas* v. *Foxell* (1858), 5 Jur. N. S. 37.

A Court will, however, feel bound to follow a previous decision of an equal or higher Court as to construction in the absence of further evidence. *Otto* v. *Steel*, 3 R. P. C. 109; *Hills* v. *Liverpool Gas Coy.* (1862), 32 L. J. (CH.) 38; *British Vacuum Cleaner Coy.* v. *Exton Hotels, Ltd.*, 25 R. P. C. 617.

Thus in *Edison* v. *Holland*, 6 R. P. C. 283, the C. A. held that they were bound by a former decision as to the following points:—

1. That the specification was not too vague and unintelligible to be construed by the Court.
2. That what was meant by "carbon filament" was reasonably plain from the specification.
3. As to how wide a certain claim was, *but* not as to whether the patentee had sufficiently described in what manner the invention was to be performed, that being a question of evidence.

So a decision as to disconformity, or as to whether an alleged prior grant was for the same invention, was considered binding in *Flour Oxidising Coy.* v. *Carr*, 25 R. P. C. 428; *Same* v. *Hutchinson*, 26 R. P. C. 597.

As to cases where the plaintiff seeks to vary the construction, see p. 121.

(*b*) *Hallett* v. *Hague* (1831), 9 L. J. (O. S.) K. B. 243; *Russell* v. *Cowley* (1835), W. P. C. at p. 470; *Neilson* v. *Harford* (1841), W. P. C. p. 370 *et seq.*, but see p. 129, *n.* (*f*).

(*c*) *Feather* v. *The Queen* (1865), 35 L. J. (Q. B.) at p. 205. *Cf. per* Lord LINDLEY in *Hattersley* v. *Hodgson*, 23 R. P. C. at p. 203, and *Automatic Weighing Machine Coy.* v. *Knight*, 6 R. P. C. at p. 307, C. A.

disclaimed by the Courts, and there are many dicta that the specification should be construed without leaning either way (*d*), but, in fact, there has been little change, as the tendency still is to so construe the specification as to make it valid if this is reasonably possible (*e*).

General principles.

It may be said, therefore, that the modern theory of construction of Letters Patent is that they are to be construed as other documents are (*f*), that is to say, the Court is to endeavour to assign a meaning if it is possible, and not to use minute verbal criticisms to destroy a meaning (*g*), that the meaning it is to assign is that which the document would bear to those to whom it is addressed (*h*), and that it is to apply the maxim *res magis valeat quam pereat*, and not to assume an interpretation that would make the grant unlawful if it can be avoided (*i*). The following "rules" only emphasise the points arising in the practical application of this theory.

First Rule

The Specification is to be read as a whole

The first important rule is that the specification is to be read as a whole, the claiming clauses being only a part—although undoubtedly an important part—of the specification, and in no sense a separate document (*k*), and the body of

(*d*) *Simpson* v. *Holliday* (1865), 35 L. J. (CH.) at p. 813; *Cropper* v. *Smith*, 1 R. P. C. at p. 89, C. A.; *Leadbeater* v. *Kitchin*, 7 R. P. C. at p. 244, C. A.; *Tolson* v. *Speight*, 13 R. P. C. 721; *Presto* v. *Orme*, 18 R. P. C. at p. 23, C. A.; *Patent Exploitation Coy.* v. *Siemens*, 21 R. P. C. 549, H. L.; *Turnbull* v. *Cruikshank*, 22 R. P. C. 521, O. H.

(*e*) *Oxley* v. *Holden* (1860), 30 L. J. (C. P.) 68; *Plimpton* v. *Spiller* (1877), 6 Ch. D. at p. 422 *et seq.*; *Otto* v. *Linford* (1881), 46 L. T. 35, C. A.; *Clippens* v. *Henderson* (1881), 4 S. X. 38, I. H.; *Needham* v. *Johnson*, 1 R. P. C. at p. 58, C. A.; *Horrocks* v. *Stubbs*, 3 R. P. C. 229; *Automatic Weighing Machine Coy.* v. *Knight*, *ubi supra*; *Edison* v. *Smith*, 11 R. P. C. at p. 400, C. A.; *Parkinson* v. *Simon*, 12 R. P. C. at p. 411, H. L.; *Young* v. *Morris*, 12 R. P. C. at p. 463, H. L.; *Cooper's Patent Coy.* v. *London County Council*, 13 R. P. C. at p. 295; *Hattersley* v. *Hodgson*, 23 R. P. C. at p. 203, C. A.; *Van Berkel* v. *Simpson*, 23 R. P. C. at p. 259; *Bosworth* v. *Components, Ltd.*, 24 R. P. C. 772. The Courts apply this principle the more readily where the invention is meritorious. *Patent Exploitation Coy.* v. *Siemen's*, 20 R. P. C. 234, C. A.

(*f*) *Adie* v. *Clark* (1876), 24 W. R. 1008; *Simpson* v. *Holliday* (1866), L. R. I. H. L. 315; *Presto* v. *Orme*, 18 R. P. C. at p. 23, C. A.; *Leadbeater* v. *Kitchin*, 7 R. P. C. at p. 244, C. A. *Electric Construction Coy.* v. *Imperial Tramways Coy.*, 16 R. P. C. 630; *Incandescent Gas Coy.* v. *De Mare Incandescent System*, 13 R. P. C. 320.

(*g*) *Clippens* v. *Henderson* (1881), 4 S. X. 38, I. H.; *Tubes, Ltd.* v. *Perfecta, Ltd.*, 20 R. P. C. at p. 95, H. L.

(*h*) See p. 122 *et seq.*

(*i*) See *n.* (*e*), *supra*.

(*k*) *Arnold* v. *Bradbury* (1871), 6 Ch. App. at p. 712; *Plimpton* v. *Spiller* (1877), 6 Ch. D. at p. 426;

the specification should be read first (*l*). Although a patentee can by clear language claim what he will (*m*), the natural course is to take the claims as referring to the invention described, and not to something substantially larger or substantially different, even if the claims do not explicitly refer back to the body of the specification (*n*). The claims (which are of com-

Parkinson v. *Simon*, 11 R. P. C. 407, H. L.; *Edison* v. *Smith*, 11 R. P. C. 395, C. A.

(*l*) *Arnold* v. *Bradbury*, *supra*; *Tubes, Ltd.* v. *Perfecta*, 17 R. P. C. 587.

(*m*) *Cf. Consolidated Pneumatic Tool Coy.* v. *Ingersoll Sergeant Drill Coy.*, 25 R. P. C. 83 H. L.

(*n*) *Illustrative Cases*:—

Where a patent had as a claim "the production by machinery at one operation of gathered work which is simply gathered and secured on itself by stitches," it was held that this was not a functional claim, but must be referred to the machinery described. *Arnold* v. *Bradbury*, (1871), 6 Ch. App. 706.

In a case where there was a claim for the use of a centring device in telegraphic apparatus used for ships or for analogous purposes, it was held that the claim was not too wide, although similar apparatus had been used in looms, calendars, etc., since analogous purposes might well refer to other telegraphs, and in view of the specification would be so interpreted. *Chadburn* v. *Mecham*, 12 R. P. C. 120.

A very important ruling was made by Lord Cairns, viz. that a statement that the patentee did not limit himself to any particular mode of producing his new manufacture did not extend his right to anything substantially beyond what he had previously described. *Binney* v. *Feldtmann* (1875), Griff. 49, H. L.

Where a specification described a method of obtaining certain new chemical bodies and claimed "as new products the colouring matters hereinbefore called anisolines obtained substantially in the manner set forth," it was held that the claim was not general for the bodies produced, but was only for bodies produced in that particular way. *Monnet* v. *Beck*, 14 R. P. C. 777.

Where a specification described a process for the manufacture of iron tubes, the apparatus described containing no mandril such as had hitherto been used, it was held that the claim must be interpreted as only applying to cases where no mandril was employed. *Russell* v. *Cowley* (1834), W. P. C. 459.

In the case of Edison's telephone patent the second claim, which was for the use of a diaphragm as described in an instrument for transmitting electrical impulses by sound, was held to be confined to its use in instruments such as formed the subject of the patent. *United Telephone Coy.* v. *Harrison* (1882), 21 Ch. D. 721.

Where a patentee had invented a machine for sewing bindings on hats, and said that his invention was for a method of putting on bindings so that the ends of the binding were joined subsequent to the binding being sewn on, and before it was turned over, and the first claim was for the method as described (the other claims being for the special machine), it was held that as the only method described was attaching the binding by a machine the claim was confined to this. *Gammons* v. *Battersby*, 21 R. P. C. 332, C. A.

But *cf.* the following case. In the case of a patent for an improved boothook made from a single piece of wire, where the specification described the process of manufacture and claimed a hook having certain characteristics and made from a single piece of wire as above set forth and for the purposes specified, it was held that the claim covered a hook with these characteristics made from a single piece of wire in any way. The case was compromised on appeal. *Bray* v. *Gardner*, 4 R. P. C. 400.

For similar decisions and dicta, see the following cases: *Kay* v. *Marshall* (1836), 1 My. & Cr. at p. 382; *Newton* v. *Vaucher* (1851), 21 L. J. (EX.) 305; *Jackson* v. *Wolstenholme*, 1 R. P. C. at p. 108, C. A.; *Mackie* v. *Berry*, 2 R. P. C. 146; *Easterbrook* v. *Great Western Railway*, 2 R. P. C. 201; *Lister* v. *Norton*, 3 R. P. C. 199;

paratively modern origin) have been defined as disclaimers (*o*), throwing open to the world all the specification contains which they do not cover, and this supports the view that the natural trend of the claim is not to extend, but rather to limit, the invention described in the specification (*p*). In so reading the specification care must be taken to distinguish the introduction which states to what the invention relates, from the description of the invention itself (*q*). The title is, of course, a part of the specification, and in some of the older cases had an important influence on construction (*r*). The drawings being part of the specification must be read with it (*s*), but the Courts are generally unwilling to hold that the drawings define the invention, or confine the claim so as to make something an essential element of the invention which is not mentioned in the letterpress (*t*).

Generally the provisional specification should not be used,

Edison v. *Smith*, 11 R. P. C. at p. 401, C. A.; *Fawcett* v. *Homan*, 13 R. P. C. 398, C. A.; *Perry* v. *La Société des Lunetiers*, 13 R. P. C. at p. 669; *Sunlight Coy.* v. *Incandescent Lighting Coy.*, 14 R. P. C. 757; *Patent Exploitation Coy.* v. *Siemens*, 19 R. P. C. 122; *Tubes, Ltd.* v. *Perfecta*, 20 R. P. C. 77, H. L.; *Patent Exploitation Coy.* v. *American Novelty Coy.*, 22 R. P. C. 316, C. A.; *Max Muller's Patent*, 24 R. P. C. 465.

(*o*) *Illustrative Case:* Where a specification after describing a process of bleaching flour by means of oxides of nitrogen, mentioned that other named re-agents could be used, but in the claim only oxides of nitrogen were mentioned it was held that the claim was limited to the use of these. *Andrew's Patent*, 24 R. P. C. 244, C. A.

See also *Hinks* v. *Safety Lighting Coy.* (1876), 4 Ch. D. at p. 612; *Plimpton* v. *Spiller* (1877), 6 Ch. D. 412, C. A.; *Kay* v. *Marshall*, *supra*; *British Motor Coy.* v. *Andrews*, 18 R. P. C. 85, H. L.

(*p*) As to the limitation of this doctrine, see *Consolidated Pneumatic Tool Coy.* v. *Ingersoll Sergeant Drill Co.*, 25 R. P. C. 61, H. L.

Where, however, something is described in the body of the specification as an invention the tendency is to read the claims as covering it. *Cf. Leadbeater* v. *Kitchin*, 7 R. P. C. 243, C. A.

So too where in the body of the specification a statement is made that the invention can be carried out in various ways, the tendency is not to confine the claims to the special form shown. *Reason Manufacturing Coy.* v. *Moy*, 20 R. P. C. 205, C. A. See also *Pether* v. *Shaw*, 10 R. P. C. 296; *Andrew's Patent*, 24 R. P. C. 364, C. A.

(*q*) *Dudgeon* v. *Thomson* (1877), 3 A. C. 40.

(*r*) See *Newton* v. *Vaucher* (1851), 21 L. J. (EX.) 305; *Oxley* v. *Holden* (1860), 30 L. J. (C. P.) 68.

(*s*) Sect. 2 (3).

(*t*) *Illustrative Case:* Where the claims of a patent for the use of an auxiliary condenser for condensing glycerine referred to the body of the specification, and the drawings showed what was probably a tubular condenser, it was held that the claims were not limited to this special form of condenser. *Scott's Patent*, 20 R. P. C. 257, C. A.

See also *Tolson* v. *Speight*, 13 R. P. C. 718; *Clark* v. *Adie* (No. 1) (1877), 2 A. C. at p. 342, H. L.; *Hinks* v. *Safety Light Coy.* (1876), 4 Ch. D. 607; *Rhodes* v. *British Cotton and Wool Dye Association*, 28 R. P. C. 67; *Palmer Tyre Coy.* v. *Pneumatic Tyre Coy.*, 16 R. P. C. at p. 480; *British Motor Traction Coy.* v. *Friswell*, 18 R. P. C. 497; *Crothwaite* v. *Moorwood*, 11 R. P. C. 561. But in *Hattersley* v. *Hodgson*, 23 R. P. C. 192, H. L., it was held that the invention might

to construe the complete (*u*), though; of course, where disconformity is raised it could be argued that if a certain construction were adopted the patent would be bad on that ground (*v*). An unamended specification must not be used in any way for the construction of the amended specification, though possibly it could be referred to as a contemporary document to show the knowledge of the time or the use of technical terms (*x*).

The claims will also in general be interpreted so as to avoid making the patentee claim what is stated in the specification to be old, whether directly or by reference to other specifications. This may lead to a claim which is not on the face of it a subsidiary claim being so interpreted (*y*).

Where there were several classes of systems or apparatus known at the date of the grant (*z*), and the whole description refers to one of these, the Court is generally unwilling to interpret the claims as covering systems or apparatus of other classes, more especially if the problems to be solved are different (*a*).

So if there is a statement as to the evils to be overcome (*b*) or

be confined to the exact thing shown in the drawings in order to meet the objection of non-utility.

(*u*) In particular it is not a proper method of construction to hold that because something is expressly mentioned in the provisional, and not expressly mentioned in the complete, it is therefore outside the claims of the patent. *Sandow* v. *Szalay*, 23 R. P. C. 6, H. L.

The rule, however, has not been absolutely adhered to, *e.g.*

In *Bailey* v. *Roberton* (1879), 3 A. C. 1055, H. L. the provisional was looked at to identify invention.

In *Parkinson* v. *Simon*, 11 R. P. C. 493, C. A., it was used to explain the working of patentee's machine, and in *Perry* v. *La Société des Lunetiers*, 13 R. P. C. 664, a claim was confined by reference to it.

It also seems to have been referred to in the course of the hearing in *Hay* v. *Gonville*, 25 R. P. C. 164; s. c. also *Marine Torch Coy.* v. *Holmes*, 29 R. P. C. 695.

(*v*) *Cf.* order of H. L. in *Bailey* v. *Roberton*, *supra*.

(*x*) See p. 236, *n.* (*s*).

(*y*) *Tubes, Ltd.* v. *Perfecta*, 20 R. P. C. at p. 95, H. L., and see p. 125.

(*z*) A different rule applies where they were not so known, see p. 150, *n.* (*u*).

(*a*) *Illustrative Case:* In the case of a patent for an atmospheric hammer (there being two well-known classes of these, one with the lower end open where the fall was by gravity, and the other with an air chamber closed at both ends, the hammer being raised and lowered by pressure on one side or the other), the patentee had throughout described an apparatus of the first kind and spoke in his claims of the closed end of the cylinder. The problems to be faced in the two cases were different. It was held that the patent did not include hammers of the second class. *Pilkington* v. *Massey*, 21 R. P. C. 696, C. A.

See also *Cleaver* v. *Wallwerk*, 13 R. P. C. 277; *British Tanning Coy.* v. *Groth*, 8 R. P. C. 113; *Downes* v. *Falcon Engine & Car Works, Ltd.*, 3 R. P. C. 70, C. A.; but *cf. Acetylene Illuminating Coy.* v. *United Alkali Coy.*, 22 R. P. C. 145, 155, H. L.

(*b*) *Jackson* v. *Wolstenholme*, 1 R. P. C. 105, C. A.; *Clay* v. *Allcock*, 23 R. P. C. at p. 750, C. A., and cases at p. 138 (*u*).

as to the advantages of the invention (*c*), the claim may be read as restricted to forms accomplishing these objects or having these advantages.

In some cases the rest of the specification may widen the apparent meaning of a claim by showing that other means may be substituted for some part (*d*), or that part of the apparatus is merely for convenience and not essential (*e*), or that words apparently introducing a fresh integer into the claim are merely for the purpose of identifying another integer (*f*). So on the other hand if the draftsman has been careful to mention where variations may be made, this may have the effect of excluding variations in other parts.

Second Rule

What is not claimed is disclaimed

The next rule is that what is not claimed by the claiming clauses is held to be disclaimed. This rule has really a two-fold effect. Firstly, it recognises and defines the true function of the claiming clauses, and secondly, it emphasises that the grant of a patent is the grant of a definite legal monopoly defined by the claiming clauses, and that there is no infringement unless such monopoly is invaded (*g*).

It was not till the judgment of the House of Lords in *Harrison* v. *Anderston Foundry Company* (*h*), in 1876, that the rule was clearly laid down that the claiming clauses measured

(*c*) *Martin* v. *Consett Iron Coy.*, 25 R. P. C. at p. 34, C. A.

(*d*) See p. 138.

(*e*) See p. 143.

(*f*) *Illustrative Case:* In the case of a patent for a method of using spent shale to heat the retorts in which distillation was conducted, a common fire chamber was described, and also a particular type of valve in the passage leading to it. The third claim was "the applying of a valve in the passage or space through which the contents of each retort are transferred to the common fire chamber such valve (followed by a description of the valve)." It was held that the reference to the common fire chamber was only to identify the valve shown, and that the patent was infringed by the use of a similar valve in apparatus in which there was no common fire chamber. *Clippens* v. *Henderson* (1881), 4 S. X. 38 I. H.

See also *Lister* v. *Dix*, 16 R. P. C. 89 (where, however, the limitation was not in the claim itself).

(*g*) "There is, by some confusion of ideas, a notion sometimes entertained that there may be something like an infringement of the equity of a patent. I cannot think that there is any sound principle of that kind in our law. That which is protected is that which is specified, and that which is held to be an infringement, must be an infringement of that which is specified." *Dudgeon* v. *Thomson* (1877), 3 A. C. *per* Cairns, L.C., at p. 44.

(*h*) *Harrison* v. *Anderston Foundry Coy.* (1876), 1 A. C. 574.

This case has been frequently followed, but the rule is so well established that it is unnecessary to give the later cases.

the whole extent of the monopoly, and that matters described and not claimed were not included in such monopoly. Prior to this the general rule of construction had been that if anything was described in the specification, and not stated expressly or by implication to be old, it was held to be claimed (*i*). This decision was really a recognition of the alteration which had gradually grown up in the mode of drafting patents by inserting at the end claiming clauses to define the monopoly sought (*k*). The change in the method of interpretation marked by this case is all-important in considering the effect of earlier decisions on modern cases.

Combination claims.

It therefore follows that even if an invention is described in the specification it does not come within the monopoly unless it is claimed (*l*). This rule is particularly important with regard to combination claims. If a combination only is claimed the separate integers or subsidiary combinations, though these may in fact be new, are not covered by the grant and the taking of these parts, except in the combination claimed or an equivalent combination, does not constitute infringement (*m*).

(*i*) Good examples of the old method of construction are to be found in: *Carpenter* v. *Smith* (1841), W. P. C. 530; *Tetley* v. *Easton* (1854), 23 L. J. (Q. B.) 77; *De La Rue* v. *Dickinson* (1857), 7 E. & B. 738; *Lister* v. *Leather* (1858), 27 L. J. (Q. B.) 295; *Patent Bottle Envelope Coy.* v. *Seymour* (1858), 28 L. J. (C. P.) 22.

(*k*) It was not till the Act of 1883 that there was any direction to insert a claiming clause, and it has been held that even this provision is only directory. See *Siddell* v. *Vickers*, 7 R. P. C. 292, H. L.; *Kelly* v. *Heathman*, 7 R. P. C. 343; *Tubes, Ltd.* v. *Perfecta*, 20 R. P. C. 77, H. L.

(*l*) *Illustrative Case:* Where a patentee described a method of casting the cogged rim of a wheel in one piece, turning and fitting so as to make it fit the inner wheel and cutting into segments which were then attached to wheel, the patent was held not to be infringed by taking the turning and fitting processes only. *Jackson* v. *Wolstenholme*, 1 R. P. C. 105, C. A.

See also *Harrison* v. *Anderston Foundry Coy.* (1876), 1 A. C. 574; *Clarke* v. *Adie*, (No. 1) (1877), 2 A. C. 320, 667; *Harrison* v. *Nicholson*, 25 R. P. C. 404, 405 C. A.; *Plating Coy.* v. *Farquharson* (1879), Griff. 187, H. L.; *Nordenfeldt* v. *Gardner*, 1 R. P. C. at p. 65; *Moore* v. *Bennet*, 1 R. P. C. 129, H. L.; *Thomson* v. *Moore*, 6 R. P. C. at p. 440, C. A. Ir.; *Automatic Diversions Syndicate* v. *Urry*, 14 R. P. C. 365; *Bunge* v. *Higginbottom*, 19 R. P. C. at p. 199, C. A.; *Hardtmuth* v. *Baker*, 22 R. P. C. 66.

This clear modern rule renders it unnecessary to consider such suggested rules as that to constitute infringement the part taken must itself have been capable of being patented. See *Tatham* v. *Dania* (1869), Griff. 213.

The rule that a subordinate integer or combination is not protected unless it is separately claimed is often applied, consciously or unconsciously by the Courts, in refusing to interpret the omnibus claim for the apparatus as described as being for some integer or subordinate combination not claimed separately elsewhere. See *Consolidated Car Heating Coy.* v. *Came*, 20 R. P. C. 745, P. C.; *Garrard* v. *Edge*, 6 R. P. C. 387, C. A.

(*m*) Even a statement that the invention is applicable to certain purposes other than those mentioned in the claim does not extend the claim so as to make it cover the use of the

Patentee not allowed to extend claim.

The second effect of this rule is to prevent a patentee, once he has defined his monopoly, from seeking to extend it by showing that his invention was really wider than his claims. Even if this is so it is irrelevant, his invention has been given to the world and the public are at liberty to make use of it, as well during the term of the patent as after, so long as they do not infringe upon the monopoly defined by the claims (*n*), which monopoly is the consideration which the inventor has sought and received.

The importance of the rule that a patèntee, who has represented to the public that he only has a limited monopoly, is not allowed to afterwards contend that he has wider rights, and could safely have made a broader claim, is shown by the number of cases in which attempts have been made to break through it, but without success (*o*). This rule

invention for those purposes. *Lyon* v. *Goddard*, 11 R. P. C. 113, H. L.; *Vickers* v. *Siddell*, 7 R. P. C. 306, H. L.; *Orley* v. *Holden* (1860), 30 L. J. (C. P.) 68.

Of course if there is a claim to the article *per se* this covers its use for any purpose. *Adhesive Dry Mounting Coy.* v. *Trapp*, 27 R. P. C. 341, and p. 150, *n.* (*s*).

(*n*) See p. 119, *n.* (*q*).

(*o*) *Illustrative Cases*:—

Where a patent claimed the production of explosives from soluble nitro-cellulose, and the defendant had found that the same process was also applicable to insoluble nitro-cellulose, it was held that the patentee was bound by his claim, and that there was no infringement. *Nobel* v. *Anderson*, 12 R. P. C. 164 H. L. See also *British Ore Concentration Coy.* v. *Minerals Separation Coy.*, 27 R. P. C. 33 H. L.

Where a patentee had described and claimed a self-centring controlling valve for steering engines, the centring being effected by a special arrangement mentioned in the claim, it was held that the patentee could not extend his claim to cover self-centring controlling valves broadly, even if these were in fact new. *Brown* v. *Hastie*, 23 R. P. C. 361, H. L.

Where in a patent for a sieving machine the patentee had included as part of the combination claimed "rotating arms furnished with brushes fastened to the inner walls of the sieves," it was held that having thus limited his claim, for whatever reason, he could not extend it to cover machines in which the brushes were fastened to the outer walls. *Bunge* v. *Higginbottom*, 19 R. P. C. 187, C. A.

So where a patentee claimed dies for folding strips of iron with an opening for tongs in the upper part, it was held that a similar die with the opening in the lower part did not infringe. *Stewart* v. *Bell's Trustees* (1883), 4 S. XI., 236.

Where a patentee claimed a clinical thermometer having two chambers formed in the ordinary bore with a constriction at the end of each, it was held that a thermometer with only one chamber having a constriction at each end was no infringement. *Hicks* v. *Simmons*, 21 R. P. C. 632, C. A.

Where a patentee claimed adding heated manganese to the liquid stream of steel metal as it came from the furnace, it was held not to be infringed by adding cold manganese. *Siemens* v. *Taylor*, 9 R. P. C. 393.

Where a patentee described a process for making certain new dyes and claimed "as new products colouring matters from dyes hereinbefore called anisoline obtained substantially in the manner set forth," it was held that the claim was confined to dyes made in the way described, whether or not a claim to the product *per se* would have been good had it been made. *Monnet* v. *Beck*, 14 R. P. C. 777.

See dicta in *Nobel* v. *Anderson*, 11

is applied with special strictness where there has been a disclaimer (*p*).

Third Rule

The Specification must be interpreted as it would be by a person skilled in the art

The specifications of Letters Patent are addressed to those skilled in the art to which such Letters Patent relate, and must be interpreted by the Courts as they would be interpreted by such persons (*q*). This means considerably more than the Court takes cognisance of the technical meaning of the terms used. With regard to the determination of the scope of a patent, it implies that the Court must read the specification and claims in the same spirit as such a competent craftsman would, and must consider whether a claim so read would represent to him that the invention lay in the general methods described by the patentee, or in the particular mechanical devices chosen by him. In order to determine this it is generally necessary that the Court should be instructed as to the prior state of the art (*r*).

R. P. C. at p. 128; *Hinks* v. *Safety Lighting Coy.* (1876), 4 Ch. D. at p. 612; *Dudgeon* v. *Thomson* (1877), 3 A. C. at p. 43; *Thomson* v. *Moore*, 6 R. P. C. at p. 440, C. A. Ir.; *Monnet* v. *Beck*, 14 R. P. C. 843.

And for further illustrative cases:

British Tanning Coy. v. *Groth*, 8 R. P. C. 113; *Hayes* v. *Hallmark*, 9 R. P. C. 25; *Nettlefold* v. *Reynolds*, 9 R. P. C. 270; *Siemens* v. *Taylor*, 9 R. P. C. 393; *Lancashire Explosive Coy.* v. *Roburite Explosive Coy.*, 14 R. P. C. 303, 311, H. L.; *Peters* v. *Owen*, 15 R. P. C. 663; *Welsbach Incandescent Coy.* v. *Daylight Coy.*, 17 R. P. C. 141, 146, C. A.; *British Motor Syndicate* v. *Andrews*, 18 R. P. C. 85, 94, H. L.; *Dunlop Pneumatic Tyre Coy.* v. *Moseley*, 18 R. P. C. 411; *Bunge* v. *Higginbottom*, 19 R. P. C. 187, H. L.; *Pilkington* v. *Massey*, 21 R. P. C. 696, C. A.; *Ackroyd* v. *Thomas*, 21 R. P. C. 737, C. A.

Cf. contra obiter dictum in *Watling* v. *Stevens*, 3 R. P. C. at p. 147, C. A., which seems hardly reconcilable with these decisions. Probably the most successful attempt to evade this rule will be found in *Incandescent Gas Light Coy.* v. *De Mare Incandescent System*, 13 R. P. C. 559, C. A., explained and distinguished in *Welsbach Incandescent Coy.* v. *Daylight Coy.*, *supra*.

(*p*) "A patentee who disclaims cannot be permitted to play fast and loose with the public. If he alters the terms of his claim originally wide and general by inserting limiting words he must be bound by the limitation which he has so designedly introduced." *Plating Coy.* v. *Farquharson* (1883), Griff. at p. 187. See also *Peters* v. *Owen Stone Coy.*, 17 R. P. C. p. 80; *Palmer Tyre Coy.* v. *Pneumatic Tyre Coy.*, 16 R. P. C. at p. 485; *Seed* v. *Higgins* (1858), 8 H. L. C. 551.

But *cf. Hocking* v. *Hocking*, 4 R. P. C. 439, C. A.

(*q*) *British Dynamite Coy.* v. *Krebs* (1879), 13 R. P. C. 192, H. L.; *Presto* v. *Orme*, 18 R. P. C. at p. 23; *Scott's Patent*, 20 R. P. C. 262;

(*r*) *Gandy* v. *Reddaway*, 2 R. P. C. 58, C. A.; *Sugg* v. *Bray*, 2 R. P. C. 230; *Fletcher* v. *Glasgow Gas Commissioners*, 4 R. P. C. 388, O. H.

Application of this rule.

The above remarks must not be understood to mean that there are two classes of patents with different rules of construction according to the nature of the invention (*s*). The same broad rules apply to all patents and the monopoly is in all cases decided by the claims. In the case of an absolutely new departure the claims may be so drawn as to render the monopoly very limited, while in the case where the only invention is a choice of particular means the claims may be so drawn that the monopoly sought is a very broad one, though, of course, in this case the patent would be bad. Where the problem before the Court is clearly decided by the wording of the specification and claims these secondary considerations do not apply, but in a very large number of cases the claims cannot be properly interpreted without comparison between what is described in the specification and what was previously generally known, and it is to such cases that the above rule applies.

True rule of interpretation.

The true interpretation of the grant is therefore to be arrived at by considering what a competent craftsman reading the specification at the date of the grant would have understood the patentee to have claimed (*t*). All later knowledge should be eliminated (*u*), as should knowledge which would not be possessed by such craftsman (*x*).

But it is for the Court, when properly instructed, to fill the place of the craftsman, and a specification must be construed from its own contents, including of course anything incorporated by reference (*y*). The evidence of experts, or of the inventor himself, is therefore not admissible on any question of construction, though of course they are entitled to instruct the Court on the state of public general knowledge and the meaning of terms, and they may draw the attention of the Court to points which it might otherwise have missed (*z*).

Construction claiming what

One effect of this rule is that the Courts are strongly averse

(*s*) *Nobel* v. *Anderson*, 11 R. P. C. 523, C. A.; but *cf. Collins* v. *Green*, 29 R. P. C. 551, C. A.

(*t*) See cases in note (*o*), p. 133, especially *Incandescent Gas Coy.* v. *De Mare Incandescent Coy.*

(*u*) *Badische, etc.* v. *Levinstein*, 4 R. P. C. 449, 463, 465, H. L.; *Vidal Dye Syndicate* v. *Levinstein*, 29 R. P. C. 277, C. A.; *Lane-Fox* v. *Kensington Electric Lighting Coy.*, 9 R. P. C. 241. See also p. 62.

(*x*) *Gandy* v. *Reddaway*, 2 R. P. C. 52, 53, C. A., and p. 245.

(*y*) *Tubes, Ltd.* v. *Perfecta*, 20 R. P. C. at p. 95, H. L.

(*z*) See p. 188.

Of course this evidence to be relevant must deal with what the competent craftsman would have known, not with what the inventor himself knew. *Gandy* v. *Reddaway*, 2 R. P. C. 52, 53, C. A. See also as to evidence by inventor, *Bradford Dyers* v. *Williams*, 18 R. P. C. 220, 232.

is notoriously old to be avoided.

to construing a claim as being for what any competent man must have known to be old, if they can possibly avoid this interpretation. This is not merely because they follow the principle of supporting a patent if it be possible, but also because this is the way in which the person to whom the specification is addressed would naturally interpret the claim (*a*). The principle is similar to that referred to above by which claims are not taken to be for matters which are stated to be old on the face of the specification, though of course in the latter case the effect is even stronger (*b*). But while this is the general and proper line of construction a specification will not be construed to prevent its including something which is clearly claimed (*c*). The application of this rule may lead to a claim being interpreted as a "subsidiary" claim or as being confined to some particular class of apparatus or process (*d*). Of course this rule only applies in the case of matters which are really common knowledge, and which must be presumed to have been known to craftsmen generally and also to the patentee, it has no application to cases of prior user not generally known, or to matter contained in publications, such as specifications, which do not form part of common general knowledge (*e*).

Application to question of infringement.

The rule has also most important applications in connection with what constitutes infringement, but this is so closely connected with the doctrine of equivalents that it will be most conveniently treated in the next chapter (*f*).

(*a*) *Adie* v. *Clark* (1876), 14 W. R. 1008; *Haworth* v. *Hardcastle* (1834), W. P. C., at p. 484; *Oxley* v. *Holden* (1860), 30 L. J. (C. P.) at p. 68; *Morton* v. *Middleton* (1863), 3 S. I. 721; *Plimpton* v. *Spiller* (1877), 6 C. D. 424, C. A.; *Watling* v. *Stevens*, 3 R. P. C. 153; *Spencer* v. *Ancoats Coy.*, 6 R. P. C. 46; *Electrolytic Coy.* v. *Evans*, 17 R. P. C. at p. 741; *Patent Exploitation Coy.* v. *Siemens*, 20 R. P. C. 234, C. A.; *Cooper Patent Coy.* v. *London County Council*, 23 R. P. C. 289; *Browns Patent*, 25 R. P. C. 114, C. A.; *Collins* v. *Green*, 29 R. P. C. 557, C. A..

In *Hinde* v. *Osborne*, 2 R. P. C. 66, C. A., it was suggested that this did not apply when patent purported to be for a new article and not for an improvement, *s. q.*

(*b*) See *Tubes, Ltd.* v. *Perfecta*, 20 R. P. C., at p. 97, H. L.

(*c*) *Clark* v. *Adie* (1877), 2 A. C., at p. 437; *Cropper* v. *Smith*, 1 R. P. C. 81, C. A.; *Sugg* v. *Bray*, 2 R. P. C. 223; *Leadbeater* v. *Kitchin*, 7 R. P. C. 233, C. A.; *Hinks* v. *Safety Lighting Coy.* (1876), 4 Ch. D. 607; *Webb* v. *Kynoch, Ltd.*, 17 R. P. C., at p. 116, H. L.; *Electric Construction Coy.* v. *Imperial Tramways Coy.*, 17 R. P. C., at p. 550, C. A.; *Turnbull* v. *Cruikshank*, 22 R. P. C. 521, O. H.

(*d*) See *Plimpton* v. *Spiller*, *supra*, and p. 118, *n.* (*y*).

(*e*) *Adie* v. *Clark* (No. 2) (1876), 3 Ch. D. 134, C. A. For cases where such evidence has been excluded, see LICENCES, p. 245, *n.* (*q*).

The fact that the patentee or his agent know of such publication would not matter; it is the interpretation to the trade that has to be ascertained: *cf. Webb* v. *Kynoch*, 15 R. P. C., at p. 577, C. A. Ir.

(*f*) See p. 132 *et seq.* The rule that a specification must be interpreted in view of the state of general knowledge

Rules as to the bearing of one Claim on the Construction of another

Claims *primâ facie* not co-extensive.

The general tendency is to construe claims in different language as not being co-extensive, although one may be construed as being merely for a special part of the monopoly claimed by the other (*g*). But this is by no means an absolute rule (*h*), and there are many cases in which, by reason of wording of the specification as a whole, or of the subject-matter of the patent, a series of claims have been construed as being practically identical (*i*). Again the Courts do not seek to differentiate the omnibus claim generally found at the end of a specification from those which have gone before (*k*).

Subsidiary claims.

Where in addition to the main claim there are claims beginning "*in a machine* of the class described and claimed in claim so and so" these claims are construed as subsidiary or appendent, *i.e.* as claims not extending the monopoly covered by the former claim. But where the later claims do not contain such introductory words, or refer merely to a machine of the class described, and then refer to certain specific integers, they are generally interpreted as for such integers, even if

at the date of the grant, being a true rule of construction, applies of course whether validity is challenged or not. *Spencer* v. *Ancoats Coy.*, 6 R. P. C. 46; *Ashworth* v. *Roberts*, 9 R. P. C. 109, C. A.; *Schermully* v. *Paine*, 18 R. P. C. 520: see also cases at p. 246, *nn.* (*o*) (*p*).

(*g*) *Illustrative Cases*:—

Where the first claim was for the construction of ships having an iron frame, combined with external wooden planking, and a later claim was practically identical with the addition of the words "as described," it was held that the first claim was for the combination generally and was not confined to the particular form described. *Jordan* v. *Moore* (1866), 35 L.J. (C. P.) 268.

Where the first three claims were for apparatus as described having a sieve and deposit surface and the fourth claim was for such apparatus having also a deflector, it was held that the deflector formed no part of the combination claimed in the earlier claims. *Parkinson* v. *Simon*, 12 R. P. C. 403, 407, H. L. See also, *Bailey* v. *Roberton* (1877), 4 S. IV, 245, I. H.; *Lawrence* v. *Perry*, 2 R. P. C., 184; *Rowcliffe* v. *Longford Wire Coy.* 4 R. P. C., p. 283; *Edison* v. *Smith*, 11 R. P. C., p. 400, C. A.; *Deeley's Patent*, 12 R. P. C. 73; *Cassel Gold Extracting Coy.* v. *Cyanide Recovery Syndicate*, 12 R. P. C. 232, C. A.; *Kane* v. *Guest*, 16 R. P. C. 433; *Electric Construction Coy.* v. *Imperial Tramways Coy.*, 17 R. P. C. 537, C. A.; *Wilson Brothers, Ltd.* v. *Wilson & Coy.*, 20 R. P. C. 1, H. L.; *Kelvin* v. *Whyte Thomson*, 25 R. P. C. 177; *Rickerby* v. *Duncan*, 25 R. P. C. 248; *British United Shoe Machinery Coy.* v. *Collyer*, 26 R. P. C. 21; *Wallace* v. *Jack*, 22 R. P. C. 502, O. H.; *Graphic Arts Coy.* v. *Hunters, Ltd.*, 27 R. P. C. 677.

(*h*) "It is not a ground for invalidating a specification that it claims the same thing over again in different language." *Van Berkel* v. *Simpson*, 24 R. P. C., at p. 137, I. H.; see also *Edison* v. *Smith*, *supra*; *Wenham Gas Coy.* v. *Champion Gas Coy.*, 9 R. P. C. at p. 55.

(*i*) *E.g. American Braided Wire Coy.* v. *Thompson*, 6 R. P. C. 518; *Duckett* v. *Whitehead*, 12 R. P. C. 657, C. A., where the whole of the claims were interpreted as for the special combination.

(*k*) *Cf. Consolidated Car Heating Coy.* v. *Came*, 20 R. P. C. 745, P. C., but see *contra Presto* v. *Orme*, 18 R. P. C. 25, C. A.; *Annand* v. *Taylor*, 18 R. P. C. 53, H. L.

these were known to be old, and must stand or fall without reference to the patentability of other parts of the apparatus (*l*). If, however, the claims are not for a combination of integers, but for an application or mode of use notoriously old, the tendency is to read them as confined to such application or mode of use of the invention before claimed, and not of things in general (*m*). But where the use of an integer in a particular novel manner is claimed in one claim and the integer alone in another, this last is construed as being for the integer *per se* (*n*).

(*l*) *Illustrative Cases* :—

Where a specification described a bootnailing machine having special methods of feeding the work, holding the nail, etc., and one of the later claims was, "In a machine for driving hobnails into boots the use of a side guard, etc. . . . substantially as described," it was held that the claim was for the use of a side guard in any such nailing machine and not merely with the particular machine claimed. *British United Shoe Machinery Coy.* v. *Claughton*, 24 R. P. C. 33, C. A. See also *Roberts* v. *Heywood* (1879), 27 W. R. 454; *Cropper* v. *Smith*, 1 R. P. C. 81, C. A.; *Britain* v. *Hirsch*, 5 R. P. C. 226, C. A.; *Haws* v. *Harding*, 14 R. P. C. 930, C. A.; *Dowler* v. *Keeling*, 15 R. P. C. 214, C. A.; *Taylor* v. *Annand*, 17 R. P. C. 126, 137, C. A.; *Consolidated Pneumatic Tool Coy.* v. *Ingersol Sergeant Drill Coy.*, 25 R. P. C. 574, H. L.; *British United Shoe Machinery* v. *Claughton*, 23 R. P. C., at p. 335; *Klaber's Patent*, 23 R. P. C. 461, C. A.

The case of *Finlay* v. *Allen* (1857), 2 S. XIX. 1087, would seem hardly reconcilable with these cases. The same remark applies to the dicta in *Kelly* v. *Heathman*, 7 R. P. C., at p. 348.

In the case of a machine of a wholly new type the expression "in a machine of the class described" might be sufficient to confine a claim to the special machine. *Cf. Van Berkel* v. *Simpson*, 24 R. P. C. at p. 137; *Van Berkel* v. *Booth*, 23 R. P. C. 573.

The mere fact that one integer is described as "for use with" another will not make the claim a combination claim. *Rowcliffe* v. *Longford Wire Coy.*, 4 R. P. C. 281.

(*m*) *Illustrative Cases* :—

In the case of a patent for a new explosive "dynamite" the second claim was for detonating this explosive with a known fuse. *Held*, appendent. *British Dynamite Coy.* v. *Krebs* (1879), 13 R. P. C. 190, H. L.

In a patent for a pneumatic tyre there was a claim for attaching the patented tyre by means not shown in the provisional. Held Appendent. *Pneumatic Tyre Coy.* v. *Casswell*, 13 R. P. C. 104.

Where the specification described and claimed a special runner for skates, and also described old means of fixing them, and there was a second claim for the mode of securing the runners and making them reversible "as above described," it was held to be confined to the use of this mode for the special runners. *Plimpton* v. *Spiller* (1877), 6 Ch. D. 412. See also *Betts* v. *Menzies* (1857), 10 H. L. C. 117; *Betts* v. *Neilson* (1866), 3 Ch. App. 420.

(*n*) See *Wilson Brothers, Ltd.* v. *Wilson & Coy.*, 20 R. P. C. 1, H. L.

For cases where claims have been held to be appendent, see *Ehrlich* v. *Ihlee*, 5 R. P. C. 437, C. A.; *Edison* v. *Smith*, 11 R. P. C. 389, C. A.; *Parker* v. *Satchwell*, 18 R. P. C. 299; *Halden* v. *Hall*, 21 R. P. C. 609; *Van Berkel* v. *Booth*, 23 R. P. C. 573, Ir.; *Van Berkel* v. *Simpson*, 24 R. P. C. 117, I. H.; *True and Variable Electric Lamp Coy.* v. *Bryant*, 25 R. P. C. 461; *Finlay* v. *Allen* (1857), 2 S. XIX. 1087. For cases where an opposite view has been taken, see *Britain* v. *Hirsch*, 5 R. P. C. 226, C. A.; *Kinmond* v. *Keay*, 20 R. P. C. 497; *Klaber's Patent*, 23 R. P. C. 461, C. A.; *Osmond's* v. *Balmoral Cycle Coy.*, 15 R. P. C. 505; and on the general question of appendent claims, *British Dynamite Coy.* v. *Krebs*, *supra*; *Pneumatic Tyre Coy.* v. *Casswell*, *supra*.

Other Points of Construction

Claim presumed to be for single invention.

The general tendency is to construe a single claim as being for one invention unless the words clearly show it is not so. Thus a claim for A and B is construed as a claim for the combination and not for A and B separately (*o*). In the case of claims such as "the herein-described improvements in the process of and apparatus for so and so" the question whether the claim is for the two matters jointly or separately will depend on the exact wording of the title and specification (*p*).

Interpretation of "or."

Generally speaking two processes or parts connected by the word "or" are to be understood as different alternatives (*q*), though in some cases this word is simply taken as introducing another definition of a technical term (*r*).

In the case of technical terms if it appears from the whole specification that they have been used in a sense different from

(*o*) *Illustrative Case:* In the case of a claim for "forming continuous supply and discharge conduits substantially as described" the Court were of opinion that the claim only covered apparatus in which *both* conduits were so formed. This was partly on the ground that any other construction would have made the patent bad. *Needham* v. *Johnson*, 1 R. P. C. 49, C. A.

For cases where a single claiming clause was construed as two claims, see *Dowler* v. *Keeling*, 15 R. P. C. 214, C. A.; *Tolson* v. *Speight*, 13 R. P. C. 718.

Generally each claim must be taken by itself, see *Haws* v. *Harding*, 14 R. P. C. 932, C. A.; but in *Kelly* v. *Heathman*, 7 R. P. C. 343, three separate claims were taken as for one combination.

(*p*) Cases where claim held to be single:—

Patent for "improvements in distillation of shale and apparatus therefor" held for one invention only. *Clippens* v. *Henderson* (1188), 4 S. X. 38, I. H.

A claim for "the metal fittings and the mode of applying the same described herein" held not to be a claim for the fittings apart from the mode of application. *Oxley* v. *Holden* (1860), 30 L. J. (C. P.), 68. Whereas in *Dowler* v. *Keeling*, *supra*, and *Tolson* v. *Speight*, *supra*, the claim was held to be for the two matters separately.

(*q*) *Simpson* v. *Holliday* (1866), L. R. 1 H. L. 315; *Elliot* v. *Turner* (1845), 15 L. J. (C. P.) 49.

(*r*) *E.g.* in the following cases:—

"Hydrated or precipitated oxides of iron," *Hills* v. *London Gas Coy.* (1850), 29 L. J. (EX.) 409; *Hills* v. *Liverpool Gas Coy.* (1862), 32 L. J. (CH.) 28; "semi solid or plastic." *Patent Exploitation Coy.* v. *Siemens*, 21 R. P. C. at p. 547, H. L. See also *Patent Exploitation Coy.* v. *American Electrical Novelty Coy.*, 22 R. P. C. 316, C. A. "In line with or parallel to," *White* v. *Bertrams*, 14 R. P. C. 735, I. H.; "conditioning or improving," *Flour Oxidising Coy.* v. *Hutchinson*, 26 R. P. C. 597.

Where a specification prescribed the use of "soft or organzine silk such as is used in the making of satin," the Judge directed the jury that only the use of "organzine" silk would be an infringement. A new trial was ordered on the ground of misdirection because "or" was primarily disjunctive, though there might be evidence such as that organzine silk was the only silk used for making buttons at the date of the patent, which would justify the jury finding otherwise. On the second trial the verdict was for the plaintiff and was not disturbed. *Elliot* v. *Turner* (1846), 2 C. B. 446.

In the case of an alleged anticipation in which mention was made of "a groove or a projection or collar," the H. L. reversing the C. A. held that these must be taken to have been mentioned as equivalents and not

the ordinary, that sense will be adopted (*s*). In other cases the sense in which the ordinary craftsman in this country (*t*) would have understood them at the date of the patent is the right one (*u*). The Court will adopt the ordinary interpretation in preference to the strictly scientific one (*x*).

Tho ordinary meaning of technical terms are questions of fact (*y*).

"Substantially as described."

There is considerable difficulty in assigning any consistent meaning to the phrase "substantially as described," which is found in so many claims. It has been said that these words only express what the law implies (*z*), but in general they exercise a limiting effect on the claim by tying it more closely to the preceding description (*a*).

Many claims are for the combination of certain integers substantially as described. Where these integers are designated in the claim in general terms the limitation applies to the method of combination and not to the particular integers so as to confine them to the precise form shown (*b*), or to make

as alternatives acting in different ways. *Kaye* v. *Chubb*, 5 R. P. C. 641, H. L.

(*s*) "Of course it (*i.e.* conduit) does mean that which the patentees have said it means. You are not to look into the dictionary to find out what conduit means, but you are to look at the specification to see in what sense the patentees have used it." *Needham* v. *Johnson*, 1 R. P. C. 49.

See also *Patent Exploitation, Ltd.* v. *American Electrical Novelty Coy.*, 22 R. P. C. 316, C. A.; *Cutler's Patent* (1836), W. P. C. 418; *United Telephone Coy.* v. *Bassano*, 3 R. P. C. 315, C. A.; *Edison* v. *Woodhouse*, 4 R. P. C. 79, C. A.; *Lister* v. *Dix*, 16 R. P. C. 89; *Jandus Arc Lamp Coy.* v. *Johnson*, 17 R. P. C. 361; *Bowden's Patent*, 22 R. P. C. 49; *Brown's Patent*, 24 R. P. C. 313; 25 R. P. C. 119, C. A.; *Rogers* v. *Cochrane*, 26 R. P. C. 596, H. L.

(*t*) *Wegman* v. *Corcran* (1878), 13 Ch. D. 65; *Plating Coy.* v. *Farquharson* (1883), Griff. 187.

(*u*) *Clegg's Patent* (1829), W. P. C. 103; *Betts* v. *Menzies* (1857), 10 H. L. C. 117; *Muntz* v. *Foster* (1843), 2 W. P. C. 96; *Plating Coy.* v. *Farquharson*, *supra*; *Badische, etc.* v. *Levinstein*, 4 R. P. C. 463, H. L.; *Lane-Fox* v. *Kensington Electric Lighting Coy.*, 9 R. P. C. 241, 242; *Welsbach Incandescent Coy.* v. *New Incandescent Coy.*, 17 R. P. C. 237.

(*x*) *Simpson* v. *Holliday* (1866), L. R. 1 H. L. 315.

(*y*) *M'Dougall* v. *Girdwood* (1867), 3 S. V. 937, I. H.; *Betts* v. *Menzies*, *supra*; *Betts* v. *Neilson*, 3 Ch. App. 429; *Badische, etc.* v. *Levinstein*, *supra*.

(*z*) As to "substantially" being mere verbiage, see *Young* v. *Rosenthal*, 1 R. P. C. 29; *Westinghouse* v. *L. & Y. Rail. Coy.*, 1 R. P. C. 220.

(*a*) A good example will be found in the case of *Hattersley* v. *Hodgson*, 21 R. P. C. 517, C. A. See also *Miller* v. *Clyde Bridge Coy.*, 9 R. P. C. 480, H. L.; *Brooks* v. *Lamplugh*, 15 R. P. C. 49, C. A.

(*b*) *Illustrative Case:* In the case of a claim for "the application of a shuttle in combination with a needle as shown in sheet one of the drawings . . . whatever be the means employed for making and working such shuttle and needle when employed together," it was held that "as shown in Fig. 1," applied to the combination and not to the needle, and that the claim was not confined to the particular needle. *Thomas* v. *Foxell* (1858), 5 Jur. (N. S.) 37.

See also *Consolidated Pneumatic Coy.* v. *Ingersoll Sergeant Drill Coy.*, 25 R. P. C. 61, H. L.; *Parkinson* v. *Simon*, 12 R. P. C. 403, H. L.; *Holmes* v. *Associated Newspapers*, 27

essential what the specification describes as optional (*c*), if, however, these are more particularly identified by references to the specification the limitation *may* apply to them also (*d*).

The view has been expressed by the Courts that it is not a proper way of claiming a general principle of construction to describe a particular form and then claim the apparatus as described (*e*).

Where infringement doubtful.

If there is a real doubt as to whether the claim includes what the defendant does, it would seem that he should have the benefit of it. It must be remembered that the words of the specification are those of the patentee, and should be taken more strongly against him. In the case where the doubt would affect the validity of the patent the application of this principle is limited by another maxim—*ut res magis valeat quam pereat*—but in a case where only the scope is affected it may be given full play (*f*).

Anomalous decisions.

Care has often to be taken in applying decisions of the Courts as to construction where the patent has been held to be valid and not to be infringed. There are a number of cases which can only be held to mean that the Court has thought it more merciful to the plaintiff to hold the patent to be confined to the particular example and not to be infringed than to hold it bad, and in such cases

R. P. C. 149, C. A.; *Deeley's Patent*, 12 R. P. C. 73; *Thompson* v. *Macdonald*, 8 R. P. C. 5; *Lawrence* v. *Perry*, 2 R. P. C. 183; *Crosthwaite* v. *Moorwood*, 11 R. P. C. 555; *Acetylene Corporation* v. *United Alkali Coy.*, 22 R. P. C. 145, H. L.; *Gamble* v. *Kurtz* (1846), 3 C. B. 435; *Farbenfabriken, &c.* v. *Chemische Fabrik, &c.*, 22 R. P. C. 517, but see *contra*; *American Braided Wire Coy.* v. *Thompson*, 6 R. P. C. 518, H. L.; *British Motor Traction Coy.* v. *Universal Motor Coy.*, 16 R. P. C. 113; *Duckett* v. *Whitehead*, 12 R. P. C. 376, C. A.; *Knight* v. *Argylls, Ltd.*, 29 R. P. C. 609.

(*c*) *Glover* v. *American Steel and Wire Coy.*, 19 R. P. C. 102; *Vidal Dyes Syndicate* v. *Levinstein*, 29 R. P. C. 270, C. A.

(*d*) *Illustrative Case:* A claim for "the combination of a guided lever A_2," &c., was held to be confined to the particular lever shown. *Westinghouse* v. *Lancashire and Yorkshire Rail. Coy.*, 1 R. P. C. 229.

Cf. Thomas v. *Welch* (1866), 35 L. J. (C. P.) 200, but *cf. Thomas* v. *Foxell*, *supra*.

(*e*) *Ackroyd* v. *Thomas*, 21 R. P. C. at p. 750, C. A.; *cf Davis* v. *Townsend*, 16 R. P. C. 497; *Fairburn* v. *Household*, 3 R. P. C. 263, C. A.

(*f*) See *Consolidated Car Heating Coy.* v. *Came*, 20 R. P. C. 756, P. C. See also as to the effect of ambiguity, *Badische, etc.* v. *Société des Usines du Rhone*, 15 R. P. C. 369, C. A.

the specification is sometimes construed in a way which would seem to defy all rules (*g*).

(*g*) *Illustrative Case:* A patent for improvements in skirt waist bands described a method of weaving webs by means of three conical rollers, and then said that although three rollers had been shown two or any suitable greater number could be used. It was in fact old to use two, and the defendant did this. The Court of Appeal restricted the claim to the use of three rollers on the ground that this was the only improvement made by the patentee. *Vorwerk* v. *Evans*, 7. R. P. C. 265, C. A.; *cf.* also *Bovill* v *Pimm* (1856), 11 Ex. 718.

CHAPTER IX

INFRINGEMENT

PART I

RIGHTS DEPENDING ON THE CONSTRUCTION OF THE SPECIFICATION

Infringement an issue of fact.

WHERE a patent action was tried with a jury the question of infringement was always for them (*a*), subject, of course, to proper directions from the Court. In the earliest days, before there was any specification, when the only questions were, had the plaintiff made an invention, and had the defendant taken it, infringement was necessarily a pure question of fact. The earlier specifications too were rather descriptions of the new manufacture than attempts to define the essential features of the invention. Although the modern systems of claims is of great assistance in arriving at this definition, the question still remains, after the Court has decided what are the essential features claimed, whether the defendant has taken these features, and this is a question of fact and substance rather than of words (*a*). The historical development of this question here referred to is not without importance as indicating the spirit in which the question of infringement should be approached.

In the great majority of cases that come before the Courts it will be found that the defendant has made some variation in one or more of the elements of the invention as claimed.

(*a*) *Clark* v. *Adie* (1873), 2 A. C. 320. See also *Walton* v. *Potter* (1841), W. P. C., at p. 586; *Consolidated Car Heating Coy.* v. *Came*, 20 R. P. C. 745, P. C.; *De la Rue* v. *Dickenson* (1857), 7 E. & B. 738; *Incandescent Lighting Coy.* v. *De Mare Incandescent System*, 13 R. P. C., at p. 330; *Newellite* v. *Lawson*, 24 R. P. C. 311, C. A.; *Hoffman Manufacturing Coy., Ltd.* v. *Auto-Machinery Coy., Ltd.*, 8 R. P. C., at p. 151.

It was, however, suggested that if everything was on paper, *e.g.* if the defendant admitted that he was working under a later patent, the Court might decide the question. *Bovill* v. *Pimm* (1856), 11 Ex. 718; *Westinghouse* v. *L. & Y. R.*, 1 R. P. C. 229.

This probably amounts to little more than that no other verdict than one which the Court approved would be tolerated in such a case.

In determining whether these variations are sufficient to avoid infringement it must be remembered that, as above explained, the specification was in its origin a practical description of the new manufacture for the practical craftsman. It does not purport to be a self-contained document as such an Act of Parliament where nearly every important expression is defined either by the words in the Act itself or by reference, and the meaning of the terms in a specification and how much they comprehend must be ascertained by the context and by reference to the knowledge of the art. This leads to the consideration of the doctrine of equivalents with which this portion of the present chapter is very largely concerned.

Doctrine of equivalents.

As has been mentioned in the chapter on subject-matter the doctrine of equivalents depends on the fact that to a skilled man mention of, say, some apparatus with the use of which he is acquainted brings more to his mind than the particular thing mentioned, since there is a surrounding penumbra suggesting other apparatus more or less closely connected with it, or equivalent to it for the various uses to which it may be put (*b*). The existence of this penumbra does not necessarily depend on the wording of the specification though this may extend, contract, or extinguish it. The Courts, therefore, recognize that in deciding whether the invention as defined has been taken it is proper to consider how far the claims may be read as including equivalents of the elements set out. This question is not wholly decided either by the state of knowledge or by the words used, but is governed by the two jointly, that is to say, by the effect that the specification would have on the mind of a reader skilled in the art (*c*).

Broad and narrow construction.

One of the most important considerations is whether the specification is such that the craftsman would understand that a new line had been struck out, or whether it would be clear to him that all that had been done was to propose a particular variation of old matters. In the former case he would naturally

(*b*) *Stevens* v. *Keating* (1847), 2 W. P. C., at p. 188.

(*c*) The standard of knowledge to be taken is that of the ordinary skilful mechanic or chemist, not that of the specialist. See *Heath* v. *Unwin* (1853), 22 L. J. (C. P.), at p. 14. In the case, however, of patents dealing with highly scientific subjects, the Courts are now taking them to be addressed to very highly trained persons. See p. 89.

Of course this reading in of common knowledge as to equivalents is an absolute necessity unless each specification is to be made a text-book for the craft to which it relates.

feel that many modifications dictated by his general knowledge might be made without departing from the spirit of the invention. In the latter he would think that, as the success claimed depended on a small variation on what was old, it would not be safe to depart largely from what had been described, as by employing other devices which for many purposes are looked on as the equivalents of those mentioned, and yet expect to obtain the benefit sought by the patentee (*d*). Specifications which fall clearly into one of these two classes are often described as being such as came into consideration in the cases of *Proctor* v. *Bennis* and *Curtis* v. *Platt* respectively (*e*).

Doctrine not remedy for faulty drafting.

Although the Courts in proper cases still adopt a wide view on the question of equivalents there is a growing feeling that it is the business of the patentee to avail himself of the facilities given by the modern method of claiming clauses so as to state clearly what monopoly he claims, and that it is not a proper method of drawing a specification to describe a machine, and claim it as described, and then to resort to the doctrine of equivalents in order to turn the claim for the thing described into a claim for a system of construction (*f*), or to say that one feature, not picked out from the others in the specification,

(*d*) See also pp. 123, 124.

(*e*) *Proctor* v. *Bennis*, 4 R. P. C. 333, C. A.; *Curtis* v. *Platt* (1865), 35 L. J. (CH.) 852.

The distinction applies rather to the dicta of the two Courts than to the actual facts of the cases. The infringement in the first-named case was really a very clear one.

For cases illustrating the *Proctor* v. *Bennis* doctrine, see *inter alia*. *Moore* v. *Thomson*, 7 R. P. C. 325, H. L.; *Boyd* v. *Horrocks*, 9 R. P. C. 77, H. L.; *Incandescent Lighting Coy.* v. *De Mare Incandescent System*, 13 R. P. C. 559, C. A.; but see as to this case *Welsbach Incandescent Coy.* v. *Daylight Co.*, 17 R. P. C. 141, C. A.; *North British Rubber Coy.* v. *Gormully and Jeffreys*, 15 R. P. C. 245, H. L.; *Presto* v. *Orme*, 18 R. P. C. 17, C. A.; *Neil* v. *Macdonald*, 20 R. P. C. 213, O. H.; *British United Shoe Machinery Coy.* v. *Thompson*, 22 R. P. C. 177; *Sandow* v. *Szalay*, 23 R. P. C. 6, H. L.; *Van Berkel* v. *Simpson*, 24 R. P. C. 117, I. H.

For cases illustrating the *Curtis* v. *Platt* doctrine see, *inter alia*, *Gosnell* v. *Bishop*, 5 R. P. C. 597, C. A.; *Wilson* v. *Barbour*, 5 R. P. C. 245, C. A. Ir.; *Boyd* v. *Horrocks*, 6 R. P. C. 152; *Tucker* v. *Kay*, 8 R. P. C. 230, C. A.; *Jahncke* v. *Bell*, 9 R. P. C. 94, C. A.; *Tweedale* v. *Ashworth*, 9 R. P. C. 121, H. L.; *Nettlefolds* v. *Reynolds*, 9 R. P. C. 270; *Brown* v. *Jackson*, 12 R. P. C. 311, P. C.; *Morris* v. *Young*, 12 R. P. C. 455, H. L.; *Birch* v. *Harrap*, 13 R. P. C. 615; *Brooks* v. *Steel*, 14 R. P. C. 46; *Tweedale* v. *Ashworth* (second action), 17 R. P. C. 620, C. A.; *Schermuly* v. *Pain*, 18 R. P. C. 529; *Crocker* v. *Aerators, Ltd.*, 20 R. P. C. 621, 790, H. L.; *White* v. *Hartley*, 20 R. P. C. 265, 273; *Bailey* v. *Airey*, 23 R. P. C. 277, C. A.; *Consolidated Pneumatic Tool Coy.* v. *Clark*, 24 R. P. C. 593, C. A.; *Ashworth* v. *English Card Clothing Co.*, 20 R. P. C. 790, H. L.; *Nicholls* v. *Kershaw*, 27 R. P. C. 237; *Collins* v. *Green*, 29 R. P. C. 551, C. A.; *British, etc. Automatic Coy.* v. *Metropolitan Gas Meters, Ltd.*, 29 R. P. C. 571, A. C.; *Knight* v. *Argylls, Ltd.*, 29 R. P. C. 593, 608.

(*f*) *Ackroyd* v. *Thomas*, 21 R. P. C. at p. 750, C. A., and see p. 129, *n.* (*e*).

is the essential feature, and all the other non-essentials for which equivalents may be used (*g*). The proper function of the doctrine of equivalents is to protect the patentee against evasions or variations which a reasonable man would either not have foreseen or not have considered it necessary to mention specifically in his specification, rather than to supplement faults of drafting by reading in claims which should have been inserted in the first instance.

Would the device have been recognised as equivalent ?

In considering whether the device used by the defendant is an equivalent of that mentioned in the claim, the important question is would it, in the state of knowledge at the time of the grant, have been known to be an equivalent, or at any rate does it belong to a class which would have been known to be equivalent (*h*)? The fact that it would have needed invention or even ingenuity to see that the device used could be substituted for that claimed would generally avoid infringement (*i*), but if that invention or ingenuity has been exercised in obtaining a particularly favourable form of the device claimed, or of a device of an equivalent class, it does not do so (*k*).

Equivalence question of fact.

The question of equivalence being one of fact no definite rules can be laid down (*l*), and the following headings must be looked on chiefly as classifications of the relevant cases. In applying such cases great attention must be paid to the particular wording of the specifications considered, and to the evidence as to the state of knowledge.

Similarity of effect.

Although similarly of effect may be evidence on the question

(*g*) *Consolidated Pneumatic Tool Coy.* v. *Ingersoll Sergeant Drill Coy.*, 25 R. P. C. 574, H. L.; *Fairburn* v. *Household*, 3 R. P. C., at p. 267, C. A.; *Hardmuth* v. *Baker*, 22 R. P. C., at p. 75, C. A. See also pp. 128, 129.

(*h*) *Heath* v. *Unwin* (1853), 22 L. J. (C. P.), at p. 14, and also 5 H. L. C. 505; *Vidal Dye Syndicate* v. *Levinstein*, 29 R. P. C. 277, C. A.; *Electric Telegraph Coy.* v. *Brett* (1851), 20 L. J. (C. P.) 123; *Badische, etc.* v. *Levinstein*, 4 R. P. C. 449, H. L.; *Lane-Fox* v. *Kensington Electric Lighting Coy.*, 9 R. P. C. 221; *Nobel* v. *Anderson*, 11 R. P. C., at p. 523, C. A., and 12 R. P. C. 167, H. L.; *Welsbach Incandescent Coy.* v. *Daylight Incandescent Coy.*, 17 R. P. C. 141, C. A.; *Bunge* v. *Higginbottom*, 19 R. P. C., at p. 196, C. A.

(*i*) *Cf. Unwin* v. *Heath* (1853), 5 H. L. C. 505.

(*k*) *Illustrative case*:—Where a patentee had described a method for making tubes by drawing bent iron through conical holes, and the defendant had improved the process by drawing the pipe through grooved rollers, which avoided relative motion, it was nevertheless held an infringement. *Russell* v. *Cowley* (1834), 1 W. P. C. 459.

In Scotland, however, it was held that the specification did not include, nor was it anticipated by, the use of grooved rollers which themselves drew in the pipe. *Russell* v. *Crichton* (1839), 2 S. I. 893.

See also *Bunge* v. *Higginbottom*, 19 R. P. C. 187, C. A.; *Neilson's Patent* (1841), W. P. C. 273; *Badische, etc.* v. *Levinstein*, *supra*.

(*l*) See *Nobel* v. *Anderson*, 11 R. P. C., at p. 524, C. A.; *Newellite* v. *Lawson*, 24 R. P. C. 311, C. A.

of equivalence, it must always be remembered that a patent is for a new manufacture, and that the mere adoption of a new principle or idea does not constitute infringement unless the defendant has taken the patented way of carrying it out (*m*).

(*m*) "Although a man has obtained a patent for a given object, there are many modes still open for other men of ingenuity to obtain a patent for the same object; there may be many roads leading to one place." TINDAL, C.J., in *Walton* v. *Potter* (1841), W. P. C., at p. 590.

See also *Moore* v. *Thomson*, 7 R. P. C., *per* HERSCHELL, L.C., at p. 332, and *Saxby* v. *Clunes* (1877), 43 L. J. (EX.) 228, H. L.

Illustrative cases:—

Where a patentee claimed a meter for measuring current in which the current to be measured energised both magnets and armature, it was held that a meter in which this current only flowed through one of these, while the other was in circuit across the mains (which gave a practically constant current) was no infringement. *Chamberlain* v. *Bradford Corporation*, 20 R. P. C. 673, H. L. See also *Ferranti* v. *Thomson-Houston*, 20 R. P. C. 145, C. A.

Patent for a machine for testing wire by means of two drums differentially driven. *Held*, not infringed by a machine having two independent drums, one of which had a brake, the difference in pace of revolution being the effect, not the cause, of the stretching of the wire. *Johnson* v. *Rylands* (1873), Griff. 138. See also *Brown* v. *Jackson*, 12 R. P. C. 311, P. C.

Patent for improvements in apparatus for hardening and tempering steel wire. The claim was for the use of a chamber for cooling the wire, "the said chamber being supplied with a gas or mixture of gases free or nearly free from oxygen." *Held*, not infringed where there was no supply of inert gas from outside, but the effect was produced by preventing the access of fresh air, so that that in the chamber became deoxydised. *Ashworth* v. *English Card Clothing Coy.*, 20 R. P. C. 790, H. L.

Where a patentee claimed a method of regulating the speed of a motor by causing the discharge valves to close and retain the products of combustion, and thus prevent the inlet valves from opening, it was held that regulating by direct actuation of the inlet valves was not an infringement. *British Motor Syndicate* v. *Universal Motor Coy.*, 16 R. P. C. 113.

A patent for improved rivets for bicycle chains having the middle part case-hardened and small ends soft, described treating the surface of a bar with carbon, etc., so as to turn it into steel capable of case-hardening, cutting away the ends while the surface was still soft, which could be done with tools, heating, etc., and cooling quickly when the untouched surface hardened, but the small parts did not. The defendant hardened the whole and cut away the ends, having to use emery wheels. *Held*, no infringement. *Appleby* v. *Albert Eady Chain Coy.*, 16 R. P. C. 318.

A patent for grinding steel balls in grooves between revolving plates described a method of equalising by making the balls change from the outer to the inner grooves. For this purpose there was a segmental pocket joining all the grooves and at a certain point the balls fell into this and were distributed haphazard into the grooves. The defendants had at intervals passages leading from groove to groove so that each ball followed a fixed course. *Held*, no infringement. *Hoffman Manufacturing Coy.* v. *Auto-Machinery Coy.*, 28 R. P. C. 141.

For further cases illustrating this principle, see *Dudgeon* v. *Thomson* (1877), 3 A. C. 34; *British Motor Coy.* v. *Andrews*, 18 R. P. C. 85; *Brown* v. *Hastie*, 23 R. P. C. 361, H. L.; *Pneumatic Tyre Coy.* v. *Tubeless Tyre Coy.*, 15 R. P. C., at p. 78; 16 R. P. C. 77, 80, H. L.; *Pilkington* v. *Massey*, 21 R. P. C. 697, C. A.; *Saxby* v. *Clunes* (1877), 43 L. J. (EX.) 228, H. L.; *Lawrence* v. *Perry*, 2 R. P. C. 179; *Heyes* v. *Hallmark*, 9 R. P. C. 25; *Miller* v. *Clyde Bridge Coy.*, 9 R. P. C. 470, H. L.; *Parkinson* v. *Simon*, 11 R. P. C. 493, 506, C. A.; *Kopp* v. *Rosenwald*, 19 R. P. C. 211; *Crocker* v. *Aerators*, 20 R. P. C. 621; *Morrison* v. *Asplen*, 21 R. P. C. 557; *Ackroyd* v. *Thomas*, 21 R. P. C. 737, C. A.; *Bailey* v. *Airey*, 23 R. P. C. 277, C. A.; *Von der Linde* v. *Brummerstaedt*, 26 R. P. C. 289; *Spennymoor*

But where the novelty really lies in carrying out a new idea by a part having a certain function the Courts sometimes give what is in effect a functional interpretation to the claim, *i.e.* regard other devices having the same function as equivalents (*n*).

Foundry Coy. v. *Catherall*, 26 R. P. C. 826; *Stone & Coy.* v. *Broadfoot*, 27 R. P. C. 701, H. L.; *Riley* v. *Taylor*, 27 R. P. C. 747, C. A.; *Collins* v. *Green*, 29 R. P. C. 551, C. A.; *Knight* v. *Argylls, Ltd.*, 29 R. P. C. 593, 608.

(*n*) *Illustrative cases:*

The following cases illustrate how far the Courts are willing to go in their interpretation of claims as functional.

The specification of a patent for an automatic weighing machine, which commenced with a statement that the invention lay in constructing a new kind of weighing machine in such manner that the act of placing the coin or the like in the apparatus would cause the weight of the body being weighed to be indicated on the dial or the like, proceeded to describe a machine in which, when a person stood on the platform, the weighing took place and an internal pointer moved round to the proper weight, but the external pointer was not moved owing to a break between the two spindles, which break was bridged by the insertion of the coin. The first claim was "the manufacture of a new kind of weighing machine as herein described in which, on a coin or the like being placed in the apparatus, the weight of the person or body being weighed would be indicated on a dial or the like substantially as hereinbefore described." It was held in a number of cases that the patent did not cover any kind of automatic weighing machine worked by the insertion of a coin, but only one in which the weighing took place in the ordinary way and the insertion of the coin served to indicate the result of such weight externally. Thus a machine in which the whole weighing machinery was locked until a coin was inserted when it was set in motion by turning a handle (*Knights' Case*) and a machine in which the weighing machinery was set in motion by pushing a button (*Combined Weighing Machine Coy. Case*) were held not to infringe. But if the coin fulfilled the functions set out above the Courts practically held that it did not matter what was the device actuated by it. Thus where a coin moved a shutter from an opening so that the internal dial could be seen (*International Hygienic Society Case*), where the coin closed an electrical contact and set the external indicator in action (*National Exhibition Association Case*), and where the coin allowed an externally turned handle to release the indicating mechanism (*Fearby's Case*) it was held that the patent was infringed. *Automatic Weighing Machine Coy.* v. *Knight*, 6 R. P. C. 297, C. A.; *Automatic Weighing Machine Coy.* v. *Combined Weighing Machine Coy.*, 6 R. P. C. 367, C. A.; *Automatic Weighing Machine Coy.* v. *International Hygienic*, 6 R. P. C. 475; *Automatic Weighing Machine Coy.* v. *National Exhibition*, 9 R. P. C. 41, C. A.; *Automatic Weighing Machine Coy.* v. *Fearby*, 10 R. P. C. 442. See also *Ticket Punch Coy.* v. *Colley*, 12 R. P. C. 171, C. A.

Where a patentee had claimed the combination in a telephone of a diaphragm and electric tension regulators, it was held that a diaphragm included anything dividing the air on one side from the air on the other so as to allow differences of pressure to be indicated. *United Telephone Coy.* v. *Bassano*, 3 R. P. C. 295; *United Telephone Coy.* v. *St. George*, 3 R. P. C. 321; *United Telephone Coy.* v. *Harrison* (1883), 21 Ch. D. 721.

Where a patentee had described and claimed an automatic milking machine in which the vacuum was controlled by the height of the column of milk between two reservoirs, it was held that the use of a safety valve instead of this method was an infringement. *Murchland* v. *Nicholson*, 10 R. P. C. 417, I. H. See also, *Moore* v. *Thomson*, 7 R. P. C. 325, H. L.

Where a patentee claimed "a rubber or an elastic tyre having the form of a saddle or arched in section lined with canvas in combination with two wires or sufficiently inelastic cords for securing the same to the rims or tyres substantially as herein described," it was held in a number of cases in which wires were

In such a case by appropriate wording all practical means of achieving the object may be covered (*o*).

Apart from the cases of this class equivalence of result, although of course important evidence on the question as to whether the apparatus or the process used is equivalent to that claimed (*p*), is not decisive as to infringement, since the real question is, would the devices adopted by the defendant have been seen *à priori* to be equivalent (*q*).

used which were not endless, but which were so fixed to the tyre, or made to overlap or the ends twisted, so that they were in practice inextensible, were infringements. *Pneumatic Tyre Coy.* v. *East London Rubber Coy.*, 14 R. P. C. 573, C. A.; *Pneumatic Tyre Coy.* v. *West London Rubber Coy.*, 15 R. P. C. 129; *Dunlop Pneumatic Tyre Coy.* v. *United Rubber Works*, 19 R. P. C. 406; *Dunlop Pneumatic Tyre Coy.* v. *New Lamb Tyre Coy.*, 20 R. P. C. 303, I. H.; *Dunlop Pneumatic Tyre Coy.* v. *Clifton Rubber Coy.*, 20 R. P. C. 393, C. A.; *Dunlop Pneumatic Tyre Coy.* v. *Ostrich Tyre Coy.*, 19 R. P. C. 365; *Dunlop Pneumatic Tyre Coy.* v. *Hyde Rubber Coy.*, 21 R. P. C. 208; but see *Pneumatic Tyre Coy.* v. *New Ixion Tyre Coy.*, 15 R. P. C. 389; *Dunlop Pneumatic Tyre Coy.* v. *Wapshare Tyre Coy.*, 17 R. P. C. 433, for cases where it was held that devices used were not equivalents.

Claim for a cream separator having a series of conical plates clamped together for dividing milk into layers. Defendant used solid cylinder with passages bored through which spread the milk out in a similar way. *Held*, infringement. *Aktiebolaget Separator* v. *Dairy Outfit Coy.*, 15 R. P. C. 527, C. A.

There is no point of patent law more overclouded by the wealth of judicial utterances than the rule that "you cannot patent a principle." Although the dictum of ALDERSON, B., in *Jupe* v. *Pratt* (1837), W. P. C., at p. 146, to the effect that if you discover a new principle and show one way of carrying it out, you are entitled to protect yourself against all other ways, has been disapproved, see *Nobel* v. *Anderson*, 11 R. P. C. 519, C. A.; there is considerable truth in it if the claim for the desired monopoly is appropriately framed. Perhaps the true law is best expressed by COTTON, L.J., in *Automatic Weighing Machine Coy.* v. *Knight*, 6 R. P. C. at p. 304.

"Where there is a principle first applied in a machine capable of carrying it into effect, the Court looks more narrowly at those who carry out the same principle in other ways." The question is one really of degree more than principle, and there seems no logical distinction between allowing a functional interpretation to a claim for a single integer, and allowing it for an integer forming part of a combination as was done in the *Automatic Weighing Machine Cases*. See also *Jones* v. *Pearce* (1832), W. P. C. 122; *Neilson* v. *Harford* (1841), W. P. C. 273; *Edison* v. *Smith*, 11 R. P. C. at p. 163; *Edison* v. *Woodhouse*, R. P. C. 79.

(*o*) *E.g.* In the case of *Jupe* v. *Pratt*, *ubi supra*, it is difficult to see what possible objection there could have been, either as to validity or scope to a claim such as "a table constructed in sections formed to slide to and from a centre," provided that this was new.

(*p*) *Wenham* v. *May*, 4 R. P. C. 303; *Young and Beilby* v. *Hermand Oil Coy.*, 9 R. P. C. 373, H. L.; *Leeds Forge* v. *Deighton*, 21 R. P. C. 487, 496, H. L.; *Osram Lamp Works* v. *Z Electric Lamp Coy.*, 29 R. P. C. 425, 426.

(*q*) For cases where identity of result has been held insufficient, see *Seed* v. *Higgins* (1860), 8 H. L. C. 551; *British Motor Syndicate* v. *Universal Motor Coy.*, 16 R. P. C. 134; *British Motor Syndicate* v. *Andrews*, 18 R. P. C. 85, H. L.; *Brown* v. *Jackson*, 12 R. P. C. 311, P.C.; *Plating Coy.* v. *Farquharson* (1883), Griff. 187, H. L.; *Scott* v. *Hamling*, 14 R. P. C. 123; *Varey* v. *Walker*, 16 R. P. C. 596; *Musgrave* v. *Hicks*, 3 R. P. C. 49; *Wallace* v. *Jack*, 22 R. P. C., at p. 591.

Bearing of specification on equivalence.

The principle, referred to in the chapter on construction; that a claim is primarily regarded as a disclaimer cutting down rather than extending the invention described (*r*), has an important bearing on the question of equivalents, and if a clear idea of the patentee's real invention can be gathered from the description it usually gives a good test of the bounds within which equivalents of the integers specifically mentioned in the claims may lie.

Of course, if it is mentioned that equivalents may be used for a certain part the Court gives effect to this (*s*). In some cases also a patentee names a number of bodies in his specification as having similar properties to the particular one claimed, or makes like statements as to apparatus or processes, and here in general the inference is that these are to be regarded as equivalents (*t*). So, too, where a patentee clearly points out the evil he desires to overcome, or the result he seeks to obtain, or the advantages of his particular device, he greatly strengthens the argument that similarity in these respects should be regarded as evidence of equivalence (*u*).

(*r*) See p. 116 *n.* (*o*).

(*s*) The dictum of WOOD, V.-C., in *Curtis* v. *Platt* (1865), 35 L. J. (CH.) 852, that the insertion of "mechanical equivalents" in a claim makes no difference, is not sound. Of course, the Courts often hold that mechanical equivalents come within a claim even if the words are not there, but the addition of these words to particular integers would make it clear that the combination might be infringed where these particular integers are replaced by others. Probably, too, if a patentee points out a number of parts in which variations may be made, the Court would be likely to infer that the other parts were essentials not to be departed from.

(*t*) *Illustrative case* :—Where a specification for a method of fixing glass bricks to walls by attaching to their back "sand or granular material as crushed or broken glass," but in the claims only broken glass was mentioned, it was held that the use of other granular materials was within the claim. *National Opalite Coy.* v. *Grand Hotel Coy.*, 18 R. P. C. 249.

The mere mention, however, of alternative methods in the body of the specification does not bring them within the claim unless they can be brought within the class of equivalents.

Illustrative case :—A patentee described a starting device in which a gaseous mixture flowed out of the cylinder and when the proper richness was arrived at, which was indicated by the sound, the rate of flow could be checked by a tap, so that the flame struck back and caused an explosion, which put the starting device out of action. The specification then stated that "the relative area of the nozzles may be such that the flame, instead of being caused to strike back by reduction of the rate of flow, strikes back on the mixture becoming sufficiently rich," and then described the appropriate arrangements for this variation. The claims spoke of "causing" the rate of outflow to be diminished. It was held that a device in which the flame struck back merely owing to the increase in richness of the mixture was not an infringement, since there was no causing of diminution of the rate of flow. *British Motor Syndicate* v. *Andrews*, 18 R. P. C. 85, H. L. See also *Monnet* v. *Beck*, 14 R. P. C., at p. 846.

(*u*) *Thomson* v. *Moore*, 7 R. P. C. 325, H. L.; *Clay* v. *Allcock*, 23 R. P. C. 745, C. A.; *Foden* v. *Wallis*, 25 R. P. C. 783, C. A.; *Wenham* v. *May*, 4 R. P. C. 303; *Jackson* v. *Wolstenholme*,

On the other hand, the Courts are unwilling to hold a device equivalent because it takes some features or produces some effect produced by the patented device, but which is not mentioned in the specification, or only incidentally mentioned there, or only to be gathered from reference to the drawings (*x*).

The converse rule is widely applied. Thus, where the patent claims (either expressly or impliedly) the use of a material, process, or apparatus, so as to produce a particular effect, there is no infringement if the method of use by the defendant is such as not to produce this effect (*y*). So if the primary object

1 R. P. C. 105, 109, C. A.; *Evans* v. *Hoskins*, 24 R. P. C. 517, C. A.; *Sandow* v. *Szalay*, 23 R. P. C. 6, H. L.

(*x*) *Illustrative case* :— In the case of a patent for a method of forming phonographic records, the plaintiffs contended that the essential feature of their invention was the method of allowing the air to escape between the record and the matrix. No mention of this was made in the specification, but something was shown in the drawing which might have had this result. *Held*, no infringement. *Lambert* v. *International Phonograph Coy.*, 21 R. P. C. 247, C. A. See also *Clay* v. *Allcock*, *supra*; *Stewart* v. *Bell's Trustees* (1883), 4 S. XI. 236; *Fairburn* v. *Household*, 3 R. P. C. 263, C. A.

(*y*) *Illustrative cases* :—

Where in a patent for producing phonograph records the claim was for forcing a blank against a matrix by means of a heating fluid such as steam, and then continuing the pressure with a cooling fluid, such as air, so as to harden the wax, and the defendants, after applying pressure by means of steam, continued the pressure by means of air, which was not allowed to escape but remained unchanged for half an hour, and so did not act as a cooling fluid, the cooling being effected by means of water. *Held*, no infringement. *Lambert* v. *International Phonograph Coy.*, 21 R. P. C. 247, C. A.

So where a patent claimed making the handles of bicycles of sheet felt by grooving the felt so as to make it flexible, it was held that grooving the felt after the handles were made was no infringement. *Cooper* v. *Baedeker*, 17 R. P. C. 209, C. A.

Where a patentee claimed the use in an inverted gas-burner of two concentric tubes joined at the top so that they were filled with rarified air which acted as a non-conductor, and the defendants employed similar tubes, but open at the top so that the air escaped and the non-conducting effect was not produced, it was held no infringement. *New Inverted Coy.* v. *Cope*, 23 R. P. C. 103.

Where a patentee claimed "the combination of a grooved rim or metal tyre and an arched tyre of indiarubber or other flexible material held in the groove by the pressure of an inflated tube within the arch which forces its edges against the side of the groove substantially as described," and laid special stress in his patent on the fact that the inner tube and outer tube could be renewed independently, it was held that a device in which there was no separate inner tube, but merely two flaps on the cover, which could be placed over each other and had soft soap put between them so that when in position they would hold the air, was not an infringement. *Pneumatic Tyre Coy.* v. *Tubeless Pneumatic Tyre Coy.*, 16 R. P. C. 77, H. L.

Where a patentee claimed a connecting piece between a horn and a sound box having, *inter alia*, the feature that it was tapered, and this was said to allow the sound to expand naturally, it was held that a similar part made with two cylindrical portions and a step was no infringement. *Gramophone Coy., Ltd.* v. *Ruhl*, 28 R. P. C. 20, C. A.; *cf.* *Gramophone Coy., Ltd.* v. *Ullman*, 23 R. P. C. 752, C. A.

Where a patentee commenced his specification by saying that in fabrics having intersecting threads in contact there was a danger of these sawing if the fabric was folded, etc., and then

of a patented apparatus is its use for a particular purpose the fact that the defendant's apparatus would be useless for that purpose tells strongly against infringement (*z*). Again, if a substance mentioned in the specification is defined as having certain properties and as used for this reason, the use of a body not having these properties would not in general be an infringement (*a*). So, too, the Courts have held that certain apparatus etc., were not equivalents on the grounds that the specification pointed away from them (*b*).

Infringement found more easily if substituted device no improvement.

The Courts hold that a device is an equivalent more easily if the substituted device is more expensive or less convenient than that claimed, than if the change is a real improve-

described a fabric made by embedding a series of parallel threads in a sheet of rubber, and joining two such sheets so that the threads were at right angles, it was held that where two series of parallel threads were placed at right angles and a film of rubber used merely to hold them together, the film being too thin to prevent sawing, there was no infringement. *Palmer Tyre Coy.* v. *Pneumatic Tyre Coy.*, 16 R. P. C. 451.

See also *Jackson* v. *Wolstenholme*, 1 R. P. C. 105; *Preston Davies* v. *Black*, 11 R. P. C. 574, I. H.; *Pennycooke* v. *Mackenzie* (1881), 4 S. IX. 414, I. H.; *Richardson* v. *Castry*, 4 R. P. C. 265; *Tucker* v. *Kay*, 8 R. P. C. 233, C. A.; *Tweedale* v. *Ashworth*, 9 R. P. C. 121, H. L.; *Brooks* v. *Steel and Curry*, 14 R. P. C. 46; *Automatic Diversions Syndicate* v. *Urry*, 14 R. P. C. 305; *Sideley* v. *London Hygienic*, 14 R. P. C. 514; *Dunlop Pneumatic Tyre Co.* v. *New Ixion Coy.*, 16 R. P. C. 16, C. A.; *Appleby* v. *Albert Eady Chain Coy.*, 16 R. P. C. 318; *Palmer Tyre Coy.* v. *Pneumatic Tyre Coy.*, 16 R. P. C., at p. 485; *Tweedale* v. *Ashworth* (second action), 17 R. P. C. 620, H. L.; *Schermuly* v. *Pain*, 18 R. P. C. 529; *Gillette Safety Razor Coy.* v. *Anglo-American Trading Coy.*, 29 R. P. C. 577, C. A.

(*z*) *Needham* v. *Johnson*, 1 R. P. C. 49.

So, too, if it does not possess an advantage on which stress is laid in the patent. *Martin* v. *Consett Iron Works*, 25 R. P. C. 27, 34, C. A.; *cf.* also *Appleby* v. *Eady Chain Coy.*, 16 R. P. C. 318 and p. 135, note (*m*).

(*a*) *Illustrative cases* :—

Where a patentee claimed making a backing for glass slabs by putting on pitch, etc., and clinker, etc., as an absorbent, and the defendants used broken pottery which, though it might be absorbent of water and other thin liquids, was not substantially absorbent of pitch, it was held no infringement. *Newellite* v. *Lawson*, 24 R. P. C. 305, C. A.

In the case of a patent for an electric battery in which the outer layer was to be made of plastic substance, it was held that a battery having the outer layer made of blotting-paper did not come within this claim, although blotting-paper might for some purposes be termed plastic, because the patent contemplated something which could be poured in, and all the examples were of plastic substances of this nature. *Patent Exploitation Ltd.* v. *American Electrical Novelty Coy.*, 22 R. P. C. 316, C. A.

Where a patent described and claimed a process for dipping incandescent gas-mantles after ignition into a substance that would set hard and protect the mantles from breakage, and said that high boiling-point paraffins were preferred, but that other substances that set hard at ordinary temperatures might be used, the patent was construed as confined to the use of substances that set by cooling, and as not covering the use of substances, such as collodion, that set by evaporation. *Sunlight Incandescent Coy.* v. *Incandescent Lighting Coy.*, 14 R. P. C. 757.

(*b*) *Cf. Morris* v. *Young*, 12 R. P. C. *per* Lord HERSCHELL, at p. 461, H. L., and *Nobel* v. *Anderson*, 12 R. P. C. 164, H. L.

ment (*c*). This follows from the fact that the patentee naturally gives, and in fact is bound to give, the best form of which he knows, and usually troubles little about inferior forms (*d*), while the craftsman seeing the cheapest or best form mentioned may easily think of using less convenient forms, but if an inferior form is named he will be apt to think that there is some special reason for choosing it, and that the better forms are purposely excluded (*e*). Another reason is that where a form which is worse is taken the Court is more apt to think that the change is only colourable and is an attempt to avoid infringement (*f*).

So where plaintiff's invention is of little or no utility the Courts lean against finding that a useful invention is equivalent to it (*g*).

(*c*) *Illustrative cases* :—

Where a patentee had taken a patent for the addition of carburet of managanese to steel in the process of casting, carburet of manganese being an expensive substance costing seven shillings a pound, and the defendants had found that common coal-tar and oxide of manganese, which did not cost one-hundredth part of the price of carburet of managnese, would do, and that the oxide of manganese did not attack the furnace sides as had been previously supposed, this was held not to be within the patent, the Lord Chancellor pointing out that if these simple and cheap substances were within the plaintiff's invention he ought to have named them, and not the more expensive. *Unwin* v. *Heath* (1855), 5 H. L. C. 505. *Cf.* also *Plating Coy.* v. *Farquharson* (1883), Griff. 107, C. A. and H. L.

Where a patent for producing a silky lustre on cotton goods spoke of forming a roller with irregular surfaces, lying at different angles to each other and arranged so as to form "a sort of parallel grooves," it was held that a roller with ordinary parallel grooves did not infringe, the specification rather leading away from this than to it. *Bradford Dyers* v. *Bury*, 18 R. P. C. 161; 19 R. P. C. 1, C. A.; *Bradford Dyers* v. *Williams*, 19 R. P. C. 125.

And compare with these cases the following:—

A patentee had claimed a process for distilling shale at two temperatures, the lower being more favourable for obtaining oil and the higher for getting off ammonia, and had described a process by which the shale was fed into and withdrawn from a vertical retort in small quantities, and proposed to make the lower half of the retort of firebrick and the upper of iron, and only to heat directly the lower part, the upper portion being heated, but to a less degree, by conduction. The defendants made the whole of firebrick and led the hot gases round the whole, but of course these gases got cooler as they rose. The House of Lords held that although this arrangement did not get as sharp a variation of temperatures as the patentee's it was nevertheless within the patent. *Young and Beilby* v. *Hermand Oil Coy.*, 9 R. P. C. 373, H. L.

See also *Bunge* v. *Higginbottom*, 19 R. P. C., at p. 196, C. A.; *British Vacuum Cleaner Coy.* v. *Suctions, Ltd.* 21 R. P. C. 303, 312.

(*d*) *Unwin* v. *Heath*, *supra*.

(*e*) *Bradford Dyers* v. *Bury*, *supra*; *Bradford Dyers* v. *Williams*, *supra*.

(*f*) *Stevens* v. *Keating* (1847), 2 W. P. C. 175, 185; *Bunge* v. *Higginbottom*, *supra*; *Heine* v. *Coninco*, 21 R. P. C. 202, 207.

(*g*) *Illustrative case*: In the case of a patent for inter-locking mechanism for signals the patentee claimed that by his method the signals and points could never be antagonistic. This was found not to be true of the plaintiff's system, but it was true of the defendant's. It was held that this showed that the systems were not equivalents. *Easterbrook* v. *G. W. Ry. Coy.*, 2 R. P. C. 201. See also *Winby* v. *Manchester Steam Tramways*, 8 R. P. C. 61.

Combinations.

The rule referred to elsewhere that a claim for a combination only protects that combination as a whole (*h*), makes it necessary to consider in each case whether there is an equivalent for each integer of the combination claimed. Of course it is not always necessary that there should be a separate part corresponding to each separate integer, one part of the infringing machine may be an equivalent for several integers in the combination claimed or *vice versâ* (*i*).

In the case of patents for combinations of old parts where neither the result nor the means are new in themselves and the invention is of the nature of selection, the doctrine of mechanical equivalents, though still applicable (*k*), is applied with much less freedom than where a new machine or process is claimed (*l*). The invention being one of selection, it is necessary to show that the infringer has adopted the same selection, and this can usually only be done where the variation is in minor parts.

Besides combinations of old elements there are many claims for a number of integers some of which are in themselves new. To establish infringement in such cases it must in general be shown that not only is the new integer (which a craftsman would necessarily consider to be an essential part of the invention) taken, but that it is taken in a combination which is in substance identical with the one claimed (*m*).

(*h*) See p. 120.

(*i*) Nor is it necessary for infringement of a combination that all the parts should be integral parts of one machine, if in fact they are used together. *Shoe Machinery* v. *Cutlan*, 12 R. P. C. 356.

(*k*) *Bunge* v. *Higginbottom*, 19 R. P. C., at p. 196, C. A. As to infringements of combination claims generally, see *Proctor* v. *Bennis*, 4 R. P. C. 333; *Lynch* v. *Phillips*, 25 R. P. C. 708; 26 R. P. C. 401, I. H.

(*l*) *Young* v. *Morris and Bastaert*, 12 R. P. C., at p. 459, 462, H. L.; *Tucker* v. *Kaye*, 8 R. P. C. 230, C. A.; *Wallace* v. *Jack*, 22 R. P. C. 581; *Lynch* v. *Phillips*, *supra*; *Bovill* v. *Pimm* (1856), 11 Ex. 718, 739; *Beston* v. *Watts*, 25 R. P. C. 26, C. A.

There are dicta to the effect that the doctrine does not apply at all in the case of combinations of old parts. See *Brown* v. *Jackson*, 12 R. P. C., at p. 324, P. C.; *Brooks* v. *Lamplugh*, 16 R. P. C., at p. 48; *Tweedale* v. *Ashworth*, 9 R. P. C. 521, 528, H. L.; *Tweedale* v. *Ashworth*, 17 R. P. C. 620, 625, H. L.; *Miller* v. *Clyde Bridge Coy.*, 9 R. P. C. 478 H. L. But undoubtedly the Courts do apply the doctrine to some extent; *cf. Harrison* v. *Nicholson*, 25 R. P. C. 405, C. A.

It has been suggested that in such cases the use of a mechanical equivalent would not be an infringement, but a colourable imitation would be, *e.g.* in *Lake and Elliott* v. *Rotax Motor Accessories Coy.*, 28 R. P. C. 532, 540, C. A. The distinction would seem merely verbal, except in so far as it points to the closeness of the imitation. As to meaning of "colourable imitation," see *Dudgeon* v. *Thomson* (1877), 3 A. C., *per* Lord Cairns, at p. 43.

(*m*) *Illustrative cases*:—

In the case of a patent for hardening and tempering wire by passing it through an open flame into a special oil-bath, it was held that the use of a tube on which a flame played together with this oil-bath was no

Although in general all the steps of a process or parts of a combination have to be taken to constitute infringement, there are certain cases where it would be clear to any competent reader that a special part or step, although it is incorporated in the claim directly or by reference, is only used for greater convenience or perfection, and is not essential (*n*). In such case infringement is sometimes found where such part or step is omitted, or a very wide interpretation is given to equivalence if a substitute is used (*o*). Such an interpretation, however,

infringement. *Ashworth* v. *Roberts*, 9 R. P. C. 309, C. A.

Where a patentee described a special adjustable frame, and showed its use in a reversible chair, and his claim was for a reversible chair, it was held that the use of the special frame apart from such chair was no infringement. *Davis* v. *Townsend*, 16 R. P. C. 497. See also *Harrison* v. *Anderston Foundry Coy.* (1876), 1 A. C., at p. 578, H. L.; *Dudgeon* v. *Thomson* (1877), 3 A. C. 34, H. L.; *Tucker* v. *Kay*, 8 R. P. C. 230, C. A.; *Welsbach Incandescent Coy.* v. *Daylight Coy.*, 17 R. P. C. 146, C. A.; *Osmond* v. *Balmoral Cycle Coy.*, 15 R. P. C. 505, C. A.; *Garrard* v. *Edge*, 6 R. P. C. 563, C. A.; *Hardmuth* v. *Baker*, 22 R. P. C., at p. 75, C. A.; *Nordenfeldt* v. *Gardner*, 1 R. P. C., at p. 65, C. A.

(*n*) It is to this class of case that the remarks of Lord CAIRNS in *Clark* v. *Adie* (1877), 2 A. C. 320, apply. See also *Proctor* v. *Bennis*, 4 R. P. C. 333, 354, C. A.

(*o*) *Illustrative cases* :—

Where in a patent for a new process of getting an ointment from wool fat the patentee had claimed a method which included putting a mixture into a centrifugal machine in order to separate two bodies of different specific gravities, it was held to be infringed by defendants who, instead of using a centrifugal machine, put the mixture into a settling pan, the centrifugal process merely being the best and quickest method of effecting the separation. *Benno-Jaffé, &c.* v. *Richardson*, 11 R. P. C. 261, C. A.

In a patent for making gas-mantles by impregnating a cotton fabric with the rare earths the plaintiff had described a process in which at one point the mantle was impregnated with ammonia. This admittedly could not affect the final result after burning, and its omission was treated as not affecting infringement. *Incandescent Lighting Coy.* v. *De Mare Incandescent System*, 13 R. P. C. 559, C. A.

In the same case the Court apparently held that where a patentee claimed a new mantle made of zirconium and lanthanum the use in a mantle of zirconium without lanthanum was an infringement. In a subsequent case the Court of Appeal disapproved of this reasoning, and explained the former decision by saying that the Court had found that erbium, which had been used with the zirconium, was an equivalent for lanthanum. See *Welsbach Incandescent Coy.* v. *Daylight Coy.*, 17 R. P. C. 141, C. A.

In the case of a machine for sewing bindings on hats, the claim included as part of the combination a guiding loop for the tape. This was found not to be necessary in practice, and it was held that its omission did not prevent infringement. *Gammons* v. *Battersby*, 21 R. P. C. 322, 332, C. A.

See also *Wright* v. *Hitchcock* (1870), 39 L. J. (EX.) 97; *Clippens* v. *Henderson* (1882), 4 S. IX. 238, affirmed in H. L. (1883), 8 A. C. 813; *Automatic Air Tight Cover Coy.* v. *Stockford*, 19 R. P. C. 453; *Gwynne* v. *Drysdale*, 3 R. P. C. 65, 67, I. H., approved in *Consolidated Car Heating Coy.* v. *Came*, 20 R. P. C. 745, P. C.; *Osram Lamp Works* v. *Z. Electric Lamp Coy.*, 20 R. P. C. 425, 426.

Of course such decisions were frequent under the older system of construction. See p. 120 *n.* (*i*).

For a case where this was applied against the patentee, see *Farbenfabriken, &c.* v. *Chemische Fabrik, &c.*, 22 R. P. C. 501.

is only given, in the case of an omitted part at any rate, when such part can be looked on so to speak as a luxury; where a substantial part of the commercial utility of the patented process or combination depends on such part it is regarded as an essential part whose omission negatives infringement (*p*).

Part not claimed as new.

A broader extension is given to equivalents in the case of a part which is not suggested to be new or used in any new way, but is mentioned in the claim rather for the purpose of completing an apparatus or combination than as in itself showing anything new (*q*). So that even if an entirely new substitute is discovered for such part of the apparatus or combination claimed there may still be infringement if the other elements are taken (*r*).

Equivalents used for certain novel parts.

If the patented machine as claimed differs from one previously known in two or more respects, it is generally difficult to allege that a machine in which only one part of the novelty is adopted is an infringement, since if the doctrine of mechanical equivalents is invoked by the plaintiff to make the old the equivalent of the new in regard to part A, it will probably be also invoked by the defendant with regard to part B (*s*).

(*p*) *Illustrative case:* In the case of a being patent which was interpreted as for a coupling for steam-pipes in the lower part of which was a hinge, it was proved that the coupling would work without the hinge except in one or two per cent. of cases, but that the commercial user was rendered more certain by the use of such hinge. It was held that the hinge was a material part of the combination and that a coupling made without it was not an infringement. *Consolidated Car Heating Coy.* v. *Came*, 20 R. P. C. 745, P. C.

See also *Nettlefolds* v. *Reynolds*, 9 R. P. C. 270, C. A.; *Jackson* v. *Wolstenholme*, 1 R. P. C. 105, C. A., and p. 120, *n.* (*l*), and cases at p. 152, *n.* (*d*).

(*q*) *Electric Telegraph Coy.* v. *Brett* and *n.* (*r*), *infra* (1851), 20 L. J. (C. P.), at p. 130; *Bovill* v. *Crate* (1867), Griff. N. C. 46; *North British Rubber Coy.* v. *Gormully and Jeffreys*, 15 R. P. C. 245, 254, H. L.; *Lane Fox* v. *Kensington Electric Lighting Coy.*, 9 R. P. C. 241, 242.

See also cases at p. 150, *n.* (*u*).

(*r*) *Illustrative case*: A patentee showed a system by which a telegraphic signal was recorded at intermediate as well as terminal stations the title being "improvements in giving signals . . . by means of electric currents transmitted through metallic circuits." At the date of the grant the only system known was a complete metallic circuit, but later the "earth return" was discovered. It was held that the application of the patented improvements on a system having an earth return constituted infringement. The rule was laid down that "a claim for improvements in the mode of doing something by a known process is sufficient to entitle the claimant to a patent for his improvements when applied either to the process known at the time of the claim or to the same process altered and improved by discoveries not known at the time of the claim so long as it remains identical with regard to the improvements claimed and their application." *Electric Telegraph Coy.* v. *Brett* (1851), 20 L. J. (C. P.) 130. See *contra*, *Barber* v. *Grace* (1848), 17 L. J. (EX.) 122; and *Plating Coy.* v. *Farquharson* (1883), Griff. 187, *per* JESSEL, M.R.

(*s*) *Illustrative case*: A patentee had described working the auxiliary piston of a lift by introducing water at high pressure into a cylinder surrounding the trunk of the piston

Chemical patents.

In the case of chemical patents the Courts at one time seemed to take the view that the doctrine of equivalents did not apply (*t*). Latterly this view has been questioned (*u*), and there is very little doubt that it no longer holds. This does not imply any change in the principles on which the Courts act, but merely that they recognise the changed state of facts, viz. that the progress of chemistry has carried the knowledge and classification of the behaviour of different bodies to a point where the doctrine of equivalents is in many cases applicable (*x*). Whether it would be so in any particular case would be a question of fact (*y*).

so as to act as a constant counterbalance to the weight of the lift, and letting the working water act on the end of the trunk which was in a second smaller cylinder. B. had previously suggested the use of an auxiliary cylinder, but had had a gravity counterpoise, and his working water acted on the end of the auxiliary piston. The defendants let their water into a cylinder surrounding the trunk of the piston, but this was the working water, and they had a gravity counter-weight. The plaintiffs contended that a gravity counterweight and a water pressure counterweight were equivalents, but it was pointed out that in that case their machine was not distinguishable from what had gone before, and the Court held that there was no infringement. *Ellington* v. *Clark*, 5 R. P. C. 319, C. A. See *Curtis* v. *Platt* (1865), 35 L. J. (CH.) 852, and cases at p. 133 *n.* (*e*); *Holmes* v. *L. & N. W. Ry. Coy.* (1852), 22 L. J. (C. P.) at p. 61; *Tucker* v. *Kaye*, 8 R. P. C. 230, 234, C. A.; *Fairburn* v. *Household*, 3 R. P. C., at p. 267, C. A.; *Hardmuth* v. *Baker*, 22 R. P. C. 66, C. A.; *Miller* v. *Clyde Bridge Coy.*, 9 R. P. C. 478, H. L.

Of course this rule must be modified where the specification points out one particular part as the essence of the invention.

(*t*) *Stevens* v. *Keating* (1847), 2 W. P. C., at p. 188; *Heath* v. *Unwin* (1855), 5 H. L. C. 505; *Lancashire Explosives Coy.* v. *Roburite Explosives Coy.*, 13 R. P. C., at p. 438. See also *Vidal Dye Syndicate* v. *Levinstein*, 29 R. P. C. 345, C. A.

In *Heath* v. *Unwin*, *supra*, it was suggested by Lord BROUGHAM that though where the elements were specified, a compound of them might be an equivalent, the converse would not apply. This was doubtless suggested by the circumstances of the particular case (as to which see p. 141 *n.* (*c*)), and the rule cannot be regarded as general, *e.g.* it would not apply in a case where the compound was the cheapest or most convenient form, if a competent chemist could see that its action depended on the presence of the elements.

(*u*) *Nobel* v. *Anderson*, 12 R. P. C. 167, H. L.; *Andrews' Patent*, 24 R. P. C. 366, H. L.

(*x*) Of course such decision could only apply to the facts of the time and should have as little effect on a Court of to-day as a decision in the eighteenth century that a written warning was insufficient because it was not to be presumed that the ordinary man could read or write. The suggestion that the doctrine of equivalents does not apply to chemistry, or that "there can be no predication in chemistry," is particularly ludicrous in view of the fact that most of the doctrines of the science are founded on the theory of equivalents. Of course there are regions in chemistry where the success of a process would be doubtful, but any competent chemist could write the equations for many thousands of reactions which he has never performed or read of with the greatest confidence in their results.

(*y*) *Nobel* v. *Anderson*, 12 R. P. C. 167, H. L.; *cf.* also *Welsbach Incandescent Coy.* v. *Daylight Coy.*, 17 R. P. C., at p. 146. For examples of what have been held to be equivalents in chemical patents, see *Badische, &c.* v. *Levinstein*, 4 R. P. C. 449, H. L.; *Incandescent Lighting Coy.* v. *De Mare*

There is no class of cases where the thorough education of the Court by means of expert testimony is so necessary as in chemical cases. There are some reactions which are clear and straightforward and with regard to which a chemist would have no hesitation in applying his knowledge as to possible variations. In others, where the chemical nature of the reaction are obscure (*z*), or complicating reactions are probable or possible, or experiment is dangerous (*a*), he will be afraid to vary from the directions given, or uncertain of the result of such variations. Again in some cases a reaction is clearly quantitative and proportions important, while in others a reaction said to give a certain substance may obviously be one giving a mixed result, of which the substance named is only the main ingredient (*b*). Although generally the complete novelty of a discovery is favourable to a broad interpretation on the question of variations and equivalents, it must not be forgotten that such a discovery may lead the chemist into a *terra incognita*, where he will be chary of trusting to knowledge acquired in other fields (*c*).

All these varying considerations have to be taken into account in deciding how far the doctrine of equivalents may be applied, together with the question of whether a chemist would understand the invention to be a broad discovery or the choice of a particularly favourable example or method, and of whether there is anything in the wording or in the nature of the discovery which would indicate that substances, etc., other than those named are excluded (*d*). But the general

Incandescent System, 13 R. P. C. 559, C. A. (The reasoning in this case must be applied with care in view of the subsequent case of *Welsbach Incandescent Coy.* v. *Daylight Coy.*, *supra*.)

(*z*) *Cf. Vidal Dye Syndicate* v. *Levinstein*, 29 R. P. C. 245, 277, C. A.

(*a*) *Cf. Maxim Nordenfeldt Coy.* v. *Anderson*, *infra*.

(*b*) *Illustrative case:* A patentee claimed making artificial musk and said that for that purpose he prepared hydrocarbon of the $C_{11}H_{16}$ group, "and proceeded as follows": and then described a process starting with toluene and (after certain reactions) distilling and taking the portion which came off between 170° C. and 200° C. It was found that it would be clear to a chemist with the knowledge of the time, from the wideness of the limits and the nature of the reactions, that the product would not be pure butyl toluene (of the $C_{11}H_{16}$ group), but a mixture of that and butyl xylene (which latter was not of the $C_{11}H_{16}$ group). The defendant prepared an artificial musk, starting with xylene and getting again a mixture of butyl toluene and butyl xylene, though in different proportions to that given by the patented process. It was held that he infringed. *Fabriques, &c.* v. *Lafitte*, 16 R. P. C. 61.

(*c*) See *Maxim Nordenfeldt* v. *Anderson*, *infra*.

(*d*) *Illustrative case:* Where in a patent for producing gas-mantles from oxides of the rare earths the patentee had indicated lanthanum and zirconium and certain equivalents as the substances to be used, the Court held that the substitution of erbium for lanthanum was an

tendency is to adopt a wide construction on the question of reagents, proportions, temperatures, and details of preparation (*e*), unless apart from these there would be no invention (*f*), but such construction will not be extended so as to make the specification cover a change greater than could have been contemplated with the knowledge of the date of the grant (*g*).

In fact with a really new discovery in chemical matters the Courts take a very broad line of interpretation. There is no science where a statement is more suggestive of alternatives and developments than is the case with chemistry, or where it would be more hopeless to expect the inventor to name all possible means of carrying out his invention, and the recognition of this has led the Courts to consider what process or materials would suggest themselves as applicable to the trained chemist reading

equivalent, but where zirconium was only used for building the skeleton, and the light-giving power was obtained from a coating of oxide of chronium (which was not a rare earth or in any way suggested in the specification), this did not come within the patent. So, too, the use of zirconium and a small quantity of cerium (cerium being indicated in the patent as prejudicial) was not within it. *Incandescent Lighting Coy.* v. *De Mare Incandescent System*, 13 R. P. C. 559, C. A.; *Incandescent Lighting Coy.* v. *Sunlight Coy.*, 13 R. P. C. 333; *Welsbach Incandescent Coy.* v. *Daylight Coy.*, 17 R. P. C. 141, C. A. See also *Nobel* v. *Anderson*, 12 R. P. C. 164, H. L.; *Unwin* v. *Heath* (1855), 5 H. L. C. 505.

(*e*) On proportions generally, see *Patent Type Foundry Coy.* v. *Richards* (1860), 6 Jur. (N. S.) 39. For cases where such variations have been held to be infringements, see *Badische, &c.* v. *Levinstein*, 4 R. P. C. 449, H. L.; *Leonhardt* v. *Kalle*, 12 R. P. C. 103 (different reagent and proportions); *Fabriques, &c.* v. *Lafitte*, 16 R. P. C. 61 (different reagent and proportions); *Fabriques, &c.* v. *Caspers*, 15 R. P. C. 94 (different reagents) *Thermit, Ltd.* v. *Weldite, Ltd.*, 24 R. P. C. 441 (variation in reagent); *Saccharin Corporation* v. *Anglo-Continental Coy.*, 17 R. P. C., at p. 319 (directions as to temperature and time); *Cassel Gold Extraction Coy.* v. *Cyanide Recovery Coy.*, 11 R. P. C. 638 (addition of electric current); *Moseley* v. *Victoria Rubber Coy.*, 4 R. P. C. 241 (method of solution and fixing); *Farbenfabriken, &c.* v. *Chemische, &c.*, 22 R. P. C. 501 (method of purification); *Badische, &c.* v. *La Société des usines du Rhone*, 14 R. P. C. 875 (temperature); *Gamble* v. *Kurtz* (1846), 3 C. B. 425 (reagent); see also cases in notes (*f*) (*g*) (*h*) p. 153 but see *contra* *Lancashire Explosive Coy.* v. *Roburite Explosive Coy.*, 14 R. P. C. 303, H. L. (dissolving with heat); *Plating Coy.* v. *Farquharson* (1883), Griff. 187, H. L. (some parts of process omitted).

(*f*) For a case where directions as to strength were read in on this ground, see *Max Muller's Patent*, 24 R. P. C. 465. See also following cases, where detail directions were held essential—*Heidemann* v. *Smokeless Powder Coy.*, 15 R. P. C. 305 (completely dissolving); *Davies* v. *Curtis and Harvey*, 20 R. P. C. 561, C. A. (use of special form of carbon); *Wilson* v. *Union Oil Mills*, 9 R. P. C. 57 (special reagent).

(*g*) *Illustrative case:* Where a patent claimed an explosive compound, consisting essentially of guncotton mixed with nitroglycerine and with castor oil or other suitable oil for the purpose specified, and gave an example in which the constituents were 2 to 5 per cent. castor oil, 10 to 16 per cent. of nitroglycerine, and the rest guncotton, it was held that a compound consisting of 58 per cent. nitroglycerine, 37 per cent. guncotton, and 5 per cent. vaseline was not an infringement. In the

the specification, or what he would understand to be the result of the reactions set out, rather than to hold the ambit of the invention to be indicated by the particular chemical substances named (*h*), or processes selected. Thus, where reagents are named for effecting well-known purposes, such as oxidation or reduction, the common knowledge of chemists will be freely incorporated so as to make the specification cover other suitable bodies (*i*), and the chemist will be assumed to apply the information at his disposal in deciding which are suitable (*j*).

Common equivalents.

One common class of alteration, usually held not to avoid infringement, is where the relative motion of two parts being kept the same, the actual motion is changed (*k*). So a mere change in the direction of motion will generally be held to be an equivalent (*l*). So too such variations as reciprocation for oscillation do not prevent infringement (*m*).

A few further cases of equivalents are collected in the notes (*n*).

state of knowledge at the date of the grant it would not have been known that it was possible so to vary the proportions. *Maxim Nordenfeldt Coy.*, v. *Anderson*, 15 R. P. C. 421, H. L. See also *Vidal Dye Syndicate* v. *Levinstein*, 29 R. P. C. 274, 275, C. A.

(*h*) "The Court ought to take a broad view, and ought not to hold that ingredients substantially differ because they have different chemical names and only differ in minor and comparatively unimportant aspects from the substances mentioned." *Per* ROMER, L.J., in *Welsbach Incandescent Coy.* v. *Daylight Coy.*, 17 R. P. C., at p. 140, C. A.

(*i*) *Leonhardt* v. *Kalle*, 12 R. P. C. 103.

(*j*) *Thermit, Ltd.* v. *Weldite, Ltd.*, 24 R. P. C. 441.

Somewhat different views were expressed by the Court of Appeal in *Maxim Nordenfeldt Coy.* v. *Anderson*, 14 R. P. C. 671, 684, but these were doubted in the House of Lords, 15 R. P. C. 421, 429.

(*k*) *Illustrative cases* :—

In a patent for a brick-making machine the clay was described as being moved against cutting wires. The defendant moved the cutting wires against the clay. *Held*, infringement. *Murray* v. *Clayton* (1872), Ch. 10 App. 675 *n*.

In a patent for a pencil case the lead was described as held in a part which was moved forward by a pin in it moving in a slot in the outer case. The defendant put the pin in the outer case and the slot in the moving part. *Held*, infringement. *Woodward* v. *Sansum*, 4 R. P. C. 166, C. A.

In a patent for a musical-box a disc was described as rotating and moving fixed levers. The defendant rotated the levers over a fixed disc. *Held*, infringement. *Ehrlich* v. *Ihlee*, 5 R. P. C. 437, C. A. See also *Electrolytic Coy.* v. *Evans*, 17 R. P. C. 733.

(*l*) *Illustrative case* : Where a patentee described a method of expanding tubes by forcing in a conical plug between rollers, and the defendant actuated his rollers by pulling out a plug, it was held an infringement. *Dudgeon* v. *Thompson* (1873), 3 S. XI. 863.

(*m*) See *White* v. *Bertrams*, 14 R. P. C. 735, I. H.; *Van Berkel* v. *Simpson*, 24 R. P. C. 117, C. A. Ir.

(*n*) Claim for tyre-cover with hooks on one edge fitting into eyes on the other. *Held*, infringed by tyre with two sets of hooks engaging with each other. *Birmingham Tyre Coy.* v. *Reliance Coy.*, 19 R. P. C. 298.

Claim for hair-curler as shown with legs having a series of twists for interlocking. *Held*, infringed by curler where legs had only one twist, but had also bulb at end which gave same effect. *Entwistle* v. *Cuthbert*, 14 R. P. C. 324. See also *Hinde* v. *Osborne*, 2 R. P. C. 64.

Variations which are infringements.

Quite apart from any question of equivalents the Courts have always held that a departure from some adjectival description such as "straight," so slight as not to change the effect, does not prevent infringement (*o*). This of course applies even more strongly when the limitation is said only to be preferable.

An extension of this class of cases is where some mathematical form is specified, and another similar form is taken which has to a greater or less degree the advantages desired (*p*).

Nor will a patentee in general be confined to the strict meaning of an adjective or technical term if it appears that it has been used in a popular or approximate sense (*q*).

Claim for cycle-saddle having supporting wires diverging from a point in front and attached to supporting plate at back. *Held*, infringed by a saddle where there was no plate, but the wires were turned in at back so as to form a support. *Brooks* v. *Rendall*, 24 R. P. C. 17.

In a machine where only *small* pressures were needed a fan was considered an equivalent for an air-pump. *Macdonald* v. *Fraser*, 11 R. P. C. 169, I. H. See also *Sutcliffes* v. *Abbott*, 20 R. P. C. 50.

Claim for tennis-marker having revolving disc to supply colour to marking wheel. *Held*, infringed where this was replaced by revolving brush. *Osmond* v. *Hirst*, 2 R. P. C. 265. See also *Electrolytic Coy.* v. *Evans*, 17 R. P. C. 733, but *cf. contra Wallace* v. *Jack*, 22 R. P. C. 581.

Substitution of square shank for circular shank and key, and casting two pieces in one. *Held*, to be infringement. *Lake and Elliott* v. *Rotax Motor Accessories Coy.*, 28 R. P. C. 532, C. A.

Substitution of cyclone for canvas filter. *British Vacuum Cleaner Coy.* v. *Exton Hotels, Ltd.*, 25 R. P. C. 617.

In the case of a patent for making a staple with unequal legs from a continuous wire driving into a boot and clicking, this being broadly new, it was held that a mere variation in the order of the cycle of operations did not prevent infringement. *British Shoe Machinery Coy.* v. *Thompson*, 22 R. P. C. 177.

(*o*) *Illustrative cases* :—

Where a patentee had spoken of "straight" seams for stays, and the defendant had seams with a very small curvature, he was held to infringe. *Young* v. *Rosenthal*, 1 R. P. C. 29.

Where plaintiff had claimed a roller with circular grooves and the defendant had spiral grooves sixty to an inch so that they appeared circular, he was held to have infringed. *Ralston* v. *Smith* (1865), 11 H. L. C. 233.

(*p*) *Illustrative cases* :—

Where a patentee claimed a pavement light having glass "moulded so as to be of a prism-like form so as to divert light," and further said that "the sides of the prism may be flat or curved in a horizontal plane," but the patent was not confined to a prism of any particular angle, and in fact in one figure the side was composed of two parts inclined to one another, it was held that a light in which the inclined face was curved in a vertical plane, which was equivalent to having a number of facets at different angles, infringed. *Hayward* v. *Pavement Light Coy.*, 1 R. P. C. 207.

In the case of a patent for a combination which included a tapered horn, it was held that the use of a horn in the form of a stepped pyramid was an infringement. *Gramophone Coy.* v. *Ullman*, 23 R. P. C. 752, C. A. But *cf. Gramophone Coy.* v. *Ruhl*, 27 R. P. C. 629. See also *Newall* v. *Elliott* (1858), 4 C. B. (N. S.) 269; but *cf. Stead* v. *Anderson* (1846), 2 W. P. C. 147. Similar rules apply to changes in material, *United Telephone Coy.* v. *Bassano*, 3 R. P. C., at p. 307.

(*q*) *Illustrative cases* :—

In the case of a patent for making

Claim for new article.

A claim to a new article covers the article however made (*r*). So a claim to the use of an article for a special purpose covers such use, however the article may be prepared, even if the article is a new one and a special means of preparation is given in the specification (*s*). Of course if the means of preparation are incorporated in the claim this does not apply (*t*).

Use for different purpose.

Where a claim for a process or apparatus is not specifically confined to its use for a certain purpose it may be infringed by the application of such process or apparatus to purposes different from those described by the patentee, and even by its application to inventions of a later date (*u*).

gas mantles by impregnating cotton "fabric" with oxides of the rare earths and burning away the cotton, the Court held that "plumes" consisting of threads tied on platinum wire was within it. *Incandescent Lighting Coy.* v. *De Mare Incandescent System*, 13 R. P. C., at p. 330.

Where a patentee in describing his process for the distillation of shale at two temperatures for the purpose of getting out both the oil and ammonia proposed to effect both distillations in different parts of the same retort, but spoke of the lower part as being kept at a "low uniform temperature" and a "low equal temperature," and the upper part at a considerably higher temperature, it was held that these terms could not be strictly construed since it was a physical fact, well known both to the patentee and to any competent workman, that the temperature of the retort varied gradually, and at the point of division must be approximately the same in both parts. *Young and Beilby* v. *Hermand Oil Coy.*, 9 R. P. C. 373, H. L. See also *Clark* v. *Adie* (No. 2) (1876), 2 A. C. 423, H. L. (parallel); *United Telephone Coy.* v. *Bassano*, 3 R. P. C., at p. 306 (tympan); *Lister* v. *Dix*, 16 R. P. C. 89 (float); *Scott* v. *Hull Steam Fishing Coy.*, 14 R. P. C. 143 (rope); but *cf. Scott* v. *Hamling*, 14 R. P. C. 123; *Leeds Forge* v. *Deighton*, 21 R. P. C. 487, 494, H. L. (sharp ridge); *Roger* v. *Cochrane*, 26 R. P. C. 596, H. L. (fluid). See also cases at p. 128 *n.* (*s*).

(*r*) *Badische, &c.* v. *Levinstein*, 2 R. P. C., at pp. 90, 91; *Monnet* v. *Beck*, 14 R. P. C., at pp. 843, 844; *Fox* v. *Astrachans, Ltd.*, 27 R. P. C. 769. See also cases in note (*s*), *infra*.

This proposition was disapproved (at any rate by SMITH, L.J.) in *Nobel* v. *Anderson*, 11 R. P. C., at p. 534, C. A. Here, however, the patent in question was clearly for a special mode of preparation. See also *Vorwerk* v. *Evans*, 7 R. P. C. 171; *Kopp* v. *Rosenwald*, 19 R. P. C. 211, where doubts were expressed if a patent could be obtained for an article apart from a special method of manufacture.

It is extremely difficult to follow these doubts in view of the fact that the great majority of patents, *e.g.* for machines, etc., are for specific articles without reference to their mode of manufacture. See also *Vorwerk* v. *Evans*, 7 R. P. C. 274, C. A.

(*s*) *Illustrative cases*:—

Where a patentee claimed "in hoods prepared as illuminant appliances the use of thorinum oxide . . . substantially as described," it was held that these last words qualified "use," and not "prepared," and that mantles containing thorinum oxide, however prepared, were within the patent. *Welsbach Incandescent Coy.* v. *New Incandescent Coy.*, 17 R. P. C. 237.

Where a patent claimed the combination of a carbon filament and a glass receiver exhausted of air, it was held to include a filament, however made. *Edison* v. *Woodhouse*, 4 R. P. C. 79, C. A.

(*t*) *Plating Coy.* v. *Farquharson* (1883), Griff. 187, H. L.; *Nobel* v. *Anderson*, 12 R. P. C. 519.

(*u*) *Pneumatic Tyre Coy.* v. *East London Rubber Coy.*, 14 R. P. C., at pp. 103 and 573, C. A.; *Palmer Tyre Coy.* v. *Pneumatic Tyre Coy.*, 16 R. P. C., at p. 494; *North British Rubber Coy.* v. *Gormully and Jeffreys*,

Where the claim is for the use for a particular purpose of course it is only infringed by the use for this purpose and the relief is limited accordingly (*x*).

Substances in special state.

If the patentee speaks of substances being used in a process in a certain state and a defendant takes them in another state and subjects them to additional processes which in fact bring them into the specified state he does not escape infringement (*y*). So, too, if in normal user the substances are brought into the specified state the user is liable for infringement (*z*).

Fortuitous use of invention.

The class of cases last referred to must be distinguished from those in which an apparatus or material is manufactured

15 R. P. C. 254, H. L., and p. 154 *n.* (*s*); *Edison* v. *Holland*, 6 R. P. C. 243; *Electric Telegraph Coy.* v. *Brett* (1851), 20 L. J. (C. P.) 123 and p. 144 *n.* (*r*); *Adhesive Dry Mounting Coy.* v. *Trapp*, 27 R. P. C. 341; *Mouchel* v. *Coignet*, 24 R. P. C. 229, C. A., affirmed in H. L. under title *Hennibique* v. *Cowlin*, 26 R. P. C. 280; but *cf. Plating Coy.* v. *Farquharson* (1883), Griff., at p. 192.

(*x*) *Illustrative cases*:—

Where a patentee described and claimed a process for making tungsten filaments and the defendant used it not for making, but for improving a filament already made, it was held no infringement. *Osram Lamp Works Ltd.* v. *Z. Electric Lamp Coy.*, 29 R. P. C. 428.

See also *Macdonald* v. *Fraser*, 11 R. P. C. 169, I. H.; *Preston Davies* v. *Black*, 11 R. P. C. 313, O. H.; *Higgs* v. *Goodwin* (1858), 27 L. J. (Q. B.) 251. The dictum to the contrary effect in *Watling* v. *Stevens*, 3 R. P. C., at p. 131, C. A., would seem to go too far; but the onus may be on the party using it to show that it did not effect the same purpose. *Z. Electric Lamp Coy.* v. *Marples*, 27 R. P. C. 737, C. A.

(*y*) *Illustrative cases*:—

Where a patentee described a process in which bodies were put into fuming sulphuric acid, and the defendant put them into weaker sulphuric acid and then evaporated, he was held to infringe. *Badische, &c.* v. *Levinstein*, 4 R. P. C. 449, H. L. See also *Fabriques, &c.* v. *Lafitte*, 6 R. P. C. 61.

Where a patentee claimed a method of fixing glass bricks to walls by means of glass pellets placed on their backs, and the defendant used sand, etc., which vitrified in the course of the operation, it was held that even if the patent was confined to the use of glass this would be an infringement. *National Opalite Coy.* v. *Grand Hotel Coy.*, 15 R. P. C. 249. See also *Muntz* v. *Foster* (1844), 2 W. P. C. 96; *Cheetham* v. *Nuttall*, 10 R. P. C. 321.

So, too, where a claim was for carrying out a process of reduction in an atmosphere of hydrogen and steam, it was held to be infringed by reducing in an atmosphere of hydrogen which contained *naturally* a little water vapour, which was sufficient for the purpose. *Osram Lamp Works* v. *Z. Electric Lamp Coy.*, 29 R. P. C. 425, 426.

(*z*) *Illustrative cases*:—

Where a patent for the use in the purification of gas of "precipitated or hydrated oxides" had been construed as meaning oxides which were artificially prepared, it was held that the use of "bog-ochre," which was a natural oxide, was not an infringement of the patent, but that continuing to use such "bog-ochre" after it had become charged with sulphur and then reoxidised to purify it was an infringement, because it was now an artificial oxide. *Hills* v. *Liverpool Gas Coy.* (1862), 32 L. J. (CH.) 28.

In the case of a patent for a stopper for aerated water bottles constructed of a cylinder or plug or hard wood having a greater specific gravity than water, it was held that it was infringed by using a stopper of wood which before use was not of greater specific gravity than water, but became so by immersion. *Barrett* v. *Vernon* (1877), 25 W. R. 343. See, however, *Binny* v. *Feldtman* (1879), Griff. 49, H. L., and p. 152 *n.* (*a*).

in one state, but in the course of use it deteriorates by wear into another. In these cases it is usually held that there is no infringement (*a*), nor is it considered that there is infringement because owing to an accident a machine might get into a state which would bring it within the patent (*b*). So, too, if the use of a substance A for a particular purpose is claimed, the use of another substance B would not be held to be an infringement, although it contained small portions of A as an impurity, if such impurity were not essential or advantageous in the defendant's process (*c*). In these cases the use of the patented manufacture is only fortuitous, but the Courts do not look on a use as fortuitous where, although other means may be provided for effecting the result desired, the patented device is used, and in the normal working of the machine affords an additional advantage or safeguard (*d*). The normal conditions

(*a*) *Illustrative cases*:—

Patent for a packing of fibrous strands impregnated with powdered mineral lubricant in which the specification described a process for such lubrication. *Held*, not to be infringed by selling packing composed of fibrous bags containing powdered lubricant, although in course of transit and use the packing worked into the fibre. *Binney* v. *Feldtman* (1875), Griff. 47, H. L..

It should be noted that in this case the manufacturer was sued. It is doubtful whether an action against a user would not have succeeded. At any rate the case is on the extreme border line. *Cf.* cases at p. 157 *n.* (*g*). and *Roger* v. *Cochrane*, 25 R. P. C. 762, I. H. The decision on this last case was reversed in H. L. 26 R. P. C. 591, but this point was not discussed.

Where in a patent for a brush-cutting machine in which the claim was held to be for a combination which included cutting plates whose edges were out of parallelism, it was held that a machine originally constructed with parallel plates did not become an infringement because in course of wear or by reasons of bad adjustment there was a slight want of parallelism. *Moore* v. *Bennett*, 1 R. P. C. 129, H. L. See also *Blackstone* v. *Bamford*, 27 R. P. C. 125; *Gwynne* v. *Drysdale*, 3 R. P. C. 66, I. H.; *Newall* v. *Elliott* (1863), 10 L. T. 792.

(*b*) *Illustrative case*: So the Court refused to hold that a gas-meter was an infringement of a certain patent because it might become so if a spring broke or ceased to act. *Meters, Ltd.* v. *Metropolitan Gas Coy.*, 24 R. P. C. 506; but *cf. British Vacuum Cleaner Coy.* v. *Exton Hotels Coy.*, 25 R. P. C. 629. See also *Shoe Machinery Coy.* v. *Cutlan* (*No.* 2), 13 R. P. C. 147.

(*c*) *Illustrative case*: Where the patent was for the production of an explosive by the treatment of soluble nitro-cellulose, and the defendant was applying the same process to the insoluble, it was held that the fact that the insoluble necessarily contained about 10 per cent. of soluble did not make this an infringement. *Nobel* v. *Anderson*, 12 R. P. C. 164, H. L. But see *Welsbach Incandescent Coy.* v. *New Incandescent Coy.*, 17 R. P. C. 217, p. 154 *n.* (*p*).

(*d*) *Illustrative case*: In an action brought for an infringement of the Welch patent for holding on a tyre by means of inextensible wires in the edge, it was contended that the defendant's tyre would hold on apart from the inextensibility of the edge and to prove this a test was made in which one was ridden with the edge cut. The Court, however, were of opinion that though it might hold on in ordinary circumstances with the wires cut, yet in the case of a sudden emergency it would be the inextensibility that would hold it on, and held that the patent was infringed. *Dunlop Pneumatic Tyre Coy.* v. *Clifton Tyre Coy.*, 20 R. P. C. 393, C. A. *Cf. Dunlop Pneumatic*

of user must also be considered in deciding whether an apparatus is an infringement (*e*).

Directions usually considered non-essential.

The general tendency is to assume that statements as to proportions (*f*), means of preparation (*g*), or method of use (*h*), are directory rather than essential parts of the claim unless the wording of the specification shows otherwise, or unless apart from these details there would be no invention.

Alternative lines of defence.

The joint effect of the two rules given in the chapter on construction, namely, that a claim is *primâ facie* a disclaimer limiting rather than extending the invention as described (*i*), and that whatever may be the invention really made (or even described) the monopoly does not extend beyond the invention claimed (*k*), gives the defendant two lines of defence—that is to say, he may escape infringement either by showing that what he has done is not within the spirit of the patentee's real invention, though apparently within the wording of the claim (*l*), or he

Tyre Coy. v. *Wapshare Tyre Coy.*, 17 R. P. C. 433. See also *North British Rubber Coy.* v. *Gormully and Jeffreys*, 15 R. P. C. 251, H. L.; *Dunlop Pneumatic Tyre Coy.* v. *New Ixion Tyre Coy.*, 14 R. P. C., at p. 873; *Dunlop Pneumatic Tyre Coy.* v. *New Lamb Tyre Coy.*, 20 R. P. C. 303, 1. H.; *Dunlop Pneumatic Tyre Coy.* v. *Ostrich Tyre Coy.*, 19 R. P. C. 365, 371; *Howes* v. *Webber*, 13 R. P. C. 39, C. A. *Cf. Consolidated Car Heating Coy.* v. *Came*, p. 144 *n.*(*m*).

So, too, where in a process some of the success came from the use of the patented invention. *Betts* v. *De Vitré* (1873), 3 Ch. App. 429.

(*e*) *Illustrative case:* Where in a patent for refrigerating apparatus certain pipes were shown as sloping so that water could run away, a defendant who fitted an apparatus aboard ship with pipes which were horizontal when the ship was at rest, but became inclined when the ship rolled, was held to infringe. *Haslam* v. *Hall*, 5 R. P. C. 1.

(*f*) *Betts* v. *Menzies* (1862), 10 H. L. C. 117; *Betts* v. *Neilson* (1871), 3 Ch. App. 429. See also *Saccharin Corporation, Ltd.* v. *Anglo-Continental Coy.* 17 R. P. C., at p. 319; *Patent Type Foundry Coy.* v. *Richards* (1860), 6 Jur. (N. S.) 39, and cases at p. 155 *n.* (*u*).

(*g*) *Illustrative case:* Where in a patent for a dry battery the specification spoke throughout of the materials being pulverised, but this was not mentioned in the claim, it was held that the claim was not restricted to cases where the materials were so pulverised. *Patent Exploitation, Ltd.* v. *Siemens*, 21 R. P. C. 547, H. L. See also *British Shoe Machinery Coy.* v. *Thompson*, 22 R. P. C. 177; but *cf. Monnet* v. *Beck*, 14 R. P. C. 777.

(*h*) *Illustrative case:* The specification of a patent for a concrete pile spoke of the pile being armed with a shoe to facilitate driving, but said it could also be inserted by other methods. The claim was for the pile as described, and was held to include piles whether adapted for driving or not. *Mouchel* v. *Coignet*, 24 R. P. C. 229, C. A.; affirmed in H. L. under title *Hennebique* v. *Cowlen*, 26 R. P. C. 280.

(*i*) See chapter on "Construction," p. 116.

(*k*) See chapter on "Construction," p. 121.

(*l*) *Illustrative case:* Where a patentee described making by physical means a series of cells in the backing for a rubber stamp, and claimed the improved foundation consisting of a series of cells of any suitable shape adapted to receive the pressure upon their walls endwise, it was held that where by chemical means a series of cells having axes in all directions was formed in the backing of a stamp, this was no infringement. *Pneumatic Rubber Stamp Coy.* v. *Lindner*, 15 R. P. C. 525. See also *Bovill* v. *Pimm*

may say that whatever the patentee may have invented the public are only prohibited from taking what is claimed, and that he has not done this.

An improvement may be an infringement.

Although the fact that the defendant has shown ingenuity and has produced a real improvement may be evidence in his favour on the question of whether his device is an equivalent to that claimed (*n*), yet if what he has taken comes within the terms of the claim ingenuity is no defence (*o*). Nor is it any defence that he has added something to the patented device (*p*), or enabled it to fulfil other functions (*q*), or has made it slightly better or worse (*r*), nor that the object he seeks by its use is different to that sought by the patentee (*s*). Where the

(1856), 11 Ex., at p. 730; *Osborne* v. *Board*, 13 R. P. C. 740; *Atkins and Applegarth* v. *Castner Kellner Alkali Coy.*, 18 R. P. C. 281, 207; *Ashworth* v. *Roberts*, 9 R. P. C. 309, C. A.

(*n*) See pp. 140, 141

(*o*) "The superadding of ingenuity to robbery does not make the operation justifiable," *per* BOWEN, L.J., in *Wenham Gas Coy.* v. *Champion Gas Coy.*, 9 R. P. C., at p. 50, C. A.; *Proctor* v. *Bennis*, 4 R. P. C. 333, 354, C. A.; *Haskell* v. *Hutchinson* (*No.* 2), 25 R. P. C. 194; *Marconi* v. *British Radio-Telegraph Coy.*, 28 R. P. C. 181, 218.

(*p*) *Illustrative cases*:—

A patent for the use of the hot blast in conjunction with hard coal in iron-making was held to be infringed by the use of a combination of hard and soft coal with a hot blast. *Crane* v. *Price* (1842), W. P. C. 377.

So where a patent claimed the use of thorium oxide in mantles a mixture of 99 per cent. of thorium and 1 per cent. corium was held to infringe, though in fact the greater part of the illuminating power came from the corium. *Welsbach Incandescent Coy.* v. *New Incandescent Coy.*, 17 R. P. C. 237.

A patent described and claimed a system of separating oxygen from nitrogen by freezing and applying the principle of rectification similar to that adopted in the Coffey still. The defendants improved on this process in two respects. Firstly, they got additional cooling by letting the expanding gases do additional work; secondly, they partly separated the gases before applying the rectifying principle. *Held*, infringement. *British Liquid Air Coy.* v. *British Oxygen Coy.*, 26 R. P. C. 526, H. L. See also *Betts* v. *De Vitré* (1873), 37 L. J. (CH.) 325; *Needham* v. *Johnson*, 1 R. P. C. 53, C. A.; *Proctor* v. *Bennis*, 4 R. P. C. 333, 354, C. A.; *Laine* v. *Herrold*, 9 R. P. C. 447; *Howes* v. *Webber*, 13 R. P. C. 30, C. A.; *Actiengesselschaft, &c.* v. *Schroeder*, 13 R. P. C. 473; *Thermit, Ltd.* v. *Weldite, Ltd.*, 24 R. P. C. 441; *British Vacuum Cleaner Coy.* v. *Exton Hotels Coy.*, 25 R. P. C. 617; *Roger* v. *Cochrane*, 26 R. P. C. 591, H. L. See, however, *Dunlop Pneumatic Tyre Coy.* v. *Moseley*, 18 R. P. C. 411.

(*q*) *Illustrative case*: Where a patent claimed the use of a priming cap to effect ignition at starting when the walls of the cylinder were cold, and the defendants used a device which acted not only at the start, but also when the engine was running, this was held to be an infringement. *British Motor Coy.* v. *Universal Motor Coy.*, 16 R. P. C. 113. See also *United Telephone Coy.* v. *Harrison* (1883), 21 Ch. D. 721; *Cannington* v. *Nuttall* (1871), L. R. 5 H. L., at p. 230; *Macdonald* v. *Fraser*, 11 R. P. C. 169, I. H.; *Pneumatic Tyre Coy.* v. *East London Rubber Coy.*, 14 R. P. C., at p. 103; *Haskell* v. *Hutchinson*, 22 R. P. C. 493; *Crosthwaite* v. *Senior*, 26 R. P. C. 713.

(*r*) See *Useful Patents* v. *Rylands*, 2 R. P. C. 255; *Automatic Coal Gas Retort Coy.* v. *Salford Corporation*, 14 R. P. C. 450; *Heine* v. *Coninco*, 21 R. C. P. 202; *British Vacuum Cleaner Coy.* v. *Suctions, Ltd.*, 21 R. P. C. 303; *Halden* v. *Hall*, 21 R. P. C. 609.

(*s*) *Illustrative case*: Where the patent claimed an explosive compound

defendant has taken a substance, etc., within the claim, but different from those whose use is described in the specification, the variations from the directions given in the latter necessitated by the change (even if these involve ingenuity) do not usually avoid infringement (*t*).

Other variations.

In the case where the defendant makes small variations in an essential element, not coming under any of the classifications dealt with above, the Court really acts simply as a jury would, and finds in each case whether on the particular facts the invention claimed has in substance been taken or not, and consequently precedents are of little value. A certain number of decisions have, however, been collected here which may possibly prove useful in particular cases (*u*).

in which oil was used as a moderant, the defendants used vaseline and said it was merely to prevent the metal being contaminated, WRIGHT, J., was of opinion that this would not matter if vaseline was within claim (which he *held* was not the case). *Maxim Nordenfeldt Coy.* v. *Anderson*, 14 R. P. C. 371, 385.

(*t*) *Illustrative case:* A patentee claimed "the combination of a grooved rim or metal tyre and an arched tyre of India rubber or other flexible material held in the groove by the pressure of an inflated tube within the arch which forces its edges against the side of the groove substantially as described" and described the inner tube as being made with a combination of canvas and rubber. The defendant used a pure rubber tube and varied the form of the groove, and it was proved that a pure rubber would not have acted with the shape of groove shown by the patentee because it was too extensible. *Held*, infringement. So, too, in another case where the edges were thickened for the same purpose. *North British Rubber Coy.* v. *Gormully and Jeffreys*, 15 R. P. C. 245, H. L.; *North British Rubber Coy.* v. *Macintosh*, 11 R. P. C. 477.

But see p. 147 *n.* (*g*).

See also *Hookham* v. *Johnson*, 14 R. P. C., at p. 577; *Leonhardt* v. *Kallé*, 12 R. P. C. 103. See *contra*, *per* ALDERSON, B., in *Morgan* v. *Seaward* (1837), W. P. C., at p. 178.

(*u*) Cases where variations held not to avoid infringement:—

PROPORTIONS: *Illustrative case:* Where in a patent for a fan the patentee said that the depths of the blades should be preferably not greater than one-eighth of the diameter of the fan, and the defendant had made blades of one-sixth the diameter, but it was shown by experiment that they act in substantially the same way as those described in the specification, he was held to have infringed. *Davidson* v. *Sun Fan Coy.*, 23 R. P. C. 493. See also *Automatic Coal Gas Retort Coy.* v. *Salford Corporation*, 4 R. P. C. 450 (angles).

FORM: *Tweedale* v. *Howard*, 13 R. P. C. 522; *British Vacuum Cleaner Coy.* v. *Suctions, Ltd.*, 21 R. P. C. 303.

VARIATIONS FROM DRAWINGS: *Illustrative case:* In the case of a patent construed as being for the particular method of centreing dobby levers shown in the drawing (such method giving the minimum of friction on the knives), the defendants had slightly varied these positions so that though they did not get the minimum of friction, they got nearly the minimum. *Held*, infringement. *Hattersley* v. *Hodgson*, 22 R. P. C. 229, C. A. See also *Fawcett* v. *Homan*, 13 R. P. C. 398, C. A.; *Leeds Forge* v. *Deighton*, 21 R. P. C. 487, 494, H. L.; *Wenham Gas Coy.* v. *May*, 4 R. P. C. 303; *Wenham Gas Coy.* v. *Champion Gas Light Coy.*, 9 R. P. C. 49, C. A.

ORDER OF OPERATIONS: *British United Shoe Machinery* v. *Thomson*, 22 R. P. C. 177, 196; *Hay* v. *Gonville*, 25 R. P. C. 161.

VARIATIONS IN ARRANGEMENT: *Thomson* v. *Moore*, 7 R. P. C. 325, H. L.; *Thomson* v. *Batty*, 6 R. P. C. 84.

Variations in old machine.

The fact that a defendant has merely varied or added to an old machine or process is, of course, no defence if such variation or addition brings him within the terms of the patent (*v*). But where both plaintiff and defendant have introduced variations in what was old, such variations being different, and all that is common being really what was known before, then there is no infringement (*w*).

Restricted interpretation.

In many cases a claim is restricted so as to make the patent merely for the example described. This is generally due to the fact that from absence of directions no further development could be made (*x*), or that owing to prior knowledge a narrow interpretation must be put upon the patent to preserve its validity (*y*).

Sometimes this is done so that a claim apparently to the use of a thing in general is confined to its use for the purpose described (*z*).

PART II

RIGHTS DEPENDING ON THE CONSTRUCTION OF THE GRANT

Extent of monopoly.

THE monopoly arises from and is defined by the patent itself (*a*), and is that of making, using, exercising, and vending the invention within the United Kingdom of Great Britain and Ireland and the Isle of Man (*b*), and any unauthorised person who does one or more of these acts thereby commits an infringement.

Cases where small variations held to avoid infringement :—

PROPORTIONS : see *Jandus Arc Coy.* v. *Arc Lamp Coy.*, 22 R. P. C. 384.

ORDER OF OPERATIONS : *Jahncke* v. *Bell*, 9 R. P. C. 94, C. A.

(*v*) *British Shoe Machinery Coy.* v. *Thomson*, 22 R. P. C. 177, 195; *English and American Machinery Coy.* v. *Union Coy.*, 11 R. P. C. 367, C.A.

(*w*) *Curtis* v. *Platt* (1865), 35 L. J. (CH.) 852, and cases at p. 133 *n.* (*e*). See also *Westinghouse* v. *Lancashire and Yorkshire Railway Coy.*, 1 R. P. C. 229; *Knight* v. *Argylls, Ltd.*, 29 R. P. C. 593, 608.

(*x*) *Maxim Nordenfeldt Coy.* v. *Anderson*, 15 R. P. C. 421, H. L.

(*y*) *E.g. Oddy* v. *Smith*, 5 R. P. C. 503; *Hocking* v. *Hocking*, 6 R. P. C. 69, H. L.; *Vorwerk* v. *Evans*, 7 R. P. C. 265, C. A.; *Preston Davies* v. *Black*, 11 R. P. C. 574, I. H.; *Jardine* v. *King*, 13 R. P. C. 411; *Birch* v. *Harrap*, 13 R. P. C. 615; *Allen* v. *Pyatt*, 16 R. P. C. 135; *Peters* v. *Owen*, 17 R. P. C. 80; *Chamberlain* v. *Bradford Corporation*, 20 R. P. C. 673, H. L.; *Corrigal* v. *Armstrong*, 22 R. P. C. 268; *New Inverted Coy.* v. *Globe Coy.*, 23 R. P. C. 157, C. A.; *Bosworth* v. *Components*, 24 R. P. C. 765.

(*z*) *Allan* v. *Finlay* (1857), 2 S. XIX. 1087; *Fletcher* v. *Glasgow Gas Commissioners*, 4 R. P. C. 386.

(*a*) See form of Letters Patent, App. *post*. See also *Von Heyden* v. *Neustadt* (1880), 50 L. J. (CH.), at p. 130, C. A.

(*b*) The Channel Islands have not been included within the Realm for this purpose since 1883, see s. 14 (1) and 46 & 47 Vict. c. 57, s. 16.

Use on board ship.

The use of patented articles on a British or foreign ship within British waters is an act of infringement (*c*), and in fact the mere presence of the article as part of the ship's equipment is sufficient to justify an injunction (*d*). But user on a British ship outside British waters is not an infringement (*e*).

The recent Act has created an exception to the above rule as to infringement by user on board a foreign ship in British waters. The use of an invention on a foreign vessel within the jurisdiction, which is not used therein for, or in connection with, the manufacture or preparation of anything intended to be sold in, or exported from, the United Kingdom or the Isle of Man, shall not be deemed an infringement provided the vessel belongs to a State which extends corresponding privileges to British ships in its waters (*f*).

Time of monopoly.

The time during which an unauthorised act may be an infringement commences on the acceptance of the complete specification (*g*), and terminates on the expiration of the patent. It would also seem that a person who manufactures articles in this country in infringement of patent rights may be restrained from selling them even after the expiration of the patent (*h*); but there is no reported case in which the use of such articles by other persons after the expiration of the patent has been held to be an infringement. There are special provisions in the case of patents granted in lieu of others revoked on the ground of fraud (*i*), and of patents that have been revived (*k*), and the patent rights may be suspended where the patentee has infringed the provisions of the Act as to restrictive clauses in contracts (*l*).

(c) *Caldwell* v. *Van Vlissingen* (1852), 21 L. J. (CH.) 97; *Adair* v. *Young* (1879), 12 Ch. D. 13, C. A.

(*d*) *Adair* v. *Young*, *supra*; see, however, *Caldwell* v. *Van Vlissingen*, *supra*, as to injunctions against masters.

(*e*) *Newall* v. *Elliott* (1864), 10 Jur. (N. S.) 954.

The fitting of the apparatus here would probably be an infringement, *ibid.* See also *Goucher* v. *Clayton* (1865), 11 Jur. (N. S.), at p. 465.

(*f*) Sect. 48.

It should be noted that this section only applies to foreign ships.

The following foreign States expressly confer corresponding rights on ships coming into their waters :—

Austria-Hungary.	Finland.
Denmark.	Germany.
Japan.	Norway.
Mexico.	Salvador.

In the case of other countries the question as to whether their ships come within the provisions of this section would depend on the interpretation given by their Courts to the rights of patentees. In most countries the point has not been decided, but in the United States of America it has been decided that the use of an invention on a vessel coming into its ports is not an infringement. See *Brown* v. *Duchesne*, 19 Howard, 183.

(*g*) Sect. 10. See also *Dowling* v. *Billington*, 7 R. P. C. at p. 201.

(*h*) *Crossley* v. *Beverley* (1829), W. P. C. 119.

(*i*) See p. 216.

(*k*) See p. 284.

(*l*) See p. 249.

Articles made abroad.

As the invention is a new manufacture and manufacture in patent law includes both the process and the thing made (*m*), the commission of any of the prohibited acts with regard to either of these constitutes an infringement of the patent. Thus the sale of an article in this country, whether such article has been made here or abroad, is an infringement of a patent either for the article itself or for the process of making it (*n*). The same rule has been held to apply where a patented process has been used in making an article out of which the article imported is made (*o*).

A further extension of the rule (which in the author's opinion is open to doubt) is that where there is a patent for a machine, the sale within the realm of articles manufactured on that machine out of the realm is an infringement of the patent for the machine (*p*). It would appear difficult to assign any meaning to the word invention which would include an article made on a patented machine.

Acts constituting infringement.

Shortly, it may be said that any act which interferes with the full enjoyment by the patentee of the monopoly granted to him constitutes an infringement (*q*).

Making.

Under making is included any manufacture either for private use (*r*), or for sale here, or for export abroad (*s*).

Exercising or using.

The prohibition against exercising or using covers any use

(*m*) See p. 17.

(*n*) *Von Heyden* v. *Neudstadt* (1880), 14 Ch. D. 230, C. A.; *Walton* v. *Lavater* (1860), 29 L. J. (c.p.) 275; *Wright* v. *Hitchcock* (1870), L. R. 5 Ex. 37; *Elmslie* v. *Boursier* (1869), L. R. 9 Eq. 217; *Betts* v. *Neilson* (1868), 3 Ch. App. 429; *Betts* v. *Wilmot* (1871), 6 Ch. App. 239. See also *Badische, &c.* v. *Chemische Fabrik, &c.*, 21 R. P. C. 345.

(*o*) *Saccharin Corporation, Ltd.* v. *Quincey*, 17 R. P. C. at p. 339; *Same* v. *Anglo-Continental Coy.*, 17 R. P. C. at p. 318.

In these cases the patent was for a particular method of making toluene sulpho-chloride, which is an intermediate product in the manufacture of saccharin, and the infringement was the importation of saccharin manufactured from toluene sulpho-chloride so made. The latter case went to appeal and from certain remarks made by the Court during the argument they did not seem to wholly agree with the view taken in the Court below. The case was finally settled.

(*p*) *United Horsenail Machinery Coy.* v. *Stewart*, 2 R. P. C. 122.

Lord Kinnear in *Carlsburn* v. *Sharpe*, 1 R. P. C. at p. 186, appeared to assume that the importation of sugar cubes made on the patented machine in America would be an infringement of an English patent for the machine, but he found that there was in fact no infringement. From some remarks in his judgment he does not seem to have distinguished between a patent for a machine and a patent for a process. See also *Wright* v. *Hitchcock*, *supra*.

(*q*) See *Saccharin Corporation, Ltd.* v. *Anglo-Continental Coy.*, 17 R. P. C. at p. 319.

(*r*) *United Telephone Coy.* v. *Sharples*, 2 R. P. C. 28.

(*s*) *Goucher* v. *Clayton* (1865), 11 Jur. (N. S.) at p. 465; *Lyon* v. *Goddard*, 11 R. P. C. 113.

for trade or private purposes or even for amusement (*t*). Thus it includes use for exhibition (*u*) or as samples (*x*), or for the purpose of instructing pupils (*y*), and even merely acquiring with intent to use or sell (*z*) or keeping or transporting an article with a view to sale (*a*), or keeping a machine as a standby which may be used in case of necessity (*b*) is sufficient to constitute infringement. Mere transport or warehousing by a carrying or warehousing agent does not constitute infringement (*c*), and the same principle probably applies to a person who has the article merely for the purpose of repair (*d*). It has also been said that using an invention for a purpose which is not a manufacture (*e*) is not an infringement, but it seems doubtful how far this dictum would be followed. *Bonâ fide* experiment for the purpose of making improvements or the like does not constitute infringement (*f*). Probably a much less liberal view

(*t*) *United Telephone Coy.* v. *Sharples*, 2 R. P. C. 28. See, however, direction of PATTESON, J., in *Jones* v. *Pearce* (1832), W. P. C. at p. 125.

(*u*) *Dunlop Pneumatic Tyre Coy.* v. *British and Colonial Motor Car Coy.*, 18 R. P. C. 313.

It was here found as a fact that the tyres on the car exhibited were not intended to be sold with it, but nevertheless their exhibition was held to constitute infringement.

(*x*) See remarks in *Badische, &c.* v. *Chemische Fabrik, &c.*, 20 R. P. C. 413, C. A.; *Same* v. *Thomson*, 20 R. P. C. 422, C. A.: the point, however, was not decided.

In *Hudson Scott* v. *Barringer*, 23 R. P. C. at p. 87, it was held that the use of articles as samples was sufficient to constitute prior user. See also *Oxley* v. *Holden* (1860), 8 C. B. N. S. 666.

(*y*) *United Telephone* v. *Sharples*, *supra*.

(*z*) *Saccharin Corporation* v. *Lyle*, 21 R. P. C. 604; *Same* v. *Ross*, 22 R. P. C. 246; *British Motor Syndicate* v. *Taylor*, 17 R. P. C. 723, C. A. See also *Adair* v. *Young* (1879), 12 Ch. D. 13, C. A.; but there must be evidence of intent to use in such a way as to infringe, *British United Shoe Machinery Coy.* v. *Collier*, 27 R. P. C. 571, H. L., *semble*, the mere act of purchase may be presumptive evidence of such intention, *ibid.*, *per* Lord DUNEDIN, at p. 572.

(*a*) *United Telephone Coy.* v. *London and Globe Coy.*, 1 R. P. C. 117. See also *British Motor Syndicate* v. *Taylor*, *supra*; *Betts* v. *Neilson* (1868), 3 Ch. App. 429; but *cf. United Telephone Coy.* v. *Henry*, 2 R. P. C. 11, and cases in last note.

(*b*) *British United Shoe Machinery Coy.* v. *Collier*, 26 R. P. C. 534, C. A.

(*c*) *Nobel* v. *Jones* (1881), 8 A. C. 5 H. L.; but *cf. Washburn and Moen* v. *Cunard Steamship Coy.*, 6 R. P. C. 398; *Badische, &c.* v. *Johnson*, 14 R. P. C. 919, H. L.

(*d*) *United Telephone* v. *Henry*, *supra*.

(*e*) *Higgs* v. *Goodwin* (1858), 27 L. J. (Q. B.) 421.

Here the patent was for treating chemically the contents of sewers so that the same might be applied to agricultural and other useful purposes. It was held that the use of this process merely for the purpose of purifying sewage water, and not for obtaining manure, was not an infringement, since in the opinion of the Court such purification was not a manufacture, *sed. quaere*.

(*f*) *Per* JESSEL, M.R., in *Frearson* v. *Loe* (1878), 9 Ch. D. 48.

In this case, however, it was held that where the defendant had used a patented machine with a view to seeing how well it worked, and had made a small quantity of screws on it, he had committed an infringement.

So where a defendant after warning had used a variation of a patented article which came within the claim during the whole of a trip for fishing purposes, this was held to be more

would be taken of the permissible limits of experimental user where this is relied on as a defence to infringement than in the case of a prior user alleged to invalidate a patent (*g*).

Vending. Vending covers selling or exposing for sale (*h*), whether for home use or for export (*i*).

Many cases have arisen as to sales of goods manufactured abroad. In such cases it is necessary in order to establish infringement to show that some act has been committed within the realm, by the defendant or his agent, which is contrary to the prohibition of the patent (*k*).

It is also necessary to show that what was sold was itself an infringement of the patent. The sale of an article which is not patented does not become an infringement because the seller knows it is to be used for a prohibited purpose (*l*). It has however been decided in one case that where an ordinary article was sold with directions to use it in a way that would involve infringement, such sale amounted to infringement (*m*).

It is possible that the sale of a machine deliberately made

than experimental user and to be an infringement. *Scott* v. *Hull Steam Fishing Coy.*, 14 R. P. C. 143. See also *Saccharin Corporation* v. *Ross*, 22 R. P. C. 246.

(*g*) *Cf. Caldwell* v. *Van Vlissingen* (1851), 9 Hare. 415, and see p. 71.

(*h*) *British Motor Coy.*, v. *Taylor*, 17 R. P. C. 723, C. A.

Certain dicta in *Minter* v. *Williams* (1835), W. P. C. 135, which seem contrary to this were considered and explained in the above case. The earlier case really turned on a point of pleading. See also *Oxley* v. *Holden* (1860), 8 C. B. (N. S.) at p. 666.

(*i*) *British Motor* v. *Taylor*, 17 R. P. C. 723, C. A.; *Betts* v. *Neilson* (1868). 3 Ch. App. 429; *Lyon* v. *Goddard*, 11 R. P. C. 113; *United Telephone Coy.* v. *Sharples*, 2 R. P. C. 31; *Goucher* v. *Clayton* (1865), 11 Jur. (N. S.), at p. 465. See also *Oxley* v. *Holden* (1860), 8 C. B. (N. S.) 666.

(*k*) Thus a foreigner posting a patented article abroad to a customer here is not guilty of infringement, since the post office is the agent of the receiver. *Badische, &c.* v. *Johnson*, 14 R. P. C. 919, H. L.

Neither is it an infringement to enter into a contract in this country for the sale abroad of goods manufactured abroad, provided that they do not come into this country while in the vendor's possession. *Saccharin Corporation* v. *Reitmeyer*, 17 R. P. C. 606; *Badische, &c.* v. *Hickson*, 23 R. P. C. 433, H. L.

But if the goods are consigned here and then exported it is infringement. *Betts* v. *Neilson* (1868), 3 Ch. App. 429; *British Motor Syndicate* v. *Taylor, supra*; *United Telephone Coy.* v. *Sharples*, 2 R. P. C. 28.

(*l*) *Townsend* v. *Haworth* (1875), 48 L. J. (C.H) 770 *n.*; *Sykes* v. *Haworth* (1879), 48 L. J. (CH.) 769; *McCormick* v. *Gray* (1861), 31 L. J. (EX.) 42; *Dunlop Pneumatic Tyre Coy.* v. *Moseley*, 21 R. P. C. 274, 281, C. A.; *Allen* v. *Doulton*, 4 R. P. C. 382. See also *Savage* v. *Brindle*, 13 R. P. C. 266.

(*m*) *Innes* v. *Short*, 15 R. P. C. 449.

The decision seems hard to reconcile with the other authorities cited above. It was distinguished in *Dunlop Pneumatic Tyre Coy.* v. *Moseley*, 21 R. P. C. 60, and doubted in *Adhesive Dry Mounting Coy.* v. *Trapp*, 27 R. P. C. 355. See also *McCormick* v. *Gray, supra*.

In *Briggs* v. *Lardeur*, 1 R. P. C. 126, a decision to the same effect was given by PEARSON, J., on a motion for an *interim* injunction. The injunction was dissolved on terms by the C. A. (1 R. P. C. 102), but there is no further report of the case.

and put on the market in such a form that by a simple alteration it could be made into an infringing machine, would be held to be an infringement, but the point has never been decided (*n*).

So the sale of parts of a combination does not amount to infringement of a patent for the combination (*o*) unless perhaps all the parts are sold together in such a form that they can be easily made into the combination (*p*).

Articles made or sold by patentee.

Articles manufactured or sold by the patentee or his agents are in the absence of special stipulations licensed generally. Such licence gives the buyer the right to bring the articles into this country even if they were manufactured and sold abroad (*q*).

Repairs.

It has been held that the owner of a patented article is entitled to make *bonâ fide* repairs to prolong the life of the article, but such repairs must not amount to making a substantially new article (*r*). It has also been held that where one part of a combination is in the natural course of events liable to wear out quicker than the other parts, the owner is entitled to replace such part without being liable to an action for infringement of the combination (*s*). It would seem, too, that where there are claims for a separate integer, and also for the combination of this integer with old parts, the purchase from the patentee or his agent of the separate integer licenses its use in the combination (*t*).

Knowledge immaterial.

The question of whether an infringement has been committed is wholly independent of the knowledge of the defendant (*u*),

(*n*) See *Shoe Machinery Coy.* v. *Cutlan*, 13 R. P. C. at p. 147; *Gwynne* v. *Drysdale*, 3 R. P. C. 62; *Newall* v. *Elliott* (1864), 10 L. T. 792.

(*o*) *Dunlop Pneumatic Tyre Coy.* v. *Moseley*, 21 R. P. C. 274, C. A.

(*p*) See *United Telephone Coy.* v. *Dale* (1884), 25 Ch. D. 770; *Goucher* v. *Clayton* (1865), 11 Jur. (N. S.) 465; *Dunlop Pneumatic Tyre Coy.* v. *Moseley*, 21 R. P. C. 280, C. A.

(*q*) *Betts* v. *Wilmot* (1871), 6 Ch. App. 239.

As to the case where the seller is a licencee, under a foreign patent see *Société, &c., des Glaces* v. *Tilghman* (1883), 25 Ch. D. 1, C. A. See also

(*r*) *Dunlop Pneumatic Tyre Coy.* v. *Neal*, 16 R. P. C. 247; *Same* v. *Excelsior Tyre Coy.*, 18 R. P. C. 209; *Same* v. *The Holborn Tyre Coy.*, 18 R. P. C. 222.

In *Dunlop Pneumatic Tyre Coy.* v. *Moseley*, 21 R. P. C. at p. 282, C. A., COZENS-HARDY, L.J., expressed a doubt whether *Dunlop* v. *Neal* had not gone too far in favour of the Patentee.

(*s*) *Sirdar Rubber Coy.* v. *Wallington Weston & Coy.*, 22 R. P. C. 257. See also *Roberts* v. *Heywood* (1879), 27 W. R. 454.

(*t*) *Arnold* v. *Bradbury* (1871), 6 Ch. App. 706. See also *Oxley* v. *Holden* (1860), 8 C. B. (N. S.) 666.

(*u*) The fact that a man may while acting in perfect innocence yet be guilty of infringement seems clearly recognised by s. 33, as to which see p. 197. See also *Stead* v. *Anderson* (1847), 2 W. P. C. at p. 150. See also remarks of ERLE, C.J., in *Walton* v. *Lavater* (1860), 29 L. J. (C.P.) at p. 279, and of PARKE, B., in the H. L. in *Heath* v. *Unwin* (1844), 5 H. L. C. at p. 537.

or of whether or not he has acted with the deliberate intention of infringing (*x*).

Acts done at plaintiff's instigation.

Where the act complained of is an act of manufacture or user, and is done at the instigation of the plaintiff, this is generally not sufficient to constitute infringement as it is considered as having been done with his leave (*y*). But the fact that a sale is made to an agent of the plaintiff does not prevent its being an infringement, because the agent has no power to license such sale (*z*).

Agency.

Of course a principal may be liable for the infringement of his agent, and a person may also be liable for infringement if he has really had a hand in the manufacture or sale of the infringing article, though not actually committing these acts himself (*a*).

Acts which are not infringements.

The grant of licences to other persons to manufacture under a patent by a process which is an infringement of a previous

The L. C. in *Stevens* v. *Keating* disapproved of the idea that intention to infringe must be proved, as appears from the judgment of SHADWELL, V.C., in *Heath* v. *Unwin* (1844), 15 Sim. at p. 553.

The contrary view, expressed in the judgment of the Court of Exchequer in *Heath* v. *Unwin* (1844), 2 W. P. C. at p. 227, and by some other judges, *cf. Seed* v. *Higgins* (1858), 27 L. J. (Q. B.) 417, *Jones* v. *Pearce* (1832), W. P. C. at p. 125, has never been followed in modern times, and seems utterly opposed to all principles of English civil law.

(*x*) See *Stead* v. *Anderson*, *supra*, commenting on *Heath* v. *Unwin*, *supra*; but as to making a workman merely executing orders a defendant, see *Savage* v. *Brindle*, 13 R. P. C. 266.

(*y*) Where an agent of the plaintiff had, without disclosing his identity, ordered a ladder to be made in a certain way which was in fact an infringement of the patent, it was held that such manufacture did not constitute an infringement; *Kelly* v. *Batchelar*, 10 R. P. C. 289, but *cf. Dunlop Pneumatic Tyre Coy.* v. *Neal*, *infra*.

In a case where the alleged infringement was by user it was proved that the plaintiff had been present on the occasion of the user, and in fact had ridden the machine complained of himself, though he had stated that he would consult his solicitor on the subject. It was held that the acts were done with his leave; *Henser* v. *Hardie*, 11 R. P. C. at p. 437.

(*z*) In the majority of patent cases the evidence of infringement is a sale to the plaintiff's agent, and this has always been considered sufficient.

In *Dunlop Pneumatic Tyre Coy.* v. *Neal*, 16 R. P. C. 247, it was further held that where an agent of the plaintiff, who had no authority to license, took a tyre to the defendant to be repaired, and the repairs exceeded the limits which in the Court's opinion were permissible, this was sufficient evidence of infringement.

(*a*) Thus the Directors of a Company were held liable for the infringement by the servants of the company in the course of their duty, although such infringement was against their express orders. Apparently the company were also considered liable. *Betts* v. *De Vitrie* (1864), 3 Ch. App. 441.

So where a father had allowed his sons to carry on business in his name he was held responsible for their infringements; *Day* v. *Davies*, 22 R. P. C. 42. See also *Anderson* v. *Patent Oxonite Coy.*, 3 R. P. C. 279; *Incandescent Gas Light Coy.* v. *New Incandescent Mantle Coy.*, 15 R. P. C. 81; *Same* v. *Brogden*, 16 R. P. C. 179; *Sykes* v. *Howarth* (1879), 48 L. J. (CH.) 769; but *cf. Savage* v. *Brindle*, 13 R. P. C. 266.

patent does not in itself render such persons the agents of the licensor, or constitute infringement (*b*). Nor does merely lending a patented article amount to infringement (*c*).

Restrictive conditions.

Where a patented article is leased, licensed, or sold with the condition that it shall only be used in a certain way, user contrary to this condition constitutes infringement (*d*). It is, however, necessary to show that the condition was brought to the knowledge of the defendant before the sale was complete (*e*). The use of such restrictive conditions is much limited by the recent Act (*f*).

(*b*) *Montgomerie* v. *Paterson*, 11 R. P. C. at p. 237, and in I. H. at p. 633. In *Anderson* v. *Patent Oxonite Coy.*, 3 R. P. C. 279, CHITTY, J., held that a Company who had purported to grant a licence guilty of infringement, but on the ground that the licencee was really their agent.

(*c*) *United Telephone Coy.* v. *Henry*, 2 R. P. C. 11.

(*d*) *Incandescent Gas Light Coy.* v. *Cantelo*, 12 R. P. C. 262; *Same* v. *Brogden*, 16 R. P. C. 179. See also *Welsbach Incandescent Coy.* v. *Doule*, 16 R. P. C. 391; *Badische, &c.* v. *Isler*, 23 R. P. C. 633, C. A.

(*e*) *Incandescent Gas Light Coy.* v. *Cantelo*, *supra*.

(*f*) Sect. 38, see p. 248.

CHAPTER X

PRACTICE AND PROCEDURE

Parties

THE general rule is that the legal owner of the patent rights must be a party (*a*). If the plaintiff is an equitable owner, then the legal owner may be joined as defendant (*b*). The questions of part owners (*c*), licensees (*d*), and executors (*e*) suing have been dealt with elsewhere.

It would seem that a seller and a buyer can be joined as defendants in the same action (*f*), but a manufacturer has no right to be joined against the plaintiff's wish as defendant in an action against the purchaser from him (*g*).

Generally speaking, assignors and assignees of a business should not both be joined as defendants in the same action (*h*). In the case where a number of actions are brought on the same patent an order may be made with the consent of the parties that one action should be tried as a test action and the others abide

(*a*) *Bowden's Patent Syndicate* v. *Smith*, 21 R. P. C. 438. See also *Adams* v. *North British Rail. Coy.* (1873), 29 L. T. 367.

In *Actiengesellschaft für Cartonnägen Industrie* v. *Temler*, 16 R. P. C. 447, the plaintiff was granted an *interim* injunction, although his title was only equitable. A mortgagor may sue alone (*Van Gelder & Coy.* v. *Sowerby Coy.*, 7 R. P. C. 208, C. A.).

(*b*) This is frequently done, *cf. Spennymoor Foundry* v. *Catherall*, 26 R. P. C. 822, and cases at p. 240, *n.* (*o*).

(*c*) See p. 12, *n.* (*i*).

(*d*) See p. 7, *n.* (*f*).

(*e*) See p. 240, *n.* (*o*).

(*f*) See *Saccharin Corporation, Ltd.* v. *Lyle & Coy.*, 21 R. P. C. 604.

In a case where both makers and users were sued and only the makers entered a defence, CHITTY, J., refused leave for judgment on motion against the users; *Actiengesellschaft für Cartonnägen Industrie* v. *Remus*, 12 R. P. C. 94.

On this point *cf. Hocking* v. *Hocking*, 3 R. P. C. 291.

(*g*) *Moser* v. *Marsden*, 9 R. P. C. 214. See also *Laing's Sewing Machine* v. *Norrie* (1877), 4 S. V. 29 (I. H.), where it was held that owners of machine could not be joined as defendants, against the plaintiff's wish, with persons who had the machine on the premises and had been sued as users. But see *Washburn & Moen* v. *Cunard Steamship Coy.*, 6 R. P. C. 398, where consignees were held to be necessary and proper parties to be joined with a steamship company.

In *Vavasseur* v. *Krupp* (1878), 9 Ch. D. 351, C. A., the Mikado was joined as a defendant at his own request, and obtained an order permitting him to remove the infringing articles.

(*h*) See *Saccharin Corporation* v. *Lyle & Coy.*, 21 R. P. C. 604; *Brigge* v. *Lardeur*, 2 R. P. C. 13: here application was by defendants.

the result (*i*). Third party procedure applies where manufacturers have given an indemnity since action brought (*k*).

Service out of the Jurisdiction

In patent actions leave to effect service out of the jurisdiction is usually sought on the ground that an injunction is asked for (*l*). In such cases it cannot be granted if the patent, or one of the patents, sued on has expired (*m*).

Another ground which is sometimes raised is that the defendant sought to be served is a necessary and proper party to an action in which another defendant has been properly served within the jurisdiction (*n*).

In either case the Court requires to be satisfied by evidence that a *primâ facie* case of infringement has been made out, but will not decide doubtful points of law or fact adversely to the plaintiff at this stage, or on a motion to discharge the order (*o*).

In the case of defendants resident in Scotland or Ireland the Court requires evidence of acts that would give ground for an injunction in England or Wales, and also considers the balance of convenience (*p*).

Leave to serve notice of motion out of the jurisdiction is also given where leave so to serve the writ is granted (*q*).

Pleading (*qq*).

Statement of claim.

The plaintiff by his statement of claim alleges the grant of the Letters Patent and his title to the same (*r*), and also

(*i*) See *Foxwell* v. *Webster* (1863), 4 De J. & S. 77, where an agreement had been made that L a user should be bound by the result of the action against Y the manufacturer, and Y did not appear, ROMER, J., refused to hear counsel on behalf of L or to stay the judgment in the Y action to give L an opportunity of applying to have the agreement set aside; *Edison* v. *Young*, 11 R. P. C. 489.

(*k*) *Edison* v. *Holland*, 3 R. P. C. 394, see also *Edison* v. *Holland*, 6 R. P. C. 286, C. A., and *United Telephone Coy.* v. *Fleming*, 3 R. P. C. 268; as to when indemnities are enforceable, see *Townsend* v. *Haworth* (1875), 48 L. J. (CH.) 770*n*.

There is no implied warranty that an article sold is not an infringement of a patent. *Montforts* v. *Marsden*, 12 R. P. C. 266.

(*l*) O. 11, r. 1 (*f*).

(*m*) *Badische, &c.* v. *Chemische Fabrik, &c.*, 20 R. P. C. 413, C. A.

(*n*) O. 11, r. 1 (*f*). See *Badische, &c.* v. *Johnson*, 12 R. P. C. 535, C. A., *Washburn & Moen* v. *Cunard Steamship Coy.*, 6 R. P. C. 398.

As to contents of affidavits, see *Badische, &c.* v. *Chemische Fabrik, &c. supra*, and 21 R. P. C. 533, H. L.

(*o*) *Badische, &c.* v. *Johnson, supra*; *Same* v. *Chemische Fabrik, &c., supra.*

(*p*) See *Washburn & Moen* v. *Cunard Steamship Coy., supra.*

(*q*) *Washburn & Moen* v. *Cunard Steamship Coy., supra.*

(*qq*) See also forms in Appendix.

(*r*) As to what title the plaintiff must show, see p. 165.

The allegation that the patent was duly assigned means that all things

usually that the patent is valid (*s*). He then alleges infringement by the defendant of the patent or patents sued on.

In certain cases, where the plaintiff has claimed to have patented all practicable methods of manufacture of the substance alleged to be an infringement, he has been allowed to sue on several patents in the same action alleging infringement of each, though in fact some only could have been infringed (*t*).

Particulars of Breaches.

The plaintiff is required to deliver with his statement of claim particulars of breaches, which shall state which of the claims are alleged to be infringed, and shall give at least one instance of each type of infringement of which complaint is made (*u*). The particulars must be in such form that the instances which will be relied on at the trial are clearly set out, though general words may be added reserving the right to

necessary for perfecting the title, including registration if necessary, have been done. *Chollet* v. *Hoffman* (1857), 26 L. J. (Q. B.) 249.

This allegation may be simply traversed in the defence, as the particulars of objections refer to validity only, *ibid.*

(*s*) See p. 188.

(*t*) In *Saccharin Corporation Ltd.* v. *Quincey*, 17 R. P. C. 257, the plaintiff alleged infringement of twelve patents.

In *Saccharin Corporation Ltd.* v. *Dawson*, 19 R. P. C. 169, the plaintiff alleged infringement of five patents.

In *Saccharin Corporation Ltd.* v. *Wild*, 20 R. P. C. 243, C. A., the infringement of twenty-three patents was alleged, but an order was made by the C. A. confining the plaintiff to three patents. The former cases were discussed.

In *Saccharin Corporation Ltd.* v. *White*, 20 R. P. C. 454, C. A., the plaintiffs sued on twenty-three patents but were limited by the Court of Appeal to seven on special terms. The judgment in the former case was explained.

In *Saccharin Corporation Ltd.* v. *Jackson*, 20 R. P. C. 611, the plaintiffs sued on twenty-three patents. The defendants had not sought to limit the number.

In *Saccharin Corporation Ltd.* v. *Ross*, 22 R. P. C. 246, the plaintiffs sued on seven patents.

See also *Saccharin Corporation Ltd.* v. *Alliance Chemical Coy., Ltd.*, 22 R. P. C. 175, C. A., where plaintiffs were allowed to interrogate before electing which patents they would rely on.

(*u*) O. 53*a*, rr. 13, 16.

The Court will, however, not generally interfere where the plaintiff alleges infringement of several or all the claims, this being a question of costs. See *Wenham Coy.* v. *Champion Gas Lamp Coy.*, 8 R. P. C. 22.

Inspection may in a proper case be ordered before delivery of the statement of claim in order to allow the plaintiff to particularise the claims infringed. *Edler* v. *Victoria Press*, 27 R. P. C. 114.

The Court will not order particulars as to the portions of the specification which describe the alleged infringement. *Cheetham* v. *Oldham & Fogg*, 5 R. P. C. 624; *Egleton* v. *Nicholls*, 7 R. P. C. 423; *Walter Church Engineering Coy.* v. *Wilson*, 3 R. P. C. 123. See also *Electric Telegraph Coy.* v. *Nott* (1847), 16 L. J. (C. P.) 174; *Batley* v. *Kynoch* (1874), L. R. 19 Eq. 229. *Casella* v. *Levinstein*, 8 R. P. C. 472.

An unreported case to the contrary effect was quoted in *Batley* v. *Kynoch*, *supra*.

Nor will the Court order particulars for the purpose of showing how the plaintiff proposes to argue his case, if the infringing article is properly identified. *Talbot* v. *La Roche* (1854), 15 C. B. 310; *Wenham Coy.* v. *Champion Gas Coy.*, *supra*; but see note, *infra*. See also *Jones* v. *Lee*, 25 L. J. (EX.) 241, and *Saccharin Corporation* v. *Alliance Chemical Coy.*, 22 R. P. C. 175, C. A.

ultimately claim relief for any further infringements which may be brought to light on discovery (*x*).

The object of these particulars is to identify the acts complained of, and they should not throw on the defendant the task of construing the patent in order to find out what is meant (*y*), but, on the other hand, if the identification is complete the defendant cannot require the plaintiff to say how he will make out his case (*z*). Generally the plaintiff is not allowed to give evidence outside of his particulars, but the Court has a discretion to allow this (*a*). The Court has also of course the power to allow amendment (*b*).

It is usual to specify the dates of the acts complained of, though in some cases this is not insisted on till after discovery (*c*).

Defence.

The defendant by his defence usually raises the issue of non-infringement. The defence should make it clear whether what is denied is that the acts alleged in the particulars of breaches have been committed, or that the articles or processes therein mentioned come within the claims of the Letters Patent, or both.

The plea of leave or licence should be specifically raised if it is intended to rely on it, but it must be remembered that the onus of showing that the articles are not manufactured by the plaintiff or his agent lies on the plaintiff, so that if

(*x*) It is doubtful whether the form of order in *Talbot* v. *La Roche* (1854), 15 C. B. 310, and *Tilghman's Patent Sand Blast Coy.* v. *Wright & Butler*, 1 R. P. C. 103, would now be followed.

Where the action is on a patent which has been in part prolonged the plaintiff must make it clear whether he is suing on the original patent or the prolonged patent or on both. *Marconi* v. *Siemens*, 20 R. P. C. 147, C. A.

(*y*) See *Marsden* v. *Albrecht*, 27 R. P. C. 785, C. A. See also *Casella* v. *Levinstein*, *supra*; *Patent Type Foundry Coy.* v. *Richards* (1860), 2 L. T. 359, but *cf. Actiengesellschaft, &c.* v. *Levinstein*, 29 R. P. C. 677, C. A.

The decision in *Marsden* v. *Albrecht*, *supra*, would probably be held to overrule *Talbot* v. *La Roche*, *supra*.

In *Haslam* v. *Hall*, 5 R. P. C. 144, C. A., it was stated that it was for the defendant who applied for further particulars to show that these are really necessary. But see *Thermos Ltd.* v. *Isola Ltd.*, 27 R. P. C. 195, C. A.

Greater particularity as to the process alleged to be used will be required in the case where the defendant is a seller than when he is the manufacturer. *Mandelberg* v. *Morley*, 10 R. P. C. 250.

See also *United Telephone Coy.* v. *Fleming*, 3 R. P. C. 268, where the plaintiff limited his particulars so as to exclude certain articles bought by the defendants from third parties.

(*z*) *Wenham Coy.* v. *Champion Gas Coy.*, *supra*.

(*a*) O. 53*a*, r. 21, see also p. 177, *nn.* (*b*) *&c.*

The discretion to allow evidence outside the particulars without amendment is seldom exercised. As to admission of evidence showing intention to infringe, see p. 187, *n.* (*b*).

(*b*) For a case where this was exercised, see *Nobel* v. *Jones* (1880), 50 L. J. (CH.) 339.

(*c*) *Russel* v. *Hatfield*, 2 R. P. C. 144.

the licence relied on is the implied licence derived from a purchase from the plaintiff or his agent, this issue can be raised by a simple traverse (*d*).

The defendant may of course challenge the plaintiff's title (*e*), and the defence usually asserts that the patent is invalid by reason of the matters appearing in the particulars of objections (*f*). There are, however, certain pleas which are more properly raised in the defence itself. These include the allegations that the patented articles are wholly or mainly manufactured abroad (*g*), and that the requirements of the public have not been properly met (*h*). A plea based on the insertion of restrictive clauses in licences should also appear in the defence (*i*).

Particulars of objections.

As in the case of particulars of breaches, the function of the particulars of objections is to identify the issues to be raised, and the facts relied on, not to argue the defendant's case (*k*).

It cannot be said that the points raised by all the different forms of particulars of objection are clearly distinguished from one another, and there are cases in which it is difficult to say in which form an objection should be raised. Unfortunately little assistance can be gained from the older cases, when pleadings were stricter than at present, since the practice of the Courts as to what is covered by the various forms of objection has changed so widely that these decisions have little or no application.

Novelty.

Taking first the objections dealing with want of novelty, these are nearly always raised in the double form that the alleged invention for which the patent was granted was not new, nor was it subject-matter for Letters Patent. These two objections are often indistinguishable, since either is usually held to raise the question that in view of what was known before there was no invention in what is claimed by the patentee (*k*). The objection of want of subject-matter would,

(*d*) *Badische, &c.* v. *Dawson*, 6 R. P. C. 387; *Betts* v. *Wilmott* (1870), 6 Ch. App. 239.

(*e*) As the register is *primâ facie* proof of this, little is gained by a formal traverse of title.

(*f*) O. 53*a*, r. 14. It has been said that these particulars do not constitute individual issues. *R.* v. *Mill* (1851), 20 L. J. (C. P.) 16.

As to the position where only one of several defendants puts in particulars of objections, see *Cropper* v. *Smith*, 2 R. P. C. 17, H. L.

(*g*) See Chapter XVI., and as to particulars, p. 174.

(*h*) See p. 251.

(*i*) See p. 249, as to particulars required, see O. 53*a*, r. 10.

(*k*) See *Riekmann* v. *Thierry*, 14 R. P. C. 105, H. L., and remarks of

however, raise the further objection that the invention claimed was not a manufacture at all, *e.g.* in the case of a system of advertising, etc. (*l*).

It is sometimes suggested that want of subject-matter means that there is nothing new in view of common general knowledge, while want of novelty would mean that the invention has been anticipated by some individual suggestion or user. This distinction has not, however, been observed by the Courts.

General common knowledge.

The defendant is always entitled to plead generally that the alleged invention was not new or subject-matter for Letters Patent in view of the general common knowledge, without giving particulars of what that knowledge was or the evidence on which he will rely (*m*). It would seem doubtful if it is even necessary to plead general common knowledge if the objection of want of novelty is raised on other grounds, since both the patent itself and any anticipations relied on will be read in the light of such general common knowledge (*n*).

But though no particulars need be given of general common knowledge or practice, since this is matter presumably equally in the cognisance of all parties, the evidence allowed to be adduced under such objection is strictly confined to matters showing what was *generally* known or done, as, for example, references to text-books in general use or to the practice of a large portion of the trade, and it is not permissible to introduce references to, say, an isolated practice in one workshop. So, too, a specification or a scientific paper would not be admissible evidence under this objection (*o*).

Questions have arisen as to how far particulars are necessary when a practice which is general only in certain localities is pleaded, and the cases on this point are at variance. Probably, however, such practice may be pleaded without particulars

LINDLEY, L.J., and of Lord DAVEY in *Morris* v. *Young*, 12 R. P. C. 455, H. L.

(*l*) See p. 255 (*q*); and see *Bush* v. *Fox* (1856), 24 L. J. (EX.) 251, H. L.; *Spencer* v. *Jack* (1864), 3 De G., J. & S. 346; *Spilsbury* v. *Clough* (1842), W. P. C. 255.

(*m*) *Holliday* v. *Heppenstall*, 6 R. P. C. 320, C. A.; *Boxwell* v. *Cochrane*, 12 R. P. C. 169; *Siemens* v. *Karo*, 8 R. P. C. 377; *Z. Electric Lamp Coy.* v. *Marples*, 26 R. P. C. 762, C. A.

It is sufficient if the knowledge is shown to be common in the trade to which the invention relates. Where it is intended to rely on the common knowledge of other trades this should be stated. *Fox* v. *Astrachans Ltd.*, 27 R. P. C. 377.

(*n*) See *per* Lord DAVEY in *Morris* v. *Young*, 12 R. P. C. at p. 460, H. L.; but *cf. Philips* v. *Ivel Cycle Coy.*, 7 R. P. C. 82.

(*o*) See p. 57, *n.* (*k*); *Ticklepenny* v. *Army & Navy Stores*, 5 R. P. C. 405, and *Peckover* v. *Rowland*, 10 R. P. C. 118.

since it is part of general common knowledge, and the reference to locality only serves to define the particular subjects to be dealt with (*p*).

Individual publications.

Where the objection of want of novelty is to be supported by references to individual publications or users, these must be strictly defined. If the publication exists in a printed form, particulars of this must be stated, and where possible these particulars must show what parts of the publications are relied on (*q*). Particulars of the date and place of publication must also be given (*r*). In the case of an allegation of prior user even greater strictness is required (*s*). Not only must the place and time be stated, but also the names of the person or persons who are alleged to have made such prior user and whether such prior user continued down to the date of the patent, or if it did not a statement of the earliest and latest dates on which such prior user is alleged (*t*). Further, the

(*p*) A plea of anticipation by the "use of starch prepared from rice flour which was known and practised by persons engaged in the manufacture and finishing of lace and similar fabrics at Nottingham." *Held*, sufficient. *Jones* v. *Berger* (1843), W. P. C. 544.

So prior user "by candlemakers generally in the vicinity of London" held good. *Palmer* v. *Wagstaff* (1853), 22 L. T. 295. (But see *Palmer* v. *Cooper* (1853), 8 Ex. 840, 9 Ex. 231.)

The plea that certain facts were generally known to winders in Manchester, Rochdale, Middleton, and certain other (named) towns held good. *Boyd* v. *Horrocks*, 3 R. P. C. 285.

But user by "carriage builders generally throughout Great Britain or in or near London, Liverpool, or other great towns" held too vague. *Morgan* v. *Fuller* (1866), L. R. 2 Eq. 297.

"Use by A B and divers other persons within the Kingdom and elsewhere" held bad. *Fisher* v. *Dewick* (1838), W. P. C. 551 *n.*

Prior alleged user "*inter alia* at Sheffield, Birmingham, and London." Further and better particulars ordered. *Holland* v. *Fox* (1852), 1 W. R. 448.

Probably in these latter cases the particulars would be held sufficient if so drawn as to show that general and not individual practice was relied on.

(*q*) For cases in which an order has been made to identify passages relied on, see *Harris* v. *Rothwell*, 3 R. P. C. 243; *Fowler* v. *Gaul*, 3 R. P. C. 247; *Holliday* v. *Heppenstall*, *supra*; *Heathfield* v. *Greenway*, 11 R. P. C. 17.

But if the Court is of opinion that the defendant honestly relies on the whole of certain specifications they will not bind his hands further. *Sidebottom* v. *Fielding*, 8 R. P. C. 266; *Siemens* v. *Karo*, *supra*; *Nettlefold* v. *Reynolds*, 8 R. P. C. 410; *Edison Bell Phonograph Coy.* v. *Columbia Coy.* 18 R. P. C. 4.

(*r*) See *Aktiebolaget Separator* v. *Dairy Outfit Coy.*, 13 R. P. C. 725; *Holliday* v. *Heppenstall*, *supra*; *Heathfield* v. *Greenway*, *supra*.

(*s*) These requirements are contained in O. 53*a*, r. 18. This rule only applies to information which the defendant can in fact give, since the obligation is only to give the best particulars in the defendant's power. *Per* EADY, J., in *Minerals Separation, Ltd.* v. *Ore Concentration Coy., Ltd.*, 26 R. P. C. at p. 418. See also *Bentley* v. *Keighley* (1844), 13 L. J. (C. P.) 169.

(*t*) If the prior user was not continuous definite dates of user should also be given where possible. *Smith* v. *Lang*, 7 R. P. C. 148.

particular thing used must be identified by aid of a description, and a drawing if necessary, and in the case of any machinery or apparatus a statement must be made whether the same is in existence and whether it can be inspected (*u*). The defendant is also bound to offer inspection of such apparatus if in his possession, or if not he must use his best endeavours to obtain inspection of the same for the plaintiff (*v*).

True and first inventor.

Another plea by which want of novelty was formerly raised was by alleging that the patentee was not the true and first inventor. Although an objection in the same form is continually pleaded it generally raises no real issue, as unless particulars are given of the person who was the true and first inventor no evidence can be given by the defendant under this objection (*x*). It is, however, a proper form if the defendants wish to raise the case that the patentee had in fact obtained the invention from some other person (*y*).

Insufficiency and non-utility.

Two other objections which the practice of the Courts has rendered it difficult to clearly distinguish are those of non-utility and insufficiency of description. The objection of non-utility raises the issue that the invention as described will not work or will not do what it is said to do, and may also raise the further issue that no improvement has in fact been made (*z*).

(*u*) The object of these particulars is identification of what was done, and not the disclosure of the defendant's case, and the information to be given may depend on the terms of the patent. Thus, in the case of a patent which claimed the use of oil generally in a process, an order for particulars of the kind of oil used in an alleged prior user was refused. *Minerals Separation, Ltd.* v. *Ore Concentration Coy., Ltd.*, 26 R. P. C. 413. See also *Crosthwaite Fire Bar Syndicate* v. *Senior*, 26 R. P. C. 260; *Scott* v. *Hull Steam Fishing Coy.*, 13 R. P. C. 206; *Brown's Patent*, 23 R. P. C. 792; *Boyd* v. *Farrar*, 5 R. P. C. 133; *Siemens* v. *Karo*, *supra*; *Sidebottom* v. *Fielden*, *supra*.

"Apparatus" does not include such things as minerals operated on, and inspection of these need not be given. *Minerals Separation, Ltd.* v. *Ore Concentration* (1905), *Ltd.*, *supra*.

Where the actual apparatus can be seen and examined a description and drawing need not be given. *Crosthwaite Fire Bar Syndicate* v. *Senior*, *supra*.

(*v*) O. 53 (*a*), r. 18.

(*x*) See *Poulton* v. *Adjustable Cover Coy.*, 22 R. P. C. 593, where, although it was pleaded that S. was first and true inventor, a communication by him to a person other than the patentee was not admitted in evidence.

There were older decisions to the contrary, see *Russell* v. *Ledsam* (1843), 12 L. J. (EX.) 439, and cases there quoted, but these would not now be followed.

This form should not now be used merely to raise issue of novelty. *Hill* v. *Thomas*, 24 R. P. C. 424, C. A.; *Morgan* v. *Windover*, 7 R. P. C. 449; *Thomson* v. *Macdonald*, 8 R. P. C. 9; *Hickson* v. *Redfern*, 22 R. P. C. 307; *Pneumatic Tyre Coy.* v. *Casswell*, 13 R. P. C. 187; *Smith's Patent*, 29 R. P. C. 340.

(*y*) *Hill* v. *Thomas*, *supra*.

(*z*) See chapter on UTILITY, and especially p. 80.

MAULE, J., expressed the view that this plea also raised the point that the manufacture was one that would be suppressed as injurious. *Bedells* v. *Massey* (1844), 13 L. J. (C. P.) 173.

The objection of insufficiency of description raises the issue that necessary directions are left out. The distinction in this case is of special importance since particulars are not required under the objection of non-utility (*a*), while very strict particulars have to be given in the case of a plea of insufficiency of description (*b*).

A case may arise where the defendant has carried out the invention as described in the specification, but has been unable to obtain a successful result. It may well be that he has no knowledge of the reasons of failure, and it would seem an unreasonable burden to say that he must point out what are the directions which the patentee should have given (*c*).

It would seem doubtful whether in any case further particulars would be ordered of the objections that the specification does not sufficiently define the nature of the invention, or does not distinguish what is new from what is old (*d*).

Want of good faith.

The obligation of the patentee is not only to give sufficient directions to attain a successful result, but also to give the best directions in his power (*e*). The objection of want of good faith in giving directions has not been discussed in many

(*a*) This is the general rule of practice, but see *Presto Collar Coy.* v. *Levy Brothers*, 28 R. P. C. 362, C. A. It must be remembered that the defendant does not know what the plaintiff will allege to be the advantages of the invention, and should therefore be allowed to traverse them generally.

(*b*) For reported cases in which further particulars of insufficiency were ordered, see *Heathfield* v. *Greenway*, 11 R. P. C. 17; *Birch* v. *Harrap*, 12 R. P. C. 431; *Crompton* v. *Anglo-American Brush Coy.*, 4 R. P. C. 179.

But an objection that the specification gives no sufficient directions to enable a skilled workman to carry the invention into effect is sufficient. It is not the defendant's business to say what ought to have been inserted. *Z Electric Lamp Coy.* v. *Marples*, 20 R. P. C. 702, C. A. See also *Crompton* v. *Anglo-American Brush Coy.*, 4 R. P. C. 200, C. A.

So, too, where the objection is that the specification does not sufficiently define the invention no further particulars need be given. *British Ore Concentration Coy.* v. *Minerals Separation Coy.*, 24 R. P. C. 798. See also *Heath* v. *Unwin* (1842), 12 L. J. (EX.) 47.

Where, however, non-utility was pleaded, and there was also an objection setting out several passages of the specification where the directions were insufficient, the petitioners were not allowed to raise objections to other passages under the objection of non-utility. *Tieman's Patent*, 16 R. P. C. 567. See also *Thermit, Ltd.* v. *Weldite, Ltd.*, 24 R. P. C. 441.

(*c*) See on this point *Z Electric Lamp Coy* v. *Marples*, 20 R. P. C. 702, C. A.

In *Badische, &c.* v. *Société des Usines de Rhone*, 14 R. P. C. 875, where the defendants had pleaded non-utility, and at the trial it appeared that the invention worked with certain apparatus, but not with the apparatus employed by the defendants, though this was within the directions in the specification, WILLS, J., held defendants could not raise this point under the objection of non-utility. It is submitted that this decision was erroneous.

(*d*) *British Ore Concentration Coy.* v. *Minerals Separation Coy.*, 24 R. P. C. 790. But see *Boxwell* v. *Cochran*, 12 R. P. C. 170.

(*e*) See Chapter on SUFFICIENCY, p. 96.

modern cases, but it would appear to be covered by the ordinary objection of insufficiency (*f*).

Discon-formity.

In the case of disconformity clear particulars must be given of the respects in which the complete specification varies from the provisional (*g*). There is no decision as yet as to how the form of pleading is affected by the new provision that disconformity shall not affect the validity of the patent if the patentee was in fact the true and first inventor of the added portion, and such portion was new at the date of the complete specification (*h*). Strictly it would seem that the plaintiff should bring himself within the exception by pleading these facts in his reply, and the defendant should then rejoin if he disputes the novelty, but probably from considerations of convenience the objections to the novelty, etc., would be raised in the particulars of objections delivered with the defence.

Prior grant.

Where the defendant wishes to rely upon a prior grant, this must be distinctly stated (*i*), and of course particulars of the grant relied on must be given.

Other objections.

An objection that if the specification were so construed as to include the alleged infringement the patent would be bad as including what was old, is not embarrassing, but is unnecessary, since the same issues are raised by the plea of non-infringement and the objection of want of novelty (*k*).

Another objection is that the claim is larger than the invention (*l*).

Non-working.

Where the defence is raised that the patented articles are wholly or mainly made abroad, proper particulars must be given, in order to enable the plaintiff to see what is the case he has to meet and to limit discovery, so that the defendant may not have general discovery on a fishing case (*m*). Thus

(*f*) See *Plimpton* v. *Malcolmson* (1876), 3 Ch. D. 531; *Thomson* v. *Batty*, 6 R. P. C. 100.

(*g*) See *Anglo-American Brush Corporation* v. *Crompton*, 4 R. P. C. 27, C. A.; *Heathfield* v. *Greenway*, 11 R. P. C. 17; *Boyd* v. *Horrocks*, 3 R. P. C. 285.

(*h*) Sect. 42.

(*i*) *Rothwell* v. *Macintosh*, 12 R. P. C. 274; *Blackett* v. *Dickson*, 26 R. P. C. 730, O. H.; *Birmingham Pneumatic Tyre Coy.* v. *Reliance Tyre Coy.*, 17 R. P. C. 277.

(*k*) *Hocking* v. *Hocking*, 3 R. P. C. 291.

In *Bailey* v. *Roberton* (1877), 3 A. C. at p. 1081, the H. L. varied the judgment below so as to read "the complete specification if large enough to cover the use of bi-sulphite would claim an invention," etc. See also *Morris* v. *Young*, 12 R. P. C. 457, 464, H. L.

(*l*) *Flour Oxidising Coy.* v. *Hutchinson*, 26 R. P. C. 599.

Particulars were ordered of this plea in *Boxwell* v. *Cochran*, 12 R. P. C. 170. See also pp. 19, 20.

(*m*) *Thermos Ltd.* v. *Isola Ltd.*, 27 R. P. C. 195, C. A. overruling *Thermos Ltd.* v. *British Caloris Coy.*, 20

the defendant has been ordered to state whether the articles which he alleges were wholly or mainly manufactured abroad were the articles sold in this country, and where such articles are alleged to be manufactured and by whom (*n*), he has also been ordered to give particulars as to which of the patented processes he alleges was used in the manufacture of such articles (*o*).

Form of particulars.

Where the attack is on the scope of one or more claims these should be specified (*p*), and in other cases the parts of the specification objected to should be indicated where possible (*q*). But it is not the object of the particulars to show how the defendant proposes to make out his case (*r*), and it is advantageous to keep the objections in the simplest forms, *e.g.* the said invention was not new, was not useful, was not subject-matter, rather than to condescend to argumentative details such as "the principle was known" or "the invention only differs by the use of equivalents from." Such variations from common form often lead to orders for further particulars (*s*).

Particulars in other actions.

Similar particulars may be ordered in cases not coming within the rules, *e.g.* in threats actions (*t*) or actions for royalties (*u*).

Amendment of particulars of objection.

Amendments of the particulars of objections before the

R. P. C. 827. See also *Vidal Dyes Syndicate* v. *Read Holliday & Coy.*, 28 R. P. C. 323, C. A.

(*n*) *Thermos Ltd.* v. *Isola Ltd.*, *supra*; *Saccharin Corporation Ltd.* v. *National Saccharin Coy.*, 26 R. P. C. 737; 27 R. P. C. 354, C. A.; *Colman* v. *Cook & Coy.*, 29 R. P. C. 175, where particulars were also ordered as to the times when such manufacture commenced.

(*o*) *Saccharin Corporation Ltd.* v. *National Saccharin Coy.*, *supra.*

(*p*) O. 53*a*, r. 17.

(*q*) *E.g.* where insufficiency is alleged. This is the invariable modern practice, see *inter alia Boyd* v. *Horrocks*, *supra*; *Birmingham Pneumatic Tyre Coy.* v. *Reliance Tyre Coy.*, 17 R. P. C. 277; *Harris* v. *Rothwell*, 3 R. P. C. 253. See also *Birch* v. *Harrap*, 12 R. P. C. 431; *Law* v. *Ashworth*, 7 R. P. C. 86; *Fisher* v. *Dewick* (1838), 4 Bing. N. C. 706; but if the defendant wishes to rely on the objections against all the claims he is entitled to do so. *Edison Bell Phonograph Corporation* v. *Columbia Phonograph Coy.*, 18 R. P. C. 4.

This practice was to some extent departed from in *Boyd* v. *Farrar*, 5 R. P. C. 33.

(*r*) *Brown's Patent*, 23 R. P. C. 792, C. A.; *Heath* v. *Unwin* (1842), 12 L. J. (EX.) 47.

(*s*) See for example *Boyd* v. *Horrocks*, 3 R. P. C. 285; *Birch* v. *Harrap*, 12 R. P. C. 431; *Darrah* v. *Purser*, 6 R. P. C. 366.

(*t*) *Wren* v. *Weild* (1869), 38 L. J. (Q. B.) 327; but see THREATS, p. 228, *n.* (*u*), and *Nadel* v. *Martin*, 20 R. P. C., *per* COZENS-HARDY, L.J., at p. 733. See also *Smith* v. *Lange*, 7 R. P. C. 145.

(*u*) *Jones* v. *Lee* (1856), 25 L. J. (EX.) 241.

So in an action for specific performance where the real issue was as to the validity of a patent, particulars of objection were ordered, *Hazlehurst* v. *Rylands*, 9 R. P. C. 1.

trial is usually allowed on the terms that the plaintiff is given six weeks from the delivery of the amended particulars in which to elect whether he will discontinue the action or not, and in the event of discontinuance he pays the costs to the date of the delivery of the first particulars, but gets any costs incurred by him since such date (*x*). Where amendment is sought at the hearing the terms are more onerous (*y*). The Court of Appeal, though it has power to allow amendment of the particulars of objections, will generally not

(*x*) This order was first made in the case of *Baird* v. *Moules Patent Earth Closet* (1876), 17 Ch. D. 137 *n.*, and has been subsequently followed in many cases, including *Aveling* v. *Maclaren* (1880), 17 Ch. D. 139 *n.*; *Edison Telephone Coy.* v. *India Rubber Coy.* (1880), 17 Ch. D. 137; *Ehrlich* v *Ihlee*, 4 R. P. C. 115; *Darrah* v. *Purser*, 6 R. P. C. 365.

Where there is a second amendment before issue joined the date from which the costs are to be the plaintiff's is that of the delivery of the first amended particulars. *Wilson Brothers Ltd.* v. *Wilson & Coy.*, 16 R. P. C. 315; *aliter* if issue has been joined, *Ehrlich* v. *Ihlee*, *supra*.

The discretion of the judge as to the terms on which amendment is allowed will not be interfered with. *Wilson Brothers Ltd.*, v. *Wilson & Coy.* *supra*, approving *Wooley* v. *Broad*, 9 R. P. C. 208.

In *United Telephone Coy.* v. *Bassano*, 2 R. P. C. 70, leave to amend was given on simply paying the costs of the application.

A similar order was made in *Parker* v. *Maigen's Filter Coy.*, 5 R. P. C. 207, the plaintiff electing to continue after amendment. See also *Kelly* v. *Heathman*, 7 R. P. C. 343; *Otto* v. *Steel*, 2 R. P. C. 139.

The Courts discourage an amendment raising the question of validity for the first time on the eve of trial, see *Sugg* v. *Bray*, 1 R. P. C. 45, though leave is sometimes granted, see *United Telephone Coy.* v. *Bassano*, *supra*.

Leave to amend should always be given where the defendant has discovered facts which he could not have discovered earlier. *Per* JESSEL, M.R., in *Holste* v. *Roberston* (1877), 4 Ch. D. 9. See also *Moss* v. *Malins*, 3 R. P. C. 375.

(*y*) Where non-infringement only is pleaded the Court will not generally allow the issue of invalidity to be raised by amendment at the hearing, see *Shrewsbury & Talbot* v. *Sterckx*, 12 R. P. C. 336; *Sugg* v. *Bray*, *supra*; *Edison Electric Light Coy.* v. *Shippy*, 4 R. P. C. 472; but *cf.* *United Telephone Coy.* v. *Bassano*, *supra*.

For a case where the evidence was admitted practically without terms, see *Pascall* v. *Toope*, 7 R. P. C. 125. See also *Hills* v. *Adams*, 10 R. P. C. 104; *Lifeboat Coy.* v. *Chambers*, 8 R. P. C. 422.

In *Chadburn* v. *Mechan*, 12 R. P. C. 120, ROMER, J., offered to allow an amendment of the particulars attacking certain claims on new grounds on the terms that if the plaintiff elected to disclaim he should get the costs thrown away.

In *Solio* v. *Mackie*, 10 R. P. C. 68, leave to amend was given at the trial on the terms of *Edison Telephone Coy.* v. *Indiarubber Coy.*, *supra*.

In *Allen* v. *Horton*, 10 R. P. C. 412, the defendant amended at the trial and proved a complete anticipation. He also succeeded on the grounds in the particulars, but the action was dismissed without costs on the ground that if the new matter had been pleaded in the first instance the plaintiff would not have gone on with the action. See also *Renard* v. *Levinstenin* (1864), 11 L. T. 766 (leave given); *Peckover* v. *Rowlands*, 10 R. P. C. 118 (leave refused). *Otto* v. *Steel*, 13 R. P. C. 112 (leave given); *Badische, &c.* v. *Société des Usines du Rhone*, 14 R. P. C. 875 (leave given on special terms); *Moss* v. *Malins*, 3 R. P. C. 375 (leave refused); *Thermit, Ltd.* v. *Weldite, Ltd.*, 21 R. P. C. 455 (leave refused); *Edison* v. *Shippey*, *supra* (leave refused); *Crosthwaite* v. *Moorwood*, 11 R. P. C. 558 (leave given).

do so (*z*). Where an order for further and better particulars is made against the defendant, he cannot utilise this order for the purpose of adding new particulars (*a*).

Evidence outside particulars.

The rules say that no evidence shall be admitted, except by leave of the Court or a judge, going beyond the particulars of breaches or objections (*b*). Cases have, however, occurred where the plaintiff's own evidence disclosed a fatal objection to the patent and the action has been dismissed, although the point was not raised in the objections (*c*).

Counterclaim for revocation.

The defendant may now claim revocation by way of counterclaim if entitled to present a petition (*d*). It is doubtful whether he can claim a declaration of invalidity (*e*).

Reply.

The only case where a reply is in general necessary in a patent action is where the defendant relies on a prior grant, and the plaintiff then attacks the validity of such grant. In such case he must raise objections in the ordinary way (*f*).

Discovery

Discovery of documents.

The general practice in patent actions is to defer discovery relating to infringements, other than those specifically, mentioned in the particulars of breaches, till after the plaintiff has obtained judgment (*g*). If the defendant alleges that he is working under a secret process discovery before trial tending to disclose this process will probably be refused (*h*), but documents relating

(*z*) *Shoe Machinery Coy.* v. *Cutlan*, 12 R. P. C. 530, C. A.; *Andrews' Patent*, 24 R. P. C. 349, C. A.; 25 R. P. C. 490, H. L.; *Brown* v. *Hasties*, 22 R. P. C. 85, and 12 Sc. L. J. 131, I. H. But leave was given in *Pirrie* v. *York Street Flax Coy.*, 11 R. P. C. 431, C. A. (Ir.).

(*a*) *Aktiebolaget Separator* v. *Dairy Outfit Coy.*, 13 R. P. C. 725.

(*b*) O. 53*a*, r. 21.

As to the admission of evidence going beyond the particulars without amendment, see *Britain* v. *Hirsch*, 5 R. P. C. 226, C. A. It would seem that this should only be allowed where the evidence goes to show common knowledge, as in *Appleby* v. *Eadie*, 16 R. P. C. 335. See also *Pascall* v. *Toope*, 7 R. P. C. 125; *Scott* v. *Hull Steam Fishing Coy.*, 13 R. P. C. 209, C. A.; *Daw* v. *Eley* (1865), L. R. 1 Eq. 38; *Renard* v. *Levinstein* (1864), 11 L. T. 766.

The Court will not consider evidence against the validity of a patent not coming within the particulars (unless admitted by leave), even if it has been admitted on another issue. *British United Shoe Machinery* v. *Fussell*, 25 R. P. C., at p. 660, C. A.

In an old case where the only objection was that the invention was not new, and no particulars had been sought, it was held that the defendant could give specific instances of anticipation under this objection. *Hall* v. *Bolland* (1856), 25 L. J. (EX.) 302.

For cases of evidence being admitted as to matters not in the particulars of breaches, see *Dowling* v. *Billington*, 7 R. P. C. 191 (Ir.); but *cf. McClay* v. *Lawes*, 22 R. P. C. 199.

(*c*) *E.g. Germ Milling Coy.* v. *Robinson*, 3 R. P. C. 254, see last note.

(*d*) Sect. 32, and see REVOCATION, p. 211, *nn.* (*a*) & (*c*).

(*e*) See p. 217, *n.* (*a*) & p. 199, *n.* (*g*).

(*f*) See PRIOR GRANT, p. 76.

(*g*) See *Smith* v. *G. W. R. Coy.* (1854), 3 W. R. 69.

(*h*) *Rawes* v. *Chance*, 7 R. P. C. 275; *Carnegie* v. *Bell Brothers*, 24 R. P. C. 82, C. A.; but see *Ashworth* v. *Roberts*, 7 R. P. C. 451; *Benno Jaffé* v. *Richardson*, 10 R. P. C. 136.

to such process should be included in the affidavit and an objection made to produce them on the ground of the injury such production would cause (*i*).

Documents relating to former actions on the same patent, or to a petition to revoke the patent, are usually relevant and must be included in the affidavit, though, if they were brought into existence merely for the purpose of a communication to the solicitor in the former action, they may be privileged (*k*). There is no privilege attaching to communications to a patent agent unless these are privileged on other grounds, and where the solicitor to a party is also a patent agent he should state that the communications for which privilege is claimed were made to him as solicitor (*l*). Where documents in a defendant's possession relate merely to prior user they are part of his case and need not be disclosed (*m*). Where a party swears that certain documents are not relevant the affidavit cannot be attacked on the ground that their relevancy may depend upon the construction of the patent (*n*). Discovery will not generally be given before defence (*o*), and where the defendant wishes to allege prior user by the plaintiff himself he must do so generally and state that he cannot give further particulars until after discovery (*p*).

Interrogatories.

The object of interrogatories is to elicit facts or evidence, and the Courts will not permit interrogatories which would compel either party to swear to a construction of the patent (*q*).

Where utility is denied interrogatories are allowed as to whether in fact the patentee uses the patented machine or

(*i*) *Carnegie* v. *Bell Brothers*, *supra*.

(*k*) *Haslam* v. *Hall*, 5 R. P. C. 1; *Bown* v. *Sansom & Coy.*, 5 R. P. C. 510; *Thomson* v. *Hughes*, 7 R. P. C. 187. See also *Edison* v. *Holland*, 5 R. P. C. 213, C. A.

(*l*) *Moseley* v. *Victoria Rubber Coy.*, 3 R. P. C. 351.

(*m*) *Carnegie* v. *Bell Brothers*, *supra*.

(*n*) *Ibid.*

(*o*) *Woolfe* v. *Automatic Picture Gallery*, 19 R. P. C. 161, C. A.

(*p*) *Ibid.*

(*q*) *Bibby & Baron, Ltd.* v. *Duerden*, 27 R. P. C. 283, C. A. See also *Delta Metal Coy.* v. *Maxim*, 8 R. P. C. 169.

So a patentee cannot be asked if an alleged prior user was constructed as claimed in his patent (*ibid.*), or as to how he alleges that the defendant's articles infringe his patent. *Moseley* v. *Victoria Rubber Coy.*, 3 R. P. C. 351.

Nor is an interrogatory admissible as to what useful addition he has made to public knowledge. *Erhlich* v. *Ihlee*, 5 R. P. C. 437.

On the other hand, interrogatories as to whether certain parts of the patented machine were not mere equivalents for other devices have been allowed (*Hoffmann* v. *Pastill* (1869), 4 Ch. App. 673); and interrogatories as to the meaning of technical terms in the specification were allowed in *Renard* v. *Levinstein* (1864), 11 L. T. 81.

In this case too, questions were permitted as to the meaning of the specification: but *cf. Bibby & Baron Ltd.* v. *Duerden*, *supra*.

process, or what modifications he has introduced (*r*). The plaintiff may be interrogated as to whether a certain person was not the true inventor of the patented process (*s*).

In the case of a company the directors are only bound in answering interrogatories to give the knowledge they have acquired as servants of the company, and not knowledge otherwise acquired (*t*). It has been said that greater scope should be allowed to the defendant than to the plaintiff in the matter of interrogatories (*u*). Where non-manufacture in this country, or the insertion by the patentee of improper clauses in licences, is relied on by the defendant, discovery will be strictly limited so as to defeat a fishing case (*x*).

Interrogatories as to infringement.

Formerly, where infringement was not denied, the plaintiff was allowed to interrogate as to persons to whom defendant had sold (*y*), and a similar rule applied in the case of a licensee even where infringement was denied (*z*). These decisions would probably not now be followed.

Interrogatories as to definite sales will be allowed unless infringement is admitted (*a*). The defendant may be interrogated as to whether he uses what is described in the specification, but whether he can be asked how his process differs from the patented process is a matter of discretion. The Court, while protecting trade secrets, does not give the defendant an absolute right to say that the question of validity must be tried first, especially if there are doubts as to the genuineness of the grounds of objection to answer (*b*).

Where the defendant is a user and says he does not know how the article is made, he may be ordered to give the name of the manufacturer if the Court is satisfied that this will enable the plaintiff to prove infringement (*c*).

The plaintiff is not allowed to interrogate before delivering his particulars of breaches, but he might in a proper case be

(*r*) *Renard* v. *Levinstein*, *supra*; *Rylands* v. *Ashley*, 7 R. P. C. 175, C. A.; but see *contra Jourdain* v. *Palmer* (1866), 12 Jur. (N. S.) 214.

(*s*) *Hoffmann* v. *Pastill*, *supra*.

(*t*) *Welsbach Incandescent Coy.* v. *New Sunlight Coy.*, 17 R. P. C. 401.

(*u*) *Hoffmann* v. *Pastill* (1869), 4 Ch. App. 673.

(*x*) See O. 53*a*, r. 10; *Vidal Dyes Syndicate Ltd.* v. *Read, Holliday & Sons*, 28 R. P. C. 323, C. A., and p. 174.

(*y*) *Tetley* v. *Easton* (1856), 25 L. J. (C. P.) 293.

(*z*) *Ashworth* v. *Roberts*, 7 R. P. C. 451.

(*a*) *Lister* v. *Norton*, 2 R. P. C. 68.

(*b*) See *Ashworth* v. *Roberts*, *supra*; *Benno-Jaffé* v. *Richardson*, 10 R. P. C. 136; *Renard* v. *Levinstein* (1864), 10 L. T. 94; *cf.*, however, *Badische Anilin und Soda Fabrik* v. *Levinstein*, 2 R. P. C. 73.

(*c*) *Saccharin Corporation, Ltd.* v. *Haynes*, 15 R. P. C. 344.

allowed after such delivery to interrogate with a view to amending (*d*).

Interrogatories as to prior user.

In view of the new rules dealing with allegations of prior user, interrogatories as to this will probably be infrequent (*e*). Interrogatories have been allowed as to the names and addresses of prior users even where such use has been pleaded as general use (*f*). Generally a defendant cannot be compelled by interrogatories to give all details of a machine, since it is not fair that the plaintiff should know exactly what is to be produced against him before starting his case (*g*).

Inspection.

The Court has power to order inspection at the instance of either party (*h*). It will, however, protect parties against trade rivals using this process to discover trade secrets (*i*), and it is for the party seeking such inspection to show that it is really necessary for him to have it (*k*).

It is doubtful whether the Court can order machinery to be worked during inspection though such an order has been made (*l*), and in general no difficulty is raised on this point. It

(*d*) *Jones* v. *Platt* (1861), 7 Jur. (N. S.) 978; but see *Edler* v. *Victoria Coy.*, 27 R. P. C. 114.

(*e*) O. 53*a*, r. 18.

(*f*) *Alliance White Lead Coy.* v. *McIvor*, 8 R. P. C. 321.

Other cases where interrogatories to defendant as to prior user were allowed are: *Birch* v. *Mather* (1883), 22 Ch. D. 629; *Crossley* v. *Tomey* (1876), 2 Ch. D. 533; *General Electric Coy.* v. *Safety Lift Coy.*, 21 R. P. C. 109, where interrogatory as to present address of prior users allowed: see *contra*, *Flower* v. *Lloyd* (1876), 45 L. J. (CH.) 746, and 20 Sol. Jo. 860; explained in *Birch* v. *Mather*, *supra*, and as to limits of interrogatory, see *Daw* v. *Eley* (1865), 2 H. & M. 925.

(*g*) *Brown's Patent*, 24 R. P. C. 61, C. A. See also *Delta Metal Coy.* v. *Maxim*, 8 R. P. C. 169.

(*h*) Sect. 34.

(*i*) In *Swain* v. *Edlin*, 20 R. P. C. 435, the plaintiff, a trade rival, was not allowed to be present at the inspection.

In *Cheetham* v. *Oldham & Fogg*, 5 R. P. C. 617, 622, the plaintiff, though a trade rival, was allowed to attend.

See also *Colley* v. *Hart*, 7 R. P. C. at p. 104 (where a special order was made); *Germ Milling Coy.* v. *Robinson*, 1 R. P. C. 217; *McDougall* v. *Partington*, 7 R. P. C. 216, C. A.

(*k*) *Ames* v. *Kelsey* (1853), 22 L. J. (Q. B.) 84; *Shaw* v. *Bank of England* (1852), 22 L. J. (EX.) 26; *Piggott* v. *Anglo-American Coy.* (1868), 19 L. T. 46; where it was stated that the plaintiff must also show that his case is not a hopeless one; *McDougall* v. *Partington*, *supra*; *Batley* v. *Kynoch* (1874), L. R. 19 Eq. 90.

Mere suspicion by the plaintiff that an infringing machine is being used is not sufficient; *Germ Milling Coy.* v. *Robinson*, *supra*; *Cheetham* v. *Oldham & Fogg*, *supra*; *Patent Type Foundry* v. *Lloyd* (1860), 5 H. & N. 192; *Shaw* v. *Bank of England*, *supra*.

(*l*) An order to this effect was made by KAY, J., in *Germ Milling Coy.* v. *Robinson*, 3 R. P. C. 254; but in *Drake* v. *Muntz Metal Coy.*, 3 R. P. C. 44, BACON, V.C., held he had no power to make such an order.

In *Rylands* v. *Ashley*, 7 R. P. C. 175, STIRLING, J., seemed to doubt if he could order this. Here the machine belonged to third parties. See also *Sidebottom* v. *Fielden*, 8

is also doubtful if inspection can be ordered on the premises of third parties (*m*). Where the defendant raises a question of prior user, he is bound to give or procure inspection if possible (*n*).

There also seems a doubt as to whether the Court can order an affidavit verifying the machine inspected (*o*) or the giving of samples to be tested in a way that would cause their destruction (*p*).

The proper time for inspection is in the discretion of the Court. Thus the Court may defer inspection till a preliminary point has been tried (*q*).

Inspection may in a proper case be ordered before the delivery of the statement of claim in order that the plaintiff may give proper particulars of breaches (*r*). The Court has power to give inspection of exhibits in its possession even to parties in another action (*s*).

Interim Injunction.

On an application for an interim injunction the Court is unwilling to try any question of validity (*t*), and in recent years it has been very rare to grant such an injunction against the opposition of a defendant who denies validity, unless the plaintiff has already obtained a certificate of validity (*u*). But in proper cases the Court would probably still grant injunctions, where the old rule of the plaintiff being able to show considerable user over a long period without interference with his monopoly is satisfied (*x*). Where a certificate of validity has been obtained

R. P. C. 266, where BRISTOWE, V.C., refused the order on the ground that it was unnecessary.

(*m*) An order for inspection on the premises of licensees was made in *Germ Milling Coy.* v. *Robinson*, *supra*.

In *Rylands* v. *Ashley*, *supra*, the judge directed the plaintiff to apply to his licensees for permission which was given.

(*n*) O. 53*a*, r. 18.

(*o*) BRISTOWE, V.C., held that he had no power to order such an affidavit: *Drake* v. *Muntz Metal Coy.*, *supra*; but in *Singer* v. *Wilson* (1865), 13 W. R. 560, an order was made for the defendants to make an affidavit of all machines exposed for sale between certain dates and to produce one of each type to the plaintiff's agent.

(*p*) See *Patent Type Foundry* v. *Lloyd* (1860), 5 H. & N. 192.

(*q*) *McDougall* v. *Partington*, 7 R. P. C. 217, C. A.

(*r*) *Edler* v. *Victoria Coy.*, 27 R. P. C. 114.

(*s*) *Smith* v. *Lang*, 7 R. P. C. 150, C. A.

(*t*) See cases in *n.* (*x*), *infra*.

(*u*) *Spencer* v. *Holt*, 20 R. P. C. 142; *Bovill* v. *Goodier* (1866), 35 Beav. 427; *Holophane Ltd.* v. *Berend*, 15 R. P. C. 18.

(*x*) See on the general principle: *Caldwell* v. *Van Vlissingen* (1851), 9 Hare, 415, 424; *Spencer* v. *Holt*, *supra*; *Newall* v. *Wilson* (1852), 2 De G. M. & G. 282; *Clarke* v. *Ferguson* (1859), 5 Jur. N. S. 1155; *British Tanning Coy.* v. *Groth*, 7 R. P. C. 1.

The fact that there is now a Patent Office search does not entitle the patentee to an interim injunction. *Zenith Motors Ltd.* v. *Collier*, 28 R. P. C. 563.

the Court will in general grant an interim injunction unless it is convinced that there is substantial fresh evidence on the question of validity (*z*), or unless the Court which tried the original action has granted a stay of the injunction pending appeal (*a*). The plaintiff must, of course, file evidence as to the novelty of the invention (*b*), and the Court also requires that the plaintiff should make out at least a *primâ facie* case of infringement (*c*). Such an injunction will only be granted

The following are some cases in which an interim injunction has been granted, before the validity of the patent had been established, with period of enjoyment: *Bickford* v. *Skewes* (1837), W. P. C. 211, six years; *Stevens* v. *Keating* (1847), 2 W. P. C. 175, twelve years; *Muntz* v. *Foster* (1834), 2 W. P. C. 93, eleven years; *Shillito* v. *Larmuth*, 2 R. P. C. 1, ten years; *Read* v. *Andrew*, 2 R. P. C. 110, thirteen years; *Gardner* v. *Broadbent* (1856), 2 Jur. (N. S.) 1041, one year (a very doubtful case); *Wheatstone* v. *Wild* (1861), Griffin, 247; *Rothwell* v. *King*, 3 R. P. C. 279, six years; *Bracher* v. *Bracher, Dean & Coy.*, 7 R. P. C. 420, twelve years; *Natural Colour Kinematograph Coy.* v. *Speer*, 29 R. P. C. 669, four years. See also *Briggs* v. *Lardeur*, 1 R. P. C. 126, 192, C. A., and notes to *Electric Telegraph Coy.* v. *Nottingham* (1847), 2 C. & C. 41, for further list of cases.

In *Shillito* v. *Larmuth*, *supra*, and *Briggs* v. *Lardeur*, *supra*, it was said that an injunction would be granted on an old and largely used patent unless on the face of it it was hopelessly bad.

The following are some cases in which interim injunctions have been refused on the ground that the patent was too new or user insufficient: *Jackson* v. *Needle*, 1 R. P. C. 174, C. A., seven months; *Holophane Coy.* v. *Berend*, 15 R. P. C. 18, five years; *Zenith Motors Ltd.* v. *Collier*, 28 R. P. C. 63, four years; *Hill* v. *Thompson* (1817), W. P. C. 229, two years; *Trautner* v. *Patmore*, 29 R. P. C. 63, one year.

An injunction was refused even where the patent was twelve years old, and there had been large user in view of a substantial case as to invalidity. *Saccharin Corporation* v. *Chemical & Drugs Coy.*, 15 R. P. C. 53.

In *Lister* v. *Norton*, 1 R. P. C. 114, CHITTY, J., expressed the view that three years' user was too little for an interim injunction.

The user to be shown must be substantial public user. *Plimpton* v. *Malcolmson* (1875), L. R. 20 Eq. 37.

The user must also have been undisturbed. See *Collard* v. *Allison* (1839), 4 My. & C. 487.

But where the only disturbance had been by persons who ceased using, apparently at the plaintiff's request, the user was considered undisturbed. *Rothwell* v. *King*, 3 R. P. C. 370.

Where the defendant has not appeared, an interim injunction will be granted even in the case of a recent patent. *Pneumatic Tyre Coy.* v. *Ferguson*, 11 R. P. C. 459; *Clark* v. *Nicholls*, 12 R. P. C. 350.

In *Coles* v. *Bayliss*, 3 R. P. C. 178, an injunction was granted where the judge doubted whether what was alleged by the defendant was in law an objection, *cf. Pessers* v. *Moody*, 26 R. P. C. 68.

(*z*) See *Edison* v. *Bernstein*, 14 R. P. C. 33; *Welsbach Incandescent Coy.* v. *Vulcan Coy.*, 18 R. P. C. 279.

(*a*) The mere fact of an appeal being pending will not necessarily prevent the Court from acting. *Moser* v. *Sewell*, 10 R. P. C. 365.

In *Collard* v. *Allison* (1839), 4 My. & C. 487, an interim injunction was refused where the plaintiff had succeeded at law, but a rule *nisi* for a new trial had been granted.

(*b*) This evidence should show belief in the novelty at the date of the affidavit, since matters affecting the question of novelty may have come to the plaintiff's notice since the date of the patent. *Hill* v. *Thompson* (1817), W. P. C. 229; *Sturz* v. *De La Rue* (1822), 5 Russ. 322.

(*c*) BRISTOWE, V.C., in *Shillito* v. *Larmuth*, 2 R. P. C. 1, thought a *primâ facie* case of infringement sufficient. This view was also expressed by the majority of the Court in *Plimpton* v. *Spiller* (1876), 4 Ch. D. 286, C. A.

where the Court thinks that it is really necessary for the plaintiff's protection (*d*), and in order to entitle himself to an interim injunction the plaintiff must act promptly, any long delay being fatal (*e*). In a case which is on the border line the Court will sometimes take into account the balance of convenience and the probability of the defendant being able to

But in *Electric Telegraph Coy.* v. *Nottingham* (1847), 2 Ch. C. 41; and *Wood* v. *Cockerel* (1819), 2 Cooper & Cott. 58, Lord COTTENHAM expressed the view that unless there was no doubt, infringement as well as validity should have been established at law.

As to the sufficiency of an affidavit merely speaking of information, see *Badische, &c.* v. *Thompson*, 19 R. P. C. 503.

As to necessary evidence generally, see *Société Anonyme des Manufactures de Glace* v. *Tilghmann* (1883), 25 Ch. D. 1, C. A.

(*d*) Thus where the plaintiff had succeeded in another action and the defendant had offered an undertaking not to infringe until the trial, the motion was dismissed with costs. *Lyon* v. *Mayor, &c., of Newcastle*, 11 R. P. C. 218.

Again, where a satisfactory undertaking had been offered between the writ and the notice of motion the judge refused to give the plaintiffs the reserved costs of the motion. *Perry* v. *La Société des Luneliers*, 13 R. P. C. 664. See also *Dunlop Pneumatic Tyre Coy.* v. *Stone*, 14 R. P. C. 263; *Spaul* v. *Monopole Coy.*, 23 R. P. C. 647.

(*e*) The following are some cases where interim relief was refused on ground of laches, with period of delay: *Aluminium Coy.* v. *Domiere*, 15 R. P. C., one year; *Bovill* v. *Crate* (1865), L. R. 1 Eq. 388, seven months; *Bridson* v. *Benecke* (1849), 12 Beav. 1, eleven months; *Aktiengesellschaft für Cartonnägen Industrie* v. *Temler*, 16 R. P. C. 447, four months; *Leonhardt* v. *Kallé*, 11 R. P. C. 534, ten months; *Gillette Safety Razor Coy.* v. *Gamage*, 24 R. P. C. 1; *Edison* v. *Hough*, 11 R. P. C. 594.

In most of these cases the defendant undertook to keep an account. Sometimes special terms as to early trial are imposed as in *Leonhardt* v. *Kallé*, *supra*. See also p. 185, *n.* (*c*).

It is probable that laches may be counted against the owners of a patent irrespective of a change of ownership. In *Gillete Safety Razor Coy.* v. *Gamage*, *supra*, the plaintiffs were only equitable owners until just before the motion, but the judge held that they could have completed their title sooner had they wished to.

A plaintiff, however, is not generally bound to move until actual infringement occurs. *United Telephone Coy.* v. *Equitable Telephone Association*, 5 R. P. C. 233.

But if he has allowed the defendant to erect special works he may be prevented from getting interim relief, see *Neilson* v. *Thompson* (1841), W. P. C. 275; *Neilson* v. *Fothergill* (1841), W. P. C. 287, where, however, special orders as to payments of sums into Court by way of royalty were made.

Nor is laches in prosecuting other infringers a reason for refusing an interim injunction. *Pneumatic Tyre Coy.* v. *Warrilow*, 13 R. P. C. 284.

The plaintiff's actual knowledge of the infringement must be shown, thus a mere statement that the plaintiff must have known of the infringement because the defendants had taken out a patent was held sufficient. *Osmond* v. *Hirst*, 2 R. P. C. 265.

The proper course for a plaintiff, who has not established his patent, when he knows of a number of infringers is to write to each asking if they will allow the first case to determine theirs, and if not to issue writs. The fact that the delay was due to the plaintiff proceeding in another action is no answer to the objection of laches. *Bovill* v. *Crate* (1865), L. R. 5 Eq. 388; followed in *North British Rubber Coy.* v. *Gormully & Jeffreys*, 12 R. P. C. 17; see also *Actiengesellschaft für Cartonnägen Industrie* v. *Temler*, 16 R. P. C. 447.

For an *ex parte* injunction (which in any case is rarely given) the plaintiff should come if possible the very day he hears of the infringement. *Greer* v. *Bristol Tanning Coy.*, 2 R. P. C. 268. Such an injunction was granted in *Moser* v. *Jones*, 10 R. P. C. 368.

pay damages (*f*), and the position or conduct of the parties may also influence the Court (*g*). In all cases where an interim injunction is granted the plaintiff must give an undertaking as to any damages that the defendant may suffer by reason of such injunction, should it be held that there was no ground for granting it (*h*). The course which is almost invariably followed in modern practice in a case where there is any substantial

(*f*) See *Bracher* v. *Bracher, Dean & Coy.*, 7 R. P. C. 420; *Thomson* v. *Hughes*, 7 R. P. C. 71; *Newall* v. *Wilson* (1852), 2 De G. M. & G. 282; but possible inconvenience will not prevent the Court acting when the patent is well established. *Davenport* v. *Jepson* (1862), 4 De G. J. & F. 440,

(*g*) *E.g.* where a defendant had tendered on a contract, it being part of the conditions that the goods supplied were to be "special seat blocks of Messrs. P.'s pattern" in an action by Messrs. P. for infringement and passing off an interim injunction was granted under both heads, although the patent was not established. *Poulton* v. *Kelly*, 21 R. P. C. 392. See also *Spencer* v. *Holt*, 20 R. P. C. 142.

The fact that the defendant has been in negotiation to acquire rights under the patent, and has only set up invalidity at the last moment, influences the Court. *Clark* v. *Ferguson* (1859), 5 Jur. (N. S.) 1155.

So also does the fact that the defendant has acted as plaintiff's adviser. *Wheatstone* v. *Wild* (1861), Griff. 247.

Where the defendants had formerly been partners of the plaintiff for working the patent, the partnership articles being apparently founded on its presumed validity, and such partnership had brought an action against a third party, an injunction was granted. *Muntz* v. *Grenfell* (1842), 2 W. P. C. 91.

Where the plaintiff had succeeded in an action against P. who had been indemnified by D., and also against D., an injunction was granted against a company of which D. was the manager, and which had apparently been formed for the purpose of infringing. *Farbenfabriken, &c.* v *Dawson*, 8 R. P. C. 397.

So where the plaintiff had succeeded against the defendant in Scotland (*Dudgeon* v. *Thomson* (1874), 22 W. R. 464), or before an arbitrator (*Lister* v. *Eastwood* (1856), 26 L. T. (O. S.) 4), an injunction was granted.

The fact that the defendant has a guarantee that the articles have not been made by an infringing process is not sufficient to prevent the Court acting. *Saccharin Corporation Ltd.* v. *National Saccharin Coy.*, 26 R. P. C. 657.

But merely evasive conduct by the defendants in the proceedings is not in itself a ground for granting an interim injunction. *Renard* v. *Levinstein* (1864), 10 L. T. 177.

Nor *semble*, that he has applied for a licence. *Zenith Motors Ltd.* v. *Collier*, 28 R. P. C. 563. See also *Heine* v. *Norden*, 21 R. P. C. 573; *Crosthwaite* v. *Steel*, 5 R. P. C. 220.

On the other hand where the plaintiffs had successfully resisted discovery as to an alleged prior user by their predecessors in title, which necessitated a commission abroad to take evidence, interim injunctions were refused in other actions. *Welsbach Incandescent Coy.* v. *General Incandescent Coy.*, 18 R. P. C. 533, C. A.

Again where it was proved that the plaintiff, who was an assignee, had himself infringed the patent before he acquired it, the injunction was dissolved. *Curtis* v. *Coutts* (1839), 8 L. J. (CH.) 184; and where plaintiff had obtained an injunction in another case by an agreement to pay the defendant's costs, and then advertised, interim relief was refused. *Roberts* v. *Graydon*, 20 R. P. C. 578; see *contra Betts* v. *Menzies* (1857), 3 Jur. (N. S.) 357.

(*h*) This applies also where the defendant gives an undertaking.

Where the plaintiff was only the agent of the real inventor, and gave his address at an hotel was required to get the security of a householder. *Moser* v. *Sewell*, 10 R. P. C. 365, C. A.; but *cf. Plimpton* v. *Spiller*, 4 Ch. D. 286, C. A.

For a case of an inquiry as to such

dispute, is that the defendant undertakes to keep an account of the articles sold so as to enable damages to be easily assessed or an account of profits properly obtained (*i*), but the plaintiff has no right to insist on such terms where he has no proper case for an injunction (*j*).

The general rule as to costs is that if the injunction is granted, the costs are made costs in the action (*k*), if it is refused on the ground that there is a substantial question to be tried the practice varies (*l*). If, however, the injunction is refused on grounds such as laches which do not depend on a final determination of the rights of the parties the costs may be given to the defendants (*m*). In some cases the costs are reserved until the trial or further order (*n*).

Trial.

Mode of trial.

A patent case will not be sent to a jury in the absence of special direction (*o*). The judge may, if he thinks fit, and shall on the application of either party, try the case either wholly or partially with an assessor (*p*). The Court may also call in an independent expert to report on certain points or to make certain experiments (*q*). The Court may in a proper case

damages being ordered, see *Rothwell* v. *King*, 4 R. P. C. 76. Other terms, such as an undertaking to supply the defendant, may also be imposed. See *United Telephone Coy.* v. *Tasker*, 5 R. P. C. 628.

(*i*) Sometimes, too, terms as to payment into Court may be imposed. See *Pneumatic Tyre Coy., Ltd.* v. *Goodman*, 13 R. P. C. at p. 724; *Neilson's Patent* (1841), W. P. C. 273, 286; *Edison* v. *Hough*, 11 R. P. C. 594; *North British Rubber Coy.* v. *Gormully & Jeffreys*, 12 R. P. C. 21. See also *Briggs* v. *Lardeur*, 1 R. P. C. 192, C. A.; *Spencer* v. *Holt*, 20 R. P. C. 142.

(*j*) *British Tanning Coy.* v. *Groth*, 7 R. P. C. 1. But see *Pneumatic Tyre Coy.* v. *Friswell*, 13 R. P. C. 15.

(*k*) In one case an interim injunction has been granted with costs. *Hayward* v. *Pavement Lighting Coy.*, 1 R. P. C. 207; but this decision is hardly likely to be followed.

(*l*) See O. 65, r. 23 notes.

(*m*) This, however, is not the invariable course, see *inter alia*, *Aluminium Coy.* v. *Domiere*, 15 R. P. C. 32; *Actiengesellschaft fur Cartonnägen Industrie* v. *Temler*, 16 R. P. C. 447; *Leonhardt* v. *Kallé*, 11 R. P. C. 534; *Thomson* v. *Bully*, 6 R. P. C. 84.

(*n*) See *Lister* v. *Norton*, 1 R. P. C. 114.

(*o*) Sect. 31 (1).

Occasionally even in recent times patent cases have been tried on circuit with a jury.

(*p*) Sect. 31. In spite of these provisions the inconvenience of trial with an assessor has rendered the course very rare, except with regard to special points in a case. For the procedure when an assessor sits, see *Hattersley* v. *Hodgson*, 22 R. P. C. 229; *Mackie* v. *Berry*, 2 R. P. C. 146. No case is reported where the C. A. have sat with an assessor, though they have ordered experiments by an independent expert. *Moore* v. *Bennet*, 1 R. P. C. 129, C. A.

(*q*) See *Badische, &c.* v. *Levinstein*, 2 R. P. C. 73; *Moore* v. *Bennet*, *supra*. This may be done after the case on both sides has been closed. *North British Rubber Coy.* v. *Macintosh*, 11 R. P. C. 477. As to costs, see *ibid.* The C. A. may make such a reference. *British Motor Syndicate* v. *Andrews*, 16 R. P. C. 591, 595. If a party desires additional questions to be put to a witness this should be done at the

order a preliminary point to be tried first (*r*). The practice varies as to adjourning a case where another case or petition involving the same point is to be tried elsewhere, or an appeal in another case is pending (*s*).

The patentee has the right to begin in all cases on an infringement action or petition (*t*), and generally the right of reply as well (*u*). In certain cases the Court will vary the order of the evidence, *e.g.* will take the defendant's evidence as to his process before the plaintiff's case is closed (*x*).

It is entirely in the discretion of the Court whether they will determine a question between the parties not actually necessary for deciding the action before them (*y*).

Secret process.

If the defendant claims to be working under a secret process the question of infringement may be postponed till the validity of the patent has been established, and the evidence on this point may be taken *in camera* (*z*).

Onus.

The onus is, of course, on the plaintiff so far as the proof

trial; it is too late on appeal. *Badische, &c.* v. *Levinstein*, 4 R. P. C. 460, H. L. See also *Mellin* v. *Monico* (1877), 3 C. P. D. 158.

(*r*) *Woolfe* v. *Automatic Picture Gallery*, 10 R. P. C. 425. In *United Telephone Coy.* v. *Mottishead*, 3 R. P. C. 213, KAY, J., refused to order issue of infringement to be tried first unless validity was admitted. See also *Hutchinson* v. *Pattulo*, 5 R. P. C. 356, I. H.

(*s*) Where the defendant in an infringement action had succeeded on a *scire facias*, but a rule *nisi* had been granted for a new trial, the trial of the action was, on the application of the patentee, ordered to stand over till after the argument on the rule. *Smith* v. *Upton* (1843), 6 M. & G. 251. But where neither action nor *scire facias* had been tried the Court refused to postpone trial of action. *Muntz* v. *Foster* (1842), 7 Sc. N. R. 898. Where the defendants who were users applied at the trial for case to stand over and abide the result of the action against the manufacturers in London, it was held that the application was too late. *Welsbach* v. *M'Grady*, 18 R. P. C. 513 (Ir.). See also *Dunlop Pneumatic Tyre Coy.* v. *Rimington*, 17 R. P. C. 665, C. A.

(*t*) As to threats action, see p. 228, *n.* (*y*).

(*u*) In a case where infringement was admitted and the only real issue was a prior user, ROMER, J., gave the defendants the right to reply on this, reserving a further general right of reply to the plaintiffs if necessary. *Pneumatic Tyre Coy.* v. *Marwood & Cross*, 14 R. P. C. 240.

(*x*) See *Monnet* v. *Beck*, 14 R. P. C. 777.

(*y*) In *Dudgeon* v. *Thomson* (1877), 3 A. C. 34, the Lords, although of opinion that the action was wrong in form, heard arguments on and decided the point of substance between the parties. See also *Nordenfeldt* v. *Gardner*, 1 R. P. C. 61, C. A.

In *Parkinson* v. *Simon*, 12 R. P. C. 403, H. L., the Lords holding one claim bad refused to decide whether another claim had been infringed, and expressed disapproval of the course taken by the other Courts who had done this.

In *Tubeless Pneumatic Tyre Coy.* v. *Trench Tyre Coy.*, 16 R. P. C. 291, BYRNE, J., refused, after consideration, to decide the issue of infringement where he had held the patent bad.

(*z*) *Badische, &c.* v. *Levinstein*, 2 R. P. C. 73.

For form of order preventing disclosure of evidence, see *ibid.*, at p. 93.

As to proper time for making objection, see *Edison* v. *Woodhouse*, 3 R. P. C. 172.

of his title (*a*) and the proof of infringement (*b*) is concerned.

(*a*) The register or a properly certified extract is *primâ facie* evidence of matters which ought to be entered therein, s. 28 (3), s. 78, and s. 79. See *Jandus Arc Lamp Coy.* v. *Johnson*, 17 R. P. C. 361.

(*b*) This involves proof of the acts complained of (see *Nobel* v. *Jones* (1881), 17 Ch. D. 721, C. A.), proof that the article alleged to be an infringement was not made by the patentee or a licensee (*Betts* v. *Willmott* (1870), 6 Ch. App. 237), and evidence to explain any technical terms in the specification relevant to the question of infringement. In *Farbenfabriken, &c.* v. *Bowker*, 8 R. P. C. 389, the plaintiff was allowed to give evidence on this issue after the close of his case. Rebutting evidence is sometimes allowed on this issue. *Adair* v. *Young* (1879), 40 L. T. 41. The onus may shift in the course of the trial. *Z Electric Lamp Coy.* v. *Marples*, 27 R. P. C. 312, 320.

When the patent is for a process the plaintiff has of course to offer some evidence than the article complained of as an infringement has been made by this process, the mere production of the article being insufficient. *Palmer* v. *Wagstaff* (1854), 23 L. J. (EX.) 217; *Cartsburn* v. *Sharp*, 1 R. P. C. 181.

This evidence may of course be derived from the actual witnesses of the manufacture, or may be to the effect that no other process would produce the article.

The following are some examples of the evidence which has been considered sufficient:—

In the case of a patent for a new method of making rope, the production of rope made by the defendants together with the evidence of experts that they knew of no other method than that patented by which it could have been made, and proof of secrecy of manufacture, was held sufficient. *Huddardt* v. *Grimshaw* (1803), W. P. C. 85. See also *Hall's Patent* (1817), W. P. C. 97; *Thermal Syndicate* v. *Silicaware*, 28 R. P. C. 665; *Badische, &c.* v. *Chemische Fabrik*, 21 R. P. C. 345.

In the case of a patent for amalgamating lead and tin by rolling, the production of articles which experts swore were apparently made by this process, together with evidence that at one time the defendants used the process, was held sufficient. *Betts* v. *Neilson* (1871), L. R. 5 H. L. 1.

In the case of the Saccharin patents, evidence that Saccharin of the quality produced could only be made by one of the processes covered by the plaintiffs' patents, or could only be made at the price at which it was sold by such methods, was held sufficient. The injunction and damages were limited to the time of expiration of the first of the patents sued on. *Saccharin Corporation* v. *Quincey*, 17 R. P. C. 337; *Saccharin Corporation* v. *Dawson*, 19 R. P. C. 169; *Saccharin Corporation* v. *Jackson*, 20 R. P. C. 611; *Saccharin Corporation* v. *Mack*, 23 R. P. C. 25; *Saccharin Corporation* v. *Lockwood*, 23 R. P. C. 274; *Saccharin Corporation* v. *Scott*, 23 R. P. C. 276; *Saccharin Corporation* v. *Jones*, 23 R. P. C. 275; *Saccharin Corporation* v. *National Saccharin Coy.*, 26 R. P. C. 735.

Where a process was claimed for the purpose of reducing the carbon in Tungsten filaments, and it was shown that the defendants had used it, and that its natural effect was to reduce the carbon, it was held that the onus was on the defendants to show that it did not do so. *Z Electric Lamp Coy.* v. *Marples*, 27 R. P. C. 737, C. A.

The question of whether the article etc., is within the claim is of course a matter for the Court. *Graphic Arts Coy.* v. *Hunters Ltd.*, 27 R. P. C. 677.

Where the plaintiff relies on admissions or answers by the defendant, these must be such as to negative the possibility of non-infringement. *Winby* v. *Manchester Steam Tramways*, 7 R. P. C. 30, C. A.; *Wilson Brothers Bobbin Coy., Ltd.* v. *Wilson & Coy.*, 20 R. P. C. 1, H. L. See also *Ashworth* v. *English Card Clothing Coy.*, 20 R. P. C. 790, H. L.; *Morrison* v. *Asplin*, 21 R. P. C. 557.

In *Parkinson* v. *Simon*, 11 R. P. C. 238, it was held that the fact of the defendants calling a certain part a deflector was no evidence that it was a deflector within the meaning of the specification. See also *Osborne* v. *Board*, 13 R. P. C. at p. 748. But see *contra*, *Morgan* v. *Windover*, 4 R. P. C. 446.

Evidence of intention to infringe may be sufficient for the purposes of obtaining an injunction. *Plumpton* v.

As to the issues going to the validity of the patent the opinion expressed by the Courts differ (*c*), but the general practice is for the plaintiff to make a *primâ facie* case on the issues of novelty, utility and sufficiency. The onus of the issues of leave and licence (*d*), non-manufacture or non-fulfilment of the reasonable requirements of the public, are on the defendant in the first instance (*e*).

Expert evidence.

A large portion of the evidence in patent cases is what is usually called expert evidence. The object of such evidence is mainly to instruct the Court as to the state of knowledge, the meaning of terms of art, and other surrounding circumstances, so that it may be better able to construe the specification and to form a judgment on the various issues. But it is not the

Spiller (1877), 4 Ch. D. 286; *Frereson* v. *Loe* (1878), 9 Ch. D. 48; *Dowling* v. *Billington*, 7 R. P. C. 101 (Ir.). But see *Shoe Machinery Coy.* v. *Cutlan*, 12 R. P. C. 342; *McClay* v. *Lawes*, 22 R. P. C. 199.

Evidence of acts after the commencement of the action may show such intention. *Dowling* v. *Billington, supra.*

But as to when such evidence is admissible, see *Shoe Machinery Coy.* v. *Cutlan, ubi supra; Welsbach Incandescent Coy.* v. *Doucle*, 16 R. P. C. 391.

The evidence must be clear that what is intended to be done will be an infringement, see *Babcock & Wilcox Ltd.* v. *Danks*, 27 R. P. C. 713; *cf. Poulton* v. *Kelly*, 21 R. P. C. 393.

(*c*) The general onus as to novelty was said to be on the plaintiff in *Penn* v. *Jack* (1866), 14 L. T. 495; *Russel* v. *Ledsam* (1843), 12 L. J. (EX.) 430; *Rollins* v. *Hinks* (1872), L. R. 13 Eq. 355 (unless the patent is an old one).

On the other hand opinions that a patent is *primâ facie* valid and that the onus is on the defendant were expressed in *Young* v. *White* (1853), 17 Beav. 532; *Ward Brothers* v. *Hill*, 18 R. P. C. 481 (cases referred to). *Peroni* v. *Hudson*, 1 R. P. C. 263; *Amory* v. *Brown* (1869), L. R. 8 Eq. 663; *Young* v. *Rosenthal*, 1 R. P. C. 29; *Minter* v. *Wells* (1834), W. P. C. 127; *Halsey* v. *Brotherhood* (1880), 15 Ch. D. 514.

Of course the onus as to specific instances of prior user is on the defendant, and the plaintiff can call evidence in rebuttal. This has been admitted even after the hearing. *Boyd* v. *Horrocks*, 5 R. P. C. 557.

In *Penn* v. *Jack, ubi supra*, further evidence to contradict such rebutting evidence was not allowed; but *cf. Blakey* v. *Latham*, 6 R. P. C. 36.

As to admissibility of statements by alleged prior users see *Hyde* v. *Palmer* (1863), 32 L. J. (Q. B.) 26.

In one case where an alleged description in a classical work was relied on as an anticipation, a passage in Ovid showing the real nature of the article was admitted to disprove the anticipation. *Benno Jaffé, &c.* v. *Richardson*, 11 R. P. C. 93, and 261, C. A.

As to proper course where user not in particulars is proved, see *Barcroft* v. *Barcroft*, 14 R. P. C. 172, C. A.

As to the onus on the issue of utility, see *Minter* v. *Wells, supra.* Rebutting evidence on this issue was allowed on special terms in *Easterbrook* v. *Great Western Railway*, 2 R. P. C. 201.

With the modern interpretation of the issue of first and true inventor the onus of this objection is of course on the defendant. See also *Nickels* v. *Ross* (1849), 8 C. B. 679; *Pilkington* v. *Yeakley*, 18 R. P. C. 459; *Ward Brothers* v. *Hill, supra; Kelvin* v. *Whyte-Thomson*, 25 R. P. C. 177.

(*d*) See *Badische, &c.* v. *Dawson*, 6 R. P. C. 387.

(*e*) See p. 174.

Of course the defendants may elicit this evidence by cross-examination. *Saccharin Corporation* v. *National Saccharin Coy.*, 28 R. P. C. 201.

function of such witnesses to pronounce on the issues (whether of law or fact) which are for the Court, and direct questions such as whether an article is an infringement, or a document an anticipation, should not be put (*f*).

Miscellaneous points of evidence.

The ordinary rules of evidence, of course, govern patent cases, but a note of a few miscellaneous points may be useful. Models (*g*) and drawings are freely used, and may be put to witnesses as illustrating what they have seen, although not made by such witnesses (*h*). Awards at public exhibitions cannot be received as evidence of novelty or utility unless a juror is called (*i*). The Court will require the production of unpublished provisional specifications if of opinion that it is necessary in the interests of justice (*k*). Observations have been made on the danger of relying on single experiments, (*l*) and on the tendency of trade evidence to be against the patentee (*m*). Where joint tests of an apparatus

(*f*) *Graphic Arts Coy.* v. *Hunters Ltd.*, 27 R. P. C. 677; *Gadd* v. *Mayor of Manchester*, 9 R. P. C. 530, C. A.; *Parkinson* v. *Simon*, 11 R. P. C. at p. 506, C. A. See also as to the function of expert evidence, *Boyd* v. *Horrocks*, 9 R. P. C. 81, H. L.; *Leadbeater* v. *Kitchin*, 7 R. P. C. 247.

Such witnesses should not be needlessly multiplied. *Automatic Weighing Machine Coy.* v. *Knight*, 6 R. P. C. 113. (The general limit is two on each side apart from those speaking to special points.)

It has also been doubted whether these witnesses, in general highly trained scientists, can properly speak as to what an ordinary workman would do. *Proctor* v. *Bennis*, 4 R. P. C. 361, C. A.

Expert evidence is admissible as to originality or as to a variation being obvious. *Fletcher* v. *Glasgow Gas Commissioners*, 4 R. P. C. 388, O. H.

Although construction is for the Court a witness may be asked what he understands by a specification. *Kaye* v. *Chubb*, 5 R. P. C., *per* Lord HALSBURY, at p. 650.

But it has been said that they should not be asked what was the substance of the invention (*Brooks* v. *Steel*, 14 R. P. C. 73), or whether two parts of a specification refer to the same thing. *Jandus Arc Lamp Coy.* v. *Arc Lamp Coy.*, 22 R. P. C. 286. See also p. 123.

(*g*) Once a model is put in it should not be altered or even cleaned without the consent of all parties. *Winby* v. *Manchester Steam Tramways*, 8 R. P.C. 61.

Where models are not put to plaintiff's witnesses these may be recalled. *Nettlefolds* v. *Reynolds*, 9 R. P. C. 282.

(*h*) *R.* v. *Haddan* (1826), 2 Car. & P. 184. But in such cases the witness must have sufficient technical knowledge to be able to speak to details. *Perry* v. *La Société des Luneliers*, 13 R. P. C. 664.

Where a witness says that what he saw was identical with what was in use in some other factory, evidence cannot be called in contradiction to show what in fact was in use in such factory. *Haggenmacher's Patent*, 15 R. P. C. 437.

Models may also be used to illustrate the arguments of counsel though not in evidence. *Boyd* v. *Horrocks*, 6 R. P. C. 154, C. A.; but see *Tweedale* v. *Ashworth*, 8 R. P. C. 52, C. A.

(*i*) *Young* v. *White* (1854), 23 L. J. (CH.) 197.

(*k*) *Pneumatic Tyre Coy., Ltd.* v. *English Cycle Coy.*, 14 R. P. C. 851.

(*l*) *Dunlop Pneumatic Tyre Coy.* v. *Clifton Tyre Coy.*, 20 R. P. C. 404, C. A.

(*m*) *Pirrie* v. *York Street Flax Coy.*, 11 R. P. C. 441, C. A. (Ir.).

have been made further tests should not be made without notice to the other side (*n*).

Appeal evidence.

The Court of Appeal will form its own inferences of facts not depending on the credibility of witnesses (*o*).

It will not in general admit fresh evidence where this would involve an amendment of the pleadings (*p*). Fresh evidence not involving an amendment of the pleadings may be admitted when it could not have been discovered earlier (*q*), or where a party has been taken by surprise (*r*) or misled (*s*). It may also sometimes be admitted where the party who was successful below called no evidence (*t*), or where there has been a slip in the evidence, or, in such cases, a new trial may be granted (*u*). Sometimes evidence will be admitted to clear up a point which the Court thinks doubtful (*x*). Models not used or put to witnesses below cannot be used on appeal (*y*). Fresh evidence will not be admitted simply because the unsuccessful party thinks he can strengthen his case (*z*), nor will it be admitted where its admission would not in the opinion of the Court enable the party to succeed (*a*). The application should in general be made before the appeal and supported by an affidavit, though the application is frequently adjourned to come on with the appeal (*b*).

Fresh points on appeal.

Fresh points not involving new evidence may be taken on appeal, unless they involve an entire change of case (*c*).

(*n*) *Young* v. *Hermand Oil Coy.*, 9 R. P. C. 382, H. L.

(*o*) See *Moore* v. *Bennett*, 1 R. P. C. 126, C. A. and H. L.; *Rickmann* v. *Thierry*, 14 R. P. C. 116, H. L.; but *cf. Nobel's Explosive Coy.* v. *Anderson*, 12 R. P. C. 166, H. L.; *Newellite Coy.* v. *Lawson*, 24 R. P. C. 311, C. A.

(*p*) *Hinde* v. *Osborne*, 2 R. P. C. 64, C. A.; *Browne* v. *Hastie*, 22 R. P. C. 85, I. H., and S. L. T. 12, 121; but fresh specifications were allowed to be pleaded in *Pirrie* v. *York Street Flax Coy.*, 11 R. P. C. 431, C. A. Ir.

(*q*) See *Hinde* v. *Osborne*, *supra*; *Watling* v. *Stevens*, 3 R. P. C. 147, C. A.; *Walker* v. *Hydrocarbon Syndicate Ltd.*, 3 R. P. C. 254, C. A.

(*r*) Leave was refused where no application for adjournment had been made below. *Barcroft* v. *Barcroft & Smith*, 14 R. P. C. 172, C. A.

An affidavit as to surprise is necessary. *Haggenmacher* v. *Watson*, 14 R. P. C. 631, C. A.

(*s*) *American Braided Wire Coy.* v. *Thomson*, 5 R. P. C. 113, C. A.; *Britain* v. *Hirsch*, 5 R. P. C. 226, C. A.

(*t*) *Deutsche Nahmaschinen Fabrik* v. *Pfaff*, 7 R. P. C. 251, C. A. But see *Lancashire Explosive Coy.* v. *Roburite Explosive Coy.*, 12 R. P. C. 480, C. A.

(*u*) *Germ Milling Coy.* v. *Robinson*, 3 R. P. C. 398, C. A.

(*x*) In *Moore* v. *Bennett*, 1 R. P. C. 126, the C. A. ordered an independent expert to make a report.

(*y*) *Erhlich* v. *Ihlee*, 5 R. P. C. 437, C. A.

(*z*) *Hinde* v. *Osborne*, *supra*; *Nadel* v. *Martin*, 20 R. P. C. 723, C. A.

(*a*) *Gammons* v. *Singer*, 22 R. P. C. 452, C. A.

(*b*) See *Watling* v. *Stevens*, *supra*; *Blakey* v. *Latham*, 6 R. P. C. 186, C. A.

(*c*) *E.g.* where in the first Court the plaintiff had admitted that an article would be an anticipation, but

A plaintiff is not entitled to put a different construction on his patent in the Court of Appeal to that which he contended for in the first Court, at any rate if the evidence might have been affected had this construction been argued in the first instance (*d*).

Relief.

Forms of relief.

The relief granted may include an injunction, damages or an account of profits, an order for the delivery up or destruction of the infringing articles, a certificate of validity, and costs.

Injunction.

Grounds for injunction.

The object of an injunction being to prevent repetition of infringement, it would in theory only be granted where there was reason to think that otherwise the offence would be repeated (*e*). But in the case where the defendant has deliberately infringed or has set up a claim of right to do what the Court holds to be unlawful, either by his defence or otherwise (*h*), the Court presumes that an injunction is necessary to protect the plaintiff, even though the defendant has subsequently offered an undertaking (*i*), unless there are special circumstances which show there is no probability of the infringement being repeated (*k*).

But in the case of an infringer who has acted innocently and has promptly discontinued and offered a proper undertaking

challenged its authenticity, he was not allowed on appeal to suggest it would not anticipate. *Westley Richards & Coy.* v. *Perkes*, 10 R. P. C. 382, C. A.

(*d*) *Badische, &c.* v. *Société des Usines de Rhone*, 15 R. P. C. 359, C. A. *Cf.* also *Gillette Safety Razor Coy.* v. *Anglo-American Trading Coy.*, 29 R. P. C. 340, C. A.

(*e*) See *Proctor* v. *Bayley*, 6 R. P. C. 538, C. A., and cases there quoted.

(*h*) *Dowling* v. *Billington*, 7 R. P. C. 191, C. A. Ir. 286; *Plimpton* v. *Spiller* (1877), 4 Ch. D., C. A.

(*i*) See *per* SHADWELL, V.C., in *Losh* v. *Hague* (1837), 1 W. 200. See also *Geary* v. *Norton* (1846), 1 De G. & S. 9; *Edison* v. *London Phonograph Coy.*, 11 R. P. C. 741.

(*k*) Where the defendant had been captain of a ship having the infringing machinery, but had given up his position, the injunction was refused. *Caldwell* v. *Van Vlissingen* (1851), 21 L. J. (CH.) 97.

Where the defendants had used the plaintiff's apparatus for one trip for fishing purposes, but had abandoned it as useless an injunction was refused. *Scott* v. *Hull Steam Fishing Coy.*, 14 R. P. C. 143.

Where the defendants had abandoned the business an injunction was refused. *Welsbach Incandescent Coy.* v. *New Incandescent Coy.*, 17 R. P. C. 237. See also *Hudson* v. *Chatteris Engineering Coy.*, 15 R. P. C. 438; *Kernot* v. *Potter* (1861), 3 De G. F. & J. 447.

Where the defendant had dismantled the machinery four years before action an injunction was refused, although he had challenged the plaintiff's rights. *Proctor* v. *Bayley*, 6 R. P. C. 538, C. A.

and compensation, the Court will not generally interfere by injunction (*l*).

The Court is sometimes reluctant to grant injunctions where the defendant does not oppose and it suspects that the plaintiff's object in getting the injunction is to advertise it (*m*).

In modern times there is no case of a final injunction being refused on the ground of delay (*n*).

It would seem that an injunction might be granted, even after the expiration of a patent, against the sale of articles manufactured in this country in infringement of such patent during its life (*o*).

Form of injunction.

In ordinary cases a successful plaintiff is entitled to a general injunction against infringement of the patent sued on. Sometimes, however, when the Court finds that the defendant is making two substantially different articles the injunction may be limited to articles similar to a certain exhibit (*p*), or the plaintiff may be put on the terms of not raising the question of infringement by certain forms on a motion to commit (*q*).

Stay of injunction.

The question of staying the injunction where the plaintiff is successful is one entirely in the discretion of the Court (*r*),

(*l*) *Jenkins* v. *Hope*, 13 R. P. C. 57; *Betts* v. *Wilmott* (1870), 18 W. R. 946. See also *Fletcher* v. *Glasgow Gas Commissioners*, 4 R. P. C. 386; but the undertaking must be full and clear, see *United Telephone Coy.* v. *London & Globe Coy.*, 1 R. P. C. 118.

(*m*) *Dover* v. *New Townsend Coy.*, 21 R. P. C. 135; *Badische, &c.* v. *Spivey*, 22 R. P. C. 65.

But in *Savage* v. *Brindle*, 17 R. P. C. 288, an injunction was granted against a defendant who had submitted to judgment, although the patent was held to be bad, but *cf. Cropper* v. *Smith*, 2 R. P. C. 17, H. L.

(*n*) In *Gadd* v. *Mayor of Manchester*, 9 R. P. C. 528, C. A., the Court refused to grant a mandatory injunction ordering the defendants to remove a gas holder, which they had erected, or to restrain them using it, although they were restrained from building fresh ones.

But in *Automatic Coal Gas Retort Coy.* v. *Mayor of Salford*, 14 R. P. C. 450, an injunction was granted restraining the further use of the retorts which had been erected. See also p. 209, *n.* (*y*).

(*o*) *Crossley* v. *Derby Gas Light Coy.* (1834), 44 L. J. (CH.) 25; *Price's Patent Candle Coy.* v. *Bawens* (1858), 4 K. & J. 727.

(*p*) *Dunlop Pneumatic Tyre Coy.* v. *New Ixion Coy.*, 15 R. P. C. 389, and 16 R. P. C. 16, C. A. But see *Shoe Machinery Coy.* v. *Cutlan*, 3 R. P. C. 141.

(*q*) *Dunlop Pneumatic Tyre Coy.* v. *Clifton Tyre Coy.*, 20 R. P. C. 393.

Special orders were made in some of the *Saccharin Cases*, where the plaintiff succeeded by showing that the defendant must have infringed one of a number of patents. Here the injunction was against infringing any of the patents, but was limited to the duration of the oldest patent. See *Saccharin Corporation* v. *Dawson*, 19 R. P. C. 169. But *cf. Saccharin Corporation* v. *Hopkinson*, 21 R. P. C. 272.

The Court will not in general lay down limits as to what the defendant may do. See *Edison* v. *Woodhouse*, 3 R. P. C., at p. 178.

(*r*) Usually, however, the defendant should show some special reason for a stay. See *Otto* v. *Steel*, 3 R. P. C. 109; *Hayward* v. *Hamilton* (1879), Griff. 124; *Hicks* v. *Simmons*, 21 R. P. C. 413; *Pilkington* v. *Massey*, 21 R. P. C. 421. See also

but the Court of Appeal will review its decision, at any rate in the interest of the defendants, and sometimes the defendant is directed to make an application to the Court of Appeal (*s*). A stay is very rarely granted after judgment for the plaintiff in the Court of Appeal, except by consent (*t*). Sometimes an exception from the injunction is made with regard to certain articles under order (*u*). A stay will not be granted where the defendant has no existing trade (*x*).

Damages and Profits.

Plaintiff may take account or inquiry.

A successful plaintiff has in general the right either to damages (*y*) or an account of profits, but must elect before judgment is finally given which of the two he will take (*z*).

Penn v. *Bibby* (1866), 15 W. R. 192. In *Hopkinson* v. *St. James's Electric Lighting Coy.*, 10 R. P. C. 62, the injunction was suspended for six months on the ground of public convenience.

The application is usually made at the trial, though sometimes a separate motion may be ordered. See *Otto* v. *Steel*, *supra*.

The following cases are examples of the terms sometimes imposed if a stay is granted :—

The defendants ordered to give security for the recovery of the royalties on articles made between trial and appeal. *National Opalite Coy.* v. *Ceralite Coy.*, 13 R. P. C. 649.

The defendants ordered to pay royalties which should be returned if they succeeded. *Jandus Arc Coy.* v. *Arc Lamp Coy.*, 22 R. P. C. 207, C. A.

The defendants ordered to pay £100 into Court or £200 towards costs and damages. *Birmingham Tyre Coy.* v. *Reliance Coy.*, 19 R. P. C. 298.

Stay granted for three weeks by the Court of Appeal on payment of a further £500 into Court in addition to amount already in. *North British Rubber Coy.* v. *Gormully and Jeffreys*, 14 R. P. C. 302.

Stay granted on payment into Court of a penny per lamp made. *Osram Lamp Works* v. *Z Electric Lamp Coy.*, 29 R. P. C. 430.

Where the defendants were supplying the Government the injunction was stayed so far as the articles supplied to the Government were concerned, a receiver being appointed to hold the money paid. *Nordenfeldt* v. *Gardner*, 1 R. P. C. 63.

(*s*) *Leeds Forge* v. *Deighton*, 18 R. P. C. 233.

(*t*) See *Hayward* v. *Hamilton* (1879), Griff. 124; *Lyon* v. *Goddard*, 10 R. P. C. 121, C. A.

The practice suggested by the Court of Appeal in *Proctor* v. *Bennis*, 4 R. P. C. 363, that a separate motion should be made is not always followed. In *Patent Exploitation Coy.* v. *Siemens*, 20 R. P. C. 225, the plaintiffs did not oppose the stay.

(*u*) See *Lyon* v. *Goddard*, *supra*; *Duckett* v. *Whitehead*, 12 R. P. C. 376; *Nordenfeldt* v. *Gardner*, *supra*.

(*x*) *Proctor* v. *Bennis*, *supra*; *Pilkington* v. *Yeakley Coy.*, 18 R. P. C. 459, C. A.

The dictum in *Proctor* v. *Bennis*, *supra*, as to granting a stay where defendant has existing trade has not been generally followed, at any rate after judgment by the Court of Appeal. It does not apply if defendant can so alter the articles as not to infringe and yet continue business. *British Motor Syndicate* v. *Andrews*, 16 R. P. C. 581, C. A.

(*y*) The action being for infringement of a legal right, a successful plaintiff is in any case entitled to nominal damages. *Cf. Davenport* v. *Rylands* (1865), L. R. 1 Eq. 302, and 14 W. R. 244.

(*z*) *Betts* v. *De Vitre* (1864), L. R. 6 H. L. 319; *Betts* v. *Neilson* (1866), L. R. 5 H. L. 1, overruling *Hill* v. *Evans* (1862), 4 De G. F. & J., at p. 309.

The old equity rule was that an

Measure of damages.

In the case of damages the plaintiff continues to treat the action of the defendant as a tort, and is given compensation for the loss caused to him by such tort, consequently the damages are usually ascertained by assuming that the plaintiff or his licensees would have sold the whole or a portion of the articles sold by the defendant, and considering what would have been his profit on such sales (*a*). But the plaintiff is allowed to increase the damage by showing that the defendant's

account would only be ordered as ancillary to an injunction and in a case where an injunction would have been granted. Thus laches would have been an objection to giving such an account (*Crossley* v. *Derby Gas Light Coy.* (1829), W. P. C., at p. 119; *Smith* v. *L. & S. W. Ry. Coy.* (1854), Kay, 408; *Price's Patent Candle Coy.* v. *Bauwen* (1858), 4 K. & J. 727), as would the fact that the patent had expired. *Betts* v. *Gallaiss* (1870), 22 L. T. 341; but see *contra*, *Fox* v. *Jones* (1866), 15 W. R. 194; *Davenport* v. *Rylands* (1866), 35 L. J. (CH.) 204.

This rule was not, however, recognised by the Common Law Courts as binding on them. *Vidi* v. *Smith* (1854), 23 L. J. (Q. B.) 342. It does not seem to have been acted on in recent years. As to old Common Law practice, see also *Holland* v. *Fox* (1854), 23 L. J. (Q. B.) 77 and 357.

Where the defendant goes bankrupt the patentee can continue the action and prove in bankruptcy for the profits, though not for damages. *Watson* v. *Holliday* (1882), 20 Ch. D. 780. See also generally on the distinction between these remedies, *Slazenger* v. *Spalding*, 27 R. P. C. 20; *Watson* v. *Holliday*, *supra*; *Nunn* v. *d'Albuquerque* (1864), 34 Beav. 595; *Betts* v. *De Vitre* (1865), 34 L. J. (CH.) 201.

(*a*) The loss to the plaintiff necessarily depends on his method of trading, and is in general highest where he is himself a manufacturer. If he grants licences the fact that a licencee might have sold the article may be taken into account as reducing the damages, though an infringer cannot claim to be put on the same footing as a licencee. *Boyd* v. *Tootal, Broadhurst, Lee & Coy.*, 11 R. P. C. 175. Where the plaintiff neither manufactures nor licenses, the damages may be nominal, and in such case an account of profits would generally be preferable.

The following are some examples of how damages have been fixed.

Where the plaintiff was in the habit of granting licences at 2*s.* 6*d.* per H.P., this figure was taken in fixing damages. *Penn* v. *Jack* (1866), L. R. 5 Eq. 81.

But where the plaintiffs supplied tyres on which the profits were 12*s.* 6*d.*, which alone were put on first-grade machines, but licensed tyres for second-grade machines at 2*s.* 6*d.* each, and the infringing tyres were only used on second-grade machines, the Court of Appeal held that the judge was wrong in assuming that a licence would have been granted for the infringing tyres at this amount, though they did not disturb his figures which were in the main based on this. *Pneumatic Tyre Coy.* v. *Puncture Proof Tyre Coy.*, 16 R. P. C. 209, C. A. See also *Dunlop Pneumatic Tyre Coy.* v. *Green*, 17 R. P. C. 234, where this case was considered and distinguished, and *British Motor Syndicate* v. *Taylor*, 17 R. P. C. 723, C. A., where a sum larger than the amount at which plaintiff's licensed, but less than their full profit, was given.

In *Boyd* v. *Tootal, Broadhurst, Lee & Coy.*, *supra*, the plaintiff's full profit was given as damages, though he had offered to accept a less sum from persons submitting without litigation.

In *English and American Shoe Machinery Coy.* v. *Union Boot and Shoe Coy.*, 13 R. P. C. 164, where the plaintiff's general system was to license, though some machines had been sold, the damages were assessed on basis of loss of royalties up to the date of the injunction.

In *Leeds Forge* v. *Deighton*, 25 R. P. C. 209, the damages were assessed at the plaintiff's full rate of profit, although he had made a special

unlawful competition has caused him to lower prices (*b*), or has otherwise caused him loss (*c*). Generally speaking, the plaintiff is only entitled to the loss of profit on the sale of the patented articles, and not that on other articles which he might have sold with them (*d*). In a case where the plaintiff takes the inquiry as to damages he is entitled to proceed against the purchasers of the articles, and to recover further damages from them (*e*).

Account of profits.

In the case of an account of profits the patentee treats the wrongdoer as his agent, and recovers the profits made by him (*f*).

arrangement for licence with one manufacturer. The damages were also assessed on the basis of the plaintiff's profits in *Dey* v. *Howard*, 20 R. P. C. 21.

In *Automatic Gas Coal Retort Coy.* v. *Salford Corporation*, 14 R. P. C. 450, it was arranged on the judge's suggestion that the damages should be ascertained by determining what would have been a proper sum for the defendants to pay by way of royalty.

(*b*) *Meters, Ltd.* v. *Metropolitan Gas Coy.*, 28 R. P. C. 157, C. A.; *United Horsenail Machinery Coy.* v. *Stewart*, 5 R. P. C. 160, H. L.; *American Braided Wire Coy.* v. *Thomson*, 7 R. P. C. 152, where *United Horsenail Machinery Coy.* v. *Stewart* is considered and explained. *Leeds Forge* v. *Deighton*, 25 R. P. C. 209.

So, too, a sum may be added if the infringement were such as to injure plaintiff's reputation. *Pneumatic Tyre Coy.* v. *Puncture Proof Tyre Coy.*, 15 R. P. C. 405.

In *Boyd* v. *Tootal, Broadhurst, Lee & Coy.*, *supra*, ROBINSON, V.-C., was of opinion that where the defendant was not a manufacturer but a user, damage from reduction in the plaintiff's price was too remote.

Where infringement has been found it is not open to the defendants on the inquiry to say that the invention was useless, nor *semble* does it affect the damages that the infringing part only formed a small portion of the machinery on which the articles sold were made. *United Horsenail Machinery Coy.* v. *Stewart*, *supra*.

In *Gavioli* v. *Shepherd*, 17 R. P. C. 157, it was held that as the defendants who were users had bought a machine only half the price of the plaintiff's, and swore they could not have paid more, there were no damages.

But a contrary view was taken in *British United Shoe Machinery Coy.* v. *Fussell*, 27 R. P. C. 205, and in *Meters, Ltd.* v. *Metropolitan Gas Coy., Ltd.*, 28 R. P. C. 157, C. A., the Court held that it was not necessary for the plaintiff to prove he would have got the orders and that there may be damage even if it is shown that he would not. See also *Leeds Forge* v. *Deighton*, 25 R. P. C. 209, and *Willman, Seager, and Head, Ltd.* v. *Burstinglaus*, 28 R. P. C. 326 (competing tenders); *Dey* v. *Howard*, 20 R. P. C. 21.

(*c*) *E.g.* That decrease of orders has thrown a greater portion of establishment charges on other work. *Leeds Forge* v. *Deighton*, *supra*.

(*d*) See *Penn* v. *Jack* (1866), L. R. 5 Eq. 81; *Clement Talbot* v. *Wilson*, 20 R. P. C. 467, C. A.

In *British Insulated Wire Coy.* v. *Dublin United Tramway Coy.*, 17 R. P. C. 14, the plaintiffs and defendants had both tendered for a contract in which the infringing articles were used. The plaintiffs sought to recover the amount of profit they would have made had their tender been accepted, but it was held that the damages were confined to loss on infringing articles actually imported before the patent expired.

But where the patented part is an integral part of the article sold, this rule does not apply, and the plaintiff is entitled to a profit on the whole article. *Meters, Ltd.* v. *Metropolitan Gas Coy., Ltd.*, 28 R. P. C. 157, C. A. See also *United Telephone Coy.* v. *Walker*, 4 R. P. C. 63; *Brown Bros. & Coy.* v. *Hasties*, 21 R. P. C. 462, O.H.

(*e*) *United Telephone Coy.* v. *Walker*, *supra*; but see *Penn* v. *Jack*, *supra*.

(*f*) *Betts* v. *Neilson* (1866), L. R. 5 H. L. 1; *Betts* v. *De Vitre* (1864), L. R. 6 H. L. 319; *Watson* v. *Holliday*

The loss to the plaintiff would not here come into account, but only the profit made by the defendant (*g*). In such a case it would seem doubtful whether the plaintiff can bring further actions against the purchasers of the articles on which he has received the profit (*h*).

Accounts and inquiries.

The costs of either an account or an inquiry are usually reserved and dealt with after such account or inquiry has been held (*i*). Neither damages nor profits can be given for more than six years (*k*) before action brought, nor can they go beyond the time when the plaintiff or one of the plaintiffs was at least an equitable owner of the patent (*l*).

Where it is clear there has been no real damage an account

(1882), 20 Ch. D. 782, C. A.; *Saccharin Corporation, Ltd.* v. *Chemical and Drugs Coy.*, 17 R. P. C. 612, C. A.

An account of profits is generally preferable where the defendant has an established trade supposed to be profitable, especially where the plaintiff is not trading. But see *Siddle* v. *Vickers*, *infra*.

In taking an account of profits, a comparison sometimes has to be made between the defendant's costs of working before and after the use of the invention. In such cases the plaintiff is given discovery of the matters necessary to make the comparison. *Siddle* v. *Vickers*, 6 R. P. C. 464. Probably the defendant might show that he could have used other labour-saving devices, *ibid.* As to other facts affecting the account, see this case and *Crossley* v. *Derby Gas Coy.* (1829), 3 My. & Cr. 428; 3 Jur. 692.

(*g*) *Ellwood* v. *Christy* (1865), 34 L. J. (C. P.) 130.

The onus lies on the plaintiff to show that the defendant has in fact made profits. *Bacon* v. *Spottiswoode* (1839), 3 Jur. (O. S.) 476.

(*h*) It was held by WOOD, V.-C., in *Penn* v. *Jack* (1866), L. R. 5 Eq. 81, that taking profits from the manufacturer did not prevent damages being obtained from users, but this was before *Betts* v. *Neilson*, *supra*.

This also seems to have been assumed in *Saccharin Corporation* v. *Chemical and Drugs Coy.*, *supra*, where, however, it was not to the interest of either party to argue to the contrary. It seems difficult to reconcile this view with the dicta in the cases in *n.* (*f*), *supra*, and especially with the grounds of the decision in *Watson* v. *Holliday* (1882), 20 Ch. D. 780, that in taking an account of profits the patentee treats the infringer as his agent, and adopts his acts, and can therefore prove in bankruptcy.

See remarks of CHITTY, J., in *United Telephone Coy.* v. *Walker*, 4 R. P. C., at p. 67, and of WOOD, V.-C., in *Penn* v. *Jack*, *supra*.

(*i*) This is the usual practice, and applies where the judgment is in default of defence. *United Telephone Coy.* v. *Fleming*, 3 R. P. C. 282; *Same* v. *Faulkner*, 3 R. P. C. 282 *n.*; but in *Craig* v. *Dowding*, 25 R. P. C. 9, KEKEWICH, J., said the costs were only reserved when there was a doubt as to there being any real damages. See also *Rothwell* v. *King*, 4 R. P. C. 76. The defendants may offer a sum for damages, and if a less sum is awarded will usually get the costs of the inquiry from the date of the offer. *Pneumatic Tyre Coy.* v. *Puncture Proof Tyre Co.*, 15 R. P. C. 405; 16 R. P. C. 209, C. A.; *British Vacuum Cleaner Coy.* v. *Exton Hotels Coy.*, 25 R. P. C. 617.

(*k*) *Crossley* v. *Derby Gas Light Coy.* (1839), W. P. C. 119.

(*l*) In *Ellwood* v. *Christy* (1865), 34 L. J. (C. P.) 130, it was held that an account only ran from the completion of the legal title.

In *United Horsenail Machinery Coy.* v. *Stewart*, 5 R. P. C. 260, H. L., damages were given from the date when the plaintiffs became equitable owners of the patents, and Lord MACNAGHTEN was of opinion they should have gone back further to the date when the plaintiffs took over the business.

or inquiry may be refused (*m*). Where judgment is signed on admissions in the defence the inquiry is limited to the admitted infringements (*n*). The inquiry is usually held before a chief clerk, but it may be sent to an official referee (*o*). It is doubtful whether it can be sent to a jury (*p*).

It is not usual to stay an inquiry or account where there is an appeal (*r*), and the damages should be assessed as if the inquiry were conducted instantaneously (*s*). On an inquiry or account the plaintiff is entitled to an order for full inspection of the defendants' books, including the names of customers, without any terms being imposed as to not bringing actions against such customers (*t*).

Limitation of damages.

The Act provides that in the case of a patent granted after the commencement of the Act (*u*) the patentee shall not recover any damages in respect of infringement of such patent from a defendant who proves that at the date of the infringement he was not aware, and had not reasonable means of making himself aware, of the existence of the patent, but this does not affect the right to an injunction (*x*). It is provided that marking the article with such words as "patent" without the number

(*m*) See *United Telephone Coy.* v. *Sharples*, 2 R. P. C. 28.

Sometimes the Court will itself fix a sum. See *Cole* v. *Saqui*, 5 R. P. C. 489.

(*n*) *United Telephone Coy.* v. *Donohoe*, 3 R. P. C. 45.

(*o*) *American Braided Wire Coy.* v. *Thomson*, 5 R. P. C. 696, C. A.

(*p*) *American Braided Wire Coy.* v. *Thomson*, *supra*. See also *Fenessey* v. *Rabbits* (1887), 56 L. T. 138.

(*r*) *Evans* v. *Hoskins*, 21 R. P. C. 682; *Hyde* v. *Terry* (1880), 29 W. R. 32.

In *Adair* v. *Young* (1879), 11 Ch. D. 136, C. A., and *Craig* v. *Dowding*, 25 R. P. C. 9, a stay was granted. See also *Muirhead* v. *Commercial Cable Coy.*, 12 R. P. C. 258, C. A.

(*s*) *Per* Court of Appeal in *Poulton* v. *Adjustable Cover Coy.*, 25 R. P. C. 661.

The fact that the patent has been revoked before the inquiry has been held does not affect the question of damages, *ibid.*

(*t*) *Saxby* v. *Easterbrook* (1872), L. R. 7 Ex. 207; *Murray* v. *Clayton* (1872), L. R. 15 Eq. 115 (damages); *Saccharin Corporation* v. *Chemical and Drugs Coy.*, 17 R. P. C. 743, C. A. (profits); *American Braided Wire Coy.* v. *Thomson*, 4 R. P. C. 375 (damages).

The dictum to the contrary effect, in *Holland* v. *Fox* (1854), 22 L. T. (o. s.) 228, must be taken to be overruled.

It has been held in Scotland that the plaintiff also must give discovery of his books in order to allow the falling off in trade to be ascertained. *Hamilton* v. *Neilson*, 26 R. P. C. 671.

(*u*) Sect. 33. This section is new, and only applies to patents "granted after the commencement of this Act," *i.e.* January 1st, 1908. These words are difficult to interpret. Considering the language of this section and of s. 98 (2), to which it forms an exception, it would certainly appear that a patent granted after the commencement of the Act means one which had been in fact sealed and issued after that date. On the other hand, s. 13 says that "a patent shall be dated and sealed as of the date of application," and for all other purposes the date of application is taken as the date of the grant. This point will need judicial determination.

(*x*) It is not clear whether this would affect an account of profits. As to the distinction between damages and profits, see pp. 194, 195.

The account of profits was a remedy

and year of the patent shall not be deemed to constitute notice (*y*).

The damages are also limited in cases where the patent has been amended (*z*).

Delivery up.

In addition to his remedy by injunction and damages the plaintiff is entitled to an order directing the defendant to deliver up to him or to destroy infringing articles (*a*). Modern practice has been to limit, where possible, this delivery up to the removal of infringing parts (*b*). Where the parts are not patentable in themselves and the only patent is for their use in a particular way the defendant may be allowed to keep the parts though ordered to remove them from the patented combination (*c*).

Certificate of Validity.

The Act provides that in an action for infringement the Court may certify that the validity of a patent came into

ancillary to an injunction, and in theory simply put the patentee in the same position as if the infringer were his agent. Since theoretically the infringer would be in no worse position than if he had not used the patent, it may be that it was intended to leave the right to such an account.

(*y*) The general object of the section would seem to be to force the patentee to adopt a practice of marking his articles similar to that enforced in the case of designs, but the provisions in the two cases vary widely. The onus of proving ignorance would be on the defendant. For a fuller discussion on this subject, see Patents and Designs Act, 1907 (ROBERTS and MOULTON), p. 69.

(*z*) See p. 236.

(*a*) Delivery up is an additional remedy to damages, and the value of the articles delivered up will not be deducted from the damages. *United Telephone Coy.* v. *Walker*, 4 R. P. C. 63.

This order is not unfrequently stayed in view of an appeal. *Lancashire Explosives Coy.* v. *Roburite Explosives Coy.*, 12 R. P. C. 470, C. A.; *Hocking* v. *Fraser*, 3 R. P. C. 9. Sometimes on an undertaking by the defendant's solicitors. *Washburn and Moen Coy.* v. *Patterson*, 1 R. P. C. 191.

For other cases where delivery up was ordered, see *Frearson* v. *Loe* (1878), 9 Ch. D. 48; *Saccharin Corporation* v. *Anglo-Continental Coy.*, 17 R. P. C. 307; but see *British Motor Syndicate* v. *Andrews*, 16 R. P. C. 577; *Siddell* v. *Vickers*, 5 R. P. C. 101.

If not asked for at trial, it may be granted on an application to vary minutes (*Edison* v. *Holland*, 5 R. P. C. 483), but where delivery up has been ordered, it is too late for the defendants on such a motion to ask for the option of the destruction of the infringing parts. *British Westinghouse Coy.* v. *Electrical Coy.*, 28 R. P. C. 530.

In *United Telephone Coy.* v. *Henry*, 2 R. P. C. 11, where BACON, V.-C., decided for the defendant on the ground that the articles had not been sold, but only lent to a person who was in fact the plaintiff's agent, he dismissed a counter-claim by the defendant for the return of the articles on the ground that they were piracies. *Cf. contra*, *Vavasseur* v. *Krupp* (1870), 9 Ch. D. 357, C. A.

(*b*) *Edison* v. *Smith*, 11 R. P. C. 389, C. A.; *British Vacuum Cleaner Coy.* v. *Suctions, Ltd.*, 21 R. P. C. 303; *Needham* v. *Oxley* (1863), 8 L. T. 604 (the machines in this case were marked so that the plaintiff could follow them); *Automatic Weighing Machine Coy.* v. *Fearby*, 10 R. P. C. 442; *Howes* v. *Webber*, 12 R. P. C. 478.

(*c*) *Morgan* v. *Windover*, 7 R. P. C. 446.

question, and if such a certificate is given then the plaintiff in any subsequent action (*d*) for infringement shall recover his full costs, charges, and expenses as between solicitor and client (*e*), unless the Court otherwise directs (*f*).

The practice is to only give this certificate when the validity of the patent is wholly or in part established (*g*), but if validity is disputed in the defence the general practice is to give a certificate to a successful plaintiff, even if the defendant abandons his attack on the validity at the trial or does not appear (*h*).

If the Court is of opinion that the validity has been established it will in general grant the certificate even if the plaintiff

(*d*) Subsequent action means an action commenced after the certificate has been granted. *Automatic Weighing Machine Coy.* v. *Combined Weighing Machine Coy.*, 6 R. P. C. 120; *Same* v. *The International Hygienic Society*, 6 R. P. C. 475; *Saccharin Corporation* v. *Anglo-Continental Coy.*, 17 R. P. C. 307. See also *Penn* v. *Jack* (1866), 15 L. T. 385. The provision does not extend to petitions. As to threats actions, see p. 229 (*d*). A certificate may be given in respect of an expired patent. *Kane* v. *Boyle*, 18 R. P. C. 325.

(*e*) These costs may be on the higher scale. *Flour Oxidising Coy.* v. *Hutchinson*, 26 R. P. C. 597.

(*f*) Sect. 35.

(*g*) In one case a certificate was granted where the patent was held invalid, but the precedent has never been followed. *Haslam* v. *Hall*, 5 R. P. C. 1. This case was disapproved in *Acetylene Illuminating Coy., Ltd.* v. *United Alkali Coy., Ltd.*, 19 R. P. C. 213. Certificates have been granted as to certain claims when these have been held to be good though other claims were found to be bad. *Badische, &c.* v. *La Société des Usines de Rhone*, 14 R. P. C. 875.

Any attack on the patent is sufficient to justify a certificate, *e.g.* merely raising issue that patent was obtained by fraud. *Pilkington* v. *Yeakley*, 18 R. P. C. 457; *Sunlight Incandescent Gas Lamp Coy.* v. *Incandescent Gas Light Coy.*, 14 R. P. C. 757.

In *Witham Bros., Ltd.* v. *Catlow*, 25 R. P. C. 788, a certificate was granted that the grant was invalid, and in *Brooks* v. *Lamplugh*, 16 R. P. C. 46, that an alleged prior grant was invalid; but see p. 217, *n.* (*a*).

(*h*) There has been some divergence in the practice as to granting a certificate where the defendant does not appear at the trial. The following list of cases as to this, which is believed to be complete, may therefore be useful. The certificate has been granted where defendant did not appear at trial in *Haydock* v. *Bradbury*, 4 R. P. C. 74; *Edison Bell Phonograph Corporation* v. *Edison Phonograph Coy.*, 11 R. P. C. 33; *Edison United Phonograph Coy.* v. *Young*, 11 R. P. C. 489; *Saccharin Corporation* v. *Sitos*, 17 R. P. C. 536, *n.*; *Acetylene Illuminating Coy., Ltd.* v. *Midland Acetylene Coy.*, 17 R. P. C. 535; *Welsbach Incandescent Gas Light Coy.* v. *Krumm*, 18 R. P. C. 211; *Same* v. *M'Grady*, 18 R. P. C. 513; *Brooks* v. *Lycett*, 20 R. P. C. 390; *Soda Stream, Ltd.* v. *Davey*, 24 R. P. C. 763; *Jackson Boilers, Ltd.* v. *Fourness Lamp Coy.*, 28 R. P. C. 459.

It has been refused where defendant did not appear at trial in *Peroni* v. *Hudson*, 1 R. P. C. 261; *Webb Lamp Coy., Ltd.* v. *Thomas Atkinson*, 19 R. P. C. 599; *Gall* v. *O'Neill*, 27 R. P. C. 18.

It has also been granted in the following cases where defendant gave up contest as to validity at the trial. *Consolidated Pneumatic Tool Coy.* v. *Churchill*, 22 R. P. C. 367; *Chadburn* v. *Robinson*, 18 R. P. C. 468; *Bowden's Patent Syndicate, Ltd.* v. *Smith*, 22 R. P. C. 498.

It was refused under these circumstances in an old case. *Stocker* v. *Rodgers* (1843), 1 Car. & Kir. 99, and in *Presto Gear Case Coy., Ltd.* v. *Simplex Coy.*, 15 R. P. C. 644.

It has been granted in certain cases

fails on infringement (*i*), but it is sometimes refused where a decision is given for the defendant on infringement and the question of validity has not really been decided (*k*).

The certificate can be given by any Court (*l*) and there is no appeal against the grant of a certificate alone (*m*), though, of course, if the Court varies the decision below in other respects, it may also vary it as to the certificate. The propriety of the grant of the certificate cannot be challenged in a subsequent action (*o*).

Formerly the Courts were averse to granting a second certificate in regard to a patent (*p*), but this is now done if different issues have been raised in the second case (*q*).

The plaintiff should plead the fact that a certificate has been obtained (*r*). On proof of the certificate the plaintiff obtains his costs as between solicitor and client unless the Court deprives him of them. As a general rule he gets these costs even if the

where the action has been settled on terms. *Delta Metal Coy.* v. *Maxim Nordenfeldt Coy.*, 8 R. P. C. 247; *Coles* v. *Baylis*, 3 R. P. C. 178, but was refused in *Robertson* v. *Standard Piston Ring Coy.*, 27 R. P. C. 266, O. H.; *Ferguson Superheaters, Ltd.* v. *Askern Colliery Coy.*, 29 R. P. C. 431, where further authorities are given; *Claughton* v. *Foster*, 21 R. P. C. 17.

(*i*) *Automatic Weighing Machine Coy.* v. *Knight*, 6 R. P. C., at p. 307; *Shoe Machinery Coy.* v. *Cutkan*, 13 R. P. C. 141; *Birch* v. *Harrap*, 13 R. P. C. 615; *Pneumatic Rubber Stamp Coy.* v. *Lindner*, 15 R. P. C. 525; *Morrison* v. *Asplin*, 21 R. P. C. 557; *Hoffmann Manufacturing Coy.* v. *Auto Machinery Coy.*, 28 R. P. C. 153.

Where the Court of Appeal allows an appeal on the ground of non-infringement, it may allow the certificate to stand. *Hardmuth* v. *Baker*, 22 R. P. C. 66, C. A.; but this is not always done, *e.g. Gillette Safety Razor Coy.* v. *Anglo-American Trading Coy.*, 29 R. P. C. 341.

The House of Lords, in *Morris* v. *Young*, 12 R. P. C. 465, doubted whether a certificate could be given where the action was dismissed, but the practice now seems well established.

(*k*) *New Inverted Incandescent Coy.* v. *Cope and Timmins*, 23 R. P. C. 103; *Same* v. *Globe Coy.*, 23 R. P. C. 157. See also *Jardine* v. *King*, 13 R. P. C. 411; *Martin* v. *Consett Iron Coy.*, 25 R. P. C. 27.

(*l*) There is no reported case where it has been granted by the House of Lords. It has frequently been granted by the Court of Appeal, *e.g. Birch* v. *Harrap*, 13 R. P. C. 615, C. A. It would seem that it can be granted by the Palatine Court. See Chancery of Lancaster Act (57 & 58 Vict. c. 16), s. 4. Prior to this Act the contrary was held in *Proctor* v. *Sutton Lodge Chemical Coy.*, 5 R. P. C. 184, but this decision was not followed in *Birch* v. *Harrap*, *supra*.

(*m*) *Haslam* v. *Hall*, 5 R. P. C. 144.

(*o*) *Peter Pilkington, Ltd.* v. *Massey*, 21 R. P. C. 697.

(*p*) *E.g. Edison and Swan Coy.* v. *Holland*, 6 R. P. C. 287.

(*q*) *E.g. Flour Oxidising Coy.* v. *Hutchinson*, 26 R. P. C. 597.

(*r*) *Pneumatic Tyre Coy.* v. *Chisholm*, 13 R. P. C. 488.

Solicitor and client costs were, however, given in this case. They had been claimed in the statement of claim, although the certificate had not been pleaded. In an old case Lord CAMPBELL, C.J., held that the proper course was to produce the record in the first case after the verdict in the second. *Newhall* v. *Wilkins* (1851), 17 L. T. (o. s.) 20; but see *Bovill* v. *Hadley* (1864), 17 C. B. (N. S.) 435.

issues in the second case are substantially different or if infringement only is in issue (*s*). It is not clear whether a certificate gives the patentee a right to solicitor and client costs if he has subsequently amended his patent (*t*). The right to solicitor and client costs does not extend to the costs of an appeal (*u*), or of a counterclaim for revocation (*x*).

Costs.

Costs on the higher scale.

Costs on the higher scale are frequently allowed in patent cases on the ground that scientific evidence has been necessary. But even in patent cases the allowance of such costs is the exception, not the rule, at the present day (*y*). These costs are allowed less frequently with regard to the proceedings on appeal, since the need for expert assistance is less (*z*), but they are sometimes given even there (*a*).

(*s*) See *Welsbach Incandescent Gas Light Coy.* v. *Daylight Coy.*, 16 R. P. C. 344; *United Telephone Coy.* v. *Townshend*, 3 R. P. C. 10; *Fabriques de Produits Chimiques de Thann* v. *Lafitte & Coy.*, 16 R. P. C. 61; *British Motor Syndicate, Ltd.* v. *Andrews*, 18 R. P. C. 577, C. A.; *United Telephone Coy.* v. *Patterson*, 6 R. P. C. 140; *British Vacuum Cleaner Coy., Ltd.* v. *Exton Hotels, Ltd.*, 25 R. P. C. 617; *United Telephone Coy.* v. *St. George*, 3 R. P. C. 321; *Automatic Weighing Machine Coy.* v. *Fearby*, 10 R. P. C. 442.

Solicitor and client costs have also been granted on judgment in default of appearance in *Saccharin Corporation* v. *Skidmore*, 21 R. P. C. 31, and on judgment in default of defence in *Saccharin Corporation* v. *Hopkinson*, 21 R. P. C. 272. On the other hand, they have been refused in *Otto* v. *Steel*, 3 R. P. C. 109; *Dunlop Pneumatic Tyre Coy., Ltd.* v. *Buckingham*, 18 R. P. C. 423; *Saccharin Corporation* v. *Dawson*, 19 R. P. C. 169; *Edison Bell Phonograph Coy.* v. *Waterfield, Clifford & Coy.*, 19 R. P. C. 329; *Automatic Weighing Machine Coy.* v. *National Exhibition Associations, Ltd.*, 8 R. P. C. 354. See also *Dunlop Pneumatic Tyre Coy., Ltd.* v. *Wilson*, 17 R. P. C. 332; *Same* v. *British and Colonial Coy.*, 18 R. P. C. 313; *Betts* v. *De Vitre* (1865), 11 Jur. (N. S.) 9. In *Dunlop Pneumatic Tyre Coy.* v. *New Ixion Tyre Coy.*, 15 R. P. C. 404, the plaintiffs were given solicitor and client costs on the issue of validity only.

(*t*) In *Brooks* v. *Rendell*, 24 R. P. C. 17, it was held that amendment destroyed the effect of the certificate for this purpose; in *Badische, &c.* v. *Thompson*, 21 R. P. C. 480, that it did not. If the former view is correct, the certificate as to certain claims being valid, *cf.* p. 199, *n.* (*g*), would seem to be useless.

(*u*) *Incandescent Gas Light Coy.* v. *De Mare Coy.*, 13 R. P. C. 579, C. A.

(*x*) *British Vacuum Cleaner Coy.* v. *L. & S. W. Ry. Coy.*, 27 R. P. C. 670.

(*y*) They were given very much more freely in earlier days. The principles of the allowance of such costs are discussed in *Gadd* v. *Mayor of Manchester*, 9 R. P. C. 535; *Ellington* v. *Clarke*, 5 R. P. C. 319, C. A.; *Dunlop Pneumatic Tyre Coy.* v. *Wapshare Coy.*, 17 R. P. C. 460; *Consolidated Pneumatic Tool Coy.* v. *Clarke*, 23 R. P. C. 666; *Marconi* v. *British Radio Telegraph Coy.*, 28 R. P. C. 181.

Where the necessity for such evidence arises from the faulty drafting of the patent, they should not be allowed to the plaintiff. *Wenham Gas Coy.* v. *Champion Gas Coy.*, 8 R. P. C. 313.

(*z*) *Automatic Weighing Machine Coy.* v. *Combined weighing Machine Coy.*, 6 R. P. C. 372, C. A.

(*a*) *E.g.* In *Kaye* v. *Chubb*, 4 R. P. C. 303; *Andrews' Patent*, 24 R. P. C.

Solicitor and client costs.

Solicitor and client costs have been allowed to a defendant authority under the provisions of the Public Authorities Protection Act in English cases (*b*), but have been refused in Scotland (*c*). These costs may also be given where the plaintiff has obtained a certificate of validity in a previous action (*d*).

Cost of different issues.

Where a defendant succeeds on one of the issues of infringement or invalidity and loses on the other, there is considerable diversity in the practice as to costs. Some judges have taken the view that a defendant is entitled to come "armed with sword and dagger" and that if the plaintiff fails to prove that the defendant has infringed his legal rights he should pay all the costs. In other cases the costs have been given according to the issues (*e*). In many cases the issues, though legally

349; *Ellington* v. *Clark*, 5 R. P. C. 319; *British Liquid Air Coy.* v. *British Oxygen Coy.*, 25 R. P. C. 577; *Consolidated Pneumatic Tool Coy.* v. *Clark*, 24 R. P. C. 593; but *cf.* *Chamberlain* v. *Bradford Corporation*, 17 R. P. C. 78.

(*b*) *Chamberlain* v. *Bradford Corporation*, 17 R. P. C. 70; *Chamberlain* v. *Bradford Corporation* (No. 2), 18 R. P. C. 455; *British Thomson Houston* v. *Manchester Corporation*, 20 R. P. C. 461.

(*c*) *New Conveyer Coy.* v. *Edinburgh, &c., Gas Commissioners*, 21 R. P. C. 147.

(*d*) See pp. 198 *et seq.*

(*e*) The following are some cases illustrating the diversities of practice.

Defendant succeeding on validity, no costs of infringement. *Philips* v. *Ivel Cycle Coy.*, 7 R. P. C. 77.

Defendant succeeding on infringement, no costs of issue of validity. *Needham* v. *Johnson*, 1 R. P. C. 49, C. A.; *Pilkington* v. *Massey*, 21 R. P. C. 712, C. A.

Costs of certain issues of validity to unsuccessful plaintiff. *Nordenfeldt* v. *Gardner*, 1 R. P. C. 75, C. A.; *Philpott* v. *Hanbury*, 2 R. P. C. 33; *Badische, &c.* v. *Levinstein*, 2 R. P. C. 73, C. A.; *Simmonds* v. *Hitchman*, 2 R. P. C. 117, *n.*; *American Braided Wire Coy.* v. *Thompson*, 4 R. P. C. 322; *Automatic Weighing Machine Coy.* v. *Knight*, 6 R. P. C. 120 and 306, C. A.; *Ungar* v. *Sugg*, 6 R. P. C. 337; *Tweedale* v. *Ashworth*, 7 R. P. C. 436; *Nobel's Explosive Coy.* v. *Anderson*, 11 R. P. C. 128; *Shoe Machinery Coy.* v. *Cutlan*, 13 R. P. C. 305; *Scott* v. *Hamling*, 14 R. P. C. 123; *Sunlight* v. *Incandescent*, 14 R. P. C. 757; *Leeds Forge* v. *Deighton*, 19 R. P. C. 285; *Sirdar Rubber Coy.* v. *Wallington*, 22 R. P. C. 257; *Robertson* v. *Purdey*, 24 R. P. C. 273; *Foden* v. *Wallis*, 25 R. P. C. 501. See also *Preston and Ralston's Patent*, 26 R. P. C. 313; *Atkinson* v. *Britton*, 27 R. P. C. 469. For older cases see *Losh* v. *Hague* (1839), W. P. C. 209. See also *Deeley's Patent*, 12 R. P. C. 200, C. A.; *Geipel's Patent*, 21 R. P. C. 391, C. A.

Plaintiff succeeding on validity and defendant on infringement, a set-off ordered. *Foden* v. *Wallis*, 25 R. P. C. 501.

Petitioner succeeding on only one case of anticipation given whole general costs. *Andrews' Patent*, 23 R. P. C. 441.

Costs of infringement to unsuccessful plaintiff. *Young* v. *Rosenthal*, 1 R. P. C. 29; *Badische, &c.* v. *Levinstein*, 2 R. P. C. 73, 117, C. A.; *Pooley* v. *Pointon*, 2 R. P. C. 165 (and certain issues as to validity); *Lister* v. *Norton*, 3 R. P. C. 199 (and certain issues as to validity); *Binnington* v. *Hill*, 8 R. P. C. 332; *Cassel Gold Extraction Coy.* v. *Cyanide Recovery Coy.*, 11 R. P. C. 652; *Fawcett* v. *Homan*, 13 R. P. C. 275; *Kane* v. *Guest*, 16 R. P. C. 433.

Costs of both issues to defendant succeeding on infringement. *Musgrave* v. *Hicks*, 3 R. P. C. 49; *Ellington* v. *Clarke*, 5 R. P. C. 328, C. A.; *Boyd* v. *Horrocks*, 6 R. P. C. 162, C. A.; *Heideman* v. *Smokeless Powder Coy.*, 15 R. P. C. 305; *New Inverted Coy.* v. *Globe Coy.*, 22 R. P. C. 431.

Where defendant succeeded on

distinct, are practically the same, and although the defendant may succeed on non-infringement he only does so by showing that any wide interpretation of the patent would render it invalid (*f*).

Where several patents sued on.

Where a plaintiff sues on two or more patents, succeeding as to some but failing as to others, the usual course is to give him the general costs of the action but to order him to pay any extra costs due to the inclusion of the patents on which he has failed (*g*).

Other points as to costs.

The question of whether costs of more than two counsel shall be allowed is usually left to the Taxing Master (*h*), but sometimes the Court gives directions on this point (*i*). Certain

non-infringement, and had a counter-claim for revocation which was not opened, both action and counter-claim were dismissed with costs. *Babcock and Wilcox, Ltd.* v. *Water Tube Coy.*, 27 R. P. C. 627.

Where a defendant first denied and then admitted a licence, but succeeded on non-infringement, he was given all the costs. *Ashworth* v. *Roberts*, 9 R. P. C. 89, 109.

Costs of both issues to defendant succeeding on invalidity. *Guilbert Martin* v. *Kerr*, 4 R. P. C. 18; *Kaye* v. *Chubb*, 4 R. P. C. 289; *Edison* v. *Holland*, 5 R. P. C. 483; *Blakey* v. *Latham*, 6 R. P. C. 184, C. A.; *Wesley Richards* v. *Perkes*, 10 R. P. C. 181; *Parkinson* v. *Simon*, 11 R. P. C. 256; *Binm* v. *Shoppee*, 28 R. P. C. 274, C. A.; *Donnersmarckhütte, &c.* v. *Electrical Construction Coy.*, 27 R. P. C. 774, C. A.

In some cases, though by no means always, the Court of Appeal have given no costs where the plaintiff appellant succeeds as to validity, but not as to infringement. *Cf. Moore* v. *Bennett*, 1 R. P. C. 129.

Sometimes an unsuccessful defendant has been given the costs of certain issues of infringement on which plaintiff failed. *Taylor* v. *Annand*, 17 R. P. C. 138, C. A.; *Mouchel* v. *Coignet*, 23 R. P. C. 665.

In some cases the whole costs have been apportioned where each party succeeded on some issues. *Monnet* v. *Beck*, 14 R. P. C. 777; *Dunlop Pneumatic Tyre Coy.* v. *New Ixion Coy.*, 15 R. P. C. 389.

Sometimes a party is given a portion of his costs. *Pneumatic Tyre Coy.* v. *Casswell*, 13 R. P. C. 189; *Incandescent Gas Light Coy.* v. *Sunlight Coy.*, 13 R. P. C. 333. See also *Consolidated Pneumatic Tool Coy.* v. *Clark*, 24 R. P. C. 593, C. A.

(*f*) It is submitted that where a defendant shows that what he is doing was old at the date of the patent he should be entitled to the whole of the costs, whichever issue he may succeed on.

(*g*) *Edison* v. *Woodhouse*, 3 R. P. C. 178; *Hocking* v. *Fraser*, 3 R. P. C. 7; *Sutcliffe* v. *Abbott*, 20 R. P. C. 50; *Badische, &c.* v. *Hickson*, 22 R. P. C. 63; *True and Variable Electric Lamp Syndicate* v. *Bryant*, 25 R. P. C. 461; *Crosthwaite Fire Bar Syndicate* v. *Senior*, 26 R. P. C. 733.

In some cases there is an apportionment of the whole costs. *Incandescent Gas Light Coy.* v. *Sunlight Coy.*, 13 R. P. C. 346. See also *Consolidated Pneumatic Tool Coy.* v. *Clark*, 24 R. P. C. 593.

Where a plaintiff succeeded on two patents in two actions against the same defendant, he was only given the costs he would have obtained if one action had been brought. *United Telephone Coy.* v. *Sharples*, 2 R. P. C. 28.

(*h*) *Andrews' Patent*, 24 R. P. C. 378, C. A.

(*i*) *E.g. Carnegie Steel Coy.* v. *Bell Bros.*, 26 R. P. C. 265 (three counsel for one defendant, two for another); *Wilson* v. *Wilson Bros. Bobbin Coy.*, 28 R. P. C. 741 (three counsel refused). Sometimes three counsel have been allowed in the Court of Appeal, *e.g. Huskell Golf Ball Coy.* v. *Hutchinson*, 23 R. P. C. 320.

costs of shorthand notes may be allowed (*k*). The costs of exhibits may be allowed even if they have not been put to witnesses (*l*), and such exhibits remain the property of the party using them, although the other party has to pay such costs (*m*). The costs of inspections, etc., may be allowed even where these have been made without a special order (*n*). The costs of experts in the Court of Appeal will in general not be allowed, and if it is desired to get these costs an application should be made to this Court (*o*). The successful party in the Court of Appeal will receive his costs without an undertaking from his solicitor unless special cause is shown (*p*). Where the plaintiff is a company whose assets consist practically of the patent in question security for costs may be ordered (*q*).

Certificates. Where any action for infringement, or petition under section 25 or counterclaim under section 32 for revocation, has proceeded to trial, the plaintiff shall not recover any costs on the issues raised in his particulars of breaches unless he obtains a certificate that he has proved them, and the defendant shall not get any costs of the issues raised by the particulars of objections unless he obtains a certificate that they were reasonable and proper (*r*). In cases where the action, etc., has not

(*k*) *British Westinghouse Coy.* v. *Braulik*, 27 R. P. C. 233, C. A. See also *Monnet* v. *Beck*, 14 R. P. C. 777; *Atkins and Applegarth* v. *Castner Kellner Coy.*, 18 R. P. C. 281; *Heidemann* v. *Smokeless Powder Coy.*, 15 R. P. C. 305; *Nordenfeldt* v. *Gardner*, 1 R. P. C. 61.

(*l*) *Wilson* v. *Wilson Bros. Bobbin Coy.*, *supra*.

(*m*) *Horrocks* v. *Stubbs*, 3 R. P. C. 220.

(*n*) *Ashworth* v. *English Card Clothing Coy.*, 21 R. P. C. 353; *Leeds Forge* v. *Deighton*, 20 R. P. C. 185.

(*o*) *Consolidated Pneumatic Tool Coy.* v. *Ingersoll Sergeant Drill Coy.*, 25 R. P. C. 574.

(*p*) *Cf. British Vacuum Cleaner Coy.* v. *L. & S. W. Ry. Coy.*, 28 R. P. C. 108, C. A.

(*q*) *Diamond Steel Coy.* v. *Harrison Brothers*, 27 R. P. C. 451.

(*r*) O. 53*a*, r. 22.

The application for these certificates should be made by the successful party at the hearing. If made later no costs of such application will in general be allowed. *Rowcliffe* v. *Morris*, 3 R. P. C. 145; *Duckett* v. *Sankey*, 16 R. P. C. 357.

The certificate may be granted by any Court, *e.g.* by the Court of Appeal (see *Castner Kellner Alkali Coy.* v. *Commercial Development Coy.*, 16 R. P. C. 276), or the House of Lords. See *Morris* v. *Young*, 12 R. P. C. 455.

In *Haskell Golf Ball Coy.* v. *Hutchinson*, 23 R. P. C. 320, where the defendant succeeded in both Courts, the Court of Appeal gave a certificate for further particulars not allowed by the judge below (see also *Deutsche Nahmachinen Fabrik* v. *Plaff*, 7 R. P. C. 259). It may be granted by a judge who has not tried the action. See *Rowcliffe* v. *Morris*, *supra*.

The Palatine Court has power to give these certificates. See Chancery of Lancaster Act, 1890 (57 & 58 Vict. c. 16), s. 4.

A plaintiff is entitled to the costs of proving the breaches unless unambiguous admissions have been made. *Bray* v. *Gardner*, 4 R. P. C. 400. See also *Badische, &c.* v. *Hickson*, 22 R. P. C. 63.

No certificate will be given where the plaintiff is not entitled to any costs. *Germ Milling Coy.* v. *Robinson*, 3 R. P. C. 260.

While a plaintiff has to *prove* his breaches, the defendant is entitled to a certificate if the objections are *reasonable and proper*. It is suggested that the proper criterion as to this is whether in the judge's opinion the defendant's advisers were justified in putting these objections forward in view of the case raised by the plaintiff in his pleadings, the character of the infringement, etc. See *New Inverted Coy.* v. *Globe Coy.*, 22 R. P. C. 431; *Jardine* v. *King*, 13 R. P. C. 411; *Philips* v. *Ivel Cycle Coy.*, 7 R. P. C. 77.

In general it is sufficient if they are reasonable and proper against any claim. *Cassel Gold Extracting Coy.* v. *Cyanide Gold Recovery Syndicate*, 12 R. P. C. 303, C. A.

Where the defendant proves that what he was doing was in fact old, it is submitted that the relevant particulars should in all cases be allowed, even if he succeeds on non-infringement, since the plaintiff's case must clearly have been based on a construction of the patent which would have covered what was in fact old.

As a general rule a Court will not give a certificate unless it is in a position to judge whether the particulars were reasonable and proper, nor will it hear evidence merely for this purpose. Where the plaintiff's case breaks down early, the defendant may therefore fail to obtain a certificate. *Mandleburg* v. *Morley*, 12 R. P. C. 35; *Dairy* v. *Bailey*, 8 R. P. C. 168; *Cole* v. *Saqui*, 5 R. P. C. 489; *Allen* v. *Pyatt*, 15 R. P. C. 723; *American Steel and Wire Coy.* v. *Glover*, 19 R. P. C. 111; *May* v. *Yuill*, 27 R. P. C. 526; *Badham* v. *Bird*, 5 R. P. C. 238; *Newsum* v. *Mann*, 7 R. P. C. 307; *Peters* v. *Owen Stone Coy.*, 15 R. P. C. 663. But see *Nuttall* v. *Hargreaves*, 8 R. P. C. 276.

It is not always necessary for particulars to be put separately, if plaintiff's witnesses admit the point. *Cooper* v. *London County Council*, 23 R. P. C. 289. See also *Germ Milling Coy.* v. *Robinson*, 3 R. P. C. 254; *Griffen* v. *Fever*, 6 R. P. C. 396.

The fact that the same particulars have been certified for in another action is not a reason for certifying. *New Inverted Coy.* v. *General Incandescent Coy.*, 22 R. P. C. 614; *Ashworth* v. *Horsfall*, 21 R. P. C. 47; *Cooper* v. *British Electric Coy.*, 23 R. P. C. 608. But *semble* proceedings in same action may be. *Ashworth* v. *Horsfall*, *supra*.

The former rule was that the Court of Appeal would not give a certificate unless they had gone into the case of invalidity. *Boyd* v. *Horrocks*, 6 R. P. C. 162, C. A. See also *Longbottom* v. *Shaw*, 6 R. P. C. 143, C. A.; but see *Castner Kellner Alkali Coy.* v. *Commercial Development Coy.*, 16 R. P. C. 270, C. A.; *Gillette Safety Razor Coy.* v. *Anglo-American Trading Coy.*, 29 R. P. C. 577, C. A.

In *Mouchel* v. *Coignet*, 24 R. P. C. 229, the Court of Appeal certified for such particulars as might be agreed, or in default of agreement settled by one of the judges.

An application may, however, be made to the judge of first instance for a certificate where the defendant has been successful on appeal. *Morgan* v. *Windover*, 7 R. P. C. 446. See also *Cropper* v. *Smith*, 2 R. P. C. 61.

Even where the defendant fails to obtain a certificate, the plaintiff does not get any costs of the particulars unless they are expressly given. *Garrard* v. *Edge*, 7 R. P. C. 130.

The Taxing Master may also allow proper costs of witnesses on other points, although they were primarily called on the issues raised by the particulars not included in the certificate. *Haskell Golf Ball Coy.* v. *Hutchinson*, 23 R. P. C. 125.

So also costs incurred as to prior specifications necessary to enable the judge to appreciate the state of prior knowledge for the purpose of construing the patent may be allowed by the Taxing Master without a certificate. *Piggott* v. *Hanley*, 23 R. P. C. 639. See also *Shoe Machinery Coy.* v. *Cutlan*, 12 R. P. C. 360; *Kelvin* v. *Whyte-Thomson*, 26 R. P. C. 734, O. H.; but sometimes a certificate is given for these: *Nettlefold* v. *Reynolds*, 9 R. P. C. 290; *Beavis* v. *Rylands*, 17 R. P. C. 93.

proceeded to trial (*s*) these costs remain in the discretion of the Taxing Master (*t*).

Contempt of Court.

The question frequently arises as to whether statements, made in the form of advertisements or otherwise during legal proceedings, as to the rights of the parties, or as to proceedings that are taking place in Court, constitute contempt of Court. The rule would seem to be that the existence of proceedings is no reason why the plaintiff should not continue the warnings that he will prosecute infringers (*u*), though he should not state that his success in the pending proceedings is certain or that the defendants have infringed (*x*). It is also a contempt of Court to make statements as to the invention being old (*y*).

With regard to accounts of proceedings that have taken place in Court a party is entitled to advertise these if the account is a true one, and if the proceedings have not been collusive. But any misrepresentation by the parties as to proceedings which have taken place in Court will be treated as a contempt (*z*), as may also be advertisements of proceedings which were in fact collusive, if another action is pending (*a*).

Where, however, both parties have written to the Press the Court will generally not interfere (*b*). It would seem that

(*s*) As to when an action has proceeded to trial, see *May* v. *Yuill*, 27 R. P. C. 526, where it was held that the action had proceeded to trial although the plaintiff did not appear at the hearing.

In *Thermos, Ltd.* v. *Isola, Ltd.* (unreported on this point), however, NEVILLE, J., held that where the plaintiff's counsel in opening had abandoned the case as to one of the patents sued on, the action with regard to this patent had not proceeded to trial.

Certificates for particulars have been given on judgment in default of appearance. *Saccharin Corporation* v. *Skidmore*, 21 R. P. C. 31, and in default of defence in *Brooks* v. *Hall*, 21 R. P. C. 29, and *Saccharin Corporation* v. *Hey*, 22 R. P. C. 212, where authorities are quoted.

(*t*) There is no reported case that throws light on what materials the Taxing Master will rely on, but see cases in note (*r*), *supra*, and *Bates* v. *Horsfall*, 22 R. P. C. 519. In general, when an action is discontinued by leave, these costs will be left to the Taxing Master. *Bibby and Baron, Ltd.* v. *Duerden*, 28 R. P. C. 305.

(*u*) *Fenner* v. *Wilson*, 10 R. P. C. 283, C. A.; *Dunlop Pneumatic Tyre Coy.* v. *Clifton Tyre Coy.*, 19 R. P. C. 527; *Haskell Golf Ball Coy.* v. *Hutchinson*, 21 R. P. C. 497. But see *Fusee Vesta Coy.* v. *Bryant and May*, 4 R. P. C. 191 (threats after application to amend). See also *St. Mungo Manufacturing Coy.* v. *Hutchinson*, 25 R. P. C. 326.

(*x*) *Gaulard and Gibbs* v. *Lindsay*, 4 R. P. C. 189; *Fenner* v. *Wilson*, *supra*.

(*y*) *Daw* v. *Eley* (1865), L. R. 1 Eq. 49. See also *British Vacuum Cleaner Coy., Ltd.* v. *Suctions, Ltd.*, 21 R. P. C. 303; *St. Mungo Manufacturing Coy.* v. *Hutchinson*, 25 R. P. C. 356, C. H.

(*z*) *Edlin* v. *Pneumatic Tyre Coy.*, 10 R. P. C. 317; *Gillette Safety Razor Coy.* v. *Gamage*, 24 R. P. C. 1.

(*a*) *Roberts* v. *Graydon* (1903), unreported.

(*b*) *Daw* v. *Eley* (1865), L. R. 1 Eq. 49. See also *De Mare's Patent*, 16 R. P. C. 527.

where an injunction is granted to restrain such contempts no undertaking as to damages need be given (*c*).

Injunction—Breach.

When a plaintiff has obtained an injunction against infringement he is entitled to raise the question of further infringement against the defendant, his servants or agents (*d*) by motion to commit for breach of the injunction, even if the infringement is of a substantially different character (*e*). It would seem, however, that it is not proper to raise the question in this way if the patent has been amended since the injunction, and, indeed, that such an amendment dissolves the injunction (*f*). Where the original injunction is held to be wrong and is dissolved, it would seem that the attachment proceedings fall with it (*g*).

When a breach of an injunction has been established an order may be made for the committal or attachment of the defendant, or, in the case of a limited company, an order for sequestration may be issued as well as orders for committal or attachment against the directors. In cases where the offence has been committed inadvertently or in ignorance of law or fact, the Court generally, instead of committing the defendant, orders him to pay the costs as between solicitor and client, and to make monetary compensation to the plaintiff (*h*). A motion for attachment or sequestration should only be made if there is

(*c*) See *Fenner* v. *Wilson*, *supra*.

(*d*) A person not a party to the former action, nor a servant or agent, will only be committed if he knowingly aids person enjoined not to infringe. *Incandescent Gas Light Coy.* v. *Sluce*, 17 R. P. C. 173. See also *Dudgeon* v. *Thomson* (1877), 3 A. C. 34, H. L., where the petition was to commit previous defendant and his partner.

(*e*) *Lancashire Explosives Coy.* v. *Roburite Explosives Coy.*, 13 R. P. C. 429, C. A., and 14 R. P. C. 303, H. L.; *Thomson* v. *Moore*, 7 R. P. C. 325, C. A. Ir.

Where an injunction was granted against dealing in "Victoria" lamps, KEKEWICH, J., held on a motion to commit for breach that if a lamp came within the class known as Victoria lamps it was immaterial whether it in fact infringed or not. The case was compromised on appeal. *Brockie Pell Coy.* v. *Johnson*, 17 R. P. C. 697. *Cf. Daw* v. *Eley* (1867), L. R. 3 Eq. 496.

In the same case he held that where certain lamps already sold on which damages were paid were excepted from the injunction, it was, nevertheless, a breach to buy them back and sell them again.

For cases where articles made according to a special process are excepted from the injunction, see *Spencer* v. *Ancoats Coy.*, 6 R. P. C. 46. See also *Roberts* v. *Graydon*, 21 R. P. C. 194.

(*f*) *Dudgeon* v. *Thomson*, *supra*.

(*g*) See *per* Lords HERSCHELL and MORRISON, in *Graydon* v. *Basset*, 13 R. P. C.

(*h*) See *inter alia*, *Welsbach Incandescent Coy.* v. *Keegan*, 17 R. P. C. 44; *Lyon* v. *Goddard*, 11 R. P. C. 113.

In *Spencer* v. *Ancoats Coy.*, *supra*, solicitor and client costs were not given.

In *Plimpton* v. *Spiller* (1877), 4 Ch. D., C. A., an interim injunction was granted.

In *Hattersley* v. *Hodgson*, 22 R. P. C. 229, an order for sequestration was

wilful disobedience to the order (*i*). The ordinary rule as to the evidence being served with the notice applies (*k*). There is an appeal when an order is made against the defendant (*l*).

Estoppel.

The circumstances under which parties are precluded from disputing the validity of Letters Patent because of their position as licensees (*m*) or assignors (*n*) has been discussed elsewhere, but certain other questions of estoppel arise in patent cases.

The point has several times been discussed how far the decisions on different issues act as an estoppel in a subsequent action between the same parties and their agents (*o*). Where a plaintiff has been successful further questions of infringement are usually tried on a motion to commit the defendants for breach of the injunction (*p*), when, of course, validity does not come into question, but if a separate action is started the defendant cannot challenge validity on any ground which would have been open to him in the first action (*q*). The

issued, but ordered to lie in the office until there was another infringement. The defendants appealed unsuccessfully, but solicitor and client costs of the appeal were not allowed. See also *Harvie* v. *Ross*, 4 R. P. C. 230, 1. H.

(*i*) *Meters, Ltd.* v. *Metropolitan Gas Meters*, 24 R. P. C. 506.

As to the position of persons, such as a ship's captain, who are under the necessity either of disobeying an injunction or neglecting their duty, see *Adair* v. *Young* (1879), 12 Ch. D. 21.

(*k*) O. 44, r. 1.

In *Spencer* v. *Ancoats Coy.*, *supra*, the Court of Appeal allowed the plaintiff to introduce fresh evidence. The point as to the necessity of copies of the evidence being served with the notice of motion does not seem to have been raised.

In *Badische, &c.* v. *Thomson*, 21 R. P. C. 460, C. A., where plaintiff had abandoned a motion to commit, a second motion for a breach prior to the first motion was dismissed.

(*l*) *E.g.* in *Bassett* v. *Graydon*, 14 R. P. C. 704, H. L., see generally O. 44, r. 1. It is very doubtful where the Court of Appeal would ever interfere with a refusal to commit. *Cf. Badische, &c.* v. *Thompson*, 21 R. P. C. 472, C. A.

(*m*) See p. 244.

(*n*) See p. 8.

(*o*) Of course agents mean agents in law, not merely what may be called agents in a particular trade. *Cf. Dunlop Pneumatic Tyre Coy.* v. *Rimington*, 17 R. P. C. 655, C. A.

Although there is no direct decision there can be little doubt that the estoppel would apply in the case of an action by the assignee of the patent.

(*p*) See p. 207.

(*q*) See *Brown* v. *Hastie*, 23 R. P. C. 360, H. L.; *Dunlop Pneumatic Tyre Coy.* v. *Rimington*, *supra*; *Thomson* v. *Moore*, 7 R. P. C. 325, H. L.

In *Goucher* v. *Clayton* (1865), 11 L. T. 732, where in an action judgment was allowed by agreement to go for the plaintiffs for 40*s.* damages, the plaintiffs agreeing to grant the defendants a licence for a certain term, it was held that in an action brought after the termination of the licence there was no estoppel by the previous judgment, as the judgment and licence were all part of one arrangement. In *Newall* v. *Elliot* (1863), 32 L. J. (EX.) 120, it was held that the award of an arbitrator finding generally that a patent was valid was not an estoppel on the question of validity in a subsequent action on another infringement.

It would be open to the defendant to raise objections which could not

decision on the issue of infringement binds the defendant only so far as concern articles identical, or substantially identical (*r*), with those in the former action. The fact that in the former action the patent was treated as one to be interpreted broadly does not prevent the defendant contending in a later action that its scope is restricted (*s*). But if the defendant was successful on the issue of non-infringement it would appear that the plaintiff could not sue for any infringement prior to the issue of the writ in the first action (*t*).

Where certain issues have been decided in favour of the plaintiff and certain others in favour of the defendant it would seem there may be an estoppel in the case of a further action against contesting these issues if the circumstances are identical (*u*). It is very doubtful how far this is the case where the patent has been amended in the interval (*x*).

Questions have also arisen as to how far parties who have allowed infringement to continue, or induced it by their acts, are estopped from claiming relief. There is no case where such estoppel has been established so as to bar all relief unless the plaintiff or his agent was actually a party to the acts in question (*y*).

have been raised in the prior action, *e.g.* that the patent had lapsed, or was invalid on the ground of the manufacture *now* being carried on wholly abroad, or because of contracts made since the date of the previous action containing terms repugnant to *s.* 38.

(*r*) See *Thomson* v. *Moore*, 7 R. P. C. 325, 334, H. L.; *Same* v. *Hughes*, 7 R. P. C. 71.

(*s*) *Brown* v. *Hastie*, 23 R. P. C. 361, H. L. See also *Dudgeon* v. *Thomson* (1877), 3 A. C. 34, H. L.

In *Brown* v. *Hastie*, *supra*, the defendant in the second action referred to prior specifications to limit the construction of the patent. These were not considered in the House of Lords.

(*t*) *Cf. Badische, &c.* v. *Thompson*, 21 R. P. C. 471.

(*u*) Where in one action the Court decided that a patent was valid, but had not been infringed, it was held that in a second action on a different infringement the defendant could not attack validity. *Shoe Machinery Coy.* v. *Cutlan*, 13 R. P. C. 141.

(*x*) See *Horrocks* v. *Stubbs*, 13 R. P. C. 69, C. A.; *Deeley's Patent*, 11 R. P. C. 716; 12 R. P. C. 199, C. A. *Westinghouse* v. *Lancashire and Yorkshire Ry. Coy.*, 1 R. P. C. 229.

(*y*) See *Procter* v. *Bennis*, 4 R. P. C. 333, C. A.

As to delay barring right to special relief, see *Thomson* v. *Moore*, 6 R. P. C. 426, C. A. Ir. See also *Siddell* v. *Vickers*, 5 R. P. C. 100, and cases at p. 192, *n.* (*n*), and p. 162, *n.* (*y*).

CHAPTER XI

REVOCATION

A PETITION for the revocation of Letters Patent may be presented by the following persons (*a*)— Who may petition.

(1) The Attorney-General or any person authorised by him (*b*).

The Attorney-General's fiat is not granted as a matter of right (*c*), but is generally granted if the petitioner is a responsible person who shows an interest in obtaining the revocation and makes out a *primâ facie* case (*d*). It will be granted

(*a*) Sect. 25. The defendant in an infringement action who would be entitled to petition may also proceed by way of counterclaim: s. 32.

(*b*) In Scotland the procedure is by an action of reduction at the suit of the Lord-Advocate or some person interested authorised by him: s. 94 (3). Even where this authority has been given the action will be dismissed unless the pursuer can show a personal interest, *Melville* v. *Cummings*, 29 R. P. C. 100 O. H.; reversed on facts, 29 R. P. C. 665, I. H. It would seem that in Ireland the Attorney-General for Ireland can grant the fiat though the point is not clear: s. 95.

(*c*) See *R.* v. *Prosser* (1848), 18 L. J. (CH.) 35.

(*d*) The fact that the applicant is an *alien ami* is no bar to the fiat being granted. *R.* v. *Prosser*, *ubi supra*.

The procedure for obtaining the fiat is as follows:—

The following documents have to be lodged with the Law Officer's chief clerk, Law Courts:—

(i) Memorial asking for fiat signed by party applying, or in the case of a firm by a partner on its behalf. In the case of a company this must be under seal.

(ii) Statutory declaration that statements in memorial are true, to be made by the parties signing the memorial, or in the case of a company by the secretary or other proper officer able to verify the statements.

(iii) Two copies of proposed particulars of objections.

(iv) Two copies of proposed petition; *or* of defence and counter-claim.

(v) In an action one copy of Pleadings so far as they have gone.

(vi) Certificate of counsel that it is a fit and proper case for the fiat to be granted.

(vii) Certificate of solicitor that the petitioner is a fit and proper person to petition, and is able to answer all costs in connection with the same.

(viii) A short statement showing in what respects the inventions described in the specifications referred to in the particulars of objections resemble those in the Letters Patent sought to be revoked.

A fee of £2 13*s.* 4*d.* has to be paid and the declaration must bear a 2*s.* 6*d.* impressed stamp.

All information, etc., has to be written on judicature paper on one side only, and all papers are to be headed:

to enable a defendant to claim revocation by way of counter-claim (*e*), and may be granted even if the patent has expired (*f*).

(2) A person alleging that he or some person under or through whom he claims was the first and true inventor. The question of who is the first and true inventor is dealt with elsewhere (*g*). There is no reported decision of the High Court as to what is covered by the words "under or through whom he claims," but a mere power of attorney does not give a person a locus to petition (*h*).

(3) A person alleging that the patent has been obtained in fraud of his rights or of the rights of some person under or through whom he claims. Fraud here, as ordinarily, implies a dishonest action of some kind, and a mistake honestly made does not give rise to any claim under this head, nor will the Court consider whether a party, who has acted honestly, has correctly interpreted his legal rights (*i*). The fraud must be proved conclusively, and the Court is not ready to infer it (*k*). On the other hand the Court will look at the conduct of the patentee subsequent to the application for the patent, as throwing light on his motives, and the fact that the petitioner has acquiesced in the patentee's obtaining the patent will not prevent his

"In the Matter of the Patents and Designs Act, 1907,
In the Matter of Patent No. ."
and in the case where the proposed petition is to be by way of counter-claim the style of the action is also to be added.

(*e*) *E.g.* in *British Vacuum Cleaner Coy., Ltd.* v. *L. & S. W. Rail. Coy.*, 27 R. P. C. 649.

(*f*) *North-Eastern Marine Engineering Coy., Ltd.* v. *Leeds Forge Coy., Ltd.*, 23 R. P. C. 96 and 529, C. A.

(*g*) See Chapter IV., pt. 1. In *Walker* v. *Hydrocarbon Syndicate*, 1 R. P. C. 37, the respondent was allowed to refer to prior specifications to show that the petitioner had not made the invention or to limit his claims, see also p. 266, *n.* (*a*).

(*h*) *Avery's Patent*, 4 R. P. C. 152; but see *Gascoigne's Patent*, 27 R. P. C., 78 C. G., where it was held to mean only executors and administrators.

(*i*) *Avery's Patent*, 4 R. P. C. 165 and 322, C. A.; *Jackson's Patent*, 22 R. P. C. 387; *Marks's Patent*, 25 R. P. C. 553; *Preston and Ralston's Patent*, 26 R. P. C. 313.

(*k*) *Marks' Patent, supra.*

The following are cases where fraud was held to be proved:—

Haddan's Patent, 2 R. P. C. 218; *Gale's Patent*, 8 R. P. C. 438; *Norwood's Patents*, 12 R. P. C. 214; *Norwood's Patents* (*No.* 2), 15 R. P. C. 98; *Marshall and Naylor's Patent*, 17 R. P. C. 553; *Smith's Patent*, 22 R. P. C. 57; *Preston and Ralston's Patent*, 26 R. P. C. 313.

In the case of *Norwood's Patent* (*No.* 2), *supra*, a second patent for a mere offshoot from the invention made by the petitioner which he would have been entitled to include in the first patent, which it was proved had been obtained in fraud of his rights, was ordered to be revoked.

In the following cases fraud was held not to be proved:—

Avery's Patent, supra; Marks's Patent, supra; Jameson's Patent, 19 R. P. C. 246; *Scott's Patent*, 20 R. P. C. 257; *Jackson's Patent*, 22 R. P. C. 384.

succeeding if fraud is proved (*l*). It is not necessary that all the patentees should have been parties to the fraud (*m*).

Where it is proved that part of the invention has been obtained in fraud of the petitioner the patentee will not in general be given an opportunity of amending by disclaimer, but the patent will be revoked (*n*).

This ground is quite distinct from the ground that the petitioner is the true and first inventor, and if the petition only alleges fraud the petitioner will not be allowed to try the question of true and first inventor (*o*).

As the importer of an invention is the inventor within the meaning of the Statute of Monopolies (*p*) the Court does not consider the question of fraud abroad (*q*).

(4) A person alleging that he, or some person under or through whom he claims an interest in any trade business, or manufacture, had publicly manufactured used or sold within this realm prior to the date of the patent anything which the patentee claims as his invention.

It would seem that where the petitioners' title is a derived one the user by his predecessors must have been in the course of the business, etc., to which the petitioner has succeeded. It is necessary for the petitioner to show strictly that the claim covers that which he has done, the grounds are much narrower than those on which subject-matter can be attacked (*r*).

Grounds for revocation.

Any person petitioning may rely on any ground on which the patent might immediately before January 1, 1884, have been repealed by *scire facias*, *i.e.* on any of the ordinary grounds of objection to Letters Patent, and may also allege that the invention has not been worked to a sufficient extent in this country, or that there are grounds on which the patent might be revoked as an alternative to the grant of a compulsory license (*s*). It would seem, however, although the point has

(*l*) *Ralston's Patent*, 26 R. P. C. 313. See also *Marshall and Naylor's Patent*, 17 R. P. C. 533.

(*m*) *Ralston's Patent*, *ubi supra*.

(*n*) *Ralston's Patent*, *ubi supra*; *cf. Norwood's Patent* (*No.* 2), *ubi supra*.

(*o*) *Avery's Patent*, *ubi supra*.

(*p*) See Chapter IV., pt. 1.

(*q*) *Avery's Patent*, *ubi supra*, and see pp. 73, 74. As to equitable relief see p. 73, *nn.* (*q*) and (*r*).

(*r*) *Dege's Patent*, 12 R. P. C. 448, 452. See also *Mark's Patent*, 25 R. P. C. 553. For a case where this ground was established, see *Sinnette's Patent*, 15 R. P. C. 761.

(*s*) Sect. 25, and *Morgan's Patent*, 5 R. P. C. 186, 187. See NON-WORKING, Ch. XVI., and COMPULSORY LICENSES, p. 251.

Grounds of defence based on the provisions of s. 38 (restrictive conditions), see p. 248, cannot be relied on by a petitioner. It would seem that the grounds mentioned are the only grounds for such a petition, and that

never been definitely decided, that unless the Petitioner establishes those facts which give him a *locus standi* the petition will be dismissed (*t*). It is therefore safer in all cases to obtain the fiat of the Attorney-General.

Parties. There may be more than one petitioner, but in general they cannot sever and be separately represented, though this has been permitted by consent (*u*). The petitioner may be ordered to give security for costs in cases coming within the rules (*x*).

All parties beneficially interested should be made parties to the petition, and if the interest appears from the petition or the register the Court will insist on this being done (*y*). In the case of other persons who are not made parties having an interest the Court will usually allow them to appear (*z*), but if the patent be revoked in their absence they apparently have no remedy. It is no longer necessary to join persons whose interest has ceased, and the Court will probably exercise its old jurisdiction in the case of a *scire facias* to protect persons who have been unnecessarily joined (*a*).

In the case of a patentee residing abroad the general course has been to direct notice of the petition to be sent to him, and for the case to go into the witness list. If the patentee does not then appear the case proceeds in his absence (*b*). A

other grounds, *e.g.* that the patent was taken out to defeat an Act of Parliament, cannot be used. *Vaisey's Patent*, 11 R. P. C. 591, 593. This point, however, would not seem free from doubt. For a case in which the objection that the object of the patented invention was illegal was raised, see *Pessers* v. *Hayden*, 26 R. P. C. 60.

(*t*) *Dege's Patent*, 12 R. P. C. 448. *Max Muller's Patent*, 24 R. P. C. 465. In these cases, and also in *Jameson's Patent*, 19 R. P. C. 246, the petitioner was allowed to obtain the fiat and amend his petition accordingly. See *contra*, *Morgan's Patent*, 5 R. P. C. 187.

(*u*) *Norwood's Patent*, 12 R. P. C. 214.

(*x*) See O. 65, r. 6 *n*, "Petitioner." Where the fiat is obtained terms as to security may be imposed.

(*y*) *Avery's Patent*, 4 R. P. C. 159.

If two respondents are served and are separately represented, they are each entitled to costs, although one may have taken no part in the case. *Brown's Patent*, 24 R. P. C. 346.

(*z*) *Miller's Patent*, 15 R. P. C. 205.

In *Haddan's Patent*, 2 R. P. C. 218, the patentee had assigned after the petition, and the new patentee was allowed to be substituted for the old on terms as to security for costs. See also *Golstein's Application*, 27 R. P. C. 289, C. G., p. 291.

(*a*) See *R.* v. *Betts* (1850), 19 L. J. (Q. B.) 531.

(*b*) *Drummond's Patent*, 6 R. P. C. 576; *Kay's Patent*, 11 R. P. C. 279, following the practice adopted in a Trade Mark case. *In the Matter of Frederick King & Coy.'s Trade Mark*, 9 R. P. C. 350, C. A.; *Hirschfield's Patent*, 11 R. P. C. 514; *Goertz und Hoegh's Patent*, 12 R. P. C. 370; *Cerckle's Patent*, 15 R. P. C. 500.

It should be noted that in *Drummond's Patent*, *ubi supra*, the patentee was resident in Scotland, and the right was reserved to him to object to the jurisdiction.

In *Kay's Patent*, *ubi supra*, special directions were given that case should not come on for hearing in

respondent out of the jurisdiction will not be ordered to give security for costs (*c*).

A petition can be presented to any division of the Court, and may be transferred from one division to another (*d*). Procedure.

A patent can only be revoked in open Court (*e*), and the patentee has in all cases the right to have the case heard on oral evidence (*f*). In many cases, however, the patent has been revoked by consent (*g*), or on evidence by affidavit (*h*), and the patentee can also at any time offer to abandon the patent (*i*).

The order for revocation is as a rule made with costs even where there is no opposition (*k*). Generally where fraud is alleged the costs of this issue are dealt with separately (*l*).

The petition should not be put into the witness list till it is ready to come on as an effective cause (*m*).

The onus is on the petitioner to prove his grounds for revocation (*n*), but the patentee always has the right to begin (*o*), although he may waive such right (*p*).

the absence of the foreign patentee, without leave from the judge.

The Patent Rules provide for the registration of an address for service by foreign applicants and patentees, see r. 8, and as to service of proceedings at such address, see *Smollen's Trade Mark*, 29 R. P. C. 158.

(*c*) *Miller's Patent*, 11 R. P. C. 55.

(*d*) *Edmund's Patent*, 6 R. P. C. 355; *Edge's Patent*, 8 R. P. C. 74.

In fact such petitions are now always presented to the Chancery Division. They are not necessarily assigned to the Special Judge. See Patent and Designs Act, 1908 (8 Ed. VII, c. 4), s. 1.

(*e*) This order will not be made in Chambers even by consent, *Clifton's Patent*, 21 R. P. C. 515. The remarks of JOYCE, J., in *Scott's Patent*, 20 R. P. C. 604, did not mean that this could be done, see *per* BUCKLEY, J., in *Clifton's Patent*, *ubi supra*. See also *Dawson's Patent*, 24 R. P. C. 140.

(*f*) *Gaulard and Gibb's Patent* (1887), 34 Ch. D. 396.

(*g*) It is not necessary for the patentee to be separately represented, *Clifton's Patent*, *ubi supra*, or apparently to be represented at all, *Simmon's Patent*, 12 R. P. C. 446.

This order may be made on application for directions. *Simmon's Patent*, *ubi supra*; *Wallace's Patent*, 12 R. P. C. 444; *Vaisey's Patent*, 11 R. P. C. 591; *Kay's Patent*, 11 R. P. C. 279; *Sleight's Patent*, 10 R. P. C. 447.

(*h*) *Slingsby's Patent*, 27 R. P. C. 524; *Vaisey's Patent*, 11 R. P. C. 501; *Lee's Patent*, 23 R. P. C. 233.

(*i*) Sect. 26 (4).

(*k*) *Scott's Patent*, 20 R. P. C. 604; *Scott's Patent*, 19 R. P. C. 280; *Simmon's Patent*, *ubi supra*; *Wallace's Patent*, *ubi supra*; *Rendell's Patent*, 11 R. P. C. 277; *Sleight's Patent*, 10 R. P. C. 447, and even if no notice was given of the intention to present the petition, *Aylott's Patent*, 28 R. P. C. 228; *Merryweather's Patent*, 29 R. P. C. 64. These costs include costs of obtaining fiat. *Poulton's Patent*, 23 R. P. C. 571; but see *Rendell's Patent*, *ubi supra*.

In *Slingsby's Patent*, 27 R. P. C. 524, the order was made without costs on the ground that the petitioners had themselves suggested to the respondents that they should take out the patent.

(*l*) *E.g. Scott's Patent*, 19 R. P. C. 280.

(*m*) *Borrowman's Patent*, 19 R. P. C. 159; *Scott's Patent*, 19 R. P. C. 273.

(*n*) *Cf. inter alia*, *Jameson's Patent*, 19 R. P. C. 246. This was also so in *scire facias*. *R.* v. *Cutler* (1847), 3 Car. & K. 215.

(*o*) O. 53*a*, r. 12.

(*p*) *E.g. Edmond's Patent*, 6 R. P. C. 55.

No estoppel against petitioner.

As the petitioner is considered to be acting in a public capacity neither he nor the patentee is estopped by a decision in a previous action (*q*). Consequently the Court would in general not interfere with the trial of a petition on the ground of other proceedings or appeals being pending, but such an order has been made on agreed terms (*r*). There are no decisions showing how far the petitioner may be estopped by his conduct (*s*).

An unsuccessful petitioner can also apparently petition again on fresh grounds (*t*).

Order and appeal.

Of course an order for revocation puts an end to an injunction and all other rights depending on the patent. It does not, however, affect a claim for past royalties or for damages under an order already made, whether such damages are ascertained or not (*u*).

If an order is made revoking the patent it is the common course to stay such order pending an appeal (*x*).

Grant of fresh patent.

Where the petitioner establishes that the patent has been obtained in fraud of his rights the comptroller may, on the application of the true inventor, grant him a patent in lieu of and bearing the same date as the patent so revoked, but no action shall be brought for any infringement committed before the actual date when such patent was granted (*y*).

(*q*) Thus an unsuccessful defendant may petition for revocation. *Deeley's Patent*, 12 R. P. C. 102; *Jameson's Patent*, 19 R. P. C. 246, 252; *Poulton's Patent*, 23 R. P. C. 183. There is no decision as to whether this applies to a counter-claim.

So a decision in an action as to a patent covering a particular machine does not bind the Court on a subsequent petition, except that it may, as a decision on a pure point of construction, bind a Court of equal jurisdiction. *Lewis and Sterckler's Patent*, 14 R. P. C. 24.

(*r*) *E.g. Hitchcock's Patent*, 20 R. P. C. 767.

(*s*) *E.g.* if he is assignor of patent. The motives of the petitioner would seem to be unimportant *cf. Taylor's Patent*, 28 R. P. C. 296.

In *Brown's Patent*, 25 R. P. C., at p. 111, C. A., statements made by the petitioner (who was not called) in a provisional specification were taken against him, and this evidence would only seem to be relevant on the ground of estoppel.

Formerly the Court would stay a *scire facias* pending an appeal in an action. *R.* v. *Neilson* (1842), W. P. C. 673.

In *Scott's Patent*, 24 R. P. C. 100, an order was made by consent that unless an appeal in a patent action was successful the patent should be revoked with costs, if it was successful the petition should be dismissed with costs.

(*t*) *Avery's Patent*, 4 R. P. C. 152, 166.

(*u*) *Poulton* v. *Adjustable Boiler Coy.*, 25 R. P. C. 529, 661, C. A.

(*x*) *E.g. Poulton's Patent*, 23 R. P. C. 183.

Terms may, however, be imposed; thus in this case it was made a term of granting a stay that an injunction obtained by the respondent against the petitioner should be suspended. For other instance of special terms, see *Alsop's Patent*, 24 R. P. C. 733.

(*y*) Sect. 15. Where only part of the invention has been obtained from the petitioner the declaration is

In the case of a petition to the Court for revocation there is an unrestricted right of appeal (*z*).

Where open petition is proper remedy.

Where there is a remedy by way of petition for revocation the Court will not entertain an action asking for a declaration that the patent is bad, or that a state of facts exist that would justify revocation (*a*). But a petition may be presented even after the patent has expired (*b*).

Points of practice.

The practice in regard to giving particulars of objection and obtaining certificates for the same (*c*), amendment of the specification during proceedings (*d*), and the course of procedure generally, is identical with that in infringement actions (*e*). The provisions as to certificate of validity, and the consequences as to costs, apply only to actions for infringement and not to proceedings for revocation (*f*).

only as to that part. *Ralston's Patent, ubi supra.*

(*z*) Patent and Designs Act, 1908 (8 Ed. VII. c. 4), s. 1.

(*a*) *North Eastern Marine Engineering Coy., Ltd.* v. *Leeds Forge, Ltd.*, 23 R. P. C. 529, C. A.; *Traction Corporation* v. *Bennett*, 25 R. P. C. 819.

In the latter case the Court held that an allegation of fraud, not amounting to fraud actionable at Common Law, but which might form grounds for a petition for revocation, gave no right to damages or an injunction against dealing with the patent.

(*b*) See cases in last note. However, in *Ludlow's Patent*, 29 R. P. C. 616, where the petition had been presented after the patent had lapsed it was dismissed with costs. The object of such a petition is, of course, to prevent claims for past breaches.

(*c*) O. 53*a*, rr. 11–22.

(*d*) See Chapter on AMENDMENT.

(*e*) The petition may be amended from time to time with the leave of the Court. For cases where amendment has been allowed see *Avery's Patent*, 4 R. P. C. 159; *Dege's Patent*, 12 R. P. C. 452; *Jameson's Patent*, 19 R. P. C. 246; *Max Muller's Patent*, 24 R. P. C. 465.

For cases where it has been refused see *Avery's Patent*, 4 R. P. C. 328, C. A.

Amendments of the particulars are allowed on the ordinary terms, see Chapter on PRACTICE, pp. 175 *et seq.*, and O. 53*a*, r. 19.

(*f*) Sect. 35.

CHAPTER XII

THREATS

A PERSON who is aggrieved by statements to the effect that he is infringing a patent may have one or more of three remedies. Remedies for threats.

Firstly, he may rely on his common law rights and bring an action on the case on the ground that the defendant has maliciously made untrue statements which have caused, or must inevitably cause, actual damage to him. This action lies against any person, whether he purport to be a patentee or not, but the plaintiff must establish the three necessary points, viz. untrue statements, malice, and actual damage. Since this burden lies on the plaintiff, and the Court is not asked to presume either malice or damage, there is probably no limitation to the form of statement which will give a cause of action, such as there is in the case of an action founded on section 36 of the Act. Common law remedy.

On the first point the plaintiff must prove publication by the defendant or his agent of the statement complained of, and that such statement was untrue in fact. In cases where such statement involves the fact that certain Letters Patent are valid the plaintiff may have to attack their validity (*a*). Untrue statement.

The plaintiff has also to prove actual malice (*b*), *i.e.* that the statements were made without any belief in their truth, and Malice.

(*a*) *Cf. Wren* v. *Wild* (1869), 38 L. J. (Q. B.) 88. As the onus of proving invalidity is on the plaintiff he has the right to begin and reply, *ibid.*

(*b*) *Colley* v. *Hart*, 7 R. P. C. 101, 112; *Halsey* v. *Brotherhood* (1881), 19 Ch. D. 386, 388, 390, C. A.; *Wren* v. *Wild* (1869), 38 L. J. (Q. B.) 327; *Gillespie* v. *Young* (1867), 3 S. IV. 715, H. L.; *Burnett* v. *Tate* (1882), 45 L. T. 743; *Sugg* v. *Bray*, 2 R. P. C. 223 (where authorities are collected); *Brauer* v. *Sharp*, 3 R. P. C. 193, 197; *Herrburger Schwander et Cie* v. *Squire*, 5 R. P. C. 581; *Incandescent Gas Lighting Coy.* v. *Sunlight Coy.*, 14 R. P. C. 180; *Temler* v. *Stevenson*, 15 R. P. C. 24; *Cars* v. *Bland Light Syndicate, Ltd.*, 28 R. P. C. 33.

In *Cars* v. *Bland Light Syndicate, Ltd.*, *supra*, at p. 38, WARRINGTON, J., held that knowingly false statements, not referring to the patents, contained in the circulars complained of

with the knowledge that they might be injurious to some person, though it is probably not necessary to show that the defendant had any feeling of hostility against the actual plaintiff (*c*). Absence of any reasonable or probable ground for making the statement would only be evidence on this issue, though in some cases it might make it so impossible to believe that the statement complained of had been made *bonâ fide* that the Court would act on this evidence alone (*d*).

In the case of statements made by an agent of the party sued presumably the same rules would apply as in actions for deceit (*e*), or for libel where there is qualified privilege (*f*).

Actual damage.

Proof of actual damage is essential, and only such damages can be recovered in an action on the case (*g*).

were evidence of malice. He also held that the object of the circulars being to stop the plaintiff's trade they were malicious. But as to the last point, see *Halsey* v. *Brotherhood* (1881), 19 Ch. D., at p. 388, C. A.; *cf.* also *Mellin* v. *White*, [1895] A. C. 154; *Montgomery* v. *Paterson*, 11 R. P. C. 237 O. H.

Some of the earlier cases, such as *Dick* v. *Brooks* (1880), 15 Ch. D. 22, C. A., would seem to suggest that if the patentee mis-stated his rights even honestly, it would give a cause of action, but this case is explained in *Halsey* v. *Brotherhood*, *supra*, at p. 391.

See also generally cases where actual malice must be proved, *e.g.* trade libel (*Mellin* v. *White*, [1895] A. C. 154, H. L., *Royal Baking Powder Coy.* v. *Wright, Crossley & Coy.*, 18 R. P. C. 95, 99, H. L.), slander of title (*Malachy* v. *Soper* (1836), 3 Bing. N. C. 371), and cases of qualified privilege.

The Equity Courts seem to have taken a wider view of their powers where only an injunction was sought, see *Rollins* v. *Hinks* (1872), L. R. 13 Eq. 355. *Axman* v. *Lund* (1874), 43 L. J. (CH.) 655; *Burnett* v. *Tate*, *supra*, but these decisions are hardly reconcilable with the judgments in *Mellin* v. *White*, *supra*.

In *Burnett* v. *Tate*, *supra*, it was held that though threats had been uttered *bonâ fide*, an injunction might be granted against their repetition, but in *Sugg* v. *Bray*, *supra*; *Brauer* v. *Sharp*, *supra*, it was held that if the plaintiff had believed the statements when made, the fact that he had sought to justify them at the trial was no evidence that he would repeat them once it had been decided that they were not justified.

(*c*) *Halsey* v. *Brotherhood* (1881), 19 Ch. D., *per* BAGGALAY, L.J., at p. 391.

This would seem to agree with the rule laid down by BRETT, L.J., in *Henty* v. *Capital and Counties Bank* (1880), 5 C. P. D., at p. 540, that where a statement is not *primâ facie* libellous it is necessary to show that the defendant knew of the circumstances that made it libellous. It is probably unnecessary to show that the statements made were intended to injure the actual plaintiff, *cf.* *Jones* v. *Hulton*, [1910] A. C. 20.

(*d*) *Cf.* *Palmer* v. *Hummerston* (1883), Cab. & Ell. 36.

As to absence of reasonable cause for believing not necessarily being proof of *mala fides*, see *Derry* v. *Peek* (1889), 14 A. C. 337; *Hicks* v. *Faulkner* (1881), 8 Q. B. D. 167.

(*e*) *E.g.* *Barwick* v. *English Joint Stock Bank* (1867), L. R. 2 Ex. 259.

(*f*) *E.g.* *Citizens Life Assurance Coy., Ltd.* v. *Brown*, [1904] A. C. 423, P. C.

(*g*) *Mellin* v. *White*, [1895] A. C. 154; *Dicks* v. *Brooks* (1880), 15 Ch. D. 22 C. A.

General loss of trade may, of course, constitute such damage: *cf.* *Ratcliffe* v. *Evans*, [1892] 2 Q. B. 524, C. A. See also *Skinner* v. *Perry*, 11 R. P. C. 406.

It would, however, seem that if the practical certainty of damage if the threats are not restrained is established an injunction might be granted (*h*).

There is also a remedy at Common Law for a licensee who is being interfered with by threats on the part of the licensor (*i*). Remedy of licensee.

The second course open to the person aggrieved is the possible remedy offered by section 4 of the Statute of Monopolies. There is no record of any action of this kind till the subject was discussed in a recent case (*k*). There seems some doubt whether mere threats would give a cause of action, and also whether the section applies to actions brought for the enforcement of patent rights (*l*). Action on statute of monopolies.

Thirdly, there is the statutory remedy (*m*) open to any person aggrieved (*n*) by threats of legal proceedings or liability in respect of alleged infringement of a patent. This action only lies against a person who, either by himself or his agents, has both threatened and claimed to be a patentee—it does not lie, for example, against a person claiming to be a licensee (*o*). Statutory remedy.

(*h*) *Cf. Darley Main Colliery Coy.* v. *Mitchell* (1887), 11 A. C., *per* Lord BRAMWELL, at p. 145.

(*i*) See *Clark* v. *Adie* (1873), 21 W. R. 456, 754; *Societé Anonyme des Manufactures de Glace* v. *Tilghmann* (1883), 25 Ch. D. 21 C. A.

(*k*) 21 Jac. 1, c. 3, s. 4. This section in effect provides that a person who is injured by a pretext of a monopoly shall have an action for three times the damage suffered and double costs.

(*l*) *Peck* v. *Hindes*, 15 R. P. C. 113. In this case the plaintiff relied on former unsuccessful patent proceedings which had been brought against him. MATHEW, J., doubted whether bringing an action in good faith could ever subject the plaintiff to further consequences than costs, and also seemed of opinion that the sixth section excepted patents purporting to be for new inventions from the operation of s. 4, whether or no they were valid. He, however, decided for the defendant on the ground that the patent having been since rendered valid by amendment the effect of s. 18 (9) of the Act of 1883 (s. 21 (7) of the present Act) was to render it valid from the first, and so bring it within the exception of the sixth section of the Statute of Monopolies.

With regard to the suggestion of the learned judge that patents purporting to be for new inventions came within the exception of s. 6, whether valid or not, it should be remembered that the validity is usually tested by considering whether the patent comes within this exception.

(*m*) Sect. 36.

(*n*) A wide view has been taken of the meaning of the word "aggrieved," and any person who finds himself hampered by threats would seem to have a remedy. See *Burt* v. *Morgan*, 4 R. P. C. 278; *Hoffnung & Coy.* v. *Salisbury*, 16 R. P. C. 375; *Johnson* v. *Edge*, 9 R. P. C. 142.

The mere fact that a plaintiff might have a legal remedy against a customer, who refuses to perform a contract by reason of the threats, does not prevent his being aggrieved. *Hoffnung & Coy.* v. *Salisbury*, *supra*.

(*o*) *Temler* v. *Stevenson*, 15 R. P. C. 24.

In *Overton & Coy.* v. *Burn, Lowe & Sons*, 13 R. P. C. 455, the patentee was resident abroad and the threats were made by his solicitors. KEKEWICH, J., seemed to be of opinion that an action did not lie against these defendants as they had not purported to be patentees, but gave leave to join the patentees, and granted an *ex parte* injunction against them and their agents.

It is not necessary for this cause of action that the threats should have issued *malâ fide* or that any actual damage should be proved. On the other hand the action does not lie if the person threatening with due diligence brings and prosecutes a *bonâ fide* action for infringement.

What is a threat.

A threat within this section may be either addressed to the plaintiff (*p*), his customers (*q*), or manufacturers (*r*), or may be simply published to the world in general (*s*). It may be a threat of action or simply a statement of liability (*t*), and may be contained in a solicitor's letter (*u*), or in a statement without prejudice (*x*), or in an answer to inquiries (*y*).

The alleged threat must in some way point to the articles or class of articles manufactured or used by the plaintiff. A mere general statement that the patentee will protect his rights, or that action will be taken against infringers, is not sufficient (*z*). But if the document really would be understood as a threat the form is unimportant (*a*).

It was at one time stated that to come within the section the threat must refer to what is happening at present and not only to what may happen in the future (*b*). This view has been

(*p*) *Driffield Coy.* v. *Waterloo Coy.*, 3 R. P. C. 46.

(*q*) *Burt* v. *Morgan*, 4 R. P. C. 278; *Hoffnung & Coy.* v. *Salisbury*, 16 R. P. C. 375; *Craig* v. *Dowding*, 25 R. P. C. 1.

(*r*) *Willoughby* v. *Taylor*, 11 R. P. C. 45; *Webb* v. *Levinstein*, 15 R. P. C. 78.

(*s*) *Johnson* v. *Edge*, 9 R. P. C. 142.

(*t*) Under the old law this scarcely seemed actionable. See *Gillespie* v. *Young* (1861), 2 S. XXIII. 135.

(*u*) *Crampton* v. *Patents Investment Coy.*, 5 R. P. C. 393; *Combined Weighing Machine Coy.* v. *Automatic Weighing Machine Coy.*, 6 R. P. C. 502; *Engels* v. *Huberts*, 19 R. P. C. 201. But see *Day* v. *Forster*, 7 R. P. C. 54.

(*x*) *Kurtz* v. *Spence*, 5 R. P. C. 161, 173.

(*y*) *Skinner* v. *Perry*, 10 R. P. C. 1 C. A.

(*z*) *Crowther* v. *United Flexible Metallic Tube Coy.*, 22 R. P. C. 549; *Dick* v. *Haslam*, 8 R. P. C. 198; *Brauer* v. *Sharpe*, 3 R. P. C. 193, 197; *Willoughby* v. *Taylor*, 11 R. P. C. 45.

A true statement that an action has been brought is not a threat. *Beven* v. *Welsbach Incandescent Coy.*, 20 R. P. C. 73; *Incandescent Gas Light Coy., Ltd.* v. *Sunlight Incandescent Coy., Ltd.*, 14 R. P. C. 180.

(*a*) *Douglas* v. *Pintsch's Patent Lighting Coy.*, 13 R. P. C. 673; *Johnson* v. *Edge*, 9 R. P. C. 142, C. A.; *Craig* v. *Dowding*, 25 R. P. C. 1, and 259, C. A.; *Kurtz* v. *Spence*, 5 R. P. C., 173; *Cars* v. *Bland Light Syndicate, Ltd.*, 28 R. P. C. 33.

In *Johnson* v. *Edge*, *supra*, the statement complained of was in the form, "Information of extensive violation of Mr. Edge's Patent rights have been received. All parties are warned not to infringe these rights." The Court found that persons to whom it was sent (some of whom were plaintiff's customers) would think that the infringements mentioned would mean the plaintiff's goods as well as those of certain other manufacturers, and held it to be a threat. *Per* KAY, L.J., at p. 147, it was for the defendant to show that the threats were not directed against the plaintiff. *Cf.* with this case, *Crowther* v. *United Flexible Metallic Tube Coy.*, *supra*.

(*b*) *Challender* v. *Royle*, 4 R. P. C. 362, 375, explained in *Kurtz* v. *Spence*, 5 R. P. C. 161, 171.

modified somewhat in a later case (*c*) where it was stated that the mere wording of a threat so as apparently to apply only to future acts would not prevent it from coming within the section (*d*). But it must be remembered that the section is clearly intended to apply to the case of patentees who threaten, and do not then take proper action (*e*), and it would therefore seem not applicable to a case where a patentee says such and such a thing would be an infringement if put on the market, but does not bring an action because there is no infringement (*f*). Though this point has never actually been decided it would probably be held either that such a statement was not a threat within the section, or that the fact that the patentee was ready to start an action if any infringement took place would bring him within the proviso (*g*).

Action not a threat.

The actual bringing of an infringement action is not a threat or allegation within section 36 of the Patents and Designs Act (*h*), nor apparently within section 4 of the Statute of Monopolies (*i*). The bringing of an action which the plaintiff knows to be utterly unfounded may, however, give rise to an action on the case at Common Law (*k*).

Legal rights.

The question of whether any "legal rights" of the patentee have been infringed involves the question of validity as well as that of infringement (*l*). Moreover, it must be shown that

(*c*) *Kurtz* v. *Spence, supra*; *Johnson* v. *Edge*, 9 R. P. C. 142, 148, C. A.

(*d*) *Cf. Challender* v. *Royle, supra*; *Kurtz* v. *Spence, supra*; *Skinner* v. *Perry*, 10 R. P. C. 1, C. A.

(*e*) *Skinner* v. *Perry, ubi supra*, at p. 8.

(*f*) See *Dick* v. *Haslam*, 8 R. P. C. 196; *cf.* also *Colley* v. *Hart*, 7 R. P. C., at p. 108.

(*g*) The rule laid down in *Challender* v. *Royle*, 4 R. P. C. 363, C. A., and *Colley* v. *Hart*, 7 R. P. C. 101, that the question of due diligence is to be considered with regard to the date of the threats and not of the infringement, would not apply to such cases as these, where the patentee has no opportunity of bringing an action. A person wishing to manufacture a certain class of article can always bring the matter to a head by expressing his intention to do so in such a way as to give the patentee an opportunity of bringing an action for an injunction. *Cf. Johnson* v. *Edge*, 9 R. P. C., *per* LINDLEY, L.J., at p. 148, C. A., and *Skinner* v. *Perry*, 9 R. P. C. 406, 407.

(*h*) See *Beven* v. *Welsbach Incandescent Coy.*, 20 R. P. C. 73.

In this case an undertaking had been given not to threaten or allege that certain articles were infringements. *Held*, that bringing an action in which this was alleged was not a breach, nor was a statement that such an action had been brought. See also *Waite* v. *Johnson*, 18 R. P. C. 1.

(*i*) *Peck* v. *Hindes*, see p. 221, *n.* (*l*).

(*k*) See *Wren* v. *Wild* (1869), 38 L. J. (Q. B.) 327, and cases there quoted.

(*l*) *Challender* v. *Royle*, 4 R. P. C. 363, C. A.; *Kurtz* v. *Spence*, 5 R. P. C. 161; *Dowson Taylor & Coy., Ltd.* v. *Drosophore Coy.*, 12 R. P. C. 95, C. A.

From the last case it appears that the onus being on the plaintiff he cannot get particulars of breaches. He may attack validity either in the Statement of Claim or in Reply.

such legal rights are those of the party threatening, and it is only an action by such party that satisfies the proviso (*m*).

Action by patentee.

An action to come within the proviso should be one that would enable the question raised by the threats to be decided (*n*). Generally speaking it should be one in which the defendant has the opportunity of raising both the defences of non-infringement and of invalidity, though of course it does not matter if he in fact does not do so (*o*). If, however, the threats are made to a licensee an action against him is sufficient, though he cannot challenge validity (*p*), and the same rule would seem to apply if the plaintiff in the threats action were himself a licensee of the defendant. The action need not be brought against the person aggrieved (*q*), provided that it refers to the class of article mentioned in the threats and in which he is interested (*r*).

Where the threats refer to several patents which are independent the action should be brought on all (*s*), but if the claims of some of these are in fact covered by the claims of the others the action need not necessarily be brought on the subsidiary patents (*t*).

Due diligence.

In deciding whether an action has been brought with due diligence the object of the section must be kept in mind, viz. that a patentee should not be able to continue to hamper others by threats unless he is prepared to test his rights in Court (*u*). The patentee is generally entitled to take proper time to decide

(*m*) *Kensington Electric Lighting Coy.* v. *Lane-Fox*, 8 R. P. C. 277; but *cf. Barnett* v. *Barrets Screw Stopper Bottling Coy.*, 1 R. P. C. 9.

Although an action by the legal owner is not an answer to an action for threats brought against a licensee or equitable owner, yet if such infringement action were successful it might be held to destroy the claim for damages.

(*n*) *Combined Weighing Machine Coy.* v. *Automatic Weighing Machine Coy.*, 6 R. P. C. 502.

(*o*) *Dunlop Pneumatic Tyre Coy.* v. *New Seddon Coy.*, 14 R. P. C. 332, C. A.

(*p*) *Day* v. *Foster*, 7 R. P. C. 54, 59.

(*q*) *Challender* v. *Royle*, 4 R. P. C. 363, C. A.; *Z. Electric Lamp Manufacturing Coy., Ltd.* v. *Osram Lamp Works, Ltd.*, 28 R. P. C. 480.

(*r*) *Combined Weighing Machine Coy.* v. *Automatic Weighing Machine Coy., supra.*

Formerly it was held to be sufficient if the action covered such articles, *e.g.* if they would have come within the scope of an enquiry as to damages even if they were not mentioned in the Particulars of Breaches (*Lycett* v. *Brooks*, 21 R. P. C. 656). It seems doubtful if this case would now be followed in view of the new system of pleading laid down by O. 53*a*, r. 16.

(*s*) *Dowson Taylor & Coy.* v. *Drosophore Coy., Ltd.*, 12 R. P. C. 95, C. A.

(*t*) *Temler* v. *Stevenson*, 15 R. P. C. 24.

(*u*) "The sword of Damocles either should not be suspended or should fall at once." *Skinner* v. *Perry*, 10 R. P. C., *per* BOWEN, L.J., at p. 8, C. A.

as to his course of action even after threats have been made (*x*), and it would seem that he might be entitled to amend his patent before bringing the action (*y*). The question of diligence is to be judged with reference to the date of the threats and not to the date when the patentee knew of the infringement (*z*). Where there is a pending action which was being duly prosecuted when the threats were made the proviso is satisfied (*a*). The fact that the threats action has been commenced before the infringement action does not show the patentee has not acted with due diligence (*b*).

(*x*) *Challender* v. *Royle*, 4 R. P. C. 363, C. A.

Probably there might be cases where the patentee would be estopped by the form of the threat from alleging that he needed time to decide on his course of action.

(*y*) *Hall* v. *Stepney Spare Motor Wheel, Ltd.*, 27 R. P. C. 233, 235; but *cf. Fusee Vesta Coy.* v. *Bryant & May*, 4 R. P. C. 191.

In *Hall's case*, *supra*, the action was commenced before the amendment was complete, but the statement of claim proceeded on the amended specification. See *Stepney Spare Motor Wheel, Ltd.* v. *Hall*, 28 R. P. C. 381, and *Davies and Davies Patent*, 28 R. P. C. 50, L. O.

(*z*) *Challender* v. *Royle*, *supra*; *Colley* v. *Hart*, 7 R. P. C. 101, 108.

In *Colley* v. *Hart*, *supra*, NORTH, J., also pointed out that the patentee cannot be expected to start an action till he finds some one who persists in infringing. See also p. 223, *n.* (*g*).

(*a*) *Dunlop Pneumatic Tyre Coy., Ltd.* v. *New Seddon Coy., Ltd.*, 14 R. P. C. 332, C. A.; *Incandescent Gas Light Coy., Ltd.* v. *Sunlight Incandescent Coy., Ltd.*, 14 R. P. C. 180, 188; *Berliner* v. *Edison Bell Phonograph Coy., Ltd.*, 16 R. P. C. 330, 338; *Haskell Golf Ball Coy.* v. *Hutchinson*, 21 R. P. C. 497.

(*b*) The following are cases where the action has been held to have been brought with due diligence:—

Threats in March, letters in April from persons aggrieved, infringement action on 15th June after issue, but before service, of writ in threats action. *Challender* v. *Royle*, 4 R. P. C. 363, C. A.

Threats 15th September. Threats action 27th September. Infringement action 6th December. The judge expressed his opinion that it was proper to wait a reasonable time for the statement of claim in the threats action so as to raise the question of infringement by counterclaim. *Colley* v. *Hart*, 7 R. P. C. 101.

Threats action started immediately after threats, infringement action a fortnight later. *Waite* v. *Johnson*, 18 R. P. C. 1. See also *Household* v. *Fairburn*, 1 R. P. C. 109; *Mackie* v. *Solvo Laundry Coy.*, 9 R. P. C. 465; *Edlin* v. *Pneumatic Tyre Coy.*, 10 R. P. C. 311; *Peck* v. *Hindes*, 15 R. P. C. 113.

The following are cases where the action has been held not to have been brought with due diligence:—

Where threats were made in September, 1886, and again in September, 1887, threats action commenced in October, 1887, and infringement action in November, 1887. *Herrburger Schwander et Cie* v. *Squire*, 5 R. P. C. 581.

Where threats had been issued since September, 1890, and the patentee, after a threats action had been commenced, on the 4th February, 1891, amended the statement of claim in a passing off action by inserting a claim for infringement, and then consented to the revocation of his patent, MATHEW, J., held that the action had not been brought with due diligence. The decision seems to have been partly at least on the ground that the action was not *bonâ fide*. *Johnson* v. *Edge*, 9 R. P. C. 142, C. A.

Where patentee threatened on the 30th August, issued a writ, but then said he would not serve it, and after the commencement of the threats action (on the 30th September) counterclaimed for infringement, PHILLIMORE, J., left question to the jury who found the action had not

Whether the action has been prosecuted with due diligence is of course a question of fact, but it is not necessary that the action should proceed to trial in order to satisfy this condition. If the patentee, after he has seen the defence and the particulars of objections, considers that the action will not be successful he may abandon it without losing the benefit of the proviso (*c*). But if the Court are of opinion that the patentee is deliberately delaying the action he will be held not to have proceeded with due diligence (*d*).

Whether action *bonâ fide*.

In some cases there has been a discussion on the question of whether or not the action brought by the patentee was *bonâ fide*. This point may be of importance where the action is not against the party aggrieved, since a collusive action, or one brought against a person whom the patentee knew would not defend, would not be within the spirit of the proviso (*e*). But where the action is against the plaintiff in the threats action it is difficult to see how, if it is brought and prosecuted with due diligence, it can fail to be an answer to the threats action (*f*). The fact that the patentee has been advised that he will fail does not prevent the action being *bonâ fide* (*g*).

Interim injunction.

The proceedings in a threats action usually commence by an application for an interim injunction to restrain the threats. The ordinary rule that the Courts will not interfere by means of interlocutory injunction, unless the plaintiff shows a strong

been brought with due diligence. *Appleby* v. *Albert Eady Chain Coy.*, 16 R. P. C. 318.

(*c*) *Colley* v. *Hart*, 7 R. P. C. 101; *English and American Machinery Coy., Ltd.* v. *Gare Machine Coy.*, 11 R. P. C. 627; *Craig* v. *Dowding*, 25 R. P. C. 259, C. A.

For other cases in which the action has been held to have been prosecuted with diligence, see *Combined Weighing Machine Coy.* v. *Automatic Weighing Machine Coy.*, 6 R. P. C. 502; *Peck* v. *Hindes*, 15 R. P. C. 113; *Voelker Incandescent Mantle, Ltd.* v. *Welsbach Incandescent Coy., Ltd.*, 18 R. P. C. 494.

In *Colley* v. *Hart*, *ubi supra*, at p. 109, NORTH, J., held that, where a threats action had been commenced, the patentee, before proceeding in the infringement action, was entitled to wait for the statement of claim in the threats action in order to decide if he would proceed for infringement by way of counterclaim. This would only apply if the infringement action had been *commenced* with due diligence. *Cf. Herrberger Schwander et Cie* v. *Squire*, 5 R. P. C. 581.

(*d*) *Household* v. *Fairburn*, 2 R. P. C. 140; *Bishop* v. *Inman*, 17 R. P. C. 749. See also *Peck* v. *Hindes*, *supra*.

The question is very similar to that of whether the action is a *bonâ fide* one.

(*e*) See *Challender* v. *Royle*, 4 R. P. C. 363, 373, C. A.

(*f*) See *Craig* v. *Dowding*, 25 R. P. C. 259, C. A.; *Colley* v. *Hart*, 7 R. P. C., at p. 112; *Peck* v. *Hindes*, 15 R. P. C. 113.

The infringement action was held not to have been brought *bonâ fide* in *Bishop* v. *Inman*, 17 R. P. C. 749, and possibly in *Johnson* v. *Edge*, 9 R. P. C. 142 (see *Craig* v. *Dowding*, 25 R. P. C. at p. 262). In these cases however, it was also held that the infringement actions were not prosecuted with due diligence.

(*g*) *Craig* v. *Dowding*, *supra*.

probability of success at the trial, applies also in the case of threats action, and the argument that the balance of convenience lies in restraining the threats is not allowed to prevail where the plaintiff cannot make out a *primâ facie* cause of action (*h*). To do this he has to show that there have been threats (*i*), that he is infringing no legal rights of the defendant (*k*), and also, if an action has been brought, that it has not been brought *bonâ fide* or with due diligence, or that it is not being duly prosecuted (*l*). Generally speaking, the Court will only decide non-infringement or invalidity on motion in the clearest possible cases (*m*), and the Court will not generally try questions of *bona fides* on affidavit (*n*). It is a very common course for the defendant to apply for the stay of the threats action in order to enable him to bring an infringement action (*o*), and in such case the action may either be stayed generally—the costs

(*h*) The Courts recognise that if the patentee has rights it is proper to warn purchasers. *Société, &c. des Glaces* v. *Tilghmann's Patent Sand Blast Coy.* (1883), 25 Ch. D. 1.

Injunctions have been refused in the following cases :—

Challender v. *Royle*, 4 R. P. C. 363, 372, C. A.; *Société, &c. des Glaces* v. *Tilghmann's Patent Sand Blast Coy.*, *supra*; *Household* v. *Fairburn*, 1 R. P. C. 109 (subsequently granted, *vide infra*); *Barber* v. *Nathan*, 19 R. P. C. 331; *Barney* v. *United Telephone Coy.*, 2 R. P. C. 173; *Mackie* v. *Solvo Laundry Coy.*, 9 R. P. C. 465; *Edlin* v. *Pneumatic Tyre Coy.*, 10 R. P. C. 311; *Douglas* v. *Pintsch's Patent Lighting Coy.*, 13 R. P. C. 69; *Parnell* v. *Dredge*, 13 R. P. C. 392; *Berliner* v. *Edison Bell Phonograph Coy., Ltd.*, 16 R. P. C. 336; *cf. Bonnard* v. *Perryman*, [1891] 2 Ch. 269, C. A.

In *Walker* v. *Clarke*, 4 R. P. C. 111, it was said that the granting of the injunction depended on the balance of convenience.

Injunctions have been granted in :—

Household v. *Fairburn*, 2 R. P. C. 141; *Colley* v. *Hart*, 6 R. P. C. 17; *Kensington Electric Lighting Coy.* v. *Lane-Fox Electrical Coy.*, 8 R. P. C. 277; *Engels* v. *Hubert*, 19 R. P. C. 210 (dissolved by consent in C. A.).

The rule as to plaintiff disentitling himself *to interim* relief by reason of delay also applies. *Edlin* v. *Pneumatic Tyre Coy.*, 10 R. P. C. 316.

Injunctions in these actions are seldom granted, *ex parte*. Such an injunction was refused in *Wilson* v. *Church Engineering Coy.*, 2 R. P. C. 175; *Commercial Development Coy.* v. *Castner Kellner Alkali Coy.*, 14 R. P. C. 939. But see *Overton* v. *Burn*, 13 R. P. C. 455.

(*i*) *Barber* v. *Nathan*, 19 R. P. C. 331.

(*k*) See p. 223, *n.* (*l*).

(*l*) Where an action within the proviso has been brought the defendant cannot be restrained under this section from issuing further threats. *Day* v. *Foster*, 7 R. P. C. 54; *Dunlop Pneumatic Tyre Coy.* v. *New Seddon Coy.*, 14 R. P. C. 332, C. A.; *Haskell Golf Ball Coy.* v. *Hutchinson*, 21 R. P. C. 497.

(*m*) *Household* v. *Fairburn*, 1 R. P. C. 109; *Barney* v. *United Telephone Coy.*, 2 R. P. C. 173; *Berliner* v. *Edison Bell Phonograph Corporation*, 16 R. P. C. 336.

For a case where the Court decided on these points, see *Colley* v. *Hart*, 6 R. P. C. 17.

(*n*) *Household* v. *Fairburn*, 1 R. P. C. 109; *Parnell* v. *Dredge*, 13 R. P. C. 392; *Barber* v. *Nathan*, *ubi supra*.

(*o*) It would seem to be the patentee's duty to prevent both actions going on. *Combined Weighing Machine Coy.* v. *Automatic Weighing Machine Coy.*, 6 R. P. C. 370 and 509.

Trying the question of infringement in a separate action gives the patentee the advantage of the opening.

usually being made costs in the infringement action (*p*)—or until after the trial of the latter action (*q*). It is not usual to require any undertaking as to the cessation of threats, though this is sometimes done (*r*).

Onus. The burden of proof lies on the plaintiff throughout (*s*) and he has to prove the issue of the threats (and, if these were by agents, the authority of such agents) (*t*), and that no legal rights of the defendant have been infringed (*u*). The onus of proving that an action within the proviso has been duly brought and prosecuted would probably lie on the defendant. The defendant can also counterclaim for infringement (*x*).

The general rule is that the plaintiff in a threats action has the right to begin even if the defence is that he has infringed the defendant's patent (*y*).

Relief. The ordinary remedy is an injunction against continuing to threaten (*z*), and damages or an inquiry as to damages.

(*p*) In *Dowson, Taylor & Coy.* v. *Drosophore Coy.*, 12 R. P. C. 95, where the threats related to four patents, and the infringement action to one only, the Court refused to stay the threats action, see p. 224, *n.* (*s*).

In one case where a licensee had threatened the threats action was stayed for the patentee to bring an action. *Barnett* v. *Barrett's Screw Stopper Bottling Coy., Ltd.*, 1 R. P. C. 9.

But see p. 224, *n.* (*m*).

For form of order, see *Wrightson* v. *Taylor*, 24 R. P. C. 347.

(*q*) *Edlin* v. *Pneumatic Tyre Coy.*, 10 R. P. C. 316.

(*r*) Such an undertaking was given in *Johnson* v. *Edge*, 9 R. P. C. 145; *Wrightson* v. *Taylor*, 24 R. P. C. 347.

Where defendants refused to give undertaking but disclaimed any present intention of threatening, and brought infringement action, no order was made, but liberty was given to renew the motion if the threats were continued. *Mackie* v. *Solvo Laundry Coy.*, 9 R. P. C. 465.

(*s*) *Dowson, Taylor & Coy.* v. *Drosophore Coy., Ltd.*, 11 R. P. C. 656.

(*t*) He must give particulars as to the threats and by whom they were issued (*Dowson, Taylor & Coy.* v. *Drosophore Coy., Ltd.*, 11 R. P. C. 538; *Law* v. *Ashworth*, 7 R. P. C. 86). He need not, however, in his pleadings give particulars of the customers who have ceased dealing with him if the relief asked for is in the form of an inquiry as to damages. *Law* v. *Ashworth*, *supra*.

(*u*) The plaintiff may, if he considers that he knows the patents on which the defendant is relying, attack their validity in the statement of claim (see *Union Electrical Power Coy.* v. *Electrical Power Storage Coy.*, 5 R. P. C. 329), or he may plead that he has infringed no legal rights of the defendants, and if they then say that certain patents have been infringed he may attack the validity of these by his reply. *Dowson, Taylor & Coy.* v. *Drosophore Coy.*, 12 R. P. C. 95.

On the other hand, the defendant may without giving particulars of breaches simply traverse the allegation that the plaintiff has not infringed any of his legal rights. This course, however, is an inconvenient one, and may lead to delay at the trial. *Dowson, Taylor & Coy.* v. *Drosophore Coy., Ltd.*, 11 R. P. C. 656.

In any case the defendant is entitled to proper particulars of objections. *Law* v. *Ashworth*, *supra*; *Dowson, Taylor & Coy.* v. *Drosophore Coy., Ltd.*, 12 R. P. C. 95; *Union Electrical Power Coy.* v. *Electrical Power Storage Coy.*, *supra*.

(*x*) *Colley* v. *Hart*, 7 R. P. C. 101, 108.

(*y*) But see *contra Crampton* v. *Patents Investment Coy.*, 5 R. P. C. 382, where the defendants apparently began.

(*z*) For forms see *Challender* v. *Royle*, 4 R. P. C. 363, 368; *Colley* v. *Hart*, 6 R. P. C. 21. Consult also

With regard to the quantum of damages this must necessarily be largely a matter of estimate. Something is generally allowed for general loss of trade over and above those orders whose loss is actually proved (*a*). But a distinction must be made between the loss that can be traced to the defendant's threats and that due to the feeling in the trade, not caused by such threats, that there may be a dispute as to patent rights and that it is better not to be involved in it (*b*).

Generally speaking, the higher Courts will not interfere with the figure fixed by the master or judge unless he has clearly acted on wrong principles (*c*).

The provisions as to a certificate of validity, or as to the consequences when one has been previously granted, have no application to threats actions, unless of course there is a counterclaim for infringement (*d*).

Costs generally follow the event (*e*), but in some cases, especially where the successful defence is founded on the proviso, the action has been dismissed without costs (*f*).

Ellam v. *Martyn*, 16 R. P. C. 28, as showing need for carefully covering possible contingencies.

(*a*) *Ungar* v. *Sugg*, 9 R. P. C. 113, C. A.; *Skinner* v. *Perry*, 11 R. P. C. 406. See also *Cars* v. *Bland Light Syndicate, Ltd.*, 28 R. P. C. 33, 41.

(*b*) *Ungar* v. *Sugg*, 8 R. P. C. 388. Where the threats had been addressed to the plaintiffs themselves, BACON, V.C., refused to give damages. *Driffield Coy.* v. *Waterloo Coy.*, 3 R. P. C. 46. It would seem that damages may be given although the plaintiff might have proceeded against his customer for breach of contract. *Hoffnung & Coy.* v. *Salisbury*, 16 R. P. C. 375.

(*c*) *Ungar* v. *Sugg*, 9 R. P. C. 113, C. A.

(*d*) See s. 35 and *Kurtz* v. *Spence*, 5 R. P. C. 184. In *Crampton* v. *Patents Investment Coy.*, 5 R. P. C. 404, such a certificate was granted, but its validity was expressly left open to be determined subsequently.

(*e*) *E.g. Colley* v. *Hart*, 7 R. P. C. 101; *Craig* v. *Dowding*, 25 R. P. C. 259, C. A. In *Kurtz* v. *Spence*, 5 R. P. C. 161, the plaintiff was given the whole of the costs, though he failed on the issues of infringement and novelty, the patent being held bad for non-utility.

(*f*) *E.g. Combined Weighing Machine Coy.* v. *Automatic Weighing Machine Coy.*, 6 R. P. C. 502; *Temler* v. *Stevenson*, 15 R. P. C. 24; *Metropolitan Gas Meters Ltd.* v. *British &c., Automatic Light Coy.*, 29 R. P. C. 680.

CHAPTER XIII

AMENDMENT

Provisions for amendment.

THE present Act, like former Acts (*a*), contains provisions for the amendment of the specification of Letters Patent. Such amendment may be made either by the Comptroller or the Court. The present chapter only deals with the conditions for, and effect of, such amendment, and the practice in amendment by the Court itself. The procedure in amendment by the Comptroller is to be found in the chapter on Patent Office Practice (*b*).

Amendment by comptroller.

The Comptroller has no jurisdiction to entertain an application for leave to amend made during the pendency of an action for infringement or proceeding before the Court for revocation, and if he does so the amendment is void and of no effect (*c*). If, however, the application is duly made while no proceedings are pending, the fact that proceedings are started before the amendment is completed does not oust his jurisdiction (*d*). The amendment once made dates back to the

(*a*) See 5 & 6 Will. IV. c. 83; 7 & 8 Vict. c. 69; 15 & 16 Vict. c. 83, s. 29; 46 & 47 Vict. c. 57, ss. 18, 21; 51 & 52 Vict. c. 37, s. 5.

(*b*) See p. 279 *et seq.*

(*c*) Sect. 21 (8). It should be noted that a threats action would apparently not affect the Comptroller's jurisdiction (see in the matter of *Hall and Others*, 5 R. P. C. 307). It does not seem clear whether a petition to the Board of Trade for a compulsory licence or in the alternative for revocation, referred to the Court under the provisions of s. 24 (2), is a proceeding before the Court. As the validity of the patent is not in question in such petition there would seem no reason why the power of the Comptroller to amend should be restricted. Questions may also arise as to whether appeals from the Comptroller under ss. 26 and 27 are proceedings before the Court. *Cf. Cropper* v. *Smith*, 1 R. P. C. 254.

An action is pending even though it has been taken out of the list and is practically dead, and where an amendment was effected before such action was actually discontinued it was in a subsequent action held to be void. Leave was, however, given to apply to amend. *Brooks* v. *Lycett*, 21 R. P. C. 651. An appeal, at any rate an appeal to the H. L., was held not to prevent a patentee applying to the Comptroller for leave to amend. *Cropper* v. *Smith*, 1 R. P. C. 254.

(*d*) *Andrew* v. *Crossley*, 9 R. P. C. 165, C. A.; *Wolfe* v. *Automatic Picture Gallery*, 20 R. P. C. 177, C. A.

As to prohibition against the Comptroller on the ground of want of jurisdiction, see p. 290.

original date of grant (*e*), except as expressly provided by the Act (*f*), and consequently a specification so amended can be given in evidence in proceedings commenced before the amendment is complete (*g*).

Amendment by the Court.

In the excepted cases the application to amend the patent must be made to the Court (*h*). Such application need only be made in one action, etc., although several may be pending (*i*). The procedure, however, permits any person interested to oppose the amendment, and the Comptroller has also the right to be heard (*k*). Whether leave to amend be given is purely a matter of judicial discretion, and the higher Courts will not interfere with such discretion unless they are clearly of opinion that it has been wrongly exercised (*l*), and, if such leave has been given, they will in practice not consider an appeal against the imposition or non-imposition of certain terms (*m*).

The only amendment which can be made by leave of the Court is one by way of disclaimer (*n*). There are, however, very few decisions throwing light on what amendments come within this term (*o*).

(*e*) *Stocker* v. *Warner* (1845), 14 L. J. (C. P.) 90; *R.* v. *Mill* (1851), 20 L. J. (C. P.) 16; *Wolfe* v. *Automatic Picture Gallery*, *supra*; *Stepney Spare Motor Wheel, Ltd.* v. *Hall*, 28 R. P. C. 251.

(*f*) *I.e.* as to *damages* for infringements before amendment, see p. 237, *n.* (*x*).

(*g*) *Andrew* v. *Crossley*, *supra*, which only decided the point when leave to amend had been obtained; but in *Stepney Spare Motor Wheel, Ltd.* v. *Hall*, *supra*, it was held that even where proceedings were started before such leave was obtained the amended specification could be given in evidence. It would also appear from *Hall* v. *Stepney Spare Motor Wheel, Ltd.*, 27 R. P. C. 233, that such amended specification could be used in proceedings for threats made before the date of the amendment. See also cases in note (*c*), *supra*, and *Singer* v. *Strassen*, 1 R. P. C. 121. The dictum in *Stocker* v. *Warner*, *supra* (also to be found in *Perry* v. *Skinner* (1837), W. P. C. 251), that an amendment does not relate back so as to make acts wrongful by relation hardly seems reconcilable with these cases.

(*h*) Sect. 22. In the case of proceedings in the Palatine Court this Court has power to grant leave to amend. See Chancery of Lancaster Act, 1890 (53 & 54 Vict. c. 23), s. 4. See also *Winter* v. *Baybut*, 1 R. P. C. 77.

It would seem doubtful if the H. L. could exercise this power, or whether it would have to be referred back to the High Court. Sect. 92 defines "the Court" as the High Court, but the H. L. have exercised certain powers of the Court, *e.g.* have granted a certificate as to particulars, see p. 204, *n.* (*r*).

(*i*) *In the matter of Hall and Others*, 5 R. P. C. 307.

(*k*) O. 53a, r. 23.

(*l*) *Armstrong's Patent*, 14 R. P. C. 747, C. A.; *New Conveyer Coy.* v. *Edinburgh Gas Commissioners*, 21 R. P. C. 147, I. H.

For cases where the higher Courts have given leave although leave was refused by the judge of first instance, see *Gaulard* v. *Lindsey*, 5 R. P. C. 192, C. A.; *Decley's Patent*, 13 R. P. C. 581, H. L.; *Alsop's Patent*, 23 R. P. C. 65, C. A.

(*m*) *Allen* v. *Doulton*, 4 R. P. C. 377, C. A.; *Lang* v. *Whitecross Iron Coy.*, 7 R. P. C. 389, H. L.; *Pitt's Patent*, 17 R. P. C. 745, H. L.; *Geipel's Patent*, 21 R. P. C. 379, C. A.

(*n*) Sect. 22.

(*o*) For cases where the proposed amendment has been held not to be by way of disclaimer, see *Lang's Patent*, 7 R. P. C. 469; *Armstrong's Patent*, 14

Leave to amend is frequently given in petitions after judgment, and it is not usual to make the patentee elect between amending and appealing (*p*). It is not, however, customary to give the plaintiff in an action leave to amend after judgment (*q*). The Court may give leave to amend more than once (*r*). Amendment after judgment.

Before leave to amend will be given by the Court, at any rate after judgment, the patentee must make out a *primâ facie* case that the patent when so amended will be good (*s*).

In the case of amendment pending legal proceedings terms are in general imposed on the patentee. These terms vary according to the period of the proceedings at which the application for amendment is made. If this is before trial the usual order as to costs is that the patentee should pay the costs of amendment and all costs up to date except so far as they are for matters which can be utilised after the amendment (*t*). The defendant or petitioner is also generally given leave to amend the particulars of objections (*u*). If leave is sought after judgment has been given against the patentee the terms Terms imposed

R. P. C. 747, C. A.; *Owen's Patent*, 15 R. P. C. 755; *Rheinische Gummi Fabrik* v. *British Xylonite Coy.*, 29 R. P. C. 672. See also *Alsop's Patent*, 24 R. P. C. 684 (L. O.), and *Ralston* v. *Smith* (1865), 11 H. L. C. 223.

Where an amendment consists of excisions only it is *primâ facie* by way of disclaimer. *Alsop's Patent*, 23 R. P. C. 65, C. A.

For cases where an amendment has been held to be by way of disclaimer, see *Seed* v. *Higgins* (1862), 8 H. L. C. 551.

For the general question of what are permissible amendments, see p. 280.

(*p*) *Deeley's Patent*, 13 R. P. C. 581, H. L.; *Justice's Patent*, 18 R. P. C. 241; *Bowden's Patent*, 22 R. P. C. 49; *Haggenmacher's Patent*, 15 R. P. C. 437.

It would appear that the amendment in this case would not be during legal proceedings, and would therefore be made by the Comptroller and not by the Court, and could be by way of disclaimer, correction, or amendment. There has been no case under the present Act, but under the former Act the order of the Court did not give leave to apply to the Comptroller, as would have been necessary in a case where proceedings were pending, but simply said that the patent should be revoked if leave to amend were not obtained, *cf. Deeley's Patent*, *supra*.

(*q*) *Lawrence* v. *Perry*, 2 R. P. C. 187; *Gillette Safety Razor Coy.* v. *Gamage*, 26 R. P. C. 761.

(*r*) *Chatwood's* v. *Mercantile Bank of Lancaster*, 17 R. P. C. 23.

(*s*) *Armstrong's Patent*, 14 R. P. C. 747, C. A.; *Klaber's Patent*, 22 R. P. C. 205, 216, C. A.; *Singer* v. *Rudge*, 11 R. P. C. 463; *Alsop's Patent*, 24 R. P. C. 761.

(*t*) *Jandus Arc Lamp Coy.* v. *Arc Lamp Coy.*, 21 R. P. C. 115; *Codd* v. *Bratby*, 1 R. P. C. 209; *Chatwood's Patent*, 16 R. P. C. 374. See also *Haslam Foundry Coy.* v. *Goodfellow*, 5 R. P. C. 28.

In *Chatwood's Patent*, *supra*, the petitioners were given fourteen days after amendment to elect if they would discontinue, in which case they were to have all costs.

The above forms of orders are those now generally adopted. In *Lang* v. *White Cross Coy.*, 7 R. P. C. 389, the costs up to the date of the order were ordered to be defendant's costs in cause.

Formerly the patentee was frequently ordered to pay all costs up to date. *Gaulard and Gibbs' Patent*, 5 R. P. C. 189; *Gaulard and Gibbs* v. *Lindsay*, 5 R. P. C. 192.

(*u*) *Chatwood's Patent*, 16 R. P. C. 374.

are naturally more onerous, and he will be ordered to pay all costs.

In some cases, especially where there has been delay on the part of the patentee, terms may be imposed that no action shall be brought in respect of past infringements or the use of articles made before a certain date (*x*).

A term which was formerly frequently imposed was that the amended specification should not be given in evidence in the pending proceedings. This was a most inconvenient procedure since the proceedings continued on a specification which was admittedly invalid. Further, the old specification being completely superseded, it is difficult to see how it could be received in evidence. This condition has not been imposed in recent times (*y*).

Other special terms, such as an undertaking not to threaten (*z*), or a consent to the dissolution of an injunction, are sometimes imposed (*a*). The Court may also impose terms as a condition of giving leave which could not be imposed directly (*b*).

In the case of an amendment before the Comptroller the Comptroller or law officer has power to impose such conditions

(*x*) Terms that no action be brought in respect of any articles made by defendant or petitioner before a certain date, *Lang* v. *Whitecross Iron Coy.*, 7 R. P. C. 389, H. L.; *Deeley* v. *Perkes*, 13 R. P. C. 581, 590, H. L. (a petition for revocation); *Allison's Patent*, 17 R. P. C. 513, C. A.; *Luddington Cigarette Coy.* v. *Baron Cigarette Coy., Ltd.*; *Pitt's Patent*, 17 R. P. C. 745, H. L.; *Corrigal* v. *Armstrong*, 20 R. P. C. 523; *Scott's Patent*, 20 R. P. C. 257; *Jandus Arc Lamp Coy.* v. *Arc Lamp Coy.*, 21 R. P. C. 115. See, however, remarks of HALSBURY, L.C., in the *Luddington Case*, *ubi supra*, at p. 747, that this form of order is not of general application, especially in actions. It was not imposed in *Alsop's Patent*, 23 R. P. C. 78, C. A.

In *Geipel's Patent*, 20 R. P. C. 545, C. A., the terms were imposed that no injunction should be asked in respect to any articles made prior to the judgment unless the Court were of opinion that the original claims, etc. Followed in *Klaber's Patent*, 25 R. P. C. 336. In *Gillette Safety Razor Coy.* v. *Luna Safety Razor Coy., Ltd.*, 27 R. P. C. 527, where the patent had been held bad in a concurrent action, leave was only given on the plaintiff's undertaking to discontinue *all* pending actions, and on the terms that no action should be brought against any member of the public (as distinguished from the trade) in respect of any razor acquired by him before the date of the application to amend, and no action against any person with regard to any razor made or imported before that date unless the Court were of opinion, etc., see also *Layland* v. *Boldy*, 29 R. P. C. 037.

(*y*) See *Jandus Arc Lamp Coy.* v. *Arc Lamp Coy.*, 21 R. P. C. 115.

For cases where the term was imposed, see *inter alia*. *Fusee Vesta Co.* v. *Bryant & May*, 4 R. P. C. 71; *Bray* v. *Gardiner*, 4 R. P. C. 40.

(*z*) *Chatwood's* v. *Ratner Safe Coy., Ltd.*, 16 R. P. C. 450; *Alsop's Patent*, 23 R. P. C. 78, C. A.

(*a*) *Kenrich and Jefferson's Patent*, 29 R. P. C. 25. See also p. 237, *n.* (*a*).

(*b*) *E.g.* payment of costs occasioned by abortive application to comptroller; *Codd* v. *Bratby*, 1 R. P. C. 209.

as they may deem just (*c*). A condition so imposed forms a good defence to an action (*d*), and presumably the same would apply where terms have been imposed by the Court.

Effect of amendment.

Once an amendment has been made by the Comptroller the amended specification is in all Courts, and for all purposes, deemed to have formed part of the Letters Patent at the date of grant (*f*), with a statutory exception as regards damages for past infringements (*g*). It follows that the Court will not entertain any objection based on the contents of the original specification (*h*), or consider whether the amended specification claims an invention substantially larger than or different from the invention originally claimed (*i*). The only grounds on which such an amendment can be attacked are that it was obtained by fraud (*k*), or that the Comptroller had no jurisdiction to entertain the application (*l*).

The effect of an amendment by the Court (*m*) when an action for infringement or proceedings (*n*) before the Court for the revocation of the patent are pending is not so clear. The provisions as to the amended specifications being substituted for the original, and as to leave to amend being conclusive of the right to make the amendment, are expressly stated not to apply if such action or proceedings are pending (*o*). The last point is specially important, and it must be remembered that it was held before the Act of 1883 and in some cases after that date (*p*), that the validity of such amendment could be

(*c*) See PATENT OFFICE PRACTICE, p. 282, *n.* (*b*).

(*d*) *United Telephone Coy.* v. *London and Globe Telephone Coy.*, 1 R. P. C. 113.

(*f*) Sect. 21 (7).

(*g*) Sect. 23. See p. 237, *n.* (*x*).

(*h*) *E.g.* that the original claims were not drawn in good faith. *British United Shoe Machinery Coy.* v. *Fussel*, 25 R. P. C. 660, C. A.

(*i*) *Moser* v. *Marsden*, 13 R. P. C. 24 H. L.

This rule has been dissented from in a recent case, *Knight* v. *Argylls, Ltd.*, 29 R. P. C. 610, but it is difficult to reconcile the judgments of Lords HALSBURY, WATSON, and DAVEY in *Moser* v. *Marsden*, *supra*, with any other view of the law.

(*k*) Sect. 21 (7). There has been no decision as to the meaning of this provision.

(*l*) See p. 231, *cf.* also *Re Hall and Others*, 5 R. P. C. 307.

No objection can be raised on the ground that the person making the amendment had no interest in the patent. *Wallington* v. *Dale* (1854), 23 L. J. (EX.) 49. See also *Spilsbury* v. *Clough* (1842), W. P. C. 255.

Nor *semble* will the Court inquire into whether proper steps as to advertisement, etc., have been taken. *Farbenfabriken, etc.* v. *Bowker*, 8 R. P. C. 389.

(*m*) The remarks in this paragraph would also apply to an amendment by the Comptroller during the proceedings in an application to revoke under the provisions of s. 26 if in fact legal proceedings were pending, see s. 26 (1) and (2).

(*n*) See p. 231, *n.* (*c*).

(*o*) Sect. 21 (8).

(*p*) *Ralston* v. *Smith* (1865), 11 H. L. C. 223; *Foxwell* v. *Bostock*

questioned, although the contrary view finally prevailed in the House of Lords (*q*). But the decision of the House of Lords was based on the sub-section which enacted that leave to amend should be conclusive of the right to make the amendment. As this provision is reproduced in the new Act only in the case of amendments made by the Comptroller it would seem that in the case of a specification amended by the Court during legal proceedings an objection might be raised to its validity in a later case on the ground that the amendment was not such as ought to have been permitted, *e.g.* that it claimed a substantially different or a substantially larger invention, or was not by way of disclaimer only. Doubtless, however, the Courts would be reluctant to establish a difference between the effect of the two amendments as this would lead to grave difficulties, and possibly they may read into the power given to the Court to amend all the consequences stated in the earlier section as arising out of an amendment, though this would be to strain the literal interpretation of the Act (*r*).

Construction of amended specification.

The rule would now seem clear that the amended specification only is to be looked at for the purposes of construction, and that no comparison must be made between the amended and unamended specifications in order to determine the scope of the former (*s*).

Infringement before amendment.

Although for other purposes the amended specification is deemed to have formed part of the letters patent *ab*

(1864), 4 De G. J. & S. 298; But see *Clarke* v. *Kenrick* (1844), 13 L. J. (EX.) 6. See also *Van Gelder's Patent*, 6 R. P. C. 22.

(*q*) *Moser* v. *Marsden*, 13 R. P. C. 24, H. L. See also *per* HALSBURY, L.C., in *Chamberlain* v. *Bradford Corporation*, 20 R. P. C. 673. So no question can be raised as to amendment not having been properly carried out. *Farbenfabriken, etc.* v. *Bowker*, 8 R. P. C. 389.

But the fact that the Comptroller had no jurisdiction to make the amendment owing to the pendency of legal proceedings can be raised. *Brooks* v. *Lycett*, 21 R. P. C. 651; *Woolfe* v. *Automatic Picture Gallery*, 20 R. P. C. 177, C. A. Nor can it be questioned on the ground of want of interest in the person making it, *Spilsbury* v. *Clough* (1842), W. P. C. 255; *Wallington* v. *Dale* (1854), 23 L. J. (EX.) 49.

(*r*) *Cf. Re Hall and Others*, 5 R. P. C., *per* CAVE, J., at p. 310.

(*s*) *Hattersley* v. *Hodgson*, 21 R. P. C. 517, C. A.; *Jandus Arc Lamp Coy., Ltd.* v. *Arc Lamp Coy.*, 22 R. P. C. 277; *Reason Manufacturing Coy.* v. *Moy*, 20 R. P. C. 211; *British United Shoe Machinery Coy.* v. *Claughton*, 23 R. P. C. 335.

WILLS, J., expressed a contrary opinion in *Palmer Tyre Coy.* v. *Pneumatic Tyre Coy.*, 16 R. P. C. 251. See also *Ricker* v. *London Electric Supply Corporation*, 17 R. P. C. 294.

The amended specification was referred to by the H. L. in *Dudgeon* v. *Thomson* (1879), 3 A. C. 34.

The effect of the judgment of the H. L. in *Moser* v. *Marsden*, 13 R. P. C. 24, on this point is not very clear, nor was the point discussed in the appeal to the H. L. in *Hattersley* v. *Hodgson*, 23 R. P. C. 192. See also *Aleop's Patent*, 24 R. P. C. 733.

initio (*t*), yet infringements before the date of the amendment (*u*), although giving a right of action and forming a ground for an injunction, do not give a right to damages unless the Court is of opinion that the original claims were drawn in good faith and with reasonable skill and knowledge (*x*).

Where the plaintiff seeks damages for infringement before the date of amendment he should raise by his pleadings the issue that the original claims were drawn in good faith and with reasonable skill and knowledge, and the onus is on him to establish this issue (*y*). Such damages are rarely granted (*z*).

Effect of amendment on injunction.

The substitution of the amended for the original specification does not extend to orders of the Court made on the latter. Thus an injunction is automatically dissolved by an amendment of the specification (*a*). It is a doubtful point whether a decision on the unamended specification acts as an estoppel with regard to a dispute as to the amended specification (*b*).

(*t*) See p. 235, *n.* (*f*).

(*u*) The Act does not define what is the date of amendment. It is probably the date when leave to amend is given by the Comptroller of *Andrew* v. *Crossley*, 9 R. P. C. 165, C. A.

(*x*) Sect. 23. The question whether an account of profits—an equitable remedy ancillary to an injunction—could be granted in respect to such infringements has never been discussed. *Cf.* p. 197, *n.* (*x*).

(*y*) *Kane* v. *Boyle*, 18 R. P. C. 325; *Jandus Arc Lamp Coy.* v. *Arc Lamp Coy.*, 22 R. P. C. 297. This issue should be raised in the opening, *ibid.*

The practice as to pleading on this point is not, however, fixed.

The Court must have materials before it to justify the grant of such a declaration. *Lake and Elliot* v. *Rotary Motor Accessories Coy.*, 28 R. P. C. 204.

(*z*) The only reported cases where such damages have been given are :—*Hopkinson* v. *St. James and Pall Mall Electric Light Coy., Ltd.*, 10 R. P. C. 41; *Brooks* v. *Lycett*, 20 R. P. C. 390; *Brooks* v. *Rendell*, 24 R. P. C. 17; *Van Berkee* v. *Booth Brothers*, 23 R. P. C. 605, C. A.

In *Kane* v. *Boyle*, *supra*, BRYNE, J. suggested that the section meant that the patentee must show that he did not intend to claim more than he knew he had invented. Probably, too, the Court should consider whether what is excluded by the amendment was a matter of common knowledge which a competent man should have known to be old and should have excluded, or some private user, or little known publication of which he could not be expected to know.

(*a*) *Dudgeon* v. *Thomson* (1878), 3 A. C. 34.

(*b*) See ESTOPPEL, p. 208. *Dudgeon* v. *Thomson*, *supra*; *Deeley's Patent*, 11 R. P. C. 76.

CHAPTER XIV

LICENCES

Who can grant licences.

A LEGAL licence can be granted by the legal owner of letters patent for the time being, and if such legal owner is the registered proprietor, and nothing which appears on the register derogates from his power of granting licences, such licence will bind his successors. It is doubtful whether a licence by an owner who is not registered would bind such successors unless they had notice at the time of assignment (*a*). A licence granted by an equitable owner who afterwards acquires the legal title is good (*b*). In the case of joint ownership of a patent all the owners must concur in granting a licence (*c*), and the same rule would in general apply to ownership in common (*d*). A licencee cannot in the absence of special terms grant sub-licences (*e*).

Different kinds of licences.

Although the letters patent only provide for a licence under seal (*f*), licences can be acquired in other ways, and the Courts freely recognise parol licences (*g*), implied licences (*h*), and

(*a*) *Cf.* s. 71 (3), as to which see p. 10, and *Frentzill* v. *Dougill*, 21 R. P. C. 639. This applies where the licence is not in writing. *Kenny's Patent Buttonhole Coy.* v. *Somervell* (1878), 38 L. T. 878.

But it does not apply where the successors had, to the knowledge of the licencee at the date of the licence, a right to an assignment of the patent. *New Ixion Coy., Ltd.* v. *Spilsbury*, 15 R. P. C. 567, C. A.

(*b*) *Jandus Arc Lamp Coy., Ltd.* v. *Johnson*, 17 R. P. C. 361.

Such a licence could in any case be enforced by making the equitable owner a party to the action.

(*c*) Sect. 37.

(*d*) See pp. 11 & 12.

(*e*) *Cf.* cases at p. 242, *n.* (*c*).

(*f*) See form of patent, Appendix, *post*. This need not be by deed, and if not so need not be stamped as a deed. *Chanter* v. *Johnson* (1845), 14 L. J. (EX.) 289.

(*g*) *Crossley* v. *Dixon* (1863), 10 H. L. C. 293; *Chanter* v. *Dewhurst* (1844), 13 L. J. (EX.) 198; *Chanter v. Johnson*, *supra*.

(*h*) *E.g.* the implied licence to use a patented machine given by its sale by the patentee, and the implied licence given to purchasers from the patentee, or from a licencee who has power to sell. This licence extended to subsequent purchasers, *Thomas* v. *Hunt* (1864), 17 C. B. (N. S.) 183. It should be noted that the implied licence by purchase from a patentee extends, in the absence of express terms to the contrary, to all countries where such patentee then owns the

licences by estoppel (*i*). No special words or form seem necessary to a licence and an agreement to grant a licence, if the parties act under it, has much the same effect as a licence (*k*). Where the Courts find that a party has continued to use a patent after the expiration of the licence they may hold that there was an implied licence for him to go on using on the old terms, and that royalty on such terms is payable (*l*). Similarly where one party has been allowed to use the patented invention while negotiations for a licence were proceeding, such user has been treated as under a licence (*m*).

Licencee has no property in patent.

Although in some cases a licence may transfer practically the whole benefit of a patent, it is quite distinct in its nature from an assignment (*n*). There is no reported case in which a licencee has been held entitled to sue for infringement without joining the patentee (*o*), though an exclusive licencee may restrain the patentee from infringing (*p*), and probably also purchasers from the patentee with notice of the exclusive licence (*q*).

patent rights, *Betts* v. *Wilmot* (1871), 6 Ch. App. 239, whereas a licence to manufacture under a foreign patent does not in general give the right to import into this country. *Société &c. des Glaces* v. *Tilghmann's Patent Sand Blast Coy.* (1883), 25 Ch. D. 1, C. A. Of course a purchaser from a licencee cannot be in this respect in a better position than such licencee. *Coppin* v. *Palmer*, 15 R. P. C. 373; *cf.* also *Dunlop Pneumatic Tyre Coy.* v. *Buckingham*, 18 R. P. C. 423.

(*i*) *Kenny's Patent Buttonhole Coy.* v. *Somervell* (1878), 38 L. T. 878; *Lawson* v. *Donald Macpherson & Coy.*, 14 R. P. C. 697; *Badische, &c.* v. *Isler*, 23 R. P. C. 173, 180.

(*k*) *Cf. Ward* v. *Livesey*, 5 R. P. C. 102; *Postcard Automatic Supply Coy.* v. *Samuel*, 6 R. P. C. 560. But see *Henderson* v. *Shiels*, 24 R. P. C. 108, and p. 246, *n.* (*r*).

(*l*) See *Goucher* v. *Clayton* (1865), 13 L. T. 115; *Warwick* v. *Hooper* (1852), 2 Mac. & G. 60.

(*m*) *Tweedale* v. *Howard*, 13 R. P. C. 522.

In some cases the proposed licencee may be in a position to elect whether or no he will be treated as a licencee. *Postcard Automatic Supply Coy.* v. *Samuel*, 6 R. P. C. 560.

Where the negotiations for a licence fell through damages were refused for acts done with the patentees' knowledge during such negotiations. *Coslett Anti-Rust Syndicate* v. *Bennett*, 29 R. P. C. 481.

(*n*) *Heap* v. *Hartley*, 6 R. P. C. 495, C. A. See also *Protheroe* v. *May* (1839), W. P. C. 414.

A licence is in the nature of a *chose in action*. *British Mutoscope Coy.* v. *Homer*, 18 R. P. C. 177.

It is probable that a licencee could compel the legal owner to perform acts necessary for his full enjoyment of the patent. *Cf. Frentzill* v. *Dougill*, 21 R. P. C. 641.

(*o*) *Heap* v. *Hartley, ubi supra*. See also *Frentzill* v. *Dougill, ubi supra*, at p. 645.

An interim injunction was granted, however, to a licencee in *Thorne* v. *Worthing* (1878), 6 Ch. D. 415.

This rule has been questioned in Scotland, see *Cochrane & Coy.* v. *Martin (Birmingham), Ltd.*, 28 R. P. C. 284.

It is sufficient if the patentee is joined as defendant. *Renard* v. *Levinstein* (1865), 2 H. & M. 628.

In this case it was also said that a licencee could sue persons infringing with knowledge of his rights. See also same case at 13 W. R. 382; see also *Hassal* v. *Wright* (1870), L. R. 10 Eq. 509, and p. 12, *n.* (*t*).

(*p*) *Rapid Steel Coy.* v. *Blakestone*, 24 R. P. C. 529; *Hassal* v. *Wright* (1870), 40 L. J. (CH.) 144.

(*q*) *Heap* v. *Hartley, ubi supra*; *cf.* also *Guyot* v. *Thomson*, 11 R. P. C. 541.

Fraud, mistake, specific performance.

The ordinary rules as to the invalidity of an instrument obtained by fraud, or executed by both parties under a mutual mistake, apply to licences (*r*). So, too, in proper cases, specific performance will be granted of agreements for the grant of licences (*s*).

Construction of licence.

Generally a licence to manufacture implies a licence to use (*t*), and a licence to vend gives the right to licence purchasers to use, or sell again, the article purchased (*u*). A licence merely to "use and exercise" may also from its general terms be extended so as to authorise manufacture and sale (*x*). But a personal licence to use certain goods, the property of the licencor, does not give the power to licence others to use them as on a distraint (*y*). If a licence only permits the making of an article of a particular kind an action for infringement will lie for making articles within the patent and not within the licence (*z*).

So, too, in some cases an agreement in the form of a licence may make royalty payable on articles or processes not in fact within the patent (*a*).

Assignability of licences.

Generally speaking a licence is strictly personal, and the rights granted by it cannot be transferred to others in the absence of special terms (*b*). The licencee may, of course, employ his own servants or agents to carry out the manufacture, but is not entitled to have the articles made for him by

(*r*) *Edison-Bell Phonograph Coy., Ltd.* v. *Rosenburg*, 16 R. P. C. 608; *Macdougall Brothers* v. *Partington*, 7 R. P. C. 216; *Ashworth* v. *Law*, 7 R. P. C. 231; *Rochen* v. *London Small Arms Coy.* (1877), 46 L. T. 577.

But this does not, of course, apply to such matters as a mutual mistake as to the validity of the patent. *Cf.* *Tayler* v. *Hare* (1805), Davies, 307.

(*s*) *Brake* v. *Rodermacher*, 20 R. P. C. 631.

(*t*) See, however, *Bassett* v. *Graydon*, 14 R. P. C. 704, H. L.

So in the case of a licence under a patent "for the metal fittings and the mode of applying them," where a royalty was fixed for each pair of metal plates it was held to include payment for using the mode of attachment. *Oxley* v. *Holden* (1860), 30 L. J. C. P. 60.

(*u*) *Thomas* v. *Hunt* (1864), 17 C. B. (N. S.) 183.

(*x*) *Dunlop Pneumatic Tyre Coy., Ltd.* v. *North British Rubber Coy.*, 21 R. P. C. 161, C. A.

(*y*) *British Mutoscope Coy.* v. *Homer*, 18 R. P. C. 177.

(*z*) *La Société d'Appareils, &c. d'Eclairage* v. *Midland Lighting Coy.*, 14 R. P. C. 419; *Dunlop Pneumatic Tyre Coy., Ltd.* v. *Buckingham*, 18 R. P. C. 43, C. A.

In the last-named case the licence was confined to tyres exactly like a deposited one. This tyre had a rim attached, but the Court held that as long as the actual tyres were the same the form of the rim might be varied. *Cf.* also *Roberts* v. *Graydon*, 21 R. P. C. 194.

(*a*) *Baird* v. *Neilson* (1842), 8 C. & F. 726.

(*b*) *British Mutoscope Coy.* v. *Homer*, 18 R. P. C. 177. Where a licence has been assigned *semble* the assignor cannot subsequently attack the patent, since to do so would depreciate the value of the licence. *Gonville* v. *Hay*, 21 R. P. C. 49.

an independent contractor (*c*). In the absence of express provisions the licencee may exercise his powers where and to what extent he will, and if a licence is assignable it can be assigned to a person with a more extensive business than the original licencee (*d*). An assignable licence can apparently be transferred to trustees for others, and the latter are then protected by it and bound by its terms (*e*). Even where a licence is not assignable the patentee if he accepts royalties from those to whom it was purported to be assigned, may be estopped from disputing the validity of the assignment (*f*). It would seem that there is no privity of contract between the patentee and the assignee of the licence (*g*).

Terminability of licences.

The question of whether either party can terminate a licence depends in each case on its special terms. Generally, however, where a licence is expressed to be for a definite time, it cannot be revoked (*h*), except for acts bringing about forfeiture (*i*), nor can the licencee disclaim it (*k*). If the licencor conveys as beneficial owner he apparently cannot revoke the licence (*l*). It would also appear that a parol licence is *primâ facie* terminable at will (*m*). The dicta and decisions in other

(*c*) See *Howard and Bullough, Ltd.* v. *Tweedale and Smalley*, 12 R. P. C. 519; *Dixon* v. *London Small Arms Coy.* (1875), 1 A. C. 632.

As to what is and is not manufacture by the licencee *cf.* these cases, and *Dunlop Pneumatic Tyre Coy., Ltd.* v. *Holborn Tyre Coy., Ltd.*, 18 R. P. C. 22; *Same* v. *Cresswell*, 18 R. P. C. 473.

In *Same* v. *North British Rubber Coy.*, 21 R. P. C. 161, C. A., it was held that an independent manufacturer was the licencees' agent. In this case, however, the tyres were manufactured abroad.

(*d*) *Bown* v. *Humber Coy.*, 6 R. P. C. 9. In this case the licence was only assignable together with the business carried on at certain premises, but it was held that the purchaser of such licence or business might also use the invention elsewhere.

(*e*) *Bower* v. *Hodges* (1853), 22 L. J. (C.P.) 194. In this case MAULE, J., expressed the view that a licence to A. and his assigns means a licence to A. and any person whom he may licence *sed quaere.*

(*f*) *Lawson* v. *Donald MacPherson & Coy.*, 14 R. P. C. 697.

(*g*) *Bagot Pneumatic Tyre Coy., Ltd.* v. *Clipper Pneumatic Tyre Coy., Ltd.*, 19 R. P. C. 69, C. A.; distinguishing *Werderman* v. *Société Generale d'Electricite* (1881), 19 Ch. D. 246, C. A.; but see *Dansk Rekylriffél* v. *Snell*, 25 R. P. C. 421.

(*h*) *Guyot* v. *Thomson*, 11 R. P. C. 541, C. A.; *Ward* v. *Livesey*, 6 R. P. C. 102.

From these cases it would seem that patent licences are in general "licences coupled with an interest." If provision is made for termination by certain parties in certain events there seems to be a presumption that the licence is not terminable otherwise. *Cutlan* v. *Dawson*, 14 R. P. C. 249, C. A.; *Guyot* v. *Thomson*, *supra.*

(*i*) *Ward* v. *Livesey*, *supra.*

A mere breach of covenant may not give this power. *Guyot* v. *Thomson*, *supra.*

(*k*) *Cutlan* v. *Dawson*, *supra.*

(*l*) *Guyot* v. *Thomson*, *ubi supra.* *Per* LINDLEY, L.J., at p. 554.

(*m*) *Coppin* v. *Lloyd*, 15 R. P. C. 373; *Coppin* v. *Palmer*, *ibid.*; *Crossley* v. *Dixon* (1863), 10 H. L. C. 293.

cases give no clear line of definition (*n*). If there is a provision that the licence is terminable on a certain date if certain provisions have not been complied with; acceptance of royalties after that date may estop the licencor from terminating it (*o*). Any party to a contract relating to the lease of or licence to use or work the article or patented process may after the patent, or all of the patents, by which the article or process was protected when the contract was made have ceased to be in force, determine such contract by three months' notice notwithstanding any agreement to the contrary (*p*).

Licence by sale.

The sale of an article by the patentee or his licencees gives, in the absence of special terms, a general licence to the purchaser or his successors to use it as he will (*q*). But if there were conditions limiting such licence which were a term of the sale, and known to the purchaser at the time of the sale, then acts infringing these conditions are not licenced (*r*). In the case of sub-purchasers it would appear that they are only bound by these conditions if they were aware of them at the time when they purchased. The patentee is also entitled, in addition to his remedy by an action for infringement (*s*), to bring an action for breach of the conditions against the immediate purchaser from him (*t*).

Duties of licencor.

With regard to the covenant for quiet enjoyment it has been suggested that in the case of an exclusive licence it is a breach of this covenant if the vendor does not prevent others

(*n*) *E.g. cf. Cheetham* v. *Nuthall*, 10 R. P. C. 321, where the licence was held not to be terminable, and *Ridges* v. *Mulliner*, 10 R. P. C. 21, where it was held to be terminable.

(*o*) *Warwick* v. *Hooper* (1852), 2 Mac. & G.

(*p*) Sect. 38 (2).

(*q*) *Betts* v. *Wilmot* (1871), 6 Ch. App. 239; *Thomas* v. *Hunt* (1864), 17 C. B. (N. S.) 183.

Semble, where articles are sold in a half-finished state there is a licence to complete them. *Coppin* v. *Lloyd*, *Same* v. *Palmer*, 15 R. P. C. 373.

(*r*) *Incandescent Gas Light Coy., Ltd.* v. *Cantelo*, 12 R. P. C. 262. See also cases in next note.

(*s*) That a purchaser is bound by such conditions if known to him appears from *Incandescent Gas Light Coy., Ltd.* v. *Brodgen*, 16 R. P. C. 179, and from the judgment in *National Phonograph Coy. of Australia, Ltd.* v. *Menck*, 28 R. P. C. 229, P. C. In the last-named case it was also laid down that these conditions would not bind a sub-purchaser in the absence of notice at the time of purchase. But in *Badische, &c.* v. *Isler*, 23 R. P. C. 173, BUCKLEY, J., held that the purchaser with a limited licence could not give a greater licence to the sub-purchaser, and that, therefore, the latter's knowledge was immaterial. In the particular case, however, he held that the patentees having attached to the goods a label purporting to set out the conditions of resale, &c., were estopped from setting up other conditions. *Cf. Coppin* v. *Lloyd*, *Same* v. *Palmer*, 15 R. P. C. 373. See also on this subject *Gillette Safety Razor Coy., Ltd.* v. *Gamage, Ltd.*, 25 R. P. C. 492, and 782, C. A.

(*t*) *Crosthwaite* v. *Steel*, 6 R. P. C. 190.

from infringing the patent (*u*). It is also a breach in the case of such a licence if the patentee himself makes under the patent (*x*). A licencor will be restrained from using threats against the licencee (*y*).

In the absence of express provisions making the performance of the covenant for quiet enjoyment a condition precedent to the covenant for the payment of royalties the Court will not construe it as such. A breach of the former covenant is therefore only available by way of counterclaim and not as a defence to an action for royalties (*z*). It would seem that there is not necessarily an obligation on a licencor to keep the patent in force, though this may be in some cases inferred from the general terms of the licence (*a*).

Estoppel on licencee.

In the case of a licence to make sell or use, other than the implied licence to use a definite article in general given by the sale of such article (*b*), the licencee is estopped from disputing the validity of the patent under which the licence is granted (*c*), and it is immaterial whether the licence is by deed or parol or whether or not it contains a covenant not to dispute validity (*d*). The general rule is that where the licencee could set up the licencee in answer to an action for infringement he is estopped from disputing validity (*e*). If, however, the licence is a terminable

(*u*) *Mills* v. *Carson*, 10 R. P. C. 9, 16, C. A.

It is not necessary that an action should be brought in every case if the infringement is effectively kept down. *Dunlop Pneumatic Tyre Coy., Ltd.* v. *North British Rubber Coy.*, 21 R. P. C. 161, C. A.; *Guyot* v. *Thomson*, 11 R. P. C. 541, C. A.

There is no such obligation in the case of other licences. *Besseman* v. *Wright* (1858), 31 L. T. (o. s.) 213.

(*x*) *Rapid Steel Coy.* v. *Blankstone*, 24 R. P. C. 529.

(*y*) *Clarke* v. *Adie* (1873), 21 W. R. 456, 702; *Société, &c. des Glaces* v. *Tilghman's Patent Sand Blast Coy.* (1884), 25 Ch. D. 1.

(*z*) *Mills* v. *Carson*, 10 R. P. C. 9, C. A.

If, however, there is such a condition, and the patent has been allowed to lapse, royalties paid in ignorance of this may be recovered back. *Lines* v. *Usher*, 14 R. P. C. 206, C. A.

(*a*) *Lines* v. *Usher*, *supra*; *Mills* v. *Carson*, *supra*.

(*b*) Such general licence may be restricted by terms agreed between the parties, *cf.* *Crossley* v. *Dixon* (1863), 10 H. L. C. 293, and see p. 248, *et seq.* Where the purchaser is sued for breach of such limited licence there is no estoppel. *Gillette Safety Razor Coy.* v. *Gamage*, 26 R. P. C. 245.

(*c*) *Crossley* v. *Dixon*, *supra*. The position of the licencor and licencee is similar to that of lessor and lessee. *Clarke* v. *Adie* (1877), 2 A. C. 423, 435.

The fact that a licencee cannot dispute validity is now so well established that it is unnecessary to refer to the earlier decisions, some of which are collected in W. P. C. at page 291, and which frequently contradicted each other. The fact that the patent has been held to be invalid in an action does not affect the estoppel. *Grover* v. *Millard* (1862), 8 Jur. (N. S.) 713.

(*d*) *Crossley* v. *Dixon*, *supra*; *Norton* v. *Brooks* (1861), 7 H. & N. 499; *Grover* v. *Millard* (1862), Jur. (N. S.) 713; *Mills* v. *Carson*, 10 R. P. C. 9, C. A.

(*e*) *Crossley* v. *Dixon*, *supra*.

one and the licencee in fact determines it, and an action is brought for infringement by acts committed after such determination, whether or not such action is in reference to articles procured under the licence, he can then dispute validity (*f*). This estoppel may, of course, be removed or modified by recitals, expressed to be by the licencor alone (*g*), or by covenants in the licence. It is doubtful whether it is affected by the fact that the patentee knew the patent to be bad when the licence was granted (*h*). The estoppel prevents any attack on the patentee's title to the monopoly purported to be granted by the Letters Patent at the time the licence was granted (*i*), but it does not prevent the licencee from alleging that the monopoly has since determined (*k*), *e.g.* from non-payment of fees or revocation of the patent, or that what he is in fact doing is not within the limits of such monopoly (*l*).

Evidence to limit scope of patent.

On this last ground continual attempts are made to refer to prior specifications and other publications nominally in order to show the limits of the monopoly granted by the patent, but really to show that if the patent covers the act complained of it is invalid on the ground of anticipation (*m*). Such efforts have been almost uniformly unsuccessful (*n*). The true rule is that evidence may be introduced to show what knowledge a workman skilled in the art had at the date of the grant, which knowledge both the person writing the specification and the person reading it would be presumed to have, in order to

(*f*) *Crossley* v. *Dixon*, *supra*; *Redges* v. *Mulliner*, 10 R. P. C. 21 26; *Dangerfield* v. *Jones* (1865), 13 L. T. 142; *Goucher* v. *Clayton* (1865), 13 L. T. 115.

(*g*) In *Haynes* v. *Malthy* (1780), Davies 156, it was suggested that recitals as to validity only bound the licencor. This was questioned in *Bowman* v. *Taylor* (1834), 4 L. J. (K. B.) 58.

(*h*) In *Smith* v. *Scott* (1859), 28 L. J. (C. P.) 325, it was held that this did not affect the estoppel, but see *contra Lawes* v. *Purser* (1857), 26 L. J. (Q. B.) 25, 27. See also *Macdougall* v. *Partington*, 7 R. P. C. 216.

(*i*) *E.g.* pleas of no novelty, no utility, or insufficiency. See *per* BYLES, J., in *Trotman* v. *Wood* (1864), 16 C. B. (N. S.) 479.

(*k*) *Muirhead* v. *Commercial Cable Coy.*, 12 R. P. C. 30, C. A.

Where, however, the licence is for a fixed term royalties may still be payable in spite of such revocation. *African Gold Recovery Coy.* v. *Sheba Gold Mining Coy.*, 14 R. P. C. 660; *Mills* v. *Carson*, 10 R. P. C. 9, C. A.

But see provisions of s. 38 of Patents and Designs Act, 1907.

(*l*) *Davies* v. *Curtis and Harvey*, 20 R. P. C. 561, C. A.; *Clark* v. *Adie* (1877), 2 A. C. 423; *Young* v. *Hermand Oil Coy.*, 9 R. P. C. 381, H. L.

(*m*) A plea to this effect in an action for royalties was held bad in *Ashworth* v. *Law*, 7 R. P. C. 247.

(*n*) *Clarke* v. *Adie* (1877), 2 A. C. 423; *Jandus Arc Lamp Coy., Ltd.* v. *Johnson*, 17 R. P. C. 361; *Roberts* v. *Graydon*, 21 R. P. C. 194; and see *n.* (*q*), *infra*.

enable the Court to construe the document properly (*o*), and where the specification is really capable of two meanings, one of which would include something which was previously well known, the Court will presume, as any properly skilled person reading the specification would presume, that it had the meaning which did not include such old matters (*p*). It is, therefore, necessary that the matter relied on should be matter of general common knowledge, and it seems extremely doubtful whether the proper way of giving evidence of this is by reference to specifications (*q*).

This estoppel can only be removed by the clearest words, thus a provision that the royalties are to cease if a patent is held void for want of novelty does not enable a licencee to raise the question of want of novelty as a defence to an action for royalties (*r*).

Royalties cannot be recovered back.

It follows, of course, that money paid for royalties under a licence cannot be recovered back on the ground that the patent

(*o*) *Clarke* v. *Adie, ubi supra*; *Davies* v. *Curtis and Harvey*, 20 R. P. C. 561, C. A.; *Cheetham* v. *Nuthall*, 10 R. P. C. 321, 331.

(*p*) *Trotman* v. *Wood*, 16 C. B. (N. S.) 479; *Ashworth* v. *Law*, 7 R. P. C. 247.

(*q*) See *Clarke* v. *Adie* (1877) 2 A. C. 423, 431, 437, H. L.; *British Ore Concentration Coy., Ltd.* v. *Minerals Separation Coy.*, 26 R. P. C. 124, 138, C. A.

The decision of BUCKLEY, J., in *Sutcliffe* v. *Abbott*, 20 R. P. C., at p. 55, apparently only means that where a specification is referred to in the Particulars of Objections questions can be founded on it, to show that it, or matters contained in it, are matters of common knowledge. *Cf. British and American Shoe Machinery Coy., Ltd.* v. *Union Boot and Shoe Machinery, Ltd.*, 11 R. P. C. 367, 373, C. A.

See remarks of FARWELL, J., in *Jandus Arc Lamp Coy., Ltd.* v. *Johnson*, 17 R. P. C. 361, 370, on this case and point. *Crosthwaite* v. *Steel*, 6 R. P. C. 109; *Couchman* v. *Greener*, 1 R. P. C. 107, 109, C. A.; *Ashworth* v. *Law, supra*; *Hay* v. *Gonville*, 25 R. P. C. 161, 168; *McDougall* v. *Partington*, 7 R. P. C. 216.

And *cf.* cases where validity not attacked, as *British Vacuum Cleaner Coy., Ltd.* v. *Exton Hotel Coy.*, 25 R. P. C. 617. See also *Mackie* v. *Solvo Laundry Coy.*, 10 R. P. C. 68, 70.

In *Neil* v. *Macdonald*, 20 R. P. C. 213, certain specifications were quoted in the defence, but it does not appear that they were admitted.

Of course specifications referred to in the body of the specification may be looked at. See p. 118, *n.* (*y*).

So, too, no prior user, not sufficiently general to be part of the common knowledge of the trade, can be relied on in such cases. *Hay* v. *Gonville, supra*.

(*r*) *Mills* v. *Carson*, 10 R. P. C. 9 C. A.

A different rule prevails in the case of an agreement for sale, see *Nadel* v. *Martin*, 22 R. P. C. 41, H. L., and p. 10, *n.* (*z*), this may also apply where there is only an agreement for a licence and not an actual licence. *Henderson* v. *Shields*, 24 R. P. C. 108; *Bassett* v. *Graydon*, 14 R. P. C., *per* Lord HERSCHELL, at p. 709. See also *Wilson* v. *Union Oil Mills*, 9 R. P. C. 57.

It should be noted that if a patent is declared bad in the Court of first instance, but the judgment is reversed on appeal, even if this is by a (non-collusive) agreement, the licence remains in force. *Cheetham* v. *Nuttall*, 10 R. P. C. 321; *cf.* also *Commercial Development Corporation* v. *Atkins*, 10 R. P. C. 98.

was invalid (*s*) unless there are terms in the licence which would permit the licencee to raise the question of invalidity.

Again, where a licence is granted before the complete specification is put in, it is not open to the licencee to refuse to pay royalties because the complete specification includes less than the provisional (*t*). Even if no patent is granted it would seem that money paid cannot be recovered back, since the licencee has been protected from possible actions for infringement since the date of acceptance (*u*).

Miscellaneous points as to Royalties.

Royalties due under a licence carry interest (*x*). An assignee of half profits can have an account against the licencee provided that it is so taken that the assignor is bound (*y*). An account will not be ordered if it appears there are no profits (*z*). The Court are very unwilling to interfere with the finding of the Master as to the proper amount of royalties (*a*). Where the defendant has not appeared an order for an account may be made on motion (*b*). The covenant to render accounts is generally only auxiliary to the covenant to pay (*c*). There have been many cases as to the amount of royalty payable under licences, but they have turned so much on the wording of the particular agreement that no general rule can be deduced. A note of some of these, which may be useful in individual cases, is given below (*d*).

(*s*) *Taylor* v. *Hare* (1805), Davies, 307.

(*t*) *Otto* v. *Singer*, 7 R. P. C. 7.

(*u*) *Otto* v. *Singer*, *ubi supra*.

It should also be observed that the fact that the patentee has amended by disclaimer does not release the licencee from his obligations. *Haddan* v. *Smith* (1830), 10 L. J. (o. s.) 154.

Nor, where a licence is granted under several patents for their respective terms at a fixed royalty, is the royalty diminished where some of the patent have expired. *Siemens* v. *Taylor*, 9 R. P. C. 393.

(*x*) *Redges* v. *Mulliner*, 10 R. P. C. 23.

In *Gill* v. *Stone* (1911), 28 R. P. C. 19, a notice was given that interest at 5 per cent. would be claimed, and interest was allowed from the date when royalties became payable.

(*y*) *Bergmann* v. *Macmillan* (1881), 17 Ch. D. 423.

(*z*) *Bergmann* v. *Macmillan*, *supra*.

(*a*) *Alma Veneer Felt Coy., Ltd.* v. *Fisher*, 14 R. P. C. 159, 167, C. A., and cases there quoted.

(*b*) *Pneumatic Tyre Coy., Ltd.* v. *Ferguson*, 11 R. P. C. 459.

(*c*) *Bower* v. *Hodges* (1853), 33 L. J. (c. r.) 194.

But the failure to keep proper books may be a material breach of the conditions and lead to forfeiture of the licence. *Ward* v. *Livesey*, 5 R. P. C. 102.

(*d*) *Edmunds* v. *Normandy* (1864), 12 W. R. 548. What were "profits" for royalty purposes.

Bagot Pneumatic Tyre Coy. v. *Clipper Pneumatic Tyre Coy.*, 19 R. P. C. 69, C. A. What were "profits" for royalty purposes, and whether assignees could be sued.

Hall v. *Bainbridge* (1843), 5 Q. B. 233. Whether royalties had to be paid on orders taken though patented invention not in fact used.

Tielens v. *Hooper* (1850), 20 L. J. (EX.) 78. Whether a provision for a minimum payment per annum, with a

Legal proceedings.

There seems no objection to the patentee suing for royalties or in the alternative for infringement in cases where the existence of a licence may be disputed (*e*). Where, however, it is found that the defendant is a licencee under a licence which still continues, an injunction will not be granted against using the invention, but only against using it otherwise than as provided by the licence, should the licencee have done this (*f*). Where the plaintiff denies the licence the defendant may plead alternatively that he is a licencee or if not that the patent is bad (*g*). Again, an equitable assignee of the licence may defend apart from the licencee, and can then dispute validly (*h*).

Agreement, etc. not to use invention.

Closely allied to this subject are the cases where a party is by agreement or judgment bound not to use a patented invention, or only to use it in a certain way. In such case the only question is whether what he does is within the claim, it does not matter whether such claim is sustainable, and, therefore, the validity of the patent is irrelevant (*i*).

Restrictive Conditions

Certain conditions forbidden.

The Act provides that it shall be unlawful to insert certain conditions in any contract made after the passing of the Act (*j*) in relation to the sale or lease of or licence to use or work any article or process protected by a patent, and that such conditions shall be null and void as being in restraint of trade and contrary to public policy (*k*). An exception is made where it

right to patentee to terminate licence if this was not paid, amounted to a covenant to pay such minimum amount.

Few v. *M'Lush* (1831), 1 S. IX. 732. Whether higher or lower royalty to be paid.

Goucher v. *Clayton* (1865), 13 L. T. 115. Whether higher or lower royalty to be paid for user after end of licence term, and whether royalty to be paid on renewal of patented parts.

Oxley v. *Holden* (1860), 30 L. J. (C.P.) 60. Whether royalty for articles covered royalty for fixing them.

Siemens v. *Taylor*, 9 R. P. C. 393. Whether full royalty continued to be payable when some of the patents had expired.

(*e*) *Haddan* v. *Smith*, *ubi supra*; *cf. Postcard Automatic Supply Coy.* v. *Samuel*, 6 R. P. C. 560.

(*f*) *Roger* v. *Cochrane*, 25 R. P. C. 9, C. H.

(*g*) *Wapshare Tube Coy., Ltd.* v. *Hyde Imperial Rubber Coy., Ltd.*, 18 R. P. C. 374.

(*h*) *Pidding* v. *Franks* (1849), 1 H. & Tw. 220.

(*i*) See for cases of agreement, *Hills* v. *Laming* (1854), 23 L. J. (EX.) 60; *MacDougall* v. *Partington*, 7 R. P. C. 216, C. A.; *Howard* v. *Tweedale*, 13 R. P. C. 211; *Roberts* v. *Graydon*, 21 R. P. C. 194; *Hay* v. *Gonville*, 25 R. P. C. 161; *Watts* v. *Everitt Press Coy.*, 27 R. P. C. 718.

And for cases of estoppel by judgment: *Dudgeon* v. *Thomson* (1879), 3 A. C. 34, H. L.; *Thomson* v. *Moore*, 6 R. P. C. 426.

(*j*) 28th August, 1907.

(*k*) Sect. 38 (1). In interpreting these provisions of the Act it is very necessary to bear in mind the

can be shown that the purchaser or licencee could have obtained the article on fair terms without such conditions, *and* the contract provides that the purchaser or the licencee can free himself from such conditions by giving three months' notice and paying a sum or royalty to be assessed by an arbitrator appointed by the Board of Trade (*l*). Provision is also made for either party determining a contract made before the passing of the Act containing conditions prohibited by it, on giving three months' notice and paying such sums as may be agreed or settled by an arbitrator appointed by the Board of Trade (*m*). The insertion by the patentee in a contract made after the passing of the Act of any of the forbidden conditions is available as a defence to an action brought for the infringement of the patent to which the contract relates while the contract is in force (*n*). The conditions forbidden by the Act are those whose effect is—

(*a*) To prohibit or restrict the purchaser, lessee, or licencee from using any article or class of articles, whether patented or not, or any patented process, supplied or owned by any person other than the seller, lessor, or licencor or his nominees; or

(*b*) To require the purchaser, lessee, or licencee to acquire from the seller, lessor, or licencor or his nominees, any article or class of articles not protected by the patent (*o*).

evils that they were intended to combat, *i.e.* the imposition of onerous terms by owners of patents as a condition of obtaining the patented article or a licence under the patent. The words of the clause are wide enough to cover a great number of ordinary commercial contracts, since any article of a complicated nature is likely to have some parts protected by letters patent, which letters patent are often not owned by either of the parties to the contract. But the Courts would naturally be unwilling to adapt such an inconvenient interpretation, and would probably hold that the words "contract for the sale lease or licence" must be confined to contracts for a licence, and contracts *ejusdem generis*, that is to say, contracts made by some person who has special rights under the letters patent, and of which the main object is, either by sale, lease or licence, to give a right to infringe on such monopoly. A contract, for example, to take a supply of cycles from a manufacturer would not be brought within this clause by the insertion of a condition that the cycle should have a patented form of tyre, such patent being owned by third parties, with whom neither of the parties had any special relation. But, on the other hand, a contract by the patentee or exclusive licencee for the sale of such tyres would be within this clause.

(*l*) Sect. 38 (1).

(*m*) Sect. 38 (3).

(*n*) Sect. 38 (4). This provision is not limited to cases of actions brought against parties to the contract. As to the pleading in such cases, see O. 53*a*, r. 10, & p. 169.

The term "patentee" has various meanings, see p. 291. Here it would probably include an equitable owner, and possibly a sole licencee. It would also seem to include predecessors in title of the present owner.

(*o*) Sect. 38 (1). It would seem

Conditions not within section.

The section does not affect any condition whereby a person is prohibited from selling any goods other than those of a particular person, or whereby the patentee reserves to himself or his nominees the rights to supply any parts needed for the repair of the article. Nor does it validate any contract which would otherwise be invalid, or affect any independent right of determining the contract or conditions (*p*).

Cases under old law.

Under the old law a clause that the licencee should only

that paragraph (*a*) must be construed as referring only to continuing covenants against using an article, which apart from this section would have entitled a licencor to an injunction against the licencee continuing to use such article; or to restrictive conditions a breach of which would have entitled the licencor to bring an action for infringement, and not to merely restrictive clauses as to purchase, a breach of which would only have given a right to damages. Unless this paragraph is so restricted paragraph (*b*) becomes meaningless, and it should be noted that paragraph (*b*) apparently contemplates as lawful a contract by which the purchaser or licencee agrees to take the articles covered by the patent solely from the seller or licencor, and, unless paragraph (*a*) is restricted as above suggested, these contracts would clearly be unlawful.

It should be observed that a clause requiring the purchaser or licencee not to use a non-patented process is not within the words of this section, and is apparently still lawful, as is a clause merely prohibiting sale.

Another difficult question is, to determine what is meant by an article "protected by a patent." If the section is held only to apply to the restricted class of contracts suggested above the difficulty does not arise, but, even if a wider interpretation is given to the section, the words "article protected by a patent" will probably be interpreted so as to be either confined to an article which is itself patented, or, if held to include articles produced by a patented process, will be confined to such articles as cannot practically be produced without the use of such patented process, or which the contract expressly contemplates as being so produced. The wider interpretation that it would include any article in the production of which a patented process was in fact used, would render this clause so wide as to include nearly every manufactured article sold.

The further question arises as to whether "protected" means validly protected, or whether it simply means covered by the claims of the patent. The first interpretation would give rise to great complications, as the legality of a condition might then depend on whether a patent was valid, which patent might not be owned by either of the parties to the contract, but by a third person. The word "protected" in this relation has received no judicial interpretation, "protection" being generally used in the sense of protection against patent rights being lost or by others claiming them. *Cf. s.* 4.

Covenants which are void as being in restraint of trade are divisible, that is to say, if a portion of the covenant is lawful, that portion will be enforced, even although the covenant includes something which is not lawful. For example, if the above interpretation of paragraphs (*a*) and (*b*) is correct, a covenant to buy different classes of articles from the licencor would be enforceable as to articles covered by the patent, but not as to other articles. See *Mallan* v. *May* (1845), 12 L. J. (EX.) 376.

Further questions may arise as to articles which at the time of making the contract were within the patent, but afterwards become outside it owing to amendment of the specification. Covenants in restraint of trade, which were reasonable when made, are not affected by a change in the position of the parties which afterward renders them unnecessary for their protection. *Elves* v. *Crofts*, 10 C. B. 241.

(*p*) Sect. 38 (5).

make machines embodying the patented invention was held not unreasonable or in restraint of trade (*q*).

Compulsory Licences

The Act provides that any person interested may present a petition for the grant of a compulsory licence, or in the alternative for revocation of the patent, on the ground that the reasonable requirements of the public in respect of the patented invention have not been satisfied. For the purposes of this section the reasonable requirements of the public shall not be deemed to have been satisfied if by reason of default in manufacture, operation, or the grant of licences on reasonable terms, the demand for the article is not reasonably met, or any existing industry in this country, or the establishment of a new industry here, is unfairly prejudiced, or if any industry is unfairly prejudiced by the conditions attached by the patentee to sales or licences (*r*).

The petition is presented to the Board of Trade who may dismiss it if they are not satisfied that a *primâ facie* case has been made out. Otherwise they refer it to the Court (*s*), who may, if the petitioners establish a case of default, order a licence to be granted on such terms as are just (*t*), or if of opinion that the reasonable requirements of the public cannot be satisfied by means of licences, order revocation (*u*). The grounds

(*q*) *Jones* v. *Lees* (1856), 1 H. & N. 189.

In the same case it was held that a plea that machines embodying the invention were unsaleable, was bad as only going to reducing the damages. See also *Mouchel* v. *Cubitt*, 24 R. P. C. 197.

These decisions may be still applicable.

(*r*) Sect. 24. The definitions in s. 24 (5) are probably not intended to be exhaustive. Little can be said as to this section until it has been judicially interpreted. But see note on s. 38.

Under s. 22 of the 1883 Act three petitions were heard. *Continental Gas Gluclicht Petition*, 15 R. P. C. 727; *Levinstein's Petition*, 15 R. P. C. 732; *Gormully and Jeffrey's Petition*, 16 R. P. C. 641.

As to where an industry is so prejudiced, see remarks of PARKER, J., in *Taylor's Patent*, 29 R. P. C. 296.

(*s*) Sect. 24 (2). The petition is tried by the special judge and there is no appeal, s. 92 (2).

Any person claiming an interest as an exclusive licencee or otherwise may appear, and also the Law Officer. It would seem that a mere licencee could not appear. But see "Patentee," p. 291. For procedure, see O. 53, rr. 7–9, and P. O. Rules 68–74.

(*t*) Sect. 24 (3). The order in itself operates as a licence, s. 24 (6). For the terms of such a licence, see *Levinstein's Petition*, *supra*.

(*u*) Sect. 24 (3). An order for revocation can only be made after three years from the date of a patent, and if the patentee fails to show satisfactory reasons for his default.

which would justify revocation as an alternative to a compulsory licence may be used as grounds for revocation on a petition to the Court, or as a defence to an action for infringement (*x*).

(*x*) Sect. 25 (2). See p. 213. For a case where a plea was discussed based on similar grounds before the present Act, see *Badische, &c.* v. *Thompson*, 21 R. P. C. 473.

CHAPTER XV

PATENT OFFICE PRACTICE

Application for Letters Patent

Application.

THE application for Letters Patent may be made by the true and first inventor alone or with others (*a*), or in the case of the death of the inventor by his legal representative (*b*).

The application must contain a declaration that the applicant or one of the applicants claims to be the first and true inventor of the invention for which protection is desired (*c*). In the case of a deceased inventor the legal representative must make a declaration that he believes the deceased to have been the first and true inventor (*d*).

The application must also be accompanied by a provisional or complete specification (*e*).

Procedure.

In the case where a provisional specification is lodged the complete must follow within six months from the date of application (*f*). If the applicant chooses he may lodge a

(*a*) Sect. 1 (*i*). As to who is the first and true inventor, see Chap. IV.

As it is a fatal objection to the patent that it was not granted to the first and true inventor it is better in a case of doubt to join all parties who have had anything to do with the invention. There are two forms for ordinary applications, "No. 1," where the applicant is the original inventor, "No 1*a*," where he is a communicatee.

No. corporation, British or foreign, can apply on form No. 1 as the original inventor. A foreign corporation must therefore make a communication to some person who will then apply on form No. 1*a*. *Société Anonyme du Generateur du Temple's Application*, 13 R. P. C. 54.

A British corporation can apply on form 1*a* as communicatee.

As to the effect if any of a communicatee applying as original inventor, see p. 74.

As to applications under the International Convention, see p. 259.

(*b*) Sects. 49 and 93. Where the applicant dies after application, but before grant, the grant is made in the name of the personal representatives if the office have notice of his death.

(*c*) Sect. 1 (3).

(*d*) Sect. 43 (2).

(*e*) Sect. 1 (3).

(*f*) Sect. 5 (1). An extension of one month can be obtained on payment of £2, Patent Form 6.

Where there are joint applicants it is sufficient if one signs the complete specification, *Grenfell and McEvoy's Application*, 7 R. P. C. 151, but if it is brought to the knowledge of the C.-G. that they do not all agree he has no power to decide between them or to accept any specification. *Apostoloff's Application*, 13 R. P. C. 275.

Probably similar rules would apply

series of provisionals, and, provided that these are for cognate inventions, lodge one complete specification for all of them within six months of the date of the first application (*g*). The application and accompanying specification are referred to an examiner to report on. If he reports that the nature of the invention is not fairly described, or that the application, specification, or drawings, have not been prepared in the prescribed manner, or that the title does not sufficiently indicate the subject-matter of the invention, the Comptroller may refuse to accept the application, or assign to it some date later than that of the application, but not later than the date when these matters were put right (*h*). The applicant is then notified that his application has been accepted, and the period of provisional protection dates from the date given to his application (*i*). When the complete specification is left it is again referred to an examiner who may raise various objections dealt with below (*k*). When all these matters have been put right the complete specification will in general be accepted, and this must take place within twelve months from the date of application except in the case of an appeal from some requirement of the office. If the complete specification is not accepted within this time the application will become void (*l*).

The acceptance of the complete specification is advertised, the specifications are then open to public inspection, and opposition may be lodged within two months (*m*). On acceptance the applicant has all the rights which would be given by the sealing of the patent at the date of acceptance, except that no action can be brought till after the grant is actually made (*n*). If there is no opposition or if, in the case of opposition, the

to any subsequent amendments, etc., up to acceptance. Where the applicant who has made the declaration that he is the first and true inventor desires to abandon the application no grant will be made. *A. & B.'s Application*, 28 R. P. C. 454. As to the possible remedies of the co-applicant, see *Wool, Hide, and Skin Syndicate, Ltd.* v. *Riches*, 19 R. P. C. 127.

(*g*) Sect. 16, as to extension of time, see note (*f*). As to what are cognate inventions, see p. 262.

(*h*) Sect. 3.

(*i*) Sect. 3 (4). Sect. 4.

(*k*) Sect. 6.

(*l*) Sect. 6. An extension of one, two, or three months can be obtained on payment of £2, £4, or £6, Patent Form 7.

(*m*) Sects. 9 and 11. The publication dates from the advertisement and not from the date when printed copies can be seen, which is slightly later. *Parson and Stoney's Application*, 27 R. P. C. 491; *Fox* v. *Astrachans, Ltd.*, 27 R. P. C. 387.

(*n*) Sect. 10. *E.g.* infringement after this date gives a cause of action. Articles made according to the specification may be marked "Patent," *R.* v. *Townsend*, 13 R. P. C. 265. Such rights do not exist after the expiration of time for sealing.

determination is in favour of the grant of the patent, the patent will be sealed on payment of the sealing fee (*o*). Generally speaking this should be done within fifteen months of the application (*p*).

Office objections and requirements.

The following objections may be raised by the Office :—

(*a*) That the application for a patent is not for any manner of new manufacture (*q*).

(*b*) That the use of the invention would be contrary to law or morality (*r*).

(*c*) That the application is for more than one invention (*s*).

(*o*) Sect. 12. This direction to seal is mandatory. In the absence of opposition the office cannot refuse a patent, or insist on amendment, once the complete is accepted though they may insert a statutory reference under sect. 8.

(*p*) Sect. 12 (2). The following are the grounds for extension of this time :—

Where there has been *any* extension of the time for leaving or accepting the complete the time for sealing is *automatically* extended for four months.

When the applicant has died within the period of sealing, his legal representatives may have the patent sealed at any time up to twelve months from the date of his death.

Where the sealing is delayed by opposition or appeal to the L. O. the patent may be sealed at such time as the L. O. may direct.

Where a collusive opposition has been lodged for the purpose of obtaining delay the L. O. will not direct sealing. *A. & B.'s Application*, 19 R. P. C. 403, 551. So, too, where the C.-G. required amendment and there was a delay of a year and ten months in complying with his requirements. *A. & B.'s Application*, 13 R. P. C. 63.

In other cases the Comptroller *may* extend the time for 1, 2, or 3 months on payment of a fee of £2, £4, or £6, Patents Form 11.

(*q*) This objection is generally raised on receipt of the application. As to what may be the subject of a patent, see SUBJECT-MATTER, p. 17, *et seq.*

The rule has been formulated that a patent can only be granted when "a material product of a substantial character is realised or effected." *Cooper's Application*, 19 R. P. C. 53. It cannot be granted for anything in the nature of literary copyright, *ibid.* But a newspaper printed so as to leave a blank space down the middle to permit of easier folding might form the subject of an application, *ibid.*, but not an envelope printed with a particular arrangement of words intended to facilitate a special method of carrying on business. *Johnson's Application*, 19 R. P. C. 57. Again a method of indexing finger prints has been held not to be a manufacture. *Ward's Application*, 29 R. P. C. 79.

(*r*) Sect. 75. See *Pessers* v. *Haydon*, 26 R. P. C. 58.

(*s*) Sect. 12 (2). There are not many decisions on this point, but generally speaking an applicant will be entitled to include in one patent alternatives having the same object, and seeking the same advantage, *Jones's Application*, Griff. 265. Again, where there is a true combination claim the applicant can protect subordinate combinations for use in a similar way. *Jones's Application, ubi supra, Robinson's Application*, Griff. 267, but he may not be able to claim such subordinate combination for all purposes, *ibid.*, and *Hearson's Application*, Griff. 266. In the case of a new machine the applicant may claim all the parts separately, but where the machine is an old one claims for a number of different improvements in parts which do not directly co-act may constitute different inventions.

Robinson's Application, supra. Z.'s Application, 27 R. P. C. 285. If this objection is upheld the application must be divided and separate fees paid on each part, and each part will be treated subsequently as a separate application. The objection may be taken on application, or at any time up to acceptance. It applies to Convention Cases.

(*d*) That the title does not properly describe the invention (*t*).

(*e*) That the specification, provisional or complete, has not been prepared in the prescribed manner (*u*).

(*f*) That drawings or further drawings are necessary to the specification, provisional or complete (*x*).

(*g*) In the case of a chemical patent that samples or further samples should be lodged with the application (*y*).

(*h*) That the invention particularly described in the complete specification is not substantially the same as that which is described in the provisional specification (*z*).

(*t*) Sect. 3 (2). This objection should be taken before the acceptance of the application. The Courts are now averse to holding a patent invalid because of a discrepancy between the title and the specification, but of course different considerations apply before the grant. For cases, see *Robinson's Application*, Griff. 267. *Brown's Application*, Griff. L.O.C. 1.

(*u*) Sect. 3 (2), s. 6 (2). This does not, however, authorise the Comptroller to interfere with the drafting otherwise than is provided by the Act or rules, see *Smith's Application*, Griff. 268.

Such objections, as that the invention is not fairly described, are separately mentioned in s. 3 (2). The requirements as to drawings are contained in rr. 19–26, and as to other documents in r. 6. The Act provides that all specifications must commence with a title, and that a complete specification must end with a claim, s. 2 (4), and the rules provide that such claim must be clear and succinct and separate from the body of the specification, r. 14. These requirements apply to the claims as a whole as well as to each individual claim, and although the mere fact of there being a large number of claims is not necessarily an infringement of this rule, it may be so if there is unnecessary repetition. *Bancroft's Application*, 23 R. P. C. 89. If the specification is prepared in the prescribed manner the office has no power to interfere with it or the claims, except under objections *e*, *g*, or *h*, or the provisions of s. 7 or s. 8.

(*x*) Sect. 2 (3). This objection may be taken any time before acceptance. The drawings form part of the specification, but need not limit the scope of the claims as these may be quite general and not refer to them.

(*y*) Sect. 2 (5). This requirement may be made at any time up to the acceptance of the complete specification. The office may ask for such samples as may be necessary to test if the reactions really extend to all the bodies covered by the claims, and their discretion on this point will not be lightly interfered with. *J. Y. J.'s Application*, 28 R. P. C. 625. As to how the samples are to be supplied, see r. 36. A notice of samples having been furnished in connection with any application will be published in the journal, *ibid.*

It should be noted that the samples, unlike the drawings, form no part of the specification, which should therefore not refer to them. They in no way affect the construction of the specification or the scope of the patent, and it will be no defence to an action for infringement that the alleged infringement differs from the samples, if it comes within the claims.

(*z*) Sect. 6 (3). The criterion is the same as that for DISCONFORMITY, see Chapter VII.

If this objection is sustained the C.G. may (1) require the applicant to excise the disconforming part (2) may, with the consent of the applicant, cancel the provisional and treat the complete specification as a fresh application for a patent bearing the date on which it was left, or (3) allow the application to proceed for the original invention, and treat the claim

(*i*) That the nature of the invention is not fairly described (*a*).

(*j*) That the invention as described has been wholly or in part described or claimed in a specification, other than a provisional specification not followed by a complete specification, for British Letters Patent published before such application and bearing a date within fifty years of the date of the application (*b*).

Compliance with the requirements of the Act and Rules is a condition precedent to the grant of the patent, although in some cases the Comptroller may have a discretionary power to waive these requirements (*c*). An appeal lies against a refusal to accept an application or specification, and so indirectly against any office requirement (*d*).

Statutory searches and references.

The Act provides that after the complete specification is left search shall be made through all British specifications published before the date of such application and bearing date within fifty years of the same (*e*). If the examiner reports that the invention is wholly or in part described or claimed in any such prior specification the applicant is informed of this and given an opportunity of amending (*f*). If, however,

for the disconforming part as a fresh application of the date on which the complete specification was left.

(*a*) Sect. 3 (2). According to the Act this objection can only be taken with regard to the specification left with the application, but *cf.* s. 6 (2), and *C.'s Application*, 7 R. P. C. 250. The objection does not extend to the description of how the invention is to be carried out.

(*b*) See *nn.* (*e*) to (*h*), *infra*.

(*c*) *Application under Section* 103, 23 R. P. C. 788.

(*d*) See *J. Y. J.'s Application*, 28 R. P. C. 625.

(*e*) Sect. 7. For the purposes of this section a specification is considered to be published at the date when it is open for public inspection. *Parson's and Stoney's Application*, 27 R. P. C. 491.

With regard to application under the International Convention it was decided, under the corresponding section of the Act of 1902, that this meant publication before the date of application in this country, and not before the date to which the patent when granted would be antedated. *Deutsche Gold, &c.'s, Application*, 24 R. P. C. 209; *cf.* also *Johnson's Application*, 24 R. P. C. 694.

This earlier Act did not give the C. G. any power to reject, and this interpretation of s. 7 of the present Act would seem to lead to strange results. Thus if an application were made abroad on the 1st January, 1911, and here under the International Convention on the 1st January, 1912, the C. G. would be entitled under s. 7 (4) to reject it if a similar patent had been applied for here say 1st March, 1911, and the complete specification published before the end of the year, although such a rejection would be in direct contradiction of the provisions of s. 91. The probable solution is that the powers given by s. 7 (4) being optional, see *P.'s Application, infra*, would not be exercised in such a case, nor does it appear that a reference could be necessary in the interests of the public to a specification which by reason of its date could have no effect on the scope or validity of the patent when granted.

(*f*) If the examiner reports that the description of the invention is not sufficient to enable him to make

the amendment is, in the Comptroller's opinion, unsatisfactory, he may decide whether any, and if so what, statutory reference to the prior specification should be inserted (*g*), and, if he is of opinion that the whole invention has been wholly and specifically claimed in any such prior specification, he may refuse the patent, but need not necessarily do so (*h*).

Further search.

A further investigation is made among specifications which have been published after the date of the application and are such that the patent granted on them will bear an earlier date than that sought on the application in question. In this case, however, all that is considered is whether the invention has been claimed in the prior specification, and in no case can the patent be refused or an amendment compelled, the only power of the office being to insert a statutory reference (*i*). The reasons for these distinctions are clear, since the only way in which the matter covered by the further search could be raised against the patent if granted would be by pleading a prior grant, and this could only be done if (1) such matter formed

a search, the C. G. may require amendment and if necessary post-date the application in order to allow of the requirements as to search being properly carried out, r. 28. The rules direct the examiner, if he is of opinion that he has found specifications in which the invention has been wholly claimed or described, to make a provisional report, and if this is not reversed or altered the search does not proceed further, but the patent is refused or a statutory reference inserted as the case may be. If, however, such provisional report is reversed or altered a further search and report is made, r. 29. The applicant is given two months, after being informed of the result of a report, in which to amend his specification.

(*g*) The applicant has a right to a hearing, and receives ten days' notice of this, and after such hearing, or if the applicant does not desire to be heard, without a hearing, the C. G. decides whether reference to any, and if so to what, specifications should be made, rr. 30, 31. For form of statutory reference see r. 32.

A statutory reference may be made even if the specification in question is referred to in the body of the specification by way of disclaimer or otherwise. *P.'s Application*, 23 R. P. C. 645.

(*h*) *P.'s Application, supra.*

(*i*) Sect. 8. This section avoids the difficulty as to Convention applications referred to in the note on s. 7, but difficulties may arise in the case where one patent is granted on several provisionals. For example, if A. puts in provisionals on the 1st January and the 1st March, and B. lodges an application on the 1st February for the same invention as is contained in A.'s provisional of the 1st March, a reference to A.'s specification might be ordered in B.'s, though the latter was really the first to apply for a patent for the invention in question. It must, however, be remembered that once B.'s patent was granted, A.'s could only be pleaded as a prior grant, and would therefore not affect B.'s patent unless valid, and for the purpose of determining the validity of A.'s patent the true date of his application for the second invention must be considered. It would, therefore, probably be held that a reference to A.'s specification would not be necessary in the interests of the public, as A's patent would not affect the scope or validity of B.'s.

the subject of a claim in the prior application ; (2) a patent had been granted on the application ; and (3) such prior patent was valid (*k*).

The statutory references under the section can be required after the acceptance of the complete specification, and even after the patent has been granted. The applicant must in all cases be given an opportunity of amending his specification (*l*).

Date.

The date of a patent is in general the date when the application was lodged (*m*), but the Comptroller has power in certain cases to postdate it (*n*). Where there are several provisional specifications and a single complete specification is lodged for all the applications, the patent bears the date of the earliest of the provisionals, but for the purposes of opposition and of determining the validity of the patent the novelty of each claim must be considered with regard to the date when the corresponding provisional was put in (*o*).

Convention applications.

The Act provides that where his Majesty has entered into arrangements with the Government of any foreign State for the mutual protection of inventions, any person who has applied for protection for any invention in that state shall be entitled to a patent for his invention in priority to other applicants, and such patent shall have the same date as the date of application in the foreign state, provided that the application here is made within twelve months of the foreign application (*p*), and such patent shall not be invalidated by reason only of the publication of a description or of the use of the invention in the United Kingdom during this period (*q*). These provisions are brought into force by an Order in Council declaring them to be applicable

(*k*) See p. 75.

(*l*) Sect. 8 (2).

(*m*) Sect. 13. A patent lodged after office hours is dated as of the next day, *Matthew and Strange's Application*, 27 R. P. C. 288. All patents lodged the same day are considered as of the same date. *Cf. Dering's Application* (1880), 13 Ch. D. 393.

See also r. 12, but the office do not claim to be able to fix the order in which applications were put in.

(*n*) *I.e.* where application, etc., are not in order, s. 3 (2). Where there is not time to complete searches, r. 28, and also under the International Convention, *infra*.

In the case of disconformity the patent may be post-dated to the date of lodging of the complete s. 6 (3) (*b*), and in any case this date has to be considered on the question of the novelty of the new matter, s. 42.

(*o*) Sect. 16, see p. 262.

(*p*) Sect. 91 (1).

(*q*) Sect. 91 (2).

It seems doubtful whether such patent would be good if some other person had applied for and actually obtained a patent in the interval. See *Main's Application*, 7 R. P. C. 13. See also *Deutsche Gold, &c., Application*, 24 R. P. C. 209, and p. 66, *n.* (*b*).

to a particular state and continue in force so long as such Order in Council does (*r*). There is also power to apply these provisions by an Order in Council to any British possession with such variations or additions as may be stated in the Order (*s*).

The application for such patent must, according to the rules, be made by the person or persons by whom the first foreign application was made, or, in the case of any of such persons being dead, the application must be signed by the legal representative of such dead person, together with the other applicants, if any (*t*), and must be made within twelve months from the date of the first foreign application (*u*). The benefit of priority must be claimed in the application (*x*). It must be

(*r*) Sect. 91 (4).

The provisions are retrospective with regard to applications made in a foreign State before the date of the Order in Council. *Main's Application*, *supra*.

(*s*) S. 91 (5).

(*t*) R. 15, see *n.* (*u*), *infra*.

A communicatee from such first applicant cannot make such an application. A foreign corporation can apply, *Shallenberger's Application*, 6 R. P. C. 550; *Carey's Application*, 6 R. P. C. 552. Form 1*c* is to be used.

(*u*) R. 15. The rules confine the benefit of these provisions to cases where the application is made within twelve months of the first foreign application, and by persons making such first foreign application, but these rules would seem to be a direct contradiction of the provisions of the Act. The Act provides that where arrangements have been made with *any* state and notified by Order in Council any person applying in *such* state shall have twelve months from the date of such application in which to make his application in this country. These provisions are fixed by the Statute, and except in the case of British possessions, cannot be modified even by an Order in Council. The Order in Council has only the effect of bringing into force the provisions laid down by the Statute. The difference may be illustrated by considering the case of a person who has applied for a patent in Germany on, say, the 1st March, 1911, having previously applied for a United States patent on the 1st January, 1911. The Act, coupled with the effect of the Order in Council notifying that arrangements have been made with Germany, give him to the 1st March, 1912, in which to apply for a patent, but the rules restrict the time to the 1st January, 1912. As the only power of the Board of Trade to make rules on this subject is given by s. 86, and the power there given is to make rules subject to the provisions of the Act, it would appear that the rule as to the application having to be made within twelve months of the first foreign application is *ultra vires*. The provision of s. 86 (2) to the effect that generally rules whilst in force are of the same effect as if they were contained in the Act would, it is submitted, not affect this result, as this only applies to rules made subject to the provisions of the Act. The rules discussed by the House of Lords in *Chartered Institute of Patent Agents* v. *Lockwood*, 11 R. P. C. 374, H. L., were not contrary to the provisions of the Act, and the *dicta* of the Lords in such case were probably only intended to apply to rules which were not so contrary. Where the first application has become abortive the period runs from the first effective application, *Van de Poole's Application*, 7 R. P. C. 69. No later date than that of the first foreign application can be given, *Scott's Application*, 27 R. P. C. 298.

(*x*) *British Tanning Coy.* v. *Groth*, 8 R. P. C. 113; *Acetylene Illuminating Coy., Ltd.* v. *United Alkali Coy.*, 19

accompanied by a declaration that a foreign application has been made in one of the countries to which these provisions apply, and such declaration shall specify all the foreign States or British possessions in which application has been made, together with the official date or dates of such applications (*y*). It must further be accompanied by a complete specification (*z*), and also by a copy of the specifications, drawings, or documents filed or deposited with the first foreign application ; and these must be certified by the chief of the Patent Office of such foreign State or British possession or otherwise verified to the satisfaction of the Comptroller. These latter documents may, however, be left not later than three months after the application by permission of the Comptroller. Where any of the documents are in a foreign language a translation verified by statutory declaration or otherwise shall accompany (*a*). The ordinary rules as to time and manner of proceedings apply to a Convention application with the single exception that if the complete specification be not accepted within twelve months of the date of the first foreign application it shall be open to public inspection at the expiration of such twelve months (*b*).

Where owing to delay or mistake of the applicant the provisions of the rules as to time, etc., cannot be complied with, the Comptroller has power to refuse to give priority (*c*), and any person interested may appeal against his giving this priority to another person's patent (*d*). The foreign applicant is only entitled to have protected here that which is protected abroad (*e*).

The States which have joined the Convention are as follows :—

Austria, Belgium, Brazil, Cuba, Denmark, Dominica,

R. P. C. 213, and 20 R. P. C. 161, C. A., but an application may be amended so as to claim this priority within the twelve months, subject to r. 16 (see *n.* (*a*), *infra*).

(*y*) R. 15.

(*z*) Sect. 91 (3).

(*a*) R. 16, the extension may be for 1, 2, or 3 months, on payment of a fee of £2, £4, or £6.

(*b*) Sect. 91 (3), and rr. 17, 18.

(*c*) *Application under s.* 103, 23 R. P. C. 788.

(*d*) *Main's Application*, 7 R. P. C. 13.

(*e*) 1910*b*. The English rules of interpretation will be applied to the foreign specification to ascertain what is the protection obtained abroad in the absence of evidence that other rules prevail there, *ibid.* A later decision, however, 1912 *A*, has fixed as the criterion not what protection has been obtained abroad, but what protection has been applied for.

But this gives the applicant no right to amend merely on the ground that his protection abroad is different, at any rate after the patent has been granted. *Vidal's Patent*, 15 R. P. C. 721.

France (with Algeria and Colonies), Germany, Great Britain (with Australia, Ceylon, New Zealand, Trinidad, and Tobago), Holland (with the Dutch Indies, Curaçao, and Surinam), Hungary (with Bosnia and Herzegovina), Italy, Japan, Mexico, Norway, Portugal (with the Azores and Madeira), Servia, Spain, Sweden, Switzerland, Tunis, and the United States.

Cognate inventions.

The Act provides that an applicant may put in two or more provisional specifications for inventions which are cognate or modifications of each other, and may then lodge one complete specification on the whole of these if the Comptroller is of opinion that the inventions may properly be included in one patent. The patent bears the date of the earliest of the applications, but in considering the validity of the patent or in proceedings on opposition regard should be had to the date of the provisional specifications relating to the several matters claimed (*f*).

Patents of addition.

Where a patent for an invention has been applied for or granted, the applicant or the patentee, as the case may be, in applying (*ff*) for a further patent in respect of any improvement in, or modification of, the invention may request in the application that the term of the new patent shall be limited to the term of the original patent. Such patent is termed a patent of addition. This patent of addition remains in force so long as the patent for the original invention remains in force, but no longer, and no renewal fees have to be paid on it. The objection cannot be raised to a patent of addition, once it has been granted, that it should have been the subject of an independent patent (*g*).

(*f*) Sect. 16. There is no definition of what is meant by cognate inventions, the question is one for the Comptroller in each case. It is believed that the rule generally followed by the office is to consider applications cognate in cases where, had the inventions forming the subject of the several applications been included in one application, such application would not have offended against the rule of being for more than one invention. See p. 255, note (*s*).

There is no provision made in the Act or the rules for the ear-marking of claims so as to show to which application they relate, and when any such patent has to be fought in the Courts considerable difficulty may arise from this circumstance, since the novelty of each claim has to be considered in respect to the date of the application on which it is founded. Further it may be that it will be open to the patentee to contend that the second application was a mere excess of caution, and that what is contained therein is merely a fair development of what was in the first application, and that therefore the validity of such further invention must be tested as at the date of the first application. Similar questions might, of course, arise in opposition cases. It would seem doubtful whether there is any appeal against a refusal to allow one complete specification to be lodged. *Cf.* Appeal, pp. 283 *et seq.*

(*ff*) Or by amendment prior to date of acceptance.

(*g*) Sect. 19. There is no attempt to define "improvement in or

Except for the fact that a patent of addition automatically expires with the original patent it would seem to be in all other respects similar to ordinary letters patent. It should therefore fulfil the requirements as to novelty and subject-matter as against all prior publications, including the original patent to which it is a patent of addition (*h*).

Secret patents.

In the case of a patent for any improvement in instruments or munitions of war, the inventor may assign it to the Secretary of State for War, for the Admiralty, who may direct the specifications and drawings to be kept secret, and on the expiration of the patent to be delivered to the Government. No proceeding for revocation shall be brought in respect of any such patent, and no communication to any such Secretary of State or to any person authorised by him to investigate the matter, or anything done in such investigation, shall be deemed use or publication so as to affect the validity of *any* patent for the same (*i*).

Opposition.

Locus.

The Act provides that any person (*k*) may within two months of the advertisement of the acceptance of the complete

modification of." The term "improvement" in or on an invention has given rise to several cases on the meaning of agreements containing this phrase. See p. 9, note (*t*). It is clear that the criterion suggested in certain of these cases, *e.g. Davies* v. *Curtis and Harvey, Ltd.*, 20 R. P. C. at p. 572, C. A., that an improvement in or on an invention must be something which would be covered by the original claim cannot apply in the case of patents of addition, since in that case there could be no object in obtaining a patent of addition since this expires at the same time as the original patent. The only reported decision would seem to suggest that much the same criterion is applied as in the case of "cognate" inventions, 1910 *J.* These provisions therefore allow a procedure similar in effect to that of s. 16 to be applied to cases where the second application is made after the complete specification has been lodged on the first. The Act provides (s. 19 (3)) that a patent of addition shall remain in force so long as, but no longer than, the original patent. The words "in force" clearly refer to the duration and not to the validity of the patents, otherwise in an action on the patent of addition the issue would be as to the validity, etc., of the original patent and not that of the patent of addition. An order revoking the original patent would, however, automatically terminate the patent of addition.

But of course the invalidation of a claim in a patent of addition will not bring down with at the original patent; this is a consideration which should lead to application for a patent of addition rather than the claiming of cognate inventions in one final specification, in any case where a valuable claim exists which ought not to be jeopardised by having a claim of possibly doubtful value put into company with it in the same specification.

(*h*) See *Rochford* v. *Dublin Theatre Coy.*, 29 R. P. C. 195, Ir.

A patent of addition can have a further patent of addition based on it, *McFeeleys Application*, 29 R. P. C. 356, L. O.

(*i*) See s. 30 where the subject is dealt with at length.

(*k*) See p. 264, *n.* (*m*).

specification give notice of opposition to the grant of the patent on certain specific grounds (*l*).

Locus.

Although the Act provides that persons may oppose the grant of a patent, it has been frequently decided under the 1883 Act on similar wording that the class of persons who may oppose is limited (*m*). The Act itself limits the persons who may oppose on the first or fourth of the grounds set out below (*n*). With regard to the second ground the persons who may oppose fall into two classes—firstly, those who have some interest in at least one of the patents on which the opposition is founded (*o*), and secondly those who have a manufacturing interest, *i.e.* are actually manufacturing according to the claims of the opposed application or of one of the earlier patents (*p*). A locus on the first, or probably the fourth ground, does not give a right to oppose on the second ground (*q*). Any person having

(*l*) Sect. 11. These grounds are dealt with separately. A patent will not be stopped merely because some general principle of Patent Law has been infringed if the objection cannot be brought within these grounds. *Newman's Application*, 5 R. P. C. 278; *Nahnsen's Application*, 17 R. P. C. 203.

Semble, an action may lie for malicious opposition, but special damage must be proved. The loss of the patent may be sufficient damage, *Haddan* v. *Lott* (1854), 15 C. B. 411.

(*m*) *R.* v. *Comptroller General, Ex parte Tomlinson*, 16 R. P. C. 233; *J. & J.'s Application*, 19 R. P. C. 555.

(*n*) *I.e.* to persons from whom the invention has been obtained or their successors in interest. This means legal representatives and does not include assignees of the invention. *Edmund's Application* (1886), Griff. 282; *Gascoine's Application*, 27 R. P. C. 78. *Spiel's Application*, 5 R. P. C. 281, though *semble* assignees might oppose on the fourth ground, *Gascoine's Application*, *supra*, but *cf.* *Bowden's Patent Syndicate, Ltd.* v. *Smith*, 21 R. P. C. 438, and 1910 *E.*

In *Heald's Application*, 8 R. P. C. 429, an employer opposed on the ground that the invention was communicated by a servant of his, who was the inventor, to the applicant, who was also a servant. Here, however, the alleged inventor also opposed.

(*o*) *Heath and Frost's Application* (1886), Griff. 290; *Gascoine's Application*, 27 R. P. C. 78.

An assignee of a patent or a licencee under it may oppose. *Hill's Application*, 5 R. P. C. 590. A person interested in one patent may oppose on others. *Stewart's Application*, 13 R. P. C. 627.

Presumably if the opposition on the patent in which he is interested wholly fails he would have no *locus*, but there is no case on this point. *Cf.* however, *Max Muller's Patent*, 24 R. P. C. 465, and other cases at p. 214, *n.* (*l*).

(*p*) *Meyer's Application*, 16 R. P. C. 526, 1911 *B.*

These decisions must be held to overrule, *Macevoy's Application*, 5 R. P. C. 285.

An assignee of the business giving the manufacturing interest may oppose. *Gascoine's Application*, 27 R. P. C. 78. Mere intention to manufacture is not sufficient. *Bairstow's Patent*, 5 R. P. C. 286; see also 1911 *B.*

The mere right to take out a patent here, *e.g.* an application in a Convention country, is not sufficient. *Meurs-Gerkin's Application*, 27 R. P. C. 565. See also *Nahnsen's Application*, 17 R. P. C. 203.

(*q*) *J. & J.'s Application*, 19 R. P. C. 555.

a practical and personal interest may oppose on the third ground, but not the man in the street (*r*).

The first ground of opposition is that the invention has been obtained from the opponent or from some person of whom he is the legal representative (*s*). Where the only dispute is as to which of two persons working together made the invention the issue is the same as whether in fact the opponent or the person he represents was the first and true inventor (*t*). It is not, however, generally sufficient for the opponent to show that he was the true and first inventor, he must in addition show that the applicant obtained the invention from him. Though this does not necessarily imply fraud (*u*), it means that the applicant, or an agent, must be fixed with the knowledge that the invention came from the opponent (*x*). On the other hand if the invention was obtained from the opponent it does not matter that there is some third person who was the true inventor, or that the opponent would not have been entitled to patent the invention (*y*). It only applies to cases where the invention has been obtained in this country, as if the applicant has obtained the invention abroad and brought it here he is in the eyes of the law the true and first inventor (*z*). First ground.

(*r*) See 1912 *B. & C.* Thus a later applicant for a patent may oppose. It is sufficient if the interest exists at the date of the hearing, *ibid.*, see also, 1911 *B.*

(*s*) See p. 264, *n.* (*n*).

(*t*) See Chapter IV.

A master cannot successfully oppose on the ground that the invention was made in his time and in consultation with his other servants, unless he can show that these in fact made it. *Heald's Application*, 8 R. P. C. 429.

Where a workman is employed to make a model for the purpose of carrying out an invention, and makes suggestions as to improvements in detail, these suggestions become the property of the master. *David and Woodley's Application* (1884), Griff. L. O. C. 26.

(*u*) 1910 *A.*

(*x*) 1910 *A.* *Edmund's Application* (1886), Griff, 282.

Where the opponent had assented to the application being made the patent was granted, there being no agreement as to opponent's rights. *Marshall's Application*, 5 R. P. C. 661, but *cf.* *Preston's and Ralston's Patent*, 26 R. P. C. 313.

(*y*) *Thwaite's Application*, 9 R. P. C. 515.

The fact that the opponent has supplied a machine to applicant does not prevent his opposing. *Ashton and Knowle's Application*, 27 R. P. C. 181.

(*z*) *Edmund's Application* (1886), Griff. 281; *Spiel's Application*, 5 R. P. C. 281; *Lake's Application*, 5 R. P. C. 415; *Higgin's Application*, 9 R. P. C. 74; *McNeil's Application*, 24 R. P. C. 680.

This applies in the case of convention applications, 1912 *A.* *Meurs-Gerkin's Application*, 27 R. P. C. 565.

This would apply even if the applicant was the party guilty of the fraud. *Higgin's Application, supra*; *McNeil's Application, supra.*

The tribunal will not investigate the question of the rights of the parties as fixed by agreements. *Spiel's Application, supra*; *McNeil's Application, supra.* See also TRUE AND FIRST INVENTOR, Chapter IV.

In the case of *Fiechter's Application* referred to in *Edmund's Application, supra*, the rule seems to have been

Where the invention patented is not identical with what was communicated it is permissible to appeal to prior knowledge to show that what was communicated was old (*a*). Where, however, something that was new has been communicated the tribunal will not be astute to find that there was no invention in this (*b*). The applicant in such case may be either directed to disclaim what he obtained from the opponent (*c*), or the patent may only be issued to the applicant and opponent jointly (*d*). The onus is, of course, on the opponent, who begins in oppositions on this ground (*e*). To discharge this onus it is not enough for him to show that there is a balance of evidence in his favour. He has to make so strong a case as to make the Comptroller or Law Officer of opinion that if a jury decided against him the verdict would be set aside as perverse (*f*).

Second ground.

The second ground is that the invention has been claimed in any complete specification for a British patent which is or will be of prior date to the patent opposed (*g*), provided that the date of the application for such opposing patent was not more than fifty years prior to that of the patent opposed (*h*). The issue here is whether the inventions which have been claimed are the same. The fact of the later invention having been described in the earlier specification but not claimed is not

held not to apply if the applicant here only acted as agent for the foreigner. But see *Avery's Patent*, 4 R. P. C. 152, 322, C. A.

(*a*) *Ashton & Knowle's Application*, 27 R. P. C. 181. *Cf. Walker* v. *Hydrocarbon Syndicate*, 2 R. P. C. 3.

(*b*) *Ibid.*

(*c*) *Ibid. Paterson's Application* (1884), Griff. 295; *Thwaite's Application*, 9 R. P. C. 515.

This applies even where what was obtained from the opponent is only described and not claimed. *Hetherington's Application*, 7 R. P. C. 419.

(*d*) This course was formerly frequently adopted. (See *Edie's Application* (1885), Griff, 279 *b*; *Russel's Patent*, (1857) 2 De G. & J. 130), and although it is now rarer, the Comptroller has power to adopt it.

Ashton & Knowle's Application, 27 R. P. C. 181. It may also be made a condition of the grant that a share of a patent be assigned; *Evans & Otway's Application* (1884), Griff. 279; *Garthwaite's Application* (1886), Griff. 284.

Where there are opposing applications the parties sometimes agree to both being granted. *Hatfield's Application* (1884) Griff. 288. For another order see *Luke's Application* (1886), Griff. 294.

(*e*) 1910 *F.*

(*f*) *Stewart's Application*, 9 R. P. C. 452.

There are a very large number of dicta to the effect that the opponent having the further resort of *scire facias* or petition the patent should not be refused if there is the slightest doubt, *e.g. Lowe's Patent* (1856), 25 L. J. (CH.) 456; *Tolson's Patent* (1856), 6 De G. M. & G. 422; *Ex parte Sheffield* (1873), 8 Ch. App. 237; *Russel's Patent* (1857), 2 De G. & J. 130; *Spence's Patent* (1858), 3 De G. & J. 523.

(*g*) The words of the present Act (see s. 11 (1) (*b*)) render obsolete the decision in *Johnson's Patent*, 24 R. P. C. 694, that the date of application in this country was to be considered and not the Convention date.

(*h*) Sect. 11 (1) (*b*).

sufficient (*i*), nor is the fact that what has been claimed in the earlier specification has been described in the later (*k*). The opposition may be founded on a specification on which no patent has yet been granted (*l*), or where the patent has lapsed (*m*), and the validity of such patent is immaterial (*n*). Although, as has been stated above, the opposition must generally be founded on a patent in which the opponent has some interest, he is yet allowed to join other patents in which he may have no interest (*o*).

In order to obtain a refusal of a patent on this ground a very clear case has to be made out, and the applicant is always given the benefit of any doubt, since the refusal of a patent is final whilst a contrary decision leaves it open to the opponent to test the question in the Courts by way of petition or otherwise (*p*). If, however, the Comptroller or Law Officer is of opponent's specification should be given a limited construction. A similar decision was given in *Jones's Application* (1887), Griff. L. O. C. 33.

For this purpose the applicant is not limited to such prior knowledge as appears in British specifications, *Thornborough & Wilke's Application, supra*, but these are admitted as evidence of prior knowledge, and foreign specifications may also be quoted. It has been pointed out (in 1911 *C.*) that, except where a claim to a master patent has been made by the opponent, the quotation of such foreign specification and publications must necessarily be confined with narrow limits (*i.e.* to the cases where there is a real doubt as to the scope of the opponent's claims).

It is difficult to see, however, how the quotation of either British or foreign specifications can be justified unless a claim is set up to the master patent in view of the rule clearly laid down by the Courts that such specifications are not evidence of common knowledge and cannot be used to affect the *interpretation* of a specification. See p. 124, *n.* (*e*), and p. 246, *n.* (*q*), *Thornborough & Wilke's Application, supra*. The system by which a specification is subject to one set of rules of construction in the Courts and to another in the Patent Office is obviously open to objection.

(*i*) *Bartlett's Application*, 9 R. P. C. 511; *Von Buch's Application* (1887), Griff. L. O. C. 40. See also *Gozney's Application*, 15 R. P. C. 259. But see p. 274, note (*u*).

(*k*) *Teague's Application* (1884), Griff. 298; *Bartlett's Application*, 9 R. P. C. 514.

The effect of these decisions, however, is practically nullified by the practice established by *Francis's Application*, 27 R. P. C. 86, to the effect that in the course of an opposition the Comptroller may insist on any amendments, whether arising from the grounds of opposition or not, which the office could have required at an earlier stage. See on this point, p. 274, *n.* (*u*). *Cf.* also *Hetherington's Application*, 7 R. P. C. 419.

(*l*) As to references in such case, see p. 276.

(*m*) *Glossop's Application* (1884), Griff. 287; *Lancaster's Application* (1884), Griff. 293; *Halland Hall's Application*, 5 R. P. C. 284; *Stewart's Application*, 13 R. P. C. 627.

It is probable that a specification on which no patent has been or can be granted, (as might happen if the patent had been refused or the sealing fee not paid), would not be held to come within this sub-section.

(*n*) *Haythornethwaite's Application*, 7 R. P. C. 70; *Green's Application* (1885), Griff. 286; *Thornborough & Wilke's Application*, 13 R. P. C. 115.

In this case it was held, however, that the prior state of knowledge might be referred to show that the

(*o*) See p. 264, *n.* (*o*).

(*p*) *Chandler's Application* (1888), Griff. 274; *Stubb's Application* (1884), Griff. 298; *Nahnsen's Application*,

opinion that there is no substantial difference between the two inventions it is his duty to refuse the patent (*q*).

What the opponent has to establish is that what is claimed in the later patent is the same invention as that previously patented. The fact that articles made under the later patent would be an infringement of a previous claim, though, of course, a necessary step towards this proof, is by no means sufficient, since the invention may be for an improvement on the earlier invention and not for that invention itself (*r*). The true test is rather, would the later patent prevent the carrying out of the invention claimed in the earlier patent in the way there indicated or in a way which it would require no invention or even ingenuity to suggest (*s*).

The question whether the later patent discloses subject-matter is not in issue. The only question is, are the inventions identical or only colourably different (*t*). On this question the tribunal will consider the question of mechanical equivalents (*u*), but mere resemblance in the result aimed at and mechanism used, not amounting to substantial identity, is not sufficient to justify refusal (*x*).

Although the question of the disconformity of the applicant's patent does not come directly in issue (*y*) the applicant will not be allowed a patent if the only distinguishing feature is something which does not appear in the provisional specification (*z*).

When patent will be refused.

One class of cases in which the power of stopping the later patent is exercised with some freedom is where the earlier patent claims the use of a class of substances or a class of arrangements and the later patent is for the use of a

17 R. P. C. 203; *Welch's Application* (1884), Griff. 301; *Jones's Application* (1887), Griff. L. O. C. 34. See also p. 266, *n.* (*f*).

(*q*) *Todd's Application*, 9 R. P. C. 487.

(*r*) *Sielaff's Application*, 5 R. P. C. 484; *Nahnsen's Application*, 17 R. P. C. 203.

(*s*) "Where there is an existing patent and (the Law Officers) 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." *Newman's Application*, 5 R. P. C., *per* WEBSTER, A. G. at p. 277.

(*t*) *Jones's Application* (1887), Griff. L. O. C. 34; *Haythornethwaite's Application*, 7 R. P. C. 70; *Todd's Application*, 9 R. P. C. 487.

(*u*) *Smith's Application*, 13 R. P. C. 200; *Haythornethwaite's Application*, 7 R. P. C. 70.

(*x*) *Maxim & Silverman's Application*, 11 R. P. C. 315.

(*y*) *Newman's Application*, 5 R. P. C. 271.

(*z*) *Harvey's Application*, 8 R. P. C. 431; *Lancaster's Application*, 20 R. P. C. 366. See also *Francis's Application*, 27 R. P. C. 86.

The effect of this decision would seem to be that the office may during an opposition raise any objection to a specification, although it has been accepted.

particular member of such class. In such case if no ingenuity was needed to select this member the patent will generally be refused (*a*). The other cases of refusal on the second ground are chiefly those in which all that differentiates the later invention from the earlier is some trifling detail of no real utility. In some of such cases, too, this detail had not in the first instance been claimed as an essential part of the invention (*b*).

(*a*) The following are examples of refusal in the case of selection patents :—

The opponent had patented a stopper with a screw thread and an indiarubber ring fixed in a groove. Applicant applied for a patent for a similar stopper with the groove in a particular position which was said to give the minimum of contact between indiarubber and fluid. *Aire & Calder's Application*, 5 R. P. C. 345.

The opponent had patented the use of soluble salts of chromium for dyeing. Applicant applied for a patent for the use of one such soluble salt, viz. the bi-sulphite. The only advantage of this salt was that no alkali was necessary for precipitation, and this advantage was shared by another salt specifically mentioned in the former patent. *Wylie & Morton's Application*, 13 R. P. C. 97.

Opponent had patented a process for sintering carbons by passing a current through them in an inert gas. Applicant applied for a patent for the use of a direct current in this process. He alleged that the current ordinarily used was alternating, but that he had found there were great advantages in the direct. *Deutsche Gasluhlicht Actiengesellschaft's Application*, 26 R. P. C. 101.

Opponent had patented the use of supports in the walls of glass vacuum vessels, saying that they could be put in any position. The applicant applied for a patent for such bottle having one such support in a central position. *Van Wye's Application*, 26 R. P. C. 490.

Opponent had patented the construction of a form of armature with a frame of non-magnetic material. Applicant applied for a patent for making such frame of nickel steel (which was one of such materials of which there was only a small class), alleging it to be the best. *Bosch's Application*, 26 R. P. C. 710.

The following are examples of selection patents which have been allowed :—

The opponent had patented a process for making smokeless powder out of insoluble nitro-cellulose, with or without a mixture of soluble nitro-cellulose. The applicant applied for a patent for smokeless powder made out of soluble and insoluble nitro-cellulose in certain specific proportions, and alleged that this gave a particularly favourable result. Patent granted, but reference ordered. *Curtis & André's Application*, 9 R. P. C. 495.

The opponent had patented safety explosives made from certain materials within a certain wide range of proportions. The applicant applied for a safety explosive for mines made with the same ingredients, and with special proportions coming within the range of the first patent. The Law Officer was of opinion that the safety aimed at by the opponent was safety in handling, and that the second patentee had been the first to draw the attention of the public to the fact that by forming an explosive with the constituents in special proportions you also got safety after ignition in a mine. The patent was allowed. In this case the opponents also alleged that they had been manufacturing in proportions near to that claimed by the later invention. This was held not to give any further ground of opposition. *Nahnsen's Application*, 17 R. P. C. 203.

(*b*) The following are examples of refusals of patents where only some slight alteration or addition had been made :—

Application for a patent for a carburetter apparatus. The only variation from what had been previously patented was a slight alteration in the position of the pipes, making no functional difference. *Wallis & Ratcliff's Application*, 5 R. P. C. 347.

The opponent had patented an

Where it is sought to stop a combination claim by showing that the parts have been separately patented a very clear case must be made out (*c*). Probably the patent would not be stopped unless the tribunal were convinced that the applicant was only attempting to give an appearance of novelty by putting into one claim matters which had no connection with each other, and did not coact in any way (*d*).

apparatus for heating water in which one part was a cone. The applicant applied for a patent for an apparatus which was identical, except that the cone was rounded at the top. This made no difference in the operation. *Daniell's Application*, 5 R. P. C. 414.

The opponent had patented a process for treating cellulose as in paper making, and scraping it off the rolls when dry as a flimsy tissue. The applicant applied for a patent for the same process, but directed that it should be scraped off when damp. There was no real advantage in the change and the product was unaffected. *Boult's Application*, 10 R. P. C. 275. See, however, *Welch's Application* (1884), Griff. 301.

Where the only difference between the opponent's and applicant's inventions was that the latter substituted for one part of the opponent's an article in common daily use, *i.e.* a stopper with a metal rim, it was held that the inventions were identical. *Hedge's Application*, 12 R. P. C. 136.

Where the only difference between the opponent's and applicant's inventions was that the latter substituted a coil for an internal cylinder for heating water, which did not affect the advantages of the apparatus, it was held that there was no invention. *Smith's Application*, 13 R. P. C. 200.

Where the opponent had patented a crank brace having as one part an L-shaped piece, and the applicant had applied for a patent for an identical piece except that there was a joint in the L, which joint was of little, if any, use, it was held that the inventions were identical. It should be noted that in this case the distinguishing feature had not been made a part of the original claim. *Whittaker's Application*, 13 R. P. C. 580.

Where the applicant had taken the whole of the opponent's process but had added certain other processes which in the opinion of the Law Officer did not make a "reasonably substantial and beneficial difference," it was held there was no invention. *Hodgkin's Application*, 23 R. P. C. 527. See also *Todd's Application*, 9 R. P. C. 487; *Lupton's Application*, 14 R. P. C. 261.

The following are examples of small additions held sufficient :—

The opponent had patented a certain form of blower for ventilating purposes. The applicant applied for a patent for a similar form of blower as an air compressor, adding a casement which served to equalise the pressure of the air blown out. Patent allowed with reference. *Tattersall's Patent*, 9 R. P. C. 150. See also *Cumming's Application* (1884), Griff. 277; *Welch's Application* (1884), Griff. 301.

(*c*) *Ross's Application*, 8 R. P. C. 477.

(*d*) *Fried Krupp's Application*, *ubi infra*.

The following are examples of such combination claims :—

A patent for the combination of previously patented rollers and pivots for movable partitions together with previously patented fastening means to hold such partitions shut. *Held*, not patentable. It should be noted that in this case the two integers performed entirely independent functions and were not in operation at the same time. *Bridge's Application*, 18 R. P. C. 257; *Harrild & Perkin's Application*, 17 R. P. C. 617. See also *Thomas & Prevost's Application*, 16 R. P. C. 69.

Application for a patent for forming grain carrying ships with double shelved sides and a deck which sloped approximately at the angle of rest of the cargo. Each feature separately was old, but the combination enabled a hold to be formed so that the sides were unbroken and exactly fitted the cargo all round, so as to prevent displacement. *Held*, patentable. *Fried Krupp Aktiengesellschaft's Application*, 25 R. P. C. 809. See also *Ross's Application*, 8 R. P. C. 477.

Again, patents for making an already patented article by a means not in itself patentable are not generally allowed (*e*).

The third ground of opposition is that the nature of the invention or the manner in which it is to be performed is not sufficiently or fairly described or ascertained in the complete specification (*f*). This ground of opposition only dates from the recent Act, but the question of unfair or insufficient description had often previously to be considered in the course of oppositions on other grounds (*g*). Third ground.

Subject to the opponent having a sufficient locus (*h*), this ground offers a wide opening for attack on the specification. Thus a description of an invention may be held to be unfair if it includes other inventions, even though these are not claimed (*i*). Again the question of utility may be raised by saying that the description of how to perform the invention must be unfair or insufficient, since it does not lead to the result claimed (*k*).

The fourth ground of opposition is that the complete specification describes or claims an invention other than that Fourth ground.

(*e*) In *Levy & Elliott's Application*, No. 21, 113, of 1907, unreported, it was held that where the same applicant had filed two specifications on the same day, one for a general method of construction and one for the application of this method to a previously patented article, the second patent must be refused. *Cf. Webster's Application*, 6 R. P. C. 163; *Wilson's Application*, 9 R. P. C. 512 *n.*

So a patent for making a previously patented article by a method old in itself has been refused. *Cruse's Application*, No. 9427 of 1910, unreported.

(*f*) Sect. 11 (1) (*c*). This ground only applies to cases where the invention claimed is not properly described, it does not allow the point to be raised that this is a different invention to that described in the application as originally lodged. *Serex's Patent*, 20 R. P. C. 284.

(*g*) See p. 268, *n.* (*s*), See also *Hetherington's Application*, 7 R. P. C. 419; *Francis's Application*, 27 R. P. C. 86; *Wadham's Application* 27 R. P. C. 172.

(*h*) It must be remembered that a locus to oppose does not necessarily give the right to raise all grounds (*J. & J.'s Application*, 19 R. P. C. 555), and it may be that it will be held that where an opponent only justifies his opposition on this ground, say as auxiliary to an opposition on the second ground based on some patent in which he has an interest, he may not be allowed to attack the specification on the ground of insufficiency in matters having no connection with the invention described in the earlier patent.

(*i*) *Francis's Application, supra.* It is also an objection that the specification describes as common knowledge what is only disclosed in a particular specification. *Hopkin's Patent*, 27 R. P. C. 72. But see *contra Kilner's Application*, 8 R. P. C. 135.

So too the patentee has not the right to impose on the public his idea of the contents of a prior specification, and if he does so he may be required to refer to it specifically. *Atherton's Application*, 7 R. P. C. 547.

(*k*) See p. 79, *n.* (*d*).

The general tendency has been to avoid a trial of the truth of the applicant's statements as to increased utility, and not to decide disputes involving scientific evidence as to facts as far as possible, 1910 *D.* But *cf. Wylie & Morton's Application*, 13 R. P. C. 99. How far this will be possible in oppositions on the third ground remains to be seen.

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 lodging of the complete specification (*l*). This ground of opposition raises questions similar to those discussed under the head of disconformity, and where the new matter is such that it would be considered a fair development not amounting to disconformity there is no ground for opposition (*m*).

Amendment. The Comptroller can allow certain claims, while ordering others to be excised (*n*), and may require such amendment as he may think right either in the claims, or by way of disclaimer, or by alteration of the specification (*o*).

References. An order which is very frequently made during an opposition is for the insertion of a reference to some earlier specification, or to its subject matter, with or without a disclaimer. The origin of this form of amendment was doubtless that in cases where there was a dispute as to whether on a proper construction the applicant's claim covered anything which was claimed before it was felt that he ought to do away with the doubt by saying distinctly that he did not claim such earlier matter. The function of such a reference should, therefore, be confined to cases where the construction of the applicant's claim is doubtful (*p*). If it is clear that it covers what has been claimed

(*l*) Sect. 11 (1) (*d*). Where the two provisional specifications were filed on the same day it was held that no opposition lay on this ground, 1910 *A.*

(*m*) *Edward's Application*, 11 R. P. C. 461; *Millar's Application*, 15 R. P. C. 718.

In *Birt's Application*, 9 R. P. C. 489 it was held that the Law Officer had to decide what the applicant really meant when he filed his provisional, and that he might for this purpose look at contemporary documents such as the original drawings.

For another case where the opposition on this ground has failed, see *Anderson's Application*, 7 R. P. C. 323.

For cases where it has been successful, see *Wilson's Application*, 9 R. P. C. 512 *n.*; *McHardy's Application*, 8 R. P. C. 431; *Hudson's Application*, 22 R. P. C. 218.

(*n*) It was held in *Webster's Application*, 6 R. P. C. 163, that where there was a claim to a new article, a second claim to its use in a manner forming the subject of a prior patent should not be allowed. See also *Athertson's Application*, 6 R. P. C. 547; *Wilson's Application*, 9 R. P. C. 512 *n.*

(*o*) See p. 274, *n.* (*u*).

Where the opposition is on the second ground only an amendment of the body of the specification may be ordered if a part of the description affects the construction of the claims, and *semble* even if it does not, but then only in exceptional cases. *Wadham's Application*, 27 R. P. C. 172; *Hetherington's Application*, 7 R. P. C. 419; *Francis's Application*, 27 R. P. C. 86.

In *Guest's Application*, 5 R. P. C. 312, an amendment was ordered excising references to alleged defects in a prior patented apparatus. *Aliter* if the prior patent is not specifically mentioned.

(*p*) *E.g.*, *Newman's Application*, 5 R. P. C. 271; *Lorrain's Application*, 5 R. P. C. 142; *Lynde's Application*, 5

before the patent should be refused or the claim excised. If it is clear it does not there is no ground for a reference. Infringement in itself is no more ground for a reference than for stopping the patent (*q*).

Although references are now ordered much more freely than formerly there are certain principles laid down by the earlier decisions which it is submitted should still apply. The main one is that the object of a reference being only to elucidate the true meaning of the claim, there is no need for such a reference where the specification and claims are properly drawn. The fact that the amount of invention is small is no ground in itself for the insertion of a reference, provided the specification and claim clearly show that it is only the small new part which is the subject of the patent (*r*).

Modern practice.

The great change which has occurred on the question of the insertion of references in oppositions is that whereas formerly an opposition was treated as being a proceeding *inter partes* (*s*),

R. P. C. 664; *Steel's Application*, 8 R. P. C. 235.

(*q*) *Newman's Application*, 5 R. P. C. 271; *Stell's Application*, 8 R. P. C. 235; *Marsden's Application* (No. 1), 13 R. P. C. 87; *Marsden's Application* (No. 2), 14 R. P. C. 174.

A different view seemed to be taken in *Hoffman's Application*, 7 R. P. C. 92, but this has not been followed.

In *Hoskin's Application* (1884), Griff. 292, a reference was inserted on the ground that the later invention would never have been made but for the fact that the applicant had seen the earlier one, but it does not appear that the claims of the later patent were directed only to the points of difference.

Where the applicant sets out in his specification as new what has formed the subject of a prior patent a reference may be ordered. *Teague's Patent* (1884), Griff. 298, and in one case it was suggested it might be done where the reference was in the applicant's provisional specification. *Hookham's Application* (1886), Griff. L. O. C. 32.

(*r*) *Adam's Application*, 13 R. P. C. 548; *Anderson & McKinnell's Application* (1887), Griff. L. O. C. 23; *Lorrain's Application*, 5 R. P. C. 142; *Stell's Application*, 8 R. P. C. 235; *Marsden's Application* (No. 1), 13 R. P. C. 87; *Marsden's Application* (No. 2), 14 R. P. C. 174. See also *Brockie's Application*, 25 R. P. C. 813, where earlier decisions were considered.

The rule was laid down most clearly by Sir Robert Finlay, S. G., in *Adam's Application*, *supra*, "... in some cases a reference to a prior patent may be desirable for the purpose of explaining what the claim of the applicant is. The applicant's claim may be worded in such a general way as to include not merely the improvement which he has effected, or thinks he has effected, but also details of construction which have formed the subject of a prior patent. . . . The amendment of the claim might be done, and it would be the most satisfactory and scientific way of doing it, by altering the language so as to direct the claim merely to those parts of the apparatus described which the applicant considers as his improvement. . . . I think that the same object which might have been achieved by properly limiting the claim in the first instance, or by embodying a proper amendment of the claim, may in substance be achieved by a reference to the prior patent."

(*s*) A reference to the earlier cases will show that this was so, although once an effective opposition has been launched the opponent was not *dominus litis* to the extent of being able to withdraw it whenever he wished, or to consent to an order being discharged, see p. 283, *n.* (*l*).

so that unless the opponent could make out a fair case for the refusal of the patent with the specification in its original form he had no right to ask for the insertion of a reference (*t*), the Office now treat an opposition as giving them again all the powers they had before the acceptance of the specification, both as regards refusing the patent or requiring amendment or references to specifications whether these have been referred to by the opponent or not (*u*). This affects the order which may be made in very important respects. For example, the Office has a right to require a reference on the ground of the invention having been wholly or partly described in a former specification, even if it is not claimed therein (*x*), but this gives no ground for opposition (*y*).

Grounds for reference.

The rule laid down by the earlier Law Officers was that a reference will not be given merely for the purpose of drawing attention to a former patent, if the claim of the later patent is clear and is for some additional feature (*z*). There was also a great disinclination, even in a case where some amendment was necessary, to insert a reference to a former specification unless it was clear that this was practically the first publication on the subject (*a*). These claims that the prior specification relied on was the first publication on the subject were usually

(*t*) *Marsden's Application* (No. 1), 13 R. P. C. 87; *Marsden's Application* (No. 2), 14 R. P. C. 174; *Lorrain's Application*, 5 R. P. C. 142; *Stell's Application*, 8 R. P. C. 235; *Brockie's Application*, 25 R. P. C. 813.

These cases show that the opponent had to make out that, at least on some possible construction of the applicant's claim, he has established a case for refusal and so justified his opposition.

(*u*) *Hughes & Kennaugh's Application*, 27 R. P. C. 281.

In this case the patent was refused on a specification not cited by the opponent, but produced by the examiner. The decision was upheld by the Law Officer who, however, intimated that the better course would have been to have amended the notice of opposition by inserting this specification.

Of course, in the absence of opposition the applicant has the right to obtain a patent on the expiration of two months from acceptance, the only power remaining in the office being to insert a statutory reference under s. 8. It is presumed that the office will only claim this extension of their powers in the case of there being some effective opposition, *e.g.* that it would not be exercised if the opponent failed to establish a locus. See also *Francis's Application*, 27 R. P. C. 86, C. G.; *Wadham's Application*, 27 R. P. C. 172.

(*x*) Sect. 7 (1) (4).

(*y*) Sect. 11 (1) (*b*). *Francis's Application*, 27 R. P. C. 86.

In some of the earlier cases, *e.g.* *Welch's Application*, 8 R. P. C. 442, it was said that a reference might be ordered where the invention had been either described or claimed in the earlier specification. *Von Buch's Application* (1887), Griff. L. O. C. 42; but see *contra Gozney's Application*, 5 R. P. C. 597.

(*z*) *Adam's Application*, 13 R. P. C. 548, and other cases quoted at p. 273, *n.* (*r*).

(*a*) *Guest's Application*, 5 R. P. C. 312; *Welch's Application*, 8 R. P. C. 442.

put forward by the use of the much-abused term "master patent," and there seems now to have grown up a tendency to treat the fact of the existence of a master patent as a separate ground for inserting a reference quite apart from any ambiguity in the applicant's claim, *i.e.* merely to draw attention to the existence of such master patent (*b*). It is somewhat difficult to reconcile this practice with the statutory grounds for opposition, unless it is said that it is impossible to properly describe a later invention without a reference to the earlier, which would, of course, be an entire reversal of the principles formerly applied (*c*).

Forms of reference.

There are several forms of reference which have been employed. The most stringent is a reference by name and number to an earlier specification, together with a disclaimer of anything claimed therein (*d*). Another form is a similar reference and disclaimer but the substance of the prior claim is set out instead of the name and number of the specification (*e*). Other forms are a statement that it has been proposed to do so and so (*f*), or a reference to a prior specification as showing a type of machine which has been formerly used or proposed (*g*), or a statement may be inserted that the later patent is for improvements in the type of articles shown in the earlier (*h*).

Object and effect of references.

The object and effect of references are very liable to be misunderstood. No form of reference is in any way an admission that the later invention is an infringement of the earlier one. A reference coupled with a disclaimer of course does limit the claims, and a reference by the patentee himself, even without a disclaimer, has the effect of saying that "in construing my specification you must remember that certain things have been already done, and therefore if there is any doubt as to the

(*b*) *Hopkin's Patent*, 27 R. P. C. 72 C. G.

The general principles on which the office proceeds in inserting specific references are here laid down. See also *Adam's Application*, 13 R. P. C. 548; *Meyenberg's Application*, 22 R. P. C. 356; *Levinstein's Application*, 11 R. P. C. 348.

(*c*) *E.g. Adam's Application, supra.*

(*d*) The disclaimer need only be of what is *claimed* in the former patent. *Gozney's Application*, 5 R. P. C. 597.

(*e*) *Newton's Application*, 17 R. P. C. 123. The difference between these two forms of reference was here discussed.

(*f*) But see as to the disadvantages of this form, *Atherton's Application*, 6 R. P. C. 547.

(*g*) *E.g. Van Gelder's Application*, 9 R. P. C. 325.

(*h*) *E.g. Hoskin's Application* (1884), Griff. 292.

In *Anderton's Application* (1887), Griff. L. O. C. 25, instead of a reference being inserted the construction of the applicant's specification was agreed and placed on record.

meaning of my claims you must take it that I have not claimed these *per se*" (*i*). But unless the reference is a specific one it does not incorporate the prior specification dealing with the matter disclaimed into the specification, or justify any reference to such an earlier specification in interpreting the later one. With regard to statutory references it seems very doubtful if these form any part of the specification or affect its construction in any way. They are merely a notice to the public by the Office that a reference to certain other specifications may be useful in enabling them to form an opinion as to the scope and validity of the later invention.

The inventor's objection to the insertion of such reference is usually a commercial one, namely, that if persons see that he has been compelled to give a reference to a prior specification they will think that the invention is of doubtful value, and also, if the reference is to an existing patent, will think that there is a grave danger of the later invention being held an infringement of the earlier one, and that therefore his patent, and possibly the articles manufactured under it, will by reason of the reference be more difficult to sell and of less commercial value.

Master patent.

Where the opponent claims to be opposing on a master patent (*k*) he must clearly state this claim, and be prepared to support it with evidence (*l*). In fact in any case where the opponent requires a specific reference to a particular specification he should be prepared with evidence as to the prior state of knowledge (*m*).

Concurrent applications.

Where a reference is sought to a specification which was not published at the time of the application special considerations

(*i*) See p. 118, *n.* (*y*).

(*k*) This was defined in *Hopkin's Patent*, 27 R. P. C. 72, as a patent for "the discovery of a new and important pioneer principle broadly claimed."

(*l*) *Southwell & Head's Application*, 16 R. P. C. 361.

A declaration under r. 4 or a statement under r. 40 must be filed clearly setting out what is said to be the master invention. It is not strictly necessary to file evidence in the first instance, but if the applicant challenges the opponent's claim the latter must be prepared with evidence dealing with the state of the art and prior specifications. A mere reference to the office search is not sufficient to support the claim to a master patent. 1911 *C. Hopkin's Patent*, 27 R. P. C. 72.

At one time a practice existed of setting up a claim to a master patent at the hearing and offering to subsequently file a declaration in support of this claim. This practice was most inconvenient, and was clearly undesirable. Where such a claim to a master patent is set up the applicant has, of course, the right to file evidence contesting the claim.

(*m*) *Stell's Application*, 8 R. P. C. 235.

apply (*n*), since such specification would not be an anticipation of, nor in any way affect the scope or validity of, the later patent (*o*), unless it could be pleaded as a prior grant (*p*). Where the earlier patent has not been sealed at the date of the hearing the references ordered will be conditional on a patent being granted on the prior application (*q*), and no reference will be granted on the ground of anything that is merely described in the earlier specification (*r*).

Procedure.

The opposition must be lodged within two months of the date of advertisement of the acceptance of the complete specification (*s*), and must state the grounds on which the opponent relies (*t*). If all that the opponent requires is some amendment or reference, and, subject to this being agreed to, would be prepared to let the patent go, he should send a statement to that effect either with the notice of opposition or as soon after as may be (*u*). If the opposition is on the first ground the opponent *must* file evidence within fourteen days of the expiration of the above-mentioned two months (*x*), and he *may* do so in other cases if he thinks fit (*y*). Whether or not evidence is filed by the opponent the applicant has the right to file evidence, and the opponent may then file evidence in reply (*z*).

(*n*) *Gaunt's Application*, 14 R. P. C. 387.

A practice of granting references to concurrent applications had, however, grown up before the present Act, and in a recent decision it has been laid down that the fact that the applications are concurrent is in no case a bar to the refusal of the second patent, but only makes the tribunal exercise greater care, 1912 *D.*

(*o*) Except of course in the case of disconformity, *cf.* s. 11 (1) (*c*).

(*p*) See Chapter IV., pt. 2.

(*q*) 1910 *G.*

(*r*) See Chapter IV., pt. 2, and p. 258.

(*s*) Sect. 11 (1). *Newman's Application*, 5 R. P. C. 271.

(*t*) Rule 40. Form 8 must be used. The form must be signed by the opponent, but where it has been signed by his agent leave may be given to amend. See *Lake's Application* (1887), Griff. L. O. C. 35.

(*u*) Rule 40. This statement should show generally the nature of the amendments required, and the portion of the earlier specifications relied on. The notice may ask for different alternatives, and if an order is made for any of these the opponent will in general get his costs unless the applicant has notified his willingness to make the alterations finally ordered. 1910 *H.* Where the opposition is on the third ground such notice is obligatory and should accompany the notice of opposition, r. 41 (2).

(*x*) Rule 41 (1). If this is not done the opposition will be considered as abandoned unless an extension of time is obtained.

(*y*) Rule 42.

(*z*) Rules 43, 44, 45. The applicant's evidence should be filed within fourteen days of the receipt of the opponent's evidence, or, if the opponent does not file evidence, within three months of the advertisement of acceptance. The opponent has a further fourteen days to file evidence in reply. All these times may be extended, r. 109. Further evidence may be filed by leave, r. 46. Unnecessary declarations may lead to the party responsible having to pay costs. *Brand's Application*, 12 R. P. C. 102.

Either party has the right to ask for a hearing, but if neither does so the Comptroller will decide the case without a hearing (*a*). Notice must be given, at least five days before the hearing, of any publication, not mentioned in the notice or declarations to which either party intends to refer (*b*).

At the hearing the applicant has the right to begin except where the opposition is on the first ground (*c*). The opposition is generally conducted on the declarations filed, but the Comptroller has power to take oral evidence, either from the deponents or from other persons, or to order the deponents to attend for cross-examination (*d*). As a general rule the tribunal attempts to avoid elaborate scientific evidence, as, if there is need for this, the proper course is probably to allow the patent and leave the parties to go to the Court (*e*).

The Comptroller has power, either at or before the hearing, to allow the notice of opposition to be amended either by adding fresh specifications (*f*), or an entirely new ground of opposition, even though the two months has elapsed (*g*), but such amendment is not a matter of right (*h*).

The Comptroller may at the hearing of an opposition allow or require such amendment as he thinks fit, and this is made without any formalities or advertisement (*i*). Such amendment, however, is not a matter of right, and the applicant who has claimed widely, and then on opposition seeks to cut his patent down to some small detail, is in danger of losing it altogether (*k*), or of having an order made for specific references which might have otherwise been avoided (*l*). This applies

(*a*) Rule 47. Each party who desires to be heard must leave form 9 before the date of the hearing, and if this is not done the Comptroller may refuse to hear him. Even if the opponent does not appear the custom is to have a hearing, and amendments may be allowed at such hearing.

(*b*) Rule 47.

(*c*) 1910 *F.*

(*d*) Sect. 77 (1).

(*e*) *Cf.* 1910 *D.*, and *Lake's Application*, 6 R. P. C. 549.

(*f*) 1910 *C.*

(*g*) *Boehm's Application*, 23509 of 1908 (unreported). See also *Airen's Application*, 5 R. P. C. 349; *Daniel's Application*, 5 R. P. C. 414.

(*h*) 1910 *C.*

(*i*) This applies also to amendments asked for by notice under Rule 40 and made by consent.

(*k*) *Harrild & Perkin's Application*, 17 R. P. C. 617; *Lupton's & Place's Application*, 14 R. P. C. 261; *Thomas & Prevost's Application*, 16 R. P. C. 69; *Garnett's Application*, 16 R. P. C. 154; *Mill's Application*, 18 R. P. C. 322; *Crist's Application*, 20 R. P. C. 475.

(*l*) Where the main claim is anticipated and only a minimum of invention left great care will be taken that the claims are strictly limited, and the opponent's claim to a master patent will not be narrowly examined. *Sachse's Application*, 18 R. P. C. 221; *Hamilton's Application*, 19 R. P. C. 33.

particularly where this detail formed no part of the original claim (*m*).

The Act provides that any person who would have had the right to oppose may apply to the Comptroller to revoke a patent on any of the grounds on which he might have opposed (*n*). These "belated oppositions" are conducted in all respects like an ordinary opposition and the same orders as to amendment may be made as in the case of an opposition (*o*). No application may be made under this section when an action for infringement or proceedings for the revocation of the patent are pending in any Court, without the leave of the Court (*p*). Application to revoke on opposition grounds.

Amendment.

Amendments may be made in the application, the commonest form being by the addition of fresh applicants or the omission of some of the original applicants. The persons to whom the patent is granted must, however, always include those who declared themselves to be the inventors except in the case of death. Amendment of application or provisional.

There are no provisions for the amendment of a provisional specification, but it is the practice of the Office to allow amendment by excision.

The applications for amendment of the complete specification which may be made to the Comptroller (*q*) fall into the following classes :— Different classes of amendment.

(1) Applications made before acceptance. Here there are no formalities as to advertisement and no fixed rules as to the character of the amendment allowed (*r*).

(*m*) *Harrild & Perkin's Application, supra ; Whittaker's Application*, 13 R. P. C. 580.

(*n*) Sect. 26.

(*o*) See pp. 272 *et seq.* See also *Hopkin's Patent*, 27 R. P. C. 72, and p. 278.

(*p*) Sect. 26 (1).

It is not the practice to permit a person who has opposed unsuccessfully to apply to revoke under this section. Nor is it the practice to permit an application under this section before the patent has been sealed.

(*q*) As to when applications may be made to the Comptroller, and as to applications to the Court, see AMENDMENT, p. 231.

(*r*) But the proposed amendment must not introduce a wider or different invention from that originally described. See *C.'s Application*, 7 R. P. C. 250. Subject to this, however, the practice of the office is generous to the inventor, and he is allowed to shape his claim so as to cover any material feature of his invention disclosed in the specification or drawings as originally filed, even if such feature were not claimed in the first instance, *Serex's Patent*, 29 R. P. C. 287. But it must be remembered that such changes may involve the necessity for further searches, for which there may be no time.

(2) Applications to amend an accepted specification under the provisions of section 8 (*s*).
(3) Applications for amendment during the course of an opposition or application to revoke under section 26 (*t*).
(4) Applications made after acceptance (otherwise than as in (3)) provided that no action for infringement or proceeding before the Court for revocation is pending. Here the application must be to amend by way of disclaimer correction or explanation (*u*). The application must set out the proposed amendment and give reasons (*x*) for the application. The request and proposed amendment must be advertised and any person may, within one month of the first advertisement, oppose the amendment (*y*). Evidence may or may not be filed and the Comptroller may give his decision with or without a hearing (*z*).

Amendment of specification after acceptance.

An amendment on application to the Comptroller may be by way of disclaimer, correction, or explanation, but must be such as not to make the specification claim an invention substantially larger than or different from that claimed before amendment (*b*). Since it has been decided that once an amendment is allowed its propriety cannot be further challenged (*c*), greater care has been exercised in criticising the allowability of proposed amendments (*d*). Generally an amendment which confines a claim by incorporating as additional essential elements matters described in the specification as intended to be used with the apparatus, etc., covered by the claim (*e*), or which disclaims

(*s*) See rr. 33–35.
(*t*) See pp. 272, 279.
(*u*) Sect. 21, rr. 60–67. Application to be made on Patent Form 17.
(*x*) *Ibid.* The reasons given will not be closely scrutinised. *Ashworth's Patent* (1886), Griff. L. O. C. 6.
(*y*) Sect. 21. There has been no general decision limiting the meaning of the term "any person" in this section, but see *Bell's Patent* (1887), Griff. L. O. C. 12. See also p. 264. Notice of Opposition to be on Patent Form 18.
(*z*) Opponent's evidence to be left within fourteen days of expiration of a month from first advertisement. Applicant's evidence within fourteen days of this, or, if opponent does not file evidence, within two months of first advertisement. Further proceedings as in the case of opposition, see p. 277. As to absence of any declaration by applicant, see *Ryland's Patent*, 5 R. P. C. 665.
(*b*) Sect. 21. For cases in the Courts where amendments have been held not to transgress this rule see *Kelly* v. *Heathman*, 7 R. P. C. 343; *Farbenfabriken, &c.* v. *Bowker*, 8 R. P. C. 396; *Moser* v. *Marsden*, 13 R. P. C. 24, H. L.; *Dick* v. *Tullis*, 13 R. P. C. 155, O. H.; *Perry* v. *Société des Lunetiers*, 13 R. P. C. 670.
(*c*) *Moser* v. *Marsden*, 13 R. P. C. 24, H. L.
(*d*) See *Knight* v. *Argyll's, Ltd.*, 29 R. P. C. 610.
(*e*) *Cochrane's Patent* (1885), Griff. 304; *Ashworth's Patent* (1886), Griff. L. O. C. 5; *Serrel's Patent*, 6 R. P. C.

some of the alternatives allowed by the specification (*f*), will be permitted. So a combination claim will in general be allowed by way of amendment when it is clear that the use of its various parts in combination was contemplated by the original specification (*g*). But it does not necessarily follow that a patentee will be allowed to change a claim, which has been deliberately drawn so as to cover a principle broadly, into one for some specific detail mentioned in the specification (*h*), and the difficulty is far greater where the particular means were not there mentioned (*i*). Of course these objections do not apply if it is merely a case of striking out one broad claim and leaving a narrower one. Generally speaking it will be assumed that the amendment makes some difference in the meaning of the specification, and it is for the applicant to show that it does not make it claim a substantially different invention (*k*). An amendment will not generally be allowed which excises or alters some statement of fact which was an essential part of the patentee's original statement of his invention (*l*), nor will one which incorporates subsequently-acquired knowledge (*m*). But if an ambiguous term has been used the patentee may define what he meant at the time of filing the original specification (*n*). It would seem that amendments will be more readily allowed where the patentee shows that the specification does not in

101. But the new claim must be in restriction of, and not in substitution for, the old, *ibid.*

(*f*) *Ryland's Patent*, 5 R. P. C. 665; *Dellwik's Patent*, 15 R. P. C. 862; *Nordenfeld's Patent* (1887), Griff. L. O. C. 18.

(*g*) *Kelly* v. *Heathman*, 7 R. P. C. 443; *Hattersley and Jackson's Patent*, 21 R. P. C. 233; *Golstein's Patent*, 27 R. P. C. 289.

(*h*) *Serrel's Patent*, 6 R. P. C. 101; *Lang's Patent*, 7 R. P. C. 469; *Ashworth's Patent* (1886), Griff. L. O. C. 5; *Parkinson's Patent*, 13 R. P. C. 509.

(*i*) *Nairn's Patent*, 8 R. P. C. 444; *Walker's Patent*, Griff. L. O. C. 5; *Hattersley and Jackson's Patent*, 21 R. P. C. 233.

In this last case the patentee had by a former amendment struck out one claim and all the letterpress referring to it. He then sought to amend again by making the remaining claim into a combination claim for the matters claimed in the two original claims. It was held that he could not do so. See also *Ralston* v. *Smith* (1865), 11 H. L. C. 223.

It must be remembered that if the general form mentioned in the original specification is old, and the only novelty lies in the specific details, now for the first time introduced, the patentee is incorporating a new invention. *Cf.* DISCONFORMITY, p. 105.

(*k*) *Knight* v. *Argyll's, Ltd.*, 29 R. P. C. 610; *Vidal's Patent*, 15 R. P. C. 721.

Prior to the decision in *Moser* v. *Marsden*, 13 R. P. C. 24, H. L., a different view prevailed. See *Luke's Patent* (1887), Griff. L. O. C. 16.

(*l*) *Johnson's Patent*, 13 R. P. C. 659; *Alsop's Patent*, 24 R. P. C. 684.

(*m*) *Beck and Justice's Patent* (1886), Griff. L. O. C. 10.

(*n*) *Johnson's Patent*, 26 R. P. C. 780; *Farbenfabriken, &c.* v. *Boucker*, 8 R. P. C. 396.

fact express what he meant to express (*p*). An amendment will not be allowed suggesting demerits in prior patented processes, at any rate without evidence as to the truth of such suggestions (*q*).

In a proper case drawings, etc., may be added by way of amendment (*r*) or a drawing described in the letter press (*s*).

Leave to amend a matter of grace.

It must always be remembered that amendment is a matter of grace, not of right, and the tribunal takes into account a large range of matters, such as the nature of the specification (*t*), the age of the patent (*u*), the conduct of the patentee in making repeated amendments (*x*), or in lying by so as to let the trade start manufacture on the assumption that the patent is invalid (*y*), or in keeping in a claim to terrorise the trade (*z*), or in delaying the application after knowledge of infringement (*a*), etc. The tribunal has power to impose terms as a condition of allowing the amendment, though it rarely does so (*b*). An amendment will not be allowed if it has been decided by the House of Lords that there is a total lack of subject matter (*c*), or if the tribunal itself is so clear as to the lack of subject matter in the specification with the proposed amendments that it would refuse to grant a patent on it in a case of opposition (*d*). Again amendments or disclaimers may be required to be inserted as in an opposition (*e*). So, too, an amendment will not be permitted which is of such a vague character as to make

(*p*) *Johnson's Patent*, 13 R. P. C. 659; *Johnson's Patent*, 26 R. P. C. 780; *Allen's Patent* (1885), Griff. L. O. C. 3. See also *Birt's Application*, 9 R. P. C. 489, 491; *Beck and Justice's Patent* (1886), Griff. L. O. C. 10; *Farbenfabriken, &c.* v. *Bowker*, *supra*.

(*q*) *Hampson and Fucer's Patent* (1887), Griff. L. O. C. 13.

(*r*) *Lang's Patent*, 7 R. P. C. 469.

(*s*) *Morgan's Patent* (1886), Griff. L. O. C. 17.

(*t*) 1911 *A*. *Haddan's Patent* (1885), Griff. L. O. C. 12.

(*u*) *Cf. Klaber's Patent*, 22 R. P. C. 416.

(*x*) *Johnson's Patent*, 13 R. P. C. 659. See *contra*, *Lang's Patent*, 7 R. P. C. 469.

(*y*) *Allison's Patent*, 15 R. P. C. 408.

(*z*) *Ainsworth's Patent*, 13 R. P. C. 76; *Ashworth's Patent*, Griff. L. O. C. 5.

(*a*) *Corrigal* v. *Armstrong*, 20 R. P. C. 523.

(*b*) *Hearson's Patent*, 1 R. P. C. 213; *Allen's Patent* (1885), Griff. L. O. C. 3; *Ashworth's Patent* (1886), Griff. L. O. C. 5; *Ainsworth's Patent*, 13 R. P. C. 76; *Allison's Patent*, 15 R. P. C. 408; *Pitt's Patents*, 18 R. P. C. 478; *Davies Patent*, 28 R. P. C. 50.

(*c*) *Hennebique's Patent*, 28 R. P. C. 41. See also *Parkinson's Patent*, 13 R. P. C. 509.

It is submitted that this should not be done merely on a decision of a lower Court, since the patentee may wish to appeal on the question of subject-matter after removing the indefensible claim. *Cf.* also *Hoffman's Application*, 7 R. P. C. 92.

(*d*) 1911 *A*, but see *contra*, *Bell's Patent* (1887), Griff. L. O. C. 10.

(*e*) 1911 *A*, but see *Bell's Patent*, *supra*.

litigation necessary for its elucidation (*f*). An appeal to the Law Officer lies against any decision of the Comptroller (*g*), but if a decision refusing an amendment is not appealed against, no subsequent application for such amendment can be entertained unless the failure to appeal against the former decision is satisfactorily explained (*h*).

Correction of clerical errors.

Besides the power to amend a specification by limiting the scope or making a correction in the description the Comptroller has also power to amend clerical errors in any application, patent, or specification, or in any matter on the register. Such a correction can be made at any time, whether legal proceedings are pending or not, and need not be advertised (*i*).

Appeal.

An appeal lies from any requirement made by an examiner to the Comptroller or to one of the persons who exercise his functions, and from such decision there is in all cases an appeal to the Law Officer (*k*). An appeal lies to the Law Officer also against a decision in an opposition (*l*), or with regard to amendment (*m*). These appeals must be lodged within fourteen days of the dates of the decision appealed against (*n*). In the case

(*f*) *Parkinson's Patent*, 13 R. P. C. 509.

(*g*) Sect. 21 (5).

(*h*) *Arnold's Patent* (1887), Griff. L. O. C. 5.

(*i*) Sect. 70.

Certain cases reported under the early practice when the amendment was made by the M. R. may throw some light on what alterations can be so made. See *Nickels' Patent* (1841), 4 Beav. 563; *Whitehouse's Patent* (1838), W. P. C. 473; *Sharp's Patent* (1840), W. P. C. 641.

Delay in making the application might be a ground for refusing it. *Jardine Blamond's Patent* (1860), 3 L. T. 800.

(*k*) That is to say there is always an appeal against the refusal of the comptroller to accept the specification if the requirement is not complied with. See *J. and J.'s Application*, 28 R. P. C. 625.

An appeal against a statutory reference under s. 7 is given by s. 7 (5), and the effect of s. 8 (1) is to apply the right of appeal so given to the case of references under s. 8, since the provisions are not inconsistent.

(*l*) Sect. 11 (3). The withdrawal of the opponent does not give the applicant the right to have the comptroller's order set aside on appeal. *Kempton and Molan's Application*, 22 R. P. C. 573.

The Law Officer has power even after deciding such an appeal to grant a re-hearing, but will not do so merely because the opponent is willing to withdraw. *Thomas and Provost's Application*, 15 R. P. C. 257.

(*m*) Sect. 21 (5).

(*n*) L. O. R. r. 1. Where the C. G.'s decision does not definitely fix form of specification the time runs from the time when amended copy of specification is forwarded. *Chandler's Application*, Griff. 273; *Cooper and Ford's Application*, Griff. 276.

The time may be extended either by the Comptroller or Law Officer, r. 3. Notice of appeal may be signed by an agent. *Anderson's Application* (1887), Griff. L. O. C. 23.

Generally speaking the evidence is the same as that used below, but the

of an application to revoke a patent under sections 26 or 27 an appeal lies to the Court (*o*), and in a case where the order of the Comptroller has been for the revocation of the patent under section 26 the decision of the Court may be appealed against in the ordinary way. In other cases the decision of the Court is final (*p*). The Court for this purpose means the judge who is selected by the Lord Chancellor for the purpose (*q*). In the case of an application for the restoration of a patent the appeal is also to the Court, whose decision is final (*r*). The only form of appeal against an entry, or a refusal to make an entry, on the register is by moving to rectify the register (*s*). It has also been the practice to allow an appeal on matters not strictly covered by these provisions (*t*).

Restoration of Lapsed Patents.

In order to maintain a patent in force it is necessary to pay the renewal fees prescribed by the Act or Rules (*u*).

Law Officer may allow further declarations or oral evidence or cross-examination, rr. 8 and 9. The Law Officer has power to give costs and such order may be made a rule of Court, s. 40.

The Law Officer will not allow new grounds of opposition to be raised or fresh specifications to be quoted against the applicant. *Bailey's Application*, Griff. 269.

Nor will an opponent who has filed no evidence below on the charge of fraud be allowed to do so on appeal. *Huth's Application* (1884), Griff. 202.

These appeals are of the nature of re-hearings. *Stubb's Application*, Griff. 298.

The Law Officer has power to send a case back to the comptroller for re-hearing. *Warman's Application*, Griff. L. O. C. 43.

In one case it was held that where the Law Officer decided that the opponent was not entitled to be heard, the C. G.'s decision might still stand, but this seems to have been on the view that it was only necessary to show a locus if there was an appeal to the Law Officer. *Heath and Frost's Application*, Griff. 200.

(*o*) Sect. 26 (4); s. 27 (4). Such appeal must be lodged within one month, O. 53*a*, r. 4. The time runs in vacation, and though the Court has power to extend it, this will not be done merely because agents or counsel have been dilatory. *Beldam's Patent*, 27 R. P. C. 758.

The appeal is by petition, and in a proper case a person who has not appeared below may present such petition. *Jonkergouw and Destrez's Patent*, 27 R. P. C. 540.

(*p*) Sect. 92 (2).

(*q*) *Ibid.*

(*r*) Sect. 20 (5), O. 53*a*, r. 4.

It is doubtful whether there is any appeal against a refusal of the comptroller to let an application for restoration go to advertisement, but such an appeal has been heard by consent. *Land's Patent*, 27 R. P. C. 481.

(*s*) Sect. 72.

(*t*) *E.g.* refusal of an application as not being for a manufacture or as being for more than one invention, see p. 255, *n.* (*d*).

(*u*) Sect. 65, rr. 52–54. The fees are £5, payable at end of fourth year, for fifth year, and increase each year by £1. A fee is in time if paid on the same day of the year as the patent is dated. *Williams* v. *Nash* (1859), 28 Beav. 93. See also *Watson* v. *Pearl* (1809), Davies, 325. A notification is sent to the patentee, or the person who paid last fee, one month before next fee is due. An extension of one, two, or three months may be obtained on payment of a fee of £1, £3 or £5.

Where a patent has become void owing to the failure of the patentee to pay these fees within the prescribed time an application may be made to the Comptroller for an order for the restoration of the patent, accompanied by a statement as to the circumstances which led to the omission. If it appears from such statement that the omission was unintentional, and no undue delay has occurred in the making of the application, the Comptroller shall advertise such application, and any person may oppose the same within two months from the first advertisement. After the expiration of two months from such advertisement the Comptroller will hear the case and may issue an order restoring the patent (*x*).

This procedure replaces the old procedure by private Bill, and the Comptroller will probably be largely guided in exercising his discretion by the considerations on which Committees decided whether such bills should be passed (*y*).

The rules provide that the order for restoration shall contain provisions protecting and preserving the rights of persons who have infringed the patent, or used, purchased, or sold any patented article, or installed patented machinery, between the date when the patent was advertised as void and the date of the order (*z*). The order also provides for an application being made to the Board of Trade within a year by any person who has expended money, time or labour on the subject-matter of the patent in the *bonâ fide* belief that it was void, for the assessment of the compensation which in their opinion should be awarded to him. If such money is not paid the patent becomes void, but the sum awarded cannot in that case be recovered (*a*).

(*x*) Sect. 20, and rr. 55–59. The fee on the application is £20. The rules as to leaving evidence, &c. are very similar to those in the case of oppositions. The hearing is necessary even in the absence of opposition. As to appeals, see p. 283.

(*y*) The fact that a patentee has acted under a misapprehension of law, *e.g.* as to the protection afforded by the patent in question or another patent, does not make the failure to pay unintentional. If the patentee knew that the fee has become payable and deliberately omitted to pay it, that is not within the section. *Land's Patent*, 1910 *I*, & 27 R. P. C. 481.

This procedure does not extend to all cases where a Private Act might have been obtained, *ibid.* But a perusal of the preambles of the Private Acts passed for this purpose do not show any cases not coming within the term "inadvertence," except cases where letters, &c. had gone wrong. Relief was frequently granted where the omission was due to the fraud or carelessness of an agent.

The fact that failure to pay was caused by poverty is not in itself a reason for restoration, but the poverty of the applicant may have some bearing on whether the application to restore has been made without undue delay.

(*z*) R. 58, s. 20 (3).

(*a*) R. 59.

Registration of Title.

Register.

A register is kept at the Patent Office in which are entered the names and addresses of grantees of patents, notices of assignments, amendments, extensions, revocations, and such other matters as may be ordered (*b*). On it are entered changes of proprietorship, notifications of claims, etc. (*c*). No notice of a trust is to be entered (*d*), but notice of an equitable assignment of a patent, or of a share in a patent, will be entered (*e*). The register kept under former Acts is incorporated in and forms part of the register (*f*). This register is open to inspection by the public (*g*), who are deemed to have notice of any matter affecting the proprietorship entered therein (*h*). The register or a certified extract is *primâ facie* proof of any matter directed or authorised to be entered therein (*i*).

A person desiring to be entered on the register as having an interest in a patent, or desiring to have a notification of a document entered upon the register, must produce the necessary documents to the Comptroller together with such proof of title as the Comptroller may require. The patentee and other persons appearing from the register to be interested will be notified, and may oppose the change (*k*).

(*b*) Sect. 28. The additional matters would seem to be date of grant, address for service (rr. 82–84), date of application in this country in the case of Convention patents (r. 83), notice of interest (rr. 85–90), notification of documents purporting to affect proprietorship (r. 91), notice of payment or nonpayment of fees (rr. 92–93).

(*c*) See last note. Also s. 71, and r. 85. The entry shows whether the interest is that of proprietor or mortgagee. See *Van Gelder Apsimon & Coy.* v. *Sowerby Bridge Flour Society, Ltd.*, 7 R. P. C. 208, C. A.

(*d*) Sect. 67.

(*e*) See *Stewart* v. *Casey*, 8 R. P. C. 258.

(*f*) Sect. 28 (2).

(*g*) Sect. 67 and r. 94.

(*h*) See p. 10.

(*i*) Sect. 28 (3).

(*k*) Any person may give notice at the Patent Office that he wishes to be notified as to any application for change of proprietorship, &c. of a patent. *Viola* v. *Sharpe*, 22 R. P. C. 23.

In case of opposition the C. G. will, if necessary, grant a hearing. The custom has grown up of the opponent giving a written statement of his grounds of opposition, but such notice is not required by the Act or rules, and the opponent would not seem to be confined to the grounds so given. There is no power to grant costs on such opposition, nor is there any appeal, except by a motion for rectification.

In accordance with the decision in *Bowden's Patents Syndicate, Ltd.* v. *Smith*, 21 R. P. C. 438, no entry of change of proprietorship will be entered on a document bearing a date before that on which the patent was sealed, 1910 *E*; though a notification of such document may be entered, *ibid.*

Generally speaking the C. G. will not go behind the documents or consider equitable objections to them, but he may delay registering the change of proprietorship to allow these points to be raised in the Courts, *ibid.*

For a notification of a document to be entered on the register it must generally speaking refer to the particular patent. It is doubtful whether a document earlier than the application could ever be entered. *Parnell's Patent*, 5 R. P. C. 126. See also

Any person aggrieved (*l*) by any entry in the register, or by the non-insertion of any entry, may apply to the Court for rectification of the register (*m*). The Court may in such proceedings decide any question which is necessary or expedient in connection therewith (*n*). The Comptroller is to be served with notice, and may, and if the Court so direct shall, appear. Any order in such proceeding shall be served on the Comptroller, who shall thereupon make any necessary alteration in the register (*o*).

Rectification of the register.

Evidence and Costs.

Evidence is generally by means of Statutory declaration (*p*), but the Comptroller may, if he thinks fit, take the evidence

Evidence before the comptroller.

Haslett v. *Hutchinson*, 8 R. P. C. 457. As to what documents may be entered, see *Stewart* v. *Casey*, 8 R. P. C. 258.

An incomplete agreement should not be entered. *Fletcher's Patent*, 10 R. P. C. 252.

When a company, after selling a patent was dissolved before an assignment was executed, the C. G. registered the purchaser as proprietor. *Re Taylor's Agreement Trusts*, 21 R. P. C. 713. See also *Heath's Patent*, 29 R. P. C. 389.

(*l*) This expression is given a wide interpretation. *Cf. Manning's Patent*, 20 R. P. C. 74; *Stewart* v. *Casey*, 8 R. P. C. 258, C. A.; *Haslett* v. *Hutchinson*, 8 R. P. C. 457; *Fletcher's Patent*, 10 R. P. C. 252; *Horsley and Knighton's Patent* (1869), L. R. 8 Eq. 475, and the decisions on the corresponding section of the Acts referring to trade marks especially, *Apollinaris Co.'s Trade Mark*, R. P. C. 137, C. A.

Generally a wrongful entry will be expunged if it appears to complicate or adversely affect any person's title, see *Ex parte Green* (1857), 24 Beav. 145. Cases in which entries have been expunged are. Entry of later assignee, *Ex parte Green*, *supra*. *Morey's Patent* (1858), 25 Beav. 481.

Assignment by one of two co-patentees of his share purporting also to give a release from claims by the other patentee. *Horsley and Knighton's Patent* (1869), L. R. 8 Eq. 475.

Entry of agreement expunged on ground (*inter alia*) that it did not show variations which had been agreed to by parties. *Haslett* v. *Hutchinson*, 8 R. P. C. 451.

Entry of agreement expunged on ground that it was not complete. *Fletcher's Patent*, 10 R. P. C. 252. Unsuccessful applications to expunge entries were made in *Manning's Patent*, *supra*; *Casey's Patents*, 8 R. P. C. 208; *Anderson* v. *Patent Oxonite Coy.*, 3 R. P. C. 279.

An order for rectification will not be made if the entry is correct at the time of hearing, though it was not so at the time when the proceedings commenced. *Manning's Patent*, 20 R. P. C. 74.

Where the entry is wrong in some particulars it may be ordered to be expunged instead of being rectified. *Haslett* v. *Hutchinson*, 8 R. P. C. 457.

(*m*) Sect. 72. No special procedure is prescribed, but the application is always made by motion, see cases in last note, and at least four clear days' notice must be given to the Comptroller, r. 113.

As this is not an appeal from the Patent Office the provisions of the Act as to reference to a particular Judge, evidence, and appeal do not apply. The motion for rectification may be heard with a motion or action by the patentee. *Anderson* v. *Patent Oxonite Coy.*, 3 R. P. C. 279.

According to the practice in trade mark cases the Scotch and Irish Courts have jurisdiction to make such orders, s. 94 (7), and s. 95 (3).

(*n*) Sect. 72 (3).

(*o*) Sect. 72 (4). As to the service of such orders, see r. 113. In view of the wording of this sub-section it is probably necessary to obtain a stay if there is an appeal. Formerly this was not so, see *Fletcher's Patent*, 10 R. P. C. 252.

(*p*) As to form and method of making these, see rr. 106 and 107.

vivâ voce in lieu of or in addition to evidence by declaration, or allow any declarant to be cross-examined on his declaration (*q*). Generally speaking contests of evidence as to scientific facts are to be discouraged, and, if possible, such decision will be given as will enable the question to be raised in the Courts (*r*).

Costs.

The Comptroller has power to give costs in cases of opposition, revocation, or amendment, and any such order may be made a rule of Court. Where an opponent to the grant of a patent, or applicant for revocation, or any person giving notice of appeal from a decision of the Comptroller, neither resides or carries on business in the United Kingdom or the Isle of Man, the Comptroller may require such person to give security for costs (*s*).

Post, Time, etc.

Any communication to the Office, Comptroller, or other person may be made by post (*t*).

Whenever the last day for doing anything shall fall on a Saturday or a day when the Office is closed (both of which are termed excluded days) it may be done on the next day which is not an excluded day (*u*).

Patent Agents.

Nearly all acts which have to be done by an applicant or patentee may be done by his properly appointed agent (*x*). Any person, with certain statutory exceptions (*y*), may act as such an agent, but he must not use the term "Patent Agent" or describe himself as a patent agent unless he is on the

(*q*) Sect. 77. As to declarations by infants, lunatics, &c., see sect. 83.

(*r*) See 1910 *D*, where directions are given as to how experiments should preferably be performed.

(*s*) Sect. 39. It should be noted that apart from this section the C.-G. has no power over costs. *Cf. Kynoch* v. *National Arms Coy.* (1877), 37 L. T 31.

(*t*) Sect. 81.

(*u*) Sect. 82 and rr. 110–111, which also state the days when the office is closed.

(*x*) Sect. 85. As to excepted matters see r. 9.

(*y*) Sect. 85. These are that the C.-G. need not recognise as an agent any person whose name has been erased from the Register of Patent Agents, or who has been proved to the satisfaction of the Board of Trade, after he has had an opportunity of being heard, to have been guilty of such conduct as would have rendered him liable to be struck off the list had he been on it. Nor need he recognise as agent a company or firm if any such person is a director or manager of such company, or a partner in such firm. He *shall* not recognise as such agent any person who neither resides nor has a place of business in the United Kingdom. As to the procedure for the removal of names from the register, see Register of Patent Agents' Rules.

register (*z*). Any person who proves that prior to the 24th December, 1888, he had been *bonâ fide* practising as a patent agent is entitled to be registered; but until he is so registered he must not represent himself as a patent agent (*a*). Other persons may be admitted to the register on the passing of the necessary examinations (*b*).

General Powers of the Comptroller and Board of Trade.

General powers of the comptroller.

The Comptroller has the general management of the Patent Office (*c*). A certificate granted by him as to any entry matter or thing which he is authorised by the Act or Rules to make or do is *primâ facie* evidence of such matter or thing, and copies or extracts certified by him are evidence in all parts of the Empire without production of the originals (*d*).

Where he has any discretionary power under the Act he shall not exercise it adversely to an applicant for a patent or

(*z*) Sect. 84. A description as "Patent Expert," or a statement that a man can do the work of a patent agent is not an offence. *Graham* v. *Eli and Ors*, 15 R. P. C. 259; *Graham* v. *Turner*, 29 R. P. C. 688. Nor is it an offence to sign a specification as "agent for the applicant." *Graham* v. *Fanta*, 9 R. P. C. 164.

Since the Act (or rather the 1883 Act) has created a new offence and fixed a penalty, no other form of procedure is open, and an action for an injunction to restrain a man from passing himself off as a patent agent will not lie. *Chartered Institute of Patent Agents* v. *Lockwood*, 11 R. P. C. 274, H. L.

(*a*) Sect. 84. *Storey* v. *Graham*, 16 R. P. C. 106.

(*b*) See Register of Patent Agents' Rules.

It may be useful to add a few remarks as to the duties and position of a patent agent. Any person undertaking work in this capacity, whether registered or not, warrants that he has the special knowledge and skill necessary for this purpose, and is liable in damages if by reason of his default in these matters his employer suffers loss; *e.g.* where patent agent, from ignorance of a decision on procedure, allowed a rival applicant to obtain a patent, he was held liable. *Lee* v. *Walker* (1871), 7 L. R. C. P. 121.

Again he is responsible if loss occurs from his negligence, *e.g.* if a patent becomes void through his failure to pay a fee or notify his employer. *Turnbull* v. *Cruikshank*, 22 R. P. C. 521, I. H.

In this case it was held that the defendant could not give evidence to show that the patent was invalid in order to limit the damages, *sed quaere*. It should also be remembered that there is no privilege for communications between a patent agent and his client, *i.e.* either can be questioned as to what passed between them, or be compelled to produce written communications, and this applies even where the patent agent is a solicitor if he is in fact acting in the former capacity. *Moseley* v. *Victoria Rubber Coy.*, 3 R. P. C. 355. Care should, therefore, be taken as to the contents of written communications to patent agents. Of course if the communication is for the purpose of obtaining information solely for the purpose of enabling the client's *solicitor* to advise him or prepare for litigation, or if the patent agent makes a report for this purpose, such documents are provided. See Annual Practice Notes to O. 31, r. 1.

(*c*) Sect. 63.

(*d*) Sects. 78 and 79. The seal of the Patent Office is judicially noticed, s. 64.

for amendment without giving such applicant an opportunity of being heard (*e*).

He may apply to the Law Officer for directions in any matter (*f*).

He may refuse to grant a patent for an invention the use of which would in his opinion be contrary to law or morality (*g*).

He may correct clerical errors in or in connection with any application, specification, or patent or in any matter entered on the register (*h*).

He may issue duplicates of lost patents (*i*).

He may accept the surrender of a patent (*j*).

He may allow amendment of any document as to the amendment of which there are no special rules (*k*).

He may enlarge the time for doing any act in the office for which a time is prescribed by the Rules only, except the three months between lodging a Convention application and lodging the necessary documents, the two months' time for opposition to the restoration of a patent and the times for lodging evidence in Petitions for compulsory Licence, where extension must be given by the Board of Trade (*l*).

He may dispense with any act, thing, signature, declaration, or evidence prescribed by the Rules only (*m*).

Comptroller and law officer acting judicially.

A mandamus will not be granted against a Law Officer as to any proceedings before him, nor against the Comptroller in any matter where he has exercised his discretion or where, having a discretion, he has taken the directions of the Law Officer (*n*). A mandamus would, however, probably be granted in the case of failure to exercise any ministerial function or to do what he is directed to do by the Act—*e.g.* if he refused to seal a patent on a specification which has been accepted, and where there has been no opposition, and the applicant has complied with the necessary conditions for sealing. Nor will prohibition be granted as to any matter within the Comptroller's jurisdiction, though *semble* it might be if he entertained an application improperly made (*o*).

Powers of the Board of Trade.

The Board of Trade has power to make rules on certain matters, subject to the provisions of the Act, and to repeal

(*e*) Sect. 73, rr. 102–105.
(*f*) Sect. 74.
(*g*) Sect. 75.
(*h*) Sect. 70, see p. 283.
(*i*) R. 100.
(*j*) Sect. 26 (3), r. 77.
(*k*) R. 108.
(*l*) R. 109.
(*m*) R. 112.

(*n*) *R.* v. *Comptroller-General* (*ex parte Tomlinson*), 16 R. P. C. 233, C. A.

(*o*) *Van Gelder's Patent*, 6 R. P. C. 23. In this case a rule *nisi* for a prohibition to the C.-G., against entertaining an application for amendment which had not been duly advertised, was granted, but was not proceeded with.

these and to make new rules. Such rules must be advertised and must be laid before both Houses of Parliament as soon as practicable after they are made. If either House of Parliament, within forty days after the rules have been laid before it, resolves that any rule ought to be annulled such rule shall after the date of such resolution be of no effect, without prejudice to the validity of anything done in the meantime under the rules, or to the making of any new rules. Generally rules while in force have the same effect as if they were contained in the Act (*p*).

The Board of Trade may do any act through certain officials, and orders sealed with their seal are *primâ facie* evidence of such orders, and this evidence may be made conclusive by a certificate from the president (*q*).

The Patent Office is under the Board of Trade, who appoint the Comptroller and other officers, and may authorise other officers to carry out the Comptroller's duties or any of them (*r*).

Patentee.

The term "Patentee" frequently occurs in connection with Patent Office Practice. This term is defined in the Act as meaning "the person for the time being entitled to the benefit of the patent" (*s*), but this definition leaves many questions open to doubt. As it is the "Patentee" who may amend or surrender a patent, or who has to defend it, it would seem clear that the person or persons having the real interest should come within this term, and that, for defensive purposes at any rate, any one of them should be allowed to be heard. In fact such a view is taken and the "Patentee" is treated as a composite personality covering all persons having interests legal or equitable (*t*). For those purposes, however, where

(*p*) Sect. 86. Where these objects are set out.

In *Chartered Institute of Patent Agents* v. *Lockwood*, 11 R. P. C. 374, H. L., it was held by a majority of the House of Lords that the validity of rules so made could not be questioned in the Courts, but these observations were probably only intended to apply to rules coming within the provisions of this section. *Cf.* p. 260, *n.* (*u*).

As to the effect of the forms prescribed and the power to vary these see *Grenfell and McEvoy's Application*, 7 R. P. C. 151.

(*q*) Sect. 87.

(*r*) Sects. 62 and 63.

(*s*) Sect. 93. It must be remembered that the decisions as to who may bring an action, see p. 165, are not directly in point, as the Act nowhere directly refers to such persons as patentees, though in ss. 22 and 23 the word would seem to apply to the plaintiff. In s. 25 it would appear to refer to the original grantee.

(*t*) *Cf.* interlocutory observations of PARKER, J., in *Hatschek's Patent*, 26 R. C. P. 234, and *Goldstein's Patent*, 27 R. P. C. 289, C. G. In *Jonkergouw and Destrez's Patent*, 28 R. P. C. 28,

notice has to be given to the patentee, only those persons appearing on the register as having an interest are considered.

Offences.

It is a misdemeanour to make, or cause to be made, a false entry in the register, or a writing falsely purporting to be a copy of any entry in such register, or to produce or lodge, or cause to be produced or lodged, in evidence any such entry or writing, knowing the entry or writing to be false (*u*).

Any person falsely representing that an article sold by him is a patented article is liable on summary conviction to a fine not exceeding five pounds. If the article has the word "patent" or "patented," or any other word implying that the article is patented, on it, this constitutes such an offence (*x*). It is also an offence punishable summarily with a fine not exceeding twenty pounds to use the words "Patent Office," or any other word suggesting that the user's place of business is officially connected with the Patent Office (*y*).

It is an offence to use, without the authority of his Majesty, in connection with any business, trade, calling, or profession, the Royal Arms, or arms so nearly resembling them as to be calculated to deceive, or to lead to the belief that the user is authorised to use the Royal Arms (*z*).

The Drafting of Specifications.

Provisional specification.

The provisional specification has only to describe generally the nature of the invention, with the object of enabling the

the assignee of an equitable owner was held entitled to petition to set aside an order for revocation.

In the case of amendment all persons having legal or equitable interest should concur in the application, or give their consent to it either directly or by estoppel. But where an application is launched without all such consents it is not bad *ab initio*, but only defective for want of parties. *Goldstein's Application, ubi supra.*

It is not clear how far licensees come within this term, but *cf. Hatschek's Patent, supra.*

(*u*) Sect. 89 (1).

(*x*) Sect. 89 (2), (3).

It would seem that once the complete specification has been accepted articles made according to it may be marked "Patent." *R.* v. *Townsend*, 13 R. P. C. 265 (Magistrate's decision), and *cf.* s. 10.

Convictions have, however, been obtained where articles were marked "Patent," and only provisional protection had been obtained. *R.* v. *Wallis*, 3 R. P. C. 1; *R.* v. *Crompton*, 3 R. P. C. 367.

(*y*) Sect. 89 (5). See also p. 289, *n.* (*z*).

(*z*) Sect. 90. See also 46 & 47 Vict. c. 57, s. 90, and 5 Ed. 7, c. 15, s. 68.

It has in many cases been recognised that "Patent" may sometimes form part of the name of the article and in such case it would probably not be held to be an offence. *Cf.* *Gridley* v. *Swinburne* (1888), 52 J. P. 971, and such cases as *Sykes* v. *Sykes* (1824), 5 D. & R. 292; *Cheavin* v. *Walker* (1877), 35 L. T. 757.

invention which will be later defined and claimed by the Complete specification to be identified with the invention for which protection was sought at the date of application. Anything which is in the Provisional may be omitted or cut down in the Complete. It is therefore generally advantageous to draw the Provisional in wide terms. But it not infrequently happens that an invention supposed to be broadly new is not so, and that all that is new are certain improvements or details. In such a case if these specific improvements or details have not been foreshadowed in the provisional they cannot be embodied in the Complete without making the latter liable to the objection of disconformity. The best form of Provisional is therefore one which states the invention in broad terms while also giving the preferred form or forms as an example. It is useful to draft and settle some principal claims upon the invention before drafting the Provisional, since their phraseology and form are helpful in the preparation of that document. They should be wide enough in scope to permit of the fair development of the contents of the Provisional.

The objection of disconformity has been to a great extent abolished by the alterations in the new Act, and the difficulties in connection therewith are also somewhat diminished by the power given to make a series of applications for inventions which are cognate or are modifications of one another, and then to lodge one Complete for the whole. On the other hand the Patent Office are much stricter than formerly in insisting that a Complete specification shall be confined to what is foreshadowed by the Provisional.

Complete specification.

The object of the Complete specification is two-fold, viz., to define the invention and to describe the manner of performing it. These two matters are not necessarily separate, and in many cases they cannot be separated. But it is generally well to state shortly what is the invention or improvement before condescending to details as to how it is to be carried out. Such statement should deal both with the object of the inventor and with the broad features of the means or methods employed to effect it, but should avoid all details. But care must be taken that this statement, short as it is, distinguishes the new step taken by the inventor from what has gone before, or the Office are likely to insist on amendments or references. If the invention comprises several features these should all be named.

It is then generally advisable to describe an example, and in all cases, except in process patents, this description should be accompanied by drawings. Such a description necessarily involves details which are not part of, or essential to the invention, and where there can be any doubt it is as well to state distinctly where this is so, or where details can be varied. Care should be taken to refer in the letterpress to any features of importance in the invention which are shown in the drawings. Of course it is unnecessary to describe in detail parts which are old and which have no reference to the new invention.

It must be remembered that the object of the specification is to teach the reader how to carry out the invention under all the circumstances under which it is to be applied, and a proper description should therefore not only give the necessary direction for its performance in the special example given, but also indicate, where necessary, how these directions should be varied to meet changing circumstances.

This is especially necessary where the patentee claims to have struck out some new line, since in such case the competent workman, whose general knowledge the patentee can usually call in aid to supplement any apparent deficiencies in description, would not know how far he could rely on such knowledge in the new circumstances.

But it is also very necessary in cases where the subject matter of the invention appears to be slight. Here to support the patent it will be necessary to argue that the change, though small, needed invention, and the difficulties of this argument are greatly increased if at the same time the patentee must contend that changes, apparently as great, would be obvious to any competent workman.

Terms of art, mathematical, and scientific phrases are quite permissible in a specification, but the greatest care must be taken that if they are employed they are used correctly. If there is any doubt as to this it is far better to describe what is necessary in simple terms. As a general rule it is better to avoid dealing with matters of merely scientific interest, or advancing theories as to how a process or apparatus works.

Description of *prior knowledge.*

Any statement as to prior knowledge is fraught with pitfalls under the modern system of reference. If no reference is made to the existence of certain earlier specifications it may be said

that the applicant has not fairly stated what prior knowledge there was. If he refers to the substance of the specification it is said that he is trying to force on the public his own construction of a written document, and that he ought to refer them to the actual document (*a*). It has also been held that it is not a fair description to refer to something as being commonly done which only occurs in a single specification (*b*). Thus, unless the greatest care is exercised an applicant who may have made a small improvement may find himself forced to put in references to a number of prior specifications. Again, where such a reference is made, either originally or as the result of opposition, the person whose specification is named may object to a statement that the apparatus there described was defective (*c*). Probably the safest plan is to describe the invention as for improvements in "the type of apparatus, etc., which" setting out what was old, and to distinguish as far as possible the new matter in the claims, commencing these with "in a machine of the type described" or "on a machine having (here set out the old features) the use of (here insert the new)." Unnecessary multiplicity of claims should be specially avoided in such cases. Where possible the need for such statements as to prior knowledge should be reduced to a minimum by confining the description to those features which are new.

Claims.

The description of how the invention is carried out is often followed by a statement either showing that the invention is not confined to apparatus, etc., having certain specified details, or, on the other hand, that no claim is made to certain matters that have been described as these are in themselves old, and this is followed by the claims themselves.

In drafting the claims the rules laid down in the chapter on construction are to be carefully borne in mind. It is especially necessary to remember that the addition of any non-essential details necessarily diminishes the scope of a claim, since a claim for the combination of details only protects the combination as a whole. Where there has been no previous search it is always well to have at least one of the claims drawn on the broadest possible lines which the draftsman thinks can be

(*a*) *Atherton's Application*, 6 R. P. C. 547.

(*b*) *Hopkin's Patent*, 27 R. P. C. 72, C. G.

(*c*) *Guest's Application*, 5 R. P. C. 312. No such objection can be raised if there is no reference to a specific patent, *ibid.*

sustained, in order to have the benefit of the wider search, though, of course, before the specification is finally accepted such claim should, if necessary, be modified in accordance with what has been discovered. In drafting subsidiary claims their effect on the construction of main claims should always be carefully considered, but, on the other hand, it is not necessary to consider whether the additional matter in each claim would constitute subject-matter as against the other claims, since all the Court considers is whether there is any claim in the patent infringes the rule of claiming what was old, and not how the patentee chooses to divide up by his claims a monopoly to which he is entitled.

Although in reading a specification the body must be read before the claims, in drafting it it is advisable to settle the main claims before embarking on the description. It is above all things necessary to good draftsmanship that the writer should have clearly in his own mind what are the features for which he wishes to claim a monopoly, and he should therefore start by setting these out specifically, and he can then see that his description contains all the details necessary for the proper understanding of the inventions so claimed.

A very general tendency has grown up to qualify claims by the addition of "substantially as described," and, generally speaking, this is a wise practice. If the spirit of the invention disclosed by the specification has been taken these words seldom prevent success against an infringer who has varied the details, and on the other hand they ought to be extremely useful in preventing anticipation by something which approaches the necessarily short description of the invention at the beginning of the claim, but which does not produce the advantages of what is described in the specification.

"Substantially as described" is a dangerous phrase, however, when used, as it too frequently is, in the hope that it will serve to settle at some later date the exact extent or meaning of a claim of the purport of which the draftsman has no very clear notion. A claim should be set out and settled as if "substantially as described" were not there, and then these words may be added for greater safety.

It is often difficult to carry out the above rules, especially in cases where, as often happens, there is uncertainty as to whether certain integers or steps in a process are essential,

or where there is doubt as to the novelty of certain parts of the invention. In such case it is sometimes better to confine the specification to a statement of how the invention is to be carried out and to mention in the claims only what is known to be essential with the qualification "substantially as described."

Forms of claims.

With reference to the drafting of claims the English practice lies midway between the German method, where the monopoly is usually defined by a single claim directed to the "new technical result" sought or produced, and the American system with its numerous claims for combinations of specific details. The general and convenient practice is to commence with a broad claim which is confined only to the essentials of the invention, and to follow this with successively narrowing subsidiary claims which are restricted by embodying as well further specific details. It is well, however, not to needlessly indulge in these subsidiary claims. Such claims are really of no value while the first claim remains in the specification since *ex hypothesi* they can only be infringed if the main claim is infringed, and therefore cannot help a plaintiff on the issue of infringement, while if the main claim is held invalid the action necessarily fails. Their principal use is that they permit of an amendment by simple disclaimer if it found that the main claim is too wide. It may be said that they do no harm, but this is not necessarily true, since the presence of these claims limiting the main claim by the addition of certain further details, necessarily prevents these details being read into the broader claim.

A quite different class of claims are those for variants on the main invention, and these should be freely inserted if there is no reason to doubt their novelty and utility.

A further class of claim is for the use of specific details without all the limitations to be found in the main claim. Here great care is necessary as such claims are peculiarly liable to attack. Moreover under modern practice they are often held to infringe the rule of a patent being confined to a single invention. Where expense is not too important it is generally better to protect these separately.

In addition there may be claims for a combination of matters separately claimed in other claims. These claims are of the nature of subsidiary claims, but are sometimes of

assistance in getting claims for different integers allowed in the same patent. For this purpose, however, these integers must form a true combination.

Generally speaking, it is better in the claims to define the monopoly by a description of the construction rather than of the function, but a functional claim may be advisable in the case where some new object is achieved, and it is desired to show that the means are of subsidiary importance. Sometimes, too, in a claim where the invention has been described, a reference to function is also introduced by way of further limitation.

CHAPTER XVI

NON-WORKING

Revocation for non-working.

THE recent Patent Act provides that at any time after the expiration of four years from the date of grant an application may be made to revoke a patent on the ground that the patented articles are wholly or mainly manufactured abroad, or that the patented process is wholly or mainly carried on abroad. If this is proved then, unless the patentee shows some satisfactory reason for the lack of manufacture in this country, an order may be made either revoking the patent or giving the patentee a certain time to start effective manufacture here.

It should be noted that the power is a discretionary one, and that there is no obligation to make an order (*a*).

The section has been construed as meaning that the patentee must give this country a fair share of the manufacture that is carried on in proportion to its needs and commercial development. It is not necessary in order to comply with the section that more articles should be made in England than elsewhere (*b*).

The section has no application unless manufacture is being carried on somewhere, nor after it has really ceased (*c*), but if manufacture is being carried on abroad it is not itself a sufficient answer for the patentee to show that there is no demand in this country, since it is his duty to attempt to create a demand and to introduce the industry here (*d*). But the mere fact of part of the demand being satisfied by importation does not show that the section has been contravened (*e*).

(*a*) Sect. 27, as to the discretionary powers of the comptroller, see *Ilgner's Patent*, 26 R. P. C. 198.

(*b*) *Hatschek's Patents*, 26 R. P. C., p. 240. See also *Bremer's Patent*, *Högner's Patent*, 26 R. P. C. 447; *Boult's Patent*, 26 R. P. C. 424.

(*c*) *Jonkergouw and Destrez's Patent*, 28 R. P. C. 423; *Boult's Patent*, 26 R. P. C. 424.

(*d*) *Boult's Patent*, 26 R. P. C. 387.

(*e*) *Hatschek's Patent*, *ubi supra*, pp. 242, 243.

The object of the section is to secure fair play, not protection, *ibid.*

Patented article.

"Patented article" means an article coming within the claim of the Letters Patent, whether such article comes within the realm or not. The question to be considered is not, therefore, confined to the manufacture of the articles sold here (*f*), nor to articles made by, or with the licence of, the patentee (*g*). Thus manufacture by infringers abroad or in this country will be taken respectively against the patent or in his favour (*h*). In the case of a patent for improvements in parts of a machine, it is sufficient if the patentee manufactures such new parts here, even if there are claims for these parts in combination with the rest of the machine. If the patent is for a combination of old parts it would seem to be sufficient if the combination is made here (*i*).

Adequacy of manufacture.

The question of adequacy depends on the facts of the particular case (*k*), but in general the manufacture is not considered to be adequate if it is less than it would have been had the patentee not abused his monopoly or given a preference to foreign traders (*l*). The power to revoke being discretionary, an order may be refused if there is adequate manufacture at the time of the hearing, though there was not at the time of the application (*m*).

Reasons for non-manufacture.

What is a satisfactory reason for non-manufacture here of course also depends on the circumstances of the particular case (*n*). The general tendency of the decisions has been to be lenient to the patentee who has made real efforts to get manufacture established here, but has failed from want of capital or support (*o*), especially if the only manufacture abroad has

(*f*) *Hatschek's Patents*, 26 R. P. C. 241.

(*g*) *Ibid.*

(*h*) *Bremer's Patent*, 26 R. P. C. 449; *Mercedes Daimler Patents*, 27 R. P. C. 768.

(*i*) *Lake's Patent*, 26 R. P. C. 447.

It has never been decided what proportion of the manufacturing processes must be performed in this country in order that the article made may be considered to be manufactured here. Some light may be thrown on the question by decisions under the Merchandise Marks Acts, *e.g. Tierney* v. *Williamson* (1900), 17 T. L. R. 174, 424. *Bischop* v. *Toler* (1896), 65 L. J. (M. C.) 1.

(*k*) *Hatschek's Patent*, *ubi supra*, p. 241.

(*l*) *Hatschek's Patents*, *ubi supra*, p. 241.

The tribunal will not generally criticise the plaintiff's prices, or consider whether a greater demand would be induced by a lower price, if it appears that the price was fixed *bonâ fide*. If, however, there was reason to think that it had been fixed for the purpose of checking the demand here, *e.g.* if it was higher than the price charged abroad different considerations would arise. *Kent's Patent*, 26 R. P. C. 670. See also *Bremer's Patent*, 26 R. P. C., at p. 460.

(*m*) *Jottrand's Patent*, 26 R. P. C. 830.

(*n*) *Hatschek's Patents*, *ubi supra*, p. 241.

(*o*) "The Act of 1907 was never meant to penalise want of success where the patentee has done his best." *Bremer's Patent*, 26 R. P. C. 465. See also *Weber's Patent*, 26 R. P. C. 300; *Taylor's Patent*, *infra*.

been in his country of origin (*p*). But a mere formal offer of licences is of little effect (*q*), and efforts which have not commenced till proceedings have been threatened are also usually disregarded (*r*). An obstacle created by the patentee himself, such as an agreement not to manufacture or grant licences here, is not a satisfactory reason, even where such agreement was prior to the new Act (*s*). Nor in general is a mistake by the patentee as to the requirements of the law a satisfactory reason (*t*).

The four years' grace is intended to give the patentee an opportunity of developing the industry, and both during and after this time he should endeavour, by the terms offered and the efforts employed, to give this country a fair start in the industry (*u*). There may be cases where, owing to the substances employed or the conditions of labour, it can be shown that commercial manufacture in this country is not practicable, though the latter reason would be very hard of proof (*x*), but the mere fact that the profits of manufacture here would be smaller than elsewhere would not constitute a satisfactory reason for non-manufacture, nor would the fact that there would be no profits, if this was due to the patentee having given foreign countries an unfair start (*y*).

The efforts should have been such as a reasonable and business-like man would have made. *Boult's Patent*, 26 R. P. C. 387.

(*p*) *Boult's Patent*, 26 R. P. C., at p. 386; *Taylor's Patent*, *infra*.

(*q*) *Hatschek's Patents*, *ubi supra*, p. 248. But the absence of such offer might prejudice the patentee. It is better to make the offer by letters addressed to persons likely to be interested, the form being varied according to their individual needs.

(*r*) *Johnson's Patent*, 26 R. P. C. at p. 58; *Fell's Patent*, 27 R. P. C. 29; *Boult's Patent*, *supra*.

(*s*) *Hatschek's Patent*, *ubi supra*, pp. 242, 244.

(*t*) *Worring and Kortenbach's Patent*, 26 R. P. C. 167.

(*u*) *Hatschek's Patent*, *ubi supra*, p. 242.

(*x*) *Hatschek's Patent*, *ubi supra*, p. 242; *Boult's Patent*, *ubi supra*, p. 387. *Kent's Patent*, 26 R. P. C. 670.

(*y*) *Hatschek's Patent*, *ubi supra*, p. 243.

Instances of reasons held satisfactory.

Where the patentees showed that for five years after the date of the patent they were perfecting the manufacture in their own country and at the end of that time, and before the date of the application, they had taken steps to have the articles manufactured here. *Boult's Patent*, 26 R. P. C. 383.

Where the patented improvements had been practically superseded, and there had been no real demand since the date of the Act, though a few parts had been manufactured and imported for use in old cars. *Osborne's Patent*, 26 R. P. C.. 819

Where the patentees immediately on the grant of the patent began genuine negotiations for the sale of the patent in this country, and had concluded them after about four years, and manufacture on a small scale was about to be commenced in this country, the article being one for which there was only a very limited and special demand. *Jottrand's Patent*, 26 R. P. C. 830.

International arrangements.

The Act provides that no order shall be made under this section which is at variance with any treaty convention arrangement or engagement, with any foreign country or British possession (*z*). The object of this provision is probably to allow of mutual arrangements being made for working in one country satisfying the requirements of another, but no such treaties have as yet been made (*a*).

Orders *nisi*.

The tribunal has power, where the applicant has established his case, either to revoke the patent forthwith or to make an order that it shall be revoked after a specified reasonable interval unless in the meantime it is shown to its satisfaction that manufacture to an adequate extent has been established

Where the demand both in this country and abroad was very small, and some manufacture had taken place here, the smallness of the demand was considered, under the circumstances, a reason for the delay in establishing the manufacture. The fact that a portion of the first machine was made abroad was also held to be satisfactorily explained by the desire of the patentees to have their first machines made of the best materials. *Kent's Patent*, 26 R. P. C. 666.

A patentee, who had at the time of the patent an established business in the United States, wrote letters to leading firms in the trade here offering licences, had one experimental plant built here, and tried unsuccessfully to establish an agency here. The patentee had a successful trade in the United States, and had sold some £30,000 worth of the patented apparatus. He had been threatened by a prior patentee with an action for infringement if he made installations in this country, and an agent of such prior patentee was the applicant for revocation. It was held that the patentee had shown a satisfactory reason for non-establishment of the industry here, and that the fact that he had been hampered by the applicant was one which the Court would take into account. It was further held that the patentee was not bound to apply for a compulsory licence. *Taylor's Patent*, 29 R. P. C. 296.

See also *Badische, &c.* v. *Thompson*, 21 R. P. C. 473; *Weber's Patent*, 26 R. P. C. 300; *Bremer's Patent, Högner's Patent*, 26 R. P. C. 449.

Reasons held not satisfactory.

Where the patentee had before the Act granted an exclusive licence to a foreign firm to manufacture abroad, and so precluded himself from manufacturing or granting licences here. *Hatschek's Patents*, 26 R. P. C. 228; but *cf. Bremer's Patent, Högner's Patent*, 26 R. P. C. 449.

Where the patentee alleged that it was impossible to manufacture a machine here on the ground that the necessary skilled workmanship and special tools were only to be found in America, the patent being for improvements in certain parts of sewing machines which were manufactured as a whole in that country. It was shown that, in fact, these machines were also made in Germany. *Johnson's Patent*, 26 R. P. C. 52.

Where the patentee alleged that it had been impossible to obtain the skilled labour necessary to manufacture the machine profitably here (the patent being for parts of a Yost typewriter, which was, in fact, manufactured in the United States), and further had advertised their willingness to grant licences under the patent in this country. *Fell's Patent*, 27 R. P. C. 25.

(*z*) Sect. 27 (2).

(*a*) The Fifth Article of the International Convention, however, provides that no patent shall be forfeited by reason of the importation by the patentee of articles made under it, and this would probably prevent the fact of importation *per se* being sufficient for revocation under this section, though such importation might be evidence to rebut the

here (*b*). If manufacture is not established within this time, then, if the patentee can show satisfactory reasons for his failure, a further extension not exceeding twelve months may be given to him in which to establish such manufacture. The power of granting an extension of time to the patentee will, in general, only be exercised when the patentee has made some efforts to introduce the manufacture before proceedings were started, and there seems a possibility of his efforts bearing fruit (*c*). If there is at the date of hearing a substantial working (and something had been done before the application), the proper course is to dismiss the application, not to make a conditional order (*d*).

The applicant has to make out a *primâ facie* case before a hearing is granted or the patentee is called on to answer (*e*). Generally speaking both sides must produce all their evidence before the Comptroller, and no fresh evidence may be produced on appeal unless special reasons are shown (*f*). Procedure.

Any person may apply, probably even a common informer (*g*). The Act provides that the answer shall be made by the patentee (*h*), who is defined as the person for the time being entitled to the benefit of the patent (*i*). It would seem that under this definition the person or persons really affected by the application will be allowed to oppose it, whoever may have the legal title (*k*). Either party may appeal against any order

argument that the manufacture here was adequate. *Cf.* p. 299, *n.* (*b*).

(*b*) Sect. 27 (2), (3), see also p. 300, *nn.* (*k*) and (*l*).

(*c*) *Worring and Kortenbach's Patent*, 26 R. P. C. 165.

For an instance of this order and subsequent proceedings thereon, see *Weber's Patent*, 26 R. P. C. 300, 27 R. P. C. 30. See also *Taylor's Patent*, 29 R. P. C. 302.

(*d*) *Boult's Patent*, 26 R. P. C. at p. 386.

Where, however, nothing has been done before the date of the application immediate revocation may be ordered. *Fell's Patent*, 27 R. P. C. 29.

(*e*) *Hatschek's Patents, ubi supra*, at p. 245; *Lake's Patent*, 26 R. P. C. 443. He must, therefore, show (*a*) that the manufacture, &c. is carried on somewhere, (*b*) that it is wholly or mainly abroad. As to the certainty necessary in the applicant's case, *cf.* p. 174, *nn.* (*m*), (*n*), (*o*).

(*f*) *Hatschek's Patents, ubi supra*, p. 247; *Bremer's Patent*, 26 R. P. C. at p. 466.

In this case further evidence was allowed. See also *Jonkergouw and Destrez's Patent, infra.*

(*g*) Sect. 27 (1). See *Hatschek's Patent, ubi supra*, at p. 240.

The motives of the applicant are immaterial, but his conduct may be material if it has interfered with the development of the industry in this country. *Taylor's Patent*, 29 R. P. C. 296.

(*h*) Sect. 27 (2).

(*i*) Sect. 93.

(*k*) See *Jonkergouw and Destrez's Patent*, 28 R. P. C. 423, where the assignee of the equitable owners was allowed to appeal. The legal owners were made respondents to the petition. See also *Hatschek's Patents, ubi supra*, at p. 234; *Hügner's Patent*, 26 R. P. C., at p. 150.

of the Comptroller. Such appeal is by petition to the special judge, whose decision is final. The law officer may be heard on such appeal (*l*).

The Act only provides for the revocation of the patent as a whole, and difficulties may arise where it appears that there is manufacture here under certain claims but not under others (*m*). Possibly in such a case the patentee might be given the option of having his patent revoked or of disclaiming those claims under which there was no manufacture.

Costs.

The Comptroller and the Court have both full power as to awarding costs (*n*). If revocation is granted the patentee has in general to pay the applicant's costs, unless the patentee, on being notified of the application, agrees not to oppose it (*o*). If the patentee succeeds the Comptroller or the Court may take into account in awarding costs the fact that at the date of the application there were reasonable grounds therefor (*p*). If the applicant, or in the case of an appeal the appellant, neither resides nor carries on business in the United Kingdom, the Comptroller may order him to give security for costs (*q*).

Procedure in High Court.

The ground of non-working can be raised in proceedings in the High Court either in a petition presented to the Court or as a ground of defence to an action (*r*). It would seem that where revocation of the patent is sought the Court would have the Comptroller's power to make a conditional order (*s*).

(*l*) Sect. 27 (4). See p. 283.

(*m*) The question arose in *Boult's Patent*, 26 R. P. C. 424, but was not decided.

(*n*) Sect. 39 (1). The Court may award a successful appellant costs before the comptroller. This was done in *Taylor's Patent*, 29 R. P. C. 296, and errata in same volume.

(*o*) See notice in Official Journal of 28th April, 1909, and *Taylor's Patent*, 26 R. P. C. 381.

(*p*) *Boult's Patent*, 26 R. P. C. 388 (no costs); *Osborne's Patent*, 26 R. P. C. 822 (modified costs given); *Jottrand's Patent*, 26 R. P. C. 834 (modified costs given).

In *Weber's Patent*, 26 R. P. C. 300, 27 R. P. C. 30, where an order was made that the patent should be revoked unless manufacture was established within a certain time, no costs were given.

In *Bremer's Patent* and *Högner's Patent*, 26 R. P. C. 449, where the patentee succeeded on appeal, but had to get leave to introduce new evidence, the comptroller's order giving the applicant's costs was allowed to stand, and no costs were given in the appeal, except that the Attorney-General's costs were ordered to be borne by the parties equally.

(*q*) Sect. 39 (2).

(*r*) Sect. 25. See p. 174, and p. 213.

(*s*) O. 53*a*, r. 8.

CHAPTER XVII

PROLONGATION OF LETTERS PATENT

A PATENTEE may, in the manner provided by the Act and Rules, apply to the Court for an extension of the Letters Patent, on the ground that he has been inadequately remunerated by his patent (*a*). The Court here exercises the jurisdiction formerly possessed by the Judicial Committee of the Privy Council, and will doubtless in general be governed by the same considerations as influenced this body (*b*). Grounds for application.

The exercise of this power is a matter of grace. While, therefore, there are certain points which it is incumbent on the petititoner to establish, before the Court will feel itself entitled to act, the latter may be influenced by considerations which may be material to the particular case but which cannot be limited or defined generally (*c*).

The three points that it is essential for the applicant for an extension to prove are :— Essential matters.

1. That the invention in question is of real merit and utility to the public.

2. That there has been insufficient remuneration for such invention.

3. That such insufficiency of remuneration is not due to any lack of efforts on the part of those who have from time to time held the patent (*d*).

(*a*) See s. 18 and O. 53*a*, r. 3.

(*b*) The former Acts dealing with this subject were: 5 & 6 Will. IV. c. 83; 7 & 8 Vict. c. 69; 15 & 16 Vict. c. 83; 46 & 47 Vict. c. 57, s. 25.

In substance their provisions were identical with those of the present Act. *Cf. Newton's Patent* (1884), 9 A. C. 592.

(*c*) Sect. 18 (4), "a discretion influenced by every such circumstance as would properly weigh on a sensible and considerate person in determining whether an extraordinary privilege, not of strict right, but rather of equitable reward should be conferred." *Hill's Patent* (1863), 1 Moo. (N. S.), at p. 265. See also p. 315.

(*d*) Of these points only the second is directly laid down by the Act (see s. 18 (5)), but the others have always been recognised as essential for success.

Merit.

The merit of the invention is primarily its value to the public, rather than the amount of ingenuity involved in it (*e*), *i.e.* what must be looked at are the comparative advantages the world enjoyed before and after the patentee's disclosure of his invention (*f*). The tribunal has always taken the view that before it will investigate other points it must be satisfied that the invention pos esses such practical utility in a high degree (*g*). In judging of this attention has to be paid both to the quantum of the improvement and the generality of its application (*h*). Hence patents for inventions which confer a general advantage, *e.g.* which lead to an improvement relating to public health, safety or comfort (*i*), or which produce some new substance of general usefulness (*k*), are in a particularly favourable position when renewal is sought. Such patents, however, are necessarily only a small proportion of the whole,

(*e*) *Bell's Patent* (1862), 1 Moo. (N. S.) 61.

"The consideration which supports the grant of the monopoly granted by Letters Patent being, in fact, the disclosure of something of value to the public, it is only where this value largely exceeds the benefit derived by the patentee from his invention that the patentee can be said to have been inadequately remunerated." *Johnson's Patent*, 25 R. P. C., *per* PARKER, J., at p. 723.

"(The inventor) has received not more than £5000 or £6000 for a discovery which has actually conferred upon the country the benefit of millions, and which opens a source of national wealth and trade to which you can put no limit." *Kay's Patent* (1839), W. P. C. 572.

(*f*) The same rule applies as in other branches of Patent Law that the former knowledge must be considered without the light thrown on it by the later invention. *Cf.* p. 62.

(*g*) See *Saxby's Patent* (1870), 7 Moo. (N. S.) 82; *Stewart's Patent*, 3 R. P. C. 10; *Stoney's Patent*, 5 R. P. C. 518. *Cf.* also *Scott's Patent*, 23 R. P. C. 480.

"It must be something more than the fact of it being a good patent, and there must be some character of public interest established in the patent and its usefulness."

It is difficult, however, to see why the invention there in question did not satisfy this criterion.

See also as to what degree of merit is sufficient. *McCulloch's Patent*, 25 R. P. C. 692, O. H.; *Thorneycroft's Patent*, 16 R. P. C. 203. Unless evidence of merit is given the petition will be dismissed. *Kelly's Patent*, 17 R. P. C. 476.

(*h*) It must be noted that merit alone is here considered. The fact that the application of the invention is limited may help on other points. See p. 308, *n.* (*l*).

(*i*) Among cases of this class are:—

Foard's Patent (1855), 9 Moo. 356 (consumption of smoke); *Herbert's Patent* (1867), 4 Moo. (N. S.) 300 (light buoys); *Bischoff's Patent*, 1 R. P. C. 163 (purification of water); *Shone's Patent*, 9 R. P. C. 438 (drainage); *Lyon's Patent*, 11 R. P. C. 537 (disinfector); *Currie and Timmis's Patent*, 15 R. P. C. 63 (railway signals); *Hart's Patent*, 25 R. P. C. 209 (improvements in ventilation chiefly of use in weaving factories); *McCulloch's Patent*, 25 R. P. C. 684, O. H. (treatment of sewage).

The fact that the invention is the only one that will enable persons to satisfy a statutory requirement is no reason for refusal of extension. *Foard's Patent*, *supra*; *Hart's Patent*, *supra*.

But it may be a reason for imposing terms as to licences. *Hart's Patent*, *supra*.

(*k*) *Cf. Cross, Beavan and Beadle' Patent*, 23 R. P. C. 485.

and in most cases a benefit to some particular trade is all that can be shown, though here generally the improvement made should be greater than would be necessary in the first class. It is very doubtful whether a patent would be extended if the only result achieved was one of no real utility, *e.g.* a new form of toy.

Although all that must be proved to establish merit is that the public have derived real benefit from the disclosure of the new invention, yet the Court considers that the degree of merit may depend on other circumstances. Thus it has been said that an invention only arrived at by experiment or research should receive more favourable consideration than one which was the result of a mere happy thought (*l*), and that an original inventor has more merit than the importer of something well known abroad (*m*). Again, it has often been given as a reason for refusal that the step made by the patentee was only a very small one in view of the prior knowledge (*n*), while on the other hand the fact that the invention involves the introduction, or first application, of a new principle is held to increase the merit (*o*).

The merit of the invention has to be judged by what is disclosed by the specification. If a further invention is needed to make the earlier one really useful, this diminishes merit (*p*), but the fact that new uses are found later does not have this effect but, on the other hand, may afford an additional reason for extension (*q*).

(*l*) *Cf. Poole's Patent* (1867), 4 Moo. (N. S.) 452; *Hill's Patent* (1863), 1 Moo. (N. S.) 258; *Johnson's Patent* (1871), 8 Moo. (N. S.) 282. But *cf. contra*, *Bett's Patent* (1862), 1 Moo. (N. S.) 49; *McCulloch's Patent*, 25 R. P. C. 684, O. H.

(*m*) *Claridge's Patent* (1851), 7 Moo. 394; *Soame's Patent* (1843), W. P. C. 729.

Where, however, the invention was new abroad, the importer, even if a mere conduit pipe, has the full merits of the inventor. *Cf. Claridge's Patent, supra*; *Berry's Patent* (1850), 7 Moo. 187; *Hutchinson's Patent* (1861), 14 Moo. 364, and in such case it is the foreign inventor's remuneration that is considered. *Peach's Patent*, 19 R. P. C. 658.

(*n*) *Wield's Patent* (1871), 8 Moo. (N. S.) 300. See also *Morgan's Patent* (1843), W. P. C. 737; *Lancaster's Patent* (1864), 2 Moo. (N. S.) 189; *Van Gelder's Patent*, 24 R. P. C. 169; *Johnson's Patent*, 25 R. P. C. 723.

But mere simplicity does not decrease merit. *Muntz' Patent* (1846), 2 W. P. C. 113; *Hazelands' Patent*, 11 R. P. C. 467. See also *Soame's Patent* (1843), W. P. C. 729; *Bett's Patent* (1862), 1 Moo. (N. S.) 49.

And a very small step may be sufficient if it is a *sine quâ non* for success. *Johnson's Patent*, 25 R. P. C. 724.

(*o*) *Carr's Patent* (1873), 9 Moo. (N. S.) 379; *Stoney's Patent*, 5 R. P. C. 518.

(*p*) *Woodcroft's Patent* (1846), 2 W. P. C. 18; *Wield's Patent* (1871), 8 Moo. (N. S.) 300; *Bell's Patent* (1846), 2 W. P. C. 159; *Norton's Patent* (1863), 1 Moo. (N. S.) 339. See also *Woodcroft's Patent* (1841), W. P. C. 740.

(*q*) *Cf. Fountain Livets Patent*, 9 R. P. C. 327; *Woodcroft's Patent*,

Remuneration.

Whether the remuneration of the patentee has been sufficient in view of the merit of the invention is clearly a pure question of fact (*r*). Sometimes a measure of the material or monetary advantages to the public can be arrived at which will give assistance (*s*), but in general the patentee relies in whole or in part on indirect evidence, *i.e.* he shows that certain causes have retarded the adoption of his invention and asks the tribunal to infer from this that he has not got the remuneration he deserves. These causes may in some cases be inherent in the invention, *i.e.* the invention may be one for which, although its utility may be great, there is only a very limited demand (*t*), or one which can only be adopted by displacing existing installations (*u*), or they may be accidental, *e.g.* want of funds (*x*), opposition of trade, etc. (*y*).

The profits of all parties to be considered.

The Act directs the Court to consider the profits of "the patentee as such" (*z*). This expresses the old practice which was to consider what profit has been made from the patent, and not what the inventor or the petitioner alone had received (*a*). It is therefore necessary to discover what have been the profits or losses of the various holders of the patent right (*b*), and in

supra; *cf.* also *McDougall's Patent* (1867), 5 Moo. (N. S.) 1; *McInne's Patent* (1868), 5 Moo. (N. S.) 72. Nor do improvements made by the patentee. *Galloway's Patent* (1843), W. P. C. 724; *Southby's Patent*, 8 R. P. C. 433, but see *contra*, *Nussey's Patent*, 7 R. P. C. 25.

(*r*) The largest remuneration in any case of prolongation was £20,000 (*Bett's Patent* (1864), 1 Moo. (N. S.) 49). In *Thomas's Patent*, 9 R. P. C. 372, the P. C. seemed to doubt whether under any circumstances £250,000 could be insufficient.

(*s*) *E.g. Kay's Patent*, see p. 306, *n.* (*e*); *Joy's Patent*, 10 R. P. C. 89.

(*t*) *E.g. Stoney's Patent*, 5 R. P. C. 518; *McCul'och's Patent*, 25 R. P. C. 684, O. H.

(*u*) *E.g. McCulloch's Patent*, *supra*; *Carr's Patent* (1873), 9 Moo. (N. S.) 379; *Bate's Patent* (1836), W. P. C. 739. See also *Errard's Patent* (1835), W. P. C. 557 (need of instructing workmen); *Newton's Patent* (1861), 14 Moo. 156 (expense of articles); *Smith's Patent*, 2 R. P. C. 14 (increased first cost); *Thompson's Patent*, 19 R. P. C. 565 (need of experiments); *Currie's Patent*, 15 R. P. C. 63 (railway signals); *Cross, Bevan & Beadle's Patent*, 23 R. P. C. 485 (need of finding uses for new material).

(*x*) *E.g. Wright's Patent* (1839), W. P. C. 575.

(*y*) *Errard's Patent*, *supra*; *Southworth's Patent* (1837), W. P. C. 486; *Stafford's Patent* (1838), W. P. C. 563; *Robert's Patent* (1839), W. P. C. 573; *Jones's Patent* (1840), W. P. C. 577; *Cocking's Patent*, 2 R. P. C. 151; for other cases see *Swaine's Patent* (1837), W. P. C. 559 (difficulty in locating works); *Wright's Patent*, *supra* (need for perfecting other machinery); *Jones's Patent* (1840), W. P. C. 577 (need for experiments as to best form); *Napier's Patent* (1861), 13 Moo. 543 (disturbance in labour market); *Roper's Patent*, 4 R. P. C. 201 (illness of patentee); *Darby's Patent*, 8 R. P. C. 380 (difficulties in manufacture and agricultural depression).

(*z*) Sect. 18 (4). These words were also in the 1883 Act, but not in the 1837 Act.

(*a*) *Cf. Trotman's Patent* (1868), 3 Moo. (N. S.) 494.

(*b*) *Cf. Trotman's Patent*, *supra*; *Barff's Patent*, 12 R. P. C. 383; *Carmont's Patent*, 14 R. P. C. 239, and cases at p. 311, *n.* (*m*).

some cases it may also be proper to include the profits made by licencees (*c*).

Profits from foreign patents.

A question which frequently arises is how far are the profits made from foreign patents to be taken into consideration. These clearly do not come within the words, "the profits of the patentee as such," and in the earlier days it was held that the question of whether profits had been made from other patents was irrelevant (*d*). But later a contrary view has prevailed in that it has been held that the fact of profits having been made, either by the petitioner or others, from such foreign patents, is a material fact which may influence the tribunal in the exercise of its discretion (*e*).

Accounts.

The accounts must be presented in such a form that the Court can determine with certainty what remuneration has been received (*f*), and it is the duty of a patentee to keep from the first records that will enable him to fulfil these requirements (*g*).

(*c*) *Tilman's Patent, supra.* See also *Shone's Patent*, 9 R. P. C. 438; *Furness's Patent*, 2 R. P. C. 175; *Bernland's Patent*, 4 R. P. C. 489; *Thomas's Patents*, 9 R. P. C. 371, 373.

On the other hand in *Cross, Bevan & Beadle's Patent*, 23 R. P. C. 491, the view seemed to be taken that the gains and losses of licensees were irrelevant. Probably the question depends on the facts of each case. *Cf. Thomas's Patent, supra.* If an exclusive licence has been granted so that the licensee was practically an assignee (*Shone's Patent*, 9 R. P. C. 440), or if the patent was worked through a company in which the petitioner was interested, it would probably be held that the licensee's profits should be brought into account. If on the other hand the licences were offered generally, and taken by independent persons, then they would probably be excluded. Where the licensee is a petitioner they should be stated.

(*d*) *Poole's Patent* (1867), 4 Moo. (N. S.) 456.

(*e*) *Johnson's Patent* (1871), 8 Moo. (N. S.) 282; *Pitman's Patent* (1871), 8 Moo. (N. S.) 293; *Adair's Patent* (1881), 6 A. C. 176; *Newton's Patent* (1884), 9 A. C. 592; *Thomas's Patent*, 9 R. P. C. 372; *Barff's Patent*, 12 R. P. C. 383; *Willans & Robinson's Patent*, 13 R. P. C. 550; *Johnson's Patent*, 25 R. P. C. 727.

This applies even where the petitioners have no interest in such patents. *Peach's Patent*, 19 R. P. C. 65; *Newton's Patent*, 1 R. P. C. 177.

The estimated profits up to the expiry of such foreign patents will be considered. *Johnson's Patent, supra.*

(*f*) The practice of the P. C. on this point in recent times was extremely severe to the petitioner. Whereas in the earlier cases every opportunity was given for the accounts to be supplemented or explained (see *inter alia Heath's Patent* (1853), 2 W. P. C. 257; *Markwick's Patent* (1860), 13 Moo. 310), in the later ones it was considered a sufficient reason for rejection that the accounts were incomplete, or in an unsatisfactory form, and no adjournment would be granted to repair this (*e.g. Yate's Patent*, 4 R. P. C. 140; *Peach's Patent*, 19 R. P. C. 65). The new rules provide for the accounts being investigated by an expert (see p. 318, *n.* (*i*)), and it is probable that there will be a return to the early practice in that the petitioner will be assisted by having any defects pointed out to him while it is possible to repair them, and that the rule as to accounts will be considered in view of its real object, viz. that the Court should be satisfied that the remuneration is insufficient (*cf. Darby's Patent*, 8 R. P. C. 380).

(*g*) *Bell's Patent* (1862), 1 Moo. (N. S.) 49; *Adair's Patent* (1881), 6 A. C. 176; *Duncan & Wilson's Patent*, 1 R. P. C. 257; *Lake's Patent*, 8

These accounts should show the whole of the receipts and outgoings in respect to the patent in question, distinguishing these as far as possible from those connected with other branches of his business (*h*).

The necessity for accuracy and clearness in these accounts has always been very strictly insisted on. It is for the petitioner to present the accounts in a form showing the remuneration and not for the Court to endeavour to disentangle the relevant figures (*i*). Accounts based on mere estimates of receipts and expenditure will usually be rejected (*k*).

Where the accounts appear unsatisfactory this point may be considered by the Court before other questions are gone into (*l*).

The accounts of receipts should include all receipts from

R. P. C. 227; *Hughes's Patent*, 15 R. P. C. 370; *Clark's Patent*, 16 R. P. C. 433; *Henderson's Patent*, 18 R. P. C. 449; *Lawrence & Kennedy's Patent*, 27 R. P. C. 252, O. H. (but in some cases absence of special account may be excused, *ibid*). And see *Lowe's Patent* (1846), 10 Jur. 363, where a prolongation was granted, although no accounts had been kept.

(*h*) *Cf. Bell's Patent, supra.*

(*i*) See *Saxby's Patent* (1870), 7 Moo. (N. S.) 82; *Willans & Robinson's Patent*, 13 R. P. C. 550; *Peach's Patent, supra*; *Lawrence & Kennedy's Patent, supra.*

The accounts of subsidiary patents should be kept distinct. *Willans & Robinson's Patent, supra*; *McClean's Patent*, 15 R. P. C. 418; *Clark's Patent, supra.* This rule is occasionally relaxed, especially where the confusion is due to a *bona fide* attempt to give all information, *cf. Cross, Beavan & Beadle's Patent*, 23 R. P. C. 485, or where the fact of a loss is clear, *Darby's Patent*, 8 R. P. C. 380; or the invention is of exceptional merit. *Parson's Patent*, 15 R. P. C. 349. On the other hand, where the profits are very large the accounts should be exceptionally clear. *Thomas's Patent*, 9 R. P. C. 372.

Even where the accounts are honestly kept and honestly presented the petition may be refused if it is not possible to determine the remuneration. *Wuterich's Patent*, 20 R. P. C. 285; but *cf. Parson's Patent, supra.*

Where part only of the patent is of sufficient merit to warrant a renewal, the accounts should show the profits derived from this part separately. *Willacy's Patent*, 5 R. P. C. 690.

Semble there may be cases where the Court will unravel accounts. *Lake's Patent, supra.* See also *Parson's Patent, supra*, in which case the P. C. estimated the patentee's profit for themselves.

(*k*) *Bell's Patent, supra*; *Clark's Patent* (1870), 7 Moo. (N. S.) 255; *Lake's Patent, supra*; *Hughes's Patent, supra*; *Lawrence & Kennedy's Patent, supra.*

In *Saxby's Patent, supra*, the addition of a percentage on prime cost for establishment charges, expenses of fitting, etc., was objected to. But in cases of large businesses it is difficult to see how this method can be avoided.

In *Thomas's Patent*, 9 R. P. C. 367, the P. C. were not prepared to say that a lump sum for salaries, rent, etc., rendered the accounts insufficient.

As to cases where an estimated price is inserted for articles made for the patentees themselves, see *Thorneycroft's Patent*, 16 R. P. C. 203.

(*l*) *Saxby's Patent, supra*; *Wield's Patent* (1871), 8 Moo. (N. S.) 300; *Lake's Patent, supra.*

But this course will not be followed unless the accounts are obviously unsatisfactory. *Houghton's Patent* (1870), 7 Moo. (N. S.) 309.

the invention, whether by the petitioner or others (*m*), and whether from the British or foreign patents (*n*).

It now seems clear that manufacturers' profits must be included (*o*), but fair charges for use of capital, etc., may be debited (*p*). In arriving at the remuneration received by the patentee as such the petitioner is generally allowed to make a deduction for the time given by the patentee to bringing the invention into use (*q*), but such allowance must be claimed in the petition or accounts (*r*). Various other expenses, such as expenses of experiments (*s*), law costs (*t*), commissions, etc. (*u*),

(*m*) See p. 308. A statement should be made of the amounts to be received under unexpired contracts. *Hill's Patent* (1863), 1 Moo. (N. S.) 158.

Remuneration to the patentee as director, etc., of a company working the patent should be included. *McClean's Patent*, 15 R. P. C. 418.

Of course accounts of assignee companies should be included, though in *Deacon's Patent*, 4 R. P. C. 119, their absence was excused.

So profits of any person who is in the position of a partner should be shown. *Cf. Pieper's Patent*, 12 R. P. C. 295.

Where there is no evidence of the real value of shares these will be taken at face value. *Parson's Patent*, 15 R. P. C. 359; *cf. Carmont's Patent*, 14 R. P. C. 239.

(*n*) See p. 309.

(*o*) *Galloway's Patent* (1843), W. P. C. 729; *Muntz' Patent* (1846), 2 W. P. C. 113; *Hill's Patent* (1863), 1 Moo. (N. S.) 258; *Saxby's Patent* (1870), 7 Moo. (N. S.) 82; *Johnson's Patent* (1871), 8 Moo. (N. S.) 282; *Thomas's Patents*, 9 R. P. C. 307.

In *Bell's Patent* (1862), 1 Moo. (N. S.) 49, *semble* (from the headnote), these profits were excluded.

In *Duncan & Wilson's Patent*, 1 R. P. C. 257, the question was also considered, and the Court seemed to think that some proportion of the total profits might be excluded as the manufacturer's share, but that two-thirds was too much. *Semble*, some sum may in certain cases be deducted for patentee's profit as salesman. *Bailey's Patent*, 1 R. P. C. 1.

In *Saxby's Patent*, *supra*, it was said that even increase of business in other directions due to the patent business should be brought into account.

(*p*) *Soames' Patent* (1843), W. P. C. 729; *Perkin's Patent* (1845), 2 W. P. C. 6; *Hill's Patent* (1863), 1 Moo. (N. S.) 253; *Davies' Patent*, 11 R. P. C. 27; *Parson's Patent*, 15 R. P. C. 439.

(*q*) For cases where such deductions were allowed, see *Perkin's Patent* (1845), 2 W. P. C. 6 (£400 per annum); *Carr's Patent* (1873), 9 Moo. (N. S.) 379 (£400 p.a.); *Cocking's Patent*, 2 R. P. C. 151 (£300 p.a.); *Joy's Patent*, 10 R. P. C. 89 (£400 p.a.); *Hazeland's Patent*, 11 R. P. C. 467 (£117 p.a.). See also *Newton's Patent* (1861), 14 Moo. 156.

But such allowance will only be made when the patentee has really given his time. *Wield's Patent* (1871), 8 Moo. (N. S.) 300; *Furness's Patent*, 2 R. P. C. 173.

The claims under this head should not be exaggerated, *Clark's Patent* (1870), 7 Moo. (N. S.) 255, and it must be remembered that the patentee's efforts may bring future business, *ibid.* See also *Trotman's Patent* (1866), 3 Moo. (N. S.) 488.

There is no case where allowance has been made for time in experimenting before the patent was taken out, but this comes into account indirectly, see p. 307.

(*r*) *Bailey's Patent*, 1 R. P. C. 1.

(*s*) See *inter alia*, *Davies' Patent*, 11 R. P. C. 27.

(*t*) See *inter alia*, *Bell's Patent* (1862), 1 Moo. (N. S.) 49, but not costs of unsuccessful litigation, *ibid.* The costs of different suits should in general be shown separately, *ibid.*

For cases where such costs were disallowed on the ground that the litigation was not really connected with the patent in question, see *Saxby's Patent* (1870), 7 Moo. (N. S.) 82; *McClean's Patent*, 15 R. P. C. 418.

(*u*) *Poole's Patent* (1867), 4 Moo. (N. S.) 452; *Davies' Patent*, 11 R. P. C. 27. But *cf. Pieper's Patent*, 12 R. P. C. 295.

have been allowed in different cases, and it is submitted that in general any expenses which a prudent man would have incurred for the purpose of obtaining the maximum profit should be allowed (*x*).

Efforts of patentee.

The petitioner has to show that he and others who have or have had interests in the patent have used their best endeavours to bring it into use, and no extension will be granted unless this is the case (*y*).

An increased demand should be shown.

The most favourable case for the petitioner is where the demand for the invention has increased in the later years of the patent. If there has been no practical user of the invention at all this affords a very strong presumption that it is of no great utility (*z*), and cogent evidence to the contrary effect is needed to rebut this presumption (*a*). But if there has been a growing demand for the invention this enables the petitioner to demonstrate its utility, and at the same time affords a probability that a moderate extension will enable the inventor to reap his reward (*b*).

Validity not considered.

If it is clear to the Court that the patent is invalid no extension will be granted (*c*), at any rate of the invalid portion, but the Court will not decide on a question of doubtful validity (*d*), but will, where the patentee makes out a *primâ facie*

(*x*) In *Lawrence & Kennedy's Patent*, 27 R. P. C. 252, O. H., it was doubted whether the sums spent in buying up other patents could be debited. It is submitted that if such purchases were really necessary to develop the manufacture the expenses of their acquisition can properly be taken into account.

(*y*) *Dolbear's Patent*, 13 R. P. C. 203; *Van Gelder's Patent*, 24 R. P. C. 160; *Paterson's Patent* (1845), 6 Moo. (N. S.) 469.

It is specially incumbent where the invention has been taken up abroad for the petitioner to show that efforts were made to get British manufacturers to adopt it. *Johnson's Patent*, 25 R. P. C. 709; *cf.* also *Henderson's Patent*, 18 R. P. C. 449; *Pieper's Patent*, 12 R. P. C. 295.

Semble in general the Court disapprove of agreements for exclusive use unless they are satisfied that this was the only way to get the invention adopted at all; *Darby's Patent*, 8 R. P. C. 384, see also p. 319, *n.* (*n*).

(*z*) *Bakewell's Patent* (1862), 15 Moo. 385; *Herbert's Patent* (1867), 4 Moo. (N. S.) 300; *Allan's Patent* (1867), 4 Moo. (N. S.) 443 (cases considered); *Hughes' Patent* (1870), 4 A. C. 174.

(*a*) For cases where this presumption has been rebutted, see *inter alia*. *Herbert's Patent*, *supra*, *Hughes' Patent*, *supra*, and cases referred to therein. *Roper's Patent*, 4 R. P. C. 201; *Southby's Patent*, 8 R. P. C. 433.

(*b*) *Stoney's Patent*, 5 R. P. C. 518; *Church's Patents*, 3 R. P. C. 95. *Cf.* also *Robert's Patent* (1839), W. P. C. 573.

The fact that there is no probability of benefit from the extension has been made the ground of refusal, *e.g.* in *Scott's Patent*, 23 R. P. C. 478; *Pinkus's Patent* (1843), 12 Jur. 233.

But even where there is a falling off of profits in the later years the Court will consider other evidence of a probability of increase. *Church's Patents*, 3 R. P. C. 95.

(*c*) *Woodcroft's Patent* (1846), 2 W. P. C. 18; *Bell's Patent* (1862), 1 Moo. (N. S.) 49.

(*d*) The question of prolongation where some claims are invalid has

case on this point, grant an extension (if other circumstances warrant this), and leave the question of validity to be decided in the ordinary way (*e*). This applies even where a Court has held the patent to be bad if the decision is under appeal (*f*).

Assignees.

In the earlier decisions extensions were granted to an assignee with practically the same freedom as to the original inventor, the tribunal taking the view that it was for the benefit both of inventor and the public that there should be the prospect of a proper reward for those persons who had assisted the inventor to develop the new manufacture (*g*).

Later it was said that the merit of an assignee was less than that of an inventor (*h*), and this doctrine was developed until it became practically impossible for a mere assignee to get an extension, unless the inventor still had some interest in the patent (*i*).

never been decided. *Burlingham's Patent*, 15 R. P. C. 195; but *cf. Simister's Patent* (1842), W. P. C. 721.

(*e*) *Kay's Patent* (1839), W. P. C. 568; *Woodcroft's Patent*, *supra*; *Pinkus's Patent* (1848), 12 Jur. 233; *Heath's Patent* (1853), 2 W. P. C. 257; *Bell's Patent*, *supra*; *Hill's Patent* (1863), 1 Moo. (N. S.) 258; *Lancaster's Patent* (1864), 2 Moo. (N. S.) 189; *Cocking's Patent*, 2 R. P. C. 151; *Stewart's Patent*, 3 R. P. C. 7; *Church's Patents*, 3 R. P. C. 95; *Johnson's Patent*, 25 R. P. C. 709.

In *Lyon's Patent*, 11 R. P. C. 539, unsuccessful defendants were allowed to produce new instances of prior user.

(*f*) *Lane Fox's Patent*, 9 R. P. C. 411; *Kay's Patent* (1837), W. P. C. 568.

In *Heath's Patent*, *supra*, also an extension was granted, although there was *lis pendens*.

(*g*) *Southworth's Patent* (1837), W. P. C. 486; *Wright's Patent* (1837), W. P. C. 561; *Jones's Patent* (1840), W. P. C. 577; *Galloway's Patent* (1843), W. P. C. 727; *Morgan's Patent* (1843), W. P. C. 737; *Woodcroft's Patent* (1846), 2 W. P. C. 18; *Porter's Patent* (1852), 2 W. P. C. 196; *Whitehouse's Patent* (1938), W. P. C. 473; *Markwick's Patent* (1860), 13 Moo. 310; *Napier's Patent* (1861), 13 Moo. 543; *Hutchinson's Patent* (1861), 14 Moo. 364; *Davies' Patent*, 11 R. P. C. 27; *McCulloch's Patent*, 25 R. P. C. 684, O. H.

Webster states that out of the first seventeen extensions six were to assignees, and one was to an executrix (W. P. C. 725, *n.*).

(*h*) *Norton's Patent* (1853), 1 Moo. (N. S.) 339; *cf.* also *Normand's Patent* (1870), 6 Moo. (N. S.) 477; *Pitman's Patent* (1871), 8 Moo. (N. S.) 293; *Hopkinson's Patent*, 14 R. P. C. 5.

In *Claridge's Patents* (1851), 7 Moo. 394, it was said that whatever the assignee had done, all that could be considered was the merits of the original inventor (see also *Norton's Patent*, *supra*).

(*i*) In *Van Gelder's Patent*, 24 R. P. C. 169, it was said that there was no instance of a prolongation where the original inventor was dead and would have obtained no advantage were he alive; *cf.* also *Banff and Bower's Patent*, 12 R. P. C. 383; *Finch's Patent*, 15 R. P. C. 674. It is impossible to say whether or not this is so, but certainly there are precedents for granting extensions from which the original inventor could get no advantage, *e.g. Bodmer's Patent* (1849), 6 Moo. 468; *Galloway's Patent* (1843), W. P. C. 724.

In *McCulloch's Patent*, 25 R. P. C. 684, O. H., the Court refused to recognise this rule.

Where the assignee is a company in which the inventor has a large number of shares, the tribunal has been more favourable. See *Napier's Patent* (1861), 13 Moo. 543; *Houghton's Patent* (1871), 7 Moo. (N. S.) 309; *Bischoff's Patent*, 1 R. P. C. 62; *Church's Patents*, 3 R. P. C. 95;

It would certainly seem more advantageous to adopt to some extent the earlier practice, more particularly in the case of assignees who have really assisted in developing the manufacture, and have not merely come on the scene when the latter was in commercial existence (*k*).

The Court frequently makes it a term of extension that some payment shall be made to the original inventor or an interest in the renewed patent given to him (*l*).

Lapsing of foreign patents.

Another point which has frequently influenced the tribunal against granting an extension is that there have been foreign patents taken out which have lapsed or are on the point of lapsing (*m*). In recent times it has been said that this fact is of importance because British manufacturers would be prejudiced if the British patent were prolonged after the foreign ones had expired, since they would have to pay royalties, while foreigners would not (*n*). If this line of reasoning were followed out it would lead to the refusal of extension in all cases, since persons outside the realm are equally free to make without licence whether there have been foreign patents which have expired, or whether there never have been such patents at all. The objection originally arose in connection with a statutory provision that in certain cases British patents expired with foreign grants for the same invention (*o*), and it is submitted

Deacon's Patents, 4 R. P. C. 119; *Shone's Patent*, 9 R. P. C. 438; *Davies' Patent*, 11 R. P. C. 27; *Cross, Bevan, and Beadle's Patent*, 23 R. P. C. 485; *McCulloch's Patent*, 25 R. P. C. 684, O. H.

In *Clark's Patent*, 16 R. P. C. 431, where the inventor only held 6¾ per cent. of the shares, this proportion was considered too small, and prolongation was refused.

In *Cocking's Patent*, 2 R. P. C. 151, an extension was granted to an inventor to whom the patent had been reassigned.

(*k*) *Cf. McCulloch's Patent, supra; Pitman's Patent, supra; Hopkinson's Patent*, 14 R. P. C. 5; *Henderson's Patent*, 18 R. P. C. 449; *Sellar's Patent* (1882), Goodeve, 581, in all of which the difference in position between assignees who have assisted in developing the invention and those who have bought as a commercial speculation was insisted on. But the decisions against assignees have extended to both classes. *Cf. Van Gelder's Patent, supra.* See also *Quarrill's Patent* (1840), W. P. C. 740.

(*l*) *e.g. Whitehouse's Patent* (1838), W. P. C. 473 (£500 per annum to inventor); *Hardy's Patent* (1849), 6 Moo. 441 (£5000 to be paid to inventor); *Markwick's Patent* (1860), 13 Moo. 310 (annuity to inventor); *McCulloch's Patent*, 25 R. P. C. 684, O. H. (shares in company in place of proportion of profit).

Sometimes, however, the grant is made without the inventor having any interest, *e.g. Bodmer's Patent* (1849), 6 Moo. 460.

(*m*) *Norman's Patent* (1870), 6 Moo. (N. S.) 477; *Pieper's Patent*, 12 R. P. C. 295; *Henderson's Patent*, 18 R. P. C. 449.

(*n*) *E.g. Semet and Solvay's Patent*, 12 R. P. C. 10.

(*o*) This statute was 5 & 6 Will. IV. c. 83, and for discussions on its effect, see *Newton's Patent* (1862), 15 Moo. 176 (grant refused); *Blake's Patent* (1873), 9 Moo. (N. S.) 373 (grant

that it should not be considered as applicable to modern conditions (*p*).

Other points influencing the Court.

Amongst other points which have influenced the tribunal against prolongation the following may be noted. The failure to disclose in the specification details essential to success (*q*), the fact that a prolongation would limit the use of an improvement patent (*r*), or an article useful for the public health (*s*), the conduct of the patentee in sleeping on his rights (*t*), or in keeping an invalid claim in his patent (*u*), in granting an exclusive licence (*x*), in supplying the demand in this country by importation (*y*) or in making statements as to the patent profits in a prospectus inconsistent with those in the petition (*z*), and Stock Exchange transactions in the shares of the assignee company (*a*). On the other hand the Court have been influenced in the petitioner's favour by the amount of energy he has shown in working to introduce the invention and in making improvements (*b*), and by the fact that he had been continually harassed by litigation (*c*). The Court will not consider an

refused); *Bell's Patent* (1862), 1 Moo. (N. S.) 49 (grant allowed).

For other cases where subject has been discussed, see cases in *n.* (*m*) and *Johnson's Patent* (1871), 8 Moo. (N. S.) 282 (foreign patents not to prejudice British patentee *secus* if patentee has foreign domicile); *Poole's Patent* (1867), 4 Moo. (N. S.) 452; *Adair's Patent* (1881), 6 A. C. 170; *Darby's Patent*, 8 R. P. C. 384; *Shone's Patent*, 9 R. P. C. 438; *Parson's Patent*, 15 R. P. C. 439; *Thompson's Patent*, 19 R. P. C. 565, in all of which cases it was held that the fact that the foreign patents had expired, or were about to expire, did not prevent prolongation being granted.

This objection should be supported by proper evidence that British manufacturers would be unfairly handicapped by an extension. *Johnson's Patent*, 25 R. P. C. 709.

(*p*) Where, however, the patentee has allowed the foreign patents to lapse, *e.g.* by non-payment of fees, this may in some cases be fairly counted against him, either as showing that he has not made full use of his advantages, or that he has allowed British manufacturers to be handicapped, if there is any evidence that this has, in fact, occurred. In *Norden's Patent* (1872), 8 Moo. (N. S.) 306, the fact that foreign patents had been allowed to lapse was held a bar to extension.

(*q*) *Fountain Livet's Patent*, 9 R. P. C. 327.

(*r*) *Norton's Patent* (1861), 1 Moo. (N. S.) 339.

(*s*) *McDougall's Patent* (1867), 5 Moo. (N. S.) 1; *Sillar's Patent* (1882), Goodeve, 581; *cf. contra*, *Foarde's Patent* (1855), 9 Moo. 370; *Hart's Patent*, 25 R. P. C. 299.

(*t*) *Simister's Patent* (1842), W. P. C. 721; *Pinkus's Patent* (1848), 12 Jur. 233; *cf.* also *Lodge's Patent*, 28 R. P. C. 379.

(*u*) *Simister's Patent*, *supra*.

(*x*) *Cardwell's Patent* (1856), 10 Moo. 488; see also *Darby's Patent*, 8 R. P. C. 384.

This, however, is often dealt with by making it a condition that the exclusive licence should be abandoned. See p. 319, *n.* (*r*).

(*y*) *Johnson's Patent* (1871), 8 Moo. (N. S.) 282.

(*z*) *Lawrence's Patent*, 9 R. P. C. 89.

(*a*) *Sillar's Patent* (1882), Goodeve, 581.

(*b*) *Southey's Patent*, 8 R. P. C. 433; *Trotman's Patent* (1866), 3 Moo. (N. S.) 488.

(*c*) *Heath's Patent* (1853), 2 W. P. C. 257.

allegation that the patent is invalid because fees were paid too late (*d*).

Uberrima fides.

The petitioner is bound to set before the Court fully and fairly all circumstances which might influence their decision (*e*). These include the history of the invention (*f*) (including any prior patents of a like kind taken out by the patentee (*g*)), the prior state of common knowledge (*h*), the improvement effected by the invention, all dealings with the patent, whether by assignment, licence or otherwise (*i*), the expenses and receipts in regard to the patent whether incurred by the petitioner or others (*k*), the existence of foreign patents, and the profits from the same (*l*).

Petitioner.

The person to petition must be the patentee, and in all reported cases the legal owners of the patent have been among the petitioners (*m*). As patentee includes the executors, administrators and assigns of the original grantee, petitions may be presented by such persons (*n*).

Court.

The petition must in England be presented to the High Court and heard by the special judge, whose decision is final (*o*). In Scotland the petition must be presented to the Court of Session (*p*), and in Ireland to the High Court (*q*), and apparently

(*d*) *Dolbear's Patent*, 13 R. P. C. 205.

(*e*) *Pitman's Patent* (1871), 8 Moo. (N. S.) 293; *Clark's Patent* (1870), 7 Moo. (N. S.) 255; *Horsey's Patent*, 1 R. P. C. 225.

(*f*) *Stanfield's Patent*, 15 R. P. C. 17.

(*g*) *Stanfield's Patent, supra.*

(*h*) *Semble*, this should include any relevant specifications known to the petitioner. *Fountain Livet's Patent*, 9 R. P. C. 327.

(*i*) *Horsey's Patent*, 1 R. P. C. 225; *Lane Fox's Patent*, 9 R. P. C. 411; *Ferranti's Patent*, 18 R. P. C. 518; *cf.* also *Dexcon's Patent*, 4 R. P. C. 119.

In *Barff and Bower's Patent*, 12 R. P. C. 383, it was said that transactions in the shares of an assignee company should also be shown.

(*k*) See p. 308.

(*l*) *Johnson's Patent* (1871), 8 Moo. (N. S.) 282; *Pitman's Patent* (1871), 8 Moo. (N. S.) 293; *Adair's Patent* (1881), 6 A. C. 176; *Newton's Patent* (1884), 9 A. C. 592; *Willans and Robinson's Patent*, 13 R. P. C. 550.

If foreign patents have been refused, this should appear. *Johnson's Patent*, 25 R. P. C. 709.

(*m*) Sect. 18 (1). See "Patentee," p. 291.

An extension may be granted to a foreigner residing abroad. *Newton's Patent* (1861), 14 Moo. 156.

(*n*) *e.g.* Executor: *Bodmer's Patent* (1849), 6 Moo. 467; Administrator: *Heath's Patent* (1853), 2 W. P. C. 257; Assigns: see p. 313.

Where petitioner died after the order the new grant was made to his executrix. *Porter's Patent* (1853), 2 W. P. C. 196.

It has been said that the personal representatives of a deceased inventor should be joined. *Willacy's Patent*, 5 R. P. C. 692 (adjournment for such representatives to be added). Also that a mortgagee of the patentee should be joined in order to give the opponents security for costs. *Church's Patent*, 3 R. P. C. 95. But the omission to do this does not necessarily lead to the rejection of the petition, *ibid.*

(*o*) Sect. 18 (1), and s. 92.

(*p*) Sect. 94.

(*q*) Sect. 95.

these decisions are also without appeal (*r*). There are no provisions as to the country in which the petition must be presented.

The petitioner must advertise in the prescribed manner his intention to apply for an extension and must present the petition at least six months before the expiration of the patent (*s*), and within a week of the publication of the last of the advertisements in the *London Gazette* (*t*). On the day named in the advertisement the petition shall come into the Court list, and the petitioner shall apply to the Court to fix a day (called in the Rules "the appointed day") for the hearing (*u*), which day shall be advertised (*x*). Procedure.

The rules of procedure are contained in O. 53*a*, r. 3, which read with the rules of the Supreme Court, forms a code on this subject (*y*). The Court, however, has power to relax any of the requirements of the rules (*z*), though not of the Act (*a*).

Any person (*b*) may oppose the petition but must lodge a notice of his intention to do so before the day named in the first advertisements (*c*). The petitioner shall then serve a copy of the petition upon him (*d*), and the opponent must within three weeks lodge and serve written notice of objections (*e*), Opposition.

(*r*) *Lawrence and Kennedy's Patent*, 27 R. P. C. 258, I. H.

(*s*) Sect. 18 (1). As to advertisements, see O. 53 *a*, r. 3 (*a*), (*b*), and (*c*). The Court has no power to hear a petition presented after this time. *Adam's Patent*, 16 R. P. C. 1.

The P. C. held in *Friese Green's Patent*, 24 R. P. C. 464, that there was no power to entertain a petition which had not been advertised; but see *contra*, *Lindon's Patent*, 14 R. P. C. 643; *Poyser's Patent*, 24 R. P. C. 157.

...ough there is no other limit to the time for such petitions, it has always been the practice not to present them until near the time of expiry, and the P. C. has refused to hear a petition presented too soon. *Macintoshe's Patent* (1836), W. P. C. 739.

In some cases, however, petitions dealing with patents expiring at different times have been entertained, *e.g. Johnson and Atkinson's Patents* (1873), L. R. 5 P. C. 87 (two patents, three years between them); *Thomas's Patents*, 9 R. P. C. 367 (seven patents, two and a half years between first and last).

As to advertisements, see O. 53*a*, r. 3 (*a*), (*b*), and (*c*).

(*t*) O. 53*a*, r. 3 (*d*).

(*u*) O. 53*a*, r. 3 (*f*).

(*x*) O. 53*a*, r. 3 (*g*).

(*y*) *Johnson's Patent*, 25 R. P. C. 391.

Summonses under this special jurisdiction are taken in Court. *Barton's Patent*, 29 R. P. C. 208.

(*z*) O. 53*a*, r. 3 (*s*).

(*a*) *Cf. Adam's Patent*, 16 R. P. C. 1; *Friese Green's Patent*, 24 R. P. C. 464.

(*b*) Sect. 18 (2). There are no decisions limiting the class of persons entitled to oppose. An alien residing abroad may oppose: *re Schlumberger* (1853), 9 Moo. 1.

(*c*) O. 53*a*, r. 3 (*j*). *Semble* this time may be extended, O. 53*a*, r. 3 (*s*), but in *Hopkinson's Patent*, 13 R. P. C. 114, an application to extend the time because the opponents had not seen the notice was refused.

A person giving such notice may be heard on the application to fix the appointed day, O. 53*a*, r. 3 (*o*).

(*d*) O. 53*a*, r. 3 (*k*).

(*e*) O. 53*a*, r. 3 (*l*).

The rules as to particulars of objections do not apply to these notices

otherwise he is deemed to have abandoned his opposition (*f*). After this time the petition comes into the list for hearing (*g*).

Petition and accounts.

The contents of the petition and accounts have been dealt with elsewhere (*h*). The accounts must be lodged a fortnight before the appointed day and the petitioner must give the Board of Trade facilities for inspecting the books, etc., on which they are based (*i*).

Hearing.

Even where the petition is not opposed and the Board of Trade raise no objections, the petitioner must give evidence as to merit, remuneration, etc. (*k*). The Board of Trade or the Comptroller may appear and raise any objections they think fit (*l*), but other opponents cannot raise objections other than those stated in their notice (*m*).

Order and condition.

The prolongation may be effected either by extending the original grant or by making a new grant (*n*). In either case the extended or new letters patent are usually vested in the person legally entitled to the grant at the time of the prolongation (*o*), but a new grant may be made to other persons, *e.g.* to

which are rather intended to indicate the grounds of objection than to give particulars, and although the opponent should give any instances of publication or prior user within his knowledge, he may give evidence of further instances discovered later. *Johnson's Patent*, 25 R. P. C. 392.

It is doubtful whether these objections are pleadings, and *semble* time runs in the Long Vacation. *Stearn's Patent*, 28 R. P. C. 664; *Barton's Patent*, 29 R. P. C. 208; *Johnson's Patent*, *supra*. *Cf.* also *Beldam's Patent*, 27 R. P. C. 758. The time may be extended. *Stearn's Patent*, *supra*.

(*f*) O. 53*a*, r. 3 (*m*).

(*g*) O. 53*a*, r. 3 (*p*).

(*h*) See p. 316 and p. 310.

(*i*) O. 53*a*, r. 3 (*i*). Opponents other than the Board of Trade have a right to obtain at their own expense copies of the accounts: O. 53*a*, r. 3 (*q*), but not to inspect the books: *cf. Bridson's Patent* (1851), 7 Moo. 499, though they may be allowed to do so at the hearing: *Lyon's Patent*, 11 R. P. C. 539.

(*k*) *Darby's Patent*, 8 R. P. C. 383; *Joy's Patent*, 10 R. P. C. 89.

In some cases before the P. C. account books were admitted in evidence without the writing being proved. *Swaine's Patent* (1837), W. P. C. 559; and where the books could not be produced estimates were permitted. *Hazeland's Patent*, 11 R. P. C. 467; but the absence of books should be explained. *Lawrence's Patent*, 9 R. P. C. 55. See also *Lake's Patent*, 8 R. P. C. 227; *Yate's Patent*, 4 R. P. C. 150.

(*l*) O. 53*a*, r. 3 (*l*). This carries on the old practice. See *inter alia Fountain Livet's Patent*, 9 R. P. C. 327.

(*m*) O. 53*a*, r. 3 (*n*). But *cf.* p. 317, n. (*e*). The opponents were allowed to refer to fresh specifications, etc., in *Ball's Patent* (1879), 4 A. C. 171; *Stewart's Patent*, 3 R. P. C. 7.

The old rule was that only two counsel would be heard for the opponents unless there were separate and distinct grounds of opposition. *Woodcroft's Patent* (1841), 3 Moo. 171.

(*n*) Sect. 18 (5). Both courses are adopted in practice. In *Smith's Patent*, 2 R. P. C. 14, and *Cocking's Patent*, 2 R. P. C. 151, new grants were made so that the patents might be subject to the conditions of the 1883 Act as to compulsory licences.

As to effect of delay in obtaining the new grant, see *re Schlumberger* (1853), 9 Moo. 1.

(*o*) See *inter alia Wright's Patent* (1837), W. P. C. 561.

the original inventor (*p*), or conditions may be imposed varying or preserving the respective rights (*q*). Conditions may also be imposed in the public interest, *e.g.* as to licences (*r*), prices (*s*), or the use of the invention by the State (*t*).

Where the Court is of opinion that part only of the invention, or only some particular application thereof, is of such merit as would justify an extension, the extension may be granted for certain claims only, or for certain applications only (*u*).

Term of extension.

The term of extension is entirely in the Court's discretion, but is limited to seven, or in exceptional cases, to fourteen years (*x*). The Court has no power to grant a second extension (*y*).

Costs.

Costs may be given either to or against opponents (*z*), other

(*p*) *Bovill's Patent* (1863), 1 Moo. (N. S.) 348, and see p. 316, *n.* (*n*).

(*q*) *E.g. Church's Patent*, 3 R. P. C. 95 (mortgagee to have same security over new patent as he had over old). *Derosne's Patent* (1844), 2 W. P. C. 1 (existing licensees to have same right under renewed patent). *Normandy's Patent* (1855), 9 Moo. 452 (opponent to continue to receive royalties under certain licences). In *Lancaster's Patent* (1864), 2 Moo. (N. S.) 189, the P. C. refused to impose conditions in favour of a person claiming to have assisted in making the invention.

See also cases in next note.

(*r*) *E.g. Shone's Patent*, 9 R. P. C. 438; (exclusive licence to be abandoned); *Lyon's Patent*, 11 R. P. C. 537 (exclusive licence to be abandoned); *Mallett's Patent*, (1866) 4 Moo. (N. S.) 175 (licences to any person on terms of existing licences); *Lyon's Patent*, *supra* (licences at 10 per cent. on selling price).

(*s*) *E.g. Hart's Patent*, 25 R. P. C. 299 (Board of Trade to have power to fix prices). See also *Hardy's Patent* (1849), 6 Moo. 441.

(*t*) *E.g.* Crown to have free use. *Pettitt Smith's Patent* (1850), 7 Moo. 133; *Hughes' Patent* (1879), 4 A. C. 174; *Napier's Patent* (1881), 6 A. C. 174 (where this condition was said to be usual).

The P. C., however, refused to impose this condition in *Lancaster's Patent*, *supra*, and *Carpenter's Patent* (1864), 2 Moo. (N. S.) 190 *n.*

(*u*) *Bodmer's Patent* (1853), 8 Moo. 282; *Lee's Patent* (1856), 10 Moo. 226; *Napier's Patent* (1881), 6 A. C. 174; *Church's Patent*, 3 R. P. C. 95; *Joy's Patent*, 10 R. P. C. 89; *Lodge's Patent*, 28 R. P. C. 365.

(*x*) Sect. 18 (5). The power to extend a patent for more than seven years was first given by 7 & 8 Vict. c. 69.

The only cases in which the P. C. or the Court have exercised their power of extending a patent for more than seven years are: *Stoney's Patent*, 5 R. P. C. 518; *Darby's Patent*, 8 R. P. C. 380; *Currie & Timmis's Patent*, 15 R. P. C. 63; *McCulloch's Patent*, 25 R. P. C. 684, O. H.

In each case the extension was for ten years. It is not possible to derive from these cases any rules as to when this power will be exercised. There are instances of longer extension by Act of Parliament.

(*y*) *Thompson's Patent* (No. 2), 26 R. P. C. 675, following *Goucher's Patent* (1866), 2 Moo. (N. S.) 532.

(*z*) O. 53*a*, r. 3 (*a*). Opponents were very seldom ordered to pay costs; but in *Downton's Patent* (1839), W. P. C. 565, they were ordered to pay the increased costs caused by opposition. Costs were given more freely where petitioners were unsuccessful. *Wield's Patent* (1871), 8 Moo. (N. S.) 300, though not always even then, *cf. Muntz' Patent* (1846), 2 W. P. C. 122; *Stewart's Patent*, 3 R. P. C. 7; *Ricci's Patent*, 23 R. P. C. 273.

In *Hopkinson's Patent*, 14 R. P. C. 5, one set of costs among seven opponents, the amount being fixed at £400.

than the Comptroller or the Board of Trade (*a*), but except under special circumstances only one set of costs will be given among all opponents (*b*).

Where a petition is withdrawn the opponents will in general be allowed their costs (*c*), but it is for the opponents to establish that there is any reason for allowing more than one set of costs (*d*).

(*a*) No costs can be given to these, O. 53*a*, r. 3 (*u*). In fact the former practice was that the Attorney-General did not ask for costs.

(*b*) O. 53*a*, r. 3 (*v*). See note (*z*), *supra*.

(*c*) *Morgan Brown's Patent*, 3 R. P. C. 212; *Imray's Patent*, 20 R. P. C. 11; *Stearn's Patent*, 28 R. P. C. 696.

(*d*) *Imray's Patent*, *supra*; *Stearn's Patent*, *supra*.

FORMS

Pleadings in Infringement Action.

FORM 1.

1912 S. No. 10000.

In the High Court of Justice,
Chancery Division.
Mr. Justice Jones.

Between William Smith, *Plaintiff*,
and
John Jones, *Defendant*.

Statement of Claim (*a*).

(1) The plaintiff is the registered proprietor of Letters Patent No. 44444* of the year 1900 granted to him for improvements in bicycle tyres (*b*).

(2) The said Letters Patent are and always have been good and valid (*c*).

(3) The specification of the said Letters Patent was duly amended in accordance with an order of the Comptroller General dated the 1st day of January, 1905.

(4) The original claims of the said specification were drafted in good faith and with reasonable skill and knowledge (*d*).

(5) In an action of *Smith* v. *Brown* (1910 S. No 1), a certificate of the validity of the said Letters Patent was granted on the 1st March, 1910 (*e*).

(6) The Defendant has infringed and threatens and claims the right to infringe the said Letters Patent in the manner appearing in the Particulars of Breaches delivered herewith, and will continue to infringe such Letters Patent unless he is restrained by the Order of this Honourable Court (*f*).

The Plaintiff claims—

1. An injunction to restrain the Defendant his servants and agents from infringing the said Letters Patent (*g*).
2. An inquiry as to damages or at the Plaintiff's option an account of profits (*h*).
3. Delivery up of the infringing articles (*i*).
4. Costs as between solicitor and client (*k*).
5. Such further or other relief as the Court may in the premises deem meet.

(*a*) Pp. 166–167.
(*b*) P. 10.
(*c*) P. 188.
(*d*) P. 237, *n.* (*y*).
(*e*) P. 200.
(*f*) Pp. 187–188, 191–192.
(*g*) Pp. 191–192.
(*h*) Pp. 193–197.
(*i*) P. 198.
(*k*) P. 200.

FORM 2.

(Heading as in Form 1.)

PARTICULARS OF BREACHES DELIVERED WITH THE STATEMENT OF CLAIM (*l*).

(1) The Defendant has both before and after the issue of the Writ in this action infringed the said Letters Patent by the manufacture sale and use of bicycle tyres made in infringement of the claiming clauses of the said specification (*m*).

(2) For the purposes of the hearing the Plaintiff will rely on the following specific breaches :—

(*a*) The manufacture by the Defendant at his works at Blank Street, London, of such infringing tyres in the months of May and June, 1911.

(*b*) The sale on the 1st day of June, 1911, to James Johnson at the Defendant's said works of one bicycle tyre made in infringement of the said Letters Patent.

(*c*) The use on a bicycle ridden by the Defendant at the Blankshire sports on Whit Monday, 1911, of tyres made in infringement of the said Letters Patent. Each of the said tyres referred to in subparagraphs (*a*) (*b*) and (*c*) hereof were made in infringement of all the claiming clauses of the said Letters Patent.

(3) The Defendant has also threatened to infringe the said Letters Patent and has claimed the right to continue to make tyres in infringement of the claims of the said Letters Patent. Such threats and claims of right were made verbally on the 1st day of June, 1911, at interviews between the Defendant and the Plaintiff's solicitor William Robinson and in a letter addressed by the Defendant to the said William Robinson, and dated the 30th day of May, 1911 (*n*).

(4) The Plaintiff is unable to give further or better particulars of the Defendant's breaches until after he shall have obtained discovery, but will claim full relief for all such breaches.

FORM 3.

(Heading as in Form 1.)

DEFENCE AND COUNTERCLAIM.

Defence (*o*).

(1) The Defendant admits the allegations contained in paragraph 1 of the Statement of Claim and further admits that the said Letters Patent were duly amended as alleged (*p*). He denies that the original claims to the said Letters Patent were framed in good faith or with reasonable skill or knowledge.

(*l*) P. 167.

(*m*) This paragraph is usual, but would seem to be unnecessary.

(*n*) Pp. 187–188.

(*o*) P. 168.

(*p*) P. 169, *n.* (*e*).

(2) The Defendant denies that he has infringed or threatened or claimed the right to infringe the said Letters Patent as alleged or at all.

(3) The said Letters Patent are and always have been invalid and of no effect for the reasons appearing in the Particulars of Objections delivered herewith.

(4) Further the Defendant says that the manufacture of the articles the subject of the said Letters Patent has been during the whole life of the patent wholly carried on abroad. Such manufacture has been carried on by the X Company at their works at Boston, Massachusetts, in the United States of America (*q*).

(5) The Defendant also says that by reason of the failure of the patentee to supply the patented articles on reasonable terms the demand for the patented article is not fairly met.

Further, the industry of tyremaking in this country is unfairly prejudiced by the refusal of the Plaintiff to grant licences on reasonable terms, and also by reason of the conditions attached by the Plaintiff to the purchase of the said patented article as appears in the next paragraph hereof (*r*).

The reasonable requirements of the public would not now be satisfied by the grant of licences (*s*).

Particulars.

The Plaintiff's wholesale price for such tyres is £2 each, which is an unreasonable price. In a letter to the Defendant dated 1st August, 1911, the Plaintiff stated he would not supply any such tyres at less than the said price.

The Plaintiff by a letter dated 1st August, 1911, refused to grant a licencee to the Defendant, and by a letter dated 1st September, 1911, refused to grant a licence to the A.B. Company, Ltd. The Defendant is unable until after he shall have obtained discovery to give further or better particulars of the Plaintiff's refusals.

(6) The Defendant will also rely on the fact that the Plaintiff has inserted in a contract, made on the 30th day of May, 1910, with E. F. of No. 1000, Canon Street, London, which contract is still in force, a requirement that the said E. F. should not purchase any tyres of any other person than the plaintiff (*t*).

Counterclaim.

By way of Counterclaim the Defendant repeats paragraphs 3, 4, and 5 of his Defence, and applies for the revocation of the said

(*q*) Pp. 169 and 174.

(*r*) P. 169.

(*s*) P. 169.

(*t*) It should be noted that there may be cases coming within s. 24 (5) (*b*) which are not within s. 38.

Letters Patent on the grounds set out therein. The Defendant has obtained the Attorney-General's fiat authorising him to petition for the revocation of the said Letters Patent (*u*).

FORM 4.

(Heading as in Form 1.)

PARTICULARS OF OBJECTIONS DELIVERED WITH THE DEFENCE (*x*).

The following are the Particulars of Objections on which the Defendant will rely :—

(1) The said alleged invention was not novel at the date of the grant of the said Letters Patent neither was it subject-matter for Letters Patent in view of the general common knowledge and practice of makers of bicycle tyres and workers in indiarubber generally, and in view of the facts set out below (*y*).

The further facts on which the Defendant will rely in support of the said objection are as follows : (*a*) The publication at the Patent Office, of the following specifications before the date of the said grant.

	Number.	Year.	Patentee.	Parties relied on.	Claims against which quoted.
(1)	11111	1870	William Jones	Figs. 1 to 5 and the corresponding letterpress	All

(*b*) The publication at the offices of Messrs. A. B. and Co., Publishers of No. 1, Fleet Street (*z*), London, on about the 1st January, 1895, of "Bicycle Tyres and their Manufacture," by Joseph Robinson. The parts relied on are pages 62 to 64, which are relied on against all the claims of the said Letters Patent (*a*).

(*c*) A Lecture delivered by J. Thompson to the Institute of Mechanical Engineers on the 6th day of January, 1899, in which the alleged inventions claimed in each of the claiming clauses of the said Letters Patent were described.

(*d*) The exhibition of a tyre made in accordance with claims 1 to 3 of the said Letters Patent at the Coventry Bicycle Show in the month of January, 1899.

(*e*) The prior use of the alleged inventions claimed by the first three claiming clauses of the said Letters Patent by John Jones of No. 1, Green Street, London. Such prior use commenced on the 1st January, 1898, and continued till the 1st January, 1899. None of the tyres so made are now in existence, but a drawing showing the construction of such tyres is delivered herewith (*b*).

(*u*) Pp. 177, 211, 214. Par. 6 of the defence affords no ground for revocation, p. 213, *n.* (*s*).

(*x*) Pp. 169, *et seq.*

(*y*) P. 170.

(*z*) P. 64, *n.* (*s*).

(*a*) P. 171. Where possible publication at the Patent Office Library is alleged for case of proof.

(*b*) Pp. 171, 172. A tyre would probably not come within the term "apparatus," but the form is given for reference.

(*f*) The prior use by the Plaintiff himself of the alleged inventions claimed by each of the claiming clauses of the said Letters Patent. Such prior use took place at 1, Blue Street, London, and continued from the 1st January, 1899, up to the date of the grant of the said Letters Patent. The Defendant is unable to give further particulars of such use until after he shall have obtained discovery (*c*).

(3) The said William Smith was not the true and first inventor of the said alleged inventions forming the subject-matter of the said Letters Patent. The true and first inventor of the same was William Rogers, No. 1, King Street, London (*d*).

(4) The said alleged inventions were not useful. This objection is relied on against all the claims of the said Letters Patent (*e*).

(5) The specification of the said Letters Patent is insufficient in that it does not distinguish what is old from what is new (*f*).

(6) The specification of the said Letters Patent is insufficient in that it gives no sufficient directions to enable a competent workman to make the tyre shown in Fig. 6 thereof.

The specification is also insufficient in that it gives no sufficient directions for obtaining the best or any useful results from the method of constructing tyres set out on page 2, lines 15 to 25 of the said specification (*g*).

(7) The alleged invention claimed by claim 5 of the said Letters Patent is a substantially different invention from any invention described or foreshadowed in the provisional specification. Such further invention was not new at the date of the lodging of the complete specification in view of the sale by the Plaintiff to one John Williams at his works at 1, Blue Street, London, aforesaid on the 1st day of December, 1900, of a bicycle tyre made according to claim 5 of the complete specification (*h*).

(8) The alleged inventions claimed in claims 1 to 4 of the said Letters Patent had been the subject of a prior grant. Such prior grant is the subject of the first three claims of Letters Patent No. 55555 of 1899, granted to William James Smithers (*i*).

The Defendant will also allege that the Plaintiff was not the true and first inventor of the inventions claimed in such four claims in view of the prior application by the said William James Smithers for Letters Patent No. 55555 of 1899 for such inventions (*k*).

(*c*) P. 67, *n.* (*f*).
(*d*) P. 172.
(*e*) Pp. 172, 173.
(*f*) P. 173.
(*g*) *Ibid.*
(*h*) P. 174.
(*i*) Pp. 174, 175.

(*k*) P. 77. Besides the defences and objections here set out the following may also be raised. That the alleged invention was not for any manner of manufacture, p. 17, that it was contrary to law or morality, p. 214, *n.* (*s*), and sect. 75,

FORM 5.

(Heading as in Form 1.)

REPLY AND DEFENCE TO COUNTERCLAIM.

Reply.

(1) Save as hereinafter appears the Plaintiff joins issue on all the allegations contained in the Defence save in so far as the same consist of admissions.

(2) The Plaintiff further says with reference to the alleged prior grant to William James Smithers referred to in paragraph 8 of the Particulars of Objections delivered with the Defence, that the Letters Patent therein referred to were invalid for the reasons mentioned in the Particulars of Objections delivered herewith (*l*).

(3) The Plaintiff does not admit any of the allegations contained in paragraph 4 of the Defence. If the said patented articles are, or were, manufactured wholly or mainly abroad as alleged or at all, which is not admitted, the Plaintiff says that there is a satisfactory reason for the absence of manufacture in this country, viz. The Plaintiff has not had during the existence of the said Letters Patent any means to enable him to start manufacture. He has used his best endeavours, during the whole period since the date of the grant, to get firms in this country to take licences for the manufacture of the said patented articles, but none of such firms have been willing to take licences or to commence manufacture.

Particulars of the Plaintiff's Endeavours.

On the 1st August in each of the years 1908, 1909, 1910, 1911 and 1912 the Plaintiff inserted an advertisement in the Patent Office Journal inviting applications for licences under the said Letters Patent. The Plaintiff has also personally or by letter communicated with all the principal firms manufacturing tyres in this country with a view to getting them to adopt the said invention (*m*).

(4) The Plaintiff denies each and every allegation contained in paragraph 5 of the Defence except that his catalogue price for the said tyres is £2. The Plaintiff denies that £2 is an unreasonable price for such tyres.

(5) The Plaintiff does not admit any of the allegations contained in paragraph 6 of the Defence. If the said contract with E. F. was entered into, and if it contained the clause alleged, neither of which is

or mischievous to the state or ments, or that the Crown has been hurtful to trade or generally inconvenient or prejudicial, p. 28, p. 252, *n.* (*x*), that the monopoly claimed was larger than the invention made, p. 19, that the specification contains material false suggestions or state-

deceived, pp. 98–100. As to a plea of infringement without notice, see p. 197.

(*l*) Pp. 176–177.

(*m*) Pp. 300, 304.

admitted, the Plaintiff will rely on the fact that he was willing to enter into an agreement for the sale of tyres to the said E. F. on reasonable terms and without the insertion of such clause, and further on the fact that the said contract contains a clause giving the said E. F. the right to terminate such contract on the payment of such sum as may be fixed by an arbitrator appointed by the Board of Trade (*n*).

Defence to Counterclaim (*o*).

(1) The Plaintiff denies each and every allegation contained in paragraph 3 of the Defence.

(2) With reference to the allegations contained in paragraphs 4 and 5 of the Defence the Plaintiff repeats paragraphs 3, 4 and 5 of his Reply (*p*).

PETITION FOR REVOCATION.

FORM 6.

In the Matter of the Patents and Designs Act, 1907,
and
In the Matter of Letters Patent No. 55555 of 1910,
granted to John Smith (*q*).

To His Majesty's High Court of Justice.

The Humble Petition of William Jones of 1, Blank Street, London,
SHEWETH AS FOLLOWS:—

(1) Your petitioner is the true and first inventor of the invention forming the subject-matter of the said Letters Patent (*r*).

(2) The said Letters Patent were obtained in fraud of the right of your petitioner under the following circumstances. Your petitioner was in the employ of the said John Smith at the time when he made the said invention, and on the 1st day of January, 1910, he confidentially communicated such invention to the said John Smith in order to obtain his opinion as to whether it was of any practical utility or would be worth patenting. The said John Smith informed your petitioner that he did not think the said invention would be of any utility. Subsequently the said John Smith without any further communication to your petitioner and without your petitioner's consent applied for the said Letters Patent in his own name and with intent to deprive your petitioner of his just rights (*s*).

(*n*) P. 249, *n*. (*l*).

(*o*) Even if the reply is a simple traverse, the defence to counterclaim must deal with the allegations *seriatim*, see O. 21, and *Benbow* v. *Low* (1880), 13 Ch. D. 553.

(*p*) The facts alleged in par. 6 of the defence are also relied on in par. 5.

(*q*) See Chapter XI.

(*r*) P. 212, *n*. (*h*).

(*s*) P. 212.

Your petitioner therefore humbly prays for the revocation of the said Letters Patent No. 55555 and for a declaration that your petitioner is entitled to have Letters Patent granted to him for the said invention (*t*).

And your Petitioner will ever pray, &c.

It is intended to serve this petition on the said John Smith (*u*).

APPLICATION FOR RESTORATION OF LAPSED PATENT.

FORM 7.

In the Matter of the Patents and Designs Act, 1907,
and
In the Matter of Letters Patent No. 55555 of 1908.

I, John Smith, hereby apply for an order from the Comptroller for the restoration of the patent granted upon Application No. 55555 dated the 1st day of June, 1908. The circumstances which have led to the omission of the payment of the fee of £5 due on or before the 1st day of June, 1912, are as follows :—

In connection with my business as an engineer I am possessed of a number of patents. The business in connection with such patents, including the payment of the renewal fees when necessary, was left by me in the hands of my chief clerk XY, he applying to me from time to time for the necessary monies. In the beginning of November last my manager informed me that he was doubtful as to the honesty of the said XY, and I thereupon gave instructions for the accounts of the said XY to be examined. On the 5th November, 1912, the said XY came to me and admitted that he had been misappropriating monies placed in his hands and in particular he had appropriated the sum of £5 which had been given to him to pay the renewal fee on the said lapsed patent. On receiving such information I immediately instructed my patent agents, Messrs. A. & B., to take the necessary steps for the lodging of this present application (*x*).

(*t*) P. 216. (*u*) P. 214. (*x*) P. 284.

APPENDIX

PATENTS AND DESIGNS ACT, 1907
(7 EDW. 7, c. 29)

CHAPTER 29

An Act to consolidate the enactments relating to Patents for Inventions and the Registration of Designs and certain enactments relating to Trade Marks. A.D. 1907.

[28th August, 1907.]

BE it enacted by the King's most Excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows :—

PART I

PATENTS

Application for and Grant of Patent.

Application.

1.—(1) An application for a patent may be made by any person who claims to be the true and first inventor of an invention, whether he is a British subject or not, and whether alone or jointly with any other person.

(2) The application must be made in the prescribed form, and must be left at, or sent by post to, the Patent Office in the prescribed manner.

(3) The application must contain a declaration to the effect that the applicant is in possession of an invention, whereof he, or in the case of a joint application one at least of the applicants, claims to be the true and first inventor, and for which he desires to obtain a patent, and must be accompanied by either a provisional or complete specification.

(4) The declaration required by this section may be either a statutory declaration or not, as may be prescribed.

Specifications.

2.—(1) A provisional specification must describe the nature of the invention.

(2) A complete specification must particularly describe and ascertain the nature of the invention and the manner in which the same is to be performed.

(3) In the case of any provisional or complete specification where the comptroller deems it desirable he may require that suitable drawings shall be supplied with the specification, or at any time before the acceptance of the same, and such drawings shall be deemed to form part of the said specification.

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(4) A specification, whether provisional or complete, must commence with the title, and in the case of a complete specification must end with a distinct statement of the invention claimed.

(5) Where the invention in respect of which an application is made is a chemical invention, such typical samples and specimens as may be prescribed shall, if in any particular case the comptroller considers it desirable so to require, be furnished before the acceptance of the complete specification.

Proceedings upon application.

3.—(1) The Comptroller General of Patents, Designs, and Trade Marks (herein-after referred to as the comptroller) shall refer every application to an examiner.

(2) If the examiner reports that the nature of the invention is not fairly described, or that the application, specification, or drawings have not been prepared in the prescribed manner, or that the title does not sufficiently indicate the subject-matter of the invention, the comptroller may refuse to accept the application or require that the application, specification, or drawings be amended before he proceeds with the application; and in the latter case the application shall, if the comptroller so directs, bear date as from the time when the requirement is complied with.

(3) Where the comptroller refuses to accept an application or requires an amendment, the applicant may appeal from his decision to the law officer, who shall, if required, hear the applicant and the comptroller, and may make an order determining whether and subject to what conditions (if any) the application shall be accepted.

(4) The comptroller shall, when an application has been accepted, give notice thereof to the applicant.

Provisional protection.

4. Where an application for a patent in respect of an invention has been accepted, the invention may during the period between the date of the application and the date of sealing such patent be used and published without prejudice to the patent to be granted for the invention; and such protection from the consequences of use and publication is in this Act referred to as provisional protection.

Time for leaving complete specification.

5.—(1) If the applicant does not leave a complete specification with his application, he may leave it at any subsequent time within six months from the date of the application:

Provided that where an application is made for an extension of the time for leaving a complete specification, the comptroller shall, on payment of the prescribed fee, grant an extension of time to the extent applied for but not exceeding one month.

(2) Unless a complete specification is so left the application shall be deemed to be abandoned.

Comparison of provisional and complete specification.

6.—(1) Where a complete specification is left after a provisional specification, the comptroller shall refer both specifications to an examiner.

(2) If the examiner reports that the complete specification has not been prepared in the prescribed manner, the comptroller may refuse to accept the complete specification until it has been amended to his satisfaction.

(3) If the examiner reports that the invention particularly described in the complete specification is not substantially the same as that which is described in the provisional specification the comptroller may—

(a) refuse to accept the complete specification until it has been amended to his satisfaction; or

(b) (with the consent of the applicant) cancel the provisional specification and treat the application as having been made on the date at which the complete specification was left, and the application shall have effect as if made on that date:

Provided that where the complete specification includes an invention not included in the provisional specification, the comptroller may allow the original application to proceed so far as the invention included both in the provisional and in the complete specification is concerned, and treat the claim for the additional invention included in the complete specification as an application for that invention made on the date at which the complete specification was left.

(4) A refusal of the comptroller to accept a complete specification shall be subject to appeal to the law officer, who shall, if required, hear the applicant and the comptroller and may make an order determining whether and subject to what conditions (if any) the complete specification shall be accepted.

(5) Unless a complete specification is accepted within twelve months from the date of the application, the application shall (except where an appeal has been lodged) become void:

Provided that where an application is made for an extension of time for the acceptance of a complete specification, the comptroller shall, on payment of the prescribed fee, grant an extension of time to the extent applied for but not exceeding three months.

Investigation of previous specifications in United Kingdom on applications for patents.

7.—(1) Where an application for a patent has been made and a complete specification has been left, the examiner shall, in addition to the other inquiries which he is directed to make by this Act, make a further investigation for the purpose of ascertaining whether the invention claimed has been wholly or in part claimed or described in any specification (other than a provisional specification not followed by a complete specification) published before the date of the application, and left pursuant to any application for a patent made in the United Kingdom within fifty years next before the date of the application.

(2) If on investigation it appears that the invention has been wholly or in part claimed or described in any such specification, the applicant shall be informed thereof, and the applicant may, within such time as may be prescribed, amend his specification, and the amended specification shall be investigated in like manner as the original specification.

(3) If the comptroller is satisfied that no objection exists to the specification on the ground that the invention claimed thereby has been wholly or in part claimed or described in a previous specification as before mentioned, he shall, in the absence of any other lawful ground of objection, accept the specification.

(4) If the comptroller is not so satisfied, he shall, after hearing the applicant, and unless the objection is removed by amending the specification to the satisfaction of the comptroller, determine whether a reference to any, and, if so, what prior specifications ought to be made in the specification by way of notice to the public:

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Provided that the comptroller, if satisfied that the invention claimed has been wholly and specifically claimed in any specification to which the investigation has extended, may, in lieu of requiring references to be made in the applicant's specification as aforesaid, refuse to grant a patent.

(5) An appeal shall lie from the decision of the comptroller under this section to the law officer.

(6) The investigations and reports required by this section shall not be held in any way to guarantee the validity of any patent, and no liability shall be incurred by the Board of Trade or any officer thereof by reason of, or in connexion with, any such investigation or report, or any proceeding consequent thereon.

Investigation of specifications published subsequently to application.

8.—(1) An investigation under the last preceding section shall extend to specifications published after the date of the application in respect of which the investigation is made, and being specifications which have been deposited pursuant to prior application; and that section shall, subject to rules under this Act, have effect accordingly.

(2) Where, on such an extended investigation, it appears that the invention claimed in the specification deposited pursuant to an application is wholly or in part claimed in any published specification deposited pursuant to a prior application, the applicant shall, whether or not his specification has been accepted or a patent granted to him, be afforded such facilities as may be prescribed for amending his specification, and in the event of his failing to do so the comptroller shall, in accordance with such procedure as may be prescribed, determine what reference, if any, to other specifications ought to be made in his specification by way of notice to the public.

(3) For the purposes of this section an application shall be deemed to be prior to another application if the patent applied for when granted would be of prior date to the patent granted pursuant to that other application.

(4) This section shall come into operation at such date as the Board of Trade may by order direct, and shall apply only to applications made after that date, and the order shall be laid before both Houses of Parliament.

Advertisement on acceptance of complete specification.

9. On the acceptance of the complete specification the comptroller shall advertise the acceptance; and the application and specifications with the drawings (if any) shall be open to public inspection.

Effect of acceptance of complete specification.

10. After the acceptance of a complete specification and until the date of sealing a patent in respect thereof, or the expiration of the time for sealing, the applicant shall have the like privileges and rights as if a patent for the invention had been sealed on the date of the acceptance of the complete specification: Provided that an applicant shall not be entitled to institute any proceeding for infringement until a patent for the invention has been granted to him.

Opposition to grant of patent.

11.—(1) Any person may at any time within two months from the date of the advertisement of the acceptance of a complete specification give notice at the Patent Office of opposition to the grant of the patent on any of the following grounds:—

(*a*) that the applicant obtained the invention from him, or from a person of whom he is the legal representative; or

(*b*) that the invention has been claimed in any complete specification for a British patent which is or will be of prior date to the patent the grant of which is opposed, other than a specification deposited pursuant to an application made more than fifty years before the date of the application for such last-mentioned patent; or

(*c*) that the nature of the invention or the manner in which it is to be performed is not sufficiently or fairly described and ascertained in the complete specification; or

(*d*) that the complete specification describes or claims an invention other than that described in the provisional specification, and that such other invention forms the subject of an application made by the opponent in the interval between the leaving of the provisional specification and the leaving of the complete specification,

but on no other ground.

(2) Where such notice is given the comptroller shall give notice of the opposition to the applicant, and shall, on the expiration of those two months, after hearing the applicant and the opponent, if desirous of being heard, decide on the case.

(3) The decision of the comptroller shall be subject to appeal to the law officer, who shall, if required, hear the applicant and the opponent, if the opponent is, in his opinion, a person entitled to be heard in opposition to the grant of the patient, and shall decide the case; and the law officer may, if he thinks fit, obtain the assistance of an expert, who shall be paid such remuneration as the law officer with the consent of the Treasury may determine.

Grant and sealing of patent.

12.—(1) If there is no opposition, or, in case of opposition, if the determination is in favour of the grant of a patent, a patent shall, on payment of the prescribed fee, be granted to the applicant, or in the case of a joint application to the applicants jointly, and the comptroller shall cause the patent to be sealed with the seal of the Patent Office.

(2) A patent shall be sealed as soon as may be, and not after the expiration of fifteen months from the date of application, provided that—

(*a*) Where the comptroller has allowed an extension of the time within which a complete specification may be left or accepted, a further extension of four months after the said fifteen months shall be allowed for the sealing of the patent:

(*b*) Where the sealing is delayed by an appeal to the law officer, or by opposition to the grant of the patent, the patent may be sealed at such time as the law officer may direct:

(*c*) Where the patent is granted to the legal representative of an applicant who has died before the expiration of the time which would otherwise be allowed for sealing the patent, the patent may be sealed at any time within twelve months after the date of his death:

(*d*) Where in consequence of the neglect or failure of the applicant to pay any fee a patent cannot be sealed within the period allowed by this section, that period may, on payment of the prescribed fee and on compliance with the prescribed conditions, be extended to such an extent as may be prescribed, and this provision shall

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in such cases as may be prescribed and subject to the prescribed conditions, apply where the period allowed for the sealing of the patent has expired before the commencement of this Act.

Date of patent.

13. Except as otherwise expressly provided by this Act, a patent shall be dated and sealed as of the date of the application: Provided that no proceedings shall be taken in respect of an infringement committed before the publication of the complete specification.

Effect, extent, and form of patent.

14.—(1) A patent sealed with the seal of the Patent Office shall have the same effect as if it were sealed with the Great Seal of the United Kingdom, and shall have effect throughout the United Kingdom and the Isle of Man:

Provided that a patentee may assign his patent for any place in or part of the United Kingdom, or Isle of Man, as effectually as if the patent were originally granted to extend to that place or part only.

(2) Every patent may be in the prescribed form and shall be granted for one invention only, but the specification may contain more than one claim; and it shall not be competent for any person in an action or other proceeding to take any objection to a patent on the ground that it has been granted for more than one invention.

Fraudulent applications for patents.

15.—(1) A patent granted to the true and first inventor shall not be invalidated by an application in fraud of him, or by provisional protection obtained thereon, or by any use or publication of the invention subsequent to that fraudulent application during the period of provisional protection.

(2) Where a patent has been revoked on the ground of fraud, the comptroller may, on the application of the true inventor made in accordance with the provisions of this Act, grant to him a patent in lieu of and bearing the same date as the patent so revoked:

Provided that no action shall be brought for any infringement of the patent so granted committed before the actual date when such patent was granted.

Single patent for cognate inventions.

16.—(1) Where the same applicant has put in two or more provisional specifications for inventions which are cognate or modifications one of the other, and has obtained thereby concurrent provisional protection for the same, and the comptroller is of opinion that the whole of such inventions are such as to constitute a single invention and may properly be included in one patent, he may accept one complete specification in respect of the whole of such applications and grant a single patent thereon.

(2) Such patent shall bear the date of the earliest of such applications, but in considering the validity of the same and for the purpose of the provisions of this Act with respect to oppositions to the grant of patents, the court or the comptroller, as the case may be, shall have regard to the respective dates of the provisional specifications relating to the several matters claimed therein.

Term of Patent.

Term of patent.

17.—(1) The term limited in every patent for the duration thereof shall, save as otherwise expressly provided by this Act, be fourteen years from its date.

(2) A patent shall, notwithstanding anything therein or in this Act,

cease if the patentee fails to pay the prescribed fees within the prescribed times; provided that the comptroller, upon the application of the patentee shall, on receipt of such additional fee, not exceeding ten pounds, as may be prescribed, enlarge the time to such an extent as may be applied for but not exceeding three months.

(3) If any proceeding is taken in respect of an infringement of the patent committed after a failure to pay any fee within the prescribed time, and before any enlargement thereof, the court before which the proceeding is proposed to be taken may, if it thinks fit, refuse to award any damages in respect of such infringement.

Extension of term of patent.

18.—(1) A patentee may, after advertising in manner provided by rules of the Supreme Court his intention to do so, present a petition to the court praying that his patent may be extended for a further term, but such petition must be presented at least six months before the time limited for the expiration of the patent.

(2) Any person may give notice to the court of objection to the extension.

(3) On the hearing of any petition under this section the patentee and any person who has given such notice of objection shall be made parties to the proceeding, and the comptroller shall be entitled to appear and be heard, and shall appear if so directed by the court.

(4) The court, in considering its decision, shall have regard to the nature and merits of the invention in relation to the public, to the profits made by the patentee as such, and to all the circumstances of the case.

(5) If it appears to the court that the patentee has been inadequately remunerated by his patent, the court may by order extend the term of the patent for a further term not exceeding seven, or, in exceptional cases, fourteen years, or may order the grant of a new patent for such term as may be specified in the order and containing any restriction, conditions, and provisions the court may think fit.

Patents of addition.

19.—(1) Where a patent for an invention has been applied for or granted, and the applicant or the patentee, as the case may be, applies for a further patent in respect of any improvement in or modification of the invention, he may, if he thinks fit, in his application for the further patent, request that the term limited in that patent for the duration thereof be the same as that of the original patent or so much of that term as is unexpired.

(2) Where an application containing such a request is made, a patent (herein-after referred to as a patent of addition) may be granted for such term as aforesaid.

(3) A patent of addition shall remain in force so long as the patent for the original invention remains in force, but no longer, and in respect of a patent of addition no fees shall be payable for renewal.

(4) The grant of a patent of addition shall be conclusive evidence that the invention is a proper subject for a patent of addition, and the validity of the patent shall not be questioned on the ground that the invention ought to have been the subject of an independent patent.

Restoration of lapsed Patents.

Restoration of lapsed patents.

20.—(1) Where any patent has become void owing to the failure of the patentee to pay any prescribed fee within the prescribed time, the patentee

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may apply to the comptroller in the prescribed manner for an order for the restoration of the patent.

(2) Every such application shall contain a statement of the circumstances which have led to the omission of the payment of the prescribed fee.

(3) If it appears from such statement that the omission was unintentional, and that no undue delay has occurred in the making of the application, the comptroller shall advertise the application in the prescribed manner, and within such time as may be prescribed any person may give notice of opposition at the Patent Office.

(4) Where such notice is given the comptroller shall notify the applicant thereof.

(5) After the expiration of the prescribed period the comptroller shall hear the case, and, subject to an appeal to the court, issue an order either restoring the patent or dismissing the application: Provided that in every order under this section restoring a patent such provisions as may be prescribed shall be inserted for the protection of persons who may have availed themselves of the subject-matter of the patent after the patent had been announced as void in the illustrated official journal.

Amendment of Specification.

Amendment of specification by comptroller.

21.—(1) An applicant or a patentee may at any time, by request in writing left at the Patent Office, seek leave to amend his specification, including drawings forming part thereof, by way of disclaimer, correction, or explanation, stating the nature of, and the reasons for, the proposed amendment.

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

(3) Where such a notice is given the comptroller shall give notice of the opposition to the person making the request, and shall hear and decide the case.

(4) Where no notice of opposition is given, or the person so giving notice of opposition does not appear, the comptroller shall determine whether and subject to what conditions, if any, the amendment ought to be allowed.

(5) The decision of the comptroller in either case shall be subject to an appeal to the law officer, who shall, if required, hear the person making the request to amend and, where notice of opposition has been given, the person giving that notice, if he is, in the opinion of the law officer, entitled to be heard in opposition to the request, and, where there is no opposition, the comptroller, and may make an order determining whether and subject to what conditions (if any) the amendment ought to be allowed.

(6) No amendment shall be allowed that would make the specification, as amended, claim an invention substantially larger than or substantially different from the invention claimed by the specification as it stood before amendment.

(7) Leave to amend shall be conclusive as to the right of the party to

make the amendment allowed, except in case of fraud; and the amendment shall be advertised in the prescribed manner, and shall in all courts and for all purposes be deemed to form part of the specification.

(8) This section shall not apply when and so long as any action for infringement or proceeding before the court for the revocation of a patent is pending.

Amendment of specification by the court.

22. In any action for infringement of a patent or proceedings before a court for the revocation of a patent the court may by order allow the patentee to amend his specification by way of disclaimer in such manner, and subject to such terms as to costs advertisement or otherwise, as the court may think fit:

Provided that no amendment shall be so allowed that would make the specification, as amended, claim an invention substantially larger than, or substantially different from, the invention claimed by the specification as it stood before the amendment, and where an application for such an order is made to the court notice of the application shall be given to the comptroller, and the comptroller shall have the right to appear and be heard, and shall appear if so directed by the court.

Restriction on recovery of damages.

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

Compulsory Licences and Revocation.

Compulsory licences and revocation.

24.—(1) Any person interested may present a petition to the Board of Trade alleging that the reasonable requirements of the public with respect to a patented invention have not been satisfied, and praying for the grant of a compulsory licence, or, in the alternative, for the revocation of the patent.

(2) The Board of Trade shall consider the petition, and if the parties do not come to an arrangement between themselves the Board of Trade, if satisfied that a primâ facie case has been made out, shall refer the petition to the court, and, if the Board are not so satisfied, they may dismiss the petition.

(3) Where any such petition is referred by the Board of Trade to the court, and it is proved to the satisfaction of the court that the reasonable requirements of the public with reference to the patented invention have not been satisfied, the patentee may be ordered by the court to grant licences on such terms as the court may think just, or, if the court is of opinion that the reasonable requirements of the public will not be satisfied by the grant of licences, the patent may be revoked by order of the court:

Provided that an order of revocation shall not be made before the expiration of three years from the date of the patent, or if the patentee gives satisfactory reasons for his default.

(4) On the hearing of any petition under this section the patentee and any person claiming an interest in the patent as exclusive licensee or otherwise,

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shall be made parties to the proceeding, and the law officer or such other counsel as he may appoint shall be entitled to appear and be heard.

(5) For the purposes of this section the reasonable requirements of the public shall not be deemed to have been satisfied—

(*a*) if by reason of the default of the patentee to manufacture to an adequate extent and supply on reasonable terms the patented article, or any parts thereof which are necessary for its efficient working, or to carry on the patented process to an adequate extent or to grant licences on reasonable terms, any existing trade or industry, or the establishment of any new trade or industry in the United Kingdom is unfairly prejudiced, or the demand for the patented article or the article produced by the patented process is not reasonably met; or

(*b*) if any trade or industry in the United Kingdom is unfairly prejudiced by the conditions attached by the patentee before or after the passing of this Act to the purchase, hire, or use of the patented article or to the using or working of the patented process.

(6) An order of the court directing the grant of any licence under this section shall, without prejudice to any other method of enforcement, operate as if it were embodied in a deed granting a licence and made between the parties to the proceeding.

Revocation of patent.

25.—(1) Revocation of a patent may be obtained on petition to the court.

(2) Every ground on which—

(*a*) a patent might, immediately before the first day of January, one thousand eight hundred and eighty-four, have been repealed by scire facias; or

(*b*) a patent may be revoked under this Act either by the comptroller or as an alternative to the grant of a compulsory licence;

shall be available by way of defence to an action of infringement and shall also be a ground of revocation under this section.

(3) A petition for revocation of a patent may be presented—

(*a*) by the Attorney-General or any person authorised by him; or

(*b*) by any person alleging—

(i) that the patent was obtained in fraud of his rights, or of the rights of any person under or through whom he claims; or

(ii) that he, or any person under or through whom he claims, was the true inventor of any invention included in the claim of the patentee; or

(iii) that he, or any person under or through whom he claims an interest in any trade, business, or manufacture, had publicly manufactured, used, or sold, within this realm, before the date of the patent, anything claimed by the patentee as his invention.

Power of comptroller to revoke patents on

26.—(1) Any person who would have been entitled to oppose the grant of a patent, or is the successor in interest of a person who was so entitled, may, within two years from the date of the patent, in the prescribed manner apply to the comptroller for an order revoking the patent

on any one or more of the grounds on which the grant of the patent might have been opposed:

certain grounds.

Provided that when an action for infringement or proceedings for the revocation of the patent are pending in any court, an application under this section shall not be made except with the leave of the court.

(2) The comptroller shall give notice of the application to the patentee, and after hearing the parties, if desirous of being heard, may make an order revoking the patent or requiring the specification relating thereto to be amended by disclaimer, correction, or explanation, or dismissing the application; but the comptroller shall not make an order revoking the patent unless the circumstances are such as would have justified him in refusing to grant the patent had the proceedings been proceedings in an opposition to the grant of a patent.

(3) A patentee may at any time by giving notice in the prescribed manner to the comptroller offer to surrender his patent, and the comptroller may, if after giving notice of the offer and hearing all parties who desire to be heard he thinks fit, accept the offer, and thereupon make an order for the revocation of the patent.

(4) Any decision of the comptroller under this section shall be subject to appeal to the court.

Revocation of patents worked outside the United Kingdom.

27.—(1) At any time not less than four years after the date of a patent and not less than one year after the passing of this Act, any person may apply to the comptroller for the revocation of the patent on the ground that the patented article or process is manufactured or carried on exclusively or mainly outside the United Kingdom.

(2) The comptroller shall consider the application, and, if after enquiry he is satisfied that the allegations contained therein are correct, then, subject to the provisions of this section, and unless the patentee proves that the patented article or process is manufactured or carried on to an adequate extent in the United Kingdom, or gives satisfactory reasons why the article or process is not so manufactured or carried on, the comptroller may make an order revoking the patent either—

(*a*) forthwith; or

(*b*) after such reasonable interval as may be specified in the order, unless in the meantime it is shown to his satisfaction that the patented article or process is manufactured or carried on within the United Kingdom to an adequate extent:

Provided that no such order shall be made which is at variance with any treaty, convention, arrangement, or engagement with any foreign country or British possession.

(3) If within the time limited in the order the patented article or process is not manufactured or carried on within the United Kingdom to an adequate extent, but the patentee gives satisfactory reasons why it is not so manufactured or carried on, the comptroller may extend the period mentioned in the previous order for such period not exceeding twelve months as may be specified in the subsequent order.

(4) Any decision of the comptroller under this section shall be subject to appeal to the court, and on any such appeal the law officer or such other counsel as he may appoint shall be entitled to appear and be heard.

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Register of Patents.

Register of patents.

28.—(1) There shall be kept at the Patent Office a book called the register of patents, wherein shall be entered the names and addresses of grantees of patents, notifications of assignments and of transmissions of patents, of licences under patents, and of amendments, extensions, and revocations of patents, and such other matters affecting the validity or proprietorship of patents as may be prescribed.

(2) The register of patents existing at the commencement of this Act shall be incorporated with and form part of the register of patents under this Act.

(3) The register of patents shall be primâ facie evidence of any matters by this Act directed or authorised to be inserted therein.

(4) Copies of deeds, licences, and any other documents affecting the proprietorship in any letters patent or in any licence thereunder, must be supplied to the comptroller in the prescribed manner for filing in the Patent Office.

Crown.

Patent to bind Crown.

29. A patent shall have to all intents the like effect as against His Majesty the King as it has against a subject:

Provided that any Government department may, by themselves, their agents, contractors, or others, at any time after the application, use the invention for the services of the Crown on such terms as may, either before or after the use thereof, be agreed on, with the approval of the Treasury, between the department and the patentee, or, in default of agreement, as may be settled by the Treasury after hearing all parties interested.

Assignment to Secretary for War or the Admiralty of certain inventions.

30.—(1) The inventor of any improvement in instruments or munitions of war may (either for or without valuable consideration) assign to the Secretary of State for War or the Admiralty on behalf of His Majesty all the benefit of the invention and of any patent obtained or to be obtained for the invention; and the Secretary of State or the Admiralty may be a party to the assignment.

(2) The assignment shall effectually vest the benefit of the invention and patent in the Secretary of State or the Admiralty on behalf of His Majesty, and all covenants and agreements therein contained for keeping the invention secret and otherwise shall be valid and effectual (notwithstanding any want of valuable consideration), and may be enforced accordingly by the Secretary of State or the Admiralty.

(3) Where any such assignment has been made, the Secretary of State or the Admiralty may at any time before the publication of the complete specification certify to the comptroller that, in the interest of the public service, the particulars of the invention and of the manner in which it is to be performed should be kept secret.

(4) If the Secretary of State or the Admiralty so certify the application and specifications, with the drawings (if any), and any amendment of the complete specification, and any copies of such documents and drawings shall, instead of being left in the ordinary manner at the Patent Office, be delivered to the comptroller in a packet sealed by authority of the Secretary of State or the Admiralty.

(5) The packet shall, until the expiration of the term during which a patent for the invention may be in force, be kept sealed by the comptroller, and shall not be opened save under the authority of an order of the Secretary of State or the Admiralty or of the law officer.

(6) The sealed packet shall be delivered at any time during the continuance of the patent to any person authorised by the Secretary of State or the Admiralty to receive it, and shall if returned to the comptroller be again kept sealed by him.

(7) On the expiration of the term of the patent, the sealed packet shall be delivered to the Secretary of State or the Admiralty.

(8) Where the Secretary of State or the Admiralty certify as aforesaid, after an application for a patent has been left at the Patent Office, but before the publication of the complete specification, the application and specifications, with the drawings (if any), shall be forthwith placed in a packet sealed by authority of the comptroller, and the packet shall be subject to the foregoing provisions respecting a packet sealed by authority of the Secretary of State or the Admiralty.

(9) No proceeding by petition or otherwise shall lie for revocation of a patent granted for an invention in relation to which a certificate has been given by the Secretary of State or the Admiralty as aforesaid.

(10) No copy of any specification or other document or drawing, by this section required to be placed in a sealed packet, shall in any manner whatever be published or open to the inspection of the public, but, save as in this section otherwise directed, the provisions of this Act shall apply in respect of any such invention and patent as aforesaid.

(11) The Secretary of State or the Admiralty may at any time waive the benefit of this section with respect to any particular invention, and the specifications, documents, and drawings shall be thenceforth kept and dealt with in the ordinary way.

(12) The communication of any invention for any improvement in instruments or munitions of war to the Secretary of State or the Admiralty, or to any person or persons authorised by the Secretary of State or the Admiralty to investigate the same or the merits thereof, shall not, nor shall anything done for the purposes of the investigation, be deemed use or publication of such invention so as to prejudice the grant or validity of any patent for the same.

(13) Rules may be made under this Act, after consultation with the Secretary of State and the Admiralty, for the purpose of ensuring secrecy with respect to patents to which this section applies, and those rules may modify any of the provisions of this Act in their application to such patents as aforesaid so far as may appear necessary for the purpose aforesaid.

Legal Proceedings.

Hearing with assessor.

31.—(1) In an action or proceeding for infringement or revocation of a patent, the court may, if it thinks fit, and shall on the request of either of the parties to the proceeding, call in the aid of an assessor specially qualified, and try the case wholly or partially with his assistance; the action shall be tried without a jury unless the court otherwise directs.

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(2) The Court of Appeal may, if they think fit, in any proceeding before them call in the aid of an assessor as aforesaid.

(3) The remuneration, if any, to be paid to an assessor under this section shall be determined by the court or the Court of Appeal, as the case may be, and be paid as part of the expenses of the execution of this Act.

Power to counterclaim for revocation in an action for infringement.

32. A defendant in an action for infringement of a patent, if entitled to present a petition to the court for the revocation of the patent, may, without presenting such a petition, apply in accordance with the rules of the Supreme Court by way of counterclaim in the action for the revocation of the patent.

Exemption of innocent infringer from liability for damages.

33. A patentee shall not be entitled to recover any damages in respect of an infringement of a patent granted after the commencement of this Act from any defendant who proves that at the date of the infringement he was not aware, nor had reasonable means of making himself aware, of the existence of the patent, and the marking of an article with the word "patent," "patented," or any word or words expressing or implying that a patent has been obtained for the article, stamped, engraved, impressed on, or otherwise applied to the article, shall not be deemed to constitute notice of the existence of the patent unless the word or words are accompanied by the year and number of the patent:

Provided that nothing in this section shall affect any proceedings for an injunction.

Order for inspection, etc., in action.

34. In an action for infringement of a patent, the court may on the application of either party make such order for an injunction inspection or account, and impose such terms and give such directions respecting the same and the proceedings thereon as the court may see fit.

Certificate of validity questioned and costs thereon.

35. In an action for infringement of a patent, the court may certify that the validity of the patent came in question; and, if the court so certifies, then in any subsequent action for infringement the plaintiff in that action on obtaining a final order or judgment in his favour shall, unless the court trying the action otherwise directs, have his full costs, charges, and expenses as between solicitor and client.

Remedy in case of groundless threats of legal proceedings.

36. Where any person claiming to be the patentee of an invention, by circulars, advertisements, or otherwise, threatens any other person with any legal proceedings or liability in respect of any alleged infringement of the patent, any person aggrieved thereby may bring an action against him, and may obtain an injunction against the continuance of such threats, and may recover such damage (if any) as he has sustained thereby, if the alleged infringement to which the threats related was not in fact an infringement of any legal rights of the person making such threats:

Provided that this section shall not apply if the person making such threats with due diligence commences and prosecutes an action for infringement of his patent.

Miscellaneous.

Grant of patents to two or more persons.

37. Where, after the commencement of this Act, a patent is granted to two or more persons jointly, they shall, unless otherwise specified in the patent, be treated for the purpose of the devolution of the legal interests therein as joint tenants, but, subject to any contract to the contrary, each

of such persons shall be entitled to use the invention for his own profit without accounting to the others, but shall not be entitled to grant a licence without their consent, and, if any such person dies, his beneficial interest in the patent shall devolve on his personal representatives as part of his personal estate.

Avoidance of certain conditions attached to the sale, etc. of patented articles.

38.—(1) It shall not be lawful in any contract made after the passing of this Act in relation to the sale or lease of, or licence to use or work, any article or process protected by a patent to insert a condition the effect of which will be—

(*a*) to prohibit or restrict the purchaser, lessee, or licensee from using any article or class of articles, whether patented or not, or any patented process, supplied or owned by any person other than the seller, lessor, or licensor or his nominees; or

(*b*) to require the purchaser, lessee, or licensee to acquire from the seller, lessor, or licensor, or his nominees, any article or class of articles not protected by the patent;

and any such condition shall be null and void, as being in restraint of trade and contrary to public policy:

Provided that this subsection shall not apply if—

(i) the seller, lessor, or licensor proves that at the time the contract was entered into the purchaser, lessee, or licensee had the option of purchasing the article or obtaining a lease or licence on reasonable terms, without such conditions as aforesaid; and

(ii) the contract entitles the purchaser, lessee, or licensee to relieve himself of his liability to observe any such condition on giving the other party three months notice in writing and on payment in compensation for such relief in the case of a purchase of such sum, or in the case of a lease or licence of such rent or royalty for the residue of the term of the contract, as may be fixed by an arbitrator appointed by the Board of Trade.

(2) Any contract relating to the lease of or licence to use or work any patented article or patented process, whether made before or after the passing of this Act, may at any time after the patent or all the patents by which the article or process was protected at the time of the making of the contract has or have ceased to be in force, and notwithstanding anything in the same or in any other contract to the contrary, be determined by either party on giving three months notice in writing to the other party; but where any such notice is given determining any contract made before the passing of this Act, the party giving the notice shall be liable to pay such compensation as failing agreement may be awarded by an arbitrator appointed by the Board of Trade.

(3) Any contract made before the passing of this Act relating to the lease of or licence to use or work any patented article or process and containing any condition which, had the contract been made after the passing of this Act, would by virtue of this section have been null and void may, at any time before the contract is determinable under the last preceding subsection, and notwithstanding anything in the same or any other contract to the contrary, be determined by either party on giving three months notice in writing to the other party, but where any such notice is given the

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party giving the notice shall be liable to pay such compensation as, failing agreement, may be awarded by an arbitrator appointed by the Board of Trade.

(4) The insertion by the patentee in a contract made after the passing of this Act of any condition which by virtue of this section is null and void shall be available as a defence to an action for infringement of the patent to which the contract relates brought while that contract is in force.

(5) *Nothing in this section shall*—

(*a*) affect any condition in a contract whereby a person is prohibited from selling any goods other than those of a particular person; or

(*b*) be construed as validating any contract which would, apart from this section, be invalid; or

(*c*) affect any right of determining a contract or condition in a contract exercisable independently of this section; or

(*d*) affect any condition in a contract for the lease of or licence to use a patented article, whereby the lessor or licensor reserves to himself or his nominees the right to supply such new parts of the patented article as may be required to put or keep it in repair.

Costs and security for costs.

39.—(1) The comptroller shall, in proceedings relating to an opposition to the grant of a patent or to an application for the amendment of a specification or the revocation of a patent, have power by order to award to any party such costs as he may consider reasonable, and to direct how and by what parties they are to be paid, and any such order may be made a rule of the court.

(2) If a party giving notice of opposition to the grant of a patent or to the amendment of a specification, or applying to the comptroller for the revocation of a patent, or giving notice of appeal from any decision of the comptroller, neither resides nor carries on business in the United Kingdom or the Isle of Man, the comptroller, or, in case of appeal to the law officer, the law officer, may require such party to give security for costs of the proceedings or appeal, and in default of such security being given may treat the proceedings or appeal as abandoned.

Procedure on appeal to law officer.

40. The law officer may examine witnesses on oath and administer oaths for that purpose, and may make rules regulating references and appeals to the law officer and the practice and procedure before him under this Part of this Act; and in any proceeding before the law officer under this Part of this Act, the law officer may order costs to be paid by either party, and any such order may be made a rule of the court.

Provisions as to anticipation.

41.—(1) An invention covered by any patent applied for on or after the first day of January one thousand nine hundred and five shall not be deemed to have been anticipated by reason only of its publication in a specification left pursuant to an application made in the United Kingdom not less than fifty years before the date of the application for the patent, or of its publication in a provisional specification of any date not followed by a complete specification.

(2) A patent shall not be held to be invalid by reason only of the invention in respect of which the patent was granted, or any part thereof,

having been published prior to the date of the patent, if the patentee proves to the satisfaction of the court that the publication was made without his knowledge and consent, and that the matter published was derived or obtained from him, and, if he learnt of the publication before the date of his application for the patent, that he applied for and obtained protection for his invention with all reasonable diligence after learning of the publication.

Disconformity.

42. A patent shall not be held to be invalid on the ground that the complete specification claims a further or different invention to that contained in the provisional, if the invention therein claimed, so far as it is not contained in the provisional, was novel at the date when the complete specification was put in, and the applicant was the first and true inventor thereof.

Patent on application of representative of deceased inventor.

43.—(1) If the person claiming to be inventor of an invention dies without making an application for a patent for the invention, application may be made by, and a patent for the invention granted to, his legal representative.

(2) Every such application must contain a declaration by the legal representative that he believes him to be the true and first inventor of the invention.

Loss or destruction of patent.

44. If a patent is lost or destroyed, or its non-production is accounted for to the satisfaction of the comptroller, the comptroller may at any time seal a duplicate thereof.

Provisions as to exhibitions.

45.—(1) The exhibition of an invention at an industrial or international exhibition, certified as such by the Board of Trade, or the publication of any description of the invention during the period of the holding of the exhibition, or the use of the invention for the purpose of the exhibition in the place where the exhibition is held, or the use of the invention during the period of the holding of the exhibition by any person elsewhere, without the privity or consent of the inventor, shall not prejudice the right of the inventor to apply for and obtain a patent in respect of the invention or the validity of any patent granted on the application, provided that—

(*a*) the exhibitor, before exhibiting the invention, gives the comptroller the prescribed notice of his intention to do so; and

(*b*) the application for a patent is made before or within six months from the date of the opening of the exhibition.

(2) His Majesty may by Order in Council apply this section to any exhibition mentioned in the Order in like manner as if it were an industrial or international exhibition certified as such by the Board of Trade, and any such Order may provide that the exhibitor shall be relieved from the condition of giving notice to the comptroller of his intention to exhibit, and shall be so relieved either absolutely or upon such terms and conditions as may be stated in the Order.

Publication of illustrated journal, indexes, etc.

46.—(1) The comptroller shall issue periodically an illustrated journal of patented inventions, as well as reports of patent cases decided by courts of law, and any other information that he may deem generally useful or important.

(2) Provision shall be made by the comptroller for keeping on sale copies of such journal, and also of all complete specifications of patents in force, with any accompanying drawings.

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(3) The comptroller shall continue, in such form as he deems expedient, the indexes and abridgments of specifications hitherto published, and shall prepare and publish such other indexes, abridgments of specifications, catalogues, and other works relating to inventions, as he thinks fit.

Patent Museum.

47.—(1) The control and management of the Patent Museum and its contents shall remain vested in the Board of Education, subject to such directions as His Majesty in Council may think fit to give.

(2) The Board of Education may at any time require a patentee to furnish them with a model of his invention on payment to the patentee of the cost of the manufacture of the model, the amount to be settled, in case of dispute, by the Board of Trade.

Foreign vessels in British waters.

48.—(1) A patent shall not prevent the use of an invention for the purposes of the navigation of a foreign vessel within the jurisdiction of any of His Majesty's Courts in the United Kingdom, or Isle of Man, or the use of an invention in a foreign vessel within that jurisdiction, provided it is not used therein for or in connexion with the manufacture or preparation of anything intended to be sold in or exported from the United Kingdom or Isle of Man.

(2) This section shall not extend to vessels of any foreign state of which the laws do not confer corresponding rights with respect to the use of inventions in British vessels while in the ports of that state, or in the waters within the jurisdiction of its courts.

Part II. of the Act, comprising sections 49 to 61 deals solely with the Subject of Designs.

PART III.

GENERAL.

Patent Office and Proceedings thereat.

Patent Office.

5 Edw. 7, c. 15.

62.—(1) The Treasury may continue to provide for the purposes of this Act and the Trade Marks Act, 1905, an office with all requisite buildings and conveniences, which shall be called, and is in this Act referred to as, the Patent Office.

(2) The Patent Office shall be under the immediate control of the comptroller, who shall act under the superintendence and direction of the Board of Trade.

(3) Any act or thing directed to be done by or to the comptroller may be done by or to any officer authorised by the Board of Trade.

(4) Rules under this Act may provide for the establishment of branch offices for designs at Manchester or elsewhere, and for any document or thing required by this Act to be sent to or done at the Patent Office being sent to or done at any branch office which may be established.

Officers and clerks.

63.—(1) There shall continue to be a comptroller-general of patents, designs, and trade marks, and the Board of Trade may, subject to the approval of the Treasury, appoint the comptroller, and so many examiners and other officers and clerks, with such designations and duties as the Board of Trade think fit, and may remove any of those officers and clerks.

(2) The salaries of those officers and clerks shall be appointed by the Board of Trade, with the concurrence of the Treasury, and those salaries and the other expenses of the execution of this Act and the Trade Marks Act, 1905, shall continue to be paid out of money provided by Parliament. A.D. 1907.

Seal of Patent Office.

64. Impressions of the seal of the Patent Office shall be judicially noticed and admitted in evidence.

Fees.

Fees.

65. There shall be paid in respect of the grant of patents and the registration of designs, and applications therefor, and in respect of other matters with relation to patents and designs under this Act, such fees as may be, with the sanction of the Treasury, prescribed by the Board of Trade, so however that the fees prescribed in respect of the instruments and matters mentioned in the First Schedule to this Act shall not exceed those specified in that Schedule.

Provisions as to Registers and other Documents in Patent Office.

Trust not to be entered in registers.

66. There shall not be entered in any register kept under this Act, or be receivable by the comptroller, any notice of any trust expressed implied or constructive.

Inspection of and extracts from registers.

67. Every register kept under this Act shall at all convenient times be open to the inspection of the public, subject to the provisions of this Act and to such regulations as may be prescribed; and certified copies, sealed with the seal of the Patent Office, of any entry in any such register shall be given to any person requiring the same on payment of the prescribed fee.

Privilege of reports of examiners.

68. Reports of examiners made under this Act shall not in any case be published or be open to public inspection, and shall not be liable to production or inspection in any legal proceeding, unless the court or officer having power to order discovery in such legal proceedings certifies that such production or inspection is desirable in the interests of justice, and ought to be allowed.

Prohibition of publication of specification, drawings, etc. where application abandoned, etc.

69.—(1) Where an application for a patent has been abandoned, or become void, the specifications and drawings (if any) accompanying or left in connexion with such application, shall not, save as otherwise expressly provided by this Act, at any time be open to public inspection or be published by the comptroller.

(2) Where an application for a design has been abandoned or refused the application and any drawings, photographs, tracings, representations, or specimens left in connexion with the application shall not at any time be open to public inspection or be published by the comptroller.

Power for comptroller to correct clerical errors.

70. The comptroller may, on request in writing accompanied by the prescribed fee,—

(*a*) correct any clerical error in or in connexion with an application for a patent or in any patent or any specification;

(*b*) cancel the registration of a design either wholly or in respect of any particular goods in connexion with which the design is registered;

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(c) correct any clerical error in the representation of a design or in the name or address of the proprietor of any patent or design, or in any other matter which is entered upon the register of patents or the register of designs.

Entry of assignments and transmissions in registers.

71.—(1) Where a person becomes entitled by assignment, transmission, or other operation of law to a patent, or to the copyright in a registered design, the comptroller shall, on request and on proof of title to his satisfaction, register him as the proprietor of a patent or design.

(2) Where any person becomes entitled as mortgagee, licensee, or otherwise to any interest in a patent or design, the comptroller shall, on request and on proof of title to his satisfaction, cause notice of the interest to be entered in the prescribed manner in the register of patents or designs, as the case may be.

(3) The person registered as the proprietor of a patent or design shall, subject to the provisions of this Act and to any rights appearing from the register to be vested in any other person, have power absolutely to assign, grant licences as to, or otherwise deal with, the patent or design and to give effectual receipts for any consideration for any such assignment, licence, or dealing: Provided that any equities in respect of the patent or design may be enforced in like manner as in respect of any other personal property.

Rectification of registers by court.

72.—(1) The court may, on the application in the prescribed manner of any person aggrieved by the non-insertion in or omission from the register of patents or designs of any entry, or by any entry made in either such register without sufficient cause, or by any entry wrongly remaining on either such register, or by an error or defect in any entry in either such register, make such order for making, expunging, or varying such entry as it may think fit.

(2) The court may in any proceeding under this section decide any question that it may be necessary or expedient to decide in connexion with the rectification of a register.

(3) The prescribed notice of any application under this section shall be given to the comptroller, who shall have the right to appear and be heard thereon, and shall appear if so directed by the court.

(4) Any order of the court rectifying a register shall direct that notice of the rectification be served on the comptroller in the prescribed manner, who shall upon the receipt of such notice rectify the register accordingly.

Powers and Duties of Comptroller.

Exercise of discretionary power by comptroller.

73. Where any discretionary power is by or under this Act given to the comptroller, he shall not exercise that power adversely to the applicant for a patent, or for amendment of a specification, or for registration of a design, without (if so required within the prescribed time by the applicant) giving the applicant an opportunity of being heard.

Power of comptroller to take directions of law officers.

74. The comptroller may, in any case of doubt or difficulty arising in the administration of any of the provisions of this Act, apply to a law officer for directions in the matter.

Refusal to

75. The comptroller may refuse to grant a patent for an invention, or

to register a design, of which the use would, in his opinion, be contrary to law or morality.

Annual reports of comptroller.

76. The comptroller shall, before the first day of June in every year, cause a report respecting the execution by or under him of this Act to be laid before both Houses of Parliament, and therein shall include for the year to which the report relates all general rules made in that year under or for the purposes of this Act, and an account of all fees, salaries, and allowances, and other money received and paid under this Act.

Evidence, &c.

Evidence before comptroller.

77.—(1) Subject to rules under this Act in any proceeding under this Act before the comptroller the evidence shall be given by statutory declaration in the absence of directions to the contrary; but in any case in which the comptroller thinks it right so to do, he may take evidence viva voce in lieu of or in addition to evidence by declaration or allow any declarant to be cross-examined on his declaration. Any such statutory declaration may in the case of appeal be used before the court in lieu of evidence by affidavit, but if so used shall have all the incidents and consequences of evidence by affidavit.

(2) In case any part of the evidence is taken viva voce, the comptroller shall, in respect of requiring the attendance of witnesses and taking evidence on oath, be in the same position in all respects as an official referee of the Supreme Court.

Certificate of comptroller to be evidence.

78. A certificate purporting to be under the hand of the comptroller as to any entry, matter, or thing which he is authorised by this Act, or any general rules made thereunder, to make or do, shall be primâ facie evidence of the entry having been made, and of the contents thereof, and of the matter or thing having been done or left undone.

Evidence of documents in Patent Office.

79. Printed or written copies or extracts, purporting to be certified by the comptroller and sealed with the seal of the Patent Office, of or from patents, specifications, and other documents in the Patent Office, and of or from registers and other books kept there, shall be admitted in evidence in all courts in His Majesty's dominions, and in all proceedings, without further proof or production of the originals.

Transmission of certified printed copies of specifications, &c.

80.—(1) Copies of all specifications, drawings, and amendments left at the Patent Office after the commencement of this Act, printed for and sealed with the seal of the Patent Office, shall be transmitted to the Edinburgh Museum of Science and Art, and to the Enrolments Office of the Chancery Division in Ireland, and to the Rolls Office in the Isle of Man, within twenty-one days after they have been accepted or allowed at the Patent Office.

(2) Certified copies of or extracts from any such documents and of any documents so transmitted in pursuance of any enactment repealed by this Act shall be given to any person on payment of the prescribed fee; and any such copy or extract shall be admitted in evidence in all courts in Scotland and Ireland and in the Isle of Man without further proof or production of the originals.

Applications

81. Any application, notice, or other document authorised or required

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to be left, made, or given at the Patent Office or to the comptroller, or to any other person under this Act, may be sent by post.

and notices by post.

82. Where the last day fixed by this Act for doing anything under this Act falls on any day specified in rules under this Act as an excluded day, the rules may provide for the thing being done on the next following day not being an excluded day.

Excluded days.

Declaration by infant, lunatic, etc.

83.—(1) If any person is, by reason of infancy, lunacy, or other disability, incapable of making any declaration or doing anything required or permitted by or under this Act, the guardian or committee (if any of the person subject to the disability, or, if there be none, any person appointed by any court possessing jurisdiction in respect of his property, may make such declaration or a declaration as nearly corresponding thereto as circumstances permit, and do such thing in the name and on behalf of the person subject to the disability.

(2) An appointment may be made by the court for the purposes of this section upon the petition of any person acting on behalf of the person subject to the disability or of any other person interested in the making of the declaration or the doing of the thing.

Register of Patent Agents.

Register of patent agents.

84.—(1) A person shall not be entitled to describe himself as a patent agent, whether by advertisement, by description on his place of business, by any document issued by him, or otherwise, unless he is registered as a patent agent in pursuance of this Act or an Act repealed by this Act.

(2) Every person who proves to the satisfaction of the Board of Trade that prior to the twenty-fourth day of December, one thousand eight hundred and eighty-eight, he had been bonâ fide practising as a patent agent shall be entitled to be registered as a patent agent in pursuance of this Act.

(3) If any person knowingly describes himself as a patent agent in contravention of this section he shall be liable on conviction under the Summary Jurisdiction Acts to a fine not exceeding twenty pounds.

(4) In this section "patent agent" means exclusively an agent for obtaining patents in the United Kingdom.

Agents for patents.

85.—(1) Rules under this Act may authorise the comptroller to refuse to recognise as agent in respect of any business under this Act any person whose name has been erased from the register of patent agents, or who is proved to the satisfaction of the Board of Trade, after being given an opportunity of being heard, to have been convicted of such an offence or to have been guilty of such misconduct as would have rendered him liable, if his name had been on the register of patent agents, to have his name erased therefrom, and may authorise the comptroller to refuse to recognise as agent in respect of any business under this Act any company which, if it had been an individual, the comptroller could refuse to recognise as such agent.

(2) Where a company or firm acts as agents, such rules as aforesaid may authorise the comptroller to refuse to recognise the company or firm as agent if any person whom the comptroller could refuse to recognise as

an agent acts as director or manager of the company or is a partner in the firm.

(3) The comptroller shall refuse to recognise as agent in respect of any business under this Act any person who neither resides nor has a place of business in the United Kingdom or the Isle of Man.

Powers, &c., of Board of Trade.

Power for Board of Trade to make general rules.

86.—(1) The Board of Trade may make such general rules and do such things as they think expedient, subject to the provisions of this Act—

(*a*) For regulating the practice of registration under this Act:

(*b*) For classifying goods for the purposes of designs:

(*c*) For making or requiring duplicates of specifications, drawings, and other documents:

(*d*) For securing and regulating the publishing and selling of copies, at such prices and in such manner as the Board of Trade think fit, of specifications, drawings, and other documents:

(*e*) For securing and regulating the making, printing, publishing, and selling of indexes to, and abridgments of, specifications and other documents in the Patent Office; and providing for the inspection of indexes and abridgments and other documents:

(*f*) For regulating (with the approval of the Treasury) the presentation of copies of Patent Office publications to patentees and to public authorities, bodies, and institutions at home and abroad:

(*g*) For regulating the keeping of the register of patent agents under this Act:

(*h*) Generally for regulating the business of the Patent Office, and all things by this Act placed under the direction or control of the comptroller, or of the Board of Trade.

(2) General rules shall whilst in force be of the same effect as if they were contained in this Act.

(3) Any rules made in pursuance of this section shall be advertised twice in the official journal to be issued by the comptroller, and shall be laid before both Houses of Parliament as soon as practicable after they are made, and if either House of Parliament, within the next forty days after any rules have been so laid before that House, resolves that the rules or any of them ought to be annulled, the rules or those to which the resolution applies shall after the date of such resolution be of no effect, without prejudice to the validity of anything done in the meantime under the rules or to the making of any new rules.

Proceedings of the Board of Trade.

87.—(1) All things required or authorised under this Act to be done by, to, or before the Board of Trade, may be done by, to, or before the President or a secretary or an assistant secretary of the Board.

(2) All documents purporting to be orders made by the Board of Trade and to be sealed with the seal of the Board, or to be signed by a secretary or assistant secretary of the Board, or by any person authorised in that behalf by the President of the Board, shall be received in evidence, and shall be deemed to be such orders without further proof, unless the contrary is shown.

(3) A certificate, signed by the President of the Board of Trade, that

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any order made or act done is the order or act of the Board, shall be conclusive evidence of the fact so certified.

Provision as to Order in Council.

88. An Order in Council under this Act shall, from a date to be mentioned for the purpose in the Order, take effect as if it had been contained in this Act; but may be revoked or varied by a subsequent Order.

Offences.

Offences.

89.—(1) If any person makes or causes to be made a false entry in any register kept under this Act, or a writing falsely purporting to be a copy of an entry in any such register, or produces or tenders or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false, he shall be guilty of a misdemeanor.

(2) If any person falsely represents that any article sold by him is a patented article, or falsely describes any design applied to any article sold by him as registered, he shall be liable for every offence, on conviction under the Summary Jurisdiction Acts, to a fine not exceeding five pounds.

(3) If any person sells an article having stamped, engraved, or impressed thereon or otherwise applied thereto the word "patent," "patented," "registered," or any other word expressing or implying that the article is patented or that the design applied thereto is registered, he shall be deemed for the purposes of this section to represent that the article is a patented article or that the design applied thereto is a registered design.

(4) Any person who, after the copyright in a design has expired, puts or causes to be put on any article to which the design has been applied the word "registered," or any word or words implying that there is a subsisting copyright in the design, shall be liable on conviction under the Summary Jurisdiction Acts to a fine not exceeding five pounds.

(5) If any person uses on his place of business, or on any document issued by him, or otherwise, the words "Patent Office," or any other words suggesting that his place of business is officially connected with, or is, the Patent Office, he shall be liable on conviction under the Summary Jurisdiction Acts to a fine not exceeding twenty pounds.

Unauthorised assumption of Royal Arms.

90.—(1) The grant of a patent under this Act shall not be deemed to authorise the patentee to use the Royal Arms or to place the Royal Arms on any patented article.

(2) If any person, without the authority of His Majesty, uses in connexion with any business, trade, calling, or profession the Royal Arms (or arms so nearly resembling them as to be calculated to deceive) in such manner as to be calculated to lead to the belief that he is duly authorised to use the Royal Arms, he shall be liable on conviction under the Summary Jurisdiction Acts to a fine not exceeding twenty pounds:

Provided that nothing in this section shall be construed as affecting the right, if any, of the proprietor of a trade mark containing such arms to continue to use such trade mark.

International and Colonial Arrangements.

International and Colonial

91.—(1) If His Majesty is pleased to make any arrangement with the government of any foreign state for mutual protection of inventions, or

designs, or trade marks, then any person who has applied for protection for any invention, design, or trade mark in that state shall be entitled to a patent for his invention or to registration of his design or trade mark under this Act or the Trade Marks Act, 1905, in priority to other applicants; and the patent or registration shall have the same date as the date of the application in the foreign state. arrangements.

Provided that—

(*a*) The application is made, in the case of a patent within twelve months, and in the case of a design or trade mark within four months, from the application for protection in the foreign state; and

(*b*) Nothing in this section shall entitle the patentee or proprietor of the design or trade mark to recover damages for infringements happening prior to the actual date on which his complete specification is accepted, or his design or trade mark is registered, in this country.

(2) The patent granted for the invention or the registration of a design or trade mark shall not be invalidated—

(*a*) in the case of a patent, by reason only of the publication of a description of, or use of, the invention; or

(*b*) in the case of a design, by reason only of the exhibition or use of, or the publication of a description or representation of, the design; or

(*c*) in the case of a trade mark, by reason only of the use of the trade mark.

in the United Kingdom or the Isle of Man during the period specified in this section as that within which the application may be made.

(3) The application for the grant of a patent, or the registration of a design, or the registration of a trade mark under this section, must be made in the same manner as an ordinary application under this Act or the Trade Marks Act, 1905: Provided that—

(*a*) In the case of patents the application shall be accompanied by a complete specification, which, if it is not accepted within the twelve months from the application for protection in the foreign state, shall with the drawings (if any) be open to public inspection at the expiration of that period; and

(*b*) In the case of trade marks, any trade mark the registration of which has been duly applied for in the country of origin may be registered under the Trade Marks Act, 1905.

(4) The provisions of this section shall apply only in the case of those foreign states with respect to which His Majesty by Order in Council declares them to be applicable, and so long only in the case of each state as the Order in Council continues in force with respect to that state.

(5) Where it is made to appear to His Majesty that the legislature of any British possession has made satisfactory provision for the protection of inventions, designs, and trade marks, patented or registered in this country, it shall be lawful for His Majesty, by Order in Council, to apply the provisions of this section to that possession, with such variations or additions, if any, as may be stated in the Order.

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Definitions.

Provisions as to "the court."

92.—(1) In this Act, unless the context otherwise requires, "the court" means, subject to the provisions as to Scotland, Ireland, and the Isle of Man, the High Court in England.

(2) Where by virtue of this Act a decision of the comptroller is subject to an appeal to the court, or a petition may be referred or presented to the court, the appeal shall, subject to and in accordance with rules of the Supreme Court, be made and the petition referred or presented to such judge of the High Court as the Lord Chancellor may select for the purpose, and the decision of that judge shall be final, except in the case of an appeal from a decision of the comptroller revoking a patent on any ground on which the grant of such patent might have been opposed.

Definitions.

93. In this Act, unless the context otherwise requires,—

"Law officer" means the Attorney-General or Solicitor-General for England:

"Prescribed" means prescribed by general rules under this Act:

"British possession" does not include the Isle of Man or the Channel Islands:

"Patent" means letters patent for an invention:

"Patentee" means the person for the time being entitled to the benefit of a patent:

"Invention" means any manner of new manufacture the subject of letters patent and grant of privilege within section six of the Statute of Monopolies (that is, the Act of the twenty-first year of the reign of King James the First, chapter three, intituled "An Act concerning monopolies and dispensations with penal "laws and the forfeiture thereof"), and includes an alleged invention:

"Inventor" and "applicant" shall, subject to the provisions of this Act, include the legal representative of a deceased inventor or applicant:

54 Geo. 3, c. 56.

"Design" means any design (not being a design for a sculpture or other thing within the protection of the Sculpture Copyright Act, 1814) applicable to any article, whether the design is applicable for the pattern, or for the shape or configuration, or for the ornament thereof, or for any two or more of such purposes, and by whatever means it is applicable, whether by printing, painting, embroidering, weaving, sewing, modelling, casting, embossing, engraving, staining, or any other means whatever, manual, mechanical, or chemical, separate or combined:

"Article" means (as respects designs) any article of manufacture and any substance artificial or natural, or partly artificial and partly natural:

"Copyright" means the exclusive right to apply a design to any article in any class in which the design is registered:

"Proprietor of a new and original design,"—

(*a*) Where the author of the design, for good consideration,

executes the work for some other person, means the person for whom the design is so executed; and

(*b*) Where any person acquires the design or the right to apply the design to any article, either exclusively of any other person or otherwise, means, in the respect and to the extent in and to which the design or right has been so acquired, the person by whom the design or right is so acquired; and

(*c*) In any other case, means the author of the design;

and where the property in, or the right to apply, the design has devolved from the original proprietor upon any other person, includes that other person.

Application to Scotland, Ireland, and the Isle of Man.

Application to Scotland.

94. In the application of this Act to Scotland—

(1) In any action for infringement of a patent in Scotland the provisions of this Act with respect to calling in the aid of an assessor shall apply, and the action shall be tried without a jury, unless the court otherwise direct, but otherwise nothing shall affect the jurisdiction and forms of process of the courts in Scotland in such an action or in any action or proceeding respecting a patent hitherto competent to those courts; and for the purposes of the provisions so applied "court of appeal" shall mean any court to which such action is appealed:

(2) Any offence under this Act declared to be punishable on conviction under the Summary Jurisdiction Acts may be prosecuted in the sheriff court:

(3) Proceedings for revocation of a patent shall be in the form of an action of reduction at the instance of the Lord Advocate, or at the instance of a party having interest with his concurrence, which concurrence may be given on just cause shown only, and service of all writs and summonses in that action shall be made according to the forms and practice existing at the commencement of this Act:

(4) The provisions of this Act conferring a special jurisdiction on the court as defined by this Act shall not, except so far as the jurisdiction extends, affect the jurisdiction of any court in Scotland in any proceedings relating to patents or to designs; and with reference to any such proceedings, the term "the Court" shall mean any Lord Ordinary of the Court of Session, and the term "Court of Appeal" shall mean either Division of that Court:

(5) Notwithstanding anything in this Act, the expression "the court" shall, as respects petitions for compulsory licences or revocation which are referred by the Board of Trade to the Court in Scotland, mean any Lord Ordinary of the Court of Session, and shall in reference to proceedings in Scotland for the extension of the term of a patent mean such Lord Ordinary:

(6) The expression "Rules of the Supreme Court" shall, except in section ninety-two of this Act, mean act of sederunt:

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(7) If any rectification of a register under this Act is required in pursuance of any proceeding in a court, a copy of the order, decree, or other authority for the rectification, shall be served on the comptroller, and he shall rectify the register accordingly:

(8) The expression "injunction" means "interdict."

Application to Ireland.

95. In the application of this Act to Ireland—

(1) All parties shall, notwithstanding anything in this Act, have in Ireland their remedies under or in respect of a patent as if the same had been granted to extend to Ireland only:

(2) The provisions of this Act conferring a special jurisdiction on the court, as defined by this Act, shall not, except so far as the jurisdiction extends, affect the jurisdiction of any court in Ireland in any proceedings relating to patents or to designs; and with reference to any such proceedings the term "the Court" means the High Court in Ireland:

(3) If any rectification of a register under this Act is required in pursuance of any proceeding in a court, a copy of the order, decree, or other authority for the rectification shall be served on the comptroller, and he shall rectify the register accordingly.

Isle of Man.

96. This Act shall extend to the Isle of Man, subject to the following modifications:—

(1) Nothing in this Act shall affect the jurisdiction of the courts in the Isle of Man in proceedings for infringement, or in any action or proceeding respecting a patent or design competent to those courts:

(2) The punishment for a misdemeanour under this Act in the Isle of Man shall be imprisonment for any term not exceeding two years, with or without hard labour, and with or without a fine not exceeding one hundred pounds, at the discretion of the court:

(3) Any offence under this Act committed in the Isle of Man which would in England be punishable on summary conviction may be prosecuted, and any fine in respect thereof recovered, at the instance of any person aggrieved, in the manner in which offences punishable on summary conviction may for the time being be prosecuted.

Repeal, Savings, and Short Title.

Saving for prerogative.

97. Nothing in this Act shall take away, abridge, or prejudicially affect the prerogative of the Crown in relation to the granting of any letters patent or to the withholding of a grant thereof.

Repeal and savings.

98.—(1) The enactments mentioned in the Second Schedule to this Act are hereby repealed to the extent specified in the third column of that schedule—

(*a*) As respects the enactments mentioned in Part I. of that schedule, as from the commencement of this Act;

(*b*) As respects the enactments mentioned in Part II. of that schedule, as from the date when rules of the Supreme Court regulating the matters dealt with in those enactments come into operation;

(*c*) As respects the enactments mentioned in Part III. of that schedule,

as from the date when rules under this Act regulating the matters dealt with in those enactments come into operation;

and the enactments mentioned in Part II. and Part III. of that schedule shall, until so repealed, have effect as if they formed part of this Act:

Provided that this repeal shall not affect any convention, Order in Council, rule, or table of fees having effect under any enactment so repealed, but any such convention, Order in Council, rule, or table of fees in force at the commencement of this Act shall continue in force, and may be repealed, altered or amended, as if it had been made under this Act.

(2) Except where otherwise expressly provided, this Act shall extend to all patents granted and all designs registered before the commencement of this Act, and to applications then pending, in substitution for such enactments as would have applied thereto if this Act had not been passed.

Short title and commencement.

99. This Act may be cited as the Patents and Designs Act, 1907, and shall, save as otherwise expressly provided, come into operation on the first day of January one thousand nine hundred and eight.

SCHEDULES.

Section 65.

FIRST SCHEDULE.

FEES ON INSTRUMENTS FOR OBTAINING PATENTS AND RENEWAL.

(a) Up to sealing.

	£	s.	d.	£	s.	d.
On application for provisional protection	1	0	0			
On filing complete specification	3	0	0			
				4	0	0
or						
On filing complete specification with first application				4	0	0
On the sealing of the patent in respect of investigations as to anticipation				1	0	0

(b) Further before end of four years from date of patent.

On certificate of renewal				50	0	0

(c) Further before end of eight years from date of patent.

On certificate of renewal				100	0	0

Or in lieu of the fees of £50 and £100 the following annual fees:

Before the expiration of the fourth year from the date of the patent				10	0	0
,, ,, ,,	fifth	,,	,, ,,	10	0	0
,, ,, ,,	sixth	,,	,, ,,	10	0	0
,, ,, ,,	seventh	,,	,, ,,	10	0	0
,, ,, ,,	eighth	,,	,, ,,	15	0	0
,, ,, ,,	ninth	,,	,, ,,	15	0	0
,, ,, ,,	tenth	,,	,, ,,	20	0	0
,, ,, ,,	eleventh	,,	,, ,,	20	0	0
,, ,, ,,	twelfth	,,	,, ,,	20	0	0
,, ,, ,,	thirteenth	,,	,, ,,	20	0	0

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Section 98.

SECOND SCHEDULE.

ENACTMENTS REPEALED.

PART I.

Session and Chapter.	Short Title.	Extent of Repeal.
46 & 47 Vict. c. 57.	The Patents, Designs, and Trade Marks Act, 1883.	The whole Act, except subsections (5), (6), and (7) of section twenty-six, section twenty-nine, subsections (2) and (3) of section forty-seven, and section forty-eight.
48 & 49 Vict. c. 63.	The Patents, Designs, and Trade Marks (Amendment) Act, 1885.	The whole Act.
49 & 50 Vict. c. 37.	The Patents Act, 1886 ..	The whole Act.
51 & 52 Vict. c. 50.	The Patents, Designs, and Trade Marks Act, 1888.	The whole Act.
1 Edw. 7. c. 18.	The Patents Act, 1901 ..	The whole Act.
2 Edw. 7. c. 34.	The Patents Act, 1902 ..	The whole Act.
7 Edw. 7. c. 28.	The Patents and Designs (Amendment) Act, 1907.	The whole Act.

PART II.

Session and Chapter.	Short Title.	Extent of Repeal.
46 & 47 Vict. c. 57.	The Patents, Designs, and Trade Marks Act, 1883.	Subsections (5), (6), and (7) of section twenty-six, and section twenty-nine.

PART III.

Session and Chapter.	Short Title.	Extent of Repeal.
46 & 47 Vict. c. 57.	The Patents, Designs, and Trade Marks Act, 1883.	Subsections (2) and (3) of section forty-seven and section forty-eight.

FORM A.

FORM OF PATENT.

EDWARD VII, by the Grace of God, of the United Kingdom of Great Britain and Ireland and of the British Dominions beyond the Seas King, Defender of the Faith, Emperor of India: To all to whom these presents shall come greeting:

WHEREAS

hath declared that he is in possession of an invention for

that he claims to be the true and first inventor thereof, and that the same is not in use by any other person to the best of his knowledge and belief:

And whereas the said inventor hath humbly prayed that a patent might be granted unto him for the sole use and advantage of his said invention:

And whereas the said inventor (herein-after together with his executors, administrators, and assigns, or any of them, referred to as the said patentee) hath by and in his complete specification particularly described the nature of his invention:

And whereas We, being willing to encourage all inventions which may be for the public good, are graciously pleased to condescend to his request:

Know ye, therefore, that We of our especial grace, certain knowledge, and mere motion do by these presents, for us, our heirs and successors, give and grant unto the said patentee our especial license, full power, sole privilege, and authority, that the said patentee by himself, his agents, or licensees, and no others, may at all times hereafter during the term of years herein mentioned, make, use, exercise, and vend the said invention within our United Kingdom of Great Britain and Ireland, and Isle of Man, in such manner as to him or them may seem meet, and that the said patentee shall have and enjoy the whole profit and advantage from time to time accruing by reason of the said invention during the term of fourteen years from the date hereunder written of these presents: And to the end that the said patentee may have and enjoy the sole use and exercise and the full benefit of the said invention, We do by these presents for us, our heirs and successors, strictly command all our subjects whatsoever within our United Kingdom of Great Britain and Ireland, and the Isle of Man, that they do not at any time during the continuance of the said term of fourteen years either directly or indirectly make use of or put in practice the said invention, or any part of the same, nor in anywise imitate the same, nor make or cause to be made any addition thereto or subtraction therefrom, whereby to pretend themselves the inventors thereof, without the consent license or agreement of the said patentee in writing under his hand and seal, on pain of incurring such penalties as may be justly inflicted on such offenders for their contempt of this our Royal command, and of being answerable to the patentee according to law for his damages thereby occasioned:

Provided always that these letters patent shall be revocable on any of the grounds from time to time by law prescribed as grounds for revoking letters patent granted by Us and the same may be revoked and made void

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accordingly: Provided also, that if the said patentee shall not pay all fees by law required to be paid in respect of the grant of these letters patent, or in respect of any matter relating thereto at the time or times, and in manner for the time being by law provided; and also if the said patentee shall not supply or cause to be supplied, for our service all such articles of the said invention as may be required by the officers or commissioners administering any department of our service in such manner, at such times, and at and upon such reasonable prices and terms as shall be settled in manner for the time being by law provided, then, and in any of the said cases, these our letters patent, and all privileges and advantages whatever hereby granted shall determine and become void notwithstanding anything herein-before contained: Provided also that nothing herein contained shall prevent the granting of licenses in such manner and for such considerations as they may by law be granted: And lastly, We do by these presents for us, our heirs and successors, grant unto the said patentee that these our letters patent shall be construed in the most beneficial sense for the advantage of the said patentee.

In witness whereof We have caused these our letters to be made patent and to be sealed as of the

one thousand nine hundred

and

*

Comptroller-General of Patents, Designs, and Trade Marks.

Seal of Patent Office.

The form of a patent of addition varies slightly from the above.

* Here is to be inserted the name of the Comptroller-General.

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